

O/002/12

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2534846
BY DENIM MERCHANTS LIMITED TO REGISTER THE TRADE MARK**

YAMAAI

IN CLASS 25

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 100432
BY INTICOM S.P.A.**


BACKGROUND

1. On 17 December 2009, Denim Merchants Limited (“Denim”) applied to register the word **YAMAAI** as a trade mark for the following goods in class 25:

Articles of outer clothing and headgear; denim clothing and headgear, jeans, jackets and waistcoats.

Following examination, the application was accepted and published for opposition purposes on 22 January 2010.

2. On 21 April 2010, INTICOM S.p.A. (“Inticom”) filed a notice of opposition which consisted of grounds based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Inticom’s opposition, which is directed against all of the goods in Denim’s application is, under sections 5(2)(b) and 5(3) of the Act, based upon the following trade marks:

Trade Mark	No.	Application date	Registration Date	Goods and services relied upon
	3159795 CTM	4.4.2003 IC (Italy) 26.2.2003	6.9.2004	25 – Outer and underclothing, swimwear, stockings and tights, footwear, headgear. 35 - Retailing of goods listed in Classes...25, namely:.. outer and underclothing, swimwear, stockings and tights, footwear, headgear.
YAMAMAY	5343769 CTM	14.9.2006	30.8.2007	Although relied upon in relation to all the goods and services for which it stands registered, the registration includes the following goods in class 25: Articles of clothing, footwear and headgear.

3. For its ground based upon section 5(4)(a) of the Act Inticom relies upon the two trade marks in the format shown above, explaining that both trade marks have been used in the United Kingdom since May 2005. Inticom states that the first trade mark has been used upon all of the goods and services for which it stands registered i.e.

Class 3: Soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.

Class 9: Spectacles, optical frames, accessories for spectacles, contact lenses; discs, CDs, DVDs, cassettes, video cassettes, electronic equipment for the recording, transmission and reproduction of sound and/or images.

Class 14: Precious metals and their alloys and goods in precious metals or coated therewith not included in other classes; jewellery, costume jewellery, precious stones; horological and chronometric instruments.

Class 16: Books, newspapers, magazines, printed matter in general, stationery; paper, cardboard and goods made from these materials, not included in other classes; prints; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials, paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks.

Class 18: Leather and imitations of leather, goods made of these materials and not included in other classes; animal skins; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery; bags, packs, wallets.

Class 24: Textiles and textile goods, not included in other classes; bed and table covers.

Class 25: Outer and underclothing, swimwear, stockings and tights, footwear, headgear.

Class 35: Retailing of goods listed in Classes 3, 9, 14, 16, 18, 24 and 25, namely: soaps; perfumery, essential, cosmetics, hair lotions; dentifrices; spectacles, optical frames, spectacle accessories, contact lenses; discs, CDs, DVDs, cassettes, video cassettes, electronic equipment for the recording, transmission and reproduction of sound and/or images; precious metals and their alloys and goods in precious metals or coated therewith not included in other classes; jewellery, costume jewellery, precious stones; horological and other chronometric instruments; books, newspapers, magazines, printed matter in general, stationery; paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding materials; photographs; stationery; adhesives for stationery or household purposes; artist's materials; paint brushes; typewriters and office requisites (other than furniture); instructions and teaching material (other than apparatus); plastic materials for packaging (not included in other classes); printers type; printing blocks; leather and imitations of leather, goods made of these materials and not included in other classes; skins and hides; trunks, and travelling bags; umbrellas, parasol, walking sticks and canes; whips, harnesses and saddlery; bags, bags, wallets; textiles and textile goods, not included in other classes; bed and table covers; outer and underclothing, swimwear, stockings and tights, footwear, headgear; services consisting of the organization of exhibitions in halls and/or showrooms for commercial or advertising purposes; advertising and marketing services; organising and managing franchise circuits, providing the necessary advice to franchisees, including in relation to arranging retail space, the use of signs and advertising; the bringing together, for the benefit of others, of a variety of goods,

enabling customers to conveniently view and purchase those goods in a retail store.

Class 42: Drawing up designs and plans regarding samples of clothing and other samples.

4. Inticom states that the second trade mark shown above has been used in respect of: “articles of clothing, footwear and headgear and in respect of the retailing of such goods.”

5. On 7 January 2011, Denim filed a counterstatement in which the grounds of opposition are denied and in which Inticom are put to strict proof of use (in relation to the goods and services in classes 25 and 35 of registration No. 3159795) and also to its claimed reputation and goodwill.

6. Only Inticom filed evidence. Neither party asked to be heard; Inticom filed written submissions in lieu of attendance at a hearing.

