

O-288-20

TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO. 3350577
BY BELO NATIVO LIMITED
TO REGISTER

BASILAR

AS A TRADE MARK IN CLASSES 25 and 35

AND

OPPOSITION THERETO
UNDER NO. 415432
BY TRISTYLE BRANDS GMBH

Background and pleadings

1. On 03 November 2018, Belo Nativo Limited (“the applicant”) applied to register the trade mark shown below under number 3350577:

BASILAR

2. The application was published for opposition purposes on 14 December 2018 for the following goods and services:

Class 25 Clothing, including tops, underwear, t-shirts, denim goods, socks, ties, coats, jackets and scarves; footwear, including trainers, shoes and boots; headgear, including caps, bandanas; belts.

Class 35 Retail services connected with clothing, footwear, headgear, clothing accessories, bags, backpacks, travel bags, handbags, luggage, brief cases, leather folios, cases and bags, sports bags, holdalls, clutch bags, purses, wallets, umbrellas, parasols, cases, jewellery, watches, perfumery and cosmetics.

3. TriStyle Brands GmbH (“the opponent”) filed a notice of opposition on 12 February 2019 on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all of the goods and services in the application. The opponent relies upon the following earlier trade marks:

4. Mark: **B/A/S/L/E/R** (“figurative mark”)

International Registration (“IR”) no. 704649

Date of protection of the IR in the UK: 9 March 2000

International registration and designation date: 4 September 1998

5. The registration of this mark covers a range of goods in classes 14, 18 and 25. Even though the opponent sought to rely on all goods covered by the registration, it only provided a statement of use for the goods shown below. As it did not plead that there

were proper reasons for non-use for the remaining goods, it may only rely on the goods for which it has claimed use in its notice of opposition, namely:

Class 25: Clothing with the exception of clothing for fishing, diving, skating and icehockeying.

6. Mark: BASLER (“word mark”)

European Union trade mark (“EUTM”) registration no. 014355614

Filing date: 10 July 2015

Date of entry in register: 8 December 2015

Goods and Services

Class 9 Spectacles [optics]; Sunglasses.

Class 14 Jewellery; Paste jewellery [costume jewellery (Am)]; Timepieces.

Class 25 Clothing, apparel; Footwear; Headgear; All the aforesaid goods other than clothing for angling, clothing for diving, clothing for ice skating and clothing for ice hockey.

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

8. Given its date of filing, the trade marks upon which the opponent relies qualify as earlier trade marks in accordance with section 6 of the Act. The word mark had not completed its registration process more than five years before the application date of the opposed application. Therefore, in accordance with section 6A of the Act, this mark is not subject to the proof of use provisions. The opponent can, as a consequence, rely upon all of the goods it has identified under this mark. The opponent’s figurative mark is subject to the proof of use provisions.


9. The applicant filed a counterstatement denying the grounds of opposition and putting the opponent to proof of use of the figurative mark.

10. The opponent is represented by Lichtenstein, Körner & Partner mbB. The applicant was initially represented by Wilson Gunn but is now unrepresented. Only the opponent filed evidence. I will mention the evidence to the extent I consider appropriate. No hearing was requested, and neither party filed written submissions in lieu. I make this decision after a careful reading of all the papers filed by the parties.

Evidence

Opponent's evidence

11. This consists of the witness statement of Marc Barrantes, with thirteen exhibits. Mr Barrantes states that he was the former Managing Director of Basler (UK) Limited from 2015, and, since 2018, the Managing Director of the opponent company.

12. Mr Barrantes states that Basler (UK) Limited was founded in Berlin in 1936 and it opened its first UK store at Bond Street in London in 2007. He further states that the UK arm of Basler has been operating three own-brand stores, 17 concessions and one factory outlet.¹ Mr Barrantes exhibits three undated Google Street View images of the BASLER fashion store in Bond Street in London.² In the first two images of the store, above the word BASLER appears the figurative sign . However, the mark is not clear in the third image.


