

O-024-18

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3189532 BY
ADEPOJU TANIMOMO
TO REGISTER:**



AS A TRADE MARK IN CLASS 25

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 408301 BY JACK WILLS LIMITED**

BACKGROUND & PLEADINGS

1. On 5 October 2016, Adepoju Tanimomo (“the applicant”) applied to register the trade mark shown on the cover page of this decision for the following goods in class 25:

Jackets being sports clothing; Jackets [clothing]; Jeans; Jerseys; Jerseys [clothing]; Jogging bottoms [clothing]; Jogging outfits; Jogging sets [clothing]; Jogging tops; Jumpers; Jumpers [pullovers]; Jumpers [sweaters]; Jumpsuits; Pants; Polo shirts; Polo sweaters; Pullovers; Tank tops; Tee-shirts; Tops; Tops [clothing]; Trousers; T-shirts; Turtleneck shirts; Turtleneck tops.

The application was published for opposition purposes on 28 October 2016.

2. On 19 January 2017, the application was opposed in full by Jack Wills Limited (“the opponent”). The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), with the opponent relying upon United Kingdom trade mark registration no. 3035295 for the trade mark **WILLS**, which was applied for on 17 December 2013 and registered on 18 April 2014. The opponent indicates that it relies upon all the goods in class 25 of its registration i.e. Clothing, footwear, headgear; belts, braces, gloves, scarves, ties.

3. Although the applicant admits in its counterstatement that the competing goods are identical, it denies there is a likelihood of confusion.

4. In these proceedings, the opponent is represented by Wilson Gunn and the applicant by Urquhart-Dykes & Lord LLP. Only the opponent filed evidence. Although neither party asked to be heard, both elected to file written submission in lieu of attendance at a hearing. I shall refer to these submissions, as necessary, later in this decision.

The opponent's evidence

5. This consists of a witness statement and exhibits from Michael Doyle, a director of the opponent company. I will return to this evidence when I consider the distinctive character of the opponent's trade mark.

DECISION

6. The opposition is based upon section 5(2)(b) of the Act which reads as follows:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

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

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

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

8. In these proceedings, the opponent is relying upon the United Kingdom trade mark registration shown in paragraph 2 above, which qualifies as an earlier trade mark under the above provisions. As this earlier trade mark had not been registered for more than five years at the date the application was published, it is not subject to the proof of use provisions contained in section 6A of the Act.

Section 5(2)(b) – case law

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

The principles:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

10. In its counterstatement, the applicant admitted the competing goods are identical. As the opponent's specification includes the term "clothing" (which is broad enough to include all of the goods in the applicant's specification), I agree the competing goods are to be regarded as identical on the principles outlined by the General Court ("GC") in *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05.

The average consumer and the nature of the purchasing act

11. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods at issue; I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

"60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

12. In *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03 the GC stated:

"50. The applicant has not mentioned any particular conditions under which the goods are marketed. Generally in clothes shops customers can themselves

either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

13. The average consumer of the goods at issue is a member of the general public buying on their own behalf or a business user buying on behalf of a commercial undertaking. As a member of the general public will, for the most part, self-select the goods from the shelves of a bricks and mortar retail outlet or from the equivalent pages of a website or catalogue, visual considerations are, as the case law explains, likely to dominate the selection process. That said, as such goods may also be the subject of, for example, word-of-mouth recommendations or oral requests to sales assistants (both in person and by telephone), aural considerations must not be forgotten. I see no reason why a business user would not select the goods in much the same way, with intermediaries such as wholesalers and trade-focused sales representatives also likely to feature in the process.


14. In their submissions, the parties characterise the degree of care the average consumer will display when selecting such goods as “reasonable” (paragraph 12 of the applicant’s submissions) and “normal” (paragraph 12 of the opponent’s submissions). The cost of the goods can vary considerably. However, as the average consumer will be alive to factors such as cost, size, colour, material and compatibility with other items of clothing, a member of the public can, I agree, be expected to pay a normal degree of attention to their selection. I think a business user selecting for commercial purposes where, for example, larger sums may be in play and contracts may be negotiated over a period of time, is likely to pay a somewhat higher degree of attention when selecting the goods at issue.

