

O/282/20

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. UK00003346649

FOR THE MARK:

CAMEL

IN THE NAME OF WAN ERIC GUANGYU

AND AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO

UNDER NO. 502624

BY WORLDWIDE BRANDS, INC

BACKGROUND AND PLEADINGS

1. Wan Eric Guangyu (“the proprietor”) is the registered proprietor of UK trade mark registration no. 3346649 for the following trade mark:

CAMEL
 (“the proprietor’s mark”)

2. The proprietor’s mark was filed on 18 October 2018 and registered on 15 March 2019. It was published for opposition purposes on 4 January 2019. It stands registered for the following goods:

Class 25: Clothing, footwear, headgear; underwear; shirts; trousers; overcoats; knitwear [clothing]; coats; skirts; sports jerseys; topcoats; jackets [clothing]; tee-shirts; layettes [clothing]; shoes for babies; swimsuits; football shoes; ski boots; footwear; boots; sandals; shoes; sports shoes; track and field shoes; mountaineering shoes; climbing shoes; footwear for women; hats; gloves [clothing]; neckties; hosiery; leather belts [clothing].

3. On 28 May 2019, Worldwide Brands, Inc (“the applicant”) applied to invalidate the proprietor’s mark. The applicant relies upon Section 47(2)(a) of the Trade Marks Act 1994 (“the Act”). The application is based upon section 5(2)(b) of the Act and the applicant relies upon international registration no. 814414 for the following trade mark:



4. The applicant’s mark was registered on 9 September 2003. With effect from 5 July 2017, the applicant sought to designate the EU as a territory in which it seeks to protect its mark under the terms of the Protocol to the Madrid Agreement.

Protection was granted on 30 January 2018. The applicant relies upon the following goods for which its mark is registered:

Class 25: clothing, footwear, headgear.

5. The applicant claims that the conditions of section 5(2)(b) of the Act are met in that there exists a likelihood of confusion between the marks on the part of the public, which includes the likelihood of association. As a result, the applicant seeks a declaration of invalidity against the proprietor's mark.
6. The proprietor filed a counterstatement denying the grounds of invalidation (and requested that the applicant provide proof of use of its mark).
7. The applicant is represented by CMS Cameron McKenna Nabarro Olswang LLP and the proprietor is represented by STOBBS. Only the applicant filed evidence. No hearing was requested and both parties filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

EVIDENCE

8. The applicant filed evidence in the form of the witness statement of Ronald van Tuijl dated 22 November 2019, which is accompanied by 18 exhibits. Mr van Tuijl is the Trademarks and Copyrights Administrator of the applicant, a position he has held since February 2016. I have read Mr van Tuijl's evidence in its entirety and have summarised the most pertinent points below.
9. The applicant was established on 18 October 1983 and its operational and financial headquarters are located in Cologne, Germany. Since 2001, the applicant has licensed its mark to its master licensee CMLC GmbH, who, with full consent and knowledge of the applicant, sub-licensed the use of the mark to various sub-licensees around the world.

10. Mr van Tuijl states that the applicant's mark has been in continuous use by the applicant's licensees with its full consent and, as a result, constitutes genuine use for the purposes of section 47(2B) of the Act.
11. The applicant produces, sells and distributes a range of casual menswear, womenswear, footwear, headwear and accessories, all of which bear the applicant's mark on the labels, soles and/or embellished on the external face of the goods. Since its launch in 2001, more than 50 million units of clothing, footwear, headgear and accessories bearing the applicant's mark have been sold worldwide.
12. Goods bearing the applicant's mark are sold in many countries around the European Union, including the UK. There are 82 retailers throughout the United Kingdom and Ireland that stock and sell clothing, headgear and footwear that bear the applicant's mark.¹
13. To coincide with each new fashion season, the applicant launches a new collection of clothing, footwear and accessories. In support of these launches, the applicant produces catalogues advertising its latest collections of clothing, footwear and headgear.² These catalogues are uploaded to the applicant's website where they can be accessed by retail customers around the world, including the UK and European Union.
14. The applicant's website is accessible to customers worldwide with language options in German, English and Russian. The website allows users to view the latest clothing collections and to locate stores that stock and sell goods bearing the applicant's mark. Between 9 October 2017 and 15 October 2019, 28,423 users accessed the applicant's website from the United Kingdom.³ During the same period, over 400,000 users visited the website from within the European Union.
15. Mr van Tuijl explains that the applicant actively exhibits its clothing, footwear and headgear bearing the applicant's mark at trade shows within the UK and has

