

O-381-10

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2515855  
BY WAHID AKHTAR & LAL HUSSAIN TO REGISTER A  
SERIES OF TRADE MARKS IN CLASS 25**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 99446 BY OUTDOOR LEISUREWEAR LIMITED**

## BACKGROUND

1. On 14 May 2009, Wahid Akhtar and Lal Hussain (“AH”) applied to register **I LOVE STORM** and **I Love Storm** as a series of two trade marks. Following examination, the application was accepted and published for opposition purposes on 3 July 2009 in Trade Marks Journal No.6792 for a specification of goods in class 25 which read:

“Clothing, footwear and headgear”.

2. On 14 August 2009, Outdoor Leisurewear Limited (“OLL”) filed a notice of opposition. This originally consisted of grounds based upon sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (as amended) (the Act). However, the ground based upon section 5(4)(a) of the Act has been abandoned. OLL states that the opposition is directed against all of the goods in the application for registration. OLL rely upon one earlier United Kingdom trade mark registration:

Trade Mark	No.	Application Date	Registration date	Goods in class 25
ARCTIC STORM  ARCTIC STORM  Series of 2	2416833	16/3/2006	15/9/2006	Articles of clothing; outer clothing; leisurewear; sportswear; underclothing; casualwear; footwear; headgear; caps; hats; gloves; mittens.

3. In their Statement of Grounds OLL say:

“The mark I LOVE STORM of the Applicant is confusingly similar to the mark ARCTIC STORM of the Opponent. The word STORM is common to both marks and is prominent within each of them. In particular the use of the phrase I LOVE before the word STORM in the applicant’s mark suggests that STORM is a common element within the mark. The goods covered in class 25 by the subject application are identical and/or confusingly similar to the goods covered by the opponent’s earlier trade mark registration.”

4. On 30 September 2009, AH filed a counterstatement which consists, in essence, of a denial of the remaining ground upon which the opposition is based. However, AH admits that the respective parties’ goods are “identical/similar.”

5. Neither party filed evidence or asked to be heard, AH filed written submissions; I will refer to these submissions as necessary below.

## DECISION

6. Section 5(2)(b) of the Act 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, or

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

7. 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, international trade mark (UK) or Community trade mark or international trade mark (EC) 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,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

8. OLL’s trade marks are earlier trade marks and are not subject to proof of use, as per The Trade Marks (Proof of Use, etc) Regulations 2004, as they had not been registered for five years at the time of the publication of AH’s trade mark application.

### **Section 5(2)(b) – case law**

9. In reaching a decision I must take into account the guidance provided by the European Court of Justice (ECJ) in a number of judgments. The principal cases are: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Mayer & 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, *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05),

It is clear from all these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all the relevant factors; *Sabel BV v. Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the good/services in question; *Sabel BV v. Puma AG*, paragraph 23, who is deemed to be reasonably well informed and 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* paragraph 27;
- (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*, paragraph 23;
- (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*, paragraph 23;
- (e) when considering composite marks, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element; *Shaker di L. Laudato & Co. Sas* (C-334/05), paragraph 42;
- (f) an element of a mark may play an independent distinctive role within it without necessarily constituting the dominant element; *Medion AG V Thomson multimedia Sales Germany & Austria GmbH*, paragraph 30;
- (g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (h) 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*, paragraph 24;
- (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*, paragraph 26;
- (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 + Adidas Benelux BV*, paragraph 41;
- (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*, paragraph 29.

### **The average consumer and the nature of the purchasing decision**

10. 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 these goods are likely to be selected by the average consumer in the course of trade. The goods at issue in these proceedings are items of clothing, footwear and headgear. These are the sort of goods which will be bought by the general public; they then are the average consumer for such goods.

11. The selection of clothing, footwear and headgear is most likely to consist of a visual act made on the basis of self selection in either a retail environment, from a catalogue or on-line (see the comments of the Appointed Person in *React Trade Mark* [2000] RPC 285).

12. In *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs)* Joined cases T-117/03 to T-119/03 and T-171/03 the General Court considered the level of attention taken in purchasing goods in the clothing sector:

“43 It should be noted in this regard that the average consumer's level of attention may vary according to the category of goods or services in question (see, by analogy, Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26). As OHIM rightly pointed out, an applicant cannot simply assert that in a particular sector the consumer is particularly attentive to trade marks without supporting that claim with facts or evidence. As regards the clothing sector, the Court finds that it comprises goods which vary widely in quality and price. Whilst it is possible that the consumer is more attentive to the choice of mark where he or she buys a particularly expensive item of clothing, such an approach on the part of the consumer cannot be presumed without evidence with regard to all goods in that sector. It follows that that argument must be rejected.”

### **Comparison of goods**

13. AH have applied for registration in respect of “clothing, footwear and headgear”, terms which are included in the specification of OLL's earlier trade mark; the respective goods are therefore identical.

### **Comparison of trade marks**

14. For the sake of convenience, the trade marks to be compared are as follows:

<b>OLL's trade marks</b>	<b>AH's trade marks</b>
ARCTIC STORM  ARCTIC STORM	I LOVE STORM I Love Storm

15. Both parties have either registered or applied for a series of two trade marks. Given the manner in which the respective trade marks within both series of two are presented, I intend to treat both trade marks within each series of two as one and the same i.e. I shall refer to the competing trade marks as ARCTIC STORM and I LOVE STORM respectively.

