

O-376-16

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3091988 BY
JAMES MARGACH FRASER**

TO REGISTER:

MARCS

AS A TRADE MARK IN CLASSES 8, 25 & 29

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 404726 BY MARC SHOES GMBH**

BACKGROUND

1. On 30 January 2015, James Margach Fraser (“the applicant”) applied to register **MARCS** as a trade mark for goods in classes 8, 25 and 29. The application was published for opposition purposes on 17 April 2015.

2. The application is opposed by MARC Shoes GmbH (“the opponent”). The opposition, which is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), is only directed against the goods in class 25 of the application i.e. “Clothing, footwear, headgear”. The opponent relies upon the goods (shown below) in the following International Trade Marks designating the European Union (“ITM(EC)”):

ITM(EC) no. 1061556 for the following trade mark:



MARC

which designated the EU on 29 November 2010 (claiming an International Convention priority date of 1 June 2010 from an earlier filing in Germany) and which was granted protection in the EU on 15 November 2011:

Class 25 - Clothing, footwear, headgear.

ITM(EC) no. 893081 for the trade mark: **MARC** which designated the EU on 13 June 2006 (claiming an International Convention priority date of 16 December 2005 from an earlier filing in Germany) and which was granted protection in the EU on 18 July 2007:

Class 25 – Footwear.

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

4. Although only the opponent filed evidence, the applicant filed written submissions during the course of the evidence rounds. Whilst neither party asked to be heard, the opponent 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.

DECISION

5. 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.”

6. An earlier trade mark is defined in section 6 of the Act, which states:

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

(a) a registered trade mark, international trade mark (UK), 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,

(b) a Community trade mark or international trade mark (EC) which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), (ba) a registered trade mark or international trade mark (UK) which-

(i) has been converted from a Community trade mark or international trade mark (EC) which itself had a valid claim to seniority within paragraph (b) from an earlier trade mark, and

(ii) accordingly has the same claim to seniority, or

(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark.

(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.

(3) A trade mark within subsection (1)(a) or (b) whose registration expires shall continue to be taken into account in determining the registrability of a later mark for a period of one year after the expiry unless the registrar is satisfied that there was no *bona fide* use of the mark during the two years immediately preceding the expiry.”

7. In these proceedings, the opponent is relying upon the two trade marks shown in paragraph 2 above, both of which qualify as earlier trade marks under the above provisions. As ITM(EC) no. 1061556 had not been protected for more than five years at the date when the application was published, it is not subject to proof of use, as per section 6A of the Act; as a consequence, the opponent is entitled to rely upon it in respect of all of the goods it has identified.

8. ITM(EC) no. 893081 however, is subject to the proof of use requirements. In its Notice of opposition, the opponent indicated that this trade mark had been used for all the goods for which it is protected i.e. footwear and in its counterstatement the applicant puts the opponent to proof of this claim. The relevant sections of the Act in relation to proof of use read as follows:

“6A. - (1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if -

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

Section 100 of the Act is also relevant and reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

Proof of use – ITM(EC) no. 893081 - MARC

9. In reaching a conclusion, I must apply the same factors as I would if I were determining an application for revocation of a trade mark registration based on grounds of non-use; the relevant period for present purposes is the five year period ending with the date of the publication of the application for registration i.e. 18 April 2010 to 17 April

2015. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He stated:

“I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at

[20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

10. As the opponent's earlier trade mark is an ITM(EC), the comments of the Court of Justice of the European Union (“CJEU”) in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11 are relevant. It noted that:

“36. It should, however, be observed that..... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

And

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or

maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77).”

The court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.”

11. In *The London Taxi Corporation Limited* case mentioned above, Arnold J. reviewed the case law since the *Leno* case and concluded as follows:

“228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national

courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issues in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that "genuine use in the Community will in general require use in more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State". On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not

sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use.”

