

**O-207-18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3243500  
BY GOMATHY RAMASWAMY  
TO REGISTER**

**adamo**  
LONDON

**AS A TRADE MARK  
IN CLASS 25  
AND  
IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 600000712 BY SCHOFFEL SPORTBEKLEIDUNG GMBH**

## BACKGROUND

1. On 13 July 2017 Gomathy Ramaswamy (“the applicant”) applied to register the trade mark shown on the cover page of this decision for *clothing* and *footwear* in class 25. The application was published for opposition purposes on 28 July 2017.

2. The application is opposed in full by Schoffel Sportbekleidung GmbH (“the opponent”) under the fast track procedure. The opposition is based upon Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), in relation to which the opponent relies upon European Union Trade Mark (EUTM) no. 14945554 for the mark ADAMONT which has a filing date of 21 December 2015 and a registration date of 25 April 2016. The opponent relies upon all the goods for which the mark is registered, including those shown in paragraph 16.

3. The opponent states:

“The registered mark ADAMONT is visually and aurally similar to ADAMO. The use of LONDON in the opposed mark in relation to clothing and fashion has relatively weak distinctive character. The goods protected by the earlier mark and those covered by the opposed marks are identical. The Opponent therefore submits that there is a likelihood of confusion”.

4. The applicant filed a counterstatement in which he denies the ground of opposition. He states:

“[...] In particular it is denied that there is any likelihood of confusion between the two marks because the Opponent’s trade mark “ADAMONT” is visually, aurally and conceptually different from the Applicant’s mark “adamo London”. The ending of the Opponent’s mark –MONT is suggestive of the word “mountain”, while the final “NT” sound is very strong. Moreover, the Opponent’s mark consists of a single word, whereas the Applicant’s trade mark consists of two words ADAMO LONDON.”

5. Rules 20(1)-(3) of the Trade Marks Rules (the provisions which provide for the filing of evidence) do not apply to fast track oppositions but Rule 20(4) does. It reads:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

6. The net effect of the above is to require parties to seek leave in order to file evidence (other than the proof of use evidence which is filed with the notice of opposition) in fast track oppositions.

7. No leave was sought in respect of these proceedings.

8. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if 1) the Office requests it or 2) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost. Otherwise written arguments will be taken.

9. In these proceedings the opponent is represented by Appleyard Lees IP LLP; the applicant is represented by Trademarkit. A hearing was neither requested nor considered necessary. Only the opponent filed written submissions.

## **DECISION**

### **Section 5(2)(b)**

10. Section 5(2)(b) of the Act states:

“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”.

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

12. In these proceedings, the opponent is relying upon the EUTM mark 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. As a consequence, the opponent is entitled to rely upon it without having to demonstrate genuine use.

### **Section 5(2)(b) case law**

13. The following principles 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.

### **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 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**

14. In the judgment of the Court of Justice of the European Union (CJEU) in *Canon*, Case C-39/97, the Court stated at paragraph 23:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

15. In *Gérard Meric v OHIM*, Case T- 133/05, the General Court (GC) stated:

“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”.

16. The competing goods are as follows:

The applicant's goods	The opponent's goods include:
Class 25: Clothing; Footwear.	<p><b>Class 25</b></p> <p>Clothing, apparel, In particular jackets, Coats, Parkas, Ponchos, Waistcoats, Parkas, Coats (top -), Half-coats, Suits, Capes, Shirts, Pullovers, Tee-shirts, Polo shirts, Undershirts, Underwear, Thermal underwear, Blousons, Trousers, Leggings, Skirts, Leg warmers, Socks, Stockings, Neck scarves [mufflers], Scarves, Gloves [clothing], Mittens, Waist belts; Rainwear; Fleeces; soft-shell clothing; Waterproof and water-repellent clothing; Woollen clothing and knitwear; Woollen and knitted headgear; Wind-resistant clothing; Headgear, in particular hats, Caps [headwear], Caps, Headbands [clothing], Hoods [clothing], Head scarves, Ski masks, Ear muffs [clothing]; Shoes, in particular boots for sports, walking boots and hiking boots.</p>

17. Both specifications contain the word *clothing*. The respective goods are self-evidently identical.

18. The opponent's *shoes, in particular boots for sports, walking boots and hiking boots* fall within the contested *footwear*. Goods are identical on the principle outlined in *Meric*.

## **The average consumer and the nature of the purchasing act**

19. As the case law cited in paragraph 13 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 will be selected 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.”

20. The goods at issue in these proceedings are clothing and footwear. The average consumer of the goods at issue is a member of the general public. The purchase is likely to be primarily visual as it is likely to be made from a physical store on the high street, a catalogue or from a website<sup>1</sup>. That said, as the selection of the goods may, on occasion, involve the intervention of a sales assistant, aural consideration cannot be ignored. As to the level of attention paid the opponent claims:

“In the present circumstances the goods are a variety of apparel and accessories. The Opponent submits that the relevant public for the goods in question is the average consumer, which will not pay specialist attention to the marks upon the goods.”

21. I disagree. While I accept that the average consumer’s level of attention will vary considerably depending on the cost and nature of the item at issue, I think that when selecting even routine items of clothing and footwear the average consumer is likely

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<sup>1</sup> *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03



to be conscious of factors such as the size, colour, material and price of the item concerned, all of which suggest, at least, an average degree of attention.



### Comparison of marks

22. 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 them, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

24. The marks to be compared are:

Applied for mark	Earlier mark
	

## **Overall impression**

25. The earlier mark consists of the single word ADAMONT presented in upper case. This is the overall impression it will convey.

