

O-175-09

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NOs 2421554 and 2421555
BY MICHAEL CAUNTER AND EMILY BOTHWELL
TO REGISTER THE TRADE MARKS**



AND



IN CLASSES 25 AND 35

AND

**IN THE MATTER OF OPPOSITION NOs 95820 AND 95813
BY BLUSTUFF LIMITED**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application Nos 2421554 and 2421555
By Michael Caunter and Emily Bothwell
To register trade marks in classes 25 and 35**

And

**In the matter of opposition Nos 95820 and 95813
By Blustuff Limited**

Background

1. On 10 May 2006, Michael Caunter and Emily Bothwell (“the joint applicants”) applied to register the following trade marks:

No: 2421554



No: 2421555



for the following goods and services:

Class 25:


Clothing, footwear and headgear.

Class 35:

Retail services in connection with clothing, footwear and headgear; mail order retail services in connection with clothing, footwear and headgear; online retail services in connection with clothing, footwear and headgear.

2. On 21 December 2007, Moocow Limited (“ML”) filed notices of opposition against the applications based on grounds under Section 5(2) (b) of the Trade Marks Act 1994 (“The Act”).

3. On 4 June 2009, following completion of the evidence rounds, Moocow Limited (“ML”) informed the Registrar that it had assigned its rights in its trade marks to Blustuff Limited (“BL”). BL is therefore the registered proprietor of the earlier marks and the opponent in these proceedings. However, this decision will continue to refer to Moocow Limited as it is the entity that filed evidence and made submissions in support of the opposition. Details of the earlier marks relied upon are shown below:

No	Mark	Class	Good relied on
UK TM 2376368		25	Clothing, footwear, headgear; ladies lingerie and underwear; tights, stockings; tee-shirts; sports wear; leisure wear; scarves; night wear, night dresses, pyjamas, negligees; caps.
CTM ¹ 2190320	PEEK-A-BOO	25	Clothing, footwear, headgear
CTM 4881595		25	Clothing, footwear, headgear

4. The joint applicants filed counterstatements denying the grounds of opposition.

5. Both sides filed evidence which is summarised below. Neither side requested a hearing. Both filed written submissions at some stage in the proceedings. Although these proceedings have not been formally consolidated, I note that the basis of both oppositions is the same, with the same earlier marks being relied upon. In addition,

¹ Community Trade Mark

both the joint applicants and ML filed one set of evidence and submissions. I will, therefore, issue a single decision, covering both applications.

ML's evidence

6. This consists of two witness statements, from Mr Michael Aldridge, the managing director of ML, the registered proprietor of the earlier marks which form the basis of the opposition, prior to the assignment to BL. He says that ML's marks were traded and used through a wholly owned subsidiary of ML, Peekaboo Pole Dancing Limited, of which he is also the managing director. Mr Aldridge claims that the ML Peekaboo marks, have been in continuous use in the UK in relation to clothing and headgear since at least 2004. Figures are given outlining the annual expenditure on advertising and promoting goods under the marks, which are shown below:

Year	Annual Amount
2004	£24,181
2005	£53,296
2006	£62,402
1 January 2007 to 21 September 2007	£11,051

7. Between 2004 and 2007, ML exhibited at a number of trade shows in the UK. These were Erotica in Olympia London in 2004 and 2005, the Spring and Autumn Fairs in Birmingham in 2005, the Clothes Show Live in Birmingham in 2006 and the London Edge in London in February 2007. Exhibit MA1 are copies of invoices issued by the organisers of these events for the stand space occupied by ML. Exhibit MA2 consists of copies of forms that ML were required to complete for these events, declaring that they intended to exhibit and sell clothing. Exhibit MA3 consists of photographs of the ML stand at some of these trade shows. Exhibit MA4 contains a booklet showing the ML products; this was used at the Clothes Show Live in 2006 and updated and used at the London Edge show in 2007. Exhibit MA5 shows a promotional flyer produced for the Clothes Show Live exhibition in 2006. Mr Aldridge points out that though this flyer refers to the 2007 "collection", the exhibition took place in December 2006.

8. Exhibit MA6 contains promotional literature called a "lookbook" which was used to promote the 2007 Peekaboo collection, together with an invoice dated 9 February 2007 for the supply of the lookbooks. The lookbooks were sent to trade buyers prior to the 2007 shows and given out at the show itself.

