

O/691/22

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003721631
BY EKOL GİYİM SANAYİ VE TİCARET LİMİTED ŞİRKETİ
TO REGISTER THE TRADE MARK:

EKOL

IN CLASS 25

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 60002221
BY JCR

BACKGROUND AND PLEADINGS

1. On 15 November 2021, EKOL GIYİM SANAYİ VE TİCARET LİMİTED ŞİRKETİ (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on the 26 November 2021. The applicant seeks registration for the following goods:

Class 25 Bandanas; Belts for clothing; Blouses; Brassieres; Cardigans; Coats; Cravats; Dresses; Footwear; Gloves; Hats; Headwear; Jackets; Jerseys; Lingerie; Overalls; Overcoats; Pajamas; Panties; Pants; Pullovers; Raincoats; Scarves; Shawls; Shirts; Skirts; Socks; Stockings; Suits; Suspenders; Sweaters; Swimwear; T-shirts; Ties; Tops; Track suits; Trousers; Underpants; Undershirts; Vests; Waistcoats; all of the aforesaid not in connection with sportswear, sports clothing and sports items.

2. The application was opposed by JCR (“the opponent”) on 14 February 2022. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the following trade mark:

EKOİ

UK registration no. UK00916660681

Filing date 27 April 2017

Registration date 28 August 2017

Relying upon some of the goods for which the earlier mark is registered, namely:

Class 25 Sports footwear for running and triathlons; Sports clothing for running and triathlons; Shorts, Stockings, Tights, Muffs for the hands, Pedal pushers and Sliding shorts, Tee-shirts, Vest tops, Sweat shirts, Jackets [clothing], Fleece, Cagoules, Gym suits, Jogging pants, Caps

[headwear], Caps [headwear], Underwear, Socks, Headbands (clothing); All of the aforesaid goods being for running and triathlons.

3. The opponent claims that there is a likelihood of confusion because the marks are similar, and the goods are identical or similar.

4. The applicant filed a counterstatement denying the claims made.

5. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20 (4) shall continue to apply. Rule 20 (4) states that:

“(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 these changes is to require the parties to seek leave in order to file evidence in fast track oppositions. No leave was sought to file any evidence in respect of these proceedings.

7. Rule 62 (5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) 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.

8. The opponent is represented by Baron Warren Redfern, and the applicant is represented by Law & Tech s.r.o. A hearing was neither requested nor considered necessary, however the opponent filed submissions in lieu. This decision is taken following a careful perusal of the papers.

9. 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 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.

DECISION

10. Section 5(2)(b) reads as follows:

“5(2) 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.”

11. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

(a) a registered trade mark ... or international trade mark (UK) ... 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,

(aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

(ab) a comparable trade mark (IR) or a trade mark registered pursuant to an application made under paragraph 28, 29 or 33 of Schedule 2B

which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

[...]"

12. Section 6A of the Act states:

“(1) This section applies where

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a),
(aa) or (ba) in relation to which the conditions set out in section 5(1),
(2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed
before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

[...]"

13. The trade mark upon which the opponent relies qualifies as an earlier trade mark because it was applied for at an earlier date than the applicant’s mark pursuant to section 6(1)(a) of the Act. As the opponent’s mark had not completed its registration process more than 5 years before the filing date of the mark in issue, it is not subject to proof of use pursuant to section 6A(1) and (1A) of the Act. The opponent is entitled to rely upon all of the goods for which the mark is registered.

Section 5(2)(b) case law

14. 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:

- (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

15. The competing goods are as follows:

| Opponent's goods | Applicant's goods |
|---|--|
| <u>Class 25</u> Sports footwear for running and triathlons; Sports clothing for running and triathlons; Shorts, Stockings, Tights, Muffs for the hands, Pedal pushers and Sliding shorts, Tee-shirts, Vest tops, | <u>Class 25</u> Bandanas; Belts for clothing; Blouses; Brassieres; Cardigans; Coats; Cravats; Dresses; Footwear; Gloves; Hats; Headwear; Jackets; Jerseys; Lingerie; Overalls; Overcoats; Pajamas; Panties; |

| | |
|---|--|
| <p>Sweat shirts, Jackets [clothing], Fleeeces, Cagoules, Gym suits, Jogging pants, Caps [headwear], Caps [headwear], Underwear, Socks, Headbands (clothing); All of the aforesaid goods being for running and triathlons.</p> | <p>Pants; Pullovers; Raincoats; Scarves; Shawls; Shirts; Skirts; Skirts; Socks; Stockings; Suits; Suspenders; Sweaters; Swimwear; T-shirts; Ties; Tops; Track suits; Trousers; Underpants; Undershirts; Vests; Waistcoats; all of the aforesaid not in connection with sportswear, sports clothing and sports items.</p> |
|---|--|

16. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. 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 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.”

