

O-546-18

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK REGISTRATION NO. 3169880
IN THE NAME OF UNIVA INTERNATIONAL LTD
FOR THE TRADE MARK**

Univa


**AND THE APPLICATION FOR INVALIDATION THEREOF
UNDER NO. CA000501622
BY
UNISA AMERICA, INC.**

Background & Pleadings

1. Univa International Ltd (hereafter 'Univa International') is the Registered Proprietor for UK Trade Mark no. 3169880 for the mark **Univa**. The mark was filed on 16 June 2016 and registered on 23 December 2016. It is registered in classes 3, 9,14,16, 25, 26, 35, 38 and 41, although only class 25 forms part of these proceedings. On 4 April 2018, Univa International surrendered two of its class 25 goods, namely *footwear; socks* by means of a form TM23. Its registered goods for class 25 are now as follows: *clothing; headgear; swimwear; sportswear; leisurewear; clothing for children; infant wear; articles of clothing for women; sleepwear, lingerie; hosiery; nightwear; sports clothing; gymwear; beach clothing; belts [clothing]; underwear; gloves; men's and women's jackets, coats, trousers, vests.*

2. Unisa America, Inc (hereafter 'Unisa America') seeks invalidation of class 25 of the registered mark under section 5(2)(b) and section 5(3) of the Trade Mark Act 1994 ('the Act') based on its earlier UK and EU trade marks set out below:

Marks relied on by Unisa America	Goods relied on by Unisa America
UK TM 1328641 UNISA Filing date: 30 November 1987 Date of entry in register: 26 November 1993	Class 18: handbags; purses; wallets Class 25: footwear
EU TM 7269707 UNISA	Class 18: handbags Class 25: shoes

Filing date: 29 September 2008 Date of entry in register: 22 April 2009	
EU TM 7270663  Filing date: 29 September 2008 Date of entry in register 22 April 2009	Class 18: handbags Class 25: shoes

3. Unisa America claims under section 5(2)(b) that the registered mark is similar to the earlier marks and is registered for goods for which the earlier marks are protected and there exists a likelihood of confusion. Under section 5(3) it claims that the registered mark is similar to its earlier marks which have a reputation in the UK and use of the registered mark would take unfair advantage or be detrimental to the reputation of the earlier marks.

4. Univa International filed a defence and counterstatement in which it denied the marks were similar. With regard to the goods, Univa International denied its class 25 goods were similar to Unisa America's class 18 goods, but agreed that *footwear* was identical to the same term in the earlier mark UK TM 1328641. However, it disagreed that *shoes* in the other two earlier marks were similar to its own *footwear*.

5. Unisa America's trade marks are all earlier marks, in accordance with Section 6 of the Act. As all marks have completed their registration procedure more than 5 years prior to the publication date of Univa International's mark, they are subject to the proof of use conditions, as per section 6A of the Act. Unisa America made a statement of use in respect of all the goods it relies on.

6. In these proceedings, Unisa America are represented by Brabners LLP, whilst Univa International represents itself.

7. Neither party requested to be heard. Unisa America filed evidence of use and written submissions in lieu of a hearing. Univa International filed submissions as part of its counterstatement. I make this decision based on the papers before me.

Unisa America's evidence

8. Unisa America submitted a witness statement from Grisel Fernandez, the Chief Financial Officer, and appended 18 exhibits. These are summarised below.

9. Exhibit GF1 comprises a selection of website screenshots from www.unisa-europa.com generated by the Wayback Machine internet archive dated between January 2003 and June 2016. Both the word and figurative earlier marks are visible.

10. Exhibit GF2 comprises a set of customer reviews dated throughout 2017 generated by eKoni, a customer feedback collection service. The earlier word and figurative marks are referenced on the screenshots by eKoni but not in the customer reviews themselves.

11. Exhibit GF3 comprise 4 images of the mark applied to the goods, namely two images of the earlier figurative mark printed on the insole and the outer (under) sole of a pair of stilettos and two images of the figurative mark applied to the outside of a handbag and affixed to an inside compartment. These images are undated but the declarant states that Unisa America have been branding their goods in this manner since 2009.

12. Exhibit GF4 comprises an undated printout of Unisa America's FaceBook page.

13. Exhibit GF5 comprises screenshots dated December 2017 of Unisa America's Instagram site.

14. Exhibit GF6 comprises a screenshot dated December 2017 from Unisa America's YouTube channel.

15. Exhibit GF7 comprises a selection of Unisa America's seasonal goods catalogues (Spring/Summer and Autumn/Winter) dated between 2011 to 2015. The goods featured are footwear and handbags. Both the word and figurative marks feature within the layout of the catalogues. The figurative mark can be seen on the insole of the footwear when it is photographed from above looking down on to the goods.

