

BL O/392/20

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATION NO. 3393554
BY CAMEL CAPA LTD
TO REGISTER AS A TRADE MARK:**

Camel Capa

IN CLASS 25

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 417039
BY WORLDWIDE BRANDS, INC.**

BACKGROUND AND PLEADINGS

1. On 19 April 2019, CAMEL CAPA LTD (“the applicant”) applied to register the trade mark **Camel Capa**, under number 3393554 (“the application”). It was accepted and published in the Trade Marks Journal on 3 May 2019 for the following goods:

Class 25: Clothing; underwear; pants; shirts; suits; topcoats; coats; sports clothing; clothing of leather; vests; shoes; leather shoes; sports shoes; scarves; neckties; hats; socks; gloves for apparel; belts [clothing]; belts made of leather.

2. On 19 July 2019, Worldwide Brands, Inc. (“the opponent”) filed a notice of opposition. The opposition is brought under Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and is directed against all the goods of the application.

3. The opponent relies upon its International Registration designating the United Kingdom number 814414 (“the earlier mark”), under which the following trade mark is protected:



4. The earlier mark was registered on 9 September 2003 and, with effect from the same date, the opponent designated the UK as a territory in which it sought to protect the International Registration under the terms of the Protocol to the Madrid Agreement. The earlier mark claims a priority date of 28 May 2003 from the German Patent and Trade Mark Office. The colours white, black and yellow are specified as a feature of the earlier mark. Protection for the earlier mark was granted on 11 December 2004 in respect of the following goods:

Class 9: Eyeglasses, sunglasses, binoculars; cases, chains, cords, lenses and frames for glasses.

Class 14: Precious metals and their alloys and goods in precious metals or coated therewith (included in this class); jewellery, precious stones; horological and chronometric instruments and cases therefor; watch straps; key rings.

Class 18: Leather and leather imitations, as well as products therefrom (included in this class); backpacks, school bags, satchels, shopping bags, book bags, shoulder bags, hand bags, waist bags, travelling bags, wallets, coin purses and purses, key cases, trunks and suitcases; umbrellas, parasols and walking sticks; animal skins, hides; whips; harness and saddlery.

Class 25: Clothing, footwear, headgear.

5. For the purposes of the opposition, the opponent seeks to rely upon the goods in class 25 of the earlier mark as designated, as well as some of its class 18 goods.

6. The opponent's mark is an earlier mark, in accordance with Section 6 of the Act. While the protection process for the earlier mark was completed more than five years before the filing date of the application and would ordinarily be subject to the proof of use provisions contained in Section 6A of the Act, the applicant has not sought to require the opponent to demonstrate proof of use.¹ Consequently, the opponent is entitled to rely upon its goods in classes 18 and 25 for its International Registration, without having to establish genuine use.

7. The opponent argues that the competing trade marks are highly similar. In this regard, the opponent has submitted that there is a high degree of visual, aural and conceptual similarity between the competing trade marks on the basis of the common element "CAMEL". Furthermore, the opponent contends that the goods for which the application seeks protection are "identical, highly similar and/or complementary" to the

¹ The relevant part of the defence, Form TM8, was not filled in by the applicant.

goods of the earlier mark. These factors, the opponent argues, will result in a likelihood of confusion.

8. The applicant filed a counterstatement denying the grounds of opposition. The applicant highlights that a number of trade marks have been applied for and registered which contain the word "CAMEL", suggesting that the word is commonly used in relation to goods in class 25. The word "CAMEL", the applicant contends, is a "general word" which the opponent should not be permitted to monopolise. Moreover, the applicant argues that the competing marks "are distinctly different to each other". The applicant also submits that the contested mark has been applied for based upon its company name, which the applicant argues is common practice. Finally, the applicant contends that "the opponent has not proved that the earlier mark is a famous mark" and "since it is not a famous mark, the applicant does not stand to benefit from" it. Based on these factors, the applicant denies that there is a likelihood of confusion.

9. The opponent has been professionally represented throughout these proceedings by CMS Cameron McKenna Nabarro Olswang LLP, while the applicant has been represented by Alfred Lei. Neither of the parties have filed evidence and only the opponent filed submissions in lieu of an oral hearing. I do not intend to summarise these but will refer to them throughout this decision, as and where necessary. Both parties were given the option of a hearing but neither asked to be heard on this matter. Therefore, this decision is taken following a careful perusal of the papers, keeping all submissions in mind.

