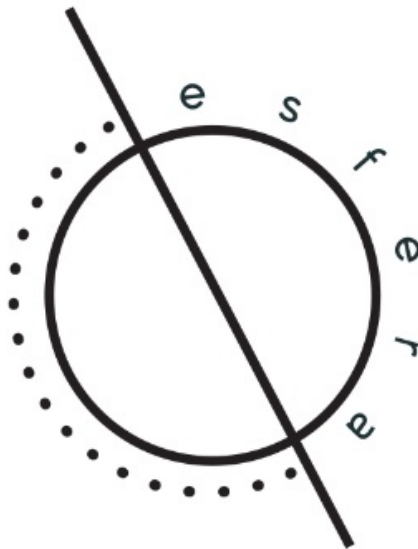


O-679-19

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION NO. 3359870
BY SARAH KRAUSE
TO REGISTER THE TRADE MARK:**



**IN CLASS 25
AND
IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 415520 BY SFERA JOVEN, S.A.**

Background and pleadings

1. On 11 December 2018, Sarah Krause (“the applicant”) applied to register the trade mark shown on the cover page of this decision.

2. The application was accepted and published in the Trade Marks Journal on 21 December 2018 for the following goods in Class 25:

Clothing.

3. Sfera Joven, S.A. (“the opponent”) filed a notice of opposition on 20 February 2019. The opposition is directed against all of the goods in the application on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the following European Union trade marks (“EUTMs”):

Mark: SFERA

(“the word mark”)

EU registration no. 2274629

Filing date: 26 June 2001

Date of entry in register: 5 October 2006

Goods relied upon: Class 25 - *Clothing, footwear, headgear.*

Mark:

(Sfera)

(“the figurative mark”)

EU registration no. 4563541

Filing date: 27 July 2005

Date of entry in register: 09 June 2006

Goods relied upon: Class 25 - *Clothing, footwear, headgear.*

4. The opponent argues that there is a likelihood of confusion, including the likelihood of association, because the respective goods are identical, and the marks are similar.

5. The applicant filed a counterstatement denying the claims made. As these are the only submissions I have from the applicant, they are reproduced below in full:

“- The name is ultimately spelled differently.

- The name ‘esfera’ is not arbitrary; it is meant to specifically evoke the spherical image of the planet, in resonance with our eco-friendly ethos.

- The logos are completely different.

- Company focus is totally different; Esfera is specifically a sustainable fashion brand.

- Esfera is distinctly differentiating itself from mass market fashion and hence would reap no benefit from imitating Sfera.

- Esfera has no physical presence in Spain; the business is conducted from the United Kingdom.

- Esfera’s website holds a .co.uk domain.

- As a subsidiary of EL Corte Ingles, Sfera’s opposition is an example of large-scale high street brands attempting to unnecessarily deter smaller, independent brands.”

6. The opponent is represented by Maucher Jenkins and the applicant represents herself. Neither party filed evidence or written submissions in these proceedings. No hearing was requested and so this decision is taken following a careful perusal of the papers.

DECISION

Section 5(2)(b)

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. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

(a) a registered trade mark, international trade mark (UK) or Community trademark 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.”

9. The trade marks upon which the opponent relies qualify as earlier trade marks under the above provisions. As the opponent’s earlier trade marks had been registered for five years or more at the application date of the opposed application, they are, in principle, subject to the proof of use provisions under section 6A of the Act. The opponent provided a statement that it has used its marks for all of the goods in Class 25. In its counterstatement, the applicant indicated that it did not require proof of use. The opponent can, as a consequence, rely upon all of the goods it has identified.

Section 5(2)(b) – case law

10. The following principles are gleaned from the judgments 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 C3/03, *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 the 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.

The average consumer and the nature of the purchasing act

11. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which these goods are likely to be selected by the average consumer.

12. 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”.

13. The goods at issue in these proceedings are articles of clothing. The average consumer for such goods is a member of the general public.

14. In *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs)* Joined cases T-117/03 to T-119/03 and T-171/03, the General Court (“GC”) commented upon the manner in which articles of clothing are selected. It 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.”

15. The average consumer of clothing is likely to purchase such goods fairly frequently. The goods are most likely to be the subject of self-selection from retail outlets, websites or catalogues. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount an aural element to the purchase, particularly when advice is sought from a sales representative or a purchase is made further to a word-of-mouth recommendation. When making a purchase, factors such as size, material, colour, cost (which will vary according to the item) may be considered. These factors suggest that the average consumer will pay a medium level of attention when making their selection.