Comparison of trade marks

15. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“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.”

16. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create. The trade marks to be compared are:

Opponent’s trade mark	Applicant’s trade mark
WILLS	 The logo for Hubb & Wills, featuring a stylized 'H' and 'W' with three dots above each letter, and the text 'HUBB & WILLS' below.

17. In reaching the conclusions which follow, I have taken into account (but do not intend to record here) all the competing submissions on this aspect of the case.

18. As the opponent's trade mark consists exclusively of the word WILLS presented in block capital letters, that is the overall impression it will convey and where its distinctiveness lies.

19. The applicant's trade mark consists of a number of components. In its submissions, the applicant describes its trade mark in the following terms:

“16...with the eye-catching and distinctive device....which consists of the conjoined letters “H” and “W” with four dots “crowning” the top of each letter. Underneath the device are the words “HUBB” and “WILLS” which are separated by an ampersand. These words are substantially smaller...”

20. I agree the device component is most likely to be construed as the conjoined and stylised letters “H” and “W” (to, I assume, reflect the first letter in the two words which appear below it) and the inclusion of the four dots may evoke the concept of a crown. I further agree with the applicant that it is a distinctive component. Given its size and positioning in the context of the trade mark as a whole, it will have a high relative weight in the overall impression the trade mark conveys.

21. Below this component and in much smaller letters there appears the words HUBB and WILLS presented in capital letters in an unremarkable font, separated by an ampersand symbol. Although much smaller than the device component appearing above them, these words and symbol will, nonetheless, make an important contribution to the overall impression the applicant's trade mark conveys. As to the distinctiveness of these words (the ampersand requires no further comment), the parties agree that WILLS may be understood as, inter alia, a surname. In my view, the word WILLS is more likely to be construed as a surname rather than, as the applicant suggests, an abbreviation of the first name William. Although the applicant submits, inter alia, that

“WILLS is a common and popular surname...” (paragraph 12), there is no evidence to support such an assertion and, in my experience, that is not the case. Similarly, there is no evidence to support the opponent’s submission that HUBB is a surname (paragraph 7). In this regard, I note that the applicant submits that HUBB has no meaning (paragraph 16). HUBB is not a word with which I am familiar (whether as a surname or otherwise). However, proceeding on the basis that the average consumer is likely to attribute surnominal significance to WILLS, that, together with what in my experience is likely to be the average consumer’s awareness that traders in many areas (including those conducting a trade in clothing) use multiple surnames as indications of origin, is more likely than not to lead the average consumer to conclude that HUBB is also a surname, albeit one with which they may not be familiar (a surname of foreign origin perhaps). Absent evidence to the contrary, HUBB and WILLS are distinctive components and as they do not combine to create a “unit” which has a different meaning to the meanings of the individual words, both play and independent role in the applicant’s trade mark; I shall return to this point below.

22. I shall now compare the competing trade marks from the visual, aural and conceptual standpoints with the above conclusions in mind. When compared from a visual perspective, the word WILLS is the only component in the opponent’s trade mark and the final component in the applicant’s trade mark. Balancing the similarities and differences between the competing trade marks (including the positioning of the component in conflict in the applicant’s trade mark), results in a low degree of visual similarity between them.

23. As to the aural similarity, it is well-established that when trade marks consist of a combination of verbal and figurative components, it is by the verbal components that the trade marks are most likely to be referred. The pronunciation of the opponent’s trade mark is predicable i.e. by the one syllable word of which it is composed. Given the degree of stylisation present in the device component in the applicant’s trade mark, I think it most unlikely that the average consumer will attempt to articulate it i.e. as the letters “H” “W”. In my view, the applicant’s trade mark is much more likely to be referred

to as the three syllable combination HUBB and WILLS. Considered on that basis and notwithstanding that the shared component i.e. WILLS will be articulated in an identical manner, the fact that the word HUBB will be articulated first, renders the competing trade marks aurally similar to only a medium degree.

