

O-320-18

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3218267 BY RETRO CLOTHING
LIMITED TO REGISTER THE FOLLOWING TRADE MARK**



IN CLASSES 18, 25 AND 35

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. 409586
BY JAKED S.R.L.**

BACKGROUND AND PLEADINGS

1) Retro Clothing Limited (hereafter “the applicant”) applied to register trade mark no. 3218267, the relevant details of which are:



Filing date: 13 March 2017



Publication date: 24 March 2017

Class 18: *Bags; luggage; wallets; purses; parts, fittings and accessories for all the aforementioned.*

Class 25: *Clothing; footwear; headgear.*

Class 35: *Wholesale and retail services connected with the sale of clothing, footwear, headgear, bags, luggage, wallets, purses, and of parts, fittings and accessories for all these goods.*

2) Jaked S.r.L. (hereafter “the opponent”) opposes the trade mark on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all the goods and services set out above and is on the basis of the following three earlier trade marks:

Mark and relevant dates	Goods and services relied upon
<p>European Union Trade Mark (EUTM) no. 7362874</p>  <p>Filing date: 31 October 2008 Date completed registration procedure: 3 February 2014</p>	<p>Class 18: <i>Travelling bags, umbrellas, backpacks, all respectively being for watersports.</i></p> <p>Class 25: <i>Bathing apparel; Swimming costumes; Swimming trunks; Bath robes; Bathing costumes for sporting competitions; Swimming caps; Water polo caps; Plastic beach footwear; Aqua shoes; All of the aforesaid goods being other than T-shirts, sweatshirts, sweaters, cardigans, trousers, jackets, coats, hats, scarves, gloves, footwear.</i></p>
<p>EUTM no. 8249963</p>  <p>Filing date: 28 April 2009 Date completed registration procedure: 9 March 2015</p>	<p>Class 18: <i>Travelling bags, rucksacks, umbrellas, each respectively for swimming sports.</i></p> <p>Class 25: <i>Swimwear; bathing suits; swimming trunks; bathrobes, swimsuits for sport competition; swim caps; water polo caps; plastic beach footwear; water shoes; all the aforementioned wares excluding t-shirts, sweatshirts, pullovers, cardigans, trousers, jackets, coats, hats, scarves, gloves and shoes.</i></p> <p>Class 35: <i>Selling, including on-line selling, in relation to ..., travelling bags, umbrellas, rucksacks, each respectively for swimming sports, swimwear, bathing suits, swimming trunks, bathrobes, swimsuits for sports, competition, swim caps, water polo caps, plastic beach footwear, water shoes, <u>all the aforementioned wares excluding t-shirts, sweatshirts, pullovers, cardigans, trousers, jackets, coats, hats, scarves, gloves and shoes.</u></i> ...</p>
<p>EUTM no. 8499741</p>	<p>Class 18: <i>Travelling bags, rucksacks, umbrellas, each respectively for swimming sports.</i></p>



Filing date: 20 August 2009

Date completed registration procedure:

28 January 2014

Class 25: *Swimwear; bathing suits; swimming trunks; bathrobes, swimsuits for sport competition; swim caps; water polo caps; plastic beach footwear; water shoes; all the aforementioned wares excluding t-shirts, sweatshirts, pullovers, cardigans, trousers, jackets, coats, hats, scarves, gloves and shoes.*

Class 35: *Selling, including on-line selling, in relation to ..., travelling bags, umbrellas, rucksacks, each respectively for swimming sports, swimwear, bathing suits, swimming trunks, bathrobes, swimsuits for sports, competition, swim caps, water polo caps, plastic beach footwear, water shoes, all the aforementioned wares excluding t-shirts, sweatshirts, pullovers, cardigans, trousers, jackets, coats, hats, scarves, gloves and shoes,*
...

3) It was pointed out, on behalf of the applicant that the exclusion underlined in the above Class 35 specifications is incomplete and, as the opponent does not have the authority to unilaterally change an exclusion, I will proceed on the basis that the list of services relied upon includes the full exclusion.

4) The opponent's registrations are earlier marks within the meaning of section 6(1) of the Act. They all completed their registration procedures less than five years before the publication of the contested mark and, therefore, they are not subject to the proof of use provisions set out in section 6A of the Act. The significance of this is that the opponent is entitled to rely upon any of the goods and services listed in the specifications of goods and services for each earlier mark.