17. Guidance on this issue has come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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

18. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“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 for 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.”

19. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

20. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary

and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

21. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

"I should add that I see no reason to give the word "cosmetics" and "toilet preparations"... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context."

22. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that "complementary" means:

"... there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think the responsibility for those goods lies with the same undertaking."

23. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected

undertakings. As Mr Daniel Alexander Q.C. noted, as the Appointed Person, *in Sandra Amalia Mary Elliot v LRC Holdings Limited*, BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes.” Whilst on the other hand: “... it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

Whilst on the other hand:

“... it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

24. Firstly, I note that both parties have limitations added to their specification. However, the applicant specifically added their limitation to their specification once opposition proceedings were initiated.

25. The use of limitations are specifically dealt with in case law by reference to what is known as the *POSTKANTOOR* principle. In *Omega SA (Omega AG) (Omega Ltd) v Omega Engineering Incorporated* [2012] EWHC 3440 (Ch), Arnold J. (as he then was) provided the following guidance on the application of the *POSTKANTOOR* principle.

“43. *The POSTKANTOOR principle.* In *POSTKANTOOR* the applicant applied to register the word *POSTKANTOOR* (Dutch for *POST OFFICE*) in respect of goods and services in Classes 16, 35–39, 41 and 42. The Benelux Trade Mark Office refused registration on the grounds that the sign was descriptive. On appeal, the *Gerechtshof te s’-Gravenhage* (District Court of The Hague) referred nine questions of interpretation of the Directive to the Court of Justice, of which the eighth was as follows:

“Is it consistent with the scheme of the Directive and the Paris Convention for a sign to be registered for specific goods or services subject to the limitation that the registration applies only to those goods and services in so far as they do not possess a specific quality or specific qualities (for example, registration of the sign ‘Postkantoor’ for the services of direct-mail campaigns and the issue of postage stamps, provided they are not connected with a post office’)?”

44. The Court of Justice answered this question as follows:

“113. ... when registration of a mark is sought in respect of an entire class within the Nice Agreement, the competent authority may, pursuant to Article 13 of the Directive, register the mark only in respect of some of the goods or services belonging to that class, if, for example, the mark is devoid of any distinctive character in relation to other goods or services mentioned in the application.

114. By contrast, where registration is applied for in respect of particular goods or services, it cannot be permitted that the competent authority registers the mark only in so far as the goods or services concerned do not possess a particular characteristic.

115. Such a practice would lead to legal uncertainty as to the extent of the protection afforded by the mark. Third parties — particularly competitors — would not, as a general rule, be aware that for given goods or services the protection conferred by the mark did not extend to those products or services having a particular characteristic, and they might thus be led to refrain from using the signs or indications of which the mark consists and which are descriptive of that characteristic for the purpose of describing their own goods.”

45. The guidance given by the Court of Justice must be seen in the context of the question to which it was addressed, namely whether it was acceptable to restrict the goods or services by reference to the absence of “a specific quality”.

What the District Court of The Hague meant by this can be seen from the example it gave, viz. “the services of direct mail campaigns and the issue of postage stamps provided that they are not connected with a post office”. When the Court of Justice referred in its answer to “a particular characteristic”, it must have meant the same thing as the District Court meant by “a specific quality”.

46. The application of this guidance has caused some difficulty in subsequent cases. In *Croom’s Trade Mark Application* [2005] R.P.C. 2 at [28]–[29] Geoffrey Hobbs QC sitting as the Appointed Person held that the *POSTKANTOOR* principle precluded the applicant from limiting a specification of goods in Classes 18 and 25 by adding the words “none being items of haute couture” or “not including items of haute couture”. He went on at [30] to refer to “characteristics that may be present or absent without changing the nature, function or purpose of the specified goods”. Mr Hobbs QC made the same distinction in *WISI Trade Mark* [2007] E.T.M.R. 5; [2006] R.P.C. 22 at [16].

47. In *Oska’s Ltd’s Trade Mark Application* [2005] R.P.C. 20 at [56] I observed *en passant* when sitting as the Appointed Person that I did not consider that it would be permissible to limit the specification by reference to the applicant’s intended target market.