PRELIMINARY ISSUES

10. In its counterstatement, the applicant refers to multiple trade mark applications and registrations containing the word "CAMEL". On this basis, the applicant argues that this demonstrates the word is commonly used for class 25 goods and, therefore, the opponent should not be permitted to prevent others from using the word. I must, at this early stage, clarify that the existence of other earlier registered marks, whether that be in the UK or EU, will not have any bearing on whether there exists a likelihood of confusion between the mark applied for and the opponent's earlier mark. This is

because there is no evidence that the marks are in use and that consumers have become accustomed to differentiating between them.

11. In *Zero Industry Srl v OHIM*, Case T-400/06, the General Court (“GC”) stated that:

“73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II-4865, paragraph 68, and Case T-29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II-5309, paragraph 71).”

12. My assessment later in this decision must take into account only the applied-for mark – and its specification – and any potential conflict with the opponent’s earlier mark. The existence of other earlier registered marks is not relevant for the purposes of this assessment. The dominant and distinctive elements of the competing trade marks is a matter which will form part of my assessment and will be discussed later in this decision, though the existence of other trade marks which have been applied for, or registered, containing the word “CAMEL” will not be considered evidence per se as to its distinctiveness.

13. Furthermore, in its counterstatement, the applicant also states that it is common practice to use a company name as a trade mark and contends that this was the basis for the application at issue. I must clarify that these points raised by the applicant will, as a matter of law, have no bearing on the outcome of this opposition. A trade mark registration is essentially a claim to a piece of legal property (the trade mark). Every registered trade mark is entitled to legal protection against the use, or registration, of

the same or similar trade marks for the same or similar goods/services if there is a likelihood of confusion. The legislation and rules governing trade marks and company names are distinct and the registration of a company name will not give rise to an automatic right to register the same name as a trade mark; even in the event that an undertaking has a registered company name which predates a registered trade mark owned by another undertaking, the former is not able to circumvent the trade mark owned by the latter on the basis of the company name. The ownership of a company name is not an adequate argument for allowing a later filed trade mark to become registered, if that trade mark is confusingly similar to the earlier trade mark.

14. Finally, the applicant makes the following points in relation to 'famous marks' in its counterstatement:

It is known that some traders use other people's famous trade marks as their own to take advantage of their reputation and reduce advertising costs. However, the opponent has not proved that the earlier mark is a famous mark. Since it is not a famous mark, the applicant does not stand to benefit from the earlier mark. The reputation of the earlier mark as well as other factors will also not be negatively affected by the application. The application is simply the applicant's company name, not only does it not affect the earlier mark's distinctiveness and goodwill, since the earlier mark is not famous, consumers will not make any connection between the two marks.

15. These arguments would be relevant to an opposition brought under Section 5(3) of the Act. However, this opposition is based upon Section 5(2)(b) of the Act and my decision as to whether there is a likelihood of confusion under these provisions must be based on an objective assessment of the relevant factors (which will be discussed below). Therefore, the applicant's arguments that the opponent has not proved that the mark has a reputation for the goods at issue and that the applied-for mark will not be detrimental to the opponent's business are not relevant for the purposes of this assessment.

DECISION

Section 5(2)(b): legislation and case law

16. 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 on the part of the public, which includes the likelihood of association with the earlier trade mark.”

17. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(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

18. 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 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

19. 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.

20. Moreover, 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."

21. 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".

22. 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 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.”

23. 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.”

24. For the purposes of considering the issue of similarity of goods and services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Albingia SA v Axis Bank Limited*, BL O/253/18, a decision of the Appointed Person, Professor Phillip Johnson, at paragraph 42).

25. The GC confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods 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”.

