

O-166-11

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2518541  
BY ANDREW DUDLEY ENTERTAINMENT LIMITED  
TO REGISTER A TRADE MARK IN CLASSES 14, 25 & 41**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 99764 BY  
LA CITY (SOCIÉTÉ PAR ACTIONS SIMPLIFIÉE)**

## BACKGROUND

1. On 16 June 2009, Andrew Dudley Entertainment Limited (“Dudley”) applied to register **City Cup** as a trade mark. Following examination, the application was accepted and published for opposition purposes on 14 August 2009 for the following goods and services:

Class 14: Medals, trophies, all relating to or for the promotion of football/ soccer leagues.

Class 25: Articles of clothing, including headgear and footwear.

Class 41: Reservations services for tickets; organisation of sporting events, shows, activities and competitions; Coaching services for sporting activities; Competitions provided by telephone; Information relating to entertainment or education, provided on-line from a computer database or the Internet; Internet games (non-downloadable); entertainment by means of television; entertainment services in the form of television programmes; entertainment provided during intervals of sporting events; entertainment by cable television; entertainment by video text systems; entertainment by means of radio; Internet entertainment; entertainment by means of telephone; entertainment by means of roadshows; television entertainment services involving telephonic audience participation; interactive entertainment for use with a mobile phone; Internet based games; operation of lottery and game of chance; provision of video clips via mobile or computer networks for entertainment and or educational purposes; rental of sound recordings and of prerecorded shows, films, radio and television performances; entertainment services for producing live shows all relating to or for the promotion football/soccer league.

2. On 13 November 2009, La City (Société par Actions Simplifiée) (“LC”) filed a notice of opposition. This consisted of a single ground based upon section 5(2)(b) of the Trade Marks Act 1994 (as amended) (the Act). LC indicates that the opposition is directed against all of the goods contained in classes 14 and 25 of the application for registration. LC relies upon two trade mark registrations:

Trade Mark	No.	Application date	Registration date	Goods relied upon
LA CITY	E7538457	20.01.2009	20.08.2009	14 - Precious metals and their alloys and goods made from or coated with these materials, not included in other classes; jewellery; Jewellery; precious stones; horological and chronometric instruments.  25 - Clothing; shoes; headgear.

LA CITY	M735151	28.02.2000 Priority claimed from 31.08.1999 (France)	14.06.2002	14 - Precious metals and alloys thereof (other than for dental use) and products made from these materials (precious metals and alloys thereof) or coated therewith not included in other classes, namely silverware (dishes), plates, tea caddies, candy boxes, tea infusers, cabarets (serving trays), non-electrical coffee makers, egg cups, baskets for household use, pitchers, tea strainers, mugs, cruet sets, tea filters, sieves, trays for household use, dishes, pepper pots, toothpick holders, household and kitchen containers, napkin rings, salad bowls, salt shakers, tableware (except cutlery), coffee services, tea services, saucers, soup bowls, sugar bowls, cups, teapots, ashtrays, household and kitchen utensils, dishes, candlesticks, busts, candelabra, figurines, works of art, silverware (with the exception of cutlery, table forks and spoons), statues, statuettes, vases, ecclesiastical plates, cigar boxes and cases, cigarette boxes and cases, cigar holders, cigarette holders, match holders, storage cases for cigars, storage cases for cigarettes, tobacco jars, snuffboxes, boxes, chain mesh purses, jewelry cases, caskets, coin purses, towel holders, powder compacts, needles, harnessing trimmings, badges, coins; jewelry, finger rings, bracelets, chains, necklaces, pendants, brooches, earrings, medals and medallions, cuff
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				<p>links, tie pins, trinkets; precious stones; timepieces, watches, alarm clocks, clocks and chronometric instruments; none being for use with boilers and not including any such goods relating to typefaces and fonts.</p> <p>25 - Clothing, underwear, sportswear other than for diving, belts, gloves, footwear, headgear.</p>
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3. In their Notice of Opposition LC said:

“The marks are both plain word marks consisting of the word City plus a not particularly distinctive additional word. In the earlier mark the French word “la” meaning “the”. In the opposed mark the word “cup”. The dominant and distinctive element of both marks is therefore identical giving rise to a high degree of similarity in the marks when considered as a whole. The goods covered by the respective marks are identical. On a global assessment the likelihood of confusion is high and the application should be refused.”

