

O-055-18

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3128049
BY ROOM SEVEN B.V. TO REGISTER THE TRADE MARK**

Room Seven

IN CLASS 18

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. 405921
BY SEVEN S.P.A.**

Background and pleadings

1) Room Seven B.V. (“the applicant”) applied to register, under no 3128049, the mark “Room Seven” in the UK on 22 September 2015. It was accepted and published in the Trade Marks Journal on 30 October 2015. The goods covered by the application, subject to these proceedings are as follows:

Class 18: ...; *goods made of these materials* [being leather and imitation leather] *including luggage, suitcases, trunks, travelling bags; shopping bags, ..., handbags, leather bags, leather imitation bags.*

2) Seven S.p.A. (“the opponent”) opposes the application, insofar as it is applied for in respect of the goods listed above, on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). It claims that the application is in respect of a mark similar to those of the opponent, and in respect of identical or similar goods. It relies upon the following earlier European Union Trade Mark (“EUTM”) 8728651:

Mark: SEVEN Filing date: 2 December 2009 Date of entry in register: 2 June 2010	Goods relied upon: Class 16: ... Class 18: ... backpacks, rucksacks, school bags, ..., bags, shopping bags, travelling bags and holdalls, bags and holdalls for sport; handbags; ...; portfolio bags; notecases; pouches (bags); ...; valises; ...; overnight bags.
--	---

3) By virtue of having a filing date that predates the filing date of the contested mark, the opponent’s EUTM qualifies, under section 6 of the Act, as an earlier mark for the purposes of these proceedings. The earlier mark completed its registration procedure more than 5 years before the publication of the contested mark and, consequently, it is subject to the proof of use provisions set out in section 6A of the Act.

4) The applicant filed a counterstatement denying the claims made and putting the opponent to proof of use of its earlier mark. The applicant points out that it is also the proprietor of an International Registration designating the EU (“IREU”) in respect of the same mark and goods that pre-dates the earlier EUTM relied upon in these proceedings and co-exists with it on the EU register. It further claims that the word “seven”, because of its wide spread use, is of low distinctive character.

5) Both sides filed evidence and the opponent also filed written submissions. I keep the latter in mind, but I will not summarise them. I hearing took place on 13 December 2017 when the opponent was represented by Ross Manaton for Broomhead Johnson and the applicant by Alaina Newnes of counsel, instructed by CMS Cameron McKenna Nabarro Olswang LLP.

Opponent’s evidence

6) This takes the form of a witness statement by Aldo Rosario Di Stasio, Managing Director of the opponent. It is in Italian and a translation is provided under cover of a witness statement by Livia Pasqualigo, a trade mark attorney with the Italian firm Buzzi Notaro & Antonielli d’Oulx S.r.l.. Ms Pasqualigo states that she is an Italian citizen and certifies that the translation of Mr Di Stasio’s witness statement is a true translation.

7) Mr Di Stasio's states that the purpose of his first witness statement is to provide evidence of the opponent's genuine use. Mr Di Stasio provides turnover figures, invoices and catalogue pages in an attempt to demonstrate genuine use of the mark relied upon. At the hearing, Ms Newnes conceded that use had been shown, but that this use was only in respect of the following marks:





8) Numerous invoices are provided to support the claim to genuine use and these have the second of the above marks appearing at the top of each. In addition, numerous items of goods where their description includes the word SEVEN, such as:

“DOUBLE BACKPACK SEVEN GROOVE”

“DOUBLE BACKPACK SEVEN BEAT”

“ZAINO ADVANCED SEVEN SOUND”

“ZAINO ADVANCED SEVEN HIP HOP”

“MAXI TROLLEY ROUND SEVEN”

“SOFTBACKPACK SEVEN REMIX BOY”

9) Further, at his Exhibit ARDS5, Mr Di Stasio’s provides a copy of an invoice for 12 bags in July 2014. The total price is €78.66. A catalogue page showing the goods is also provided and illustrates the goods as follows:



Applicants’ evidence

10) This takes the form of a witness statement by Niels Bot, Chief Executive Officer of the applicant. He states that the applicant has been active since 1995 and he provides evidence of its activities in the EU. However, there is no claim to concurrent

use in the UK. Therefore, I do not summarise the evidence of the applicant's use in the EU.

