

O-400-18

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3227228

BY BORISLAVA BOZHIKOVA

H.O.P.E.

IN CLASS 25

AND

THE OPPOSITION THERETO UNDER NUMBER 410017

BY

NM HOPE LIMITED

Background

1. On 26 April 2017, Borislava Bozhikova filed trade mark application number 3227228, for the mark H.O.P.E. for *clothes; headwear; scarfs; gloves as clothing*, in Class 25. The application was accepted and published in the *Trade Marks Journal* for opposition purposes on 12 May 2017. NM Hope Limited (“the opponent”) opposes the application under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), relying upon the following earlier trade mark registrations:

(i) 2552306



Class 25: *Clothing, footwear, headgear; belts and clothing accessories.*

Class 35: *Retail services connected with clothing, footwear, headgear, belts, clothing accessories, leather goods, bags, handbags, purses and wallets.*

Date of filing: 8 July 2010; completion of registration procedure: 14 January 2011.

(ii) 3080074



Class 25: *Clothing, headwear, footwear.*

Date of filing: 21 July 2014, claiming priority from the EUIPO¹; completion of registration procedure: 27 February 2015.

¹ European Union Intellectual Property Office, which at the time of filing was called the Office for Harmonization in the Internal Market.

2. The opponent claims that the marks are similar and that the goods are identical, leading to a likelihood of confusion under section 5(2)(b) of the Act.

3. Ms Bozhikova filed a defence and counterstatement, denying a likelihood of confusion. She states that her application is an abbreviation of the phrase “Humans Of Planet Earth” and that, owing to the capital letters and full stops between each letter, the mark does not consist of a word, visually or aurally (as it would be pronounced as separate letters). The flower device in earlier mark (ii) is a further distinguishing feature. Ms Bozhikova claims that there is, therefore, no likelihood of confusion with either earlier mark.

4. The opponent is professionally represented by Keltie LLP, whilst Ms Bozhikova represents herself. Neither party filed evidence and neither chose to be heard. Both parties filed written submissions in lieu of a hearing. I make this decision after carefully reading all of the papers filed by both parties.

Decision

Section 5(2)(b) of the Act

5. 5(2)(b) of the Act states:

“(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.”

6. The following principles are gleaned from the decisions of the Court of Justice of the European Union (“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.

The principles

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

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

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

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

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

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

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

Comparison of goods and services

7. The opponent's earlier mark 2552306 had been registered for more than five years on the date on which the contested application was published. It is, therefore, subject to the proof of use provisions under section 6A of the Act. However, Ms Bozhikova expressly stated in her notice of defence that proof of use was not required. The consequence of this is that the opponent may rely upon all the goods and services specified in the registration without having to prove that it has made genuine use of them.

8. The parties' respective specifications are:

Earlier marks	Application
<p><u>2552306:</u> Class 25: <i>Clothing, footwear, headgear; belts and clothing accessories.</i></p> <p>Class 35: <i>Retail services connected with clothing, footwear, headgear, belts, clothing accessories, leather goods, bags, handbags, purses and wallets.</i></p> <p><u>3080074:</u> Class 25: <i>Clothing, headwear, footwear.</i></p>	<p>Class 25: <i>Clothes; headwear; scarfs; gloves as clothing.</i></p>

9. The law requires that goods and services be considered identical where one party's description of its goods or services encompasses the specific goods or services covered by the other party's description (and vice versa): see *Gérard Meric v OHIM*, Case T-33/05, General Court ("GC"). The opponent's terms in 2552306, clothing and headgear, cover the goods of the application. Clothing is a wide term encompassing clothes, scarves and gloves (as clothing). Headgear and headwear are interchangeable terms meaning the same thing. For the same reasons, the opponent's terms in 3080074, clothing and headwear, also cover the goods of the application. The parties' goods are, therefore, identical.

The average consumer and the purchasing process

10. Ms Bozhikova submits that "the opposition is entirely based on assumption and suggestion presuming the perception of the consumer. Due to the brought variety and number of the UK public this not reliable argument if not based on facts."

11. Established trade mark law states that the average consumer is deemed to be reasonably well informed and reasonably observant and circumspect, i.e. not someone paying very little attention, and not an expert in the particular goods and

services. The average consumer is a fictional person so that decision takers in trade mark disputes may assess, objectively, how the UK public which buys the goods or services in question are typically likely to react to the marks and how they are likely to purchase the goods or services. This was explained by Birss J. 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):

“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 word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

12. In assessing the likelihood of confusion, 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. In *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03 the GC stated:

“50. The applicant has not mentioned any particular conditions under which the goods are marketed. Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

13. The average consumer of the goods at issue is a member of the general public who is likely to choose the goods from a shop, or from a website or catalogue. In such a purchasing process, the mark will, primarily, be seen rather than heard which means the visual perception of the mark will be the most important. I do not,


however, ignore the potential for the marks to be spoken; for example, by sales assistants providing assistance. The average consumer will take into consideration the cost, size, colour, material and suitability of the goods, meaning that he or she will pay at least a normal degree of attention to their selection.

Comparison of marks

14. 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 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.”

15. 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. The opponent's best case lies with earlier mark 2552306; if it cannot succeed with this mark, it will do no better with the mark containing a flower, which is further away in terms of similarity with the application. I will, therefore, confine my analysis from here on to this earlier mark. The marks to be compared are:

Earlier mark	Applicant's mark
	<p data-bbox="999 367 1209 416">H.O.P.E.</p>

16. The earlier mark consists of the word 'hope' superimposed upon a black rectangle. Whilst the black rectangle cannot be said to be negligible, its weight in the overall impression of the mark is low because it is likely to be viewed simply as a background to enable one to see the white letters in the word. Consequently, it is the word 'hope' which is the dominant and distinctive component of the earlier mark.

