

**BL O/221/20**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION 3354991**

**BY**

**KICK AIR MANCHESTER LIMITED**

**TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 25:**



**AND**

**OPPOSITION THERETO (NO. 415692)**

**BY**

**MOHAMMED ASIF MANN**

## **Background and pleadings**

1. Kick Air Manchester Limited (hereafter “the applicant”) applied to register the trade mark:



in the UK on 20 November 2018. It was accepted and published in the Trade Marks Journal on 07 December 2018, in respect of the following goods:

**Class 25:** Clothing for sports.

2. Mohammed Asif Mann (hereafter “the opponent”) opposes all of the goods in the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (the Act). The opposition is based on earlier UK registration 3274683, filed on 02 December 2017 and registered on 09 March 2018, for the mark:

**KICK AIR**

In respect of the following goods:

**Class 25:** Men's, women's and children's Tee shirts, trousers, jackets, underwear, suits, thermal underwear, long sleeve tops, short sleeve tops, shorts, hoodies, track suits, jogging suits, jogging bottoms, polo shirts, waistcoats, cap, sweatshirts.

3. The opponent claims that the marks at issue are the same, being spelt in the same way, and covering the same class of goods. It adds that the term ‘Sports clothing’ is extremely vague and could cover almost any kind of clothing item and, as such, will likely include the goods that it produces under the earlier mark. The opponent states that as a result of this, confusion would occur.

4. In its counterstatement, the applicant accepts that the opponent has a registered trade mark that contains similar wording to theirs, however it adds that the opponent's mark is a plain word mark comprising two separate words. The applicant also states that the opponent's mark does not contain the brand image of the logo of the contested mark, and the contested mark is presented as a single word.
5. The opponent provided evidence which will not be summarised here but will be referred to later in this decision where necessary.
6. No hearing was requested and so this decision is taken following a careful perusal of the papers.
7. Throughout the proceedings the applicant has represented itself. The opponent has been represented by Robina Mann.

## **Decision**

### **Section 5(2)(b) of the Act**

8. 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.”

9. 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**

10. 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”.

11. 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.

12. The parties' respective specifications are:

Earlier mark	Application
<b>Class 25:</b> Men's, women's and children's Tee shirts, trousers, jackets, underwear, suits, thermal underwear, long sleeve tops, short sleeve tops, shorts, hoodies, track suits, jogging suits, jogging bottoms, polo shirts, waistcoats, cap, sweatshirts.	<b>Class 25:</b> Clothing for sports.

13. In *Gérard Meric v Office for Harmonisation in the Internal Market ('Merici')*, 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".

14. The applicant's 'Clothing for sports' covers any and all items of clothing intended to be used when taking part in sports activities. It also provides for those goods to be worn by men, women and children.

15. For the purposes of my assessment I must consider the term 'sports' in its broadest possible sense, which includes a wide variety of activities as diverse as sailing, equestrianism, swimming, running or gymnastics.
16. Due to the broad scope of the term 'clothing' the applicant's goods may include underwear, outerwear, jackets, thermal clothing etc. The opponent's goods are all items of clothing including specifically 'track suits; jogging suits and jogging bottoms' which are goods that can be said to be sports clothing. The remaining goods of the opponent are all clothing items that have not been limited to a particular purpose and therefore, can be said to enjoy a broad scope of protection, i.e. the earlier 'long sleeve tops' may be used for everyday wear or may be used whilst engaging in a sports activity such as running or playing tennis and the 'waistcoats' may be worn when playing a sport such as snooker.
17. Applying the *Meric* principle, I find that the applicant's 'Clothing for sports', wholly encompasses all of the earlier goods, including 'caps' which are a common accessory worn during sports activities. These goods are identical.

#### **Average consumer and the purchasing act**

18. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.
19. 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."

