

O/371/18

TRADE MARKS ACT 1994

IN THE MATTER OF
INTERNATIONAL REGISTRATION NO. WO1281319 IN CLASS 28
DESIGNATING THE UNITED KINGDOM
BY SEO JAE HONG



AND OPPOSITION THERETO (UNDER NO. 410047)


BY
CHARLES CLAIRE LLP

Background & pleadings

1. Seo Jae Hong ('the holder') is the holder of International Registration (IR) WO1281319 ('the designation) in respect of the mark outlined on the title page. Protection in the UK was requested on 3 February 2017 in respect of the following class 28 goods: *Golf bags; golf balls; golf gloves; golf clubs; golf club grips; golf club shafts; golf club heads; head covers for golf clubs; Boston bags specially adapted for golf; shaped covers for golf clubs; golf tees; mannequin dolls; pet toys; plaything dolls; fashion dolls; toys; golf putting mats.*

2. The IR was published in the United Kingdom, for opposition purposes, on 19 May 2017. Charles Claire LLP ('the opponent') opposes the designation under Section 5(2)(b) of the Trade Marks Act 1994 ('The Act') on the basis of the class 28 goods in its earlier EU trade marks outlined below. Initially the opponent had also pleaded the additional grounds of Section 5(3) and 3(6), but these grounds were subsequently withdrawn in the opponent's correspondences dated 19 January and 23 January 2018.

EU000230433 BLACK CAT Filing date: 17 April 1996 Date of entry in register: 27 November 1998	Class 28: Golf clubs and parts thereof, namely clubheads, shafts, grips; covers for golf heads (headcovers), golf balls, golf tees, golf bags, caddy bags; golf gloves.
EU000806877 CRYSTAL CAT Filing date: 17 April 1998 Date of entry in register: 27 June 2002	Class 28: Golf clubs
EU00230391 LYNX Filing date: 17 April 1996 Date of entry in register: 17 May 1999	Class 28: Golf clubs and parts thereof, namely clubheads, shafts, grips; covers for golf heads (headcovers), golf balls, golf tees; golf bags, caddy bags; golf gloves

<p>EU000242131</p>  <p>Filing date: 29 April 1996 Date of entry in register: 21 April 1999</p>	<p>Class 28: Golf clubs and parts thereof, namely clubheads, shafts, grips; covers for golf heads (headcovers), golf balls, golf tees; golf bags, caddy bags; golf gloves.</p>
<p>EU000637975</p> <p>SILVER CAT</p> <p>Filing date: 23 September 1997 Date of entry in register: 1 June 1999</p>	<p>Class 28: Equipment for use in playing the game of golf; golf clubs</p>

3. The opponent's above mentioned trade marks all have filing dates that are earlier than the date of the holder designating the UK and, therefore, they are all earlier marks, in accordance with Section 6 of the Act. As the registration procedures were completed more than 5 years prior to the publication date of the contested designation, they are subject to the proof of use conditions, as per section 6A of the Act. The opponent made a statement of use in respect of all the goods it relies on.

4. The holder filed a counterstatement in which it denied the grounds of opposition but did not put the opponent to proof of use. Consequently, the opponent is entitled to rely on the full breadth of the goods for which it made a statement of use.

5. In these proceedings, the holder is representing himself and the opponent is represented by Briffa.

6. The holder filed evidence and written submissions in lieu of a hearing whilst the opponent only filed submissions. I do not intend to summarise the holder's evidence here but will refer to it in the decision if it becomes necessary. I make this decision based on the papers before me.

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. With regard to the comparison of goods, in the judgment of the CJEU in *Canon*, Case C-39/97, the court 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”.

10. 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 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. 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.

11. Furthermore in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court stated that:

“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 trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

12. The goods to be compared are outlined below. Since three of the Opponent's earlier marks share the same class 28 specification, this has just been listed once.

Opponent's goods	Holder's goods
Golf clubs and parts thereof, namely clubheads, shafts, grips; covers for golf heads (headcovers), golf balls, golf tees, golf bags, caddy bags; golf gloves.	Golf bags; golf balls; golf gloves; golf clubs; golf club grips; golf club shafts; golf club heads; head covers for golf clubs; Boston bags specially adapted for golf; shaped covers for golf clubs; golf tees; mannequin dolls; pet toys; plaything dolls; fashion dolls; toys; golf putting mats
Golf clubs	
Equipment for use in playing the game of golf; golf clubs	

13. It is self-evident that many of the golfing goods in the holder's specification, namely *Golf bags; golf balls; golf gloves; golf clubs; golf club grips; golf club shafts; golf club heads; head covers for golf clubs; Boston bags specially adapted for golf; shaped covers for golf clubs; golf tees* are identical to the opponent's goods listed above. With regard to *golf putting mats* in the holder's specification this will be

covered by the opponent's term *Equipment for use in playing the game of golf* so is considered identical on the *Merck* principle.