26. The contested mark consists of the word adamo presented in lower case and in a slightly stylised font with the word LONDON appearing underneath in a much smaller unstylised font. The most distinctive element of the stylisation of the mark are the initial letters 'ada', with the 'd' appearing as an inverted 'a'. Whilst this makes a more-than-negligible contribution to the visual impression created by the mark, I consider that the overall impression will be dominated by the word adamo with LONDON being seen as a reference to a well-known geographical location and having very little relative weight upon the perception or recall of the average consumer.

## **Visual similarity**

27. The opponent referred me to a number of decisions<sup>2</sup> which, it submitted, showed that beginnings of marks are, generally, more focused upon. There is a general rule, clear from decisions such as joined cases T-183/02 and T-184/0272, that the first parts of words (and consequently, first words of marks) catch the attention of consumers, however, this is only a general rule and each case must be decided on its merits and considering the marks as wholes.

28. In the case before me the dominant elements of the respective marks, i.e. adamo/ADAMONT, are of different length, consisting of 5 and 7 letters respectively. Both marks share the first five letters adamo/ADAMO but the presence of the additional letters 'NT' at the end of the earlier mark introduces a visual difference. As notional and fair use of a mark registered in block capitals will include use in upper and lower case letters, use of the earlier mark includes use in lower case. Whilst use of a word mark also covers use in different scripts, the font used in the contested mark is not a standard script. Consequently, it would be beyond fair and notional use to

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<sup>2</sup> *Adama Holding Public Limited v Jasmin Knoll* (EUIPO Opposition division decision no. B2415530); BL-338/16 and *Coreix Limited Holdings Plc and others* [2017 EWHC 1695]

imagine the earlier mark in the same font of the contested mark. Though the first (or only) five letters of the marks are the same, i.e. adamo/ADAMO, the comparison cannot be confined to comparing only the terms adamo/ADAMONT. The similarity created by the presence in both marks of the identical letters adamo/ADAMO is balanced against the visual difference introduced by the element 'NT' at the end of the earlier mark and by the visual impact of the font, which is particularly striking at the beginning of the contested mark. In my view, the marks at issue look quite different and I find that, overall, there is a low to medium degree of similarity between them.

### **Aural similarity**

29. Aurally, the marks will be pronounced as a three syllable word a-da-mo and a three syllable word A-DA-MONT. The marks coincide in the pronunciation of the five first (or only) letters, however, the contested mark will be pronounced without any significant pause between the three short syllables a-da-mo, whilst the presence of the longer syllable 'MONT' at the end of the earlier mark will create a longer pause between the first two syllables, i.e. A-DA, and the last one, i.e. MONT. Although LONDON must also be taken into account, in my experience, it is not unusual for the descriptive element of a mark to be dropped in speech. As LONDON is the second and descriptive element in the contested mark, it is likely that the average consumer will refer to this mark by the word adamo alone. There is a medium degree of aural similarity.

### **Conceptual similarity**

30. In terms of concept, the applicant states that "the ending of the opponent's mark – MONT is suggestive of the word mountain". However, neither mark in its totality has a concept so the conceptual position is neutral.

### **Distinctive character of the earlier mark**

31. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated at paragraphs 22 and 23 that:

“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).

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).”

32. As no evidence of use has been filed by the opponent, I have only the inherent distinctive character to consider. The word ADAMONT has no obvious meaning and must be regarded as an invented word. That puts it at the top of the scale, so to speak, of distinctiveness.

### **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 marks may be offset by a greater degree of similarity between the respective goods and vice versa. 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

marks and must instead rely upon the imperfect picture of them he has retained in his mind.

34. There are two types of relevant confusion to consider: direct confusion (where one mark is mistaken for the other) and indirect confusion (where the respective similarities lead the consumer to believe that the respective goods and/or services come from the same or a related trade source). This distinction was summed up by Mr Iain Purvis Q.C. sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“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.”

35. The opponent filed the result of an Internet search from what it describes as “the Bingham Young University’s authoritative British National Corpus”. This is aimed to demonstrate that NT is a common ending in the English language, however, as no leave to file evidence was sought by the opponent, the material filed is inadmissible.

36. Earlier in my decision I found that the respective goods are identical. The goods will be selected primarily by visual means with the average consumer paying, at least, an average degree of attention. The earlier mark has a high degree of distinctiveness and the marks are visually similar to a low to medium degree with the conceptual position being neutral. Though, I found, that level of the aural similarity is medium, the purchase is primarily a visual one, so aural considerations are less important. The

opponent contends that since the element adamo/ADAMO is dominant in both marks, they should be regarded as similar. However, contrary to the opponent's submissions, the element 'ADAMO' is not the dominant element of the earlier mark. The relevant consumer will identify in both marks two invented words with no meaning. Taking into account all of the above I find that in spite of the highly distinctive character of the earlier mark and the identity of the goods involved, the differences between the marks at issue are sufficient to preclude a likelihood of confusion, both direct and indirect. **There is no likelihood of confusion.**

## **CONCLUSION**

37. The opposition fails.

## **COSTS**

38. As the applicant has been successful, it is entitled to a contribution towards his costs. Awards of costs in Fast Track opposition proceedings are governed by Tribunal Practice Notice (TPN) 2/2015. Using TPN2/2015 as a guide, I award costs to on the following basis:

Preparing a statement and considering the other side's statement:	£200
Considering written submissions:	£50
Total:	£250

39. I order SCHOFFEL Sportbekleidung GmbH to pay Gomathy Ramaswamy the sum of £250 as a contribution towards his costs. 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 29<sup>th</sup> day of March 2018**

**Teresa Perks**

**For the Registrar**

**The Comptroller – General**