

O-294-16

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3105608 BY
UNIQUE PHYSIQUE CLOTHING LTD**

TO REGISTER:



AS A TRADE MARK IN CLASS 25

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 404883 BY 1000 MILE SPORTSWEAR LIMITED**

BACKGROUND

1. On 24 April 2015, Unique Physique Clothing Ltd (“the applicant”) applied to register the trade mark shown on the cover page of this decision for the following goods in class 25:

Athletic clothing; Athletic tights; Athletics footwear; Athletics hose; Athletics shoes; Athletics vests; Athletics wear; Baseball caps and hats; Body warmers; Body warmers [clothing]; Bottoms [clothing]; Boxer briefs; Boxer shorts; Bras; Cap peaks; Casual clothing; Casual footwear ; Casual jackets; Casual shirts; Casual trousers; Casualwear; Children's footwear; Children's headwear; Climbing boots; Climbing boots [mountaineering boots]; Climbing footwear; Clothes for sports; Clothing ; Clothing, footwear, headgear; Clothing for children; Clothing for cycling; Clothing for cyclists; Clothing for fishermen; Clothing for gymnastics; Clothing for martial arts; Clothing for skiing ; Coats; Combinations [clothing]; Cycling pants; Cycling shoes; Cycling shorts; Cyclists' clothing; Ear muffs; Ear muffs [clothing]; Fitted swimming costumes with bra cups; Fleece shorts; Fleeces; Flip-flops; Football jerseys; Footwear ; Footwear; Footwear for men; Footwear for sport; Footwear for sports; Gloves; Gloves as clothing; Gloves [clothing]; Gloves for apparel; Gloves for cyclists; Golf caps; Golf footwear; Golf pants, shirts and skirts ; Golf shirts; Golf shoes; Golf trousers; Gym shorts; Gymshoes; Gymwear; Hats; Head bands; Head sweatbands; Head wear; Headbands against sweating; Headbands [clothing]; Headbands for clothing; Headdresses [veils]; Headgear for wear; Hooded pullovers; Hooded sweatshirts; Hooded tops; Hoods; Hoods [clothing]; Jackets; Jackets and socks; Jackets [clothing]; Jackets (Stuff -) [clothing]; Jeans; Jerseys; Jerseys [clothing]; Jogging bottoms; Jogging bottoms [clothing]; Jogging pants; Jogging shoes; Jogging suits; Jogging tops; Jumpers; Jumpers [pullovers]; Jumpers [sweaters]; Knit jackets; Knit shirts; Knitted gloves; Knitted underwear; Knitwear; Knitwear [clothing]; Ladies' boots; Ladies' footwear; Ladies' suits; Ladies' underwear; Leg warmers; Leggings [leg warmers]; Leggings [trousers]; Leisure shoes; Leisure suits; Leisure wear; Leisurewear; Long jackets; Long sleeve pullovers; Long sleeved vests; Loungewear; Men's and women's jackets, coats, trousers, vests; Men's socks; Menswear; Polo knit tops; Polo neck jumpers; Polo shirts; Polo sweaters; Pullovers; Rugby jerseys; Rugby shirts; Rugby shoes; Rugby shorts; Rugby tops; Running shoes; Running Suits; Running vests; Shirts; Shoes for leisurewear; Short trousers; Shorts; Shorts [clothing]; Short-sleeve shirts; Short-sleeved or long-sleeved t-shirts; Short-sleeved shirts; Ski and snowboard shoes and parts thereof; Ski boots; Ski gloves; Ski hats; Ski jackets; Ski pants; Ski suits; Ski suits for competition; Ski trousers; Ski wear; Skiing shoes; Sleeveless jackets; Sleeveless jerseys; Small hats; Sneakers; Sneakers [footwear]; Snow boarding suits; Snow boots; Snowboard boots; Snowboard jackets; Snowboard shoes; Snowboard trousers; Snowsuits; Soccer boots; Soccer shoes; Sock suspenders; Socks; Socks and stockings; Soles for footwear; Soles [Inner]; Sport shirts; Sport stockings; Sports (Boots for -) ; Sports caps and hats; Sports jackets; Sports jerseys; Sports jerseys and breeches for sports; Sports over uniforms; Sports overuniforms; Sports

