

O-061-17

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION No 1250568
AND THE REQUEST BY LISA NOUH AND BNB GROUP AUSTRALIA PTY LTD
TO PROTECT IN THE UK THE TRADE MARK**

iFLY

IN CLASS 25

AND

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO 405741
BY SKYVENTURE INTERNATIONAL (UK) LTD**

BACKGROUND AND PLEADINGS

1. An international trade mark registration (“IR”) (numbered 1250568) was made on 12 September 2014 seeking to protect in the UK the trade mark “iFLY” in Class 25, which relates to clothing. (Details of the specification are given below.) The holders of that IR are Lisa Nouh and BNB Group Australia PTY Ltd (“the Applicants”). The Applicants are represented by Trademarkit, based in the UK.
2. For their IR designating the UK, the Applicants claim priority from 18 August 2014, based on their application for a national trade mark in Australia.
3. The Applicants’ IR 1250568 was published for opposition purposes in the Trade Marks Journal on 2 October 2015 and was opposed by Skyventure International (UK) Ltd (“the Opponent”). The Opponent is represented by Marks & Clerk LLP, trade mark attorneys based in the UK.
4. The Opponent owns an international trade mark registration (numbered 1225899) designating the European Union (EU), for its trade mark “IFLY”. The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and the Opponent relies on all goods covered by its IR 1225899, for the mark IFLY, which is protected in the EU as follows:

Class 9: *Pre-recorded DVDs and videotapes featuring people engaging in simulated skydiving; downloadable video recordings featuring people engaging in simulated skydiving.*

Class 16: *Photographs featuring pictures of people engaging in simulated skydiving.*

Class 25: *Clothing, namely, shirts, jackets, hats, underwear, gloves and sweatshirts.*

5. Following an amendment, the Applicants' specification now reads as follows:

Class 25: *Ballet clothing; clothing for gymnastics; clothing for surfing; clothing for swimming; cycling shorts and bibs; swim briefs; bathing trunks; swimming trunks; surfing shorts; swimming costumes; swimming shorts; swimming suits; beach shoes; dance shoes; dress shoes; flat shoes; shoes for infants; sleepwear; nightclothes (sleeping garments); sleeping garments; disposable underwear; jockstraps (underwear); shapewear (slimming underwear); slimming underwear; sweat-absorbent underwear; underwear; boxer shorts; briefs; bras; brassieres; foundation garments.*

6. The Opponent's IR designated the EU on 30 July 2014¹ and has been protected in the EU since 6 October 2015.

7. Section 6(1)(a) of the Act defines an "earlier trade mark" as:

"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."

8. The Opponent's mark is therefore an earlier trade mark in accordance with section 6 of the Act. Moreover, since the date on which protection was conferred on the Opponent's IR is less than five years before the UK publication date of the Applicants' IR, the earlier mark is not subject to the proof of use provisions under section 6A of the Act. Consequently, the Opponent may rely on all the goods protected by the earlier mark without having to prove use.

9. The Opponent enclosed a Statement of Grounds with their Notice of Opposition, and subsequently provided written submissions. The Opponent claims that there is a high level of similarity between the respective trade marks and identity or

¹ (There is a typographical error in the Opponent's submissions where the reference is to 30 July 2015, but this is of no consequence – indeed the Opponent gives the correct date in its Statement of Grounds enclosed with its Notice of Opposition.)

similarity between the respective goods in question, such that there would be a likelihood of confusion on the part of the relevant UK public as to the origin of the goods in question.

10. The Applicants filed a brief counterstatement that denies all claims made in the Opponent's Statement of Grounds, including similarity between the respective marks. The counterstatement includes various comments as to why the opposition should fail. I will take those points into account and will refer to them where appropriate during this decision.
11. Neither party has filed evidence or requested to be heard, so this decision is taken following a careful consideration of the papers before me.

DECISION

12. The Opponent's claim is based solely on section 5(2)(b) of the Act, which states:

"... 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."

13. The following decisions of the EU courts provide the principles to be borne in mind when considering section 5(2)(b) of the Act:

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 are that:

- (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.

