

**O-190-19**

**TRADE MARKS ACT 1994  
IN THE MATTER OF  
TRADE MARK APPLICATION NO 3265136  
BY EPOD AMERICA, LLC  
TO REGISTER**

**DOPE**

**AS A TRADE MARK  
IN CLASS 25  
AND OPPOSITION THERETO (UNDER NO. 411831)  
BY  
ILLUME HOLDING AB**

## Background & Pleadings

1. EPOD America, LLC ('the applicant') applied to register the trade mark DOPE in class 25 on 20 October 2017. The mark was accepted and published on 5 January 2018 for the following goods:

*Clothing; footwear; headgear; athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; athletic pants; athletic shirts; athletic shorts; athletic uniforms; beanies; board shorts; boxer shorts; business wear, namely, suits, jackets, trousers, shirts, skirts, dresses and footwear; camouflage jackets; crew neck sweaters; denim jackets; golf shorts; gym shorts; gym suits; hats; jackets; jogging suits; men's dress socks; men's suits; shirts and short-sleeved shirts; short-sleeved shirts; socks; sweat shorts; sweaters; swim trunks; swim wear; swim wear for gentlemen and ladies; women's clothing, namely, shirts, skirts.*

2. ILLUME Holding AB ('the opponent') opposes the application under sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 ('the Act') on the basis of its EU trade marks outlined below. The goods are set out later in this decision.

EU TM11339884

Do.pe

Filing Date: 13 November 2012

Registration Date: 13 May 2013

EU TM11518313

DOPE

Filing Date: 25 January 2013

Registration Date: 21 June 2013

EU TM 11518371

**DOPE**

Filing Date: 25 January 2013

Registration Date: 21 June 2013

EU TM 11333771



Filing Date: 9 November 2012

Registration Date: 13 May 2013

EU TM11333895



Filing Date: 9 November 2012

Registration Date: 13 May 2013

3. The opponent claims under section 5(1) that the applied-for mark is identical to its earlier marks and has identical goods to the earlier mark. In addition, the opponent claims under section 5(2)(a) that the applied-for mark is identical to its earlier marks and has similar goods to the earlier marks and there exists a likelihood of confusion. Under section 5(2)(b) it claims that the applied-for mark is similar to its earlier marks and has identical or similar goods to the earlier mark and there exists a likelihood of confusion.

4. The opponent's trade marks are earlier marks, in accordance with section 6 of the Act but, as they have not been registered for five years or more at the publication date of the applicant's mark, they are not subject to the proof of use requirements, as per section 6A of the Act.

5. The applicant submitted a counterstatement in which it denied all the grounds of opposition.

6. In these proceedings the applicant is represented by Marks & Clerk LLP and the opponent by Murgitroyd & Company.

7. No hearing was requested. Both parties provided written submissions in lieu. I make this decision from a consideration of the material before me.

### **Sections 5(1) and 5(2)**

8. Sections 5(1) and 5(2) of the Act are as follows:

“5(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods and services for which the trade mark is applied for are identical with the goods and services for which the earlier trade mark is protected.

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

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the 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.
- (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 leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

## **The principles**

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

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

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

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

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

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

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

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

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

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

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

### **Identity of the marks**

10. The opponent relies upon the five marks set out in the table at paragraph 2. None of the marks are subject to proof of use and all share the same specifications. Bearing all of this in mind and in the interests of procedural economy, I will proceed initially on the basis of EU TM11518313 which I consider to be the opponent's strongest mark, returning to consider the other marks only if it becomes necessary to do so.

11. The marks to be compared are:

Opponent's mark EU TM11518313	Applicant's mark
DOPE	DOPE

12. I find the marks to be visually, aurally and conceptually identical.

### **Comparison of the goods**

13. In the judgment of the Court of Justice of the European Union 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”.

14. 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 uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) 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;
- (f) 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.