26. The goods to be compared are:

Opponent's goods	Applicant's goods
<p>Class 18: Leather and leather imitations, as well as straps made of leather, straps made of imitation leather, briefcases made of leather, briefcases made of imitation leather, pouches made of leather, pouches made of imitation leather, cases of leather, cases of imitation leather, belts of leather, belts of imitation leather, boxes of leather, boxes of imitation leather, bags made of leather, bags made of imitation leather, key cases made of leather, key cases made of imitation leather, credit card holders made of leather, credit card holders made of imitation leather; backpacks, schoolbags, satchels, shopping bags, book bags, shoulder bags, hand bags, waist bags, travelling bags, wallets, coin purses and purses, key cases, trunks and suitcases; umbrellas, parasols and walking sticks; animal skins, hides; whips; harness and saddlery.</p> <p>Class 25: Clothing, footwear, headgear.</p>	<p>Class 25: Clothing; underwear; pants; shirts; suits; topcoats; coats; sports clothing; clothing of leather; vests; shoes; leather shoes; sports shoes; scarves; neckties; hats; socks; gloves for apparel; belts [clothing]; belts made of leather.</p>

27. The term '*clothing*' in the specification of the application has a direct counterpart in class 25 of the earlier mark. These goods are self-evidently identical.

28. *'Underwear', 'pants', 'shirts', 'suits', 'topcoats', 'coats', 'sports clothing', 'clothing of leather', 'vests' and 'socks'* in the specification of the application all are encompassed by the broader category of *'clothing'* in class 25 of the earlier mark. These goods are therefore identical under the principle outlined in *Meric*.

29. *'Shoes', 'leather shoes' and 'sports shoes'* in the specification of the application fall within the broader category of *'footwear'* in class 25 of the earlier mark. Therefore, these goods are identical under the principle outlined in *Meric*.

30. The term *'hats'* in the applicant's specification describes a certain type of headgear and, as such, is encompassed by the broader category of *'headgear'* within class 25 of the earlier mark. Consequently, these goods are identical under the principle outlined in *Meric*.

31. *'Scarves'* in the applicant's specification describes a length or square of fabric worn around the neck or head. These are commonly used to provide extra warmth to the wearer, though they are also often worn for decorative purposes. Scarves are items of clothing and, as such, this term is directly encompassed by the broader category of *'clothing'* within class 25 of the earlier mark. As a result, these goods are identical under the principle outlined in *Meric*.

32. *'Neckties'* in the specification of the application describes a piece of long cloth that is tied around the neck, most commonly for decorative purposes. A necktie is typically worn with a collared shirt. Given that a necktie is an item of clothing, it falls within the remit of the wider term *'clothing'* in class 25 of the earlier mark. For this reason, I consider these goods to be identical under *Meric*.

33. The term *'gloves for apparel'* contained within the applicant's specification describes a garment that is worn on the hands. Gloves can have many uses, such as sports gloves or protective gloves. However, the wording used in the applicant's specification specifically describes it as attire, another word for an item of clothing.² On this basis, I find that these goods are encompassed by the broader category of

² <https://www.lexico.com/definition/attire>

'clothing' contained within class 25 of the earlier mark. Therefore, these goods are identical under the principle outlined in *Meric*. Even in the event that I am wrong in this finding, it remains the case that there will be overlap in user, use, method of use and trade channels, rendering the goods highly similar.

34. 'Belts [clothing]' and 'belts made of leather' in the specification of the application refer to a strip of material that is fastened around the consumer's waist, the latter being made from leather. Typically, the purpose of a belt is to hold an item of clothing in place; in addition, a belt can be used for decorative purposes. To my mind, both terms would fall within the scope of the term 'clothing' in the opponent's class 25 specification. Accordingly, these goods are identical under the principle outlined in *Meric*. If I am wrong in this finding, it remains the case that there will be significant overlap in user, purpose and trade channels. Moreover, belts can often be found in shops next to other items of clothing such as trousers, jeans, skirts and dresses. In certain circumstances, they may also be sold together with these items of clothing. Furthermore, as belts are used to hold up items of clothing, they will be complementary; it is likely that consumers would assume that the same undertakings will produce belts (whether that be leather or not) and other items of clothing. For these reasons, even if I am wrong about the identity of the goods, they will still be highly similar.

The average consumer and the nature of the purchasing act

35. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question (see *Lloyd Schuhfabrik Meyer*, Case C-342/97).

36. 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.”

37. 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.”