24. I have already concluded that the opponent's trade mark (and the same word in the applicant's trade mark) is most likely to be construed as a surname and that when considered in context, the word HUBB is also likely to be construed as a surname. As a consequence, the concept the competing trade marks are likely to convey are surnominal in nature. Although the letters "H" "W" and the dots in the device component in the application (the latter of which may introduce an additional concept, royalty perhaps), do nothing to modify the surnominal significance, as the concept of surnames is a very general one, the competing trade marks are conceptually similar to only a low degree.

Distinctive character of the earlier trade mark

25. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

26. I have already concluded that the opponent's trade mark is most likely to be construed as a surname. Surnames are, of course, one of the most traditional forms of trade marks. In its submissions, the opponent states that its trade mark is "inherently highly distinctive in relation to the goods claimed" (paragraph 17) and in its submissions,

the applicant states that: WILLS has only “a low level of distinctiveness in relation to the goods in class 25...” (paragraph 23). Absent evidence to support the applicant’s submissions that WILLS is a “common and popular surname”, I must reach my own conclusion. As I explained earlier, WILLS is not, in my experience, a common surname. It is, as a consequence, and absent use, possessed of an average degree of inherent distinctive character.

27. That, of course, is not the end of the matter as the opponent has filed evidence in support of a claim to enhanced distinctiveness through use. In this regard, I return to Mr Doyle’s statement mentioned above. Mr Doyle explains that the opponent is a “British fashion retailer that designs and produces high-quality, contemporary clothing and accessories for men and women”. He states that the opponent’s first store was opened in 1999. It moved its head office to London in 2005 and opened an additional ten stores across the United Kingdom. In 2010, two additional stores were opened in Tunbridge Wells and Carnaby Street, in 2012 it opened an outlet store in Halifax and in 2014, a concept store in Witney. He adds that “At this time...”, the opponent had seventy stores in the United Kingdom including eight in London, four in Scotland, two in Wales and one in Northern Ireland. Mr Doyle states:

“5. With regard to the sole use of the word WILLS in relation to clothing goods and accessories, please refer to exhibit 3 which is comprised of the sales figures for clothing goods and accessories that feature the word WILLS as a trade mark in its own right.”

28. The information provided in exhibit 3 is helpfully summarised in Mr Doyle’s statement and indicates that between 2009 and 2016, the opponent sold in the United Kingdom a range of goods described as “sweatpants”, “trackpants”, “crew”, “Hoodie”, “Sweat Top”, “Tee”, “Cap”, “Vest” and “Sweatshirt”. This amounted to 405,417 units and sales of £15,827,250. Exhibits 4a to 4o consist of pages from the Jack Wills catalogues/handbooks between spring 2001 and summer 2016, all of which contain images of the type of clothing mentioned above bearing the word WILLS.

29. Mr Doyle explains that in 2008 the opponent acquired “its first set of Land Rovers, which feature the WILLIS mark...”. Exhibit 5 consists of a tweet, dated 16 December 2015, entitled “FREE LIFTS FOR UNI STUDENTS IN JACK WILLIS’ DEFENDER” together with a picture of a vehicle bearing, inter alia, the word WILLIS. Exhibit 6 consists of an undated photograph of another Land Rover which is being used as a photo booth and which bears the word WILLIS and exhibit 7 consists of an undated photograph of a remote controlled toy model of a Land Rover, bearing the word WILLIS.

30. In its submissions, the applicant comments on this evidence in the following terms:

“23...The applicant submits, that whilst there were substantial sales figures in relation to units bearing the WILLIS trade mark into the United Kingdom, all of these goods are sold under, or via the Jack Willis catalogue, retail store or website. None of the evidence suggested that there had been any marketing or advertising activity for the mark WILLIS, in relation to goods in class 25. The applicant submits, that the evidence submitted by the opponent shows sales of products that bear the WILLIS sign but which are marketed and sold under the JACK WILLIS trade mark.”

31. Not surprisingly, in its submissions, the opponent concludes that its trade mark “has acquired a substantially high level of enhanced distinctive through use in the UK” (paragraph 18).