12. The General Court (“GC”) restated its interpretation of *Leno Marken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of a EUTM. Consequently, in trade mark opposition and cancellation proceedings it continues to entertain the possibility that use of an ITM(EC) in an area of the European Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an ITM(EC). This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the European Union. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the ITM(EC), in the course of trade, sufficient to create or maintain a market for the goods/services at issue in the EU during the relevant 5 year period. In making the assessment I am required to consider all relevant factors, including:

- i) The scale and frequency of the use shown
- ii) The nature of the use shown
- iii) The goods and services for which use has been shown
- iv) The nature of those goods/services and the market(s) for them
- v) The geographical extent of the use shown.

13. The opponent’s evidence consists of a witness statement from its manager Bernhard Hillen, a position he has held since September 2014. Mr Hillen confirms that the information in his statement comes from his own knowledge and the opponent’s records. In view of comments contained in the applicant’s written submissions (to which

I will return in a moment), it is not, in my view, necessary for me to summarise Mr Hillen's statement in any great detail. Suffice to say that Mr Hillen states that the opponent's MARC trade mark has been in use in the EU since "at least as early as 2008 in connection with footwear for ladies and gentlemen", adding that the trade mark has been used continuously in a range of countries in the EU "since at least as early as 2011." He provides sales figures for Germany, Belgium, Denmark and Finland for the period 2010 to 2014 with sales in these four countries alone amounting to a little under €62.5m. He states that footwear is sold under the MARC trade mark via sales agents, wholesalers/distributors and direct to customers with the approximate cost per unit of a direct sale being €30 and €22 to retailers. At exhibits BH2-BH7, Mr Hillen provides a range of brochures from Spring/Summer 2009, 2011, 2012 and 2015 and Autumn/Winter 2011 and 2012/2013, all of which bear the MARC trade mark and which relate to footwear. Mr Hillen explains that 5,000 of these brochures are ordered each season and are sent to all existing customers and to the opponent's agents and distributors. At exhibits BH8 and BH9 Mr Hillen provides sample orders placed by and invoices issued to undertakings based in the EU. He also provides details of the various exhibitions and trade fairs the opponent has attended between 2010 and 2015 to promote goods bearing its MARC trade mark which, I note, have taken place in a range of EU jurisdictions. Returning to the applicant's comments on this evidence, in its submissions it states:

"11...it is abundantly clear that any use by the opponent of [its earlier trade marks] is in relation to footwear only...We therefore submit that although there appears to be evidence that the opponent has proved use of its earlier marks for "footwear"..."

And:

"15. All of the evidence filed by the opponent clearly illustrates that although it appears to have used [its earlier trade marks] within the relevant period this use is strictly related to "footwear" only and there is no actual commercial use in the

UK, either presently or within the recent past...we submit that the opponent has only (at best) proved use for a narrow scope of goods within the relevant time period...”

14. Although the applicant’s submissions are based on a misunderstanding that ITM(EC) no. 893081 is registered for clothing, footwear and headgear (rather than footwear alone), in my view, it represents a realistic (if somewhat begrudging) admission that the opponent has made genuine use of its MARC trade mark in the EU in the relevant period in relation to the goods for which it is registered. The correctness of that admission can be easily tested by reference to the evidence provided by Mr Hillen which I have summarised above. In short, I have no hesitation concluding that within the relevant period the opponent has made genuine use of its MARC trade mark in the EU and is entitled to rely upon it for the goods for which it stands registered i.e. footwear.

Section 5(2)(b) – case law

15. 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

16. The specification of the application in class 25 i.e. “Clothing, footwear, headgear” and that of ITM(EC) no. 1061556 are identical. As to ITM(EC) no. 893081, I have concluded that the opponent is entitled to rely upon this trade mark for the goods for which it is registered i.e. footwear, which is, of course, identical to “footwear” in the application. As to the remaining goods in the application, in its submissions, the opponent states:

“35. The term “footwear” is similar to “clothing” and “headgear” of the opposed application. These are all products for clothing or covering one’s body. Although different parts of the body would be covered by the respective goods, the users of the goods would be the same i.e. the public at large. The trade channels are likely to coincide. It is commonplace for clothing manufactures to also offer footwear under their trade marks, such as HUGO BOSS, RALPH LAUREN, DANIEL HECHTER, VERSACE, ESPIRIT, DOCKERS and TOMMY HILFIGER, by way of example. The goods may be sold in the same retail establishments, such as clothing stores, which also sell footwear, or general department stores which sell various goods for clothing one’s body...”

