

O-441-17

**TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO 3160612
BY ZIAULLAH RAHIM ANSARI
TO REGISTER**

Wellness SoxTM
for healthier feet 

**AS A TRADE MARK
IN CLASS 25
AND OPPOSITION THERETO (UNDER NO. 407674)
BY
CSP PARIS FASHION GROUP**

BACKGROUND & PLEADINGS

1. Mr Ziaullah Rahim Ansari ('the applicant') applied to register the trade mark outlined above on the title page on 21 April 2016. It was accepted and published in the Trade Mark Journal on 15 July 2016 in respect of **socks, stockings, tights**.

2. CSP Paris Fashion Group ('the opponent') opposed the trade mark under Section 5(2)(b) of the Trade Marks Act 1994 ('the Act') against all of the goods in the application on the basis of its earlier European Union Trade Mark set out below:

EUTM No. 527630	Goods relied on
<p>WELL</p> <p>Filing date: 1 May 1997</p> <p>Seniority date: 10 December 1991</p> <p>Registration date 17 February 1999</p>	<p>Class 25: clothing; footwear; headgear; lingerie; hosiery.</p>

3. The applicant filed a counterstatement in which it denied the grounds of opposition under section 5(2)(b) and requested that the opponent produce evidence to demonstrate proof of use.

4. The opponent's trade mark is an earlier mark, in accordance with Section 6 of the Act. As it completed its registration procedure more than 5 years prior to the publication date of the applicant's mark, it is subject to the proof of use conditions, as per section 6A of the Act. The opponent made a statement of use in respect of all the goods it relies on.

5. In these proceedings the applicant has represented himself and the opponent has been professionally represented by Stevens Hewlett & Perkins.

6. Only the opponent filed evidence. Neither party made written submissions and neither requested to be heard. I now make this decision based on the papers before me.

OPPONENT'S EVIDENCE

7. The opponent submitted a witness statement from Thierry Simon, the General Manager of the opponent, and appended four exhibits. These are summarised below.

8. Exhibit CSP1 comprises copies of the opponent's catalogues dated between 2012 and 2016. There are spring/summer and autumn/winter product catalogues for each year. The goods featured are bras, knickers, tights, knee high stockings and leggings. The catalogue details are in French but English translations have been given where appropriate. The opponent's mark appears in the following form in the catalogues supplied.



9. Exhibit CSP2 comprises copies of invoices to customers in Belgium, France and Luxembourg dated between 2012 and 2016 for hosiery products. The opponent's mark, as outlined above, appears on all the invoices. The first two invoices are blank but the remainder show orders and customer details. The details are in French but English translations have been given where appropriate.

10. Exhibit CSP3 comprises material from a specific price reduction promotional campaign run by the opponent in France during 2016. The materials, which show the mark outlined above, consist of promotional packaging and other graphics detailing the price reduction campaign.

11. Exhibit CSP4 comprises screenshots of the opponent's website as it appeared in November 2014 provided from the Wayback Machine internet archive. The Wayback Machine details in the bottom left corner of the exhibit states that the opponent's website was captured 32 times between October 2012 and December 2015.

12. In addition to the exhibits, the declarant also states that the opponent's turnover for the years 2011-2016 was as follows:

2011	€49,622,562
2012	€50,704,363
2013	€52,131,350
2014	€51,355,121
2015	€51,672,997
2016	€53,926,987

13. The declarant also states that the date of first use was 1972, that the opponent's advertising expenditure is €1.5m per annum and that their mark is used in France, Belgium and Luxembourg.

PROOF OF USE

14. The first issue is whether, or to what extent, the opponent has shown genuine use of the earlier mark. The relevant statutory provisions are as follows:

"Raising of relative grounds in opposition proceedings in case of non-use

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”.

15. Section 100 of the Act is also relevant, which reads:

“100. 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”.