shirts; Sports shirts with short sleeves; Sports shoes ;Sports singlets; Sports socks; Sports vests; Sportswear; Stockings; Strapless bras; Sweat bands; Sweat bands for the head; Sweat bands for the wrist; Sweat bottoms; Sweat pants; Sweat shirts; Sweat shorts; Sweat suits; Sweat-absorbent underclothing [underwear];Sweat-absorbent underwear; Sweat-absorbent underwear; Sweatbands;Sweaters;Sweatjackets;Sweatpants;Sweatshirts;Sweatshorts;Sweat suits;Swim briefs; Swim suits; Swim wear for gentlemen and ladies; Swimming caps; Swimming caps [bathing caps];Swimming costumes; Swimming suits; Swimming trunks; Swimsuits; Swimwear; Tabards; Tank tops; Tank-tops; Tee-shirts; Tennis dresses; Tennis pullovers; Tennis shirts; Tennis shoes; Tennis shorts; Tennis skirts; Tennis socks; Tennis sweatbands; Thermal underwear; Thermally insulated clothing; Tights; Tips for footwear; Trainers; Trainers [footwear];Training shoes; Training suits; T-shirts; Under garments; Under shirts; Underclothes; Underclothing; Underclothing (Anti-sweat -);Underclothing for women;Undergarments;Underpants;Undershirts;Underskirts;Underwear;Underwear (Anti-sweat -); Uniforms; Vest tops; Vests; Walking boots; Walking breeches; Walking shoes; Warm up suits; Warm-up jackets; Warm-up pants; Warm-up suits; Warm-up tops; Waterpolo caps; Waterproof capes; Waterproof clothing; Waterproof outerclothing; Waterproof pants; Wearable garments and clothing, namely, shirts; Women's shoes; Womens' underclothing; Womens' undergarments; Women's underwear; Wooden shoes; Wooden shoes [footwear].

The application was published for opposition purposes on 15 May 2015.

2. The application is opposed by 1000 Mile Sportswear Limited (“the opponent”). The opposition, which is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), is directed against all of the goods in the application. The opponent relies upon the goods (shown below) in the following United Kingdom and European Union Trade Marks (“EUTM”):

United Kingdom no. 2544819 for the following series of three trade marks:





which were applied for on 14 April 2010 and which were entered in the register on 24 September 2010:

Class 25 - Clothing, footwear and headgear; leisure clothing, footwear and headgear; laces for footwear; gloves; socks; t-shirts, sweat shirts, shorts and caps; sports clothing, footwear and headgear; sports anoraks; fitness and exercise clothing; sports uniforms; shoes; sandals; training shoes; leisure shoes; sleeves; arm bands; head bands; ear-warmers; gaiters; ponchos.

EUTM no. 9741571 for the trade mark:



which was applied for on 16 February 2011 and which was entered in the register on 23 August 2011:

Class 25 - Clothing, footwear and headgear; leisure clothing, footwear and headgear; gloves; socks; t-shirts, sweat shirts, shorts and caps; sports clothing, footwear and headgear; sports anoraks; fitness and exercise clothing; sports uniforms; shoes; sandals; training shoes; leisure shoes; sleeves; arm bands; head bands; ear-warmers; gaiters; ponchos; articles of sports clothing.

In its Notice of opposition, the opponent stated:

“The mark of the application consists of the word UP in a basic stylised format. The mark of the earlier registration also consists of the word UP also in a stylised format. Whilst the respective marks are not visually identical, there is similarity in that the only letters present in both are “U” and “P”. Furthermore, the respective marks are phonetically identical and conceptually identical. The goods of the application are identical to those of earlier registration...”