4. On 23 August 2010, Dudley filed a counterstatement in which it said:

“We counter that while the word “la” is not distinctive, both the words “city” and “cup” (meaning a trophy in the shape of an oversized cup) when used in combination for a sporting event is unique and completely distinctive term that would not result in confusion to “La City” or “The City”.

5. Neither party filed evidence or written submissions nor did they ask to be heard.

## DECISION

6. The opposition is based upon section 5(2)(b) of the Act which reads as follows:

“5. - (2) A trade mark shall not be registered if because -

(a)....

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, or

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

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

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

8. In these proceedings LC are relying upon the two registrations shown in paragraph 2 above; both are for the same trade mark i.e. LA CITY and both are earlier trade marks under the above provisions. As Community Trade Mark No. 7538457 covers goods in classes 14 and 25 and is not subject to proof of use, as per The Trade Marks (Proof of Use, etc) Regulations 2004, it is this trade mark that I will use to make the comparison.

### **Section 5(2)(b) – case law**

9. In reaching a decision I must take into account the guidance provided by the European Court of Justice (ECJ) in a number of judgments. The principal cases are: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Mayer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05),

It is clear from all these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all the relevant factors: *Sabel BV v. Puma AG*, paragraph 22;

(b) the matter must be judged through the eyes of the average consumer of the good/services in question; *Sabel BV v. Puma AG*, paragraph 23, who is deemed to be reasonably well informed and 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27;

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;
- (e) when considering composite marks, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element; *Shaker di L. Laudato & Co. Sas (C-334/05)*, paragraph 42;
- (f) an element of a mark may play an independent distinctive role within it without necessarily constituting the dominant element; *Medion AG V Thomson multimedia Sales Germany & Austria GmbH*, paragraph 30;
- (g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (h) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;
- (i) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;
- (j) further, 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; *Marca Mode CV v. Adidas AG + Adidas Benelux BV*, paragraph 41;
- (k) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

### **The average consumer and the nature of the purchasing process**

10. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. The goods at issue in these proceedings are medals, trophies and articles of clothing. These are the sort of goods which will be bought by the general public; they then are the average consumer for such goods.

11. In my view the selection of the goods at issue is most likely to consist primarily of a visual act made on the basis of self selection in either a retail environment, from a catalogue or on-line (see the comments of the Appointed Person in *React Trade Mark* [2000] RPC 285). In addition, I note that in *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs)* Joined cases T-117/03 to T-119/03 and T-171/03, the General Court considered the level of attention taken in purchasing goods in the clothing sector:

“43 It should be noted in this regard that the average consumer’s level of attention may vary according to the category of goods or services in question (see, by analogy, Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26). As OHIM rightly pointed out, an applicant cannot simply assert that in a particular sector the consumer is particularly attentive to trade marks without supporting that claim with facts or evidence. As regards the clothing sector, the Court finds that it comprises goods which vary widely in quality and price. Whilst it is possible that the consumer is more attentive to the choice of mark where he or she buys a particularly expensive item of clothing, such an approach on the part of the consumer cannot be presumed without evidence with regard to all goods in that sector. It follows that that argument must be rejected.”

12. In my view the comments in *New Look* also apply to the selection of medals and trophies. As both medals, trophies and clothing can vary widely in terms of both cost and quality, it is reasonable to assume that the average consumer’s level of attention will also vary depending on the cost of the item under consideration.