38. The contested goods in class 25 are available to the general public and are ordinary purchases consisting of various items of clothing, headwear, footwear and accessories. Due to the nature of the goods, they are likely to be purchased frequently for the purposes of functionally clothing one’s self or as a form of self-expression. The cost of such goods may vary between cheaper items of limited quality at one end of the spectrum, to more expensive fashion pieces at the other. However, on average they would not typically require a significant outlay. The purchasing of these goods is likely to be more casual than careful, factoring upon personal taste, particular style or superficial preference. For this reason, it is not considered to be an immensely important choice for the consumer. In my view, the purchasing process for these goods would be overwhelmingly visual in nature; the goods are likely to be purchased after they are viewed in physical retail establishments or their online equivalents, brochures, window displays or visual advertising. Nevertheless, I do not discount aural considerations in the form of advice sought from sales assistance or word of mouth

recommendations. I find that the level of attention of the general public in respect of these goods would be average.


Comparison of trade marks

39. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

40. Therefore, it would be wrong to artificially dissect the trade marks, though 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 hence contribute to the overall impressions created by the marks.

41. The competing trade marks are as follows:

Earlier trade mark	Applicant'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 thick yellow horizontal line is positioned below 'Active', with a curved end on the right side. A black curved line arches over the top of the text.	Camel Capa

42. The opponent has claimed that the contested mark is highly similar to the earlier mark. In respect of the earlier mark, the opponent has argued that the word “CAMEL” is the dominant and distinctive element and that the word “ACTIVE” in the mark is descriptive. Moreover, the opponent has contended that the figurative elements in the earlier mark are non-distinctive. In relation to the contested mark, the opponent has highlighted that the common, identical word “CAMEL” appears at the beginning of the mark. Further, the opponent has argued that the word “Capa” in the contested mark is secondary to the word “Camel” as it does not have a meaning. In this regard, the opponent has contended that it is the word “Camel” in the contested mark which will resonate more with consumers. Based upon these factors, the opponent has submitted that there is a high degree of visual, aural and conceptual similarity between the competing trade marks.

42. Conversely, the applicant has submitted that the competing trade marks are distinctly different. The applicant has argued that the figurative elements, capitalisation, stylisation and colour contribute to an overall impression of the earlier mark which will “create a totally different impression on consumers” than the contested mark, which is comprised of two plain words. Moreover, contrary to the opponent’s argument, the applicant has contended that the word “CAMEL” is a common word and has intimated that it does not dominate either competing mark.

43. The earlier mark is a figurative mark comprising two elements: the words “CAMEL ACTIVE” and two curved line devices. I note from the International Registration that the background of the mark is detailed as white; however, to my mind, this will go unnoticed by the average consumer. The verbal elements of the mark consist of the word “CAMEL” displayed above the word “ACTIVE”, two common, easily understood words in the English language. The words are presented in a black, slightly stylised font. Although there is a very minimal degree of stylisation to the font, I am of the opinion that this will be overlooked by the average consumer. As a result, the words are effectively presented in a standard typeface. The words appear in the middle of the mark and are framed above and below by two curved lines, the former being black in colour and the latter being yellow. The curved lines act as a border to the words and consumers are accustomed to trade marks utilising borders of this kind. Moreover, the

eye is naturally drawn to elements that can be read. For these reasons, the figurative elements will play a significantly lesser role in the overall impression of the mark. As for the words, given that the word “ACTIVE” has allusive, or descriptive, qualities in respect of clothing and the like, it will also play a reduced role in the overall impression conveyed by the mark, though not as reduced as the figurative elements. As will become more apparent, for some consumers the word “CAMEL” will have no allusive or descriptive qualities and, therefore, will have more impact and dominate the overall impression of the mark. For other consumers, the word “CAMEL” will allude or describe the colour of the goods. In this eventuality, both words will have a roughly equal impact and will co-dominate the overall impression of the mark.

44. The contested mark consists of the words “Camel Capa” in word-only format and presented in title case. The word “Camel” is a common, easily understood word in the English language. The word “Capa”, however, has no clear and obvious meaning in relation to the goods at issue and, therefore, is likely to be perceived as an invented word. The words do not combine to form a unitary phrase. The word “Camel” appears first in the mark and offers a clear meaning to consumers. In this connection, it is established that the attention of the consumer is usually directed to the beginnings of marks because the UK consumer reads from left to right. Accordingly, although the word “Capa” is an invented term, I am of the view that the word “Camel” will have more impact and provide a greater contribution to the overall impression of the mark. As it has a clear meaning, appears first in the formulation of the mark and does not form a unit with the word “Capa” it will have more dominance, while the word “Capa” will play a slightly reduced role.