¹ Exhibit RVT-15

² Exhibits RVT-1 – RVT-8

³ Exhibit RVT-10

exhibited a number of photographs from various trade shows between February 2015 and January 2018.⁴

16. Mr van Tuijl has also provided a selection of invoices dated between 3 February 2014 and 8 August 2018.⁵ I note the following:

- a. In total, these invoices amount to the shipment of 939 of the applicant's goods to retailers. This includes 100 items of clothing, 788 items of footwear and 51 items of headgear.
- b. The invoices confirm the goods are to be delivered to a variety of locations across to UK including Norwich, Derby, Rugeley, Perth, Rye, Harpole, Ilkley, Crewe, Newcastle, Belfast, Newmarket, Llandudno, Suffolk, Bristol, Ludlow, Guernsey, Bridgport, York and Mold.
- c. All invoices display the applicant's mark.
- d. While the quantity of goods shipped remains visible, the information regarding the value of the goods shipped has been redacted on all invoices to protect confidential and commercially sensitive information.

17. I have read both parties' written submissions and, whilst I do not propose to summarise those here, I will refer to them below where necessary.

PRELIMINARY ISSUE

18. In its notice of defence and counterstatement, the proprietor put the applicant to proof of use of its mark for all goods upon which the invalidation is based. In response to this, the applicant provided evidence in support of its proof of use. However, for reasons I will now explain, the issue of proof of use is not relevant to these proceedings.

19. Section 47(2A) of the Act states:

⁴ Exhibits RVT-12 and RVT-14

⁵ Exhibits RVT-16 – RVT-18

“The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

- (a) The registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declarations,
- (b) The registration procedure for the earlier trade mark was not completed before that date, or
- (c) The use conditions are met.”

20. This is explained in section 3.4.6 of the Tribunal Section of the Trade Marks Manual⁶ as follows:

“The obligation to demonstrate use of the trade mark is not applicable immediately after registration of the trade mark; instead the registered proprietor has five years following the completion of the registration procedure to put the trade mark into use on the goods and/or services for which the trade mark was registered. Before this period of five years expires the registration is protected for all the goods and/or services for which it is registered. Once the mark has been registered for five years proof of use may be required.”

21. As set out above, the applicant’s mark is an international registration that was registered on 9 September 2003. However, the applicant did not designate its mark for protection within the European Union until 5 July 2017 with protection ultimately granted on 30 January 2018. Prior to that date, the applicant’s mark was not protected in the European Union. The initial period of five years since the applicant’s mark was registered as protected in the European Union is yet to lapse. The applicant’s mark is, therefore, not subject to proof of use pursuant to section 6A of the Act. The applicant can, therefore, rely upon all of the goods for which the applicant’s mark is registered.

⁶ <https://www.gov.uk/guidance/trade-marks-manual/tribunal-section>

22. For the avoidance of doubt, if it were in issue in these proceedings, the evidence is such that I would have concluded that the applicant had put its mark to genuine use within the European Union during the relevant period.

DECISION

23. Section 5 of the Act has application in invalidation proceedings because of the provisions set out in section 47. The relevant legislation is set out below:

“47. –[...]”

(2) The registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) ...

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2A) But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.”

[...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

24. Section 5(2)(b) of the Act reads as follows:

“(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 or association with the earlier trade mark.”

25. 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 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.”

26. The mark upon which the applicant relies qualifies as an earlier trade mark under the above provisions. I have set out above the reasons why the applicant is not subject to proof of use and can, therefore, rely upon all of the goods for which the earlier marks are registered.

27. 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) ("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.

- (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

28. The competing goods are as follows:

The applicant's goods	The proprietor's goods
<p><u>Class 25</u></p> <p>Clothing, footwear, headgear.</p>	<p><u>Class 25</u></p> <p>Clothing, footwear, headgear; underwear; shirts; trousers; overcoats; knitwear [clothing]; coats; skirts; sports jerseys; topcoats; jackets [clothing]; tee-shirts; layettes [clothing]; shoes for babies; swimsuits; football shoes; ski boots; footwear; boots; sandals; shoes; sports shoes; track and field shoes; mountaineering shoes; climbing shoes; footwear for women; hats; gloves [clothing]; neckties; hosiery; leather belts [clothing].</p>

29. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 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”.

