

O/795/21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003515406

BY ITER APPAREL LTD TO REGISTER THE FOLLOWING TRADE MARK

Iter

IN CLASS 25

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 422325 BY YOUTH SRL

Background and Pleadings

1. On 24 July 2020, Iter Apparel Ltd ('the Applicant') filed an application to register the trade mark shown on the cover page of this Decision, number UK00003515406. The application was published for opposition purposes in the *Trade Marks Journal* on 4 September 2020. Registration is sought in respect of the following term only:

Class 25

Clothing

2. On 4 December 2020, the application was opposed by Youth SRL ('the Opponent') based on section 5(2)(b)¹ of the Trade Marks Act 1994 ("the Act"). The opposition is directed against all of the goods in the application. The Opponent relies on the following earlier registration for its section 5(2)(b) grounds:

IR(EU): WO00001464760

IUTER

Filing date: 17 January 2019;

Date registration completed: 8 October 2019;

Priority date: 17 July 2018;

Priority country: Italy

Relying on the following of its goods only²:

Class 25

Clothing; footwear; headgear

3. The Opponent claims that there is a likelihood of confusion under section 5(2)(b).

¹ Additional grounds under sections 5(3) and 5(4) were initially raised but subsequently withdrawn by the Opponent.

² The full specification for this earlier registration can be found here <https://trademarks.ipo.gov.uk/ipo-tmcase/page/Results/1/UK00801464760>.

4. The Applicant filed a defence and counterstatement including the following:

5(2)b - We strongly deny the claim under section 5(2)b that the applicant's trademark is similar to an earlier mark and for identical or similar goods and services. The word IUTER has a total different meaning, sounds totally different and spelt totally different.

5. During the evidence round, written submissions were filed by the Opponent only; neither party has filed evidence. Neither party has filed written submissions in lieu of a hearing.
6. The Opponent is represented by D. Young & Co.; the Applicant represents itself.
7. The following decision has been made after careful consideration of the papers before me.

Relevant dates

8. Section 6A of the Act provides that where the registration date of the earlier mark is more than 5 years prior to the application date of the applied-for mark, the Opponent may be required to prove use of the earlier mark. In the instant case, Section 6A is not engaged because the priority date of the earlier mark is less than 5 years prior to the application date of the applied-for mark, i.e. 17 July 2018. Consequently, the Opponent is entitled to rely upon its mark in respect of all of the goods on which it seeks to rely as set out in its statement of grounds.

Decision

Section 5(2)(b) of the Act and related case law

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

“A trade mark shall not be registered if because—

(a) ...

- (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.”

10. The following principles are derived from the decisions of the CJEU³ 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 C120/04; *Shake 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;

³ Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

(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

11. The Applicant seeks registration of its mark solely in respect of *Clothing* in class 25. The Opponent also includes the term *Clothing* in class 25. These goods are self-evidently identical.

Average consumer and the purchasing act

12. 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*.

13. In *Hearst Holdings Inc*⁴ Birss J. described the average consumer in the following way:

“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 word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

14. The average consumer of the goods in question is a member of the general public. The goods will be sold from physical shops, catalogues or online. The

⁴ *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).

goods will, in most cases, be self-selected: in retail premises, they will be selected from shelves or rails; online, they will be ‘added to the shopping basket’ after visual inspection of the product listing. The purchasing act will, in most cases, be primarily visual; in instances where a member of staff is consulted, there will be an aural aspect. In my view, the average consumer will consider factors including: size of the garment; colour; composition of the fabric; care instructions; comfort/how the fabric feels; durability and how the garment looks when tried on. In my view, the average consumer will display at least an average level of attention when purchasing these goods.

Comparison of the marks

Opponent’s (earlier) mark	Applicant’s (contested) mark
IUTER	ITER

15. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The 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, 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.
17. The Opponent's mark comprises a single word element 'IUTER' in a plain font, all letters of uniform size and in upper case. The overall impression resides in its entirety.
18. The Opponent's mark comprises a single word element 'ITER' in a plain font, all letters of uniform size and in upper case. The overall impression resides in its entirety.
19. Visual comparison
Both marks are short, comprising one word only. The respective marks share four letters 'I, T, E, R' appearing in that order. Points of difference are: the presence of the letter 'U' as the second letter of the earlier mark, absent from the Applicant's mark; the one-character difference in length of the marks.
20. Courts have been willing to find similarity of marks where there is an identical verbal element that is shared by the respective marks, even though the remaining letters are different. The General Court in the case of *Lancôme v OHIM*⁵ considered the word marks 'ACNO FOCUS' and 'FOCUS' and concluded that there was a certain visual similarity between them by virtue of both marks containing the common element 'FOCUS'.
21. In *El Corte Inglés, SA v OHIM*, the General Court observed that the attention of the consumer is *usually* [my emphasis] directed to the beginning of a word mark⁶, but I am mindful that this is not an absolute rule.

⁵ Case T-466/08 *Lancôme Parfums et Beauté & Cie v OHIM* EU:T:2011:182, para [63].

⁶ Cases T-183/02 and T-184/02 at para [83].

22. Consequently, I find the respective marks to be visually similar to at least a medium degree.

23. Aural comparison

The Opponent's mark, in my view, will be articulated by the average consumer as either 'eye-yoo-tuh' or 'ee-yoo-tuh', with the emphasis on the second syllable. The Applicant's mark, to my mind, will be articulated as either 'ee-tuh', 'eye-tuh' or 'itt-uh', with the emphasis on the first syllable.