45. Visually, the competing marks are similar because they have a common five-letter string “C-A-M-E-L”, in the same order, at the beginning of the marks. As previously outlined, this word dominates both competing trade marks. The marks differ insofar as the earlier mark contains the word “ACTIVE”, which has no counterpart in the contested mark. Moreover, the contested mark includes the word “Capa”, which is not replicated in the earlier mark. The respective endings are very different, though as explained above, the attention of the consumer is usually directed to the beginning of words. The competing marks are also visually different due to the figurative elements and use of colour employed by the earlier mark. The contested mark is a plain word

mark and does not reproduce these elements. However, as outlined above, the border element does play a much lesser role in the overall impression of the earlier mark. Moreover, registration of a mark in black and white will cover the use of the mark in different colours. Therefore, I do not consider the visual difference created by the figurative elements of the earlier mark to be a significant variance. Furthermore, the words of the earlier mark are presented in a slightly stylised font, while the contested mark is in word-only format. However, as previously explained, the stylisation of the words in the earlier mark would likely be overlooked by the average consumer; the registration of a word-only mark covers use in any standard typeface, and so any differences created by the minimal stylisation are not significant. In addition, I note the applicant's mark is presented in title case, while the words contained in the earlier mark are displayed in a mixture of upper and lower-case letters. Nevertheless, the registration of a word-only mark provides protection for the words themselves, irrelevant of whether they are presented in upper, lower or title case. Bearing in mind my overall assessment of the overall impressions, I consider there to be a medium degree of visual similarity between the marks.

46. Aurally, the contested mark comprises four syllables, i.e. ("KA-MUL-KA-PA"). In respect of the earlier mark, the device elements would not be pronounced. Moreover, I am not entirely convinced that consumers would articulate the word "ACTIVE" due to its allusive, or descriptive, nature. If the word is pronounced, the mark will also consist of four syllables, i.e. ("KA-MUL-ACK-TIV"). The first two syllables of the competing marks are indistinguishable, while the remaining syllables of each mark are phonetically very different. Taking into account the overall impressions, I consider that the marks are aurally similar to a medium degree. If the word "ACTIVE" is not articulated by consumers, the earlier mark will consist of two syllables, i.e. ("KA-MUL"). In this eventuality, the first two syllables of the contested mark would be identical to the whole of the earlier mark, the aural identities of the competing marks only differing by the remaining two syllables of the contested mark. If consumers do not pronounce the word "ACTIVE" in the earlier mark, I consider the marks aurally similar to a medium to high degree.

47. Conceptually, the only element of the earlier mark that will convey a conceptual message is the word element, namely, "CAMEL ACTIVE". The curved line devices will

not provide any conceptual message. The word “CAMEL” will be understood by a significant number of consumers as a large animal with a long neck, that lives in the desert and has one or two humps on its back.³ Another group of consumers will understand the word “CAMEL” to mean a yellowish-fawn colour.⁴ For these consumers, the word will describe a characteristic of the goods at issue, namely, their colour. It is also possible that some consumers would perceive the word “CAMEL” as a reference to a soft, pale brown cloth made from wool and used to make coats. However, no evidence has been adduced by the parties in this regard and I am disinclined to accept this as a notorious fact. Consumers will understand the word “ACTIVE” to mean busy with a particular activity.⁵ When applied to the goods for which the mark is registered, the word will be perceived as an allusive reference to, or a description of, a characteristic of the goods. For example, when applied to clothing, the word alludes to the intended purpose of the goods, namely, those to be worn for a particular activity such as physical exercise. In respect of the contested mark, the word “Camel” will also be understood by a significant number of consumers as meaning the large, desert inhabiting animal or as a description of the colour of the goods by another group of consumers. The word “Capa” does not have any obvious meaning per se and, as such, would likely be perceived by consumers as an invented term. Consequently, the entire conceptual identity of the contested mark is provided by the word “Camel”. This concept is common to both competing marks. However, the earlier mark also includes the word “ACTIVE”. Although this word is allusive, or descriptive, of the goods for which the mark is registered, it still contributes towards the overall identity of the mark and cannot be disregarded completely; as such, the word introduces a new conceptual aspect which is not replicated in the applicant’s mark. On this basis, and in consideration of my assessment of the overall impressions, I consider that the marks are conceptually similar to a medium degree.