Comparison of the goods

14. By virtue of its international registration designating the European Union, the Opponent has protection in the UK for its mark (IFLY) in relation to a limited list of specified items and types of clothing within Class 25, and it is in Class 25 that the Opponent has its strongest prospect of success. I shall shortly examine the degree of similarity between the items listed by the Opponent and the Applicants in their respective specifications in that Class. Before doing so, however, I note that the Opponent's protection for its trade mark extends to cover goods under Classes 9 and 16 (i.e. moving visual images or photographs featuring people engaging in simulated skydiving, as detailed above).
15. In its written submissions, the Opponent contends that since the items of clothing within the Applicant's specification – and, by way of example, the Opponent references disposable underwear and jockstraps – may feature within such visual records, then those clothing items for which the Applicant seeks protection should be considered similar to the simulated skydiving photographs and videos that are

the wares of the Opponent. The Opponent estimates such similarity between clothing and photographs and DVDs as being to an average degree.

16. I find that line of argument unconvincing. Even assuming that the clothing items in question were naturally and prominently visible within the visual record of people simulating skydiving, a photograph of, for example, ballet clothing, is no more similar to the physical item ballet clothing than Magritte's oil painting of a pipe is equivalent to a pipe as a three dimensional, functioning object. Or to put it another way, it would be wrong to allow a registration in respect of photographs or DVDs to protect just any class of goods (or for that matter services) captured in those media. For the avoidance of doubt, I find no similarity between the goods in Classes 9 and 16 and the goods of the Applicants in Class 25. Were this decision to be made only on the basis that the Opponent has registrations in Classes 9 and 16, the opposition would not succeed in respect of an application for goods in Class 25.

17. I turn now to compare the goods that the parties have specified in Class 25. As noted at paragraph 4 above, the Opponent's specification for Class 25 reads: *Clothing, namely, shirts, jackets, hats, underwear, gloves and sweatshirts*. In its submissions, the Opponent states that "*the respective parties' goods in Class 25 are to be generally described as articles of clothing or clothes, items worn to cover the body*". Although this statement is a reasonable description, it risks glossing over any narrowing effect implied by the inclusion of the word "namely" in the Opponent's specification. The classification chapter of the Trade Mark Registry's Work Manual states that specifications that include 'namely' should be interpreted as only covering the named goods; that is, the specification is limited to those goods. My comparison of the goods in question will look at the specifications as presented and will give the words their natural meaning with neither undue extension nor constraint.

18. It is convenient to compare first the closest matching goods specified. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court stated that:

“29. goods can be considered as identical when ... the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

19. The Opponent’s inclusion of “underwear” in its specification, squarely covers the following items listed in the Applicants’ specification: *“disposable underwear; jockstraps (underwear); shapewear (slimming underwear); slimming underwear; sweat-absorbent underwear; underwear; boxer shorts; briefs; bras; brassieres; foundation garments.”* I agree with the Opponent’s submission that those goods are identical.

20. I now compare the similarity of the other items listed. In approaching this task, I am mindful of the words of Floyd J. (as he then was) in *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch),) where he stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise Nevertheless the principle should not be taken too far Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

21. I also take account of the factors identified by the Court of Justice in *Canon*, Case C-39/97, where at paragraph 23 of its judgment it states that:

“In assessing the similarity of the goods all the relevant factors relating to those goods .. 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”.

22. 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.

23. I also take note that in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court 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”.

24. In its submissions, the Opponent uses many of the above factors to contend that the remaining items in the Applicants’ specification are similar “*to a high degree*” to the registered goods – namely shirts, jackets, hats, underwear, gloves and sweatshirts.

25. For example the Opponent argues that the Applicants’ “*beach shoes; dance shoes; dress shoes; flat shoes; shoes for infants*” are liable to be sold along with the Opponent’s goods in Class 25.