30. 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.

31. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another or (vice versa):

“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”.

32. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

“...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”.

33. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

34. Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

35. The applicant has provided submissions regarding the comparison of the goods. I do not propose to reproduce these in full but have taken them into account in making my comparison.

36. “Clothing, footwear, headgear” and “footwear” contained within the proprietor’s mark have direct counterparts in the applicant’s mark’s specification i.e. “Clothing, footwear, headgear”. These goods are identical.

37. “Underwear”, “shirts”, “trousers”, “knitwear [clothing]”, “skirts”, “sports jerseys”, “tee-shirts” and “layettes [clothing]” in the proprietor’s mark’s specification fall within the broader category of “clothing” in the applicant’s mark’s specification. These goods are therefore identical under the principle outlined in *Meric*.
38. “Shoes for babies”, “football shoes”, “ski boots”, “boots”, “sandals”, “shoes”, “sports shoes”, “track and field shoes”, “mountaineering shoes”, “climbing shoes” and “footwear for women” in the proprietor’s mark’s specification all describe different types of footwear and, therefore, fall within the broader category of “footwear” in the applicant’s mark’s specification. These goods are therefore identical under the principle outlined in *Meric*.
39. “Overcoats”, “coats”, “topcoats” and “jackets [clothing]” in the proprietor’s mark’s specification describe various items of clothing that are worn over the top of other items of clothing in order to protect the consumer from the elements, such as rain and/or cold weather. These goods fall within the broader category of “clothing” contained within the applicant’s mark’s specification and are, therefore, identical under the principle outlined in *Meric*.
40. “Swimsuits” in the proprietor’s mark’s specification describes an item of clothing that is worn for the purpose of swimming and falls within the broader category of “clothing” in the applicant’s mark’s specification. These goods are therefore identical under the principle outlined in *Meric*.
41. “Hats” in the proprietor’s mark’s specification describe a certain type of headgear and, therefore, falls within the broader category of “headgear” within the applicant’s mark’s specification. These goods are therefore identical under the principle outlined in *Meric*.
42. “Neckties” in the proprietor’s mark’s specification describes a piece of long cloth that is tied around the neck, mainly for decorative purposes. It is commonly worn with a collared shirt. A necktie is an accessory and, therefore, does not fall within any of the categories in the applicant’s mark’s specification. However, given that a necktie will commonly be worn as an accessory to clothing, it will likely overlap in user and purpose with “clothing” contained within the applicant’s mark’s

specification. Further, there may be overlap in trade channels because the same undertakings are likely to produce both neckties and various items of clothing, such as shirts. Neckties will also be found in shops next to clothing items such as shirts and, in some instances, may also be sold together. I, therefore, consider these goods to be highly similar.

43. “Hosiery” in the proprietor’s mark’s specification describes a garment that is worn directly on the feet and legs, such as tights or stockings. These goods can either be worn as an undergarment or combined with items of clothing, such as skirts. They are items of clothing and, therefore, fall within the broader category of “clothing” contained within the applicant’s mark’s specification. These goods are identical under the principle outlined in *Meric*.

44. “Gloves [clothing]” contained within the proprietor’s mark’s specification describes a garment that is worn on the hands. A glove can have many uses such as sports gloves or protective gloves. However, the term, as contained in the proprietor’s mark’s specification, specifically describes an item of clothing. Therefore, I find that these goods fall within the broader category of “clothing” as contained within the applicant’s mark’s specification. These goods are identical on principle outlined in *Meric*. Even if I am wrong in this finding, there will be overlap in user, use, method of use and trade channels and the goods will be highly similar.

45. “Leather belts [clothing]” contained within the proprietor’s mark’s specification describes a strip of leather that is fastened around the consumer’s waist. The purpose of a belt is commonly to hold an item of clothing in place; however, it can also be used for decorative purposes. While I note the description within the proprietor’s mark’s specification specifies clothing, I do not consider it to be an item of clothing. It, therefore, does not fall within any of the categories contained in the applicant’s mark’s specification. However, the goods may overlap in user and purpose with “clothing” contained within the applicant’s mark’s specification. Further, given that leather belts are used to hold up items of clothing they will be complementary to clothing, such as trousers, jeans and skirts and dresses. There will also be overlap in trade channels as the same undertakings are likely to produce both leather belts and other items of clothing. Leather belts will also be

found in shops next to items of clothing such as jeans, trousers, skirts and dresses. They may also, in some circumstances, be sold together with these items. I, therefore, consider these goods to be highly similar.