17. In the judgment of the CJEU in *Canon*, Case C-39/97, the Court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) In the case of self serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity

between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

In *Giordano Enterprises Ltd v OHIM* (case T-483/08) the GC stated:

“20 As regards the goods in Class 25 for which the applicant seeks registration of its trade mark, it challenges the Board of Appeal’s finding that ‘clothing’ and ‘headgear’ are similar to ‘footwear’ for which the earlier trade mark is registered. As the Court has held in previous cases, in view of the sufficiently close links between the respective purposes of ‘clothing’ and ‘footwear’, which are identifiable in particular by the fact that they belong to the same class, and the specific possibility that they can be produced by the same operators or sold together, it may be concluded that those goods may be linked in the mind of the relevant public (Case T-115/02 *AVEX v OHIM – Ahlers (a)* [2004] ECR II-2907, paragraphs 26 and 27; see also judgment of 10 September 2008 in Case T-96/06 *Tsakiris-Malla v OHIM – Late Editions(exé)*, not published in the ECR, paragraphs 29 and 30, and judgment of 8 March 2005 Case T-32/03 *Leder & Schuh v OHIM – Schuhpark Fascies(Jello Schupark)*, not published in the ECR, paragraph 50). That reasoning may be applied by analogy to ‘headgear’ and ‘footwear’ since ‘headgear’ also has the same basic nature and purpose as ‘footwear’, albeit in respect of a different part of the human body.”

18. Given the similarity in, inter alia, the respective users, nature, intended purpose, method of use, trade channels and the potential complementary relationship that may

exist between them, “footwear” in the opponent’s specification is, in my view, similar to “clothing” and “headgear” in the application to a high degree.

The average consumer and the nature of the purchasing act

19. 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.”

20. 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.”

21. 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

22. 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 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.”

23. 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. The trade marks to be compared are as follows:

Opponent's trade marks	Applicant's trade mark
MARC 	MARCS

24. As all of the letters in the applicant's trade mark are presented in plain block capitals, the overall impression it will convey is that of a single word and it is in the totality that the distinctiveness lies. The same analysis applies to the opponent's MARC trade mark. As to the opponent's **MARC** trade mark, this, in my view, consists of the word MARC presented in capital letters in a slightly stylised (but unremarkable) heavy bold font; in the centre of the bowl of the letter "C" there appears a dot presented in the same heavy bold font as that in which the word is presented. Even if the dot is noticed by the average consumer, given its relative size and positioning in the context of the trade mark as a whole, it does not, in my view, change the overall impression of the word of which it is a part. As a consequence, it is the word MARC that will dominate the overall impression the trade mark conveys and in which the trade mark's distinctiveness lies.

25. Having reached the above conclusions, I must now assess the degree of visual, aural and conceptual similarity between the applicant's trade mark and the two earlier trade marks relied upon by the opponent.

Comparison between the opponent's MARC trade mark and the applicant's trade mark

26. The competing trade marks consist of four and five letters respectively; the first four letters of the applicant's trade mark are identical to the letters of which the opponent's trade mark consists. Notwithstanding the presence at the end of the applicant's trade mark of the additional letter "S", the competing trade marks are, in my view, visually and aurally similar to a high degree. In relation to the conceptual comparison, in its counterstatement, the applicant began by stating:

"2.4. The applicant's mark consists of the original and invented word MARCS..."

However, it went on to state:

“2.6. Conceptually, the opponent's mark possesses several possible meanings. The average consumer may identify the mark as referring to a common male first name (MARC/MARK) or they may consider it to be a play on the word “MARK” which denotes the act of writing a word or symbol on an object or the word or symbol per se when used as a noun. Both of which may be considered as alluding to the idea of branding or identity. The applicant's mark on the other hand contains the suffix letter “S” which changes the dynamics and meaning of the word insofar as it would be recognised by the average consumer as denoting a name, with the “S” element indicating ownership of the products. **In effect, the relevant public would identify the applicant's mark MARCS as indicating that the goods sold under the brand are created, produced and owned by a person or entity named “MARC” as the “S” element implies that there would be an apostrophe present to demonstrate ownership of something.** Such conceptual differences would not go unnoticed by the relevant public...”
(my emphasis)

In its written submissions however, it stated:

“3...The applicant's mark MARCS is a purely invented word and has no specific conceptual meaning in English...”.