13. Mr Barrantes states that the design of the logo B/A/S/L/E/R was modernized into BASLER in 2013.³

14. Basler (UK) Limited's report and financial statements for the year ended 30 April 2014, 30 April 2015 and 30 April 2016 are provided as Exhibits TB2, TB3 and TB4. These reports show the company's revenue as £11,249,979, £9,138,334, and £8,651,024, respectively. As per these reports, the principal activity of the company is "dealing in ladies fashion wear".

¹ Witness Statement, para 2.

² Exhibit TB1

³ Witness Statement, para 3

15. Cosgroves' spring/summer 2014 brochure is produced as Exhibit TB5. Cosgrove is a department store with a selection of ladieswear, menswear and accessories.⁴ Page 4 of the brochure features photograph of a model wearing a top and skirt. The mark displayed on this page is **B/A/S/L/E/R** and above it appears the sign . The opponent has not provided the circulation figures for the brochure, and, therefore, it is difficult to ascertain how many customers have seen the brochure.

16. A print out purportedly from Cosgrove's website is provided as Exhibit TB6. On the pages filed in evidence, the website address has been chopped off. It is undated, however, makes the following reference to the Basler fashion show spring/summer 2015 collection:

“Over 70 customers were treated to a fashion show of the Basler Spring/Summer collection ..”


Page 2 of this Exhibit shows a photograph of a shop floor displaying what appears to me as women's jackets/coats under the mark **B/A/S/L/E/R**.

17. Another print out from Cosgrove's website is provided as Exhibit TB7. The website address is not visible on the Exhibit, and the Exhibit is undated. It refers to the Basler Fashion Show hosted at Cosgrove's Rimington showroom in September 2016. Page 2 of the Exhibit features women's jackets under the mark **BASLER** with the following statement:

“Basler presented numerous coat solutions from the quilted ski to the wool funnel coat.”

18. A print out from the website *cosgrovesfashion.com* is provided as Exhibit TB8. It is undated and contains a photograph of a shop floor featuring women's jackets/coats/tops under the mark Basler.

⁴ Exhibit TM5, page 9.

19. Exhibit TB9 is a print out of an article from the website *www.femalefirst.co.uk* dated 4 February 2014. The article is titled “*Basler fashion collection for AW14 inspired by London*”. It provides five images from a fashion show that displays the mark BASLER on the runway background. Above the mark appears the sign . The following are the relevant excerpts from page 3 of the Exhibit:

“The Basler Collections are always feminine, exclusive and very modern, with perfect fit and international flair. Designed by Creative Director Brian Rennie, there is always an element of surprise, a bold mix of pattern and print. From Sporty to Couture to Event dressing, Basler has collections for all market segments with excellent price points. Presenting LONDON as the theme at “Platform Fashion” in Dusseldorf, Basler staged a spectacular show, with many Basler favourites in the Front Row.”

20. Mr Barrantes further states that Basler (UK) Limited and its German parent company Basler Fashion GmbH fell into insolvency proceedings in September 2017 and as a result, all the stores in the UK had to be closed. Mr Barrantes also states that the trade mark rights were sold to TriStyle Mode GmbH in October 2017 and then assigned to the other group company TriStyle Brands GmbH.⁵

21. An extract from Retail Gazette’s newsletter is provided as Exhibit TB10. It is dated 1 September 2017. The newsletter reports that the UK arm of Basler officially entered into insolvency procedures.

22. A print out of an article from *Fashion United* on the appointment of administrators for Basler UK is provided as Exhibit TB11. The article is dated 4 September 2017. On page 2 of the article, the following information is provided:

“Arron Kendall and Simon Thomas, partners at Moorfields Advisory, have been appointed joint administrators, and they have confirmed that the UK subsidiary, which has three own-brand stores located at Bond Street in London,

⁵ Witness Statement, para 2.

Chichester, and Epsom, will continue to trade as normal to fulfil wholesale order, while conducting a stock liquidation through the retail outlets.”

