

O-128-16

Trade Marks Act 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3087132 IN
THE NAME OF PUBLIC NUISANCE CLOTHING LIMITED TO
REGISTER THE TRADE MARK**



IN CLASS 25

**AND OPPOSITION UNDER NO. 404070
THERE TO BY HEL MANEY LTD**

Background and pleadings

1) On 22 December 2014, Public Nuisance Clothing Limited (“the applicant”) applied to register the following trade mark in the UK:



2) It was accepted and published in the Trade Marks Journal on 16 January 2015 in respect of the following class 25 goods “Clothing, footwear, headgear”.

3) On 2 April 2015, Mr Rupert Mark Leigh opposed the application, though Mr Leigh was subsequently substituted as the opponent by Hel Maney Ltd (“the opponent”). The opposition was based upon Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and relied upon its earlier UK trade mark registration (“the earlier mark”). Pertinent details of the earlier mark are as follows:

Mark: a public nuisance
Number: 3082208
Filing date: 19 November 2014
Publication date: 27 February 2015
Date of entry on register: 8 May 2015
Goods: Clothing, footwear, headgear

4) The opponent argues that the respective goods are identical and that the marks are similar. The applicant filed a counterstatement denying the claims made.

5) Both sides filed evidence in these proceedings which has been summarised below.

6) A hearing took place via video-link on 22 January 2016, with the opponent represented by Mr Rupert Leigh, Managing Director of Hel Maney Ltd, and the applicant by Mr David Power, Managing Director and Chief Executive of Public Nuisance Clothing Limited.

Opponent’s evidence

Witness statement of Rupert Mark Leigh and exhibits 1 – 21

7) Mr Leigh is the managing director of Hel Maney Ltd. Mr Leigh’s witness statement includes various submissions which I shall not summarise but will refer to where necessary.

8) Mr Leigh states that the earlier mark was first used by the brand “APN” and thereafter by the opponent since July 2012 on a branded sweatshirt and sold in its

online retail store. Mr Leigh provides the following sales and promotional spend figures for the mark “a public nuisance” in the UK:

Year	Annual sales	Annual promotional spend
2012	£1,200	£500
2013	£2,000	£500
2014	£8,000	£1,500

9) Throughout Mr Leigh’s evidence, and during the hearing, there were references to the mark APN (registered by Mr Leigh in September 2010)¹. I informed Mr Leigh that since this mark has not been used as the basis to oppose the application, it has no bearing on these proceedings. The evidence also includes a UK trade marks register extract for the mark “its just a ride”² which has not been relied upon in this opposition and is, therefore, not relevant. In support of the opposition Mr Leigh submitted the following exhibits:

- Exhibits 1 and 2 consist of domain name registrations for “a public nuisance” with the suffix .com and .co.uk. They were registered in July and November 2010 respectively.
- Exhibit 6 consists of an extract from “Shopwindows” which is headed “public nuisance”. The extract is not dated.
- Exhibits 7, 8, 9 and 10 comprise of internet images searches for “a public nuisance”. They are not dated and it is not clear who produces the various goods or even where they are advertised. Therefore, they have no impact on these proceedings.
- Exhibit 11 consists of an extract from what appears to be the applicant’s website. It is headed “PUBLIC NUISANCE STREET WEAR” and shows the application. It states that the “Public-Nuisance Street-Wear launched in September 2014”.
- Exhibits 12 to 21 are a number of website screen shots. Exhibit 12 is headed “The Blog” and is dated 24 January 2012. It contains the heading “Get a Sweat On With A Public Nuisance, the Bad Boys of Vintage”. In the text of the blog the words “A Public Nuisance” appear to feature as a hyperlink though no further information is provided. The majority of the remaining screen prints either relate to the mark APN or are dated after the date of the application. Therefore, they are not relevant to these proceedings.

Applicant’s evidence

Witness statement of David Michael Bernard Power and exhibits DMBP1 to DMBP8

10) Mr Power is the managing director and chief executive of Public Nuisance Clothing Limited, a position he has held since its incorporation on 21 October 2014.

¹ An extract of the UK Trade Marks Register for the mark APN under no. 2558604 has been filed as exhibit 3

² Exhibit 5. UK Trade Mark Application No. 3091493 filed on 28 January 2015

The witness statement contains various submissions and criticisms of the evidence filed by the opponent. I shall refer to these if and where necessary.