9. Mr Aldridge explains that goods are sold both to trade customers and the general public at trade shows and through the Peekaboo website. Exhibit MA7 shows copies of invoices to trade customers, copies of dispatched orders made through the website and copies of sales receipts for sales made direct to the public at trade shows. The dates of some of these documents are unclear; however, I note that the majority are dated before the date of application.

10. Exhibit MA8a consists of documents confirming the registration of the domain name www.peekaboo.co.uk and Exhibit MA8b contain clothing pages from what Mr Aldridge refers to as the "office working copy" of the website, presumably meaning an internal version or a pre launch version (though this is unclear). The website was

launched in January 2006 and it has been possible to purchase goods from the website from that date. On 15 December 2007, www.peekaboopalace.com replaced the www.peekaboo.co.uk domain name.

11. ML also operates the website www.peekaboopedancing.com which was first launched on 9 September 2004 and it was possible to purchase goods from the website on that date. The range of clothing offered for sale on this website mirrors that offered on the www.peekaboo.co.uk website (as shown in Exhibit MA8b).

12. Exhibit MA9 contains a sample of one of the t-shirts supplied to customers. This shows use of the trade mark on the label and the swing ticket as well as use of the trade mark on the label applied to the packaging.

The joint applicants' evidence

13. This is a witness statement from one of the joint applicants, Mr Michael Caunter. The majority of the statement is submission which I will not summarise here. Rather I will make reference to his key arguments where appropriate in my decision. Mr Caunter also explains that evidence of the joint applicants' trading activities have already been supplied to the Registrar at examination stage, though I note that this is not evidence in these proceedings as it has not been included, either as part of the witness statement or the exhibits. Mr Caunter goes on to provide what he terms "further evidence" in support of the joint applicants' trading activities. Exhibit MC1 shows a copy of its unaudited accounts. These show the following sales figures:

Year	Sales
2000	£14,212
2001	£25,221
2002	£89,845
2003	£231,321
2004	£470,324
2005	£733,426
2006	£732,191

14. Mr Caunter explains that goods sold under the joint applicants' Peekaboo marks have been sold in fashion stores owned by the Arcadia Group since 30th March 2001, in particular within the High Street retail chain TOPSHOP. Exhibit MC2 is a copy of an email from the Arcadia group referring to this agreement which was signed by Emily Bothwell (the other applicant). Exhibit MC2a shows photographs taken inside TOPSHOP showing the display of the Peekaboo vintage range of fashion articles and accessories. Exhibit MB2b consists of a copy of a website article about TOPSHOP and its trade in vintage clothing. In this regard, Peekaboo is mentioned as one of the vintage clothing brands currently stocked by TOPSHOP.

DECISION IN RELATION TO APPLICATION 2421554

Proof of use regulations

15. I note that the proof of use regulations² apply to ML's earlier CTM 2190320 and that the joint applicants requested proof of use of this registration. However, as ML have two other earlier marks, to which the proof of use regulations do not apply, I will consider the opposition in relation to them and will return to CTM 2190320 only if necessary.

The law and the leading authorities

16. Section 5(2) of the Act states:

“(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.”

17. When making my determination, I take into account the guidance from the case-law of the European Court of Justice (“ECJ”) on this issue, notably: *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Case C-120/04 Medion (2005) ECR I-8551* and *Case C-334/05P Shaker di Laudato & C.Sas v OHIM (“LIMONCHELLO”)*. It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,⁶

² See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods and services, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,
- (f) the assessment of similarity can only be carried out solely on the basis of the dominant element in a mark if all of its other components are negligible (*Limonchello, para 42*)
- (g) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*,
- (h) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,
- (i) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,
- (j) further, 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; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,
- (k) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,
- (l) in comparing marks, one of which is a composite mark, it is possible that the overall impression of the composite mark is dominated by one or more of its components (*Case C-3/03P, Matratzen Concord v OHIM, para 32 and Case C- 120/04 Medion, para 29*),
- (m) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of

the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

(n) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*.