23. A print out of an article from *Fashion Network* on Basler entering administration is provided as Exhibit TB12. It is dated 4 September 2017.

24. Mr Barrantes states that the Basler fashion collection was released for the season autumn/winter 2018, including in the UK. Since then the mark BASLER has been put to use again by the opponent in the UK. The new distribution in the UK is coordinated by the Dutch importer Martens Fashion Group with the consent of the opponent.

25. Exhibit TB13 is an article titled “*New owners breathe life into Basler*” dated 2 January 2018 from *Drapers Fashion Business*. The article states:

“Collapsed German womenswear brand Basler is gearing up to relaunch in the UK. The brand has produced an initial outerwear collection for autumn 18, which will be followed by a relaunch of its main line later in the year for spring 19.”

26. Mr Barrantes sets out the sales figures which he states are the annual sales of clothing with the exception of clothing for fishing, diving, skating and ice hockey by Basler (UK) Limited in the UK between 3 November 2013 and 3 November 2018. During the period 1 May 2014 to 30 April 2015, the sales to wholesalers and end-users amounted to £4,016,134.00 and £5,227,200.00, respectively while for the year 1 May 2015 – 30 April 2016, sales were recorded at £7,293,817.00 and £1,357,208.00, respectively. Mr Barrantes gives no details of the breakdown of the sales figures to illustrate which particular clothing goods have been sold, nor does he state whether the sales were made under the earlier trade marks.

27. Mr Barrantes claims that the goods bearing the mark BASLER have been sold to end-users in the UK through various outlets, namely, House of Fraser, Harrods,

Beales and Basler stores at Bond Street in London, Chichester and Epsom, and its factory outlet in York.⁶

My approach in this decision

28. The opponent's word mark is the closest in terms of similarity to the applicant's mark and the goods the opponent can rely upon under the figurative mark are identically contained in the word mark. Moreover, only the figurative mark is subject to the proof of use provisions. Therefore, even if the opponent can demonstrate genuine use of its figurative mark, it will not place it in a better position than its word mark, which has a wider specification. That makes the assessments of proof of use and any findings on the figurative mark unnecessary. Accordingly, my decision on the word mark will determine the final outcome of this opposition.

DECISION

Section 5(2)(b)

29. Section 5(2)(b) of the Act reads 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 of the part of the public, which includes the likelihood of association with the earlier trade mark”.

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

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

⁶ See witness statement, para 8.

(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”.

Section 5(2)(b) – case law

31. 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.

Comparison of goods and services

32. When making the comparison, all relevant factors relating to the goods and services in the specification should be taken into account. In *Canon*, the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

“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”.

33. Guidance on this issue has also come from Jacob J. (as he then was) in *British Sugar Plc v James Robertson & Sons Ltd* (the Treat case), [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

(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.

34. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“[...] Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question”.

35. 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 General Court (“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”.

36. 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., sitting as the Appointed Person, noted in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL O/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”,

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”.

37. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the General Court (“GC”) stated:

“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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

38. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the General Court held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

39. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

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

40. However, on the basis of the European courts’ judgments in *Sanco SA v OHIM*,⁷ and *Assembled Investments (Proprietary) Ltd v. OHIM*,⁸ upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd*,⁹ Mr Hobbs concluded that:

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

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent’s goods and then to compare the opponent’s goods with the retail services covered by the applicant’s trade mark;

⁷ Case C-411/13P

⁸ Case T-105/05, at paragraphs [30] to [35] of the judgment /11

⁹ Case C-398/07P

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

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

Contested goods in class 25

Clothing, including tops, underwear, t-shirts, denim goods, socks, ties, coats, jackets and scarves; footwear, including trainers, shoes and boots; headgear, including caps, bandanas

41. The contested goods are identical to the opponents clothing, footwear and headgear in class 25 because the goods are either identically contained in both lists or included in the broad category of the opponent's goods.

