

O-521-21

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3457520
BY CINDY-LEE VILLAGE
TO REGISTER THE FOLLOWING TRADE MARK:**



BOO LONDON

IN CLASS 24

AND

**OPPOSITION THERETO UNDER NO. 420326
BY BOOHOO.COM UK LIMITED**

BACKGROUND AND PLEADINGS

1. On 13 January 2020, Cindy-Lee Village (“the applicant”) filed trade mark application number UK00003457520 for the mark shown on the cover page of this decision. The application was accepted and published for opposition purposes on 24 January 2020, in respect of “Silk fabrics” in class 24.

2. On 24 April 2020, Boohoo.com UK Limited (“the opponent”) filed an opposition opposing the application in full under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Since the opponent did not file evidence, the grounds for opposition under sections 5(3) and 5(4)(a) were struck out by the Registry.

3. Under section 5(2)(b) of the Act, the opponent relies upon UK trade mark number UK00003372067, the pertinent details of which are as follows:

Representation: 

Filing date: 1 February 2019

Registration date: 10 May 2019

Goods relied upon: “Textiles; fabrics” in class 24.

4. The mark relied upon by the opponent qualifies as an earlier mark and, given its registration date, is not subject to the proof of use provisions contained in section 6A of the Act.

5. The opponent claims that the parties’ goods are identical and that the marks are similar, resulting in a likelihood of confusion, including a likelihood of association.

6. The applicant filed a defence and counterstatement denying a likelihood of confusion on the basis that the marks at issue are not similar. The applicant drew comparisons between the parties’ goods and made further submissions in its counterstatement that I will deal with as preliminary issues later in this decision.

7. Neither party filed evidence. A hearing took place before me on 13 May 2021, by video conference. Andrew Marsden of Wilson Gunn attended, who represents the opponent in these proceedings. The applicant, who is unrepresented, did not attend, nor did it file submissions in lieu of attendance.

8. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

PRELIMINARY ISSUES

9. A number of points have been raised by the applicant in its counterstatement. Before going any further into the merits of this opposition it is necessary to explain why, as a matter of law, these points will have no bearing on the outcome of this opposition.

Goods comparison and the targeting of different demographics

10. In its counterstatement, the applicant made submissions relating to the target market of both parties, as follows:

“1. [...]

The opponent is an online fashion business and from research their target market are women (girls) between the ages of 16-25, selling seasonal budget items.

2. The applicant has a different target market, selling high momme (weight/quality), Charmeuse, silk pillowcases, eye masks, and scrunchies for the benefits it has on the skin and hair and aimed at older, high net worth individuals.”

11. The applicant also drew comparisons between the parties' goods, as follows:

“2. [...]

A set of pillowcases would sell at upwards of £100, one medium scrunchie at about £28, one eye mask for about £50. The items are priced on the quality and benefits of pure mulberry silk to the skin and hair and not as a fashion item. The applicant would not be selling clothing.

3. The product the opposition are selling are budget items. From searches on their websites could not find items of mulberry, high quality silk, or in fact any silk items.”

12. Differences between the goods currently provided by the parties, such as the quality or price, are irrelevant, except to the extent that those differences are apparent from each party’s specification. Since the opponent’s earlier mark is not subject to proof of use, it is entitled to protection in relation to all the goods for which it is registered. It is the goods relied upon by the opponent and the goods applied for by the applicant that I will be comparing, later in this decision. The assessment I must make between the goods is a notional and objective assessment, rather than a subjective one. Marketing strategies, including the targeting of specific demographics (age and “net worth”, for example), are temporary and may change over time. As such, it is not appropriate to take that factor into account in my assessment. However, I will make an assessment, later in this decision, as to who the average consumer could be for the goods at issue.

State of the register

13. In its counterstatement, the applicant made the following submission:

“The applicant notes a number of trademarks that have the name “Boo”, with 24 classification, that does not belong to the opposition.” (original emphasis)

14. 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). “

15. Accordingly, the state of the register is not evidence of how many of such trade marks are effectively used in the market, nor does it clarify whether consumers have or have not been confused by the presence of such marks.