3. The applicant filed a counterstatement in which it denies the basis of the opposition. The applicant states:

“In its TM7, the opponent admits that [the registrations upon which it relies] are not visually identical to the mark being applied for. They are in fact completely different and there is no prospect of any confusion between the marks or any damage to the opponent...The opponent is attempting to secure a monopoly over a two letter word mark, the letters “UP”, in respect of goods in class 25, a monopoly it does not own nor which it is entitled to. The opponent owns a highly-stylized mark which on first examination is difficult to interpret to having any meaning. Only on closer scrutiny is it possible to identify that it includes the letters “up”, the artistic additions to the letters making quicker recognition impossible or at best very difficult. By contrast, the simplicity of the mark being applied for makes it immediately recognisable as being “UP”. The later mark being capitalised and within a circle further and substantially differentiates them. To co-exist, logos for two letter marks need to be visually different and these are. No one would ever think there is a connection or association between them...”

4. Although only the applicant filed evidence, both parties filed written submissions during the course of the evidence rounds. Whilst neither party asked to be heard, both filed written submissions in lieu of attendance at a hearing. I will bear all of these submissions in mind and refer to them, as necessary, below.

The evidence

5. This consists of a witness statement (accompanied by three exhibits) from Stuart Bramley, a director at the applicant; I will return to Mr Bramley’s evidence later in this decision.

DECISION

6. The opposition is based upon section 5(2)(b) of the Act which reads as follows:

“5 (2) A trade mark shall not be registered if because -

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

7. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.-(1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for

registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

8. In these proceedings, the opponent is relying upon the trade marks shown in paragraph 2 above, all of which qualify as earlier trade marks under the above provisions. As none of these trade marks had been registered for more than five years at the date when the application was published, they are not subject to proof of use, as per section 6A of the Act. As a consequence, the opponent is entitled to rely upon all of the goods it has identified.

Section 5(2)(b) – case law

9. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

10. The competing goods are shown above. Although, in its submissions, the opponent provides a detailed analysis of the competing goods at issue, it goes on to state:

“11. The earlier marks cover the class heading “clothing, footwear and headgear” which catches all of the goods in the application...”

11. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

12. All of the applicant’s goods would (at the very least) be encompassed by the phrase “clothing, footwear, headgear” in the earlier trade marks. That being the case, the competing goods are to be regarded as identical on the principle outlined in *Merica*.

The average consumer and the nature of the purchasing act

13. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods; I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

14. The average consumer for the goods at issue is a member of the general public. As to the manner in which such an average consumer will select these goods, in *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs)* Joined cases T-117/03 to T-119/03 and T-171/03, the GC considered the level of attention paid when and the manner in which clothing is selected. It stated:

“43 It should be noted in this regard that the average consumer's level of attention may vary according to the category of goods or services in question (see, by analogy, Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26). As OHIM rightly pointed out, an applicant cannot simply assert that in a particular sector the consumer is particularly attentive to trade marks without supporting that claim with facts or evidence. As regards the clothing sector, the Court finds that it comprises goods which vary widely in quality and price. Whilst it is possible that the consumer is more attentive to the choice of mark where he or she buys a particularly expensive item of clothing, such an approach on the part of the consumer cannot be presumed without evidence with regard to all goods in that sector. It follows that that argument must be rejected.

50. The applicant has not mentioned any particular conditions under which the goods are marketed. Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

15. As items of clothing, footwear and headgear are most likely to be the subject of self-selection from traditional retail outlets on the high street, catalogues and websites,

visual considerations are likely to dominate the selection process, though not to the extent that aural considerations can be ignored (for example, when orders are placed by telephone or during interactions with sales assistants). The cost of the goods at issue can vary considerably. Nevertheless, as factors such as material, size, colour, cost and compatibility with other items may all come into play, the average consumer, in my experience, will pay an average degree of attention when making their selection. This level of attention, also in my experience, is likely to increase as the cost and importance of the item increases.

