

O-663-17

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION 01317529
BY LTD “BTC HOLDING”
FOR PROTECTION OF THE FOLLOWING TRADE MARK IN CLASSES 18 & 25:**



AND

**OPPOSITION THERETO (NO. 408236) BY
PUMA SE**

Background and pleadings

1. Ltd “BTC holding” (“the applicant”) designated the above International Registration (“IR”) for protection in the UK on 23 June 2016. It was accepted and published in the Trade Marks Journal on 25 November 2016 in respect of the following goods:

Class 18 *Leather and imitations of leather; pocket wallets; business card cases; briefcases for documents; purses; haversacks; leather straps; imitation leather straps; net bags for shopping; rucksacks; travelling bags; bags for climbers; travelling sets [leatherware]; sling bags for carrying infants; garment bags for travel; handbags; tool bags, empty; wheeled bags; beach bags; bags for sports; bags for campers; shopping bags; school satchels; trunks; key cases of leather; suitcases; leather cases; imitation leather cases.*

Class 25 *Clothing, footwear, headgear.*

2. PUMA SE (“the opponent”) oppose the trade mark under Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). This is on the basis of its earlier European Union (formerly Community) Trade Mark 012579711, which was filed on 6 February 2014 and which completed its registration procedure on 30 June 2014:



The following goods are relied upon in this opposition:

Class 18 *Leather and imitations of leather, and goods made of these materials, namely briefcases, bags, bags for clothing, holdalls, weekend bags, multipurpose bags, all-purpose athletic bags, all-purpose sports bags, work bags, attaché cases, shopping bags, two-wheeled shopping bags, souvenir bags, bags (envelopes, pouches), for packaging, tote bags, handbags, small clutch purses, sling bags, Gladstone bags, ladies' handbags, gentlemen's handbags, bags for men, hip bags, evening*

handbags, evening bags, beach bags, bags for sports, courier bags, changing bags, tool bags, bags for campers, belt bags and hip bags, pouches, gym bags, shoe bags, satchels, school book bags, school bags, shoulder belts and straps, shoulder bags, haversacks, camping bags, boston bags, casual bags, sling bags for carrying infants, diplomatic bags, document cases, folders, document wallets, boxes, luggage, travel luggage, trunks for travel purposes, baggage, flight bags, trunks and travelling bags, travel bags, flight bags, wheeled shopping bags, travelling handbags, vanity cases, not fitted, garment carriers, suit carriers, travel garment covers, duffel bags, rucksacks, bags for climbers, bags for campers, nappy bags; Bags and pouches, included in class 18, and small goods of leather, namely luggage tags, Luggage label holders, Bags for men, Baggage, Coin purses, Coin purses, Pocket wallets, Wallets, Coin purses, Card holders, Card holders, Briefcases, Credit-card holders, Credit-card holders, Credit-card holders, Business card cases, Driving licence cases, Key bags, Key bags, Fanny packs, Clutch bags, Small pouches, Toiletry bags, Cosmetic purses, Cosmetic purses, Make-up bags, Cosmetic purses, Cosmetic purses, Cosmetic purses, Tie cases, Laces; Wallets, pocket wallets, key cases, handbags, briefcases, shopping bags, satchels, carrier bags, travelling bags, sports bags, included in class 18, duffel bags, rucksacks, school bags, belt bags, toiletry bags, trunks and travelling bags; Umbrellas, parasols and walking stick.

Class 25 *Apparel, footwear, headgear.*

Class 28 *Games and playthings, gymnastic and sporting equipment, gymnastic and sporting articles (included in class 28); Skiing and tennis equipment; Skis, ski bindings, ski poles, edges for skis, climbing skins for skis; Balls, including balls for sports and balls for games, golf balls, tennis balls; Dumb-bells, shot puts, Discus, javelins, clubs for gymnastics, Sport hoops; Shin pads, Knee, elbow and ankle guards for sports purposes; Sports gloves, included in class 28; Tennis rackets, cricket bats, golf clubs, hockey sticks; Table tennis rackets, badminton rackets and*

squash rackets and parts therefor, in particular grips, strings, grip and lead tape; Bags for sports equipment, specially designed for the objects to be carried therein; Specially adapted bags and sleeves for tennis rackets, table tennis rackets, badminton rackets, squash rackets, cricket bats, golf clubs and hockey sticks; Roller skates and ice skates, inline skates, table tennis tables and nets; Nets for sports, goal and ball nets; Start and finish banners, tapes and awnings for sports events, sight screens for tennis courts, umpires' stools for tennis events.

