

**O-297-15**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3029996 BY  
BRANDSHOUSE LTD**

**TO REGISTER THE TRADE MARK:**

**CAPO JEANS**

**FOR GOODS IN CLASS 25**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 401823 BY  
KAPORAL FRANCE**

## BACKGROUND

1) On 11 November 2013 Brandshouse Ltd (“the applicant”) applied to register the trade mark **CAPO JEANS**. The application was published for opposition purposes on 6 December 2013 for the following goods:

**Class 25:** Clothing, footwear, headgear.

2) The application is opposed by Kaporal France (“the opponent”). The opposition, which is directed against all of the goods in the application, is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), for which the opponent relies upon the following two Community Trade Mark (“CTM”) registrations respectively, the relevant details of which are:

CTM no. 9753435, which was applied for on 21 February 2011 and for which the registration process was completed on 26 July 2011:

The logo for Kaporal JEANS features the word "Kaporal" in a large, elegant, cursive script. Below it, the word "JEANS" is written in a smaller, all-caps, sans-serif font, with wide letter spacing.

**Class 25:** Clothing, footwear, headgear.

CTM no. 5871652, which was applied for on 03 May 2007 and for which the registration process was completed on 29 January 2009:

## KAPORAL

**Class 25:** Clothing, footwear (except orthopaedic) and headgear.

3) The significance of the respective dates on which the opponent’s marks were applied for and on which their registration process was completed is that 1) both the opponent’s marks constitute an earlier mark in accordance with section 6 of the Act, and 2) neither is subject to the proof of use conditions contained in section 6A of the Act, their respective registration procedures both having been completed less than five years before the publication of the applicant’s mark.

4) The applicant filed a notice of defence and counterstatement, denying the grounds of opposition, though conceding that the competing trade marks encompass identical goods. Evidence was filed by the opponent. Both parties filed written submissions. Neither side requested a hearing. I therefore give this decision after a careful review of all the papers before me.

## THE OPPONENT’S EVIDENCE

5) This consisted of a witness statement by Ms Helene Whelbourn, a registered trade mark attorney employed by the opponent’s representatives in these

proceedings. Ms Whelbourn states that on 15 September 2014 she conducted a Google search for websites selling KAPORAL JEANS in the UK, and attaches an exhibit showing screenshots of the first two websites selling products under the KAPORAL JEANS trade mark and a screenshot of the first page of search results. The evidence is irrelevant in respect of proof of use, since neither of the earlier marks relied on in these proceedings is subject to the requirement to prove genuine use. As to its potential significance with regard to enhanced distinctiveness through use, I shall discuss this later in my decision.

## **SECTION 5(2)(b)**

6) The opposition is based upon section 5(2)(b) of the Act, which reads as follows:

“5(2) A trade mark shall not be registered if because – [...]

(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”.

7) I have taken into account the guidance provided by the Court of Justice of the European Union (“CJEU”) in a number of judgments. The following principles are gleaned from the decisions 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

## **COMPARISON OF GOODS**

8) Both in its counterstatement and in its written submissions the applicant concedes that the goods are identical.

## **THE AVERAGE CONSUMER AND THE PURCHASING PROCESS**

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

10) For the purposes of my global assessment of the likelihood of confusion I must take into account notional use of the competing marks over the range of goods for which they are registered. The average consumer of the goods of the competing marks will consist of the general public. Clothing, footwear and headgear are regular consumer purchases. The cost of all the goods can vary but they are not, generally speaking, highly expensive purchases. Whilst the average consumer of expensive clothing, for example, will probably pay higher attention to the selection of the goods, the position must also be considered from the perspective of more ordinary clothing. When selecting even routine items of clothing, footwear and headgear the average consumer is likely to be conscious of factors such as the size, colour, material and price of the item concerned. It will be examined from the point of view of personal taste and suitability for purpose, and the appearance of the articles will normally be an important consideration. Overall, consumers will normally pay a reasonable degree of attention, neither higher nor lower than the norm, when selecting the goods. The purchasing of all these goods is a predominantly visual process, so visual aspects of the marks take on more importance; but there may be some scope for aural use of the marks, so aural aspects will not be overlooked in my comparison of the marks.

## **THE DISTINCTIVENESS OF THE EARLIER MARKS**

11) The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark (on the basis either of inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

12) The opponent has not sought, in either its pleadings or submissions, to rely on any enhanced distinctiveness through use in respect of either of the earlier marks. The evidence in any case falls far short of establishing that the distinctiveness of either of the earlier marks has been enhanced to any material degree among the relevant public for the relevant goods in the UK. This leaves the question of their inherent distinctiveness to be considered. KAPORAL has no meaning likely to be known by the average consumer, who will assume it to be either an invented word, or one the meaning of which is unknown to him/her. It is not descriptive or allusive of the goods protected by the mark. CTM no. 5871652 therefore has a high degree of inherent distinctiveness. The contribution made to the distinctive character of CTM no 9753435 by cursive script of KAPORAL is marginal (and still more so in the case of the plain font of JEANS). Cursive script is an ordinary and traditional style, largely unremarkable from the perspective of the average consumer of the relevant goods, and the word KAPORAL is clearly legible in CTM no 9753435. The word JEANS is descriptive of clothing, and in any case plays a visually very subordinate role. These additional elements in CTM no 9753435 do not significantly increase its distinctive character, which resides overwhelmingly in the word KAPORAL. The mark as a whole has a high degree of inherent distinctiveness.