11) Mr Bot states that:

- “seven or 7” is a common word/letter used throughout history and used in many industries;
- “seven” is used widely throughout the fashion and bag industry and at Exhibit 13 he provides size charts for shoes and apparel. He observes these sizes are all expressed in numbers, e.g. UK Size 7 for shoe and hat sizes;
- There is a link between the numeral seven and bags. At Exhibit 14 he provides an Internet extract offering for sale a lightweight postal bag, size 7;
- There are a number of third party uses of “seven” in company names or slogans for the fashion and bag industry such as “7bags”, “Misty Seven” fashion bags, Osprey Europe having a “24-seven-series”, a luxury fashion house called “7forallmankind” and a UK brand for eco friendly bags called “The Seventh Heaven”.

12) At Exhibit 16, Mr Bot provides a copy of a decision (Opp 15-5483/PCO, dated 2 June 2016) from the French trade mark registry together with a sworn translation. He draws attention to the decision maker finding that the marks are dissimilar.

13) Mr Bot also makes numerous criticisms regarding the opponent's evidence of use and makes a number of submissions regarding the similarity of the respective marks. I will keep these in mind, but not detail them here.

Opponent's evidence-in-reply

14) This takes the form of a further witness statement by Mr Di Stasio, together with a translation provided under the cover of a further witness statement by Ms Pasqualigo.

15) In an attempt to address criticisms of his first witness statement, Mr Di Stasio:

- provides evidence of the opponent's distribution outlets outside of Italy;
- states that the opponent operates a multilingual online store with sections dedicated to various countries within the EU and worldwide. Printouts of the online store are provided at Exhibit ARDS29;
- states that the opponent sells its goods throughout Italy via nationwide stores and supermarkets.

16) Mr Di Stasio also makes a number of submissions that I will keep in mind.

DECISION

Proof of Use

17) For reasons of procedural economy I will not decide the issue of whether the opponent has made genuine use of its earlier EUTM. For the purposes of this decision, it is sufficient that I proceed on the basis that it has demonstrated such use.

Section 5(2)(b)

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

Comparison of goods

19) At the hearing, Ms Newnes accepted that the respective goods are identical or highly similar.

Comparison of marks

20) The respective marks are:

Opponent's mark	Applicant's mark
SEVEN	ROOM SEVEN

21) It is clear from the judgment of Court of Justice of the European Union (“the CJEU”) in *Sabel BV v Puma AG*, Case C-251/95 (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.”

22) It would be wrong, therefore, to artificially dissect the 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.

23) The opponent's mark consists of the single word SEVEN and this is, self-evidently, the dominant and distinctive element. The applicant's mark consists of the two words ROOM SEVEN. The opponent submits that the word SEVEN is the

dominant and distinctive element. I do not agree. As Ms Newnes submitted, the two words combine to form a unit that describes a room codified by the numeral “seven”. Therefore, its distinctive character resides in its totality with no one element more dominant than the other.

24) Visually, the marks differ in that the applicant’s mark includes the word ROOM that appears in front of the word SEVEN that is present in both marks. The applicant’s mark is, therefore, nearly twice the length of the opponent’s mark and consists of two words not one. At the hearing, Ms Newnes submitted that there was only a low level of visual similarity because there will be a focus on the beginning of each mark. I do not disagree with the rationale, but taking account that the word SEVEN being present in both marks, I conclude that the respective marks share a low to medium level of visual similarity.

25) Aurally, Ms Newnes submitted that there are significant differences between the marks with the first word of the applicant’s mark being the word ROOM which has entirely different vowels and consonant sounds. Ms Newnes also submitted that the applicant’s mark is significantly longer than the opponent’s mark and that it is the first word that is aurally the most distinctive. The applicant’s mark will naturally split into the three syllables ROOME-SEV-EN, therefore they are identical in respect of two syllables and differ in respect of one. Taking this into account, I find that the aural differences are not as great as Ms Newnes submitted. Nevertheless, I would not put aural similarity any higher than medium.