11) Mr Power states that the words “Public Nuisance” have been used in trade by third parties since 1995 in connection with clothing, footwear and headgear. To evidence this he has filed exhibits DMBP1 to DMBP8 which are various website screen shots. None of the screen shots are dated earlier than the date of application so they are not relevant to these proceedings. Many of the screen shots include references to “PN” and “APN”. Mr Power claims that this use has led to the words “Public Nuisance” and the abbreviations “PN” and “APN” becoming synonymous with a particular genre of apparel. Mr Power also refers to a decision of the General Court (“GC”). This will be referred to later in this decision.

DECISION

Section 5(2)(b)

12) Sections 5(2)(b) of the Act is 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, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

Case law

13) The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

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 be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Average consumer and the purchasing act

14) 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*.

15) 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 at paragraph 60 in these terms:

“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.”

16) The conflict relates to clothing, footwear and headgear. The average consumer of such goods are members of the general public. The goods may be tried on and are likely to be inspected for colour, size, style, fitness for purpose, etc. All of this increases the potential exposure to the trade mark. That being said, the purchase is unlikely to be a highly considered process since clothing, footwear and headgear are purchased relatively frequently and, although cost can vary, they are not generally a highly expensive purchase. In view of this, I consider the level of care and attention paid when purchasing the goods to be medium.

17) As to how such an average consumer selects such goods, in *New Look Ltd v Office for the Harmonization in the Internal Market (“OHIM”)* Joined cases T-117/03 to T-119/03 and T-171/03 the General Court (“GC”) stated in paragraph 50:

“The applicant has not mentioned any particular conditions under which the goods are marketed. 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.”

18) Since the goods at issue are most likely to be purchased following a process of self-selection via a retail outlet on the high street, catalogues or websites, I agree that visual considerations dominate the selection process. In accordance with the guidance set out *New Look*, greater weight should be given to the visual aspect. Whilst taking this view, I do not rule out aural use.

Comparison of goods

19) The application and the earlier mark both cover Class 25 “clothing, footwear, headgear”. Therefore, the respective goods are identical.

Comparison of marks


20) 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 (“CJEU”) stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of

that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

21) It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

22) The respective trade marks are shown below:

Application	Earlier mark
	a public nuisance

23) Since the earlier mark only consists of the words “a public nuisance” this is what forms the overall impression of the mark. With regard to the application, this consists of two primary components i.e. the stylised device of a face partially covered by what appears to be a neckerchief (which seems to depict a hoodlum) and the words “public nuisance streetwear”. In my view, the device is only slightly more prominent than the words.

24) Visually, the application is more complex than the word only earlier mark since it contains a device. However, both marks contain the words public nuisance which are instantly recognisable. Therefore, I find that the marks are visually similar to be a medium degree.

25) The device within the application will not be verbalised. Instead, the application would be pronounced as “PUBLIC NUISANCE STREETWEAR”. The earlier mark would be spoken as “a public nuisance”. Since the words “public nuisance” would be verbalised in each mark I consider there to be a high degree of aural similarity.

26) Conceptually both marks would be remembered for the public nuisance element of the marks. Whilst the application also contains a device this will merely reinforce the “public nuisance” message and does not alter the conceptual similarities between the marks. Further, the application includes the word “streetwear” but in view of the applied for goods, this would be viewed as descriptive. Overall, I consider there to be a high degree of conceptual similarity.

Distinctive character of the earlier trade mark

27) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated at paragraphs 22 and 23 that:

“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).

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).”

28) The opponent has provided evidence of use of the mark together with turnover and promotional figures. The total sales in 2012 were £1,200, then £2,000 in 2013 and £8,000 in 2014. Promotional spend ranges from £500 to £1,500 per annum. I do not consider the opponent’s use, sales and promotional spend to warrant an enhanced degree of distinctive character. Therefore, I only have the inherent distinctive character to consider.