EVIDENCE

7. Inticom’s evidence consists of an eight page witness statement, dated 20 July 2011, (accompanied by 28 exhibits) from Francesco Pinto, the President of the Board of Directors of Inticom. While, for reasons which will shortly become apparent, it is not necessary for me to summarise Mr Pinto’s evidence here, I will refer to it briefly later in this decision.

DECISION

8. The opposition is based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Act. Section 5(2)(b) of the Act 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.”

9. 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.”

10. In these proceedings, Inticom is relying upon the trade marks shown in paragraph 2 above, both of which constitute earlier trade marks under the above provisions. Given the interplay between the dates on which Inticom’s registrations completed their registration procedure and the date on which Denim’s application was published, registration No. E3159795 is, as per The Trade Marks (Proof of Use, etc) regulations 2004, subject to proof of use (and Inticom have been asked by Denim to provide such proof). However, registration No. E5343769 is not subject to proof of use. As Denim’s trade mark and Inticom’s trade mark No. E5343769 are both presented in block capital letters, it is this trade mark that, in my view, offers Inticom the best prospect of success under section 5(2)(b), and it is this trade mark that I intend to use to conduct the comparison.

Section 5(2)(b) – case law

11. The leading authorities which guide me are from the CJEU (Court of Justice of the European Union): *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). It is clear from these cases that:

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

(b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

- (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*,
- (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*,
- (e) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*
- (f) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*.
- (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*,
- (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*,
- (i) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,
- (j) 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*,
- (k) 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 and Adidas Benelux BV*,
- (l) 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*.

The average consumer and the nature of the purchasing process

12. 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. In its statement of grounds Inticom said:

“8. The average consumer of the goods and services is the general public who displays only an average degree of attention and who often must rely on an imperfect recollection of the marks (*Lloyd Schuhfabrik* case).”

13. The goods at issue in these proceedings are articles of clothing, footwear and headgear; goods which will, as Inticom say, be bought by the public at large. As to the manner in which the goods are likely to be selected by the average consumer, this is most likely to consist of a visual act made on the basis of self selection in either a retail environment, from a catalogue or on-line. 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 (GC) said:

“50. The applicant has not mentioned any particular conditions under which the goods are marketed. 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.”

14. The GC also considered the level of attention taken purchasing goods in the clothing sector. It said:

“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.”

15. As the *New Look* case acknowledges, the cost of clothing can vary considerably. However, as neither of the competing specifications in class 25 is limited in this respect, it is goods across the whole price spectrum I must keep in mind. While I agree the

average consumer's level of attention is likely to be heightened when selecting, for example, a bespoke gown or suit, it is also, in my view, likely that the same average consumer's level of attention will diminish when selecting, for example, an inexpensive pair of socks. While these examples demonstrate that the average consumer's level of attention will vary considerably given the cost and nature of the article of clothing at issue, I think that when selecting even routine items of clothing the average consumer is likely to be conscious of factors such as the size, colour, material and price of the article concerned. Overall, I think the average consumer is likely to pay at least a reasonable degree of attention to the selection of the goods at issue.

Comparison of goods

16. In these proceedings Denim seeks registration in respect of:

Articles of outer clothing and headgear; denim clothing and headgear, jeans, jackets and waistcoats,

whereas Inticom earlier trade mark No. E5343769 stands registered, inter alia, in respect of:

Articles of clothing, footwear and headgear.

17. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05 the GC said:

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

18. Having applied the guidance in *Gérard Meric* to the competing specifications in these proceedings, it is clear that as all of the goods in Denim's application fall within the terms “Articles of clothing...headgear” that appears in class 25 of Inticom's registration; the competing goods must be regarded as identical.

Comparison of trade marks

19. The trade marks to be compared are: YAMAMAY and YAMAAL.

20. 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 rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has kept in his 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

21. As both parties' trade marks consists of single words presented in block capital letters, there are no distinctive and dominant components, the distinctiveness in each trade mark lying in its totality.

Visual/aural similarity

22. In its statement of grounds Inticom said:

“3. The mark applied for is aurally and visually similar to the earlier marks since the respective marks share the same first 2 syllables, the same number of vowels, including the same number of letters A and because the ending AI is very similar to AY. The marks coincide in the sequence of letters Y-A-M-A-* -A-* and have almost the same length (6 letters/7 letters).”

23. Consisting of six and seven letters respectively and sharing the same first four letters and the same penultimate letter, results, in my view, in a relatively high degree of visual similarity between the competing trade marks. Insofar as aural similarity is concerned, the manner in which the competing trade marks will be pronounced by the average consumer is, in my view, uncertain. However, in my view, the average consumer is most likely to pronounce Denim's trade mark as YAM-EYE or YAM-A-EYE and Inticom's trade mark as YAMA-MAY or YAM-A-MAY. The fact that the pronunciation of both parties' trade mark are likely to begin YAM or YAMA, combined with the potential similarities in the endings of the competing trade marks results, in my view, in a relatively high degree of aural similarity between them.