26) The applicant puts forward an argument that the numeral “7” is used to indicate a size in the fashion industry. Whilst I do not dispute this, I keep in mind that in these proceedings, it is the word SEVEN that is in issue rather than the numeral itself. There is nothing before me to show that the word is used to designate size. This alone would not be persuasive, however, the applicant’s evidence aimed at illustrating that it is also used to indicate a size of bag is weak. There is only one example, which in itself is a reason to find it not to be persuasive but additionally, as the opponent points out, it appears to show a padded envelope rather than a bag proper to Class 18. Nevertheless, I agree with Ms Newnes’ submission that the marks are conceptually distinct because the word SEVEN will be perceived as a

reference to the number seven, whereas the phrase ROOM SEVEN will be perceived as a reference to a room numbered 7. Therefore, the marks are conceptually dissimilar.

Average consumer and the purchasing act

27) 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.

28) 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.”

29) All of the parties' goods are normally purchased from high street or Internet retailers. These goods are usually selected for their aesthetic qualities and, as a result, the purchasing act is usually visual. Certainly, there is nothing before me to lead me to conclude differently. However, I do not ignore the aural considerations that may be involved. The purchase of bags and similar goods is, if not an everyday purchase, certainly not unusual. Taking this into account, I conclude that the level of attention paid by the consumer during the purchasing process is reasonable rather than high.

Distinctive character of the earlier trade mark

30) 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).”

31) There is no claim to enhanced distinctive character, therefore, I need only consider the level of inherent distinctive character. The earlier mark consists of the word SEVEN. This is an ordinary dictionary word that will be readily understood by the average consumer. Ms Newnes submitted that it is a word commonly used in third party marks and that it is widely used in the UK in company names or slogans. Whilst I acknowledge this, when presented alone, the word SEVEN has distinctive character. Taking all of this into account, I conclude that whilst the mark is not endowed with the highest level of distinctive character, neither is it the lowest. I conclude that it is endowed with a moderate degree of inherent distinctive character.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.

32) The following principles are gleaned from the decisions of the CJEU 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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

33) I must adopt the global approach advocated by case law and take into account that marks are rarely recalled perfectly with the consumer relying instead on the imperfect picture of them he has in kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). I must take into account all factors relevant to the circumstances of the case and in particular the interdependence between the similarity of the marks and that of the goods or services designated (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*).

34) I have found, or it has been conceded that:

- the respective goods are identical or highly similar;

- the respective marks share a low to medium level of visual similarity, no higher than a medium level of aural similarity and I also found that they are conceptually dissimilar;
- the distinctive character of both marks resides in their totalities with the two separate words creating the applicant's mark forming a unit that describes a room codified by the numeral "seven";
- the purchasing process is mainly visual in nature, but I keep in mind that aural considerations may play a role;
- the level of care and attention paid by the average consumer in the purchase of the relevant goods is reasonable rather than high;
- the opponent's mark is endowed with a moderate degree of inherent distinctive character and that this is not enhanced through use.

35) I keep all of the above in mind. The key issue in this case is whether the word SEVEN retains an independent distinctive role in the applicant's mark such that upon the average consumer encountering it, it will be perceived as being the same as the opponent's mark or that it is identifying goods that originate from the same or linked undertaking. In considering this point, I am mindful of the following further comments from the CJEU in *Bimbo SA v OHIM*, C-591/12 P:

21 The global assessment of the likelihood of confusion, in relation to the visual, aural or conceptual similarity of the marks at issue, must be based on the overall impression given by the marks, account being taken, in particular, of their distinctive and dominant components. The perception of the marks by the average consumer of the goods or services in question plays a decisive role in the global assessment of that likelihood of confusion. In this regard, the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (see, to that effect, *SABEL* EU:C:1997:528, paragraph 23; *OHIM v Shaker* EU:C:2007:333, paragraph 35; and *Nestlé v OHIM* EU:C:2007:539, paragraph 34).