16. Having dealt with the necessary submissions made by the applicant, I go on now to consider the opposition.

DECISION

Section 5(2)(b)

17. Section 5(2)(b) of the Act states that:

“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.”

Relevant law

18. 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.

The principles

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing

in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

19. In *Gérard Meric v Office for Harmonisation in the Internal Market* ("OHIM"), Case T-133/05, the GC stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für 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”.

20. As I mentioned earlier in this decision, it is the parties' goods as listed in their respective specifications that are relevant. To my mind, it is self-evident that the applicant's "silk fabrics" fall within the scope of the opponent's "fabrics". The goods are identical in accordance with *Meric*.

The average consumer and the nature of the purchasing act

21. It is necessary for me to determine who the average consumer is for the goods in question; I must then determine the manner in which the goods are likely to be selected by the average consumer in the course of trade.

22. 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: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

23. 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.”

24. The goods at issue are silk fabrics and fabrics. Despite the applicant's submission that it targets “older, high net worth individuals” and that the opponent targets girls aged 16-25 years, the average consumer of the goods could include any member of the general public who wishes to purchase fabrics. The goods are not an everyday purchase but are likely to be purchased fairly frequently. The cost will vary depending on the type of fabric; leather and silk tend to be more expensive than cotton, for example. However, none of the goods are likely to be prohibitively expensive. Choosing which fabric to buy will involve considerations such as the intended purpose of the fabric and whether its qualities are suited to the individual's needs, whether the fabric is natural or synthetic, the cost of the fabric, and whether it is vegan or not, amongst other factors. I am of the view that an average level of attention will be paid to the purchase.

25. The goods are likely to be purchased by self-selection from websites, shops, or via marketing material and so I consider the purchasing process to be predominantly visual. However, given that word-of-mouth recommendations might be made or conversations with assistants in retail premises might take place, I do not discount an aural element to the purchase.

Comparison of marks

26. It is clear from *Sabel* that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“CJEU”) stated at paragraph 34 of its judgment in *Bimbo*, 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 relevant 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.”

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

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

| Earlier mark | Contested mark |
|---|---|
|  |  |

29. In its counterstatement, the applicant submitted that the only similarity between the marks is BOO and that all other elements are visually different. At the hearing, Mr Marsden, for the opponent, made numerous submissions on the similarities and differences between the marks, which I bear in mind and will refer to, where necessary, in my comparison.

Overall impression

30. The earlier mark consists of the word BOOHOO, in lower case, in a black, standard typeface. There are no other elements and so the overall impression lies in the word itself.

31. The contested mark consists of textual and figurative components, all of which are in gold: a highly stylised letter B contained within an ornate circular device, below which are the words BOO LONDON, in upper case, in a standard typeface. I agree with the opponent that the word LONDON simply suggests that the business is in London or the goods originate from London, meaning it plays a weaker role than the other elements, which, given their size and position, play a roughly equal role in the overall impression.

Visual comparison

32. Visually, the similarity between the marks rests in the letters B-O-O. The fact that none of the remaining elements of each mark are present in the other creates multiple visual differences. The earlier mark contains the additional letters H-O-O that do not appear in the contested mark. Similarly, the contested mark contains the stylised letter B within a circular device and the additional word LONDON, none of which have a counterpart in the earlier mark. I consider there to be a low degree of visual similarity.

Aural comparison

33. I agree with the opponent that in relation to the applicant's mark, the letter B contained within the circular device will not be articulated. LONDON is also unlikely to be articulated, given its geographical nature. Therefore, the aural comparison is between BOOHOO and BOO, for which I find a medium degree of similarity. In the alternative, if the contested mark is referred to as BOO LONDON, I find a low to medium degree of aural similarity.

Conceptual comparison

34. At the hearing, Mr Marsden, for the opponent, submitted that neither BOOHOO nor BOO have a meaning in relation to the goods. He further submitted that there is a similar concept between the marks given that BOO is a loud sound or an exclamation. The applicant did not make any submissions relating to the concept of either mark.