Conceptual similarity

24. In its statement of grounds Inticom said:

“4. Because the mark applied for is also an invented word it cannot be said that it is conceptually dissimilar to the earlier marks. In fact, it is submitted that this further enhances the high degree of similarity between the respective marks.”

25. In Inticom's evidence (exhibit 02, page 5) it says:

"The evolution of the world of fashion, with its forms and spaces steadily changing, takes on a precious turn with the arrival of an inventive and innovative set-up, whose name comes from the most precious silk cocoon in existence. The Yamamay silkworm is found exclusively in the unpolluted hills in inland Japan. In its larval state it is adorned with silver and crystal reflections tending towards pearly white. These colours are complemented by bright green and Yamamay red, representing strong inner passions..." (my emphasis).

26. Whilst I note the above reference, I very much doubt (and there is no evidence to the contrary) that the average consumer would be aware of the Yamamay silkworm and the possible significance of the word YAMAMAY in the context of clothing made from silk. The average consumer would, in my view, treat the word YAMAMAY as an invented word. As there is no evidence that Denim's YAMAAI trade mark has any meaning, the competing trade marks are, in my view, neither conceptually similar nor conceptually dissonant.

Distinctive character of Inticom's earlier trade mark No. E5343769

27. I must now assess the distinctive character of Inticom's earlier 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, secondly, 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.

28. In its submissions Inticom said:

"7. The opponent's earlier marks being composed of an invented word are inherently highly distinctive in relation to the goods and services for which they are registered as they have no conceptual link with these goods and services. The earlier marks' distinctiveness is further enhanced by the marks reputation in respect of articles of clothing, footwear and headgear and in respect of the retailing services of such goods."

29. The word YAMAMAY is clearly not an invented word. However, I concluded above that although the word refers to a silkworm to be found in Japan, as this is not a meaning which would be known to the average consumer, it would, in my view, be treated by the average consumer as an invented word which neither describes nor is non-distinctive for the goods at issue in these proceedings. As a consequence of that conclusion, Inticom's trade mark is, in my view, possessed of a high degree of inherent

distinctive character. The evidence of Mr Pinto demonstrates that Inticom have made use of its trade mark (primarily, I think it is fair to say, in the format shown in registration No. E3159795) in relation to a range of clothing in, inter alia, a number of European countries including the United Kingdom. While this use is likely to have built up the trade marks' inherent credentials to some extent, any enhanced reputation Inticom may or may not have in the word YAMAMAY presented in upper case is not (given that I have found that the word is inherently highly distinctive) a factor which will impact to any significant extent on my findings as to the likelihood of confusion.

Likelihood of confusion

30. 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 to keep in mind the distinctive character of Inticom's earlier trade mark (as the more distinctive this trade mark is, the greater the likelihood of confusion), 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 has retained in his mind.

31. Earlier in this decision I concluded that the average consumer was a member of the general public who would select the goods primarily by visual means and who would pay at least a reasonable degree of attention to his selection. I also concluded that the goods were identical and that while there was a relatively high degree of visual and aural similarity between the competing trade marks, the conceptual position was neutral. Finally, I concluded that Inticom's earlier trade mark No. E5343769 was possessed of a high degree of inherent distinctive character.

32. Applying those conclusions to the matter at hand, I have absolutely no hesitation concluding that there is a likelihood of confusion. Considered in the context of the doctrine of imperfect recollection, the identity in the goods and the overall degree of visual and aural similarity between the competing trade marks (and the absence of any conceptual meanings to assist the average consumer's recall) is likely, in my view, to result in direct confusion i.e. where the average consumer mistakes one parties' trade mark for the other. As a consequence of that conclusion, Inticom's opposition based upon section 5(2)(b) of the Act succeeds.

The objections based upon section 5(3) and 5(4)(a) of the Act

33. Given my very clear finding under section 5(2)(b) of the Act, there is no need for me to go on and consider the other grounds of opposition.

Costs

34. Inticom, having been successful, 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 keeping in mind the nature of Inticom's pleadings under sections 5(3) and 5(4)(a) of the Act, together with the fact that one of Inticom's earlier trade marks was subject to proof of use and that Denim put Inticom to strict proof of its use and reputation/goodwill, I award costs to Inticom on the following basis:

Preparing a statement and considering Denim's statement	£300
Preparing evidence:	£700
Written submissions:	£300
Official fee:	£200
Total	£1500

35. I order Denim Merchants Limited to pay to Inticom S.p.A the sum of **£1500**. 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 5th day of January 2012

C J BOWEN
For the Registrar
The Comptroller-General