

O-350-16

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 3112530
BY BANI TRADING LIMITED TO REGISTER THE TRADE MARK**

MOMO FASHIONS

IN CLASS 25

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO 405092
BY WOMO S.R.L.**

Background and pleadings

1) Bani Trading Ltd (“the applicant”) applied to register the trade mark “Momo Fashions” in the UK on 9 June 2015. It was accepted and published in the Trade Marks Journal on 26 June 2015 in respect of the following goods:

Class 25: *Clothing, footwear, headgear, fancy dress.*

2) Womo S.R.L. (“the opponent”) opposes the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). This is on the basis of the following earlier European Union (formerly Community) Trade Mark (“EUTM”), the relevant details of which are:

Mark and relevant dates	Goods relied upon
EUTM 10422244 WOMO Filing date: 16 November 2011 Date of entry in register: 20 April 2012	Class 25: <i>Clothing, belts, footwear, headgear</i>

3) The opponent argues that the respective goods are identical or similar and that the marks are similar.

4) The applicant filed a counterstatement denying the claims made. It states that it sells fancy dress and ladies’ fashion whereas the opponent sells menswear only. It also requested that the opponent provide proof of use of its earlier trade mark, but because it was applied for less than five years before the publication of the applicant’s mark it is not subject to the proof of use provisions set out in section 6A of the Act. It is not required to provide evidence of use.

5) Both sides filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate/necessary. The opponent is represented in these proceedings by Stevens Hewlett & Perkins. The applicant is unrepresented. No hearing was requested and so this decision is taken following careful consideration of the papers.

Opponent's evidence

6) This takes the form of a witness statement by Stefano Percassi, managing director of the opponent. He discloses that the opponent has a number of shops in main cities in Italy and Switzerland and that it offers fashion products and services for men, particularly cosmetics and clothing. He provides turnover and marketing figures.

Applicant's evidence

7) This consists of a joint witness statement by Moazma Mahmood, personal secretary to the applicant's director (and her husband) Adnan Mahmood. Their evidence relates to the use of the applicant's mark.

8) Mrs Mahmood states that when conducting an Internet search using Google, for "momo fashions" the results relate only to momo fashions and when a search for "WOMO design" is undertaken, only information relating to WOMO Design SRL is shown.

9) Evidence of the applicant's presence on the UK market is also provided.

DECISION

The legislation

10) Section 5(2)(b) of the Act is 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, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

Comparison of goods and services

11) The respective goods (all in Class 25) that I must consider are:

Opponent's goods	Applicant's goods
<i>Clothing, belts, footwear, headgear</i>	<i>Clothing, footwear, headgear, fancy dress</i>

12) Both parties' specifications include the terms *Clothing, footwear and headgear* and it is self-evident that these describe identical goods.

13) The applicant's specification also includes the term *fancy dress*. In considering the similarity of this term with the terms in the opponent's specification, I keep in mind *Gérard Meric v OHIM*, T-133/05 (GC):

“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 the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedial v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

14) Whilst the term fancy dress is not present in the opponent's specification, the term clothing is so broad that it encompasses *fancy dress*. Applying the guidance from *Meric*, in these circumstances, the respective terms cover identical goods.

14) In summary, all of the applicant's goods are identical to the goods listed in the opponent's earlier mark.

Comparison of marks

15) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union 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.”

16) It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

17) The opponent's mark consists of the single word WOMO and it is, therefore, self-evidently the dominant and distinctive element of the mark. The applicant's mark consists of the two words “Momo” and “Fashions”. The second word is descriptive of the goods relied upon and is therefore of low or no distinctive character. The dominant and distinctive element of the applicant's mark is the word “Momo”.

18) The respective trade marks are shown below:

Opponent's mark	Applicant's mark
WOMO	Momo Fashions

19) Both marks are simple word marks and consequently, they cover use in any ordinary typeface and in lower or upper case. Therefore, the difference in case is of no consequence when considering the similarity of the marks. Visually, the marks are similar by virtue of having the same letters "OMO" appearing as the last three letters of the four letter word WOMO or MOMO in the respective marks. The first letters differ with "W" appearing at the front of the opponent's mark and the letter "M" at the front of the applicant's mark, but I note that one is merely the inverted form of the other. The applicant's mark also includes the additional element "Fashions". Taking the similarities and the differences into account, I conclude that the respective marks share a moderately high level of visual similarity.

20) From an aural perspective, the opponent's mark is likely to be pronounced as the two syllables WO-MO. The applicant's mark is likely to be pronounced in one of two ways. Firstly, if the whole mark is articulated as the four syllables MO-MO-FASH-UNS. However, descriptive elements of marks are often not expressed, but rather the mark is referred to by way of its distinctive element. In such a case the applicant's mark will be articulated as the two syllables MO-MO. The aural similarity is moderately high or high depending on which of these two ways the applicant's mark will be referred.

21) Conceptually, the opponent's mark has no obvious meaning and neither does the MOMO element of the applicant's mark. The word "Fashions" in the applicant's mark has an obvious meaning that will be immediately understood by the consumer and will introduce an element of conceptual difference.

Average consumer and the purchasing act

22) The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

23) 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.”

24) The average consumer of the parties' goods will be ordinary members of the public who wish to purchase clothing, footwear and headgear. The purchase is normally made from high street or Internet retailers. In respect of the nature of the purchasing act for these goods, I am mindful of the comments of Mr Simon Thorley, sitting as the Appointed Person, in *React trade mark* [2000] R.P.C. 285:

“There is no evidence to support Ms Clark's submission that, in the absence of any particular reputation, consumers select clothes by eye rather than by placing orders by word of mouth. Nevertheless, my own experience tells me it is true of most casual shopping. I have not overlooked the fact that catalogues and telephone orders play a significant role in this trade, but in my experience the initial selection of goods is still made by eye and subsequent order usually placed primarily by reference to a catalogue number. I am therefore prepared to accept that a majority of the public rely primarily on visual means to identify

the trade origin of clothing, although I would not go so far as to say that aural means of identification are not relied upon.”

