

O-616-17

**TRADE MARKS ACT 1994  
IN THE MATTER OF  
TRADE MARK APPLICATION NO 3190060  
BY BUTTERFLY JUNGLE LONDON LTD  
TO REGISTER**



**AS A TRADE MARK (SERIES OF 2)  
IN CLASS 25  
AND OPPOSITION THERETO (UNDER NO. 408362)  
BY  
TAMASU BUTTERFLY EUROPA GMBH**

## BACKGROUND & PLEADINGS

1. Butterfly Jungle London Ltd ('the applicant') applied to register the marks outlined on the title page as a series of two on 8 October 2016 for the following goods in class 25: **Beachwear; Bikinis; Dresses; Evening wear; Footwear; Headwear; Leather clothing; Lingerie; Silk clothing; Swimwear.** The marks were published for opposition purposes on 28 October 2016.

2. Tamasu Butterfly Europa GmbH ('the opponent') opposes this application under Section 5(2)(b) of the Trade Marks Act 1994 ('the Act') on the basis of all the class 25 goods registered under their EU trade mark set out below:

EU TM 11145109
<b>Butterfly</b>
Filing date: 28 August 2012
Date of entry in register: 28 December 2012

3. The applicant filed a counterstatement in which it denied the grounds of opposition.

4. The opponent's trade mark is an earlier mark, in accordance with section 6 of the Act, but had not been registered for five years or more at the publication date of the applicant's mark, so it is not subject to the proof of use requirements, as per section 6A of the Act.

5. Neither party requested a hearing. Only the opponent filed written submissions in lieu. I now make this decision on the basis of all of the papers before me.

6. The applicant represented themselves in these proceedings and the opponent is represented by RDP Rohl Dehm & Partner mbB.

## DECISION

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

8. The leading authorities which guide me are from the Court of Justice of the European Union ('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

9. The goods to be compared are:

Opponent's goods	Applicant's goods
<p>Clothing, in particular outerclothing, winter jackets, windbreakers, fleece jackets, underpants, T-shirts, sportswear and leisurewear, sport shirts, sport trousers, training suits, jogging suits and leotards, sweatbands and headbands, knitwear, in particular stockings, socks, sports socks, sweaters, singlets, jersey clothing; Knitwear (clothing), in particular jumpers, sweatshirts; Terry-towelling goods, namely bathrobes; Footwear, particularly athletic shoes for tennis and table tennis; Headgear, in particular caps.</p>	<p>Beachwear; Bikinis; Dresses; Evening wear; Footwear; Headwear; Leather clothing; Lingerie; Silk clothing; Swimwear</p>

10. With regard to the comparison of goods and services, in *Canon* the CJEU stated at paragraph 23 of its judgment that:

“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”.

11. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) 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;
- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

12. In *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM Case T-133/05) (*'Meric'*), the General Court ('GC') held:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

13. In the counterstatement the applicant states:

“[the opponent]...is selling winter jackets, sweatshirts and mainly sports related clothing and athletic shoes. I'm selling high end womens [sic] designer silk dresses and beachwear. Winter sports and summer elegant [sic] have nothing in common”.

14. I note the applicant's submission regarding the kinds of goods that it currently uses its mark on. The way in which either party currently uses their marks is irrelevant. I must compare the parties' goods on the basis of notional and fair use of the goods listed in the parties' specifications. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. stated that:

"78. ....the court must.... consider a notional and fair use of that mark in relation to all of the goods or services in respect of which it is registered. Of course it may have become more distinctive as a result of the use which has been made of it. If so, that is a matter to be taken into account for, as the Court of Justice reiterated in *Canon* at paragraph [18], the more distinctive the earlier mark, the greater the risk of confusion. But it may not have been used at all, or it may only have been used in relation to some of the goods or services falling within the specification, and such use may have been on a small scale. In such a case the proprietor is still entitled to protection against the use of a similar sign in relation to similar goods if the use is such as to give rise to a likelihood of confusion."

15. With regard to *Footwear; Headwear* in the applicant's specification, these are considered identical to *Footwear, particularly athletic shoes for tennis and table tennis; Headgear, in particular caps* in the opponent's specification on the *Meric* principle outlined above. I make this finding on the basis that the term 'particularly' and 'in particular' are not considered to be limitations so the terms that precede them, i.e. footwear and headgear cover all types of these goods.

16. The remainder of the applicant's goods, namely *Beachwear; Bikinis; Dresses; Evening wear; Leather clothing; Lingerie; Silk clothing; Swimwear* will be covered by the broad term *clothing* in the opponent's specification and are considered identical goods on the *Meric* principle.

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

17. I must now consider the role of the average consumer and how the goods are purchased. 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*.

18. 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.”

19. The contested goods in this matter include clothing. In *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs)* Joined Cases T-117/03 to T-119/03 and T-171/03, the General Court ('GC') stated:

“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.”

20. As stated by the GC, items of clothing vary in price and quality. The same can be said of footwear and headgear. Ordinarily I would expect a normal level of attention to be paid by the consumer when selecting such goods. The purchasing act will be mainly visual as the goods are commonly purchased on the basis of their aesthetic appeal and functionality. It is likely they will be selected after viewing of racks/shelves in retail establishments, or from images on Internet websites or in catalogues. However, I do not discount any aural considerations which may also play a part.