5) The opponent claims that it is visually, aurally and conceptually highly similar to the applicant's mark. It claims that JAKED is the dominant part of its marks and contains the same string of letters JA-ED as the dominant element of the applicant's mark. It also claims that the respective goods are identical or have "similar overlap" and concludes that there is a likelihood of confusion.

6) The applicant filed a counterstatement denying the claims made.

7) Both sides filed evidence and I will summarise this evidence to the extent that I consider necessary.

8) A Hearing took place on 16 May 2018 with the applicant represented by Benet Brandreth QC, instructed by Dolleymores. The opponent chose not to attend, but its representative, Stevens Hewlett & Perkins provided written submissions in lieu of attendance. I will keep these in mind

Opponent's Evidence

9) This takes the form of a witness statement by Giorgio Antichi, Chief Executive Officer of the opponent. He provides evidence of the extent and scope of use of the opponent's marks and requests that the mark's "ambit of protection be regarded as wider [than] for a mark which has been used to only an average or limited extent" and submits that the opponent's mark "has acquired an enhanced degree of distinctiveness by virtue of its substantial use and that the degree of protection afforded to it should be correspondingly larger."

10) This evidence can be summarised as follows:

- At the relevant date (the date of filing of the contested mark – 13 March 2017), JAKED branded goods were available from a number of outlets in the UK. Details of nine shops in the UK are provided, all of which appear to be swimwear specialists and includes *Proswimwear* that Mr Antichi describes as "Europe's largest competitive swimwear shop". Six invoices relating to the opponent's sales to some of these shops, in the period 2012 to 2017, are provided at Exhibit GA2. These all feature a mark very similar to that of the opponent's 8499741, but without the words "more than skin". They are for sums ranging from just over £1000 to just over £5300;
- Goods representative of what the opponent provides are shown in pages from its website shown at Exhibit GA3. This illustrates towels, robes, swim

goggles, ear plugs and swimming aids, sports bags, flip flops and pool shoes, swim caps, swimwear for girls, women, boys and men, beachwear, sportswear, t-shirts and hoodies. Many of these are seen with a mark consisting of the word “Jaked” with appearing directly above the word as in the opponent’s earlier marks. Other goods are identified by just the word “jaked”;

- The opponent’s swimwear typically has a retail price of between £35 to £55 and the following sales figures and advertising expenditure relating to the EU are provided:

Year	Sales figures (in excess of) (€)	Advertising expenditure (€)
2012	500,000	1,089,484
2013	800,000	404,911
2014	520,000	371,790
2015	640,000	405,295
2016	520,000	676,688

- Example invoices to continental EU suppliers for the opponent’s goods bearing the “Jaked” mark are provided at Exhibit GA5;
- Exhibit GA1 is “sampled evidence” of the opponent’s promotional activities. In addition to sponsorship of various Italian national teams at various major championships including the World Swimming Championships and the Olympic Games, the opponent also sponsored the opening ceremony of the 2011 Swimming World Championships in Shanghai;
- Exhibit GA8 consists of pages sourced from the applicant’s website that show its mark being used in respect of swimwear.

Applicant’s Evidence

11) This takes the form of two witness statements, the first by Samantha Freedman, a freelance beauty journalist October 2017. Prior to this, she was Associate Beauty Editor at *Grazia* magazine. Ms Freedman explains that the beauty editor of a

magazine is required to have an in-depth knowledge of clothing as well as cosmetics, beauty products and the like. Consequently, Ms Freedman claims to know the clothing fashion market well and that she is familiar with the brand names used in the business. Ms Freedman's statements can be summarised as:

- She has known of the applicant's mark since late 2013;
- Ms Freedman associates the brand with high street fashion and street wear;
- The applicant's designs are aimed at young millennials (15 – 30 year olds);
- She is aware of the dispute between the parties but asserts that sports swimwear (the core goods of the opponent) is a completely different market to fashion centred swimwear that is not suitable for sport;
- Ms Freedman had never heard of JAKED prior to this matter.

12) The second witness statement is by Jade Goulden, director of Jaded London Limited, a company authorised by the applicant to use its mark. The two companies have directors in common, who have overall control of both companies. Ms Goulden's provides evidence to demonstrate that the JADED LONDON brand has "a very high profile" and has done for some years. It is a high street fashion brand. I need say no more about this evidence.