**Comparison of goods**

13. For the sake of convenience the goods to be compared are as follows:

<b>LC’s goods</b>	<b>Dudley’s goods</b>
14 - Precious metals and their alloys and goods made from or coated with these materials, not included in other classes; jewellery; Jewellery; precious stones; horological and chronometric instruments.	14 - Medals, trophies, all relating to or for the promotion of football/ soccer leagues.
25 - Clothing; shoes; headgear.	25 - Articles of clothing, including headgear and footwear.

14. In *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-133/05, at paragraph 29 the General Court said:

“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 Vedral 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.”

15. It is, I think, self evident that Dudley’s goods in class 14 are encompassed by the term “precious metals and their alloys and goods made from or coated with these materials” which appears in LC’s registration; the goods are therefore identical. Insofar as class 25 is concerned, the terms used in Dudley’s application are either the same as or would encompass goods contained within LC’s registration. In summary, all of the competing goods are identical.

### **Comparison of trade marks**

16. The trade marks to be compared are: **LA CITY** and **City Cup**.

17. The average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as wholes and does not pause to analyse their various details. In addition, he/she rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he/she has kept in his/her mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant components of the respective trade marks and, with that conclusion in mind, I must then go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

### **Distinctive and dominant components**

18. In their Notice of opposition LC argue that it is the word CITY which is the distinctive and dominant component of the competing trade marks, the other components being, in their view, “not particularly distinctive”. LC’s earlier trade mark consists of the word/letters LA and the word CITY presented as two separate components all in upper case. LC argues that the first part of their trade mark would be seen as the French word “la” meaning “the”. However, there is no evidence to support this assertion. The average consumer is, in my view, just as likely to see the first component of LC’s trade mark as the acronym for Los Angeles. In addition, LC argues that the French word “la” is not particularly distinctive. If the first component of LC’s trade mark is construed by the average consumer as the French word La, then this word would, in my view, be neither descriptive nor non distinctive for the goods upon which LC rely in these proceedings. However, if the letters LA are viewed in the other context I have suggested i.e. as an acronym for Los Angeles, then they are unlikely to be considered distinctive given the size and well known nature of that geographical location. Insofar as the word CITY is concerned, although a very well known word, it appears, in the absence of evidence to the contrary, to be distinctive for the goods upon which LC relies.



19. Appearing as it does as the first component of LC's trade mark, the word/letters LA have a degree of dominance over the word CITY. If LC's trade mark is viewed in the manner they suggest, it would consist of two distinctive components the first component of which was likely to be considered dominant because of its positioning. It would also create an unusual combination of French/English words which would render the totality distinctive. However, if the letters LA are seen as an acronym for Los Angeles, the totality is likely, in my view, to be construed as Los Angeles City, thus rendering the individual components and the totality descriptive and non-distinctive.

20. Turning now to Dudley's trade mark, this consists of the words City and Cup presented in title case; I have already commented on the distinctive credentials of the word City above. As for the word Cup, while this is unlikely to be distinctive for the goods in class 14, it appears to be distinctive for the vast majority of the goods in class 25 (perhaps with the exception of brassieres). Here again the positioning of the word City as the first component of the trade mark gives it a degree of dominance.

21. I have no evidence as to how the average consumer will construe either trade mark. However, insofar as LC's trade mark is concerned, I am prepared to accept that some average consumers will construe the trade mark in the manner they suggest i.e. as a combination of French/English words thus rendering both the individual components and the totality distinctive. In my view, this interpretation of LC trade mark provides them with their best prospect of success in these proceedings and I intend to conduct any further analysis on the basis of this interpretation of their trade mark (LC's prospect of success is, in my view, likely to be much reduced if the average consumer construes their trade mark as Los Angeles City). Although the word LA has a degree of dominance by virtue of its positioning as the first component of the trade mark, it is, in my view, the unusual mixture of English/French words created by the totality of the trade mark that is likely to fix itself in the average consumer's mind. As to Dudley's trade mark, the word City is likely to be considered a distinctive element whereas the word Cup is unlikely to be considered distinctive for the goods in class 14 and for some of the goods in class 25. While the distinctive nature and the positioning of the word City gives it some dominance over the word Cup, here again I think it is the totality of Dudley's trade mark that the average consumer is likely to recall rather than the individual components of which it is made up. Having reached those conclusions I will now apply them to the visual, aural and conceptual comparison.