Comparison of goods

16. The competing goods are as follows:

Opponent's goods (relied upon under both earlier trade marks)	Applicant's goods
<u>Class 25</u> Clothing, footwear, headgear.	<u>Class 25</u> Clothing

17. The specifications of the earlier trade marks cover terms identical to those in the applicant's specification, namely clothing. It is, therefore, self-evident that the goods for which the applicant seeks registration are identical to those of the opponent. Although I note the applicant's comments regarding its goods being sustainable products, the correct comparison is between the specifications as they appear on the register: see *Roger Maier v ASOS* ([2015] EWCA Civ 220 at paragraphs 78 and 84 and *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited* (Case C-533/06) at paragraph 66. Differences between the actual goods marketed by the parties, for example, are not relevant unless such differences are apparent from the specifications.

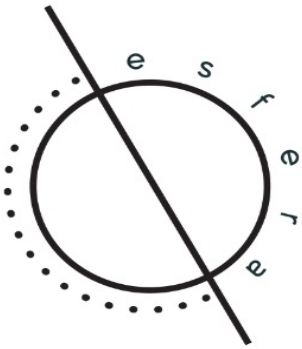
Comparison of marks

18. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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.”

19. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

20. The trade marks to be compared are as follows:

Opponent's trade marks	Applicant's trade mark
<p style="text-align: center;">SFERA</p> <p style="text-align: center;">(Sfera)</p>	

21. The opponent's word mark consists of the word "SFERA" presented in capital letters. The mark has no additional stylisation. Its overall impression and distinctiveness, therefore, lie in the single word of which it is composed.

22. The opponent's figurative mark consists of the word "Sfera" presented in an ordinary font. The letter "S" is presented in upper case, and the letters "fera" are presented in lower case. The word is placed in between what appear to be slightly

tilted round brackets. It is the word “Sfera” that dominates the overall impression; the brackets play a lesser role.

23. The applicant’s mark consists of the word “esfera” presented in lower case and accompanied by a device of a black circle and an intersecting black straight line that cuts through the centre of the circle. The bisecting line is diagonally positioned on the circle, with equal proportions exposed on either side. A semi-circle of dotted lines forms the outer layer of the circle on the left-hand side of the intersecting line. Along the outside of the circle, on the right-hand side of the intersecting line, appears the word “esfera”. Even though the word takes up a smaller portion compared to the device element in the applicant’s trade mark, words tend to speak louder than the device in a mark. Therefore, in my view, both the word and the device play a roughly equal role in the overall impression of the applicant’s trade mark.

24. I will compare the applicant’s trade mark with the earlier trade marks, in turn, beginning with the opponent’s word mark.

Opponent’s word mark

25. Visually, the competing trade marks consist of five and six letters, respectively. The last five letters of the applicant’s trade mark are identical to the opponent’s word mark. The applicant’s mark has an additional letter “e” at the beginning and has a device element in it. Considering the similarities and the differences, in my view, there is a medium degree of visual similarity between the competing trade marks.

26. In an aural comparison, the consumer will not verbalise the device in the applicant’s mark. Therefore, it is necessary to compare only the word elements in the trade marks. The opponent’s word mark consists of two syllables, and will be pronounced as SFE-RA. The applicant’s trade mark contains three syllables and will be pronounced in either of these ways: ES-FE-RA or EE-SFE-RA. In my view, the aural similarity between the marks is fairly high in both cases.

27. Turning to the conceptual similarity, the opponent submits that the word “esfera” is Spanish for sphere and the word “sfera” is Italian for sphere or ball, which the average consumer will recognise. However, the opponent has filed no evidence to support the contention that the average consumer will know these meanings. It does not seem to me that knowledge of a foreign language can be assumed for the average consumer and there is no evidence that either Spanish or Italian are, for example, commonly taught languages in the UK. Therefore, I consider it unlikely that the average consumer will know the Spanish or the Italian meaning of the words “esfera” or “sfera”. The opponent further submits that the average consumer is likely, even if they do not speak Italian or Spanish, to associate the marks with the term sphere given that the words “sfera” and “esfera” look like phonetic representations of the term sphere. For a conceptual meaning to be relevant, it must be one capable of immediate grasp¹. In my view, the competing marks will only be seen as invented words. I do not consider that the marks in issue resemble the word “sphere” sufficiently to cause the average consumer to attribute a meaning to what he or she will perceive as a made-up word, or associate it with a known word, as the opponent contends. On that basis, there is neither conceptual similarity nor conceptual difference.