Opponent's evidence-in-reply

13) This consists of a witness statement by Luca Carrara, Chief Executive Officer of the opponent since January 2018 when he succeeded Mr Antichi. To counter Ms Freedman's claim that sports swimwear and fashion swimwear are completely different markets, Mr Carrara provided pages obtained from the Internet at Exhibit LC1. These show the brands such as *Arena* and *Speedo*, *Zoggs* and *Adidas* all offering for sale both sports and leisure beachwear.

DECISION

14) 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”.

15) The following principles are gleaned from the decisions of the Court of Justice of the European Union (“the CJEU”) 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.

16) The opponent relies upon three earlier marks. Whilst there are minor differences between these three marks, such differences are not such as to materially impact upon the outcome of the proceedings. Therefore, for procedural economy, I will consider one of the opponent's marks that has the broader list of goods and services. I will therefore base my analysis on the opponent's earlier EUTM no. 8249963.

Comparison of goods and services

17) In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“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”.

18) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

19) The following guidance of the General Court in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05 (“*Meric*”) is also relevant:

“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”.

20) At the hearing, Mr Brandreth accepted that, applying the guidance from *Meric*, the applicant’s specifications cover goods and services for which the earlier mark is registered. Therefore, I will proceed on the basis that the respective goods and services are identical.



Comparison of marks

21) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23), Case C-251/95, that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

22) 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.

23) The respective marks are:

Earlier mark	Contested mark
	

24) The opponent's earlier mark consists of the word "Jaked" with a device consisting of an oval tilted to the right and a curved line appearing above it. Mr Brandreth characterised this as a representation of a stick figure swimming front crawl. I am not convinced that the consumer will identify such a concept, but I keep this in mind. I note that the word element is embellished by some thin lines visible on each letter. It is my view that the presence or absence of these will not impact upon the findings in this case and, therefore, whilst I will keep them in mind, I will not refer to them further. The device element appears above the word, but it is approximately half the length of the word element. As a result, the word element is the dominant and distinctive part of the mark. However, the device element contributes to the distinctive character of the mark and as such, I keep it in mind when conducting the necessary comparison analysis between the marks.

25) The applicant's mark consists of the word JADED presented in white on a dark background with a diagonal line running from below mid-way up the "J" to the top right of the last letter. The word "London" appears in smaller letters underneath the word JADED. The dominant and distinctive element of the mark is the word JADED, but I also keep in mind the other, non-verbal elements of the mark that contribute to the overall distinctive character. The word LONDON is presented in a way as to indicate a geographical location and, as such, it does little if anything towards contributing to the distinctive character of the mark.

26) Visually, the opponent submits that the diagonal “strike-out” line through the applicant’s mark does not disguise the word JADED and that this word differs from the dominant word “Jaked” in the opponent’s mark by just one letter in a non-prominent position in the mark. I agree with these observations, but I must consider what impact these have upon the level of visual similarity. Mr Brandreth pointed out numerous differences between the respective marks:

- Both marks have their own distinct stylisation;
- The applicant’s mark is presented in uppercase, the opponent’s mark in lower case and just the first letter in capitals;
- The applicant’s mark includes white letters on a dark background, whilst the opponent’s mark is dark letters on a white background;
- The applicant’s word JADED is struck through, partially obscuring it;
- The opponent’s mark features a device element absent in the applicant’s mark;
- The applicant’s mark features a plain font and the opponent’s mark a decorative font;
- The applicant’s mark features the second word LONDON.

27) When considering the respective marks, I have taken account of all these submissions and I conclude that the different get-up of the respective marks together with the different third letter in the dominant word element of each mark results in the visual similarity being no more than medium.

28) Aurally, the opponent submits that the first syllable of both marks will be pronounced as JAY with JAKED being pronounced like FAKED or BAKED. I concur with this submission. The opponent also submits that the pronunciation effect for JADED is precisely the same. I do not agree. Mr Brandreth submitted that the applicant’s mark contains the four syllables JAY-DED-LON-DON. It does, but it is my view that the consumer is not likely to refer to the LONDON element of the mark. I agree with Mr Brandreth’s submission on the pronunciation of the JADED element. It is likely to be pronounced in the same way as the word FADED with the distinct DED

sound as the second syllable. Taking all of this into account, I conclude that the respective marks share medium level of aural similarity.

29) Conceptually, the opponent concedes that there is no meaningful conceptual comparison. Mr Brandreth went further and submitted that:

- The word JADED will be immediately understood as meaning “exhausted or dissipated”;
- The word LONDON is a reference to a city and is a common indicator of the location of a fashion label;
- Neither of the above concepts are present in the opponent’s mark;
- The device element present in the opponent’s mark may be recognised as a representation of a stick figure swimming.