### **Visual comparison**

22. Both parties' trade marks consist of two elements. In LC's trade mark the word CITY occupies the suffix position whereas in Dudley's trade mark it is in the prefix position. While the presence of the word CITY in both trade marks creates a degree of visual similarity, the significant visual difference between the other elements in the competing trade marks reduces the overall degree of visual similarity to a low level.

### **Aural similarity**

23. Proceeding on the basis that the first component of LC's trade mark will be pronounced as the French word La, LC's trade mark consists of two words consisting of one and two syllables respectively, whereas Dudley's trade mark consists of two words consisting of two and one syllable respectively, leading, in my view, to a different aural rhythm. Once again the fact that both trade marks contain the word CITY is bound to lead to a degree of aural similarity between them. However, the fact that both trade marks contain an additional element which is aurally completely different, combined with the different aural rhythm the respective trade marks create, reduces the overall degree of aural similarity to a low level.

### **Conceptual similarity**

24. Again proceeding on the basis that the first component of LC's trade mark will be construed as the French word La, the totality of LC's trade mark may (perhaps) conjure up an image in the average consumer's mind of a city in France or (perhaps) a city with French influences. More likely, in my view, is that it will not create any clear conceptual picture in the mind of the average consumer. Insofar as Dudley's trade mark is concerned, I think it is also unlikely to create any clear conceptual image in the average consumer's mind (even when used upon goods relating to football). Consequently, in my view, the competing trade marks are neither conceptually similar nor conceptually dissonant; the conceptual position is neutral.

### **Distinctive character of LC's earlier trade mark**

25. I must now assess the distinctive character of LC's LA CITY trade mark. The distinctive character of a trade mark must be appraised first by reference to the goods in respect of which it has been registered and, second, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. When considered as a combination of French and English words, the individual elements of LC's trade mark and the totality these elements create are, when considered in relation to the goods upon which they rely in these proceedings, possessed of a fairly high degree of inherent distinctive character.

### **Likelihood of confusion**

26. In determining whether there is a likelihood of confusion, I need to bear a number of factors 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. It is also necessary for me consider the distinctive character of LC's trade mark, as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and 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 he/she has retained in his/her mind.

27. Earlier in this decision I concluded that the competing goods were identical. Based on the most favourable interpretation of LC's earlier trade mark, I also concluded that the competing trade marks shared only a low degree of visual and aural similarity, that the conceptual position was neutral and that LC's LA CITY trade mark was possessed of a fairly high degree of inherent distinctive character. Applying these conclusions to the matter at hand, I have little hesitation in concluding that notwithstanding the identity in the goods and the fairly high degree of inherent distinctive character LC's trade mark possesses, the low degree of both visual and aural similarity created by the presence of the well known word CITY appearing in the competing trade marks is most unlikely to result in direct confusion (where one trade mark is mistaken for the other). Nor is it likely, in my view, to result in indirect confusion (where the average consumer thinks that the goods of Dudley come from an undertaking economically linked to LC). LC's opposition based upon section 5(2)(b) of the Act fails accordingly.

### **Costs**

28. As Dudley has been successful, it is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice 4 of 2007. Using that TPN as a guide and bearing in mind the registrar's practice to award costs at half the rate that would have been awarded where a party had legal representation, I award costs to Dudley on the following basis:

Preparing a statement and considering LC's statement:	£150
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<b>Total:</b>	<b>£150</b>
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29. I order La City (Société par Actions Simplifiée) to pay to Andrew Dudley Entertainment Limited the sum of **£150**. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 17 day of May 2011**

**C J BOWEN**  
**For the Registrar**  
**The Comptroller-General**