

O-292-16

**TRADE MARKS ACT 1994
IN THE MATTER OF
APPLICATION NO 3142606
BY EDITION TWELVE LIMITED
TO REGISTER THE TRADE MARK**

Edition° 12

IN CLASS 18

AND

**OPPOSITION THERETO (UNDER NO. 600000404)
BY EPO FASHION CO., LTD.**

BACKGROUND

1) On 31 December 2015, Edition Twelve Limited ('the applicant') filed an application to register the following trade mark in respect of the goods listed below:

Edition° 12

Class 18: Dog clothing; accessories for dogs, namely, leather collars, harnesses and leashes.

2) The application was published on 22 January 2016 in the Trade Marks Journal and notice of opposition, under the fast track opposition procedure, was subsequently filed by EPO Fashion Co., Ltd. ('the opponent'). The opponent claims that the application offends under section 5(2)(b) of the Trade Marks Act 1994 ('the Act'). It directs its opposition against all of the goods in the application.

3) The opponent relies on the UK trade mark registration ('UKTM') shown in the table below:

UKTM details	Goods relied upon
<p>UKTM No: 3038581</p> <p>MO&Co.edition</p> <p>Filing date: 21 January 2014 Date of entry in the register: 18 April 2014</p>	<p>Class 25: Clothing; layettes (clothing); bathing suits; waterproof clothing; gloves (clothing); shoes; hats; hosiery; scarfs; girdles.</p>

4) The trade mark relied upon by the opponent has a filing date of 21 January 2014 and completed its registration procedure on 18 April 2014. The consequences of these dates in relation to the applicant's mark are that the opponent's mark is an earlier mark in accordance with section 6 of the Act and it is not subject to proof of use, as per The Trade Marks (Proof of Use, etc) Regulations 2004.

5) The applicant filed a counterstatement denying the ground of opposition.

6) Rule 6 of the Trade Marks (Fast Track Opposition)(Amendment) Rules 2013, S.I. 2013 2235, dis-applies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

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

7) The net effect of these changes is to require parties to seek leave from the registrar in order to file evidence in fast track oppositions. No leave was sought in the instant 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. A hearing was neither requested nor considered necessary. Neither party has filed written submissions beyond those in the notice of opposition and counterstatement. I now make the following decision on the basis of the papers before me.

DECISION

Section 5(2)(b)

9) Section 5(2)(b) of the Act provides:

“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,

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

10) The leading authorities which guide me are from the CJEU: *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 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

11) For ease of reference, the goods to be compared are set out in the following table:

Opponent's goods	Applicant's goods
Class 25: Clothing; layettes (clothing); bathing suits; waterproof clothing; gloves (clothing); shoes; hats; hosiery; scarfs; girdles.	Class 18: Dog clothing; accessories for dogs, namely, leather collars, harnesses and leashes.

12) The leading authorities as regards determining similarity between goods and services are considered to be *British Sugar Plc v James Robertson & Sons Ltd* ('*Treat*') [1996] R.P.C. 281 and *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117 ('*Canon*'). In the latter case, the CJEU accepted that all relevant factors should be taken into account including the nature of the goods/services, their intended purpose, their method of use and whether they are in competition with each other or are complementary. The criteria identified in the *Treat* case were:

- (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 respectively 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;
- (f) The extent to which the respective goods or services are competitive.

13) In *Beautimatic International Ltd v. Mitchell International Pharmaceuticals Ltd and Another* ('*Beautimatic*') [2000] FSR 267 Neuberger J held that the words must be given their natural meaning, subject to their being construed within their context; they must not be given "an unnaturally narrow meaning simply because registration under the 1994 Act bestows a monopoly on the proprietor".

14) Further, in *YouView TV Ltd v Total Ltd* ('*YouView*') [2012] EWHC 3158 (Ch) Floyd J said:

"... 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."

15) Whether goods/services are complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), will depend on whether there exists a close connection or relationship such that one is important or indispensable for the use of the other. In *Boston Scientific Ltd v Office for Harmonization in the*

Internal Market (Trade Marks and Designs) (OHIM) ('Boston Scientific') Case T-325/06 it was stated:

“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).”

16) The opponent contends:

“The mark we are opposing include goods in Class 18 which, according to the Trade mark cross search list of the UK Intellectual Property Office, are similar to “Articles of clothing” in Class 25. Our mark is registered in respect of “Clothing” and other goods in Class 25. Therefore, the goods of our mark and the mark we are opposing are similar.”

This submission does not assist the opponent. The cross search list is merely a guide to be used during the examination process; it is not determinative of the question of similarity of goods (or services) in inter partes proceedings (and, in any event, the cross search list does not state, as the opponent appears to assert, that all goods in class 18 are similar to ‘Articles of Clothing’ in class 25; rather it states that ‘handbags and purses’ in Class 18 *may* be considered to be similar to ‘Articles of Clothing’ in class 25). In *Proctor & Gamble Company v Simon Grogan*, O-176-08, Anna Carboni, sitting as the Appointed Person, stated:

“32. The International Classification system also applies to Community trade marks. Rule 2(4) of Commission Regulation 2868/95/EC implementing the Regulation on the Community trade mark (40/94) states as follows:

(4) The classification of goods and services shall serve exclusively administrative purposes. Therefore, goods and services may not be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification, and goods and services may not be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

33. It is thus made plain under the Community trade mark system that class numbers are irrelevant to the question of similarity of goods and services.

34. There is no similarly plain provision in the Act or the Directive. The Court of Appeal has held that, although the purpose of classifying goods and services is primarily administrative, that does not mean that the class numbers in an application have to be totally ignored in deciding, as a matter of

construction, what is covered by the specification: *Altecnic Ltd's Trade Mark Application (CAREMIX)*. But neither the Court of Appeal, nor the ECJ, nor any other court or tribunal in the United Kingdom, has gone so far as to state that class numbers are determinative of the question of similarity of goods in the case of national trade marks. On the contrary, they are frequently ignored.”

17) In deciding whether the respective goods are similar it is necessary to consider the factors set out in the case law in paragraphs 12-15 above. Having done so, I have no hesitation in concluding that the respective goods are not similar. The opponent's goods in class 25 are those which are for the purpose of clothing humans. The applicant's class 18 goods are clothing and accessories for dogs. The users are not the same, the uses are not the same, the trade channels are unlikely to converge and they are patently not in competition or complementary.

18) As there cannot be a likelihood of confusion where there is no similarity between the respective goods, the opponent has no prospect of success. To this end, see, for example, *Waterford Wedgwood plc v OHIM – C-398/07 P*, where the CJEU stated:

“35...Since the Court of First Instance found, in paragraph 35 of the judgment under appeal, that the goods in question were not similar, one of the conditions necessary in order to establish a likelihood of confusion was lacking (see, to that effect, *Canon*, paragraph 22) and therefore, the Court of First Instance was right to hold that there was no such likelihood.”

The opposition fails.

COSTS

19) The applicant has been successful and, as such, is entitled to a contribution towards its costs. I take into account that the applicant has represented itself in these proceedings and, therefore, will not have incurred legal fees. I award the applicant £100 for considering the notice of opposition and filing a counterstatement.

20) I order EPO Fashion Co., Ltd. to pay Edition Twelve Limited the sum of **£100**. 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 16th day of June 2016

**Beverley Hedley
For the Registrar,
the Comptroller-General**