26. Similarly, the Opponent argues that the Applicants' "*ballet clothing; clothing for gymnastics; clothing for surfing; clothing for swimming; cycling shorts and bibs; swim briefs; bathing trunks; swimming trunks; surfing shorts; swimming costumes; swimming shorts; swimming suits; beach shoes*" are liable to be complementary to and sold alongside goods such as the Opponent's "sweatshirts" "*since such goods often form part of sportswear ensemble to allow people taking part in sports to conserve heat or be comfortable during rest periods or to move about doing other things in between sporting activities...*"
27. I think it is fair to say that the Opponent's specification of *shirts, jackets, hats, gloves and sweatshirts* are similar to "*clothing for surfing*" since although they may not be used during the actual activity of surfing, they are all items commonly found for sale in a surf shop. A surf shop, whether bricks and mortar or online, is recognised as a distinct type of retail outlet that provides clothing sought out and worn by members of the general public, whether or not those individuals engage in the sport or pastime of surfing. I therefore find a low to medium degree of similarity for those items.
28. I accept that dancers and gymnasts and others may commonly wear sweatshirts between activities and for heat conservation, and the Opponent clearly has coverage in respect of sweatshirts. However, I consider that *ballet clothing; clothing for gymnastics* are distinguishable types of specialised clothing, more likely to comprise leotards, leg warmers, skirts and the ilk.
29. On the other hand, I acknowledge that there is (admittedly at a general and high level) similarity in the nature, intended purpose and method of use of clothing items, which are essentially to be worn to cover the body. I take account of shared channels of trade: the range of clothing available in supermarkets and clothing department stores is extensive. Such is the breadth of the range of offerings that it would be quite possible buy not only the goods listed in the Opponent's specification, but also items suitable for ballet or gymnastics, such as a leotard or other close-fitting, stretchable clothing items. These items may also be located together in-store. These considerations lead me therefore to find

similarity in respect of *ballet clothing; clothing for gymnastics* and *sweatshirts* although to no more than an average degree.

30. Similar considerations apply in respect of “*clothing for swimming; cycling shorts and bibs; swim briefs; bathing trunks; swimming trunks; surfing shorts; swimming costumes; swimming shorts; swimming suits.*” For instance, a sporting goods store may sell all of those items, as well as the goods listed by the Opponent, such as *hats, gloves and sweatshirts*. I therefore find similarity in respect of “*clothing for swimming; cycling shorts and bibs; swim briefs; bathing trunks; swimming trunks; surfing shorts; swimming costumes; swimming shorts; swimming suits*”, although again certainly to no more than an average degree.

31. As for “*beach shoes; dance shoes; dress shoes; flat shoes; shoes for infants*” I recognise a stronger difference between the nature of footwear and clothing. However, the diversity of stock readily available in a wide range of retail outlets again has a bearing. It would not be uncommon, for example, to find that a shelved aisle of footwear, including all varieties enumerated above, may give onto or otherwise be found near, say hats or gloves, or other items protected by the Opponent’s registration. I therefore find similarity in respect of “*beach shoes; dance shoes; dress shoes; flat shoes; shoes for infants*”, although to a less than average degree.

32. Lastly I consider whether any of the goods specified in the Opponent’s registration conflict with the protection sought for “*sleepwear; nightclothes (sleeping garments); sleeping garments.*” When retiring to sleep, people clothe themselves differently, both in extent and type of clothing. Theoretically one may wear all or several of the items registered, and I recognise that it is conceivable the term “*shirts*” could be construed to include *nightshirts*, a standard form of sleepwear. I again consider common channels of sale, common essential nature and purpose of the goods. I particularly recognise that sleepwear and nightclothes have a marked association with underwear, with general fashion retailers tending to locate nightwear items such as chemises and camisoles alongside underwear in their stores, or to categorise them in proximity in catalogues or online. Moreover, nightwear and underwear are readily linked as the common business basis of a

more specialised, discrete variety of retail provider. I therefore find similarity in respect of “*sleepwear; nightclothes (sleeping garments); sleeping garments*”, to an above average degree.

