

**O-340-15**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 3076521**

**BY**

**MAJIC (SCOTLAND) LTD**

**TO REGISTER THE TRADE MARK**

**sub2**

**IN CLASSES 5, 25, 28 AND 32**

**AND**

**THE OPPOSITION THERETO**

**UNDER NO 600000200**

**BY**

**DENNIS AND GILLIAN MACFARLANE**

## BACKGROUND

1. On 10 October 2014, MAJIC (SCOTLAND) LTD (the applicant) applied to register the trade mark: **sub2** in classes 5, 25, 28 and 32 of the Nice Classification system.<sup>1</sup> The specification stands as follows:

**Class 5**

Sport supplements; food supplements.

**Class 25**

Sport clothing; sport footwear.

**Class 28**

Sport equipment.

**Class 32**

Sport drinks.

2. The application was published on 24 October 2014. Dennis and Gillian Macfarlane (the opponent) filed notice of opposition against the application, on 19 February 2015, under the fast track opposition procedure.

3. The opposition was brought under section 5(2)(b) of the Trade Marks Act 1994 (the Act). The opponent relies upon UK trade mark 2530450, shown below:

Mark details and relevant dates	Goods relied on
<p><b>Mark:</b></p> <p><b>SUB4</b></p> <p><b>Filing date:</b> 2 November 2009</p> <p><b>Date of entry in the Register:</b> 5 February 2010</p>	<p><b>Class 25</b></p> <p>Hats, caps, balaclavas, headbands (clothing), bandannas (neckerchiefs), long sleeve T-shirts, short sleeve T-shirts, fleece tops, sweatshirts, shirts, pullovers, vests, gilets, jackets, tops, sports brassieres, briefs, shell suits, track suits, footless running tights, footless shorter running tights, shorts, trousers, over trousers, gloves, wristbands (clothing). Footwear</p>

4. On 8 May 2015, the applicant filed a counterstatement, denying the ground of opposition.

5. Rules 20(1)-(3) of the Rules (the provisions which provide for the filing of evidence) do not apply to fast track oppositions, but Rule 20(4) does. It reads:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

---

<sup>1</sup> *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).*

6. The net effect of the above is to require parties to seek leave in order to file evidence (other than the proof of use evidence which is filed with the notice of opposition) in fast track oppositions.

7. No leave was sought in respect of these proceedings.

8. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if 1) the Office requests it or 2) 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.

9. A hearing was neither requested nor considered necessary. The applicant filed written submissions, which I will refer to as necessary, below.

10. I give this decision following a review of all of the material before me.

## **DECISION**

11. The opposition is brought under section 5(2)(b) of the Act which 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.”

### **Section 5(2)(b) case law**

12. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the CJEU cases mentioned) on the basis indicated below:

#### The CJEU cases

*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; *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723; *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-6/01; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04; *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P.

## The principles

“(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

## The average consumer and the nature of the purchasing act

13. In accordance with the above cited case law, I must determine who the average consumer is for the goods at issue and also identify the manner in which those goods will be selected in the course of trade. 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.”

14. Specifically, in respect of the goods in class 25, in considering the level of attention that will be paid to such a purchase and the nature of the purchasing act, I am mindful of the decision of the General Court (GC) 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*, in which it commented:

"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."

...

53. Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion."

15. The average consumer of the goods at issue will be a member of the general public. The purchase is likely to be primarily visual as it is likely to be made from a store, website or directly from a shelf. In the case of some of the applicant's goods, such as, inter alia, sports supplements, the goods may be bought from a gym or health food shop. The goods cover a range of products which vary in price and frequency of purchase. Consequently, the level of attention is likely to vary: a specialist item of sports equipment is likely to be a fairly expensive, infrequent purchase, which will be purchased according to the particular

requirements of the purchaser. It will demand a higher level of attention to be paid than, for example, buying a t-shirt or a sports drink.

### Comparison of goods

16. In the absence of any submissions from either party regarding the nature of the goods to be compared, the following assessment is made from my own understanding.