48. In *MERLIN Trade Mark (BL O/043/05)* [1997] R.P.C. 871 at [27]–[28] I held when sitting as the Appointed Person held that the disclaimer “but not including the provision of venture capital” was acceptable, because it was not framed by reference to the absence of particular characteristics of the services, but rather it was a restriction on the scope of the services embraced by the specification. Accordingly, “the effect of [the disclaimer] is simply to excise a particular service from the specification. The mere fact that it is more convenient to express it in negative than positive terms does not make it objectionable.”

49. I also allowed a second disclaimer “and not including the provision of any such services to the pharmaceutical biotechnological [or] bioscientific sectors” for reasons which I expressed at [29] as follows:

“The position with regard to the second disclaimer is more debatable, but in my judgment the disclaimer does not relate to a characteristic of the services. I consider that there is a distinction between goods and services here. An article of clothing is an article of clothing regardless of whether it is of a particular style or quality and regardless of the identity and proclivities of the intended purchaser. By contrast, services can be defined in part by the recipient of the service. The opponent’s registration is an example of this, since both the Class 35 and the Class 36 specification are limited to services provided to the pharmaceutical biotechnological and bioscientific sectors. In my view *POSTKANTOOR* does not make it impermissible to define services in this way. That being so, I consider that it makes no difference if the definition is expressed negatively rather than positively.”

50. In *Patak (Spices) Ltd’s Community Trade Mark Application (R746/2005-4) [2007] E.T.M.R. 3* at [28] the Fourth Board of Appeal at OHIM refused to allow a proposed limitation “*none of the aforesaid being dart games or darts*” to a class 28 specification as offending the *POSTKANTOOR* principle. I find this decision difficult to follow, since the exclusion related to categories of goods, rather than the characteristics of goods. It appears that the objection may have been down to the fact that the exclusion was negatively worded, but as I explained in *MERLIN [1997] R.P.C. 871* that is a matter of form, not substance, and so should not have been determinative.”

And

“56. Against this background, counsel for Swiss submitted that the limitation “intended for a scientific or industrial application in measuring, signalling, checking, displaying or recording heat or temperature (including such having provision to record heat or temperature over a period of time and/or to display the time of day)” contravened the *POSTKANTOOR* principle because it purported to restrict the specification of goods by reference to whether the goods possessed particular characteristics.

57. I do not accept that submission for the following reasons. First, if and insofar as the *POSTKANTOOR* principle depends on the limitation being expressed in negative terms, the limitation in the present case is expressed in positive terms. Secondly, and more importantly, I do not consider that the limitation refers to whether the goods possess particular characteristics in the sense in which the Court of Justice used that term in *POSTKANTOOR*. Rather, the limitation refers to the functions of the goods. To revert to the analogy discussed above, it is comparable to a limitation of “clocks” to “clocks incorporating radios”. Accordingly, in my judgment it falls on the right side of the line drawn by Mr Hobbs QC in *Croom’s Trade Mark Application [2005] R.P.C. 2* and *WISI Trade Mark [2007] E.T.M.R. 5; [2006] R.P.C. 22.*”

26. Following the guidance given above, I find that the limitations in both specifications are *POSTKANTOOR* compliant and are acceptable because they exclude specific categories of goods within class 25.

27. Before the individual specification comparisons, I wanted to address the applicant’s submission that the opponent’s and applicant’s goods are aimed at different target groups in the market (cycling equipment market vs women’s clothing market). Albeit I will address this in more detail later in this decision, I consider that all of the opponent’s and applicant’s goods are types of clothing, whether in connection or not to sportswear. Therefore, the relevant market for these goods will be members of the general public. I consider that this user applies to all of the comparisons below.

Hats; Headwear; all of the aforesaid not in connection with sportswear, sports clothing and sports items.

28. I consider that the applicant’s above goods overlap with the opponent’s “caps [headwear]” “all of the aforesaid goods being for running and triathlons”. All of the goods are types of headwear which could be worn to either protect the user from the sun or for fashionable purposes. However, I also note that the applicant’s hats could also include those used for warmth such as a woolly hat. I therefore consider the goods overlap in user, nature, method of use and purpose. I also consider that there would be an overlap in distribution channels as general retail stores would sell all of the

goods, and they would be sold in the same aisle. The goods are not complementary, but they are in competition because the user could wear either goods whether for sporting activities or not. I am unaware of how to distinguish headwear, which is specifically being used for sport or not, and therefore I consider that the goods are identical. However, if I am wrong in this finding, I consider that the goods are similar to a very high degree.