3. Given its filing date, the opponent's mark EUTM 01257911 constitutes an earlier mark in accordance with Section 6 of the Act. Furthermore, given that the earlier mark completed its registration procedure less than five years before the publication of the IR, it is not subject to the requirement to show genuine use (see section 6A of the Act).

4. In its statement of case, the opponent argues that the respective goods are identical or similar. The opponent further argues that the dominant element of the application is visually and conceptually identical to, or in the alternative "confusingly similar" with, the entirety of their earlier mark, with it following that there is a likelihood of confusion. Furthermore, the opponent argues that the average consumer, who is the purchaser of the goods covered by the application, would believe that the products bearing the IR would be produced by the opponent, or with their consent.

5. The applicant filed a counterstatement wholly denying the claims made, and stating that there does not exist a likelihood of confusion.

6. In these proceedings, the opponent is represented by Urquhart-Dykes & Lord LLP, whilst the applicant is represented by Stevens Hewlett & Perkins.

7. Neither side filed evidence or written submissions. No hearing was requested and so this decision is taken following a careful perusal of the papers.

Section 5(2)(b)

8. Sections 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”.

9. The principles of a likelihood of confusion are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

(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 goods

10. Even if some of the goods are not worded identically, they can still be considered identical if one term falls within the ambit of another (or vice versa), as per the judgment in *Gérard Meric v OHIM*, Case T-133/05.

11. The applicant's *leather and imitations of leather* in Class 18 are identical to the opponent's *leather and imitations of leather* in Class 18. The applicant's *pocket wallets, business card cases, briefcases for documents, purses, haversacks, rucksacks* and *trunks* are also all identically found in the opponent's Class 18

specification. The applicant's *net bags for shopping; travelling bags; bags for climbers; sling bags for carrying infants; garment bags for travel; handbags; tool bags, empty; wheeled bags; beach bags; bags for sports; bags for campers and shopping bags* are included in the broad category of the opponent's *bags* in Class 18. The applicant's *school satchels* and *key cases of leather* are included in the broad categories of the opponent's *satchels* and *key cases* respectively, whilst the applicant's *suitcases, trunks* and *travelling sets [leatherware]* are included in the opponent's broader category of *travel luggage*. The applicant's *leather/imitation leather cases* are identical to the various cases covered by the opponent's specification. Finally, the applicant's *leather straps; imitation leather straps* are identical to the straps covered by the opponent's mark. The applicant's Class 18 goods are all, therefore, identical to those goods registered in the opponent's Class 18 specification.

12. The applicant's *clothing, footwear, headgear* in Class 25 are identical to the *apparel, footwear, headgear* in Class 25 of the opponent's specification.

Average consumer and the purchasing act

13. 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*.

14. 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.”

15. In regards to the average consumer for the applied for goods, I consider such a person to be a member of the general public. Whilst goods in Classes 18 and 25 vary widely in terms of quality and price, and the consumer is more attentive to the choice of mark where he or she buys a particularly expensive item, such an approach cannot be presumed with regard to all the goods concerned, which includes goods of a more modest price. In most scenarios the average consumer will, though, still consider issues such a colour, style, size, fitness for purpose etc. Generally speaking, the goods will be selected with an average level of care and consideration.

16. Considering the nature of the goods applied for, the average consumer is accustomed to purchasing them through self-serve channels, such as brochures, websites and shop shelves. Therefore, it is the visual impact of the marks which is likely to take on the most significance in the comparison of signs (see, for example, the judgment in *Quelle AG v OHIM*, Case T-88/05). The aural impacts of marks should not, though, be ignored completely.

Comparison of marks



17. 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.”

18. 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.

19. The respective trade marks are shown below:

	
Earlier trade mark	Contested trade mark

20. The earlier trade mark consists exclusively of a blacked out, or silhouette, “big cat” leaping from right to left. The “big cat” or *Panthera* genus, would appear to be a puma (although I accept that the average consumer may not be aware of the precise species). As this is the only component of the earlier mark, it is the only thing that contributes to its overall impression. The contested trade mark also contains a “big cat” leaping, this time from left to right. It is not blacked out, and contains stripes, which informs that it is a tiger. This impression is reinforced by the wording below in plain font: URBAN TIGER. The figurative tiger and the words URBAN TIGER have roughly equal weight in the overall impression of the mark due to the size and shared central positioning.