Average consumer and the purchasing act

18. As the ECJ stated in *Sabel BV v. Puma AG*, matters must be judged through the eyes of the average consumer. I must, therefore, assess who this is. The respective goods in question are consumer items - clothing, footwear and headgear at large. The applications also include retail services for the sale of clothing in class 35. It is clear, therefore, that the average consumer for the goods and services is the public at large.

19. In relation to items of clothing, the case law³ informs me that it is the visual impression of the marks that is the most important bearing in mind the manner in which such goods will normally be purchased. This would normally be from a clothes rail, a catalogue or a web-site rather than by oral request. Notwithstanding this, aural and conceptual considerations remain important and should not be ignored completely. As the average consumer is the general public and these are consumer items/consumer services, I would normally expect the average consumer to display a reasonable degree of care and attention during the purchasing process.

Comparison of the goods

20. All relevant factors should be taken into account in determining whether or not the respective goods and services are similar. As the ECJ stated at paragraph 23 in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*:

“.....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”.

³ See, for example, *Société provençale d'achat and de gestion (SPAG) SA v OHIM* Case T-57/03 and *React Trade Mark* [2000] RPC 285.

21. The goods and services under comparison are:

ML's specification	The joint applicants' specification
<p>UK TM 2376368:</p> <p>Class 25:</p> <p>Clothing, footwear, headgear; ladies lingerie and underwear; tights, stockings; tee-shirts; sports wear; leisure wear; scarves; night wear, night dresses, pyjamas, negligees; caps.</p> <p>CTM 4881595:</p> <p>Class 25:</p> <p>Clothing, footwear, headgear</p>	<p>Class 25:</p> <p>Clothing, footwear and headgear.</p> <p>Class 35:</p> <p>Retail services in connection with clothing, footwear and headgear; mail order retail services in connection with clothing, footwear and headgear; online retail services in connection with clothing, footwear and headgear.</p>

22. The joint applicants make two key submissions. Firstly, that ML's evidence illustrates that its core business is in relation to pole dancing kits, erotic games and associated merchandise. Secondly, ML's goods are clearly marketed for the "pole dancing/lap dancing/sex industry" which differentiates them from the joint applicants' goods which are targeted at the general fashion market.

23. It may be true that ML's core business is in relation to pole dancing kits and games. However, the correct comparison to be made in these proceedings is based upon ML's earlier marks which cover clothing, footwear and headgear. The joint applicants, in submission, appear to be seeking to draw a distinction between the respective markets within which the parties currently operate. This distinction is not reflected in the respective specifications (and indeed, cannot be). In this regard, I am mindful of the guidance provided by the following cases:

a) In *McQUEEN CLOTHING CO Trade Mark Application* [2005] RPC 2, where, at paragraph 31, Geoffrey Hobbs (sitting as the appointed person), stated:

"When assessing the objections to registration in the present case, it is necessary to assume normal and fair use of the marks for which registered trade mark protection has been claimed. The context and manner in which the marks have actually been used by the applicant and the opponent in relation to the goods of the kind specified may be treated as illustrative (not definitive) of the normal and fair use that must be taken into account".

b) The CFI⁴ in *Saint-Gobain SA v OHIM* (Case T-364/05) stated:

"67..... Furthermore, it is important to reiterate that the comparison between the goods in question is to be made on the basis of the description of the goods

⁴ The Court of First Instance of the European Communities

set out in the registration of the earlier mark. That description in no way limits the methods by which the goods covered by the earlier mark are likely to be marketed.”

c) In *Devinlec Developpement Innovation Leclerc SA v OHIM* Case T-147/03, the CFI stated:

“104 Consideration of the objective circumstances in which the goods covered by the marks are marketed are fully justified. The examination of the likelihood of confusion which the OHIM authorities are called on to carry out is a prospective examination. Since the particular circumstances in which the goods covered by the marks are marketed may vary in time and depending on the wishes of the proprietors of the trade marks, the prospective analysis of the likelihood of confusion between two marks, which pursues an aim in the general interest, that is, the aim that the relevant public may not be exposed to the risk of being misled as to the commercial origin of the goods in question, cannot be dependent on the commercial intentions, whether carried out or not, and naturally subjective, of the trade mark proprietors.”