Distinctive character of the earlier mark

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

³ <https://dictionary.cambridge.org/dictionary/english/camel>

⁴ <https://www.lexico.com/definition/camel>

⁵ <https://dictionary.cambridge.org/dictionary/english/active>

“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).”

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

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

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an

aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

50. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask *in what does the distinctive character of the earlier mark lie?* Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

51. I have no submissions from the opponent regarding the overall distinctiveness of the earlier mark. However, the opponent has argued that the word “CAMEL” in the mark is inherently distinctive and has no descriptive qualities in relation to the goods for which the mark is protected. Moreover, the opponent has accepted that the word “ACTIVE” in the mark is of low distinctive character and may be considered descriptive if used in relation to clothes that are worn for sports or other physical activities. Finally, in respect of the figurative elements, the opponent has submitted that the mark has a low degree of stylisation.

52. Similarly, the applicant has not commented on the overall distinctiveness of the earlier mark. Nevertheless, the applicant has argued that the word “CAMEL” is commonly used in the trade of class 25 goods on the basis that there are multiple trade marks containing the word which have been applied for or registered. Further, the applicant has contended that the word “CAMEL” is common; as it has not been invented by the opponent, the applicant has submitted, the opponent should not be granted a monopoly over the word.

53. Although the protection process for the earlier mark was completed more than five years before the filing date of the application, the applicant has not sought to require the opponent to demonstrate proof of use. The opponent has not filed evidence in relation to these proceedings to establish that the earlier mark enjoys an enhanced level of distinctive character. Consequently, I have only the inherent position to consider.

54. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the goods or services, to those with high inherent distinctive character, such as invented words. Dictionary words which do not allude to the goods or services will be somewhere in the middle.

55. The earlier mark is comprised of two elements, namely, the word element and two coloured, curved lines which form a border. The mark contains the words "CAMEL ACTIVE", presented in a black, slightly stylised font. The words are ordinary dictionary words and, while the word "CAMEL" is placed above the word "ACTIVE", the words will still be read as "CAMEL ACTIVE". As previously explained, the word "CAMEL" will be understood by a significant number of consumers to be a reference to the large desert animal. For this group of consumers, the word will have no allusive or descriptive qualities and is considered somewhat unusual in respect of the opponent's goods. Conversely, the word "ACTIVE" will be understood by consumers to mean busy with a particular activity. I agree with the opponent that, when applied to goods to be used in conjunction with physical exercise, the word will be perceived as a description of those goods. When applied to other goods in classes 18 and 25, the word will be understood as allusive of this meaning. Although the words are presented in a slightly stylised font, I am of the view that this is likely to be overlooked by the average consumer. Consequently, the minimal stylisation of the font does not increase the distinctive character of the earlier mark to any material extent. Similarly, the registration specifies that the background of the earlier mark is white, though I do not consider that this will have any effect on the distinctiveness of the mark. Above and below the words are two curved lines, the former being black and the latter being yellow. While the two lines are not connected, they function as a curved border or framing device for the word element. Consumers are accustomed to trade marks which utilise borders such as this, though are not familiar with these borders or frames signifying brand origin messages per se. Accordingly, while the border may be aesthetically pleasing, I do not consider that it increases the distinctive character of the mark to any meaningful degree. The distinctive character of the earlier mark predominantly rests with the words themselves, rather than the figurative elements. As for the words, given their respective meanings, I consider that the distinctive character of the earlier mark overwhelmingly rests with the word "CAMEL". In light of

the above, in respect of consumers whom understand the word “CAMEL” as referring to the large desert animal, I find that the earlier mark possesses a medium level of inherent distinctive character. For another group of consumers, the word “CAMEL” will be perceived as an indication of the colour of the goods for which the earlier mark has protection. Given that the word “CAMEL” will describe a characteristic of the goods, the overall distinctiveness of the earlier mark will be somewhat reduced. For consumers whom understand the word to be a reference to the colour, I find that the earlier mark possesses a low to medium level of inherent distinctive character.