17. The goods to be compared are as follows:

The opponent's goods	The applicant's goods
<p><b>Class 25</b> Hats, caps, balaclavas, headbands (clothing), bandannas (neckerchiefs), long sleeve T-shirts, short sleeve T-shirts, fleece tops, sweatshirts, shirts, pullovers, vests, gilets, jackets, tops, sports brassieres, briefs, shell suits, track suits, footless running tights, footless shorter running tights, shorts, trousers, over trousers, gloves, wristbands (clothing). Footwear</p>	<p><b>Class 5</b> Sport supplements; food supplements.</p> <p><b>Class 25</b> Sport clothing; sport footwear.</p> <p><b>Class 28</b> Sport equipment.</p> <p><b>Class 32</b> Sport drinks.</p>

18. In comparing the goods, I bear in mind the following guidance provided by the General Court (GC) in *Gérard Meric v OHIM*, Case T-133/05:

*“29. ...goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”*

19. Factors which may be considered include the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)*<sup>2</sup>(hereafter Treat) for assessing similarity between goods and services:

- (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 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;

<sup>2</sup>[1996] R.P.C. 281

(f) the extent to which the respective goods or services are competitive, taking into account how goods/services are classified in trade.

And the comments of the CJEU in *Canon* in which it stated, at paragraph 23 of its judgment:

“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.”

20. With regard to interpreting terms in specifications, I will bear in mind the guidance provided in *Treat*:

“In construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. Words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning.”

21. I will also bear in mind Floyd, J’s statement in *YouView TV Ltd v Total Ltd*:<sup>3</sup>

“...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.”

22. I also bear in mind the decision in *El Corte Inglés v OHIM Case T-420/03*, in which the court commented:

“96...goods or services which are complementary are those where 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 that the responsibility for the production of those goods or provision of those services lies with the same undertaking (*Case T-169/03 Sergio Rossi v OHIM-Sissi Rossi* [2005] ECR II-685)”

23. And *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 325/06* in which the GC explained when goods are complementary:

---

<sup>3</sup> [2012] EWHC 3158 (Ch) at [12]

“82. It is true that goods are complementary if 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 that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P *Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

24. The comments of Daniel Alexander Q.C., sitting as the Appointed Person, in *LOVE*<sup>4</sup>, are also to be borne in mind:

“18. ...the purpose of the test, taken as a whole, is to determine similarity of the respective goods in the specific context of trade mark law. 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.”

25. And at paragraph 20 where he warned against applying too rigid a test:

“20. In my judgment, the reference to ‘legal definition’ suggests almost that the guidance in *Boston* is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, 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. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to *Boston*.”

26. Where appropriate I will, for the purposes of comparison, group related goods together in accordance with the decision in *Separode Trade Mark*<sup>5</sup>:

“5. The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

## **Class 25**

27. The applicant’s specification in class 25 includes the term ‘sport clothing’. The opponent’s specification is for a number of named articles of clothing, all of which could be considered ‘sports clothing’. In accordance with the decision in *Merix* these are identical goods.

---

<sup>4</sup> BL O/255/13

<sup>5</sup> BL O-399-10



28. The applicant's specification also includes 'sports footwear'. The opponent's includes footwear at large, which clearly includes 'sports footwear'. These are identical goods.

29. In its statement of grounds the opponent submits that all of the applicant's goods are similar to its own goods in class 25. Neither party has offered any explanation as to where such similarity may lie. All of the goods share a very high level similarity in that they may be used during sporting activity. However, having considered the nature of the goods, their intended purpose, their method of use and whether they are in competition with each other or are complementary, I can find no meaningful areas in which the competing goods coincide. Consequently, I find the applicant's goods in classes 5, 28 and 32 to be dissimilar to the opponent's goods in class 25.

### Comparison of marks

30. The marks to be compared are as follows:

The opponent's mark	The applicant's mark
SUB4	sub2

31. In making a comparison between the marks, I must consider the respective marks' visual, aural and conceptual similarities with reference to the overall impressions created by them, bearing in mind their distinctive and dominant components<sup>6</sup>, but without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

32. The opponent's mark consists of the letters 'SUB' and the number '4', joined together with no gaps. It is presented in plain type in upper case and is not stylised in any way. The distinctiveness lies in the mark as a whole.

33. The applicant's mark consists of the letters 'sub' and the number '2', joined together with no gaps. It is presented in plain type in lower case and is not stylised in any way. The distinctiveness lies in the mark as a whole.