20. The average consumer of clothing and caps will predominantly be the general public but could also be a professional public, buying on behalf of others.
21. The selection of such goods is largely a visual process, as the average consumer (general public) will wish to physically handle the goods and try on articles of interest, to ensure a correct fit, whilst simultaneously appraising the overall aesthetic impact.
22. The professional consumer will also take some care over the visual assessment of the goods as it will be essential that any items they select, precisely match the requirements of their clients. I do not, however, ignore the potential for the marks to be spoken, for example, by sales assistants in a retail establishment or when making a purchase from a catalogue, over the telephone. However, in those circumstances, the consumer will have had an opportunity to view the goods, perhaps electronically via an online catalogue or website, or on paper in the traditional sense of catalogue shopping<sup>1</sup>. Therefore, when considering the aural impact of the marks, the visual impression of these goods will already have played a part in the consumer's mind.
23. The average consumer will pay a medium degree of attention in its assessment, during the purchase of clothing or headgear.

### **Comparison of 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

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<sup>1</sup> *Quelle AG v OHIM*, Case T-88/05, paragraph 69



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 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.

26. The respective trade marks are shown below:

The applicant’s contested mark	Earlier trade mark
	<p><b>KICK AIR</b></p>

27. The applicant’s contested mark is comprised of the words ‘KICK’ and ‘air’ presented in a fairly standard typeface, in white lettering, placed upon a black background. The word ‘KICK’ is presented in capital lettering and is slightly larger in size than the word ‘air’ which is presented in lower case lettering. Although the word ‘KICK’ is somewhat larger than the word ‘air’ and appears at the beginning of the expression, it cannot be said to dominate or overwhelm the word ‘air’. Neither term has a clear or obvious association with the goods at issue and they may therefore be said to be distinctive elements in the mark. The black rectangular background upon which the verbal elements sit, cannot be said to play a significant role in the mark. As such, the overall impression of the applicant’s mark lies in the words ‘KICK air’.

28. The earlier mark is a plain word mark comprised of the word elements ‘KICK’ and ‘AIR’. Neither word can be said to dominate the mark and neither word has a clear or obvious link with the goods at issue. Consequently, the overall impression of the earlier mark lies in its totality.

### **Visual similarity**

29. Visually, the respective marks are similar inasmuch as they share the words 'KICK' and 'AIR/air'. They differ visually in the slight stylisation of the lettering and the black background of the contested mark. A word-only mark has protection for its use in upper or lower case, or a mixture of both, and in any colour or font.<sup>2</sup> The font, colour and case differences between the respective marks are thus of little or no significance. The marks at issue are therefore considered to be visually similar to a high degree.

### **Aural similarity**

30. The only verbal elements in the marks at issue are the words 'kick' and 'air', presented in the same order. The marks are therefore aurally identical.

### **Conceptual similarity**

31. The only elements of the contested mark that might convey a conceptual message are the words 'KICK' and 'AIR'. The earlier mark is comprised solely of the same verbal elements. Whilst the meanings of both words will be obvious to the average consumer, neither can be said to have any obvious link or connection to the goods at issue. This is also true when the words are considered as a single unit 'KICK AIR' or 'KICKair'. However, the relevant public will understand both marks as referring to the action of kicking the air. As both marks convey an identical, somewhat abstract message, the marks at issue must be found to be conceptually identical.

32. In conclusion, the marks have been found to be aurally and conceptually identical and visually similar to a high degree.

### **Distinctive character of the earlier trade marks**

33. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

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<sup>2</sup> See paragraphs 11 and 12 of the appeal decision BL O/091/19, Professor Philip Johnson as the Appointed Person., which includes reference to paragraph 39 of the ruling of the General Court in T-24/17 *La Superquímica v EUIPO*, EU:T:2018:668.

“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 opponent has made no claim that its earlier mark has acquired an enhanced degree of distinctive character. I must therefore assess the mark purely on its inherent distinctive character.

35. In *Kurt Geiger v A-List Corporate Limited*, BL O/075/13, Mr Iain Purvis Q.C., sitting as the Appointed Person, observed that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything, it will reduce it.”