30) As a consequence of these, Mr Brandreth submitted that there are significant conceptual differences. If the device element present in the opponent’s mark is, indeed, perceived as a swimming stick figure, I agree. However, I am not convinced that the consumer will identify such a concept. Nevertheless, even if this is so, the alleged confusable elements of the respective marks, namely the words “Jaked” and JADED are not conceptually similar. Upon encountering the opponent’s mark, the consumer is likely to perceive an invented word with no obvious meaning. When encountering the applicant’s mark, the consumer will encounter a word with a common, known meaning. The remaining elements of each mark would not impinge upon these conceptual impressions.

31) In summary, where the consumer does not perceive the device in the opponent’s mark as a swimming stick figure, there is no conceptual similarity between the marks when considered in their totalities. Where the “swimming stick figure” is perceived, this creates an element of conceptual dissimilarity.

Average consumer and the purchasing act

32) 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 of the goods and services concerned is the bags, clothes and footwear purchasing public and there is no reason why I should assume that s/he is any different to that identified by Birss J. above. The General Court has continued to identify the importance of visual comparison when considering the purchasing act in respect of clothing (see for example Joined Cases T-117/03 to T-119/03 and T-171/03 *New Look Ltd v OHIM (NLSPORT et al)* [2004] ECR II-3471 at [49]-[50] and Case T414/05 *NHL Enterprises BV v OHIM (LA KINGS)* [2009] ECR II.). By analogy, the same comments can also apply equally to the purchase of bags. I conclude that the purchasing process is primarily a visual one, however, I do not ignore that aural considerations may be involved.

35) The purchasing act will, generally involve a reasonable degree of care and attention but not the highest degree of attention. I recognise that the opponent's goods and services are focussed upon the competitive swimwear market where

functional characteristics of the goods may play a heightened importance, but I do not find that the degree of care and attention is enhanced to any significant degree.

Distinctive character of the earlier trade mark

36) 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).”

37) The opponent’s mark consists of an invented word with a device that will either be perceived as a highly stylised swimming stick figure or at least equally likely to be perceived as a fanciful device with no conceptual hook. There is also a certain stylisation. Taking all of the above into account, I conclude that the opponent’s earlier mark is endowed with a high level of inherent distinctive character.

38) The opponent provided evidence in an attempt to demonstrate that its mark has acquired an enhanced level of distinctiveness through its use and that, consequently, the degree of protection afforded to it should be correspondingly larger. Whilst it clearly has sales in the UK, the scale of this use is unclear because sales figures and advertising spend relate to the EU as a whole and it is not possible to discern the figures for the UK. I also note the promotional activities undertaken, including providing swimwear to a number of Italian national teams, including at the London Olympics and also sponsoring the opening ceremony at the 2011 Swimming World Championships in Shanghai. This may have led to members of UK teams appearing at these events being exposed to the opponent's products, and in terms of the sponsorship of the opening ceremony in 2011, to the wider public interested in the sport of swimming. However, this is insufficient to develop any significant enhanced distinctive character in the UK. I should add that, even if I am wrong on this point, in light of the high level of inherent distinctive character, the impact of any enhanced level of distinctiveness would not impact upon the outcome of these proceedings.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

39) In his witness statement, Mr Carrara submitted that Ms Goulden's claim of not being aware of any confusion is not surprising because, as the senior mark, such matters would have been directed at the opponent. I agree with Mr Brandreth when he submitted that this is irrelevant because instances of confusion could have been brought to the attention of either party.

40) Mr Brandreth went further, submitting that it is significant that neither side have been aware of any confusion. I note this but the relevance of an absence of confusion in the marketplace considered in *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, where Kitchen L.J. stated that:

“80.the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in *Specsavers* at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a

likelihood of confusion. But conversely, the absence of actual confusion despite side by side use may be powerful evidence that they are not sufficiently similar to give rise to a likelihood of confusion. This may not always be so, however. The reason for the absence of confusion may be that the mark has only been used to a limited extent or in relation to only some of the goods or services for which it is registered, or in such a way that there has been no possibility of the one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur.”

41) In the current case, it is the positions of the parties that they are in the field of high street fashion and sports swimwear fields respectively. Consequently, there will have been limited opportunities for consumers to encounter both marks in the marketplace, reducing the opportunity to test whether confusion would occur. Therefore, I dismiss the submission that a lack of actual confusion is significant in this case.