Comparison of trade marks

16. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“CJEU”) stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

17. It would be wrong, therefore, artificially to dissect the trade marks, although, it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create. Although the opponent relies upon four earlier trade marks, as they only differ to the extent they are presented in different colours or against a non-distinctive background, I shall conduct the comparison on the basis of EUTM no. 9741571; if the opponent does not succeed on the basis of this trade mark, it will, in my view, be in no better position in relation to the other trade marks upon which it relies. Proceeding on that basis, the trade marks to be compared are as follows:

Opponent’s trade mark	Applicant’s trade mark
	

18. The applicant’s trade mark consists of two components. The first, is a circular device with a bold outer border and the second the letters/word “U-P”/“UP” presented in upper

case in a bold font and which appears within the confines of the circular device. Given the propensity of those in trade to use a range of geometric shapes as backgrounds upon or borders within which to present their trade marks, the circular device has little distinctive character and will, in my view, play a negligible role in the overall impression the applicant's trade mark conveys. Rather, it is the letters/word "U-P"/"UP" which is the distinctive and dominant component of the applicant's trade mark and it is this component which, in my view, will dominate the overall impression it conveys. Notwithstanding the presentation of the letters "UP" in upper case, as the average consumer is, in my experience, most likely to treat any two letter combination which forms a well-known word as the word itself, it is, in my view, most likely that the applicant's trade mark will be construed as the word "up".

19. The opponent's trade mark is more difficult to assess. To some average consumers it is likely to be seen as a purely figurative trade mark. However, to others it will be seen as a stylised lower case letter "u" presented in white and a stylised lower case letter "p" presented in black in which the bowl of the letter "p" is replaced by an arrow device pointing in an upward direction; to the average consumer who sees the opponent's trade mark in this way, it may be construed as the letters "u-p" or, more likely in my view, given the upward pointing arrow, as the word "up". Regardless of how it is construed, there are, in my view, no dominant components, the distinctiveness lying in the trade mark as a whole and the manner in which it is configured.

The visual, aural and conceptual comparison

20. For those average consumers who construe the opponent's trade mark as purely figurative, there will be no visual, aural or conceptual similarity between the competing trade marks. However, even for those average consumers who construe the opponent's trade mark as the letters/word "u-p"/"up", the degree of stylisation present in the opponent's trade mark renders the competing trade marks visually similar to only a low degree.

21. As to the aural comparison, for those average consumers who construe the opponent's trade mark as either the letters "u-p"/"U-P" or the word "up"/"UP", the competing trade marks will be aurally identical. As I indicated above, the verbalisation of both as the word "up" is, in my view, most likely. If the competing trade marks are construed as the word "up"/"UP", they will be conceptually identical and if construed as the letters "u-p"/"U-P", conceptually neutral.

Distinctive character of the earlier trade mark

22. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has

been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

23. As the opponent has filed no evidence in these proceedings, I have only the inherent characteristics of its trade mark to consider. If construed as a purely figurative trade mark it is, in my view, possessed of a high degree of inherent distinctive character. However, even if it is construed by the average consumer as the letters/word “u-p”/“up”, in my view, it would be possessed of an average degree of inherent distinctive character.

Likelihood of confusion

24. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent’s trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision I concluded, inter alia, that:

- the competing goods are identical;
- the average consumer is a member of the general public who will pay an average degree of attention during the selection process;
- while the goods at issue will be selected by predominantly visual means, aural considerations must be taken into account;
- the letters/word “U-P”/“UP” will dominate the overall impression the applicant’s trade mark conveys;
- the opponent’s trade mark may be construed as either purely figurative or as the stylised letters “u-p” or, more likely, the word “up”;
- if the opponents’ trade mark is construed as purely figurative, there is no visual, aural or conceptual similarity between the competing trade marks;
- if the opponent’s trade mark is construed as the word “up”, the competing trade marks are visually similar to a low degree and aurally and conceptually identical;

- insofar as it is relevant, the opponent's trade mark is possessed of an average degree of inherent distinctive character.