16. The average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as a whole and does not pause to analyse their various details. In addition, he rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has kept in his mind. In reaching a conclusion on similarity I must identify what I consider to be the distinctive and dominant elements of the respective trade marks and, with that conclusion in mind, I must, as the case law dictates, then go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

### **Distinctive and dominant components**

17. OLL's trade mark consists of the well known dictionary words ARCTIC (relating to the regions around the North Pole) and STORM (meaning, inter alia, a violent disturbance of the atmosphere with strong winds and usually rain, thunder, lightning, or snow). While both words used individually may, in the context of the goods at issue in these proceedings, be considered by the average consumer to have allusive connotations i.e. clothing designed or adapted for use in the Arctic or in storm conditions, when considered as a totality the conceptual image the combination is likely to convey to the average consumer is one of a storm taking place in the Arctic region. There is, in my view, no dominant element within OLL's trade mark.

18. Insofar as AH's trade mark is concerned this consists of the words I LOVE STORM; a trade mark which, in my view, divides naturally into two elements i.e. I LOVE and STORM. The meaning of the words I LOVE are so well known as to require no further explanation. As to the distinctiveness of these words I have no evidence or submissions to assist me. It appears to me that these words may (if used alone) be distinctive of the goods for which AH seek registration. However, in the context in which they appear in AH's trade mark (where LOVE is being used in the first person singular of the present tense of the verb with STORM being the direct object of that verb), whatever distinctive character they may possess is, I think, somewhat lost. Consequently, I do not consider any element of AH's trade mark to be truly dominant. In my view the distinctiveness of AH's trade mark lies in its totality. I will approach the comparison of the competing trade marks with those conclusions in mind.

## **Visual/aural similarity**

19. I have described the competing trade marks above. Clearly both trade marks share the word STORM as an element and to that extent at least there is a degree of visual and aural similarity between them. However, in my view, the presence of the other elements in the respective trade marks relegates the overall degree of visual and aural similarity between them to a low level.

## **Conceptual similarity**

20. In their written submissions AH draw my attention to the comments of the Court of First Instance (now the General Court) in a number of cases including *Phillips-Van Heusen Corp., v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (Case T-292/01). In that case the GC said:

“Next, it must be held that the conceptual differences which distinguish the marks at issue are such as to counteract to a large extent the visual and aural similarities pointed out in paragraphs 49 and 51 above. For there to be such a counteraction, at least one of the marks at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately.”

21. AH do not specifically explain why they think the above authority is relevant other than to say that: “Conceptually the respective marks are not confusingly similar”. While one could reasonably argue that as both parties’ trade marks contain the word STORM this shared element must lead to a degree of conceptual similarity between them, as I pointed out above OLL’s trade mark is likely, in my view, to conjure up in the average consumer’s mind an image of a storm taking place in the Arctic region. Although AH’s trade mark contains the word STORM it is, when considered as a totality, unlikely to create any conceptual image in the average consumer’s mind.

## **Distinctive character of OLL’s earlier trade mark**

22. I must also assess the distinctive character of OLL’s trade mark. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which it has been registered and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. I have already commented on the distinctive character of the individual elements within OLL’s trade mark in paragraph 17 above. However, when considered as a totality the words ARCTIC STORM are, in my view, more distinctive of the goods for which OLL’s trade mark stands registered

than are the individual elements within OLL's trade mark. OLL's trade mark is, in my view, possessed of a reasonable level of inherent distinctive character.

### **Likelihood of confusion**

23. In determining whether there is a likelihood of confusion, 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. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of OLL's trade mark, as the more distinctive this trade mark is the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and 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 he has retained in his mind. In paragraph 8 of their written submissions AH have deployed what I would describe as a state-of-the-register/state-of-the-market argument. However, in the absence of evidence which establishes that a number of non-economically linked undertakings have used trade marks which contain the word STORM in relation to articles of clothing, these assertions are of no assistance to me and have played no part in my decision.

24. The respective goods at issue are identical. I have concluded that the respective trade marks share only a low level of visual and aural similarity and that while OLL's trade mark will convey a meaning which the average consumer will immediately grasp, AH's trade mark will not. Applying the global approach advocated and in particular that a conceptual difference can to a large extent counteract visual and aural similarities, I have concluded that the average consumer is most unlikely to mistake one trade mark for the other (i.e. there will be no direct confusion) nor is it likely, given the clear conceptual message OLL's trade mark will convey, that the average consumer will assume that AH's goods come from an undertaking economically linked to OLL (i.e. there will be no indirect confusion).

25. In summary, OLL's opposition has failed.

### **Costs**

26. As AH have been successful they are entitled to a contribution towards their costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, I award costs to AH on the following basis:

Preparing a statement and considering the other side's statement:	£200
Preparation of written submissions:	£300



**Total:**

**£500**

27. I order Outdoor Leisurewear Limited to pay to Wahid Akhtar and Lal Hussain the sum of £500. 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 2 day of November 2010**

**C J BOWEN  
For the Registrar  
The Comptroller-General**