

**O-125-17**

**TRADE MARKS ACT 1994  
IN THE MATTER OF  
APPLICATION NO 3127362  
BY ROMAXX LIMITED  
TO REGISTER**

**Romaxx**

**AS A TRADE MARK IN CLASSES 25 & 35  
AND  
OPPOSITION THERETO (UNDER NO. 405801)  
BY  
ROMAN ORIGINALS PLC**

## BACKGROUND

1) On 16 September 2015, Romaxx Limited ('the applicant') applied to register the trade mark shown on the cover page of this decision in respect of the following goods and services:

Class 25: Clothing, footwear, headgear.

Class 35: Advertising; business management in the field of clothing, footwear, headgear and sports clothing and equipment; business administration; office functions; retail services connected with the sale of clothing, footwear, headgear and sports clothing and equipment. (my emphasis)

2) The application was published on 09 October 2015 in the Trade Marks Journal and notice of opposition was subsequently filed by Roman Originals Plc ('the opponent').

3) The opponent claims that the application offends under Section 5(2)(b) of the Trade Marks Act 1994 ('the Act'). It directs its opposition only to the underlined terms shown in paragraph 1 above. It relies upon two trade mark registrations. Both are for the mark **ROMAN/Roman** and cover identical goods in classes 18 and 25. Both registrations are also subject to proof of use as per Section 6A of the Act. It therefore suffices to use only one of the registrations as the basis for my decision, as the opponent's prospect of success is the same for both. The details of the relevant mark, including the goods relied upon, are as follows:

**TM No: 2405262**

**ROMAN**

**Roman**

(Series of 2)

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

**Class 18: Bags, shoulder bags, handbags, purses.**

**Filing date: 31 October 2005**

**Date of entry in the register: 04 August 2006**

4) The applicant filed a counterstatement in which it denies, with supporting explanation, the grounds of opposition and puts the opponent to proof of use.

5) Both parties filed evidence. Neither party requested to be heard, preferring to file written submissions in lieu. I now make this decision on the basis of the papers before me.

### **Evidence**

6) The opponent's evidence in chief consists of a witness statement in the name of Rick Christodoulou, Managing Director of Roman Originals Plc, with accompanying exhibits. I do not consider it necessary to summarise the evidence here. It is directed to proving use of the opponent's earlier mark and its enhanced distinctiveness through use. In the interests of procedural economy, I shall assume that the opponent has established both genuine use of its earlier mark and a high degree of distinctiveness acquired through use in relation to all of the goods it relies upon.

7) The applicant's evidence consists of a witness statement in the name of Muhammad Naeem Akram of Romaxx Limited with five exhibits thereto and the opponent's evidence in reply of a second witness statement from Rick Christodoulou with a single exhibit. I will also not summarise any of this evidence here but will refer to it in the following decision if, and when, it is necessary and relevant to do so.

### **DECISION**

8) Section 5(2)(b) of the Act states:

“5. (2) A trade mark shall not be registered if because –  
(a) .....

(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.”

9) The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *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 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 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 and services**

10) The contested goods in class 25 are self-evidently identical to the opponent's goods in class 25. Owing to the findings in this decision, and for reasons of procedural economy, I will also proceed on the assumption that all of the contested services in class 35 are highly similar to the opponent's goods.

## **Average consumer and the purchasing process**

11) It is necessary to determine who the average consumer is for the respective goods and services 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 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.”

12) 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 ('GC') 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.

...

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, 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.”

As stated by the GC, items of clothing will vary greatly in price. The same applies to footwear and headgear. 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 on account of the goods being commonly purchased based on their aesthetic appeal; they are likely to be selected after perusal of racks/shelves in retail establishments, or from photographs on Internet websites or in catalogues. However, I do not discount aural considerations which may also play a part. Insofar as the contested services are concerned, again, I would expect these to be sought out mainly by eye, although I bear in mind the potential for aural use of the mark in the course of oral recommendations or discussions with sales representatives, for example. The services are also likely to vary in price but, generally speaking, I would expect a normal level of attention to be paid during the purchase.

### **Comparison of marks**

13) 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 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.”

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 which are not negligible and therefore contribute to the overall impressions created by the marks.

14) The opponent’s earlier registration is for a series of 2 marks which are materially the same. Accordingly, it does not matter which of the marks I use as the basis for the comparison. The marks to be compared are:

**Roman**

v

Romaxx

15) Neither mark is readily divisible into separate components; their overall impressions are based solely on the single word of which they consist.

16) From a visual standpoint, the marks share the same four letters at the beginning creating a clear point of visual similarity. However, there is also a point of difference given that the fifth letter in the opponent’s mark is ‘N’ and the fifth and sixth letters in the applicant’s mark are ‘XX’. I note the opponent’s submission that it is usually the beginnings of words that will tend to have the greater impact on the perception. However, it should be noted that this is a general rule of thumb rather than an immutable rule; each case must still be assessed on its own merits. The difference in



the endings of the marks in the instant case is quite striking. Overall, there is a medium degree of visual similarity.