The average consumer and the nature of the purchasing act

46. 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 decide the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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.”

47. The applicant submits that, “the average consumer purchasing the goods covered by the Earlier Mark and Registered Trade Mark is identical, that being a member of the general public.” Further, in respect of the purchasing act, the applicant submits that “It is arguable that the average consumer will display at least an average degree of attention when selecting the goods in question.”

48. The proprietor has submitted that “clothing, footwear and headgear are products that are marketed and sold to general consumers.” I agree with the parties' submissions that the average consumer for the goods at issue is a member of the general public.

49. In *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, the GC stated that:

“50..... 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.”

50. The goods at issue are most likely to be sold through a range of clothing retailers and their online or catalogue equivalents. In clothing retailers, the goods at issue will be displayed on shelves or racks, where they will be viewed and self-selected by the consumer. A similar process will apply to websites and catalogues, where the consumer will select the goods having viewed an image displayed on a webpage or in a catalogue. The selection of the goods at issue will, therefore, be primarily visual. While the visual aspect plays a greater role in the selection process, I do not discount aural considerations in the form of advice sought from sales assistants, word of mouth recommendations or telephone queries with retailers.

51. The price and frequency of purchase of the goods at issue may vary. Even where the goods are of low cost and purchased relatively frequently, a number of factors will still be considered by the average consumer during the purchasing process. For example, the consumer may consider current fashion trends, price, quality and suitability. With this in mind, I consider that the average consumer will pay a medium degree of attention during the purchasing process.

Distinctive character of the opponent's mark

52. 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).”

53. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

54. The applicant has pleaded that its mark has acquired enhanced distinctiveness through use and has submitted the following:

“we refer to the Cancellation Applicant's "proof of use evidence" submitted on 25 November 2019, which establishes that the Applicant has acquired enhanced distinctiveness relating to the Earlier Mark. The evidence submitted shows that the Applicant has clearly been using the Earlier Mark for a significant period of time (since as early as 2002) in the UK in relation to class 25 goods.

As a result of this enhanced acquired distinctiveness, the Applicant enjoys a greater scope of protection and therefore it follows, that there exists a likelihood of confusion between the Earlier Mark and the Registration.

55. Enhanced distinctiveness must be established in relation to the UK market as the test for confusion will be assessed by reference to the average consumer who is a member of the general public within the UK. The applicant has filed a significant amount of evidence relating to the broader EU market. However, the evidence that applies to the UK market is as follows:

- a. evidence of users to its website between 9 October 2017 and 15 October 2019;⁷
- b. evidence of attendance at trade shows;⁸
- c. a list of 82 retailers that stock the applicant's goods, 55 of which are located within the UK;⁹ and
- d. invoices to various retail outlets across the UK¹⁰ relating to the shipment of 939 items of the applicant's goods.

56. Whilst I recognise that use of the mark has not been insignificant, I am not satisfied that the evidence is sufficient to demonstrate that the applicant's mark has acquired an enhanced level of distinctiveness within the UK. I recognise that the applicant's evidence shows 55 retailers across the UK stocking the applicant's goods. Whilst this does show the geographical extent of the use of the mark, the applicant has failed to provide evidence of the market share held by its mark in the UK. I note that the applicant has stated that since 2001, it has sold over 50 million items bearing its mark,¹¹ however, it has not provided any evidence in respect of how many of these sales have been in the UK. The sales evidence filed, being the

⁷ Exhibit RVT-10

⁸ Exhibits RVT-12 and RVT-14

⁹ Exhibit RVT-15

¹⁰ Exhibits RVT-16, RVT-17 and RVT-18

¹¹ Paragraph 2.3 of the Witness Statement of Ronald van Tuijl

various invoices referred to above, does not demonstrate a significant level of sales of the applicant's goods within the UK. Whilst there is also evidence in respect of attendance at trade shows, there is no evidence that demonstrates the amount the applicant has invested in promoting its mark. On this basis, I do not find that the evidence filed supports a claim for enhanced distinctive character and, therefore, I am only able to consider the position based on inherent characteristics.