32. The applicant appears to accept that the opponent has made use of its WILLIS trade mark in the United Kingdom and that its sales figures are “substantial”. However, it argues that this does not assist the opponent because there is no independent advertising/marketing of the word WILLIS alone and all of the opponent’s goods bearing the WILLIS trade mark are sold/marketed through the opponent’s handbooks, retail stores or website under the JACK WILLIS trade mark. While it is true that all of the catalogues bear the name JACK WILLIS, I am satisfied that the average consumer has (since at least 2001) been exposed to the word WILLIS as a stand-alone trade mark in

connection with the goods mentioned in Mr Doyle's statement. Although the size of the market for the goods at issue is considerable, the duration and quantum of use outlined above will, in my view, not only have cemented the average consumer's perception of the word WILLS as a sub-brand, but will also have enhanced the inherent distinctiveness of the WILLS trade mark in relation to the goods mentioned in Mr Doyle's statement, elevating its WILLS trade mark to one possessed of a fairly high degree of distinctive character.

Likelihood of confusion

33. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

34. The competing goods are identical; this is a point in the opponent's favour. Earlier in this decision, I concluded that the average consumer was either a member of the general public or a business user who (whilst not discounting aural considerations) is most likely to select the goods at issue by predominantly visual means paying at least a normal degree of attention during that process. Having assessed the competing trade marks distinctive and dominant components and concluded that, inter alia, the word WILLS plays an independent and distinctive role in the applicant's trade mark, I found the competing trade marks to be visually similar to a low degree, aurally similar to a medium degree and conceptually similar to a low degree. I assessed the opponent's

trade mark to be inherently distinctive to an average degree and in relation to the goods for which use has been shown, distinctive to a fairly high degree.

35. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU's judgment in *Bimbo*, Case C591/12P, on the court's earlier judgment in *Medion v Thomson*. He stated:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

36. I should begin by saying that as the opponent points out, in reaching a conclusion, the applicant’s submissions regarding the origin of its trade mark are not relevant (paragraph 18), nor are its submissions regarding the state of the United Kingdom and European Union Intellectual Property Office’s registers in respect of trade marks which consist of or contain the word WILLS in class 25 (paragraphs 24 and 25).

37. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.

38. In its submissions, the opponent states:

“19...the applicant’s mark is likely to cause confusion amongst the relevant public, such that they are likely to perceive HUBB & WILLS as an extension of the WILLS brand, or that HUBB & WILLS is economically linked to the opponent in some manner, such as a clothing design partnership.”

39. Given the conclusions I reached earlier in relation to the various differences between the competing trade marks, even allowing for imperfect recollection, I consider it unlikely that a consumer paying a normal degree of attention during the selection process will mistake the applicant’s trade mark for that of the opponent i.e. there is unlikely to be direct confusion. However, as I mentioned earlier, the word WILLS plays an independent and distinctive role in the applicant’s trade mark. In those

circumstances, the opponent's position is, in my view, strongest when one considers the enhanced distinctive character its WILLS trade mark enjoys. As the opponent's use has, inter alia, educated the average consumer to recognise the word WILLS as a surname, this will, in my view, make the average consumer even more likely to consider the word HUBB as a surname. I think its presence in the applicant's trade mark as one of what is likely to be regarded as a two surname combination may, for example, lead the average consumer to assume that the applicant's trade mark is a variant trade mark being used by the opponent or, alternatively, to conclude that the opponent has entered into a joint venture with an undertaking trading under the surname HUBB (where the stylised letters "H" "W" simply reflect the first letters in the names of the respective surnames which appear below them). Either of those scenarios will, in my view, result in indirect confusion and the opposition succeeds accordingly.

Conclusion

40. The opposition has been successful and, subject to any successful appeal, the application will be refused.

Costs

41. As the opponent has been successful, it is entitled to a contribution towards its costs. Awards of costs in proceedings commenced after 1 July 2016 are governed by Annex A of Tribunal Practice Notice ("TPN") 2 of 2016. Using the TPN mentioned as a guide, I award costs to the opponent on the following basis:

Preparing a Notice of Opposition and reviewing the counterstatement:	£200
Preparing evidence:	£500
Written submissions:	£300

Official fee: £100

Total: £1100

42. I order Adepoju Tanimomo to pay to Jack Wills Limited the sum of £1100. 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 9th day of January 2018

C J BOWEN

For the Registrar