Socks; all of the aforesaid not in connection with sportswear, sports clothing and sports items.

29. I consider that the applicant's above goods overlap with the opponent's "socks" "all of the aforesaid goods being for running and triathlons". All of the goods are socks, which would be worn on the feet of the user as a protection layer between the shoes and their feet. Therefore, I consider the goods overlap in user, nature, method of use and purpose. I also consider that there would be an overlap in distribution channels as general retail stores would sell both goods, and they would be sold in the same aisle. The goods are not complementary, but they are in competition because the user could wear either goods whether for sporting activities or not. I am unaware of how to distinguish socks which are specifically being used for sport or not. Therefore, I consider that the goods are identical. However, if I am wrong in this finding, I consider that the goods are similar to a very high degree.

Gloves; all of the aforesaid not in connection with sportswear, sports clothing and sports items.

30. I consider that the applicant's above goods overlap with the opponent's "muffs for the hands" "all of the aforesaid goods being for running and triathlons". All of the goods are used to keep the users hands warm, and most likely worn in the winter months. Therefore, I consider the goods overlap in user, nature, method of use and purpose. I consider that the goods would overlap in distribution channels as general retail stores would sell both the opponent's and applicant's goods. I also consider that they would be sold in the same aisle. The goods are not complementary, but they are in competition because the user could wear either goods whether for sporting activities or not. I do not consider that there would be any distinguishing differences between

gloves not in connection to sportswear and muffs which are used specifically for running and triathlons. Therefore, I consider that the goods are identical. However, if I am wrong in this finding, I consider that the goods are similar to a very high degree.

Footwear; all of the aforesaid not in connection with sportswear, sports clothing and sports items.

31. I consider that the applicant's above goods overlap with the opponent's "sports footwear for running and triathlons". All of the goods are footwear which would be worn on the users feet for protection. I therefore consider the goods overlap in user, nature, method of use and purpose. I consider that there would be an overlap in distribution and trade channels because both goods would be sold by the same footwear undertakings. Furthermore, I consider that these goods would be sold in the same aisle of general retail stores. However, I also appreciate that there will be some specialist running footwear undertakings which only focus on the production of running footwear. The goods are not complementary; however, I consider that they may be in competition as the user may choose to wear either/or footwear or running and triathlon specialised footwear as you do not need to be performing sporting activities in order to wear running shoes because they can also be used for walking, for example. Taking the above into account, I consider that the goods are similar to a high degree.

Sweaters; all of the aforesaid not in connection with sportswear, sports clothing and sports items.

32. I consider that the applicant's above goods overlap with the opponent's "sweat shirts" "all of the aforesaid goods being for running and triathlons". All of the goods are to be worn and covers the upper part of the users body and their arms, to keep them warm. I also note that they may be worn for fashionable purposes. Therefore, they overlap in user, nature and method of use. However, I appreciate that the specific purpose will differ for the opponents goods because they are to be worn "for running and triathlons", and therefore sweat shirts are made from cotton to "absorb sweat during or after exercise."¹ I consider that all of the goods would be sold in the same

¹ <https://www.collinsdictionary.com/dictionary/english/sweat-shirt>

aisle of general retail stores. The goods are not complementary, but they are in competition because the user could wear either goods whether for sporting activities or not. Therefore, I consider that the goods are similar to a high degree.

Brassieres; Lingerie; Panties; Pants; Stockings; Underpants; all of the aforesaid not in connection with sportswear, sports clothing and sports items.

33. I consider that the applicant's above goods overlap with the opponent's "underwear", "stockings" and "tights" "all of the aforesaid goods being for running and triathlons". All of the goods are types of underwear. Therefore they overlap in nature, method of use and user as they are to be worn by the general public to cover intimate parts of the body. I consider that the goods would overlap in distribution channels as general retail stores would sell both sports underwear and non-sports underwear. There would be an overlap in purpose, as they are all underwear which would provide protection and support. However, I appreciate that the specific purpose will differ for the opponents goods because they are to be worn "for running and triathlons" and therefore the goods may be made out of sweat-resistant material, or made to be more supportive. I do not consider that the goods are complementary, however, I consider that they would be in competition because the general public could wear either the underwear which is specifically used for sporting purposes or non-sporting purposes in any circumstances because you do not need to be performing sporting activities in order to have to wear sport specific underwear. Taking all of the above into account, I consider that the goods are similar to a high degree.

