

O/081/19

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION UK 3282833

BY

ZHEN ZHOU ZHANG

TO REGISTER THE FOLLOWING MARK IN CLASSES 25 AND 35

Tatadoo

AND

THE OPPOSITION UNDER NO. 412328 THERETO

BY

Tata Sons Limited

Background and Pleadings

1. ZHEN ZHOU ZHANG (the Applicant) applied to register the mark as shown on the front cover page on the 16 January 2018 for goods and services in classes 25 and 35 shown below¹. It was accepted and published on the 2 February 2018.

Class 25: Clothing for babies; Body suits for babies; Articles of clothing for babies; Articles of clothing for infants; Babies' dungarees and overalls; Articles of children's clothing; Bottoms as clothing for children; Dresses for children; Pajamas for babies; Tops as clothing for children; Trousers for children; Underwear for children.

Class 35: Retail and wholesale services relating to clothing and articles of clothing for babies and children.

2. TATA SONS LIMITED (the Opponent) opposes the application under section 5(2)(b) of the Trade Mark Act 1994 (the Act) relying on its earlier UK registered mark TATA, registration number UK 3019436 which was filed on the 30 November 2006 and registered on the 6 December 2013. The mark is registered in respect of goods relied upon in class 25 outlined below:

Class 25: Boots, boot uppers, boots for sports, clothing, footwear, footwear uppers, heels, heel pieces, sandals, shoes, slippers, soles for footwear and headgear.

3. The Opponent relies on all its goods in class 25 for which the mark is registered. The Opponent claims that there is a likelihood of confusion under section 5(2)(b)

¹ By way of form TM21B dated the 2.7.18 the Applicant amended its application as originally filed, limiting its specification to those as outlined.

because the trade marks are similar and are to be registered for goods and services identical or similar to those for which the earlier marks are protected.

4. The Applicant filed a defence and counterclaim denying the claims made, refuting “that there is any likelihood of confusion between the two marks.”

5. Both parties are professionally represented, the Applicant by Trademarkit LLP, the Opponent by Reddie & Grose LLP. Neither party filed evidence and only the Opponent filed submissions in lieu of a hearing. The decision is taken upon the careful perusal of the papers including the caselaw raised by the Opponent in so far as it is relevant.

Decision

6. The opposition is based on section 5(2)(b) of the Act which states:

“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”.

7. An earlier trade mark is defined in section 6 of the Act, which states:

“6. - (1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

8. In these proceedings, the Opponent is relying upon its UKTM registration shown above, which qualifies as an earlier trade mark under section 6 of the Act. As the earlier mark had been registered for less than five years at the date the application was published it is not subject to the proof of use provisions contained in section 6A of the Act. Consequently, the Opponent is entitled to rely upon all the goods of its registration without having to establish genuine use.

9. The following principles are gleaned from the decisions of the EU courts 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 greater 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 to mind the earlier mark, 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 the goods and services

10. The competing goods and services are as follows:

Applicant's Goods and Services	Opponent's Goods
Class 25: Clothing for babies; Body suits for babies; Articles of clothing for babies; Articles of clothing for infants; Babies' dungarees and overalls; Articles of children's clothing; Bottoms as clothing for children; Dresses for children; Pajamas for babies; Tops as clothing for children; Trousers for children; Underwear for children.	Class 25: Boots, boot uppers, boots for sports, clothing, footwear, footwear uppers, heels, heel pieces, sandals, shoes, slippers, soles for footwear and headgear.
Class 35: Retail and wholesale services relating to clothing and articles of clothing for babies and children.	

11. When conducting a goods and services comparison, all relevant factors should be considered as per the judgment of the Court of Justice of the European Union (CJEU) in *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc* Case C-39/97, where 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”.

12. I am also guided by the relevant factors for assessing similarity identified by Jacob J in *Treat*, [1996] R.P.C. 281 namely:

- (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.

13. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (GC) 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 für 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”.