Likelihood of confusion

56. 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. One of these 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 vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier trade mark, the average consumer for the goods and services 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 they have retained in their mind.

57. 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 down to the responsible undertakings being the same or related.

58. In *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the GC noted that the beginnings of word tend to have more visual and aural impact than the ends. The court stated:

“81. It is clear that visually the similarities between the word marks MUNDICOLOR and the mark applied for, MUNDICOR, are very pronounced.

As was pointed out by the Board of Appeal, the only visual difference between the signs is in the additional letters 'lo' which characterise the earlier marks and which are, however, preceded in those marks by six letters placed in the same position as in the mark MUNDICOR and followed by the letter 'r', which is also the final letter of the mark applied for. Given that, as the Opposition Division and the Board of Appeal rightly held, the consumer normally attaches more importance to the first part of words, the presence of the same root 'mundico' in the opposing signs gives rise to a strong visual similarity, which is, moreover, reinforced by the presence of the letter 'r' at the end of the two signs. Given those similarities, the applicant's argument based on the difference in length of the opposing signs is insufficient to dispel the existence of a strong visual similarity.

82. As regards aural characteristics, it should be noted first that all eight letters of the mark MUNDICOR are included in the MUNDICOLOR marks.

83. Second, the first two syllables of the opposing signs forming the prefix 'mundi' are the same. In that respect, it should again be emphasised that the attention of the consumer is usually directed to the beginning of the word. Those features make the sound very similar.

59. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU's judgment in *Bimbo*, Case C-591/12P, on the court's earlier judgment in *Medion v Thomson*. The judge said:

"18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and

conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

60. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms,

is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

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

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

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

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

61. In *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, Kitchin L.J. stated that:

“If, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement.”

62. This was, of course, in the context of infringement. However, the same approach is appropriate when considering a claim under Section 5(2) of the Act.⁶ It is not, therefore, necessary for me to find that the majority of consumers will be confused. The question is whether there is a likelihood of confusion amongst a significant proportion of the public displaying the characteristics attributed to an average consumer.

63. Earlier in this decision I concluded that:

- The goods of the application are identical to those in class 25 of the earlier mark;
- The average consumers of the goods at issue are likely to be members of the general public at large, whom would demonstrate an average level of attention during the purchasing act;
- The purchasing process for the goods at issue would be overwhelmingly visual in nature, though I have not discounted aural considerations entirely;
- For a significant number of consumers, the overall impression of the earlier mark would be dominated by the word “CAMEL”, while the word “ACTIVE” and the figurative elements play a lesser role;
- For another group of consumers, the words “CAMEL” and “ACTIVE” will be co-dominant in the overall impression of the mark, while the figurative elements play a lesser role;
- The word “Camel” would be more dominant in the overall impression of the contested mark, while the word “Capa” would play a slightly reduced role;
- The competing trade marks are visually and conceptually similar to a medium degree;

⁶ *Soulcycle Inc v Matalan Ltd* [2017] EWHC 496 (Ch), Mann J.

- Aural similarity would factor upon whether the word “ACTIVE” in the earlier mark is articulated by consumers, the competing trade marks being aurally similar to a medium degree if they do or aurally similar to a medium to high degree if they do not;
- For a significant number of consumers, the earlier mark possesses a medium level of inherent distinctive character.
- For another group of consumers, the earlier mark possesses a low to medium level of inherent distinctive character.