Cardigans; Coats; Jackets; Overcoats; Pullovers; Raincoats; all of the aforesaid not in connection with sportswear, sports clothing and sports items.

34. I consider that the applicant's above goods overlap with the opponent's "jackets [clothing]" and "cagoules" "all of the aforesaid goods being for running and triathlons". All of the goods are types of coats/jackets which would be worn over other items of clothing to protect the general public from the weather, such as the rain, or to keep them warm. Consequently, they will overlap in nature, method of use and user. I also consider that they would overlap in purpose, albeit the opponent's goods' specific purpose is that they can be worn for sports purposes and therefore could be made out

of a more breathable material. I consider that there would be an overlap in distribution channels as general retail stores would sell all of the goods. I do not consider that the goods are complementary, however, I consider that they would be in competition because the general public could use either the coats/jackets which is specifically used for sporting purposes or non-sporting purposes in any circumstances. The user does not have to be performing sporting activities in order to wear a jacket designed for sport, it could also be worn for fashion purposes. Therefore, taking all of the above into account, I consider that the goods are similar to a high degree.

Blouses; Jerseys; Shirts; T-shirts; Tops; Undershirts; Vests; all of the aforesaid not in connection with sportswear, sports clothing and sports items.

35. I consider that the applicant's above goods overlap with the opponent's "tee-shirts" and "vest tops" "all of the aforesaid goods being for running and triathlons". All of the goods are types of tops which a user would wear on the top half of the body. Consequently, they will overlap in nature, method of use and user. I also consider that they would overlap in purpose, albeit the opponent's goods can be specifically used for sports purposes, and therefore may be made from lighter fabrics which are more breathable. I consider that general retail stores would sell all of the goods. Therefore they overlap in distribution channels. I consider that the goods could be in competition because a user could wear a sporting top without performing sporting activities, and vice versa. However the goods are not in complementary. Taking all of the above into account, I consider that the goods are similar to a high degree.

Track suits; all of the aforesaid not in connection with sportswear, sports clothing and sports items.

36. I consider that the applicant's above goods overlap with the opponent's "sports clothing for running and triathlons". I consider sports clothing would include track suits which are used for sporting purposes. I consider that all of the goods are clothing, and therefore would be worn by the general public. However, I consider that the opponent's goods may be made of a lighter-weight, more breathable material to satisfy its sporting purposes. Therefore, I consider that the goods would overlap in user, nature and method of use, however, they would differ to some extent in purpose. I consider that

there would be an overlap in trade channels because general retail stores would sell all of the goods. The goods are not complementary; however, they may be in competition because a user could wear either/or the opponent's and applicant's goods regardless of whether they are using it to perform sporting activities in. Alternatively, it could be worn for fashion purposes. Therefore I consider that the goods are similar to a high degree.

Trousers; all of the aforesaid not in connection with sportswear, sports clothing and sports items.

37. I consider that the applicant's above goods overlap with the opponent's "jogging pants" "all of the aforesaid goods being for running and triathlons". I consider that jogging bottoms are a type of trousers as the goods are to be worn on the bottom half of the user's body, and would most typically cover from the waist to the ankle. Consequently, they will overlap in nature, method of use and user. I consider that general retail stores would sell all of the goods. Therefore they overlap in distribution channels. I am unaware of how to distinguish jogging bottoms which are specifically being used for sport or not. Therefore, I consider that the goods could be in competition because jogging bottoms or trousers could be worn by the user interchangeably. Taking all of the above into account, I consider that the goods are similar to a high degree.

Skirts; Skirts; all of the aforesaid not in connection with sportswear, sports clothing and sports items.

38. I consider that the applicant's above goods overlap with the opponent's "shorts" "all of the aforesaid goods being for running and triathlons". I consider that both goods are worn on the lower half of the user's body and would most typically cover from the waist to the thigh. However, I note that shorts cover each leg separately, whereas a skirt does not. I also appreciate that the opponent's goods could be made out of a lighter weight material appropriate for sporting activities. Consequently, I consider that the goods overlap in method of use and user, as well as to some extent overlap in nature and purpose. I also consider that general retail stores would sell all of the goods. Therefore they overlap in distribution channels. However, I do not consider that

the goods are complementary nor in competition as it is unlikely that a user would choose to do sports in a non-sportswear skirt. Taking the above into account, I consider that the goods are similar to between a medium to high degree.

Swimwear; all of the aforesaid not in connection with sportswear, sports clothing and sports items.