- 22 The assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole (*OHIM v Shaker* EU:C:2007:333, paragraph 41).
- 23 The overall impression conveyed to the relevant public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components. However, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element (*OHIM v Shaker* EU:C:2007:333, paragraphs 41 and 42, and *Nestlé v OHIM* EU:C:2007:539, paragraphs 42 and 43 and the case-law cited).
- 24 In this connection, the Court of Justice has stated that it is possible that an earlier mark used by a third party in a composite sign that includes the name of the company of the third party retains an independent distinctive role in the composite sign. Accordingly, in order to establish the likelihood of confusion, it suffices that, on account of the earlier mark still having an independent distinctive role, the public attributes the origin of the goods or services covered by the composite sign to the owner of that mark (Case C-120/04 *Medion* EU:C:2005:594, paragraphs 30 and 36, and order in Case C-353/09 P *Perfetti Van Melle v OHIM* EU:C:2011:73, paragraph 36).
- 25 None the less, a component of a composite sign does not retain such an independent distinctive role if, together with the other component or components of the sign, that component forms a unit having a different meaning as compared with the meaning of those components taken separately (see, to that effect, order in Case C-23/09 P *ecoblue v OHIM and Banco Bilbao Vizcaya Argentaria* EU:C:2010:35, paragraph 47; *Becker v Harman International Industries* EU:C:2010:368, paragraphs 37 and 38; and order in *Perfetti Van Melle v OHIM* EU:C:2011:73, paragraphs 36 and 37).

36) Arnold J in *Whyte and Mackay Ltd v Origin Wine UK Ltd* [2015] EWHC 1271 (Ch) commented on the same issue as follows:

19 ... In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 ... [However] It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

37) Ms Newnes submitted that the applicant's mark forms a unit to create a phrase that describes a room codified by the number seven. I agree. It is describing a location whereas the opponent's mark consists of the written form of the number "7" and therefore, conceptually, it is no more or less than a description of the seventh number. This conceptual difference between the marks is very likely to be sufficient to result in no confusion between the marks (either "direct" where the consumer confuses one mark for another, or "indirect", where the consumer does not confuse the marks but, nevertheless, believes that goods provided under each mark originate from the same or linked undertaking).

38) Such a finding appears to be consistent with the comments of Geoffrey Hobbs, Q.C., sitting as the appointed person in *Cardinal Place Trade Mark*, BL-O-339-04 where he found that the addition of the word "Place" to the word "Cardinal" had the effect of changing the meaning from an ecclesiastical one to one of a location.

39) Mr Manaton drew my attention to a decision of the EUIPO Board of Appeal (Appeal No. R955/2012-4) between the same parties and involving the same marks

where it was held that there was a likelihood of confusion “at least in Italy” (paragraph 27). He also relied upon a related decision of the Board of Appeal (R1490/2014-4) that found that the refused mark could not be converted to a UK national mark. I have taken note of these, but:

- I am not bound to follow them and, as an independent decision maker, I must consider the facts before me and reach my own independent decision;
- I note that decision R0955/2012-4 records that there is a likelihood of confusion “at least in Italy”. This stops short of concluding that there is a likelihood of confusion for UK consumers, and;
- Whilst the latter decision (R1490/2014-4) finds that the refused mark cannot be converted to national marks including a UK national mark, it was not because the finding of likelihood of confusion extended to the UK consumer, but because the earlier mark relied upon was a Community Trade Mark. In accordance with Article 112(2)(b) of the Community Trade Mark Regulation, the unitary nature of a Community Trade Mark is such that a relative grounds finding that confusion is likely in one territory of the EU is sufficient to prevent conversion to national marks in any other EU territory. However, it does not necessarily follow that the consumers in other EU territories will also be confused.

40) Consequent to all of the above, I reach the conclusion that my finding does not conflict with the finding of the EUIPO Board of Appeal but, nonetheless, even if it did, it is a finding I am entitled to reach.

41) In light of my finding regarding likelihood of confusion, even if the opponent has genuinely used its mark, it would not assist it in these proceedings. Consequently, the opposition fails in its entirety and the application can proceed to registration.

COSTS

42) The applicant has been successful and is entitled to a contribution towards its costs, according to the published scale in Tribunal Practice Notice 4/2007. I take

account that both sides filed evidence, that the opponent filed written submissions and that a hearing was held. With this in mind, I award costs as follows:

Considering other side's statement and preparing counterstatement	£300
Preparing evidence and considering other side's evidence	£900
Preparing for & attending hearing	£900
Total:	£2100

43) I order Seven S.p.A. to pay Room Seven B.V. the sum of £2100 which, in the absence of an appeal, should be paid within 14 days of the expiry of the appeal period.

Dated this 24th day of January 2018

Mark Bryant
For the Registrar
The Comptroller-General