### COMPARISON OF THE MARKS

21. The marks to be compared are:



22. 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 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.”

23. It would be wrong, therefore, artificially to 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.

24. The opponent's trade mark consists of a single word **BUTTERFLY** in plain block capitals. The overall impression of the mark and its distinctiveness rests solely in that word.

25. The applicant's marks were filed as a series of two. The marks are identical save for a dark background on one mark which is not present in the other mark. The marks are a composite arrangement consisting of the words **Butterfly Jungle** in title case in a cursive script with a device of a leaf on a branch and a second device of two circles. The devices are positioned above the words. The opponents submits that “a figurative element of the contested mark is a Butterfly as well”. I take that submission as meaning that the two circles resemble a butterfly. I do not think the device is that clear cut. It is an abstract image which may or may not lead an average consumer to see it as a butterfly. In marks which consist of both words and

devices, it is a general rule of thumb that the words will speak louder than the devices. I consider that rule to be applicable in this case. Although the devices are significant in terms of their size and stylisation and will make a visual impact, the marks are likely to be referred to by the **Butterfly Jungle** word elements. In my view neither word dominates the other and both make an equal contribution to the overall impression. I consider that the use of a dark background (in the applicant's second mark) plays only a weak role, the only effect being that the dark background provides a variant contrast against which the words may be read.

26. In a visual comparison, the point of similarity is the word **Butterfly**. It is the whole of the opponent's mark and one of the two word elements of the applicant's marks. The opponent's mark has no other elements whereas the applicant's mark contains the device element and the additional word **Jungle**. The opponent submits in their visual comparison that "Jungle is only a location and the public will give no particular attention to this part". I am not inclined to agree with this particular submission. In my view the word 'jungle' will be clearly seen and read as part of the two word element of the applicant's marks. Nevertheless taking these factors into account, overall I find there to be a medium degree of visual similarity.

27. In an aural comparison, the opponent's mark **butterfly** is a well-known English word and will be given its usual pronunciation. The **butterfly** element of the applicant's mark will be pronounced identically. An average consumer will then go on to vocalise the second word element **Jungle**. The devices will not be vocalised. Overall I find there to be a medium degree of aural similarity.

28. In a conceptual comparison, the opponent's mark will bring to mind the concept of a butterfly. The applicant's marks are likely to bring to mind a jungle filled with butterflies. I find that there is some similarity of ideas between the marks although the opponent's mark has a more direct concept of an insect. With regard to the device element, although the opponent stated that the 'figurative element of the contested mark is a Butterfly', I have previously found that this is not necessarily the case for all consumers. If they do see the two circle device as a butterfly then the concept of an insect is reinforced but if they do not then the device is conceptually

neutral. Taking all these factors into account, I find there to be a medium degree of conceptual similarity.

## **DISTINCTIVE CHARACTER OF THE EARLIER MARK**

29. In *Lloyd Schuhfabrik Meyer* 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).”

30. The opponent has not filed any evidence to indicate that the earlier mark enjoys any enhanced distinctiveness, therefore I only have the inherent position to consider. The opponent’s mark consists of an ordinary dictionary word which is not descriptive of the goods it is registered for. On that basis, I find that there is an average level of inherent distinctiveness.

## LIKELIHOOD OF CONFUSION

31. I must now draw together my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors and those outlined in paragraph 8:

- a) The interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon*).
- b) The principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*).
- c) The factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer*).

32. Confusion can be direct (when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related). In terms of indirect confusion, this was dealt with by 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 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”.

33. Furthermore in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

34. So far I have found that the contested goods are identical and that the goods are primarily purchased visually by a member of the general public who will be paying a normal level of attention during the purchasing process. In addition I have found that the earlier mark has an average level of inherent distinctiveness but that the contested marks are visually, aurally and conceptually similar only to a medium degree.

35. Based on the marks and the goods before me and taking into account the assessments I have made, I conclude that there is a no likelihood of confusion. One of the factors that lead me to this conclusion is the point outlined in paragraph 33. The marks do share a single common element but the applicant's marks have a significantly different visual, aural and conceptual impact which may well bring the earlier mark to mind because of the common element but will not be confused either directly or indirectly.

## **CONCLUSION**

36. The opposition fails under section 5(2)(b).

## **COSTS**

37. The applicant has been successful and is therefore, in principle, entitled to a contribution towards its costs. As the applicant is unrepresented, at the conclusion of the evidence rounds the tribunal invited them to indicate whether they wished to make a request for an award of costs, and if so, to complete a pro-forma including a breakdown of their actual costs, including providing accurate estimates of the number of hours spent on a range of given activities relating to the defence of the

opposition; it was made clear to the applicant that if the pro-forma was not completed “no costs will be awarded”. The applicant did not respond to that invitation. Consequently, I make no order as to costs.

**Dated this 4<sup>th</sup> day of December 2017**

**June Ralph  
For the Registrar  
The Comptroller-General**