## COMPARISON OF THE MARKS

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

14) It would be wrong, therefore, to dissect the trade marks artificially, 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.

15) The Opponent draws my attention to two recent decisions before OHIM, which it submits present analogous aspects to the present case with regard to the comparison of marks: opposition division decision in opposition No B 1 728 073, where the marks compared were *Buff* (figurative) and *BUFFLOX*, and board of appeal decision R 803/2013-4, where the marks compared were *athé* and *ATHEIST*. In both cases the first four letters of the competing marks were the same and one of the marks contained an additional element. I have borne these cases in mind, but must

point out that decisions before OHIM are not binding on the Registrar, and I am not bound to come to the same conclusions. As territorial scope differs, so also do issues, factual backgrounds, cultural perceptions and linguistic factors. I must reach my decision in the present proceedings on the particular facts of the present case and on the particular marks that are before me. Moreover, amongst other things, I note that the initial letters of the marks considered in those cases were identical, which is not the case in the present proceedings.

16) The marks to be compared are shown below:

The opposed mark	The earlier mark CTM no. 5871652	The earlier mark CTM no. 9753435
<b>CAPO JEANS</b>	<b>KAPORAL</b>	

#### **Comparison with CTM no. 5871652**

17) The opposed mark is a word mark consisting of the two words CAPO and JEANS. CAPO is not descriptive or allusive of the goods protected by the mark. The word JEANS, being descriptive of clothing, has less weight in the overall impression of the mark. Nevertheless, it does make some contribution to the overall visual impression of the mark as a whole. The earlier mark CTM no. 5871652 consists solely of the word KAPORAL; it is not descriptive or allusive of the goods protected by the mark, and its distinctive character resides in the whole word.

18) The opposed mark is composed of two words, which make a total of nine letters in all. The earlier mark consists of one word of seven letters. Although the initial letter of each mark is visually very different, the next three letters – APO – are the same. Whereas in the earlier mark these are followed by three more letters, however, in the opposed mark, they are followed by a second word. Overall, there is only a low degree of visual similarity between the competing marks.

19) Aurally, both marks consist of three syllables. The first syllable of both marks will be pronounced identically, like the English word “cap”. I think the natural tendency for an English-speaker is to pronounce the O at the end of the word CAPO as a long vowel: OH. When followed by the R in KAPORAL the tendency will be to pronounce this O like the O in “or” or “port”. I consider that the word JEANS in the opposed mark, being descriptive, will be omitted when consumers refer to the goods orally. Even if it is spoken, it will contrast strongly with the final RAL syllable of the earlier mark, and there will be a low degree of aural similarity between the competing marks overall. Where it is omitted, the final syllable of the earlier mark has no counterpart in the opposed mark, and the differences in length and pronunciation which I have noted between CAPO and KAPORAL will counter the identical pronunciation of their first syllable, still resulting in a low degree of similarity overall.

20) Neither CAPO nor KAPORAL have a meaning likely to be known by the average consumer, who will assume them to be either invented words, or words the meaning of which is unknown to him/her. They give rise to neither conceptual similarity nor conceptual difference. The semantic content of the word JEANS is obvious but, being descriptive, its capacity to engender conceptual distinction in the mind of the consumer will necessarily be weak.

### **Comparison with CTM no. 9753435**

21) Stylisation of the word KAPORAL and (to a much lesser extent) the contrasting plain typeface of JEANS make some contribution to the overall impression of the earlier mark; but normal and fair use of the applicant's mark would include use in a variety of fonts which would reduce the apparent visual differences between the respective marks<sup>1</sup>. Both competing marks consist of two words. The second words are identical but, being descriptive of clothing, have less weight in the overall impression of the marks. Moreover, this subordinate role is graphically reflected in the very small size of JEANS in relation to KAPORAL in CTM no. 9753435.

22) I have already observed that neither of the first words of the respective marks – CAPO and KAPORAL – are descriptive or allusive of the relevant goods; they therefore have greater weight in the overall impressions of their respective marks. Although the letter combination APO appears after the initial letters of both words, the initial letters are distinctly different, and the final three letters of KAPORAL have no counterpart in the shorter CAPO. Overall, the degree of visual similarity between the competing marks lies between low and moderate.

23) I have already indicated my opinion that, owing to its descriptive character, the word JEANS will be omitted in oral use (the very subdued nature of its graphical representation in CTM 9753435 is consistent with this view), and that differences in length and pronunciation between CAPO and KAPORAL will counter the identical pronunciation of their first syllable, resulting in a low degree of aural similarity. Even if the word JEANS is spoken, it will only give rise to a moderate degree of aural similarity between the competing marks overall.