16. 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 said:

“217. In *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch); [2013] F.S.R. 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *Pasticceria e Confetteria Sant Ambroeus Srl v G&D Restaurant Associates Ltd (SANT AMBROEUS Trade Mark)* [2010] R.P.C. 28 at [42] of the jurisprudence of the CJEU in *Ansul BV v Ajax Brandbeveiliging BV* (C-40/01) [EU:C:2003:145]; [2003] E.T.M.R. 85, *La Mer Technology Inc v Laboratories Goemar SA* (C-259/02) [EU:C:2004:50]; [2004] E.T.M.R. 47 and *Silberquelle GmbH v Maselli-Strickmode GmbH* (C495/07)[EU:C:2009:10]; [2009] E.T.M.R.28 (to which I added references to *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-416/04 P) [EU:C:2006:310]). I also referred at [52] to the judgment of the CJEU in *Leno Merken BV v Hagelkruis Beheer BV* (C149/11) EU:C:2012:816; [2013] E.T.M.R. 16 on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-141/13 P) EU:C:2014:2089 and that Order has been persuasively analysed by Professor Ruth Annand sitting as the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd* (O/528/15) [2016] E.T.M.R. 8.

218. [...]

219. 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 *Bundervsvereinigung 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]”.

17. As the opponent’s trade mark is an EU Trade Mark, the comments of the Court of Justice of the European Union (“CJEU”) in *Leno Merken BV v Hagelkruis Beheer BV*, Case C149/11, 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)”.

18. 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”.

19. In *London Taxi*, 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".

20. The General Court 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 what was then known as a Community trade mark (now a European Union trade mark). Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory

of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the Union.

21. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods at issue in the Union during the relevant 5 year period. In making the required 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
- iv) The geographical extent of the use shown.

FORM OF THE MARK

22. As noted above, the mark which has been used is that set out in paragraph 8 above, as opposed to the plain word mark that has been registered. However s.6A(4)(a) enables an opponent to rely on use of a mark “in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered. In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was) as the Appointed Person summarised the test under s. 46(2) of the Act (which is analogous to s. 6A(4)(a)) as follows:

“33. [...] The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter’s distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade

mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all”.

23. The evidence shows that the mark has been used in the following form:



24. In terms of the registered trade mark's distinctive character, it consists of the word WELL in plain block capitals. This is the only thing that contributes to the distinctive character. In terms of the differences, the mark as used is in title case and is in a particular font as opposed to the plain word WELL as registered. It is also presented on a contrasting black background border. I do not consider that the use of the word in white on a dark background has any material effect on the distinctive character of the trade mark, the effect being merely that the dark background provides a contrast against which the word may be read. Further, the particular stylisation is unremarkable and again I do not consider that the distinctive character of the mark is altered. The difference in casing is similarly an insignificant adaptation and, in any event, the mark as registered may notionally be used in either upper, lower or title case. Overall I find that the use shown is use of the mark in a form which does not alter the distinctive character of the mark as registered, upon which the opponent is entitled to rely.

SUFFICIENCY OF USE

25. Firstly there is no evidence of use in the UK, however, it is clear from the case law that this is not a pre-requisite. Figures of between €49m and €52m are given as annual turnover for sales in France, Belgium and Luxembourg for the relevant 5 year period prior to the publication of the later mark, i.e. 15 July 2011 to 15 July 2016. The invoices confirm dates and sales to customers in those countries. There is also

evidence of advertising by way of product catalogues as well as expenditure in the French promotional campaign outlined in exhibit CSP3. Overall I am satisfied that there has been genuine use of the mark I set out in paragraph 8 in the EU.

FAIR SPECIFICATION

26. The next stage is to decide whether the opponent's use entitles it to rely on all of the goods for which it is registered. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

27. The evidence demonstrates that the opponent has used its mark on a range of bras, knickers, tights, knee high stockings and leggings. Therefore I feel that the opponent may rely on 'lingerie' and 'hosiery' in their specification.