57. The applicant submits that:

"The Earlier Mark consists, of two elements, CAMEL and ACTIVE. The first element of the mark, "CAMEL", is identical to the Registration. The second element "ACTIVE", is descriptive of the products for which it is registered and as such, is of low distinctive character. At **Annex 1** we attach extracts taken from the online Cambridge Dictionary, which defines the word "ACTIVE" as meaning an adjective for "*busy*". When the word "ACTIVE" is used in relation to class 25 goods, namely clothing, it is commonly referred to as "ACTIVEWEAR" which is defined as "*clothes that a worn for sports or other physical activities*" (**Annex 1**). It follows, that the element ACTIVE is common place in relation to class 25 goods and as such, is of low distinctive character and/or descriptive.

58. The proprietor submits that "CAMEL ACTIVE has a different meaning when compared to the element CAMEL alone. This is because the combination of two words that do not typically go together creates a degree of unusual distinctive character."

59. The applicant's mark is made up of two elements, being the word element and the coloured outline. The mark contains the words 'CAMEL ACTIVE' in a black, slightly stylised font. While the word 'CAMEL' is placed above the word 'ACTIVE', the words will still be read as 'CAMEL ACTIVE'. The outline element of the mark consists of two lines in black at the top and yellow at the bottom. The lines are not connected and act as a curved framing device for the words 'CAMEL ACTIVE'. Within the registration of the applicant's mark, the background to the mark is specified as being white.

60. The word 'CAMEL' will be seen by a significant proportion of average consumers to be a reference to the large desert animal and will be neither descriptive nor allusive to the type of goods protected by the applicant's mark. When used on the applicant's goods, the word 'CAMEL' will be seen as unusual by a significant proportion of the average consumer. It will therefore have at least a medium degree of inherent distinctiveness.

61. The word 'ACTIVE' means someone who moves around a lot or does a lot of things¹². When displayed on the applicant's goods I agree with the applicant's submissions that it will be seen by a significant proportion of average consumers to be a reference to active wear. It will, therefore, be descriptive of the type of goods for which the applicant's mark is registered. On goods that are not worn for sports or physical activity, the word 'ACTIVE' will be given its ordinary meaning and will, therefore, not be considered by a significant proportion of average consumers to be allusive or descriptive to the goods for which the applicant's mark is registered.

62. While noticeable, I am of the view that the stylisation of the words 'CAMEL ACTIVE' and the black and yellow curved lines contribute slightly to the inherent distinctive character of the mark. Further, while the background is specified in the registration as being white, I do not consider that this will have any effect on the distinctive character of the applicant's mark. Overall, I consider the applicant's mark to have a higher than medium degree of inherent distinctive character.

Comparison of marks

63. It is clear from *Sabel 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.


¹² <https://www.collinsdictionary.com/dictionary/english/active>

64. 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.”

65. 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.

66. The respective trade marks are shown below:

The applicant's mark	The proprietor's mark
 The logo for 'Camel Active' features the word 'CAMEL' in a bold, black, sans-serif font above the word 'ACTIVE' in a similar font. A yellow curved line underlines 'ACTIVE' and extends to the right. A black curved line above 'CAMEL' extends to the left.	CAMEL

67. I have lengthy submissions from both parties regarding the similarity of the marks. Whilst I do not propose to reproduce these in full here, I will refer to them below where necessary.

Overall Impression

The applicant's mark

68. The applicant's mark consists of two elements, being a word element and a device element. While I note that registration states the background of the mark is white, I am of the view that this will go unnoticed by the average consumer. The word element consists of the word 'CAMEL' placed above the word 'ACTIVE'. The words are displayed in a black, slightly stylised font. The word element is placed in the middle of the mark and is surrounded by the outline element, which acts as a border to the words. The top line of the border is black and the bottom line is yellow. The eye is naturally drawn to the elements of the mark that can be read and I consider the words 'CAMEL ACTIVE' play a greater role in the overall impression of the mark, with the device element playing a lesser role.

The proprietor's mark

69. The proprietor's mark consists of the word 'CAMEL'. There are no other elements to contribute to the overall impression, which lies in the word itself.

Visual Comparison

70. The applicant has submitted:

“Visually, the signs are highly similar on the basis that Registration is comprised of the element "CAMEL" which is identical to the dominant and distinctive element in the Earlier Mark. Furthermore, the descriptive and non-distinctive element "ACTIVE" for the goods covered by class 25 and the low stylisation in the Earlier Mark does not serve to differentiate the visual similarity between the respective marks. ACTIVE will not be at the forefront of the average consumers mind given the low level of distinctiveness.”