24. Consequently, I find the following:

- If the average consumer articulates the earlier mark as 'eye-yoo-tuh' and the applied-for mark as 'ee-tuh', the marks will be aurally similar to a low-medium degree;
- If the earlier mark is articulated as 'eye-yoo-tuh' and the applied-for mark as 'eye-tuh', the marks will be aurally similar to a medium degree;
- If the earlier mark is articulated as 'eye-yoo-tuh' and the applied-for mark as 'itt-uh', the marks will be aurally similar to a low degree;
- If the earlier mark is articulated as 'ee-yoo-tuh' and the applied-for mark as 'ee-tuh', the marks will be aurally similar to a medium degree;
- If the earlier mark is articulated as 'ee-yoo-tuh' and the applied-for mark as 'eye-tuh', the marks will be aurally similar to a low-medium degree;
- If the earlier mark is articulated as 'ee-yoo-tuh' and the applied-for mark as 'itt-uh', the marks will be aurally similar to a low degree.

25. Conceptual comparison

Both parties' marks will be perceived by the average consumer as invented words to which no concept will attach. They are conceptually neutral.

Distinctive character of the earlier mark

26. *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).”

27. ‘IUTER’ will be perceived by the average consumer as an invented word. The mark neither describes, nor alludes to, the goods and services in respect of which it is registered. Consequently, the Opponent’s mark is inherently distinctive to a high degree.

Likelihood of confusion

28. Confusion can be direct or indirect. Mr Iain Purvis Q. C., as the Appointed Person, explained the difference in the decision of *L.A. Sugar Limited v By Back Beat Inc*⁷. Direct confusion occurs when one mark is mistaken for another. In *Lloyd Schuhfabrik*⁸, the CJEU recognised that the average consumer rarely

⁷ Case BL O/375/10 at [16].

⁸ *Lloyd Schuhfabrik Meyer and Co GmbH v Klijsen Handel BV* (C-34297) at [26].

encounters the two marks side by side but must rely on the imperfect picture of them that he has in his mind. Direct confusion can therefore occur by imperfect recollection when the average consumer sees the later mark before him but mistakenly matches it to the imperfect image of the earlier mark in his 'mind's eye'. Indirect confusion occurs when the average consumer recognises that the later mark is indeed different from the earlier mark, but, concludes that the later mark is economically linked to the earlier mark by way of being a 'sub brand', for instance.

29. Before arriving at my decision, I must make a global assessment taking into account all of the relevant factors, including the principles a) – k) set out above at [10].

30. The purchasing act will be primarily visual, therefore the visual aspect of the marks will play a more prominent role in the average consumer's perception of the marks.⁹ I consider that the weight to be accorded to the aural similarity of the marks is therefore diminished.

31. When considering all relevant factors 'in the round', I must bear in mind that a greater degree of similarity between goods *may* be offset by a lesser degree of similarity between the marks, and vice versa.

32. The goods are self-evidently identical.

⁹ In *New Look Limited v OHIM*⁹ the General Court stated that:

"49. ...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...";

In *Quelle AG v OHIM*, Joined cases T-117/03 to T-119/03 and T-171/03, the general Court held that:

"68..... If the goods covered by the marks in question are usually sold in self-service stores where consumers 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 phonetic similarity between the signs."

33. My comparison of the respective marks has determined that:

- The marks are visually similar to at least a medium degree;
- Aurally speaking, there are several ways in which each of the respective marks might be articulated; these are set out at [24] above. In my view, a significant proportion of average consumers in the UK market will articulate the Opponent's mark 'IUTER' as 'eye-yoo-tuh' and the applied-for mark, 'Iter' as 'eye-tuh'. I consider these pronunciations to be the most intuitive for English-speakers. I therefore find the respective marks to be aurally similar to a medium degree.
- The marks will be conceptually neutral.

34. I have found that the earlier mark is inherently distinctive to a high degree. The CJEU held in *Sabel*¹⁰ that:

"24. The more distinctive the earlier mark, the greater will be the likelihood of confusion."¹¹

35. I find that a significant proportion of average consumers would confuse the marks. Both marks comprise invented words. There is therefore no conceptual 'hook' upon which the average consumer may grasp. The fact that the respective goods are identical, together with the levels of visual and aural similarity between

¹⁰ *Sabel BV v Puma AG* (C-251/95), [1998] E. T. M. R. 1 (1997) at [24].

¹¹ This principle was given an important qualification by Mr Iain Purvis Q.C, as the Appointed Person, in the decision of *Kurt Geiger v A-List Corporate Limited* BL O-075-13:

"39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything, it will reduce it."

the marks will, in my view, lead to direct confusion. I find that when the average consumer tries to remember the Applicant's mark, 'Iter', should they encounter the Opponent's mark, 'IUTER', they may well mistake it for the Applicant's mark¹² because the mind's eye has failed to register the visual difference (i.e. the presence of the 'U' in the Opponent's mark). There is a likelihood of confusion. I find this to be the case even though the average consumer will display at least an average level of attention when purchasing the respective goods.

Final Remarks

36. The Opposition has succeeded in full and the Application is refused.

COSTS

37. I award the Opponent the sum of **£400** as contribution towards its costs, calculated as follows¹³:

Preparation of statement and consideration of the Applicant's statement:	£200
Official fee for 5(2)(b) only:	£100
Written Submissions in evidence round:	£100 ¹⁴
Total:	£400

38. I therefore order Iter Apparel Ltd to pay to Youth SRL **the sum of £400**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

¹² Or vice versa; the Applicant's mark may be mistaken for the Opponent's mark.

¹³ Based upon the scale published in Tribunal Practice Notice 2/2016.

¹⁴ I have awarded a sum below the threshold because the written submission was less than a single page in length and could easily, and more appropriately, have been included in the space provided at Q5 of the Notice of Opposition and Statement of grounds (the Opponent chose to leave this section blank).

Dated this 25th day of October 2021

Mx N. R. Morris

For the Registrar,

the Comptroller-General