42) The opponent submits that for clothing, visual considerations are more important than aural or conceptual considerations. Certainly (and as I have found in paragraph 34 earlier), visual considerations are generally more important, but this does not relegate the role of conceptual considerations because, as Mr Brandreth submitted, these are inextricably linked to how the consumer perceives a mark, even where visual considerations are more important than aural considerations. Mr Brandreth relied upon the judgment of the CJEU in *Il Ponte Finanziaria SpA v. OHIM* (Case C-234/06 P) where the following guidance was provided:

“34. That global assessment means that conceptual and visual differences between two signs may counteract aural similarities between them, provided that at least one of those signs has, from the point of view of the relevant public, a clear and specific meaning, so that the public is capable of grasping it immediately (see Case C-361/04 P *Ruiz-Picasso and Others v OHIM* [2006] ECR I-643, paragraph 20; *Mülhens v OHIM*, paragraph 35; and Case C-171/06 P *T.I.M.E ART y OHIM*, not published in the ECR, paragraph 49).”

43) This is the case in the current proceedings where the word element of the applicant's mark has a specific meaning. The word element is the only element that has any similarity to the opponent's mark, even though I do not ignore the additional non-verbal elements of the mark, and their presence does not disturb the conclusion that the conceptual meaning of the word element may counteract the aural similarities between the marks. I therefore dismiss the opponent's submission that conceptual considerations carry less weight.

44) I have found that:

- The respective goods and services are identical;
- the word "Jaked" is the dominant and distinctive element in the opponent's earlier mark;
- the word JADED is the dominant and distinctive element of the applicant's mark;
- the respective marks share no more than a medium level of visual similarity, a medium level of aural similarity and there is either no conceptual similarity (or conceptual dissimilarity where the consumer perceived the device present in the opponent's mark as a swimming stick figure);
- the average consumer consists of ordinary consumers and the purchasing process is primarily visual in nature (but I don't ignore aural considerations) and these consumers pay an average level of care and attention during the purchasing act. I recognised that the opponent is involved in the competitive swimwear market where functional characteristics of the goods may play a heightened importance, but that the degree of care and attention is not enhanced to any significant degree;
- the opponents mark is endowed with a high level of inherent distinctive character, but this is not enhanced through use. I further noted that even if it did benefit from an enhanced level of distinctive character, this would not materially impact upon the outcome of the proceedings.

45) Mr Brandreth's submitted that the applicant's primary position was that there is no similarity between the respective marks and, consequently, there can be no

likelihood of confusion. I dismiss this submission. I have found that the respective marks share a degree of visual and aural similarity and it follows that the marks share some overall similarity. In light of these findings it is not open to me to find that the marks share no similarity.

46) Mr Brandreth, whilst acknowledging that the respective goods and services are identical, submitted that if I were to find some similarity then I should find that they are lowly similar with the consequence that there would still not be any likelihood of confusion. In considering this, I keep in mind that descriptive or non-distinctive matter to be given less weight when comparing marks (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, paragraph 22). Therefore, whilst the word LONDON in the applicant's mark is a point of difference when comparing to the opponent's mark, its presence has a minimal impact upon the outcome of my assessment. That said, the visual embellishments of the respective marks are totally different in each mark and is a factor that I also keep in mind.

47) The similarity claimed by the opponent arises from the comparison of the dominant and distinctive element of each mark and I have found that there is no conceptual similarity between these elements (or the marks when considered as a whole). This is an important factor when considering the likelihood of confusion and when I take this into account together with the visual differences that arise from the get-up of each mark, I conclude that when a consumer encounters one of the marks, it will not bring the other to mind. As a result, even though identical goods and services are involved, there is no likelihood of confusion.

48) As I also stated earlier, the opposition would not have succeeded if I had based my analysis on either of the other two of the opponent's marks.

Summary

49) The opposition fails in its entirety.

Costs

50) The applicant has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2 of 2016. I award costs as follows:

Considering other side's statement and preparing counterstatement	£300
Considering other side's evidence and preparing own evidence	£800
Preparing for, and attending hearing	£700
Total:	£1800

51) I order Jaked S.r.L. to pay to Retro Clothing Limited the sum of **£1800**. 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 23rd day of May 2018

Mark Bryant

For the Registrar

The Comptroller-General