24. The net effect of these cases is that I must consider the specifications of ML as registered. A specification cannot reflect the relative expense of the goods as marketed, nor can it reflect the exact market targeted by the goods. The guidance also makes clear that circumstances can change in that a trade mark registration can be used in an altogether different market from that which was first envisaged. In any event, I note from ML’s evidence that its marks have been used at events which do target a more general fashion market, such as the clothes show. I am not persuaded by the joint applicants’ argument. My analysis of the specifications must be based on ML’s terms as registered.

25. Comparing the respective goods first of all, I note that the class 25 goods of ML’s earlier marks and the joint applicants’ marks are expressed in identical terms. I need say nothing further. The goods are self evidently identical.

26. In comparing the class 35 services of the joint applicants with the class 25 goods of ML, I am mindful of the judgment of the CFI in *Oakley v OHIM, Case T-116/06* where the court said:

“53 In that regard, it must be pointed out that the goods covered by the earlier mark, that is clothing, headwear, footwear, rucksacks, all-purpose sports bags, travelling bags and wallets, are identical to those to which the applicants’ services relate.

54 Clearly, in the present case, the relationship between the retail services and the goods covered by the earlier trade mark is close in the sense that the goods are indispensable to or at the very least, important for the provision of those services, which are specifically provided when those goods are sold. As the Court held in paragraph 34 of *Praktiker Bau-und Heimwerkermarkte*, paragraph 17 above, the objective of retail trade is the sale of goods to consumers, the Court having also pointed out that that trade includes, in addition to the legal sales transaction, all activity carried out by the trader for the purpose of encouraging the

conclusion of such a transaction. Such services, which are provided with the aim of selling certain specific goods, would make no sense without the goods.

55 Furthermore, the relationship between the goods covered by the earlier trade mark and the services provided in connection with retail trade in respect of goods identical to those covered by the earlier trade mark is also characterised by the fact that those services play, from the point of view of the relevant consumer, an important role when he comes to buy the goods offered for sale.

56 It follows that, because the services provided in connection with retail trade, which concern, as in the present case, goods identical to those covered by the earlier mark, are closely connected to those goods, the relationship between those services and those goods is complementary within the meaning of paragraphs 54 and 55 above.....

62 It follows from all of the foregoing that the Board of Appeal was right to consider that services consisting of “retail and wholesale of clothing, headwear, footwear, athletic bags, backpacks and knapsacks and wallets”, and “retail and wholesale services, including on-line retail services”, are similar to the goods covered by the earlier trade mark”.

27. These principles can be applied directly to these proceedings. The retail services of the joint applicants are in relation to clothing, footwear and headgear. The goods being retailed are the goods covered by ML’s earlier marks. I conclude, therefore, that the services of the joint applicants are similar to the goods of ML.

Distinctiveness of the earlier mark

28. The guidance in *Sabel BV V. Puma AG* is that there is a greater likelihood of confusion where the earlier trade mark has a high degree of distinctive character, either per se or because of the use that has been made of it.




29. ML’s marks essentially comprise the word peekaboo, though there are additional words and/or device elements present in the two earlier marks I am considering first. The word peekaboo, though an ordinary dictionary word with a defined meaning, is not meaningful in relation to the goods. I, therefore, consider it to have a reasonably high degree of distinctive character, per se.

30. What impact does the evidence of use filed by ML have on this assessment? I am of the view that it has little effect. This evidence is insufficient to show that ML has a reputation under the marks and that it is known to a significant proportion of the relevant public, and it is therefore not entitled to claim enhanced distinctive character for its earlier marks, above and beyond its inherent distinctiveness.

Comparison of the marks

31. In assessing this aspect, I must consider the visual, aural and conceptual similarities between the respective trade marks and bear in mind their distinctive and dominant components (*Sabel Puma BV v. Puma AG, para 23*).

32. For ease of reference, the respective marks are reproduced below:

ML's earlier marks	The joint applicants' marks
<p data-bbox="193 495 440 524">UK TM 2376368:</p>  <p data-bbox="193 846 408 875">CTM 4881595:</p> 	

Comparison with ML's earlier mark 2376368

33. Visually, I note that both marks contain the work peekaboo, but both have additional elements (devices and/or additional words) which have an impact, on visual impression. I note that the device elements of both are female characters, each of whom can accurately be described as in a state of undress. ML's mark also has the words "pole dancing" and what seems to be a device of a pole. Both marks also use different typefaces for the word peekaboo. However, to my mind, peekaboo is the dominant and distinctive element of both trade marks, which, inevitably creates a degree of visual similarity (indeed a strong degree). However, the additional (and different) elements of both are unlikely to go unnoticed; therefore the overall degree of visual similarity is, in my view, a reasonable degree of similarity.