39. I consider that the applicant's above goods overlap with the opponent's "underwear" "all of the aforesaid goods being for running and triathlons". Both underwear and swimwear overlap in nature, method of use and user as they are to be worn by the general public to cover intimate parts of the body. I also consider that the goods would overlap in distribution channels as general retail stores would sell both sports underwear and swimwear. However, the goods would not overlap in purpose as swimwear is specially used to swim in and the opponent's goods are used for sporting purposes. I do not consider that the goods are in competition, or complementary. Consequently, I consider that the goods are similar to at least a medium degree.

Bandanas; all of the aforesaid not in connection with sportswear, sports clothing and sports items.

40. I consider that the applicant's above goods overlap with the opponent's "caps [headwear]" "all of the aforesaid goods being for running and triathlons". I note that a bandana is a piece of cloth which is to be worn around a person's neck or head.² Therefore, I consider that all of the goods would be worn on the users head, and both can be used as fashion accessories. However, I note that the opponent's goods would also protect the users face and eyes from the sun. Consequently, I consider that the goods would overlap in nature and method of use. I also consider that the goods would overlap in purpose to the extent they can both be worn as fashion accessories. I also consider that the goods would be sold in the same general retail stores. However, I do not consider that the goods are complementary, nor do I consider that they would be

² <https://www.collinsdictionary.com/dictionary/english/bandanna>

in competition. Taking the above into account, I consider that the goods are similar to a medium degree.

Scarves; all of the aforesaid not in connection with sportswear, sports clothing and sports items.

41. I consider that the applicant's above goods overlap with the opponent's "muffs for hands" for "running and triathlons". I consider that these goods share the purpose of being worn as accessories which keep the user warm. However, I appreciate that scarves are designed to keep the neck warm, whereas muffs will keep the hands warm. I also consider that the goods would be sold by the same undertakings, in general retail stores, in the same aisle. Therefore, the goods overlap in user, method of use and trade channels. However, the goods differ in nature, and the goods are neither in competition nor complementary. I therefore find these goods similar to a medium degree.

Shawls; all of the aforesaid not in connection with sportswear, sports clothing and sports items.

42. I consider that shawls are very similar items of clothing to scarves, and therefore the applicant's above goods overlap with the opponent's "muffs for hands" for "running and triathlons". I consider that these goods share the purpose of being worn as accessories with the purpose of keeping the user warm. I note that shawls are designed to keep the upper body of the user warm, whereas muffs will keep the hands warm. I also consider that all of the goods would be sold in general retail stores, in the same aisle. Therefore, the goods overlap in user, method of use, trade channels and purpose. However, the goods differ in nature, and the goods are neither in competition nor complementary. I therefore find these goods similar to a medium degree.

Dresses; all of the aforesaid not in connection with sportswear, sports clothing and sports items.

43. I consider that the applicant's above goods overlap with all of the opponent's goods for "running and triathlons". All of the goods are types of clothing that will be worn by

the user, for both practical and fashionable purposes. They therefore overlap in user. I also consider that they overlap in method of use and purpose as they are to be worn as clothing. However, I note that opponent's goods are to be worn for running and triathlons. The goods to some extent will overlap in nature as the opponent's goods either cover the top halves or the bottom half of the person, whereas the applicant's dresses cover both halves. I consider that there will be an overlap in distribution channels as all of the goods would be sold in general retail stores, and are likely to be found in close proximity within these establishments. I do not consider that the goods are complementary nor in competition. Consequently, I consider that that the goods are similar to a medium degree.

Overalls; all of the aforesaid not in connection with sportswear, sports clothing and sports items.

44. I consider that the same comparison applies as above in paragraph 43. However, I acknowledge that the bottom half of overalls cover each leg separately, whereas a dress does not. Therefore, I consider that that the goods are similar to a medium degree.

Suits; all of the aforesaid not in connection with sportswear, sports clothing and sports items.

45. I consider that the applicant's above goods overlaps with all of the opponent's goods for "running and triathlons". All of the goods are types of clothing that will be worn and covers both the top and bottom half of the user. Therefore, they overlap in user, nature and method of use. I consider that the goods also may overlap in purpose as they can all be worn for fashionable purposes. However, applicant's goods are to be worn to more formal occasions whereas opponent's goods would be worn for sporting purposes. I consider that there will be an overlap in distribution channels as all of the goods would be sold in general retail stores, but not in the same aisle. I do not consider that the goods are complementary nor in competition. Consequently, I consider that that the goods are similar to no more than a medium degree.