21. Visually, the fact that both marks contain a leaping animal from the *Panthera* genus indicates some level of similarity, with both animals having a stretched out overall outline shape. However, one is in silhouette, whilst the other has stripes (including an unusual facial pattern). In addition, the outline shapes, whilst being similar, are not exactly the same. Also, the tiger’s tail in the contested trade mark is in a different,

flatter position than its “big cat” counterpart in the earlier trade mark, whose tail is more erect. Further, the contested trade mark contains the words URBAN TIGER, which have no counterpart in the earlier trade mark. Having regard to the similarities and differences, together with my assessment of the overall impression of the respective marks, I consider there to be only a low level of visual similarity.

22. Aurally, only the contested trade mark has an element that will be read and spoken: URBAN TIGER. There is no verbal counterpart in the earlier mark. Even if the average consumer were to verbalise the image in the earlier trade mark, they would not pronounce it as TIGER (or anything like it) as whilst (as I explain below) it will be perceived as a big cat, the average consumer will not necessarily know which one, although the fact that there are no stripes indicates that it is not a tiger. I consider there to be no aural similarity.

23. Conceptually, the marks are similar in so far as they each feature an animal from the *Panthera* genus, in a leaping pose. However, both are different species within the genus given that one is clearly a tiger whilst the other is less easily definable. The animal in the earlier mark may be a puma, but the average consumer may not know this, as it could also be a cougar or panther. Either way, importantly, there is nothing to indicate that it is a tiger. Also, the contested trade mark contains the words URBAN TIGER, which is in itself slightly odd. It is an unusual concept to refer to a tiger which is urbanised or exists in an urban environment. This concept is not present in the earlier trade mark. Having regard to the low level conceptual similarity on a “big cat” basis, together with the differences, I consider there to be only a low level of conceptual similarity at best.

Distinctive character of earlier mark

24. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier marks, based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v Puma AG*, paragraph 24). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“27. 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).

28. 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).”

25. No evidence has been filed so I only have the inherent distinctiveness of the earlier mark to consider. The mark consists of a big cat. It cannot be said that there is any link, be it suggestive or otherwise, between a big cat and the goods for which the earlier mark is registered. The mark does not, though, strike me as a highly unusual or distinctive mark. I come to the view, therefore, that the earlier trade mark is inherently distinctive to a medium degree for the registered goods.

Likelihood of confusion

26. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), and a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific

formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

27. In the above assessment, I have found the goods to be identical, and that the average consumer will display an average level of care when purchasing them via predominantly visual means. Due to the way in which the goods will be purchased, it is the visual comparison of the marks which will be most determinative for assessing the likelihood of confusion. The level of visual similarity between the two marks has been found to be low.

28. Confusion can either be direct or indirect. The difference was explained in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, by Mr Iain Purvis Q.C., as the Appointed Person:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

29. The visual differences between the marks are stark and would be easily and immediately noticed by the average consumer. Therefore, notwithstanding the concept of imperfect recollection, the marks will not be directly confused for one another. In addition, whilst both marks contain the common element of a big cat, the representations are nevertheless sufficiently different to prevent the average consumer being indirectly confused. The presence of the term URBAN TIGER in the applied for trade mark further distances the marks from one another. Overall, there is

no reason for the average consumer to assume that the producers of the goods are the same or economically related.

30. It would appear, therefore, clear that there is neither direct nor indirect confusion between the marks at issue. The ground of opposition fails.

Conclusion

31. Subject to appeal, the opposition is rejected and the mark may be protected in the UK for the designated goods.

COSTS

32. The applicant has been successful and is entitled to a contribution towards its costs. In the circumstances, I award the applicant the sum of £300 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Official fee - £100

Preparing a statement and considering the other side's statement - £200.

33. I therefore order PUMA SE to pay Ltd "BTC holding" the sum of £300. The above sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 21st day of December 2017

**Oliver Morris,
For the Registrar,
The Comptroller-General**