34. Aurally, it seems to me that it is possible that both marks would be referred to as "peekaboo" marks, with the additional words in ML's mark not being pronounced. However I cannot discount the fact that ML's mark may be referred to in its entirety,

particularly as it has the appearance of a complete phrase. However, as peekaboo is the dominant and distinctive element of both marks, I consider there to be a reasonable degree of aural similarity between them.

35. Conceptually, I must consider whether either or both of the marks have a defined meaning. Peekaboo is a reference to an object permanence game, normally played with babies, where the older player hides his/her face and then reveals it again. The addition of the words “pole dancing” means that, as with my conclusions on aural similarity, that these marks are not conceptually identical. However, the presence of peekaboo in both leads me to the conclusion that there is a high degree of conceptual similarity between them.

Comparison with ML’s earlier CTM 4881595

36. ML’s mark is, again, the stylised word peekaboo, together with the device of a female character in her underwear, lying on top of the word. The joint applicants’ mark is also the word peekaboo with a (seemingly naked) female character on top of the word. The dominant and distinctive element of both marks is the word peekaboo, though the stylisation of the words and the device elements do have an impact. However, the respective devices used, though not the same, are similar. Both females lie on top of the words in a similar position. I therefore conclude that there is a high degree of visual similarity between them.

37. With regards the aural and conceptual considerations, the absence of the words “pole dancing” in this earlier mark renders the respective marks aurally and conceptually identical.

Parallel Trading

38. The joint applicants argue (as part of Michael Caunter’s witness statement), that ML has not provided any evidence that there have been actual instances of confusion between the marks. They add that they are also unaware of any instances of confusion having taken place, which, in their view, reflects the different market sectors in which the parties operate. They further argue that they have used the marks since 1992 is a factor that should be considered in determining whether there is a likelihood of confusion. They referred to the decision in *CODAS Trade Mark* [2001] RPC 40:

“ However, if opposition is filed then the registrar must determine whether the grounds for refusal upon which the opposition is based are made out. If the opposition is based upon section 5 then the provisions of the appropriate subsections must be considered. The fact that honest concurrent use has been shown at the examination stage cannot overcome the objection. If, for example, the trade mark the subject of the application for registration and the trade mark the subject of the earlier right were identical, and the specification of goods or services of the application was identical to the specification of the goods or services covered by the earlier trade mark, then refusal must follow under section 5(1), which bars absolutely the registration of identical trade marks in respect of identical goods or services (unless the proprietor of the earlier trade mark consents to the registration of the later trade mark). But in relation to section 5(2)

the respective trade marks or respective specifications of goods or services may only be similar and the fact that there has been actual use of the trade mark in suit concurrently with the earlier trade mark, may be relevant in determining whether there is a likelihood of confusion”.

39. In response, ML argues that the joint applicants’ use is “local” hence no actual confusion would have arisen. However, in its view, the test is whether there is a likelihood of confusion and not whether actual confusion has occurred. ML also argues that the joint applicants’ claim of first use is also irrelevant.

40. Evidence of parallel trading is a factor which could, potentially, assist in deciding whether there exists a likelihood of confusion. This is because if the evidence establishes that the respective marks have actually been put to use in the same market without the consumer being confused regarding economic origin, then this can inform the tribunal’s decision. Alan Steinfield QC, sitting as a deputy judge of the High Court, in *Fiorelli Trade Mark* [2007] RPC 18 gave weight to an absence of confusion in the marketplace. However, this approach must be set against a number of decisions which express caution about the circumstances in which it is appropriate to give these factors weight (see the Court of Appeal in *The European Ltd v. The Economist Newspaper Ltd* [1998] FSR 283 at page 291, Laddie J in *Compass Publishing BV v. Compass Logistics Ltd* [2004] RPC 41 at 809 and the Court of Appeal in *Phones 4U Ltd v. Phone 4u.co.uk Internet Ltd* [2007] RPC 5 at paragraphs 42 to 45). In the first of these cases, Millet LJ stated:

“Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff’s registered trade mark.”