SECTION 5(2)(B)

28. Section 5(2)(b) of the Act is as follows:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

29. 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

30. As per my previous finding regarding the proof of use evidence, the opponent is entitled to rely on 'lingerie' and 'hosiery' in their specification. The term 'hosiery' in the opponent's specification exactly covers 'socks, stockings, tights' in the applicant's specification. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court ('GC') stated that:

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

where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

31. On this basis I consider the contested goods to be identical goods. I will focus on these clearly identical goods for the time being and come back to anything else if it is necessary to do so.

AVERAGE CONSUMER AND THE PURCHASING ACT

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

33. 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.”

34. The average consumer for the contested goods are members of the general public. The goods can be sold in general retailers such clothing stores and supermarkets as well as online or through mail order retailing. The act of purchasing hosiery will be a primarily visual process and will include factors such as aesthetics, opacity and fit. Hosiery items are not generally an expensive purchase so overall I

conclude that an average consumer will pay a normal level of attention during the purchasing process.

COMPARISON OF THE MARKS

35. The marks to be compared are:

Opponent's mark	Applicant's mark
WELL	 The logo for 'Wellness Sox' features the words 'Wellness Sox' in a bold, sans-serif font, with a trademark symbol (TM) to the upper right of 'Sox'. Below this, the phrase 'for healthier feet' is written in a smaller, lowercase sans-serif font. To the right of the text is a stylized graphic of a foot, represented by a thick, black, wavy line that curves upwards and then downwards, suggesting the shape of a foot or a sock.

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

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

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

38. The opponent's trade mark consists of a single word **WELL** in plain block capital letters. The overall impression of the mark and its distinctiveness rests solely on that word.

39. The applicant's mark is a composite comprising the words **Wellness Sox** placed above the words **for healthier feet** and a wave-like device. The words **for healthier feet** will be seen as descriptive slogan given the nature of the contested goods and, together with the fact that it is subordinate in position and size, carries little weight in the overall impression of the mark (although it is not wholly negligible). In terms of the remaining two elements, **Wellness Sox** and the device, it is a general rule of thumb that words speak louder than devices. I consider that rule to be applicable here. The wave device plays a subordinate role and although both of those elements are distinctive and have a visual impact, it is the **Wellness Sox** element which is more dominant and by which the mark is likely to be referred to and which carries the greater weight in the overall impression of the mark.

40. In a visual comparison of the marks, the point of similarity is the word **well**. It forms the entirety of the opponent's mark and the first four letters of the applicant's more dominant word element. However, the dominant word element of the applicant's mark is longer than the opponent's mark given that it consists of two words, with the -ness suffix added to the first word to form **Wellness**, together with the additional word **Sox**. There are no other visual elements to the opponent's mark whereas the applicant's mark has the wave device placed below the words **Wellness Sox** as well as the additional descriptive words **for healthier feet**. Overall I find there to be a low degree of visual similarity.

41. In an aural comparison of the marks, the word **well** in both marks will be pronounced in the same way, although the **well** element is only the first part of the applicant's mark and the consumer will go on to vocalise the whole word **wellness**. The word **Sox** is a phonetic equivalent of the descriptive noun 'socks' so will be accorded the usual pronunciation for that word. It is unlikely that a consumer would vocalise the device element. Furthermore I also consider it unlikely that the consumer will vocalise the **for healthier feet** part of the applicant's mark. It is more

likely that only **Wellness Sox** will be pronounced. I consider there would be a low degree of aural similarity.

42. With regard to conceptual similarity, the opponent states that the signs are

“visually, aurally and conceptually similar due to the presence in the mark the subject of the application of the identical element “WELL” and the fact that “WELLNESS” is a derivative of “WELL”. “

43. One of the definitions of the word ‘well’ from the Oxford English Dictionary specifies good health or a healthy appearance (i.e. looking well) whilst the word ‘wellness’ is specifically defined as being in a state of good health. The word WELL, does have a number of other meanings of course. However, in relation to the goods at issue here, which can have an impact on health or appearance, the average consumer is most likely to form a conceptual hook based on some, albeit vague, reference to health or a healthy appearance. Thus, there is some similarity to the applicant’s mark even though that has a clearer and more direct concept based upon socks (sox) which will bring some form of wellness to the wearer. Overall I find there is a medium degree of conceptual similarity.