17. The overall impression of the application is of the letters which comprise the word HOPE, separated by full stops in the manner of an abbreviation or acronym. I say more about the significance of the full stops below.

18. The visual differences between the marks are the black background (which has little weight in the overall impression) and the full stops between the letters in the application. The font used in the earlier mark is unremarkable; further, notional and fair use of marks includes presentation in either lower and upper case letters (provided the font used is normal), so this is not a distinguishing feature between the marks. The main elements of the marks are the letters HOPE, in the same sequence. The marks are visually similar to a high degree.

19. If the later mark is seen as the individual letters, there is no aural similarity between the marks. However, if the later mark is seen as an acronym (which is a pronounceable abbreviation), it is more than likely to be pronounced. The longer an abbreviation is which is capable of being pronounced (as acronyms are), the more likely and natural it is that users will pronounce it, because this is easier; for example NATO (North Atlantic Treaty Organisation). Given that for UK consumers the letters H.O.P.E. form a recognisable English word, and that it is a mouthful to sound them out individually, I find that it is more likely than not that the later mark will be articulated as HOPE, which is aurally identical to the earlier mark.

20. The dominant and distinctive part of the earlier mark is the common word 'hope', the meaning of which will be well-known to UK consumers. If the later mark is viewed and articulated as HOPE, it also has this meaning. Given that the letters in the later mark form the common word HOPE, UK consumers are likely to notice this first, even if they then make the decision to separate the letters in their mind. I will bring forward these points when I make the global assessment as to whether there is a likelihood of confusion.

Distinctive character of the earlier mark

21. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*² 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).”

² Case C-342/97

22. The relevance of the level of distinctiveness of the earlier mark is explained in *Sabel*: 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. There is no evidence that the opponent has used the earlier mark, so it cannot claim any 'extra' distinctiveness from the public having been made aware of it. As it stands (*per se*), the mark does not describe or allude to the goods, but is a common English word. It has an average degree of distinctiveness.

Likelihood of confusion

23. Ms Bozhikova has made submissions about her mark. She submits that it stands for 'Humans of Planet Earth', a project to support and integrate youth offenders. This is not relevant for three reasons. Firstly, this submission constitutes evidence of fact, but Ms Bozhikova has chosen not to file evidence. It cannot be taken into account because as it has not been filed as evidence, the opponent has not had an opportunity to reply to it, which is fundamentally unfair in legal proceedings. Secondly, even if it had been filed as evidence, there is no information which would enable me to determine to what extent the mark has been used (if it has) and therefore to what extent the public has become used to it as a trade mark. Thirdly, since the opponent has not shown that it has used its own mark, I cannot determine what opportunities the public has had to become accustomed to distinguishing between the parties' marks, because there is no evidence of concurrent use of them.

24. The application is not for charitable services, it is for clothing, the same goods as covered by the earlier mark. Although Ms Bozhikova submits that her clothing will appeal to those in her specific charitable environment, the matter must be approached on a notional and fair use basis. I am required to consider the likely result of the use of her mark in relation to all, or any, of the goods listed in the application, not just the specific clothing in relation to which Ms Bozhikova currently uses the mark, or currently proposes to use it. It is not possible to carve up the clothing market on such a subjective basis; i.e. particular markets. This is because the legal protection Ms Bozhikova seeks is governed by the list of goods, not by her current intentions. For example, she could change her marketing plans tomorrow, or

sell the mark to another trader with different plans. In *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, the CJEU stated that:

“59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

25. In *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06, the CJEU stated at paragraph 66 of its judgment that when assessing the likelihood of confusion under Section 5(2) it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered. Consequently, no weight can be given to Ms Bozhikova’s current marketing plans.

26. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. One of those principles states that a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*). I have found that the goods are identical. The marks share highly similar dominant and distinctive components, particularly visually; and the goods will primarily be purchased visually.

27. I have also found that it is more than likely that the immediate first impression of the application will be the word HOPE because the mark is capable of being pronounced and it forms a very common English word. In these circumstances, the marks are conceptually identical. The marks are also visually similar to a high degree and the earlier mark is averagely distinctive. For average consumers whose immediate first impression of the application is the word HOPE, there is a likelihood of confusion.

28. Even if the full-stops between the letters cause average consumers to separate the letters in their mind, there is still a likelihood of confusion. This is because if the mark is interpreted as letters, it is nevertheless unavoidable, given the commonness of the word 'HOPE', that the word formed by the letters H.O.P.E. will be recognised and given conceptual meaning. It is also likely that the average consumer will simply consider that the parties' marks, for the identical goods, are variations used by the same or economically linked undertakings, presented with or without full-stops. Sometimes called 'indirect confusion', this nevertheless constitutes confusion for the purposes of section 5(2)(b) of the Act.

Outcome

29. There is a likelihood of confusion. The opposition succeeds in full. The application is refused.

Costs

30. The opponent has been successful and is entitled to a contribution towards its costs. Awards of costs in proceedings are governed by Annex A of Tribunal Practice Notice ("TPN") 2 of 2016, published on the website of the Intellectual Property Office. The cost breakdown is as follows:

Opposition fee	£100
Preparing the statement of case and considering the counterstatement	£200
Written submissions	£300

Total

£600

31. I order Borislava Bozhikova to pay to NM Hope Limited the sum of **£600**. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful

Dated this 4th day of June 2018

Judi Pike

For the Registrar,

the Comptroller-General