41. As I have already mentioned, the joint applicants refer to evidence of its use of its marks which has already been provided to the Registrar at ex parte stage. However, this evidence has not been presented to this tribunal; therefore, I am unable to make any assessment of it. Some evidence of use has been provided to this tribunal, which I have already summarised. Bearing in mind the case-law referred to above, for concurrent trading to play a meaningful role in the assessment of the likelihood of confusion I must be satisfied that the parties have traded in circumstances that suggest consumers have been exposed to both marks and have been able to differentiate between them without confusion as to trade origin. That simply is not the case here, where there has been no evidence at all to this effect. Indeed, the joint applicants have also been at pains to stress that it and ML operate consistently in different areas of the market. As a result, this factor can be given no weight in determining whether or not there is a likelihood of confusion.

42. I must also deal with a further argument. This relates to joint applicants’ claimed first use of its mark (1992), which pre-dates any use of ML’s marks. Though concurrent confusion free trading can be given weight in assessing a likelihood of confusion (although I have already found that it has no weight here), this does not extend to giving priority to the person who uses their mark first. The facts and evidence in this case do nothing to establish that there is no likelihood of confusion as a result of the respective use that has been made.

Likelihood of confusion

43. In reaching a decision on whether there is a likelihood of confusion, I must consider the possibility of both direct and indirect confusion. I begin by considering direct confusion which occurs when the average consumer mistakes one mark for the other and is consequently confused as to the economic origin of the goods sold under the respective marks. The case law makes it clear that there is an interdependency between the relevant factors (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*) and that a global assessment of the factors must be made when determining whether there is a likelihood of confusion (*Sabel BV v. Puma AG*). I must also consider the relevant factors from the viewpoint of the average consumer to determine whether they are likely to be confused.

44. It seems to me that ML's best prospect of success lies with its earlier CTM 4881595. I have already found that the joint applicants' mark is visually similar to a high degree, and aurally and conceptually identical with this mark. I have also found that the goods are identical and that the joint applicants' services are similar. I must also bear in mind that the average consumer rarely has the opportunity to view marks side by side and must instead rely on an imperfect picture of them he has kept in mind (*Lloyd Schuhfabrick Meyer*).

45. Considering all relevant factors, I do believe that the average consumer would mistake the joint applicants' marks for ML's marks and vice versa, given the strong overall degree of similarity and the identity/similarity of the goods and services. **I therefore conclude that there is a likelihood of direct confusion.**

46. This effectively deals with the matter. However even if the consumer would not directly confuse the marks, then I must consider indirect confusion, namely where the average consumer makes an association between the marks, due to some similarity between them, which leads them to believe that the goods come from the same or an economically linked undertaking. The question is whether the presence of peekaboo in both marks is enough to make the average consumer believe that the goods are the responsibility of the same or an economically linked undertaking? I have already found peekaboo to be the dominant and distinctive element of all the relevant marks and I am of the view that the earlier marks have a reasonably high degree of distinctive character. There is, therefore, every reason to believe that the average consumer would assume that the goods come from the same or an economically linked undertaking even if they would not directly confuse the trade mark.

DECISION IN RELATION TO APPLICATION 2421555

47. It seems to me that the joint applicants are in no better position in relation to this application. My findings with regard to a comparison of the respective goods and services and trade marks and my conclusions on likelihood of confusion apply equally here. Although the application contains the additional word "vintage" this will be seen as nothing more than a descriptive element indicating vintage clothing. There will still be a likelihood of confusion.

COSTS

48. As the oppositions have succeeded, ML is entitled to a contribution towards its costs. I hereby order Michael Caunter and Emily Bothwell to pay Blustuff Limited the sum of £2,400. I outline my breakdown of costs below. It should be noted that certain costs were incurred twice, but savings of time and effort were achieved in relation to evidence and submissions where composite documents were filed.

Preparing statements of case - £300
Official Fees (filing notice of opposition) x2 - £400
Considering counterstatement x 2 - £400
Preparing evidence - £500
Considering evidence - £500
Submissions - £300

TOTAL: £2,400

49. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful

Dated this 24th day of June 2009

**L White
For the Registrar
The Comptroller-General**