DISTINCTIVE CHARACTER OF THE EARLIER MARK

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

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

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

45. Distinctiveness can be enhanced through use of the mark. Although the opponent has not made a specific claim of enhanced distinctiveness, it has filed evidence of use. For the purposes of this assessment, the relevant market to which I must have regard is the UK market¹. There is no evidence of sales to the UK. Any evidence of promotional activity is confined to Europe. On the basis of the evidence filed, I am unable to determine that the earlier mark has an enhanced distinctive character in relation to the goods at issue.

46. In view of the above, I have only the inherent position to consider. The earlier mark consists of an ordinary dictionary word which although is not descriptive of the goods does allude to the qualitative characteristics of goods which could enhance health or appearance. Overall I consider that the earlier mark has a low degree of inherent distinctiveness.

LIKELIHOOD OF CONFUSION

47. I must now draw together my earlier findings into the global assessment of the likelihood of confusion.

¹ On the irrelevance of a reputation in continental Europe when assessing enhanced distinctiveness for the purposes of Section 5(2), see the comments of Iain Purvis QC, sitting as the Appointed Person, in *China Construction Bank Corporation v Groupement des cartes bancaires* (BL O/281/14) at [30]-[34].

48. So far I have found that the goods at issue in class 25 are identical and that the average consumer is a member of the general public who will select the goods by primarily visual means whilst paying a normal degree of attention during the purchasing process. I also found that the overall impression and distinctiveness of the opponent's mark lies in the single word **WELL**, whereas the overall impression and distinctiveness of the applicant's mark lies in the combination of the words and device, with the words **WELLNESS SOX**, carrying the greater weight. In addition, I have found that the opponent's mark is of lower than average distinctiveness. With regard to the comparison of the marks, I have found that the marks are visually and aurally similar to a low degree and conceptually similar to a medium degree.

49. Although I have found that there is a conceptual similarity to a medium degree, it is in relation to a concept which is not greatly distinctive. Further, the marks at issue only have a low degree of visual and aural similarity. The lowest point of similarity is in the visual impact. This is important as I found that these are goods which are purchased visually. The applicant's word elements as a whole, **Wellness Sox for healthier feet**, is likely to provide a much more specific concept of goods which will benefit the health of your feet rather than 'well' as a more general concept of good health.

50. Therefore I do not consider there to be a likelihood of direct confusion between the applicant's mark and the opponent's mark, on the part of an average consumer paying a normal level of attention. The differences are sufficient to avoid this. Nor do I consider that the average consumer will be indirectly confused and put the commonality of the word/prefix **WELL** down to the respective undertakings being the same or related. Instead, the average consumer will consider the commonality to be an unsurprising co-incidence of unrelated undertakings happening upon different marks which give the same conceptual allusion to a characteristic of the goods.

CONCLUSION

51. The opposition fails under section 5(2)(b) of the Act. Given this, there is no need to consider the other goods of the application for which the opposition will also fail.

COSTS

52. The applicant has been successful and is therefore, in principle, entitled to a contribution towards its costs. As the applicant is unrepresented, at the conclusion of the evidence rounds the tribunal invited him to indicate whether he wished to make a request for an award of costs, and if so, to complete a pro-forma including a breakdown of his actual costs, including providing accurate estimates of the number of hours spent on a range of given activities relating to the defence of the opposition; it was made clear to the applicant that if the pro-forma was not completed “no costs will be awarded”. The applicant did not respond to that invitation. Consequently, I make no order as to costs.

Dated this 19th day of September 2017

June Ralph

For the Registrar,

For the Comptroller General