### Similarity of the marks

34. The marks begin with the same three letters, 'SUB'. The applicant's is followed by the number 2, while the opponent's is followed by the number 4. Whether the first three letters are presented in upper or lower case is a fact likely to go unnoticed by the average consumer. The marks are visually and aurally highly similar.

35. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.<sup>7</sup> The assessment must be made from the point of view of the average consumer. In its counterstatement the applicant indicates that in its view 'sub2' refers to 'sub 2 hour'. It states:

---

<sup>6</sup> *Sabel v Puma AG*, para.23

<sup>7</sup> This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.

*“...While there are no guarantees the sub2hr marathon consortium will succeed in delivering a sub2hr marathon within 5 years, a number of outcomes beyond the breaking of the sub two hour barrier are envisaged including the promotion of clean high performance marathon running and the development of the next generation anti-doping tests and “intelligent” training method using “omnics” technologies, real time performance management systems, optimal training and performance nutrition, and novel training and racing footwear design.”*

36. Without the addition of an element which clearly shows that the ‘2’ refers to 2 hours, the average consumer may see the mark in a number of ways. The letters ‘SUB’ may be seen as indication something less than the number which follows the three letter combination, i.e. less than (or below) 4, less than (or below) 2, as submitted by the applicant or the marks may be considered to indicate the word ‘substitute’ followed by the number 2 or 4. In any case, the interpretation given to the marks will be the same in both cases. To the extent that the marks provide a conceptual message, that message is highly similar.

### **Distinctive character of the earlier mark**

37. In determining the distinctive character of a trade mark it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify its goods 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.

38. As I have concluded above, the opponent’s mark may convey a number of meanings to the average consumer. None of these are descriptive or elusive of the goods at issue and consequently the mark enjoys a high level of inherent distinctive character.

### **Likelihood of confusion**

39. In assessing the likelihood of confusion, I must adopt the global approach advocated by case-law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind.<sup>8</sup> I must also keep in mind the average consumer for the goods, the nature of the purchasing process and have regard to 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.

40. Earlier in this decision I concluded that the marks share a high degree of visual and aural similarity and are conceptually highly similar. I have found the earlier mark to have a high level of inherent distinctive character. I have found the applicant’s goods in classes 5, 28 and 32 to be dissimilar to the opponent’s goods in class 25. Consequently, for these goods there can be no likelihood of confusion as per the judgment in *Waterford*.<sup>9</sup>

### **41. The opposition fails under section 5(2)(b) of the Act in respect of:**

#### **Class 5 - Sport supplements; food supplements**

---

<sup>8</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

<sup>9</sup> *Waterford Wedgwood plc v OHIM – C-398/07 P* (CJEU)

## **Class 28 - Sport equipment**

### **Class 32 - Sport drinks.**

42. With regard to the applicant's goods in class 25, which I have found to be identical to the opponent's goods in the same class, and taking into account the concept of imperfect recollection, the differences between the marks are such that the average consumer may misremember the number which follows 'SUB' leading to direct confusion, where one mark is mistaken for the other. Even if I am found to be wrong in this, I am mindful of *L.A. Sugar Limited v By Back Beat Inc*<sup>10</sup>, in which Mr Iain Purvis Q.C. sitting as the Appointed Person noted that:

"16. 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.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ("26 RED TESCO" would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as "LITE", "EXPRESS", "WORLDWIDE", "MINI" etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ("FAT FACE" to "BRAT FACE" for example)."

43. In my view, the change of the last element of the mark from 4 to 2 (or vice versa) does fall squarely within the types of indirect confusion identified in *LA Sugar*, particularly the brand extension point. If the average consumer were familiar with either mark and encountered the other they would simply conclude that the goods were being provided by an economically linked undertaking.

---

<sup>10</sup> Case BL-O/375/10

## **CONCLUSION**

**44. The opposition succeeds under section 5(2)(b) of the Act in respect of class 25 only.**

45. Since both parties have achieved a measure of success I decline to make an award of costs in this case.

**Dated this 24th day of July 2015**

**Ms Al Skilton  
For the Registrar,  
The Comptroller General**