33. The Applicants signal a measure of frustration as they claim in their counterstatement to have developed the mark since 2012 when it was used in respect of men’s underwear, achieving, it is claimed, global exposure, including in the UK. The counterstatement therefore claims earlier rights to the mark, but the Applicants make no formal counterclaim.
34. Tribunal Practice Notice 4/2009 makes clear that defences to section 5 (2) claims based on the applicant for registration having used the trade mark before an opponent registered its mark are wrong in law. “*Section 5(2) of the Act turns on whether the attacker has an earlier trade mark compared to the mark under attack, as defined by section 6 of the Act. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker’s mark.*²”
35. The Applicants’ counterstatement also identifies that the focus of the Opponent’s business is on indoor skydiving experiences in wind tunnels, and the Applicants therefore contend that the Opponent has no legitimate interest in underwear. They allege that the Opponent’s IR 1225899 has been filed to interfere with the Applicant’s legitimate business activities and that insofar as it covers clothing in Class 25, the Registration has been made in bad faith. Again, the Applicants make no formal counterclaim.
36. Of course, it is noted, that the Opponent is not required to have evidence of use in the UK of the trade mark on its specified items of clothing goods since the Opponent has a period of five years from registration to make use of its trade mark for the purposes registered. My task of comparing the goods must be made on

² See the decision of Ms Anna Carboni, sitting as the Appointed Person in *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09.

the basis of notional and fair use of the goods in the parties' respective specifications. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchin L.J. stated that:

“78.the court must.... consider a notional and fair use of that mark in relation to all of the goods or services in respect of which it is registered. Of course it may have become more distinctive as a result of the use which has been made of it. If so, that is a matter to be taken into account for, as the Court of Justice reiterated in Canon at paragraph [18], the more distinctive the earlier mark, the greater the risk of confusion. But it may not have been used at all, or it may only have been used in relation to some of the goods or services falling within the specification, and such use may have been on a small scale. In such a case the proprietor is still entitled to protection against the use of a similar sign in relation to similar goods if the use is such as to give rise to a likelihood of confusion.”

37. In *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06, the CJEU stated at paragraph 66 of its judgment that when assessing the likelihood of confusion under section 5(2) it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered. In *Oakley v OHIM* (Case T-116/06) it is made clear that consideration of likelihood of confusion is prospective and not to be restricted to the current marketing or trading patterns of the parties:

“...Since the particular circumstances in which the goods covered by the marks are marketed may vary in time, and depending on the wishes of the proprietors of the trade marks, the prospective analysis of the likelihood of confusion between two marks, ... cannot be dependent on the commercial intentions, whether carried out or not – and which are naturally subjective – of the trade mark proprietors ...”

The average consumer and the purchasing process

38. It is necessary to determine who the average consumer is for the respective goods and the manner in which they are likely to be selected. 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 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 word “average” denotes that the person is typical... [it] does not denote some form of numerical mean, mode or median.”

39. As the Opponent would be in no better a position were I to extend my analysis to its other classes, I will consider only the average consumer of the goods in Class 25. That average consumer is, in my view, a member of the general public, since the general public wear clothing and a diverse and wide cross-section of the general public may seek to purchase any of the items specified.

40. 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 General Court stated:

“43. .. the average consumer’s level of attention may vary according to the category of goods or services in question ... 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.

...

53. 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, 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.”

41. Although items of clothing, footwear and headgear will vary greatly in price, generally speaking, I would expect a normal level of attention to be paid by the consumer when selecting such goods. The purchasing act will be mainly visual as such goods are commonly purchased based on their aesthetic appeal; they are likely to be selected after perusal of racks/shelves in retail establishments, or from images on Internet websites or in catalogues. However, I do not discount aural considerations which may also play a part.

Comparison of the marks

42. The Applicants in their counterstatement deny all the claims in the Opponent’s Statement of Grounds. The Applicants argue that the respective marks iFLY and IFLY are visually, phonetically and conceptually different and, accordingly, deny that any confusion would be likely to arise between the two marks.

The respective trade marks are shown below:

| | |
|---|--|
|  |  |
| Opponent’s earlier trade mark | Applicants’ contested trade mark |

Overall impression

43. 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.