42. The opponent's specification contains the limitation: "all the aforesaid goods other than clothing for angling, clothing for diving, clothing for ice skating and clothing for ice hockey". I acknowledge that the applicant's specification is unrestricted and that there is potential for it to include goods which are not identical. However, even accepting some difference in their intended purpose, such goods would still be highly similar, coinciding in all other relevant factors.

Belts

43. The term belts includes garter or suspender belts that are types of clothing used to hold up stockings and other types of fabric belt. They are therefore identical to clothing in the opponent's specification under the *Merit* principle.

Contested services class 35

Retail services connected with clothing, footwear, headgear

44. The nature, purpose and method of use of these services differ from clothing, footwear and headgear in the opponent's specification as is the case with any goods and services. The users are the same, and the opponent's goods may reach the market through the same retail channels through which the applicant's retail services are offered. The goods and services are complementary as the opponent's goods are indispensable to the retail services relating to them, and the consumers may think that the same undertaking is responsible for both the goods and services. The goods and services are similar to a medium degree.

Retail services connected with clothing accessories

45. Clothing accessories include items such as scarves, gloves or ties that are often used to complement the wearer's look. As these items are also included in the broad category of clothing, the applicant's retail services concern the same goods covered by the opponent's specification. The opponent's goods are indispensable to the applicant's retail services, and the consumers may think that the same undertaking is responsible for both goods and services. There is, therefore, a medium degree of similarity between the applicant's retail services and the opponent's clothing.

Retail services connected with bags, backpacks, handbags, clutch bags, purses, wallets, leather folios, cases

46. The nature, purpose and method of use of the applicant's retail services are different from the opponent's goods in class 25. The users may overlap on a high level of generality. They are not in competition. Even though there is a certain degree of similarity between the goods in class 18, for example, bags or wallets, and the goods in class 25 based on common aesthetic function,¹⁰ the comparison here is further removed. The opponent's goods are not important for the applicant's retail services and from the consumer's point of view, the goods and services are unlikely to be offered by the same undertaking. Accordingly, there is no complementarity in the sense defined in the case law. I find that the opponent's goods in class 25 are dissimilar to the applicant's services. I also find that the opponent's goods in classes

¹⁰ See *Gitana SA, v OHIM*, Case T-569/11, para 45.

9 and 14 are dissimilar to the applicant's retail services. This is because the goods and services inherently differ in the nature, purpose and method of use. They are neither in competition, nor are they complementary. The users are the same, though it is at a high level of generality and is not determinative on its own.

Retail services connected with travel bags, luggage, brief cases, sports bags, holdalls, umbrellas, parasols, cases, umbrellas, parasols

47. There is no similarity in nature, purpose or method of use between these services and the opponent's goods. The users are the same. However, that factor alone will not give rise to similarity. There is no competition, nor there is any complementarity in the sense described by the case law. The goods and services are dissimilar.

Retail services connected with jewellery

48. The nature, purpose and method of use of these services differ from jewellery in the opponent's specification. The users are the same, and the opponent's goods may reach the market through the same retail channels through which the applicant's retail services are offered. The opponent's goods are indispensable to the retail services relating to them, and there is, therefore, a complementary relationship between the goods and services. I consider the goods and services to be similar to a medium degree.

Retail services connected with watches

49. *Collins English Dictionary* defines a timepiece as a clock, watch, or other device that measures and shows time.¹¹ A timepiece in the opponent's specification is also, therefore, referred to as a watch. Accordingly, the goods and services are complementary as the opponent's goods are indispensable to the retail services relating to watches, and the consumers may think that the same undertaking is responsible for both the goods and services. The users are the same, and the

¹¹ <https://www.collinsdictionary.com/dictionary/english/timepiece> [accessed 4 May 2020].

opponent's goods may reach the market through the applicant's retail services. The goods and services are similar to a medium degree.