14. In relation to the remainder of the holder's goods, namely *mannequin dolls; pet toys; plaything dolls; fashion dolls; toys*, I note paragraph 16 of the holder's counterstatement in which the holder states that,

“Persian cat hangs accessory dolls on the golf bags and covers”.

15. Since *mannequin dolls; pet toys; plaything dolls; fashion dolls; toys* relate to goods that are used as adornments or decoration for golf bags and covers, then I must consider them to be similar goods to those goods in the opponent's specifications as at the very least the users of the goods, namely golfers, will be the same and the channels of trade, namely golf shops or golf sections of larger retail establishments, by which the goods reach the marketplace will be the same.

Average Consumer and the purchasing process

16. I must next consider who the average consumers are for the contested goods and how those 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 in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

17. 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.”

18. The average consumers for the contested goods are members of the general public with an interest in golf. The contested goods can vary in price, for example golf tees being an inexpensive purchase to golf clubs being much more expensive. The average consumer is likely to pay a varying amount of attention to the contested goods. For example, the purchase of golf tees will merit less attention than the purchase of say golf clubs which need to be considered in conjunction with a golfer's physique, technique, ability etc. These purchases would either come from traditional bricks and mortar retail outlets or from online retailers. The goods are likely to be purchased visually especially as purchasers may wish to handle goods such as golf clubs to get a feel for weight or grip but I do not discount aural considerations such as word of mouth recommendations or advice sought from a golfing retailer or other golfing professional.



Comparison of the marks

19. 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.”

20. 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.

21. The marks to be compared are:

Opponent's marks	Holder's mark
BLACK CAT	
CRYSTAL CAT	
LYNX	
SILVER CAT	
	

22. The holder's mark is a composite arrangement of a device of a cat's head wearing a crown, monocle and moustache, outlined with broken lines, then two smaller devices of a cat's pawprints either side of the words **Persian cat** which is depicted in a manuscript style font curved below the cat's head device. The cat's head device here is significant in terms of its size, position and stylisation and makes a substantial visual impact. So combined with the words **Persian cat**, which is likely to be taken as describing the cat's head device, makes the word and device elements equally dominant and distinctive within the mark as they are conceptually linked.

23. The opponent's first four earlier marks consist of word only marks, namely **BLACK CAT**, **CRYSTAL CAT**, **LYNX** and **SILVER CAT** in plain block capitals. The overall impression of these marks are based solely on these words.

24. The opponent's fifth earlier mark consists solely of a device of a cat's head, with no other elements. The overall impression of this mark is based on this presentation.

25. In terms of a visual comparison, and taking the opponent's word only earlier 'cat' marks first, there is clearly a commonality in the word **CAT** which is shared by the holder's mark and the opponent's **BLACK CAT**, **CRYSTAL CAT** and **SILVER CAT** marks. The opponent states that,

"all expressions are tri-syllabic with the last syllable being identical, using the word 'CAT' ".

I note the submission regarding the syllabic construction. However, it remains that the contested marks all have different first words, and in *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the General Court noted that the beginnings of word tend to have more visual and aural impact than the ends. The court stated:

"81. It is clear that visually the similarities between the word marks MUNDICOLOR and the mark applied for, MUNDICOR, are very pronounced. As was pointed out by the Board of Appeal, the only visual difference between the signs is in the additional letters 'lo' which characterise the earlier marks and which are, however, preceded in those marks by six letters placed in the same position as in the mark MUNDICOR and followed by the letter 'r', which is also the final letter of the mark applied for. Given that, as the Opposition Division and the Board of Appeal rightly held, the consumer normally attaches more importance to the first part of words, the presence of the same root 'mundico' in the opposing signs gives rise to a strong visual similarity, which is, moreover, reinforced by the presence of the letter 'r' at the end of the two signs. Given those similarities, the holder's argument based on the difference in length of the opposing signs is insufficient to dispel the existence of a strong visual similarity.

82. As regards aural characteristics, it should be noted first that all eight letters of the mark MUNDICOR are included in the MUNDICOLOR marks.

83. Second, the first two syllables of the opposing signs forming the prefix 'mundi' are the same. In that respect, it should again be emphasised that the attention of the consumer is usually directed to the beginning of the word. Those features make the sound very similar.