Opponent’s figurative mark

28. Visually, the competing trade marks consist of five and six letters, respectively. The last five letters of the applicant’s trade mark are identical to the word element in the opponent’s figurative mark. The visual differences between the contested trade marks are that in the opponent’s word mark, “S” is presented in upper case and “fera” in lower case and is presented within brackets. The applicant’s mark has an additional letter “e” at the beginning and has a device element in it. Considering the similarities and the differences mentioned above, in my view, the visual similarity between the competing trade marks is slightly less than medium.

¹ See Case C-361/04 P *Ruiz-Picasso and Others v OHIM* [2006] ECR I-00643; [2006] E.T.M.R. 29.

29. My findings as set out at paragraphs 26 and 27 apply for the aural and conceptual similarities between the contested marks. The competing marks are aurally similar to a fairly high degree, and there is neither conceptual similarity nor conceptual difference between the contested marks.

Distinctiveness of the earlier marks

30. The distinctive character of the earlier marks must be considered. The more distinctive they are, either inherently or through use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). 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. As the opponent filed no evidence, I have only the inherent position to consider. I note that the word “sfera” has no suggestive or evocative qualities relating to clothing, and I do not consider that the average consumer would attribute a meaning to that word. From that perspective, in my view, the earlier trade marks will be perceived as invented words and, therefore, are inherently highly distinctive.

Likelihood of confusion

32. I have considered the applicant’s submissions that the applicant’s mark is a “sustainable fashion brand” that “distinctly differentiates itself from mass fashion market” and therefore would not benefit from “imitating” the earlier trade marks. I do not consider that there is merit in these arguments as a trade mark owner’s eco-friendly practices or business models are not relevant to the issue of confusion between the contested marks.

33. A likelihood of confusion is determined following a global assessment of all factors relevant to the circumstances of the case (*Sabel* at [22]). It is necessary for me to factor in the distinctive character of the earlier trade mark, as the more distinctive this trade mark is the greater the likelihood of confusion (*Sabel* at [24]). I must also have regard to 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 and vice versa (*Canon* at [17]). I must also keep in mind the average consumer for the goods, the nature of the purchasing process and that the average consumer rarely has an opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

34. I will begin by considering the position in relation to the opponent’s word mark first. The opponent’s mark is wholly contained in the applicant’s trade mark. The goods are identical. Those goods will be selected with a medium degree of attention. The purchasing act of the respective goods is primarily visual, so the visual similarity carries more weight in my comparison. Earlier in this decision, I concluded that the

contested marks share a medium degree of visual similarity and a fairly high degree of aural similarity. The conceptual position is neutral.

35. Confusion can be direct (which occurs 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 undertaking being the same or related).

36. The difference between direct and indirect confusion was explained in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, by Iain Purvis Q.C., sitting as the Appointed Person, where he explained 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.

37. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor Q.C., sitting 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 another mark to mind. This is mere association not indirect confusion.

38. In my view, the device element in the applicant’s trade mark is sufficiently prominent and distinctive to avoid direct confusion. Although there is no likelihood of

direct confusion, the similarity of the word elements in the marks, when considered alongside imperfect recollection, is likely to lead the consumer to believe that the later mark is a brand extension or variant mark being used by the owner of the earlier trade marks. Accordingly, I find that the average consumer would be indirectly confused in respect of the contested goods in Class 25.

39. Following my findings as given above, I consider that there is a likelihood of confusion in respect of the opponent's figurative mark as well. Despite some presentational differences, the similarity between the word elements in the marks, when considered alongside the other relevant factors, outweighs the differences and the consumer will think that the later mark is a brand extension or variant mark being used by the owner of the earlier trade marks.

Conclusion

40. The opposition has succeeded in full. The application will be refused.

Costs

41. The opponent has been successful and is entitled to an award of costs. Awards of costs are governed by Tribunal Practice Notice ("TPN") 2/2016. I note both parties did not file evidence. I award costs to the opponent on the following basis:

Official fee:	£100
Preparing the notice of opposition and considering the counterstatement:	£200
Total:	£300

42. I order Sarah Krause to pay Sfera Joven, S.A. the sum of **£300**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one

days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 6th November 2019

Karol Thomas

For the Registrar

The Comptroller-General