Retails services connected with perfumery and cosmetics

50. There is no similarity in nature, purpose or method of use between these services and the opponent's goods. The users are the same, though it is at a very high level of generality. However, that factor alone will not give rise to a similarity. There is no competition, nor there is any complementary in the sense described by the case law. Therefore, these services are dissimilar to the opponent's goods.

The average consumer and the nature of the purchasing act

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

52. 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”.

53. The goods in classes 14 and 25 do not appear to me as specialist goods which require particularly careful consideration. The frequency of the purchase may vary. However, the goods are likely to be purchased with a reasonable degree of frequency. When making a purchase, the average consumer will pay attention to factors such as

suitability for the intended purpose, fit, colour and cost. These factors suggest that the average consumer will pay a medium level of attention when making their selection. The average consumer, when selecting the services, will pay some care and consideration to factors such as the range of goods on offer, stock levels and knowledgeability of staff. These factors will also attract a medium degree of attention.

54. In terms of method of selection, the goods are 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 selection process, particularly when the average consumer consults a sales assistant, or a purchase is made further to a word-of-mouth recommendation. Selection of the services is likely to follow visual inspection of premises. However, word of mouth recommendations or verbal enquiries may also play some part in the selection process.

Comparison of marks

55. 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.”

56. 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.

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

Opponent's trade mark	Applicant's trade mark
BASLER	BASILAR

58. The only component of the opponent's mark is the word "BASLER" presented in capital letters. The overall impression of the mark lies in the word "BASLER".

59. The applicant's mark is comprised of the word "BASILAR" presented in bold capital letters. Although filed as a figurative mark, the word is presented in an unremarkable font. The overall impression is dominated by the word BASILAR. The stylisation plays only a weak role.

60. Visually, the opponent's mark is comprised of six letters, out of which five letters are contained in the applicant's mark. The first three letters are in the same order, and the marks also share the same last letter. The differences between the marks are the presence of the letter "I" in the fourth position in applicant's mark which does not have a counterpart in the opponent's mark. The letter "E" appears in the penultimate position in the opponent's mark while the applicant's mark contains the letter "A" in that position. Bearing in mind the similarities and differences, I find that the marks are visually similar to a high degree.

61. The applicant argues that the competing marks are different due to the "SIL" sound in the middle of the mark while the opponent contends that the marks are highly similar because the beginning "BAS" and the ending "LAR/LER" are spoken identically. The marks consist of two and three syllables, respectively. I agree with the opponent that the marks begin with the identical pronunciation of the syllable "BAS". However, in my view, the ending syllable in the applicant's mark may be pronounced in more than one

way. If the average consumer articulates “AR” sound in the applicant’s mark identically to the “ER” sound in the opponent’s mark, the only difference in the pronunciation of the marks is introduced by the second syllable “I” in the opponent’s mark which does not have a counterpart in the applicant’s mark. In those circumstances, the aural similarity between the marks is reasonably high. I also factor into account that some average consumers may pronounce the “AR” sound like the word “are”. This would result in a different pronunciation of the ending syllables in respective marks. In those circumstances, the aural similarity between the marks is medium.

62. In a conceptual comparison, the opponent’s mark does not have any meaning for the average consumer, and the mark will be seen only as an invented word. The applicant argues that its mark has a concept which differs from the opponent’s mark which is an invented term. The applicant’s mark means “(mainly anatomy) of or situated at a base”.¹² It is well established that for a conceptual meaning to be relevant, it must be one capable of immediate grasp.¹³ While some consumers may know the meaning of this anatomical term, I do not consider that the meaning would be known to the average consumer of the category of goods and services in question who, in my view, will see it as an invented word. On that basis, I find that the marks are conceptually neutral.

Distinctiveness of the earlier mark

63. The distinctive character of the earlier mark must be considered. The more distinctive the mark is, 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

¹² <https://www.collinsdictionary.com/dictionary/english/basilar> [accessed 4 May 2020].