64. Although the competing trade marks share the common word “CAMEL”, there are differences between the marks which, to my mind, would not be overlooked by the average consumer during the purchasing process. I accept that the word “ACTIVE” in the earlier mark is low in distinctive character, resulting in the word “CAMEL” dominating the mark for a significant proportion of consumers. I also accept that the figurative elements play a lesser role in the earlier mark and, therefore, do not create a significant variance between the competing marks. Moreover, I appreciate that the word “Camel” dominates and appears at the beginning of the contested mark, to which the attention of the consumer is usually directed. However, the earlier mark also contains the word “ACTIVE” which, while admittedly low in distinctive character, does provide a contribution to the overall impression of the mark. Further, this word has no counterpart in the contested mark. Even if this word were overlooked entirely by consumers, the contested mark also includes the invented word “Capa”. The word is not replicated in the earlier mark and, as an invented word, has a high level of inherent distinctive character. I am of the view that consumers are extremely likely to notice the word upon a visual inspection of the mark, which is of heightened importance given the visual purchasing process of clothing. Aurally, if consumers articulate the word “ACTIVE” in the earlier mark, the competing trade marks share only the first two syllables. If the word is not pronounced, owing to its allusive or descriptive qualities, there are still two syllables which are unique to the contested mark. While the competing marks share the conceptual hook provided by the word “CAMEL”, the contested mark is lacking the – albeit allusive – meaning of the word “ACTIVE”. It is

considered that the various differences between the competing trade marks previously identified will sufficiently enable the average consumer to avoid mistaking one trade mark for the other. Therefore, even when factoring in the imperfect recollection principle and interdependency, it follows that there will be no direct confusion. For the sake of completeness, my conclusion on direct confusion would be the same whether or not consumers articulate the word “ACTIVE” in the earlier mark because the other factors point in the applicant’s favour.

65. Nevertheless, I have found the respective goods of the competing marks to be identical and the attention level of the average consumer to be no more than average. As outlined above, I believe the average consumer will recognise that there are differences between the marks in the words “ACTIVE” and “Capa”. However, consumers will also recognise the common element “CAMEL”, which, for a significant proportion of consumers, is moderately distinctive and somewhat unusual for the goods at issue; for this group of consumers, the word dominates the overall impressions of both competing marks. Whether consciously or unconsciously, this will lead the average consumer through the mental process described in case law by Mr Purvis, namely, that there is a difference between the marks, but there is also something in common. The word “ACTIVE” in the earlier mark has a clear meaning in the context of the goods for which the earlier mark is protected and would be seen as an allusive, if not descriptive, intimation that the goods are to be worn for a particular activity such as physical exercise. This readily lends itself to a sub-brand or logical brand extension. Although the word “Capa” in the contested mark cannot be said to have any allusive or descriptive qualities in relation to the goods at issue, it is an invented word which provides no concept which can be retained in the mind of the consumer. Accordingly, the meaning of the mark rests with the word “CAMEL”, which provides the conceptual hook; consumers will be drawn to this word as a basis for brand origin, particularly considering it is at the beginning of the mark, to which the attention of the consumer is usually directed. Moreover, consumers are frequently exposed and accustomed to inventive brand extensions employed by clothing companies in order to market their goods. It has been recognised by the GC in Case T-400/06, *Zero Industry Srl, v (OHIM)*, (paragraph 81) that “it is common in the clothing sector for the same mark to be configured in various ways according to the type of product which it designates, and second, it is also common for a single clothing

manufacturer to use sub-brands (signs that derive from a principal mark and which share with it a common dominant element) in order to distinguish its various lines from one another". Given that the respective goods of the competing trade marks are identical, and factoring in the interdependency principle, the potential for consumers to perceive the contested mark as an inventive brand extension of the earlier mark – or vice versa – is greatly magnified. To my mind, the differences between the marks are conducive to a brand extension and I am satisfied that the average consumer would assume a commercial association between the parties, or sponsorship on the part of the opponent, due to the shared dominant element "CAMEL". Consequently, I consider there to be a likelihood of indirect confusion for a significant proportion of consumers.

CONCLUSION

66. The opposition under Section 5(2)(b) of the Act has succeeded in its entirety. Subject to any successful appeal, the application will be refused.

COSTS

67. The opponent has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. This decision has been taken from the papers without an oral hearing. The opponent did not file evidence in these proceedings but did file written submissions in lieu of a hearing. In the circumstances I award the opponent the sum of **£600** as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the applicant's counterstatement	£200
Preparing written submissions	£300
Official fee	£100
Total	£600

68. I therefore order CAMEL CAPA LTD to pay Worldwide Brands, Inc. the sum of **£600**. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 7th day of 2020

James Hopkins
For the Registrar,
The Comptroller General