Pajamas; all of the aforesaid not in connection with sportswear, sports clothing and sports items.

46. I consider that the applicant's above goods overlaps with all of the opponent's goods for "running and triathlons". All of the goods are types of clothing that will be worn by the general public, and therefore they will overlap in method of use and user. However, "pajamas" are specifically worn in bed as nightwear and the opponent's goods are specifically sportswear. Therefore, I consider that the goods would be made out of different materials, with "pajamas" made from silks and cottons whereas the applicant's goods being made from more breathable and light-weight materials. I also consider that there is a very limited overlap in nature and purpose. I consider that there will be an overlap in distribution channels as all of the goods would be sold in general retail stores but not in the same aisle. I do not consider that the goods are complementary nor in competition. Therefore, I consider that the goods are similar to between a low and medium degree.

Waistcoats; all of the aforesaid not in connection with sportswear, sports clothing and sports items.

47. I consider that the applicant's above goods overlap with the opponent's "jackets [clothing]" "all of the aforesaid goods being for running and triathlons". I consider that both goods are worn by the general public, over other layers of clothing such as shirts and tops. I note that jackets, specifically those which are for running and triathlons, would be used to keep the user dry and protected from the weather, as well as could be worn for fashionable purposes. Waistcoats can be worn both for casual and formal occasions, albeit is more likely to be worn with a suit. I also note that a jacket could be worn over a waistcoat. Therefore, I consider that the goods overlap in user, but there is limited overlap in purpose and method of use. I consider that the goods may overlap in distribution channels as general retail stores would sell all of the above goods, but located in different aisles. The goods are not in competition nor are they complementary. Therefore, I consider that the goods are similar to between a low and medium degree.

Belts for clothing; Suspenders; all of the aforesaid not in connection with sportswear, sports clothing and sports items.

48. I consider that the applicant's above goods has limited overlap with all of the opponent's clothing goods for "running and triathlons". Belts are used hold up garments, such as a pair of trousers or a skirt, but they can also be used for purely for fashionable purposes. I note that suspenders are also used to hold up garments because they are "a pair of straps that go over someone's shoulders and are fastened to their pants at the front and back to prevent the pants from falling down".³ The opponent's goods are used to be worn and cover up the users body, and as highlighted by the limitation, also to be worn for running and triathlons. I also accept that the opponent's goods can also be worn for fashionable purposes. Although both goods are to be worn on the body, they are to be worn in such a different way that I do not consider that they overlap in method of use. The goods will likely be selected by the same users and sold through the same distribution channels. However, the physical nature of the goods will differ. The goods are neither competitive nor complementary. I therefore find these goods similar to a low degree.

Cravats; ties; all of the aforesaid not in connection with sportswear, sports clothing and sports items.

49. I consider that the applicant's above goods has limited overlap with all of the opponent's goods for "running and triathlons". I consider that the applicant's above goods are accessories that are to be worn by the average consumer. I also consider that they would be worn to a formal occasion as a fashion accessory. The opponent's goods are more likely to be worn for sporting purposes, or for fashionable purposes. Therefore, there is limited overlap in purpose and method of use. I consider that there would be an overlap in user and the goods would all be sold in general retail outlets, but not in the same aisle. I also do not consider that there is an overlap in nature. The goods are neither competitive nor complementary. Consequently, I consider the goods are similar to a low degree.

³ <https://www.collinsdictionary.com/dictionary/english/suspenders>

The average consumer and the nature of the purchasing act

50. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. 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.”

51. As highlighted above, the average consumer for the goods will be members of the general public. The cost of purchase is likely to vary, from an inexpensive pair of socks to an expensive pair of running trainers. I also note that the goods will be purchased relatively frequently.

52. However, various factors are still likely to be taken into account during the purchasing process, such as materials used, cut, aesthetic appearance and durability. Consequently, I consider that a medium degree of attention will be paid by the average consumer when selecting the goods.

53. The goods are likely to be obtained by self-selection from the shelves of a retail outlet, online or catalogue equivalent. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there will also be an aural component to the purchase, as advice may be sought from a sales assistant or representative.

Comparison of the trade marks

54. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade 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.”

55. 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.

56. The respective trade marks are shown below:

| Opponent's trade mark | Applicant's trade mark |
|-----------------------|------------------------|
| EKOï | E K O L |

57. The opponent's mark consists of the word EKOÏ. There are no other elements to contribute to the overall impression which lies in the word itself.