Taking this into account I find that there is only a low degree of visual similarity between the contested marks.

26. The Opponent's other word mark **LYNX** has no visual similarity at all with the holder's mark as it is an entirely different word from the word element of the holder's mark.

27. In considering the opponent's device only mark, I find that whilst at the most general level both the opponent's mark and the holder's device element consist of a cat's head, there are considerable visual differences between them. The opponent's mark resembles the head of a wildcat, the holder's mark is more cartoon-like and has accessories such as a crown, monocle and moustache. The holder's mark also has the additional words **Persian cat**, whereas the opponent's mark has no other element to it. Taking these factors in to account, I find only a low degree of visual similarity.

28. Turning now to the aural comparison, again the opponent's **BLACK CAT**, **CRYSTAL CAT** and **SILVER CAT** marks share the common element **CAT** with the holder's mark. The word 'cat' will be pronounced identically in each case but all the marks have different first words. As outlined above in the *El Corte Ingles* case law, it is the beginnings of mark which are considered to have greater aural impact. With that in mind I find there is only a low degree of aural similarity.

29. The opponent's other word only mark, **LYNX**, has no aural similarity at all with the holder's mark as it is an entirely different word and will be pronounced differently from the word element of the holder's mark.

30. The opponent's device only mark of a cat's head has no aural element to make a comparison.

31. With regard to a conceptual comparison, the holder's mark will bring to mind a type of cat, being the specific breed known as Persian cats. This concept will be reinforced by the cat's head device. The opponent's **BLACK CAT** mark will also bring to mind the image of a commonly known cat type. Whereas the opponent's other two 'cat' marks namely **CRYSTAL CAT** and **SILVER CAT** may bring to mind a concept of a cat or cat shaped article made of either crystal or silver material. The opponent's **LYNX** mark will bring to mind the concept of the lynx wild cat species and the device only mark will also bring to mind a wild animal, possibly a wild cat. At the most basic level of conceptual comparison, the common denominator is that of a cat but each of the marks has a more specific and detailed conceptual hook, so I find that the marks are conceptually similar only to a low degree.

Distinctiveness of the earlier marks

32. I must next consider the distinctive character of the earlier mark. 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).”

33. There is no evidence before me in these proceedings. Therefore, I only have the inherent position to consider. Four of the opponent’s earlier marks consist solely of ordinary dictionary words which have no meaning in relation to the goods for which they are registered. The opponent’s device only mark also has no meaning in relation to its registered goods. As a result, I find that the opponent’s earlier marks have an ordinary level of inherent distinctiveness.

Likelihood of confusion

34. I 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) 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*).

35. 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”.

36. 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.

37. So far, I have found that the contested goods are identical or similar and the average consumer will paying a varying but reasonable amount of attention during a primarily visual purchasing process. I have also found that the marks containing the shared ‘cat’ word element are visually, aurally and conceptually similar only to a low degree. Regarding the opponent’s LYNX mark, I found there was no visual or aural similarity and conceptual similarity only to a very low degree. Finally, for the opponent’s device only earlier mark, I found a low degree of visual and conceptually similarity but no aural similarity.

38. Taking these factors into account, I do not find that there is direct confusion between the holder’s mark and any of the opponent’s five earlier marks. I do not think that an average consumer would mistake one mark for another. Turning to the

question of indirect confusion, I do not find there is any indirect confusion between the holder's mark and the opponent's LYNX and device only earlier marks. There are no aural similarities here and only a visual and conceptual similarity at the lowest level. This leaves me to consider the opponent's remaining earlier 'cat' marks namely **BLACK CAT**, **CRYSTAL CAT** and **SILVER CAT**. Although these marks and the holder's mark share the word **CAT**, the adjectival words preceding **CAT** are .dissimilar and form different conceptual hooks. Looking at the Appointed Person's guidance outlined above in paragraph 30, the shared common word **CAT** may call to mind another mark but that is only mere association. So in this matter I do not find any indirect confusion between the holder's mark and the opponent's earlier 'cat' marks.

Conclusion

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

Costs

40. The holder has been successful and is therefore, in principle, entitled to a contribution towards his costs. As the holder is unrepresented, at the conclusion of the evidence rounds the tribunal invited him, in their letter dated 15 March 2018, to indicate whether he wished to make a request for an award of costs, and if so, to complete a pro-forma including a breakdown of his 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 holder that if the pro-forma was not completed "no costs will be awarded". The holder did not respond to that invitation. Consequently, I make no order as to costs.

Dated this 19th day of June 2018

June Ralph
For the Registrar
The Comptroller-General