36. The words ‘KICK’ and ‘AIR’ are common English words which are readily understood by the average member of the UK public. Neither word, individually, can be said to have a clear or obvious link with the goods at issue, however, the combination of the two words creates a somewhat abstract expression that conveys a simple concept around the action of kicking air. As a whole, the earlier mark ‘KICK AIR’ can be said to be inherently distinctive to a medium degree.

### **Likelihood of Confusion**

37. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

38. Confusion can be direct (which effectively 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/services down to the responsible undertakings being the same or related).

39. I have already found that:

- the goods at issue are identical;
- the marks are visually similar to a high degree and aurally and conceptually identical;
- the average consumer will be a member of the general public or a professional;
- the consumer will pay a medium level of attention when selecting the goods;

- the visual and aural assessments will both be important, but the visual impact will carry greater weight;
- the earlier mark has a medium degree of inherent distinctiveness.

40. Taking all of the aforesaid into account, I find that direct confusion is likely to occur.

The differences between the opponent's earlier mark and the applicant's contested mark are minor and the relevant public is likely to mistake one for the other.

41. I remind myself of the legal principles outlined above in paragraph 9, where the courts found that the average consumer rarely has the chance to make direct comparisons between marks side by side, but instead relies upon an imperfect picture of them that he has kept in his mind.

42. The applicant has stated that the marks at issue are different. The argument for this position is that the earlier mark comprises two words whilst in the contested mark, the words 'KICK' and 'air' have been presented together as one word. The applicant has also stated that the earlier mark does not have the 'brand image of the logo' present in the contested mark. I take this to mean the slightly stylised lettering and the black background.

43. I do not accept these arguments. I find that in fact, the applicant's use of uppercase lettering in the word 'KICK' and lowercase lettering in the word 'air' acts as a natural break in the expression and serves to set the words apart. Therefore, the fact that no gap has been placed between the words in the applicant's mark, cannot be said to create a neologism or newly invented expression. I also find that the black background in the contested mark serves very little if any trade mark purpose. It is the case that the opponent's earlier plain word mark may be used fairly, in the course of trade, in black or white lettering and may commonly be used in such a way when considering the nature of the clothing and fashion markets. It is not beyond reason that the opponent may use the earlier mark on labels and swing tags that are rectangular or square in shape and that those labels or swing tags may be dark in colour, affecting the manner in which the opponent may wish to present the words 'KICK AIR'.

44. However, in the event that I am found to be wrong in a finding of direct confusion, I go on to consider the matter in respect of indirect confusion.

45. Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 noted that:

“16. ...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.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

46. These examples are not exhaustive but provide helpful focus.

47. For the relevant public that may notice the differences between the marks at issue, I find that the identical nature of the goods at issue, combined with the identical impact of the marks aurally and conceptually, serve to ensure that the average consumer who perceives the marks as visually different, will certainly assume that they are variant marks from the 'KICK AIR' brand or range of clothing, and that any goods bearing these marks come from the same, or an economically linked, undertaking.

48. I conclude therefore, that indirect confusion is likely to occur.

### **Conclusion**

49. As I have found that there is a likelihood of confusion, the opposition is successful and, subject to appeal, the application is refused.

### **Costs**

50. The opponent has been successful and is entitled to a contribution towards its costs. I bear in mind that the relevant scale is contained in Tribunal Practice Notice 2/2016. I make no award however, for the submission of evidence, as this material played no significant role in the matter and cannot be said to be particularly detailed or lengthy in nature.

51. I award costs to the opponent as follows:

Official opposition fee	£100
Preparing the statement of case and Considering the counterstatement	£200
<b><u>Total</u></b>	<b><u>£300</u></b>

52. I therefore order Kick Air Manchester Limited to pay Mohammed Asif Mann the sum of £300. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 8<sup>th</sup> day of April 2020**

**Andrew Feldon**

**For the Registrar**

**The Comptroller-General**