¹³ See Case C-361/04 *P Ruiz-Picasso and Others v OHIM* [2006] ECR I-00643; [2006] E.T.M.R. 29.

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).”

64. Invented words usually have the highest degree of distinctive character, while words which are allusive of the goods have the lowest. Distinctiveness can also be enhanced through the use of the mark.

65. The opponent’s mark is an invented word which is neither allusive nor suggestive of the goods at issue. It is, therefore, inherently highly distinctive. Although the evidence filed by the opponent demonstrates the use of the word mark, the opponent has not claimed enhanced distinctiveness of its mark. As per the financial statements produced for the years from 2014 - 2016,¹⁴ the opponent’s principal activities were in ladies’ fashion wear. Given the size of the UK market for clothing, the use on the scale shown by the opponent is insufficient to establish the acquired distinctiveness of the mark in relation to womenswear. Moreover, there is no information regarding the market share held, the intensity of use or third-party evidence of recognition. Taking the evidence into account, I am unable to conclude that the distinctiveness of the earlier mark has been enhanced through its use. Even if the distinctiveness has been

¹⁴ Exhibits TB2, TB3 and TB4

enhanced by use, the mark is already inherently highly distinctive, and it, therefore, makes no material difference to the outcome.

Likelihood of confusion

66. The factors considered above have a degree of interdependency and must be weighed against one another in a global assessment (*Canon* at [17]; *Sabel* at [22]). They must be considered from the perspective of the average consumer and a determination made as to whether the average consumer is likely to be confused. In making my assessment, I must keep in mind 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 he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

67. Where there is no similarity between the goods and services, there can be no confusion¹⁵ and the opposition against the following dissimilar services is dismissed accordingly:

Class 35: Retail services connected with, bags, backpacks, travel bags, handbags, luggage, brief cases, leather folios, cases and bags, sports bags, holdalls, clutch bags, purses, wallets, umbrellas, parasols, cases, perfumery and cosmetics.

68. 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 and the goods and services down to the responsible undertaking being the same or related).

69. Earlier in this decision, I concluded:

- That the goods at issue are identical and certain services at issue are similar to a medium degree;
- That the goods and services will be selected primarily by visual means, with a medium degree of attention by the general public;

¹⁵ See *Waterford Wedgwood plc v OHIM* – C-398/07 P (CJEU).

- That the marks are visually similar to a high degree, aurally similar to a reasonably high degree or medium degree depending on how the average consumer articulates the applicant's mark, and conceptually neutral;
- That the opponent's mark is distinctive to a high degree.

70. Applying these conclusions, I find that there is a likelihood of direct confusion for the average consumer. The high degree of visual and aural similarity between the respective marks is likely to counteract any visual and aural differences. Given the high degree of the distinctive character of the earlier mark, the average consumer, who pays a medium degree of attention, is likely to confuse one mark for the other, particularly when factoring in imperfect recollection. Confusion is still likely even where the competing goods and services are similar only to a medium degree and the marks are aurally similar to a medium degree. Even though the marks are only six and seven letters long, the level of visual similarity between the marks and the lack of a conceptual hook to aid in differentiating between the two will result in a likelihood that one mark will be mistaken for the other.

Conclusion

71. The application will be refused in relation to:

Class 25: Clothing, including tops, underwear, t-shirts, denim goods, socks, ties, coats, jackets and scarves; footwear, including trainers, shoes and boots; headgear, including caps, bandanas; belts.

Class 35: Retail services connected with clothing, footwear, headgear, clothing accessories, jewellery and watches.

72. The application will proceed to registration for the following goods:

Class 35: Retail services connected with bags, backpacks, travel bags, handbags, luggage, brief cases, leather folios, cases and bags, sports bags, holdalls, clutch bags, purses, wallets, umbrellas, parasols, cases, perfumery and cosmetics.

Costs

73. As both parties have achieved a measure of success, I order that they bear their own costs.

Dated this 21st day of May 2020

Karol Thomas

For the Registrar

The Comptroller-General