29) In Mr Power’s witness statement he claims that given the use of the words “Public Nuisance” by different UK and overseas traders results in no one entity having the exclusive right to the words. However, the earlier mark is a registered trade mark for the goods in which it is registered. In *Formula One Licensing BV v OHIM*, Case C-196/11P, the Court of Justice of the European Union found at paragraphs 41 to 44 that:

“.....it is not possible to find, with regard to a sign identical to a trade mark protected in a Member State, an absolute ground for refusal, such as the lack of distinctive character, provided by Article 7(1)(b) of Regulation No 40/94 and Article 3(1)(b) of Directives 89/104 and 2008/95. In this respect, it should be noted that the characterisation of a sign as descriptive or generic is equivalent to denying its distinctive character.

It is true that, as is clear from paragraph 48 of the judgment under appeal, where an opposition, based on the existence of an earlier national trade mark, is filed against the registration of a Community trade mark, OHIM and, consequently, the General Court, must verify the way in which the relevant public perceives the sign which is identical to the national trade mark in the mark applied for and evaluate, if necessary, the degree of distinctiveness of that sign.

However, as the appellant rightly points out, their verification has limits.

Their verification may not culminate in a finding of the lack of distinctive character of a sign identical to a registered and protected national trade mark, since such a finding would not be compatible with the coexistence of Community trade marks and national trade marks or with Article 8(1)(b) of Regulation No 40/94, read in conjunction with Article 8(2)(a)(ii).”

30) The words do not describe the goods or a characteristic thereof. However, the words will be easily understood as alluding to something or someone who is disruptive and/or conducts themselves in a socially unacceptable manner. Balancing the easily understood message the mark conveys and the comments made in the *Formula One* judgment, I consider the inherent distinctive character in the earlier mark to be low.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.

31) In Mr Power’s witness statement he referred to the GC decision of *Giovanni Cosmetics, Inc. v OHIM* Case T559/13. This was an appeal to the OHIM Board of Appeal decision which upheld OHIM’s decision that there is no likelihood of confusion between the earlier GIOVANNI, and the applied for.



GIOVANNI GALLI

32) The goods in question were:

Class 3 ‘Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices’.

33) Mr Power states that the GC held that the OHIM Board of Appeal had been wrong in not considering the two word elements and the figurative element as equally important when carrying out the global assessment of the two marks. Accordingly, Mr Power argues, “that the Applicant’s mark be accorded like consideration and that the Opponents application be refused bearing in mind that the words, viz. ‘Public Nuisance Streetwear’ and the figurative element provided by the masked man rondel should be considered as a whole and not as separate elements of the mark”.³

34) Decisions of the GC on points of law are binding on the tribunal and decisions of fact are of persuasive value in cases where similar considerations apply. In the GC’s decision it is stated that “the mark applied for contains a figurative element which has a considerable impact on the overall visual impression given by that mark.”⁴ the device is of a duck, which is larger and more prominent than the words plus it has no bearing to the words. In this opposition action the device has less of an impact since it merely reinforces the message of the words. Therefore, the referred to GC case is not comparable to this opposition.

³ Paragraph 11 of the witness statement

⁴ Paragraph 128 of the judgment

35) 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 the opponent'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 the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision, I concluded that:

- The respective trade marks are aurally and conceptually similar to a high degree. They are visually similar to a medium degree.
- The goods are identical.
- The inherent distinctive character of the earlier mark is low.
- The average consumer will pay a medium degree of care and attention. The purchasing process will mainly be visual, though I do not discount aural considerations.

36) Taking all of the above into consideration, I find that there is a likelihood of direct confusion between the marks. The goods are identical, there is a high degree of aural and conceptual similarity plus a medium degree of visual similarity. All of these factors offsets the low distinctive character in the earlier mark.

Outcome

37) The opposition succeeds. The application, subject to appeal, shall be refused in its entirety.

COSTS

38) The opponent has been successful and is entitled to a contribution towards its costs. Since the opponent was not professionally represented, in accordance with the published scale of costs, its award (excluding official fees) shall be reduced by 50%. Therefore, I award the opponent the sum of £650 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Official fee	£100
Preparing a statement and considering the other side's statement	£150
Preparing evidence and considering and commenting on the other side's evidence	£300
Preparing for and attending a hearing	£150
TOTAL	£650

39) I therefore order Public Nuisance Clothing Limited to pay Hel Maney Ltd the sum of £650. 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 9th day of March 2016

MARK KING
For the Registrar,
The Comptroller-General