17) In terms of aural similarity, the opponent's mark will be vocalised as ROW-MAN and the applicant's mark as ROW-MAX. Both marks consist of two syllables, the first of which is identical and the second of which is similar given the common 'MA' aspect. I note the opponent's submission to the effect that the letters at the end of the marks are "likely to be slurred in speech and/or may go unnoticed by the average consumer". However, in my view, the respective 'XX' and 'N' consonants create quite distinct sounds that are unlikely to be slurred or go unnoticed. Overall, there is a medium degree of aural similarity.

18) Insofar as concept is concerned, the opponent's mark will be perceived as the well-known reference to an individual from Rome or, more generally, of something associated with Rome. The applicant's mark, on the other hand, is likely to be perceived as an invented word with no meaning. The opponent concedes that the marks are "conceptually distinct".<sup>1</sup>

### **Likelihood of confusion**

19) I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the goods and services may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

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<sup>1</sup> Paragraph 3.17. of the opponent's submissions dated 9 January 2017 refers.

20) I make my assessment on the basis that the contested goods are identical to the opponent's goods and the contested services are highly similar to those goods. I am also assuming a high degree of distinctiveness for the earlier mark in respect of all of the goods relied upon. These are all important factors weighing in the opponent's favour. I have also found that the degree of attention paid by the consumer during the purchase is likely to be of a normal level and that the goods and services are likely to be selected primarily by eye. As the opponent points out, this means that the degree of visual similarity is of particular importance. However, it does not mean that factor is, of itself, determinative. As the opponent has also conceded, the marks are conceptually distinct. I bear in mind that conceptual differences do not always counteract visual and aural similarities<sup>2</sup> and for there to be such a counteraction at least one of the marks must have, from the point of view of the relevant public, a clear and specific meaning which is capable of being grasping it immediately.<sup>3</sup> To my mind, the said counteraction exists in the instant case. The opponent's mark is likely to create a strong and immediate conceptual hook in the consumer's mind which is likely to militate against imperfect recollection and the applicant's mark shares no such concept or similar concept. I consider this factor to outweigh the medium degree of visual and aural similarity that exists between the marks. Taking into account all factors, I find that there is no likelihood of direct or indirect confusion even in relation to the identical goods at issue. I should add that I would have reached the same conclusion even if I had found a high degree of visual and aural similarity as contended by the opponent. **The opposition fails.**

## **COSTS**

21) As the applicant has been successful, it is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice 4/2007 (which was in force at the time of commencement of these proceedings). As the applicant is a litigant in person, it has submitted a costs pro-forma detailing the number of hours it has spent on various aspects of the proceedings. The minimum level of compensation for litigants in person in *The Litigants in Person* (Costs and

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<sup>2</sup> See the judgment of the General Court in *Nokia Oyj v OHIM*, Case T 460/07 at paragraph 66.

<sup>3</sup> See the judgment of the CJEU in *Mühlhens GmbH & Co KG v OHIM*, Case C-206/04P at paragraph 11, noting the judgment of the Court of First Instance at paragraph 49. See also Case T-292/01 *Phillips-Van Heusen v OHIM – Pash Textilvertrieb und Einzelhandel* (BASS) at paragraph 54.

Expenses) Act 1975 is £18 per hour. I will consider the applicant's claims in relation to each stage of the proceedings, in turn, as follows:

Considering the notice of opposition and preparing the counterstatement

The applicant states that it spent 6 hours and 30 minutes on the latter activity and 4 hours on the former, making a total of 10 hours 30 minutes. On the basis of £18 per hour, this would amount to £189 which is only just shy of the minimum amount of £200 stipulated in TPN 4/2007 to be awarded to a party with legal representation. As the applicant has not incurred the costs of legal representation, I do not consider it appropriate to award the applicant £189. Rather, I will make an award on the basis of 5 hours for the latter activity and 2 hours on the former i.e. a total of 7 hours. Accordingly,  $7 \times £18 = £126$ .

Preparing evidence and considering the other side's evidence

The applicant states that it spent 7 hours preparing its evidence and 5 hours 30 minutes considering the opponent's evidence. I consider the latter claim to be a reasonable one but not the former. The applicant's evidence went to matters that have not assisted me. Accordingly,  $5 \frac{1}{2} \times £18 = £99$ .

Written Submissions

The applicant states that it spent 8 hours 45 minutes on this activity. The applicant's submissions are comprehensive. However, a significant part of the submissions were of no assistance to me. I consider an award on the basis of 4 hours to be appropriate. Accordingly,  $4 \times £18 = £72$ .

**Total: £297**

22) I order Roman Originals Plc to pay Romaxx Limited the sum of **£297**. 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 20th day of March 2017**

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