25. In reaching a conclusion in these proceedings, I am mindful of the decision of the Appointed Person ("AP") Mr Iain Purvis Q.C., in BL-O-010-16. In that decision, the AP was asked to reconsider whether there would be a likelihood of confusion between the following trade marks in relation to a range of goods and services in classes 9, 14, 16, 18, 24, 25, 28 and 41:



26. At first instance, the Hearing Officer had concluded that: (i) the competing goods were identical or highly similar, (ii) the average consumer was a member of the general public who would select the goods by primarily visual means and whose level of attention would vary depending on the goods and services at issue, (iii) the competing trade marks were aurally identical, not visually similar and conceptually neutral, and (iv) the earlier trade mark was reasonably high in distinctiveness but that this was attributable to the particular graphic presentation of the letters, not the letters themselves. Having reminded herself that the selection process was primarily visual, the Hearing Officer concluded:

“Furthermore, although I have found that the earlier mark is possessed of a reasonably high degree of distinctive character, this is attributable to the heavy stylisation of the mark, rather than to the letters within the mark per se; there is no such stylisation or similar stylisation in the contested mark. Bearing all this in mind, I come to the conclusion that, notwithstanding that for certain of the goods at issue the level of attention is likely to be low there is no likelihood of confusion, either directly or indirectly, in respect of any of the goods or services at issue.”

27. In relation to the Hearing Officer's conclusion that there was no visual similarity between the competing trade marks, the AP stated:

“12. Secondly, the difference between ‘no visual similarity’ and ‘a low degree of visual similarity’ is not only impossible to define but quite subjective. It is hard to imagine a case in which the spread of reasonable opinions about visual similarity could not cover both of these characterisations. This is not, therefore, fertile ground upon which to base an alleged error of principle.

13. Thirdly, I do not have any difficulty with the notion (which Mr Stobbs appeared to be contending was illogical) that two representations of the

same thing may have no visual similarity. In the world of art, the visual representation of a horse in Picasso's Guernica has little or nothing in common with the visual representation of a horse in one of George Stubbs' portraits. I do not think it unreasonable to say that they have no visual similarity, whilst having some limited conceptual similarity (they are both paintings of horses)."

28. In relation to the fact that the competing trade marks were aurally identical, the AP stated:

"15...In essence his argument was that there was bound to be a likelihood of confusion in this case because of the aural 'identity' between the marks (if one tried to ask for goods using an aural version of the earlier mark, one would ask for 'RA' goods, just as one would ask for the applicant's goods). This argument seems to me to fly in the face of the necessary 'global' assessment, bearing in mind the visual, conceptual and aural similarities, which the tribunal must carry out. Particularly in the case of an earlier mark which is a heavily stylised device mark, taking the aural similarities alone tends to ignore the real substance and distinctive character of the mark and is likely to lead to an erroneous result."

29. The parallels between the two cases are obvious. In these proceedings, I have concluded, inter alia, that for those average consumers who construe the opponent's trade mark as the word "up", the competing trade marks are visually similar to a low degree (as opposed to no visual similarity in the earlier proceedings), aurally identical (as in the earlier proceedings) and conceptually identical (as opposed to conceptually neutral in the earlier proceedings). I have also concluded that even if the letters/word "u-p"/"up" were presented in normal typeface they would be possessed of an average degree of inherent distinctive character.

30. Although I have accepted that some average consumers may construe the opponent's trade mark as purely figurative, within the average consumer group there will be, in my view, a similarly not insignificant group who treat the opponent's trade mark as the word "up". This is important, because the opposition may still succeed if a sufficiently significant percentage of relevant consumers (which may not necessarily be the majority of consumers) are confused. To illustrate the point, in *J.W.Spear & Sons Ltd and Others v Zynga Inc.* [2015] EWCA Civ 290, Floyd L.J. summed up the Court of Appeal's earlier judgment in *Interflora Inc. and another v Marks and Spencer plc* [2014] EWCA Civ 1403 like this:

"37. In relation to what the court described as the crucial question, namely whether the average consumer, as a hypothetical person, necessarily has a single reaction and so precludes a consideration of the perceptions of a proportion of the relevant public the court in *Interflora* identified the following propositions:

i) the average consumer test provides the court with a perspective from which to assess the particular question it has to decide, for example whether a statement is liable to mislead purchasers.

ii) a national court may be able to assess this question without the benefit of a survey or expert evidence.

iii) a national court may nevertheless decide, in accordance with its own national law, that it is necessary to have recourse to an expert's opinion or a survey for the purpose of assisting it to decide whether the statement is misleading or not.

iv) absent any provision of EU law dealing with the issue, it is then for the national court to determine, in accordance with its own national law, the percentage of consumers misled by the statement that, in its view, is sufficiently significant in order to justify banning its use.”

31. Although I have acknowledged that the purchasing act for the goods at issue will be primarily visual, I have also found that aural considerations must not be overlooked, citing orders placed by telephone and interactions with sales assistants as examples. Whilst, of course, I am mindful of the AP’s comment in the earlier proceedings that: “taking the aural similarities alone tends to ignore the real substance and distinctive character of the mark and is likely to lead to an erroneous result”, the position in these proceedings, in my view, is different. Unlike the figurative trade mark in the earlier proceedings, it is much more likely, in my view, that a “sufficiently significant” percentage of average consumers will construe and verbalise the opponent’s trade mark as the word “up”. This will lead to aural and conceptual identity between the competing trade marks and, in my view, from at the very least an aural perspective, to a likelihood of direct confusion.

The applicant’s evidence and submissions in relation to the state-of-the-register

32. For the sake of completeness, I should point out that in reaching the above conclusion, I have not overlooked either the applicant’s “state of the register” evidence or the evidence of Mr Bramley filed on its behalf. In relation to the former, suffice to say that “state of the register” evidence is rarely of assistance (that being the case here). Insofar as Mr Bramley’s evidence is concerned, he states:

“3...I make this statement to highlight the differences between the physical nature of the goods sold under the [the applicant’s trade mark] and the goods sold by the opponent, the respective users of such goods and the markets to which they are sold.”

33. Attached to his statement are three exhibits which consist of: screen shots of the applicant’s website (exhibit SB1), a screen shot of the applicant’s products on the ASOS website (exhibit SB2) and screen shots of the opponent’s website (exhibit SB3).

34. In *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, the CJEU stated that:

“59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

As neither parties' specification are limited in any way, the manner in which the parties' currently use their respective trade marks and the markets they target are not relevant considerations.

Fall back specification

35. In a letter dated 24 May 2016, the applicant stated:

“...should the hearing officer be minded to find in favour of the opponent on the basis of the specification set out in the application, the applicant would be prepared to accept a limited fall-back specification, as follows:

Clothing, footwear and headgear limited to leisure wear, sports clothing, fitness wear, gym clothing and clothing for bodybuilders.”

36. As I mentioned earlier, the opponent's earlier trade mark is registered in respect of, inter alia, “clothing, footwear and headgear” at large; as the goods in the applicant's fall-back specification would all be included within those general terms, the applicant's offer to limit its specification does not assist it.

Conclusion

37. The opposition succeeds in full and, subject to any successful appeal, the application will be refused.

Costs

38. As the opponent has been successful it is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice 4 of 2007. Using that TPN as a guide, but making no award to the opponent in respect of its submissions filed in lieu of attendance at a hearing in which it specifically indicated that it had “nothing further to add” (to its pleadings and submissions filed during the evidence rounds), I award costs to the opponent on the following basis

Preparing a statement and considering the other side's statement: £200

Written submissions (including considering and commenting on the applicant's evidence): £400

Official fee: £100

Total: £700

39. I order Unique Physique Clothing Ltd to pay to 1000 Mile Sportswear Limited the sum of **£700**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 16th day of June 2016

**C J BOWEN
For the Registrar
The Comptroller-General**