24) I have already found that there is neither conceptual similarity nor conceptual difference between CAPO and KAPORAL. Since the word JEANS is descriptive, its capacity to engender conceptual similarity in the mind of the consumer will necessarily be weak.

### **LIKELIHOOD OF CONFUSION**

25) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific

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<sup>1</sup> See *Peek & Cloppenburg v OHIM*, T-386/07 at paragraph 38.



formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

### **Likelihood of confusion with CTM no. 5871652**

26) I have found a low degree of both visual and oral similarity between the competing marks. I have found the earlier word mark KAPORAL to have a high degree of distinctiveness, residing in the word as a whole. CAPO and KAPORAL have no semantic content for the average consumer and, since the word JEANS is descriptive, its capacity to engender conceptual distinction in the mind of the consumer is weak. Bearing in mind my findings on the average consumer and the purchasing process, I consider that, even in the case of identical goods, and even taking into account the effect of imperfect recollection, the differences between the marks are sufficient to rule out any likelihood that the consumer will directly confuse the marks, i.e. mistake them for one another. However, I must also consider the possibility of indirect confusion, and in this connection it is helpful to bear in mind the observations of Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, where he noted (at paragraph 16) that:

“ Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark” ”.

27) The only element of the earlier mark which might be seen as being in common with the contested mark consists in its initial letters: KAPO. Even in purely aural terms I find it difficult to see why the average consumer would perceive CAPO, the first word of the contested mark (which admittedly bears the mark’s distinctive weight) as, for example, a truncated or abbreviated form of the earlier mark, or as being similar in a way which might indicate some economic connection with the owner of the earlier mark. Still less would this be the case in visual terms, where the initial letters are very distinctly different. Moreover, as the General Court observed in *New Look Ltd v OHIM*, Cases - T-117/03 to T-119/03 and T-171/03, whilst oral communication is not excluded, choice of items of clothing is generally made visually and the visual aspect accordingly plays a greater role in the global assessment of the likelihood of confusion. I do not consider that the competing marks will be associated by the public in such a way as to create a risk that they will wrongly believe that the respective goods come from the same or economically-linked undertakings. **Accordingly, the opposition based on CTM no 5871652 fails.**

## **Likelihood of confusion with CTM no. 9753435**

28) I have found a low to moderate degree of visual similarity and a low or, at most, moderate degree of aural similarity between the competing marks. The contribution made to the distinctive character of CTM no 9753435 by its stylisation is, for reasons I have explained, minor. The word JEANS is descriptive of clothing and in any case, appearing (in relation to KAPORAL) in very small plain font capitals, it plays only a minor role. These additional elements in CTM no 9753435 do not significantly contribute to its distinctive character, which resides overwhelmingly in the word KAPORAL, this word lending the mark as a whole a high degree of inherent distinctiveness. Though the word JEANS is common to both the competing marks, and makes some contribution to their overall impression, its descriptive character limits its capacity to engender visual, aural or conceptual similarity, or resulting confusion in the mind of the consumer. In the overall impression of the marks the greatest weight still lies with the words CAPO and KAPORAL respectively. I have already considered above the similarities and differences between these elements. Bearing in mind my findings on the average consumer and the purchasing process, I consider that, even in the case of identical goods, and even taking into account the effect of imperfect recollection, the differences between the marks as a whole are still sufficient to rule out any likelihood that the consumer will directly or indirectly confuse them. **Accordingly, the opposition based on CTM no 9753435 fails.**

## **OUTCOME**

**The opposition fails in its entirety.**

## **COSTS**

36) The TM7A notice of threatened opposition was filed in the name of Reservoir Team SAS. The TM7 notice of opposition was filed in the name of Kaporal France. The opponent explained in the form TM7 that there had been a change of ownership of the earlier rights in the intervening period, and provided copies of current case details from OHIM's website, the registration certificates, and publication of the assignment. Although the applicant raised no issue regarding the status of the opponent in its notice of defence and counterstatement, in its written submissions it requested that the opponent provide details and evidence as to when the transfer was actually executed. The opponent's representatives provided details but observed that, the transfer document being confidential, they had not yet received permission to file it, and asked if this was deemed necessary. The applicant submitted that without sight of the relevant documents it could not agree that there was a clear chain of title; it was possible the opposition was filed late and should be rejected. Following a case management conference the applicant confirmed that a translation of the relevant merger document provided by the opponent was sufficient for the applicant to accept that the assignment was legitimate. Taking account of all the facts relating to this procedural issue, I consider it fair for the parties each to bear their own costs in respect of the case management conference

37) In the opposition Brandshouse Ltd has been successful and is entitled to a contribution towards its costs. I hereby order Kaporal France to pay Brandshouse Ltd the sum of £900. This sum is calculated as follows:

<i>Preparing a statement and considering the other side's statement</i>	£300
<i>Preparing submissions and considering the other side's evidence and submissions</i>	£600

The above sum should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 29th day of June 2015**

**Martin Boyle  
For the Registrar,  
The Comptroller-General**