Goods in class 25

14. The Opponent submits that the “*goods at issue are identical.*” and that its “‘*clothing*’ ‘*footwear*’ and ‘*headgear*’ terms ..encompass all of the goods covered by the Applicant’s mark”. The Applicant makes no submissions as to the identity or similarity of the goods and services at issue. I note that the Opponent’s list of goods is not separated by semi colons, the absence of which does not alter the core characteristics of each category, I will therefore consider “clothing” as a separate item and not as a sub category of boots and footwear. In my view all the Applicant’s goods in Class 25 are encompassed in the broader category of the Opponent’s “clothing” and according to the principles outlined in *Merix* they are identical.

Services in class 35

15. I take note of the decision in *Oakley, Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-116/06, at paragraphs 46-57, where the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

16. The GC in the *Boston Scientific Ltd v OHIM*, Case T-325/06, defined “complementary”:

“82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking...”.

17. I also take into consideration the decision in *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services against goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘*similar*’ to goods are not clear cut.”

18. However, on the basis of the European courts’ judgements in *Sanco SA v OHIM* (Case C-411/13P), and *Assembled Investments (Proprietary) Ltd v. OHIM* (Case T-105/05 at paragraphs [30] to [35] of the judgement), upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd* (Case C-398/07P), Mr Hobbs concluded that:

i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer’s point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to

envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;

iii) It is not permissible to treat a mark registered for 'retail services for goods 'X' as though the mark was registered for goods X;

iv) The General Court's findings in Oakley did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

19. In order for there to be a complementary relationship between the goods and the retail services of those goods it is necessary for there to be a sufficiently close relationship between them so that the public might reasonably believe that they are likely to be offered by the one and the same undertaking. The contested Class 35 "*retail and wholesale services relating to clothing and articles of clothing for babies and children*" have some degree of connectivity to "*clothes*". The services are indispensable to the goods; without which the clothing would not be able to reach the market. They share trade channels and are targeted towards the same end user. The average consumer would consider the retailing or wholesale distribution services as originating from the same undertaking as the actual goods. I consider they are similar to a medium degree.

Average Consumer

20. The average consumer is deemed to be reasonable well informed and reasonably observant and circumspect. When considering the opposing trade marks, I must bear

in mind that the level of attention is likely to vary according to the category of goods and services in question.²

21. 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.”

22. I am also mindful of the GC decision in *New Look Limited v OHIM*, joined cases T-117/03 to T – 119/03 and T – 171/03 the GC in which it 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.

² *Lloyd Schuhfabrik Meyer*, C-342/97

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.

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."

23. Accordingly, the average consumer and the level of attention will vary depending on whether the clothes are low end, mass produced goods or high-end designer products. They are likely to choose the goods from retail outlets through self-selection or from online or catalogue equivalents. The purchasing process is therefore dominated primarily by visual considerations although I do not discount aural purchases. In light of this I find that an average degree of attention will be taken in the purchasing process because consumers take into account a number of factors before purchasing items of clothing to include the cost, size, colour, material, and suitability of goods.

Comparison of the marks

24. 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.”

25. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to consider 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.

26. The respective trade marks are shown below:

Applicant's mark	Opponent's mark
Tatadoo	TATA

27. Lengthy submissions were submitted by the Opponent as to the comparison of the marks whilst the Applicant limited its observations (in the counterstatement) to the visual and aural differences. Whilst I do not propose to reproduce these submissions in their entirety here, I have taken them into consideration in reaching my decision.

28. The contested mark consists of a seven-letter word **Tatadoo** presented in emboldened title case. There are no other elements to contribute to the overall impression which is contained in the word itself. Emboldening the word does not contribute significantly to the overall impression of the mark.

29. The Opponent's mark consists of a four-letter word TATA in conventional font presented in capitals. Again, there are no other elements to contribute to the overall impression, which is contained in the word itself.

Visual Comparison

30. Both marks present visually as word marks differing in not only font and casing but also in length. A word trade mark registration however protects the word itself irrespective of font, capitalisation or otherwise and therefore, a trade mark in capitals covers use in lower case and vice versa.³ The marks coincide in four of their letters; the first four of the Applicant's seven letter mark being identical to the entirety of the Opponent's mark, "TATA". The Applicant's mark has the additional letters "doo" at the end of the word. I take note that as a general rule, beginnings of words tend to have more visual and aural impact than the ends⁴ and although I accept this does not apply in all cases, the relevant public is unlikely to dissect each element of a mark but rather perceive them in their entirety. In this case, the shared presence of the letters "TATA", will result in the marks sharing a medium degree of visual similarity.