In its written submissions, the opponent commented upon the applicant's views of the conceptual position (as stated in its counterstatement) in the following terms:

“21. The applicant acknowledges that the word mark MARC is a male first name. The further submissions by the applicant that the applicant's mark is the possessive form of MARC would seem to be an admission that there is conceptual similarity between the respective marks. We would agree. We

consider the opponent's mark and the applicant's mark to be conceptually very similar.

27. Despite what appears to be the applicant's change of tack in its written submissions, I agree with its original comments contained in its counterstatement. In my experience, MARC is a fairly well-known variant spelling of the very well-known male forename MARK. Notwithstanding the absence of an apostrophe between the letters "C" and "S", I agree with the applicant's initial view i.e. that its trade mark will (to use its words) be understood "as indicating that the goods sold under the brand are created, produced and owned by a person or entity named "MARC". In my view, the competing trade marks are conceptually highly similar.

Comparison between the opponent's **MARC trade mark and the applicant's trade mark**

28. When conducting this comparison I remind myself that the opponent's trade mark also includes a dot in the bowl of the letter "C". However, I have already concluded that given the size and positioning of this element in the context of the trade mark as a whole, it is the word MARC that will dominate the overall impression the trade mark conveys. As a consequence, my conclusions in relation to the opponent's MARC trade mark are of relevance here. Whilst I am prepared to accept that the presence of the dot may marginally reduce the degree of visual similarity, in my view, it will have no material impact on my earlier conclusions in relation to the degree of aural or conceptual similarity between the competing trade marks.

Distinctive character of the earlier trade mark

29. 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.

30. Although the opponent has provided evidence which indicates that it has conducted a trade under its MARC trade mark in the United Kingdom (including having a representative in and attending a number of exhibitions held in this country), as it has provided no information regarding the scale of its trade in this country, I am not in a position, on the basis of the evidence provided, to conclude that the distinctiveness of this trade mark has been enhanced by the use made of it. As far as I can tell (and there are no submissions to the contrary), no evidence has been provided which demonstrates that the opponent has used its **MARC** trade mark in other countries in the EU let alone in this country. In its counterstatement, the applicant stated:

“2.4...The relevant public will also possess a higher level of attention because of the noticeable dilution in the market place due to the existence of various other “MARC” marks that cover identical and similar goods/and or services.”

As no evidence has been provided in support of the above assertion, it does not assist the applicant. Considered in that context and absent use, as neither of the opponent’s earlier trade marks are, in my view, either descriptive of or non-distinctive for the goods at issue, they are, in view, possessed of at least an average degree of inherent distinctive character.

Likelihood of confusion

31. 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.

32. Earlier in this decision I concluded that the opponent's MARC trade mark was visually, aurally and conceptually highly similar to the application and that the competing goods were similar to a high degree. Reminding myself, inter alia, that the average consumer is a member of the general public who will select the goods at issue by predominantly visual means whilst paying only an average degree of attention (thus making them prone to the effects of imperfect recollection), I have no hesitation concluding that there is a likelihood of direct confusion i.e. the applicant's MARCS trade mark will be mistaken for the opponent's MARC trade mark. For the reasons indicated in paragraph 28 above, I reach the same conclusion in relation to the opponent's **MARC** trade mark in relation to which, of course, the respective goods are identical.

Conclusion

33. The opposition succeeds and, subject to any successful appeal, the application will be refused in relation to class 25. The application may proceed to registration in the classes which were not opposed i.e. 8 and 29.

Costs

34. 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, I award costs to the opponent on the following basis

Preparing a statement and considering the other side's statement:	£200
Preparing evidence:	£600
Written submissions (including considering and commenting on the applicant's submissions):	£300
Official fee:	£100
Total:	£1200

35. I order James Margach Fraser to pay to Marc Shoes GmbH the sum of **£1200**. 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 5th day of August 2016

C J BOWEN
For the Registrar
The Comptroller-General