35. The conceptual message of the earlier mark is that of BOOHOO as a whole, not BOO alone. BOO by itself is an exclamation used either to surprise someone or to express dissatisfaction or disapproval. The word BOOHOO, on the other hand, is likely to be seen as a reference to the noise of crying or sobbing.¹ For consumers who do not instantly recognise that meaning, the mark is conceptually neutral. In either scenario, I consider the marks to be conceptually dissimilar.

Distinctive character of the earlier mark

36. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, the greater the likelihood of confusion (see *Sabel*). In *Lloyd Schuhfabrik Meyer* the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

¹ www.collinsdictionary.com/dictionary/english/boohoo

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

38. In its statement of grounds, the opponent referred to its enhanced distinctive character arising through its reputation in the UK. However, with no evidence from which to make an assessment of an enhanced distinctive character through use, I only have the inherent position to consider. Mr Marsden, at the hearing, submitted that the earlier mark is inherently distinctive to a high degree, since it is not descriptive of or allusive for the goods. I agree that BOOHOO has no meaning in relation to the goods for which the mark is registered, so it does not have the lowest level of distinctive character. However, marks with a high degree of inherent distinctive character tend to be invented words, which I do not consider BOOHOO to be. I am of the view that the earlier mark has a medium degree of inherent distinctive character.

Likelihood of confusion

39. 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. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

40. I have found the marks to be visually similar to a low degree, aurally similar to a medium degree (or to a low to medium degree if the contested mark is articulated as BOO LONDON) and conceptually dissimilar. I have found the earlier mark to have a medium degree of inherent distinctive character. I have identified the average consumer to be a member of the general public who will purchase the goods predominantly by visual means, although I do not discount an aural element to the purchase. I have concluded that an average degree of attention will be paid during the purchasing process. I have found the goods at issue to be identical.

41. Although the start of both marks will be articulated identically (as BOO) and the beginnings of marks tend to have more visual and aural impact than the ends,² the comparison here is not between two word marks, but between marks with multiple visual differences. The earlier mark has an additional three letters which have no counterpart in the contested mark and will not be forgotten by the average consumer. Similarly, the contested mark has textual and figurative elements alien to the earlier mark. I do not consider that the average consumer would mistakenly recall or misremember one mark for the other, even when considered in relation to identical goods. There are too many non-negligible differences which the average consumer would notice. There is no likelihood of direct confusion.

42. I will now consider whether there is a likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*:³

“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 recognised that the later mark is different from the earlier mark. It therefore requires a mental

² *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

³ BL O/375/10.

process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: 'The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark'.

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

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

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

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

43. I have borne in mind that the examples given by Mr Purvis are not exhaustive. Rather, they were intended to be illustrative of the general approach.⁴

44. In order to find indirect confusion in this case, it would be necessary to conclude that the average consumer will see in BOOHOO and BOO (or BOO LONDON), respectively, an element common between the marks, leading them to the conclusion

⁴ See *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17 at paragraphs [81] to [82].

that BOO in the context of the contested mark means it is a brand of the owner of the earlier mark. Aurally, it is true that I found a medium degree of similarity between BOO and BOOHOO, however, I have found that the purchasing process will be a primarily visual one and that the average consumer will notice the letters H-O-O in the earlier mark and the other elements in the contested mark. Given the clear difference of concept of BOO compared to BOOHOO,⁵ I do not envisage a scenario, either falling into one of the three categories listed above or otherwise, whereby consumers see the letters B-O-O in both marks and assume the undertakings are linked. Even for identical goods, I do not consider there to be a likelihood of indirect confusion.

CONCLUSION

45. The opposition has failed under section 5(2)(b) and the application can proceed to registration.

COSTS

46. The applicant has been successful and would ordinarily be entitled to a contribution towards its costs. As the applicant is unrepresented, at the conclusion of the evidence rounds the tribunal invited it to indicate whether it wished to make a request for an award of costs and, if so, to complete a pro-forma including a breakdown of its actual costs. The applicant failed to return the pro-forma. As it incurred no official fees in the defence of its application, I make no award of costs in this matter.

Dated this 8th day of July 2021

E VENABLES

For the Registrar

⁵ *The Picasso Estate v OHIM*, Case C-361/04 P.