³ *Bentley Motors Limited v Bentley 1962 Limited* BL O/159/17

⁴ *El Corte Inglés, SA v OHIM*, Cases T-183/02

Aural comparison

31. I note the parties' submissions regarding the aural articulation of both marks, however I consider that the Applicant's mark will be pronounced TA-TA-DU whereas the Opponent's mark will be pronounced TA-TA. In both cases the first and second syllable will be pronounced identically, the only difference being in the contested mark's third syllable there being no counterpart in the earlier mark. Overall there is sufficient similarity in the articulation of the words when taken as a whole, for me to determine that the marks share a medium degree of aural similarity.

Conceptual Comparison

32. The Opponent submits that conceptually its mark is an invented word with no direct meaning in the English language. Similarly, it contends that the Applicant's mark is also invented. The Applicant is silent on whether **Tatadoo** has any conceptual meaning. With no other evidence to the contrary I perceive both marks as invented words and consequently the conceptual similarity between them will be neutral.

Distinctiveness of the earlier mark

33. The case of *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 sets out the legal position to determine the distinctive character of a mark. In this case 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).”

34. The matter must be considered based on inherent characteristics as the Opponent has not filed any evidence regarding use of its mark. The earlier mark consists of one word “TATA” which the Opponent accepts is an “entirely invented term” and which “has no connection to the goods covered”. I accept that the Opponent’s mark will be considered as an invented word, which has no allusive association to the goods covered by the registration; I therefore consider it to possess a high degree of inherent distinctiveness.

Likelihood of confusion

35. When considering whether there is a likelihood of confusion between the two marks I must consider whether there is direct confusion, where one mark is mistaken for the other or whether there is indirect confusion where the similarities between the

marks lead the consumer to believe that the respective goods or services originate from the same or related source.

36. In determining whether there is a likelihood of confusion there are a number of factors to bear in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods or services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the Opponent's trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must consider that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

37. I have found that the marks are visually similar to a medium degree and that they share a medium degree of aural similarity. I have found the conceptual similarity between the marks to be neutral. I have found that the earlier mark has a high degree of inherent distinctive character. I have identified the average consumer to be a member of the general public who would primarily select the goods or services via visual means but with aural means not being discounted. I have concluded that an average degree of attention will be paid in the purchasing process. I have found that the parties' goods are identical and that the services are similar to a medium degree.

38. Since the earlier mark is considered to be invented with nothing attributed to it to link it with the goods or services in question and taking into account the fact that consumers rarely have a chance to compare marks side by side, I am satisfied that there is sufficient visual and aural commonality between the marks, with the shared presence of the letters TATA, that consumers will directly mistake the one for the other. The difference with the inclusion of the letters "doo", is insufficient to allow the average consumer to distinguish between them, especially with the respective goods being identical and the services being similar to a medium degree; leading to a likelihood of direct confusion.

39. If, however, I am wrong in this conclusion and that the average consumer does recognise the difference with the addition of the letters “doo”, I consider they would discount those differences perceiving the Applicant’s mark to be a sub brand of the earlier mark and that the goods and services originate from the same economically linked undertaking. On this basis I consider there would be a likelihood of indirect confusion.

Outcome

40. Whether direct or indirect the opposition succeeds under section 5(2)(b); subject to any appeal, the application is refused.

Costs

41. As the Opponent has been successful it is entitled to a contribution toward its costs. Award of costs in proceedings are based upon the scale as set out in Tribunal Practice Note 2 of 2016. Applying that guidance, I award costs to the Opponent on the following basis:

Preparing a notice of opposition

And reviewing the counterstatement: £200

Preparing submissions in lieu of hearing £300

Official fee: £100

Total: £600

42. I order ZHEN ZHOU ZHANG to pay TATA SONS LIMITED the sum of £600 as a contribution towards its costs. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case, if any appeal against this decision is unsuccessful.

Dated this 12th day of February 2019

Leisa Davies

For the Registrar