15. I am also guided by *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, in which the GC stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für Lernsysteme

v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

16. For reasons which are explained below, I will be comparing the following class 25 goods only:

Opponent's goods	Applicant's goods
<p>Class 25: Clothing, footwear, headgear; shirts, hoodies, jersey shirts; vests; sweaters; braces for clothing; collars (clothing); underwear; clothing; sweat absorbent underwear; clothing apparel; outerwear; jackets; (other than for protection against accidents and injuries); headbands (clothing); clothing of imitations of leather; clothing of leather; t-shirts; camisoles; hats; caps; shirts; socks; beach wear; gloves (clothing); gloves (other than for protection against accidents and injuries); sports headgear (other than helmets); pants; jeans; tights; shorts; swimwear; shorts; footwear for use in snowboarding and skiing; sports and leisure shoes and boots.</p>	<p>Class 25: Clothing; footwear; headgear; athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; athletic pants; athletic shirts; athletic shorts; athletic uniforms; beanies; board shorts; boxer shorts; business wear, namely, suits, jackets, trousers, shirts, skirts, dresses and footwear; camouflage jackets; crew neck sweaters; denim jackets; golf shorts; gym shorts; gym suits; hats; jackets; jogging suits; men's dress socks; men's suits; shirts and short-sleeved shirts; short-sleeved shirts; socks; sweat shorts; sweaters; swim trunks; swim wear; swim wear for gentlemen and ladies; women's clothing, namely, shirts, skirts.</p>

17. Both parties have *clothing, footwear, headgear* in their specifications which is self-evidently identical. The remaining individual clothing items listed in the applicant's specification are caught by the broader terms *clothing, footwear,*



*headgear* in the opponent's specification and as such are considered as identical under the *Meric* principle.

18. As I have found the applicant's class 25 goods to be identical with the opponent's goods, I do not intend to make a further comparison with the opponent's class 35 services as it does not put the opponent in any stronger a position.

### **Average consumer and the purchasing process**

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

20. 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.”

21. The guidance given in *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03 is also appropriate here as the goods in that case were also clothing. The General Court stated that:

“49. However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the

objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

And

“50..... 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.”

22. The average consumers for the contested goods in this case are members of the general public. The goods will be sold in bricks and mortar retail clothing stores as well as online and through mail order. As set out above in *New Look*, the act of purchasing clothing will be a primarily visual process and factors such as aesthetics, functionality and fit in addition to the cost will come into play. In traditional retail premises, the average consumer will be viewing and handling garments. In an online website or mail order catalogue, a consumer will be viewing images of the goods before selection. Given that clothing prices can vary from garment to garment, I conclude that an average consumer will be paying a reasonable degree of attention during the purchasing process. Although I have found the purchasing process to be primarily visual, I do not discount any aural consideration such as seeking advice from sales staff or from word of mouth recommendations.

### **Distinctiveness of the earlier mark**

23. The distinctive character of the earlier mark must be considered. The more distinctive it is, either inherently or through use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). 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).”

24. There is no evidence before me in relation to the earlier mark so I have only the inherent position to consider. The earlier mark consists of an ordinary dictionary word, with which the average consumer will be familiar, which is not descriptive or allusive of the goods for which it is registered. As such I find it to be inherently distinctive to an average degree.

## **Likelihood of confusion**

25. Drawing together my earlier findings into the global assessment of the likelihood of confusion, I keep in mind the following factors:

- a) The interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon*).
- b) The principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*).
- c) Imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer*).

26. So far, I found the earlier mark to be of average inherent distinctiveness. I also found that the average consumer will be purchasing goods by a primarily visual means, although an aural aspect is not discounted, and will be paying a reasonable degree of attention. Additionally, I have found that the marks are identical, and the goods are identical in class 25. The opposition succeeds under section 5(1) for these goods.

## **Conclusion**

27. The opposition succeeds in full and subject to any successful appeal against this decision, the application is refused.

## **Costs**

28. As the opponent has been successful, it is entitled to a contribution towards the costs incurred in these proceedings. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. Using the guidance in TPN2/2016, I make the following award:

£100 Official opposition fee

£300 Preparation of a statement and consideration of the counterstatement

£400 preparation of submissions

**£800 Total**

29. I order EPOD America, LLC to pay ILLUME Holding AB the sum of £800. This sum is to be paid within 14 days of the expiry of the appeal period or within 14 days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated 9 April 2019**

**June Ralph  
For the Registrar,  
The Comptroller General**