58. The applicant's mark, while a figurative mark, consists of the word EKOL in a standard typeface. I consider the word EKOL plays a greater role in the overall impression of the mark with the stylisation playing a lesser role.

59. Visually, the marks coincide in the presence of the letters E, K and O at the beginning of both marks. As a general rule, the beginning of the marks tend to make more impact than the ends, especially as words are read from left to right.⁴ These all act as visual points of similarity.

60. I note that the opponent's mark ends in the letter Ï and the applicant's mark ends in the letter L. These act as visual points of difference. However, I consider that both letters share the vertical line which is predominant in the letters. Therefore, the only difference between the marks lies in the horizontal line on the bottom of the L and the double tittle on top of the Ï. I also bear in mind that registration of a word only mark covers use in any standard typeface. I do not, therefore, consider that the slight stylisation of the applicant's mark creates a real point of difference between them. Taking the above into account, I consider that the marks are visually similar to a high degree.

61. Aurally, I have not been provided with submissions from either party as to how the opponent's mark would be pronounced. I consider that the opponent's mark will be pronounced as EK-OI. I consider that the applicant's mark will be pronounced as EK-OL. As the marks share the first syllable, and the "O" element of the second syllable, I consider that the marks are aurally similar to a high degree.

62. Conceptually, I have not been provided with submissions from either party as to what concepts would be assigned to the opponent's and applicant's marks. I consider that both the opponent's and the applicant's marks, when viewed as a whole, are likely

⁴ *El Corte Ingles, SA v OHIM*, Cases T-183/02 and T-184/02

to be viewed as invented words which would be attributed no particular meaning. Taking the above into account, I consider the marks to be conceptually neutral.

Distinctive character of the earlier trade mark

63. 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 C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, 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 promotion of 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).”

64. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

65. As the opponent has not filed any evidence to show that the distinctiveness of its mark has been enhanced through use, I only have the inherent position to consider.

66. As highlighted above, I consider that the word EKOÏ will be viewed as an invented word which is neither allusive nor descriptive in relation to the goods for which the mark is registered. Therefore, I consider the opponent's mark to be inherently distinctive to a high degree.

Likelihood of confusion

67. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

68. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the marks to be visually similar to a high degree.
- I have found the marks to be aurally similar to a high degree.
- I have found the marks to be conceptually neutral.
- I have found the opponent's mark to be inherently distinctive to a high degree.

- I have identified the average consumer to be members of the general public who will select the goods primarily by visual means, although I do not discount an aural component.
- I have concluded that a medium degree of attention will be paid during the purchasing process for the goods.
- I have found the parties' goods to be identical to similar to a low degree.

69. Taking all of the factors listed in paragraph 68 into account, bearing in mind that the opponent's mark is highly distinctive and the principle of imperfect recollection, I consider that the marks are likely to be mistakenly recalled or misremembered as each other. This is particularly the case given the high visual similarity between the marks and the predominantly visual purchasing process. Even where aural considerations play a greater role, the higher aural similarity between the marks will have the same result.

70. I consider that the beginnings of marks tend to make more of an impact than the ends. Therefore, I consider that because the marks share the same beginnings, (EKO), the singular end letter of the opponent's and applicant's marks would be overlooked by the average consumer. The visual similarities between the last letters, both sharing the predominant vertical line furthermore highlights that they could be easily mistaken, with the horizontal line at the bottom of the letter L or double tittle on the letter ĩ being easily overlooked.

71. Lastly, I consider that, in the absence of any conceptual hook in either of the marks, the average consumer will not have a strong conceptual message to assist them in differentiating between the opponent's and applicant's marks. In my view, this results in a likelihood of direct confusion, even where there is only a low degree of similarity between the goods, due to the effect of the interdependency principle.

CONCLUSION

72. The opposition is successful in its entirety and the application is refused.

COSTS

73. Award of costs in fast track proceedings are governed by TPN 2/2015. The opponent has been successful and is entitled to a contribution towards her costs. In the circumstances, I award the opponent the sum of **£500** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

| | |
|--|-------------|
| Filing a Notice of opposition and considering the applicant's counterstatement | £200 |
| Preparing and filling written submissions in lieu | £200 |
| Official Fee | £100 |
| Total | £500 |

74. I therefore order EKOL GİYİM SANAYİ VE TİCARET LİMİTED ŞİRKETİ to pay JCR the sum of £650. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 17th day of August 2022

L FAYTER

For the Registrar