44. 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.”

45. It would therefore be wrong to artificially dissect the marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features that are not negligible and therefore contribute to the overall impressions created by the marks. It is my view that the distinctive and dominant component of both parties' marks is that they present as a single, non-standard word, containing two discernible standard words.

Visual similarity

46. Both marks consist of the same four letters, in the same order, presented as a single word. The only visual difference is that the Applicants' mark has the initial letter in lower case, so that it presents as “iFLY,” whereas the Opponent's registered mark is uniformly in uppercase, presenting as IFLY.

47. In *Groupement Des Cartes Bancaires v China Construction Bank Corporation*, case BL O/281/14, Mr Iain Purvis QC, sitting as the Appointed Person stated:

“It is well established that a ‘word mark’ protects the word itself, not simply the word presented in the particular font or capitalization which appears in the Register of Trade Marks. See for example Present-Service Ullrich GmbH & Co. KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-66/11 at [57]. A word may therefore be presented in a different way (for example a different font, capitals as opposed to small letters, or hand-writing as opposed to print) from that which appears in the Register whilst remaining ‘identical’ to the registered mark.”

48. Even if notional use of the Opponent’s registered mark does not cover the use of a lower case letter “i” followed by capitals (which would make the marks identical) I nevertheless find that the marks are visually similar to a very high degree.

Aural similarity

49. The Applicants assert that their mark would be pronounced as “eye fly” with a long “i” sound, and that in contrast the Opponent’s mark would be pronounced with a short “i” sound as in the word “if”. Whilst it is conceivable that the Opponent’s mark could, as the Applicants suggest, be pronounced as “if-lee,” or even “if-lye,” it seems to me far more probable that it would be pronounced “eye-fly” - whether or not the spoken stress fell on the first or second syllable. I find the marks of the Applicants and the Opponent to be aurally similar to the highest degree, if not identical.

Conceptual similarity

50. The Applicants claim in their counterstatement that the mark is “*intended to refer to a patented underwear concept related to the shape of the opening in the front men’s underwear.*” In light of this information from the Applicants, it may therefore be reasonable to conceive of the mark as commenting on the form or nature of the fly – perhaps contrasting with traditional ‘Y fronts.’ In other words, the formulation

could be “i” + noun (the noun here being “fly”, perhaps signifying an opening at the crotch typically covered with a flap).

51. However, despite the explanation quoted in the above paragraph, the Applicants go on to assert that their mark “*would be seen as two words conjoined, namely “I fly” (that is, the first person singular of the verb “to fly”); in contrast the Opponent’s mark would be seen as one meaningless word “ifly”*”. In any event, whatever the Applicants’ view of their mark, it is the perception of the average consumer which matters.

52. As I have said above in the aural comparison, I think it likely that both marks would be perceived as ‘I fly’, in which case they may be considered conceptually identical. However, even if the Opponent’s mark were seen as a single, meaningless word, I consider that it is still likely that the FLY part of the earlier mark will resonate with the average consumer. In *Usinor SA v OHIM*, Case T-189/05, the General Court found that:

“62. as regards the conceptual comparison, it must be noted that while the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (Lloyd Schuhfabrik Meyer, paragraph 25), he will nevertheless, perceiving a verbal sign, break it down into verbal elements which, for him, suggest a concrete meaning or which resemble words known to him (Case T-356/02 Vitakraft-Werke Wührmann v OHIM – Krafft (VITAKRAFT) [2004] ECR II-3445, paragraph 51, and Case T-256/04 Mundipharma v OHIM – Altana Pharma (RESPICUR) [2007] ECR II-0000, paragraph 57).

Distinctive character of earlier trade mark

53. The distinctive character of the earlier mark must be considered. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). 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 WindsurfingChiemsee 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 ...”