25) The General Court (“the GC”) has continued to identify the importance of visual comparison when considering the purchasing act in respect of clothing (see for example Joined Cases T-117/03 to T-119/03 and T-171/03 *New Look Ltd v OHIM (NLSPORT et al)* [2004] ECR II-3471 at [49]-[50] and Case T-414/05 *NHL Enterprises BV v OHIM (LA KINGS)* [2009] ECR II.). There is nothing before me in the current proceedings to lead me to conclude differently and, consequently, taking into account the above comments, I conclude that the purchasing act will generally be a visual one. However, I do not ignore the aural considerations that may be involved. The purchase of clothing and similar goods is, if not quite an everyday purchase, certainly a regular purchase for most consumers. Whilst these goods vary in cost, they are not normally very expensive. Taking account of this, the level of attention paid by the consumer is reasonable rather than high.

Distinctive character of the earlier trade mark

26) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically

widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

27) The opponent’s earlier mark consists of the single word WOMO. It appears to be an invented word with no meaning and, as such, is endowed with a high level of inherent distinctive character.

28) The opponent has provided evidence of the marks use, but this is all use outside the UK and therefore it cannot show that it has acquired an enhanced level of distinctive character through use in the UK.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.

29) The following principles are gleaned from the decisions of the CJEU 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:

(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 great 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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

30) The applicant submits that the parties actually trade in different types of fashion with the applicant involved in women's clothing and fancy dress targeting young women that go out partying and socialising at clubs. On the other hand, it is submitted that the opponent will target working men that have a different interest when socialising. It is well established that marketing considerations do not play a part in assessing likelihood of confusion (see for example: *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P). I must make an assessment based upon notional use of the respective marks. Such an assessment requires that I consider that the earlier mark has been used in relation to all the goods relied upon (see *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220). This is because the current marketing strategy of either party may change over time, and one or both may start trading in identical goods to the other. Further, either trade mark may be sold and the new proprietor may change the marketing strategy. Therefore, I reject the applicant's argument and confirm my earlier finding that the respective goods are identical.

31) Further, I have found that the respective marks share a moderately high level of visual, a moderately high or high level of aural similarity and in so far as the applicant's mark contains the descriptive word "Fashions", there some conceptual difference. However, it is well established that descriptive or non-distinctive matter should be given less weight when comparing marks: see *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* - C-342/97 (CJEU) at paragraphs 22-23, *Digipos Store Solutions Group Ltd v Digi International Inc* [2008] RPC 24 (HC), *Reed Executive Plc v Reed Business Information Ltd* [2004] RPC 40 (COA) and *CM Capital Markets Holding, SA v OHIM* - T-563/08 (GC).

32) There is also guidance from the courts regarding the importance of the first element: See T-183/02 and T-184/02 *El Corte Inglés, SA v OHIM* (GC) but see also the following cases from the GC: *Castellani SpA v OHIM*, T-149/06, *Spa Monopole, compagnie fermière de Spa SA/NV v OHIM*, T-438/07, *CureVac GmbH v OHIM*, T-80/08 and *Enercon GmbH v OHIM*, T-472/07 (the latter for the application of the principle to a two word mark). Generally speaking, the first element of a mark may have greater importance when assessing whether there is a likelihood of confusion

and that the shorter the word is, the greater the likelihood that a different first element will be sufficient to differentiate the respective marks. In the current case, the common distinctive elements MOMO and WOMO both consist of four letters and the first element of these words, i.e. the letter "M" and the letter "W" differ. However, the letter "M" presents as an inverted "W" and, as a result, with the letters comprising of essentially the same shape, there is an additional point of visual similarity between the marks.

33) I take all of this into account, together with the fact that the purchasing act is primarily visual in nature and that the level of distinctive character of the opponent's mark is high. It is well established that the more distinctive a trade mark the greater the likelihood of confusion (see *Icebreaker Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-112/09*). I find that as a result of imperfect recollection, the average consumer is likely to confuse the marks. The additional element "Fashions", present in the applicant's mark, being descriptive, even if recalled in imperfect recollection, does not remove a likelihood of confusion. Rather, it will function only in separating the marks from each other in the minds of the consumer but not the trader. In other words, the consumer will still believe that the goods provided under the respective marks originate from the same or linked undertaking.

34) Mrs Mahmood's evidence illustrates that searches for the respective marks on the Google Internet search engine do not produce hits for both marks in the same results. This is not persuasive because I must assess the likelihood of confusion from the perspective of the average consumer and not based on the way a particular search engine searches and retrieves hits. This evidence does not disturb my finding.

35) In summary, I have found that the opposition is successful in its entirety.

COSTS

36) The opponent has been successful and is entitled to a contribution towards its costs, according to the published scale in Tribunal Practice Notice 2/2016. I take

account that both sides filed evidence, but that the opponent's evidence did not assist its case. I award costs as follows:

Preparing statement and considering counterstatement	£300
Opposition fee	£100
Considering applicant's evidence	£500
Total:	£900

37) I order Bani Trading Limited to pay Womo S.R.L. the sum of £900, which, in the absence of an appeal, should be paid within 14 days of the expiry of the appeal period.

Dated this 20th day of July 2016

Mark Bryant
Principal Hearing Officer
For the Registrar,