71. The proprietor has submitted:

“the additional element ACTIVE present in the mark that is the subject of IR No. 814414 differentiates the marks. That mark appears in a lock-up format: with the word CAMEL appearing directly above the word ACTIVE. The two words are, as noted above, of approximately equal length. The words appear in the same stylised font. The comparison between the marks must be a comparison by examining the marks as a whole (ECJ, 20 September 2007, Societe des Produits Nestle/CHIM - Quick Restaurants, C-193/06 P, paragraph 35). Therefore the assessment must take into account the overall appearance of the CAMEL ACTIVE mark, in lock-up. The words CAMEL ACTIVE do not run beside each other. The mark appears in a specific format which visually emphasises both verbal elements one above the other as equal (balanced) features.

The font used in the mark is highly distinctive. It is not an everyday font, and it is distinguished by an unusual combination of the letters appearing in a mixture of capital and lower-case.

Further, the mark subject of IR No. 814414 includes border features. A black border appears above the mark in a curved format. A yellow border of equal size and shape appears below the mark. This again emphasises that the mark must be considered as it appears as a whole, in lock-up.

The only shared visual elements in the marks at issue is the word CAMEL. However, this element does not dominate the mark subject of IR No. 814414 visually. No one feature of that mark dominates.”

72. Visually, the marks coincide in that they share the words CAMEL. The marks differ in the word ‘ACTIVE’, that is present in the applicant’s mark but absent in the proprietor’s mark. The marks also differ in that the wording of the applicant’s mark is slightly stylised and it also has a black curved line at the top and a yellow curved line at the bottom. I have found that the outline plays a lesser role in the applicant’s mark, however, it still constitutes to the visual differences between the marks. I note that the proprietor’s mark is a word only mark and can be used in any standard typeface and registration in black and white will cover the use of the mark in

different colours. Taking all of this into account, I find that the marks are similar to a medium degree.

Aural Comparison

73. The applicant submits that:

Aurally, the marks are highly similar on the basis that both marks consist of and/or incorporate the dominant and distinctive element "CAMEL" at the beginning of the mark. Therefore the first and therefore the dominant element of the marks will be pronounced identically and as noted above, where the marks coincide at the beginning, the likelihood of confusion is greater as "consumers generally take more note of a word's beginning than of its ending" [...] In this Invalidity, the Registered Trade Mark is wholly comprised of the dominant and distinctive element in the Earlier Mark.

74. The proprietor submits that:

"The mark upon which the cancellation action is based consists of the verbal element CAMEL ACTIVE. The Registered Proprietor submits that the additional element ACTIVE differentiates the marks. The mark would be referred verbally to as CAMEL ACTIVE, a composite expression. The mark is not CAMEL alone, nor is it ACTIVE alone. The two elements are presented in lock-up together. As such, the mark upon which the cancellation application is based is pronounced very differently from the word CAMEL.

The Registered Proprietor submits that the mark upon which the cancellation action is based would not be recognised as CAMEL. It would be recognised and referred to by consumers as CAMEL ACTIVE as one composite reference. Both words appear in the mark relied on in the action in equal font and size. One element is not given prominence in relation to the other. As such, consumers of clothing items would not refer to the mark as CAMEL. Consumers would refer to it as CAMEL ACTIVE.

The inclusion of the ACTIVE element means the marks are pronounced differently, and are of different length and emphasis. The trade mark CAMEL consists of two syllables: CAM / EL. By contrast, the trade mark CAMEL ACTIVE consists of four: CAM / EL ACT / IVE. The latter mark contains two words of similar length. Each word in the CAMEL ACTIVE mark "balances" the other. A pause between the two words highlights the differences in pronunciation between the relevant marks."

75. Aurally, the applicant's mark consists of four syllables that will be pronounced 'KA-MUL-ACK-TIV'. The proprietor's mark consists of two syllables, being 'KA-MUL'. The outline element of the applicant's mark will not be pronounced. The similarities, therefore, include the entirety of the aural element of the proprietor's mark. The marks differ aurally with the inclusion of the last two syllables of the applicant's mark. In respect of those goods for which 'ACTIVE' would be considered allusive of the goods, I conclude that it is unlikely to be produced (because it is simply viewed as the type of goods for which the applicant's mark is registered). In those circumstances, the marks will be aurally identical. However, if the word 'ACTIVE' is pronounced, then the marks will be aurally similar to a medium degree.