54. IFLY is not a word found in a standard English dictionary. To the extent that the word is a neologism, it has a normal level of inherent distinctiveness and in the case of the clothing in Class 25, the mark neither describes nor alludes to the relevant goods. I recognise that were the clothing sold as merchandising items associated with the skydiving experience, then an allusive message may be drawn, but my assessment is on the basis of a notional and fair use as described in paragraph 36 of this decision. Overall, I find the earlier mark to have a good level of distinctiveness. In the absence of any evidence, there is no need to consider whether there has been any enhancement of the mark through use.

Conclusion as to likelihood of confusion

55. I now turn to reach a conclusion as to the likelihood of confusion between the two marks if they were used in relation to the goods specified. In making this global assessment of likelihood of confusion I take stock of my findings set out in the foregoing sections of this decision as to: the relevant average consumer; the nature of the purchasing process; the degree inherent distinctiveness of the earlier mark; the similarity between the conflicting marks and between the specified goods.

56. I also hold in mind the so-called interdependency principle – which is to say that a lesser degree of similarity between the respective goods may be offset by a greater degree of similarity between the respective marks (and vice versa). (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*).

57. In comparing the marks I have found that they are visually, aurally and conceptually similar to a very high degree, approaching identity. I have found that the relevant average consumer for clothing is a member of the general public, who would pay a normal level of attention by the consumer when selecting the goods in Class 25.

58. In *Quelle AG v OHIM*, Case T-88/05, the General Court found that visual similarity (and difference) is most important in the case of case of goods that are self-selected or where the consumer sees the mark when purchasing the goods. The Court stated that:

“69. ... the degree of phonetic similarity between two marks is of less importance in the case of goods which are marketed in such a way that, when making a purchase, the relevant public usually perceives visually the mark designating those goods (BASS, paragraph 56 supra, paragraph 55, and Case T-301/03 Canali Ireland v OHIM – Canal Jean (CANAL JEAN CO. NEW YORK) [2005] ECR II-2479, paragraph 55). Moreover, while oral communication in respect of the product and the trade mark is not excluded, the choice of an item of clothing or a pair of shoes 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 (NLSPORT, NLJEANS, NLACTIVE and NLCollection, paragraph 53 supra, paragraph 50). The same is true of catalogue selling, which involves as much as does shop selling a visual assessment of the item purchased by the consumer, whether clothing or shoes, and does not generally allow him to obtain the help of a sales assistant...”

59. I have considered the notional nature of the purchasing process and the fact that the average consumer of the goods in question rarely has the chance to compare

marks side by side and must instead rely on an imperfect mental picture of them (as per *Lloyd Schuhfabrik* case). It is my view that the distinctive and dominant component of the mark is its presentation of a single, non-standard word and that the average consumer may easily overlook the different case usage in the presentation of the initial letter of the word as it appears on clothing.

60. As to the comparison of goods I have found no similarity between the Applicants' goods in Class 25 and the Opponent's registered goods in Classes 9 and 16. However, as to the clothing items in Class 25 I have found that some of the goods are identical, while all other goods are similar to varying degrees.

61. I have also found that the earlier mark enjoys a good level of inherent distinctiveness in relation to clothing. Weighing in the balance all of the above factors, including the interdependency principle, it is my conclusion that an average consumer, paying a normal degree of attention, is likely to believe that the goods emanate from the same or linked undertaking(s). There is a likelihood of confusion.

The opposition succeeds in full.

Costs

62. The Opponent has been successful and is entitled to a contribution towards its costs, which I assess based on the guidance in Tribunal Practice Notice 4/2007. In the circumstances I award the Opponent the sum of £600 (six hundred pounds) as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Reimbursement of the official fee for Notice of Opposition and Statement of Grounds:

£100 (one hundred pounds)

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

£200 (two hundred pounds)

Preparation of written submissions in lieu of oral hearing:
£300 (three hundred pounds)

63. I therefore order Lisa Nauh and BNB Group Australia PTY Ltd to pay Skyventure International (UK) Ltd the sum of £600 (six hundred pounds) 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 14TH day of February 2017

A handwritten signature in black ink, appearing to be 'M Williams', written in a cursive style.

Matthew Williams

**For the Registrar,
the Comptroller-General**