Conceptual Comparison

76. The applicant submits that:

"Conceptually, the marks are once again identical on the basis that the dominant and distinctive element of the respective marks is the word "CAMEL". Given that the element "ACTIVE" is non-distinctive and descriptive in relation to class 25 goods, a consumer is likely to understand both marks as the animal. Given this, the likelihood of confusion claim in the Invalidity is strengthened on the basis of the highly visual and aural similarities between the contested sign of the Application and the Earlier Marks."

77. The proprietor submits that:

“The Registered Proprietor notes that the combination of the words CAMEL and ACTIVE is non-sensical. One would not refer to a camel (a large desert-living animal) as "active". If it was, the reference would be to "an active camel." The combination of the two words and the unusual order is irregular and the Registered Proprietor submits there is distinctive character in what is an unusual combination.”

78. The only element of the applicant's mark that might convey a conceptual message is the word element, being 'CAMEL ACTIVE'. The average consumer will view the word 'CAMEL' in both marks as a large, desert animal and will, therefore, be conceptually identical. However, I recognise that the word 'ACTIVE' in the applicant's mark will act as a point of conceptual difference between the marks. The word 'ACTIVE' will be given its ordinary meaning. On goods associated with active wear, the word 'ACTIVE' will be descriptive of the goods for which the mark is registered. Overall, I find that the conceptual meaning conveyed by the marks as a whole will be similar to at least a medium degree.

Likelihood of confusion

79. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne 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 and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact 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.

80. I have found the goods to vary from being identical to similar to a high degree. I have found the average consumer to be a member of the general public who will purchase the goods primarily by visual means, although I do not discount an aural component. I have concluded that a medium degree of attention is likely to be paid in the purchasing process of the goods at issue. I have taken these factors into account in my assessment of the likelihood of confusion between the marks.

Direct Confusion

81. I have found the marks to be visually similar to a medium degree, aurally identical or similar to a medium degree (depending on whether the word 'ACTIVE' is pronounced) and conceptually similar to at least a medium degree. The applicant's mark is inherently distinctive to at least a medium degree. Notwithstanding the principle of imperfect recollection and taking all of the above factors into account, I consider that the presence of the word 'ACTIVE' and/or the outline element in the applicant's mark will be sufficient to enable the consumer to differentiate between them. This will particularly be the case given the importance of the visual component in the selection of the goods at issue and in circumstances in which the consumer will be paying a medium degree of attention when selecting the goods at issue. Consequently, I do not consider there to be a likelihood of direct confusion between the marks, even where they are used on identical goods.

Indirect confusion

82. I will now consider whether there is a likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10.

"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.”

83. I must now consider the possibility of indirect confusion and whether average consumers would believe that there is an economic connection between the marks or that they are variant marks from the same undertaking as a result of the shared common elements of the marks. If I am wrong in my finding that the marks will be misremembered or mistakenly recalled as each other by the average consumer, because the word ‘ACTIVE’ and the presentational differences will be recalled, they are likely to be seen as an extension of a brand (being a variant mark that identifies a range of active wear clothing). Taking all of the above factors into account, the presence of the word ‘CAMEL’ in each of the marks will lead the average consumer to view them as alternative marks used by the same or economically linked undertakings. I therefore consider there to be a likelihood of indirect confusion.

CONCLUSION

84. The ground for invalidation under section 47(2) of the Act based on section 5(2)(b) has succeeded in full. Under section 47(6) UK trade mark registration 3346649 is deemed never to have been made. This means that the registration of the mark will be cancelled with effect from 18 October 2018.

COSTS

85. As the applicant has been successful, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. I acknowledge that the applicant filed evidence in relation to proof of use of the mark in the European Union. For the reasons set out above, proof of use was not an issue that was relevant to this decision. However, I recognise that part of the

evidence did go to the issue of enhanced distinctive character within the UK market and I have, therefore, made an award of costs in respect of the evidence filed, albeit with an appropriate reduction applied. In the circumstances, I award the applicant the sum of **£1,100** as a contribution towards its costs. The sum is calculated as follows:

Preparing a statement and considering the proprietor's statement:	£200
Preparing evidence:	£400
Preparing written submissions in lieu:	£300
Official fee:	£200
Total:	£1,100

86. I therefore order Wan Eric Guangyu to pay Worldwide Brands, Inc the sum of £1,100. This sum is to be paid within two months or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 14th day of May 2020

A COOPER
For the Registrar