16. Exhibit GF8 comprises a selection of invoices priced in Euros, dated between 2012 and 2016 for various stockists and distributors in Germany, The Netherlands, Spain, Sweden, France, Italy, Belgium and the UK. The invoices make references to 'pairs', which I take to mean footwear and 'units' and 'bags' which I take to mean handbags. There is no reference to either purses or wallets.

17. Exhibit GF9 comprises undated images of some of Unisa America's shop fronts. The locations of the particular shop fronts featured are not disclosed, although the declarant states they have 22 retail stores in Europe.

18. Exhibit GF10 comprises a spreadsheet showing sales and turnover figures for each EU member state and their oversea territories between 2012 and 2017. It is unnecessary for me to replicate that level of detail here but the declarant has helpfully set out a table (see below) of their sales, broken down with reference to each of the claimed class 18 and class 25 goods. However, although purses and wallets are featured in the table, there is no evidence in the exhibits submitted of use on these specific goods.

	2012	2013	2014	2015	2016	2017 (to 31 Oct)
Bags/purses/wallets (€)	435,422	555,856	593,760	715,249	908,198	941,887
Footwear (€)	50,278,362	51,291,244	54,333,187	59,110,334	59,916,708	51,667,659
Total (€)	50,713,784	51,847,100	54,926,947	59,825,583	60,824,906	52,609,546

19. Exhibit GF11 comprises a selection of screenshots dated December 2017 from Unisa America's European website www.unisa-europa.com with images of footwear and handbags priced in pounds sterling. There are no images of purses or wallets.

20. Exhibit GF12 comprises a list of 1289 stockists and retailers who sold Unisa America's class 18 goods between 2012- 2017. The declarant states that class 18 goods were sold in 20 of the 28 EU member states during this period.

21. Exhibit GF13 comprises screenshots dated December 2017 of the John Lewis and the Amazon UK retail websites selling Unisa America's footwear and handbags priced in pounds sterling. There are no images of purses or wallets.

22. Exhibit GF14 comprises screenshots dated December 2017 of various UK stockists and retailers who sell Unisa America's goods.

23. Exhibit GF15 comprises a map of the UK and a list of outlets indicating where Unisa America's goods are sold. These include outlets in Northern Ireland, Wales, Scotland and throughout England.

24. Exhibit GF16 comprises a selection of advertisements for footwear and handbags from various publications which were published in the EU dated between 2013-2017.

25. Exhibit GF17 comprises photographs of celebrities which the declarant states are wearing Unisa America's goods. However, in only one of the photographs (of Jenn Murray) are the goods, in this case shoes, attributed to Unisa.

26. Exhibits GF18 is an article from the Swarovski Crystal website outlining a brand tie-in with Unisa America to apply its crystals as decorations to footwear. The article itself is undated although the declarant states that Unisa America and Swarovski have collaborated since 2009.

Proof of Use

27. Section 5 is applicable in invalidation proceedings because of the provision of section 47 of the Act. The first issue is whether, or to what extent, Unisa America has shown genuine use of its earlier marks. The relevant statutory provisions are as follows:

47. - (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

(2) The registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2A) But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

- (a) within the period of five years ending with the date of the application for the declaration the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes –

- (a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and
- (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(2D) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Union.

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

(3) An application for a declaration of invalidity may be made by any person, and may be made either to the registrar or to the court, except that-

- (a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and
- (b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(4) In the case of bad faith in the registration of a trade mark, the registrar himself may apply to the court for a declaration of the invalidity of the registration.

(5) Where the grounds of invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made.

Provided that this shall not affect transactions past and closed.

28. Section 100 of the Act is also relevant, which reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it”.

29. The relevant period is the five-year period ending on the date of the application for invalidity. Consequently, the relevant period under these provisions is 19 April 2012 to 18 April 2017.

30. When considering whether genuine use has been shown, I must apply the same factors as if I were determining an application for revocation based on the grounds of non-use. What constitutes genuine use has been subject to several judgements. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He said:

“217. *The law with respect to genuine use* . In *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch), [2013] FSR 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439 , Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I added references to Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237). I also referred at [52] to the judgment of the CJEU in Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16 on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and that Order has been persuasively analysed by Professor Ruth Annand sitting as the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd* (O/528/15).

218. An important preliminary point to which Prof Annand draws attention in her decision is that, whereas the English versions of Articles 10(1) and 12(1) of the Directive and Articles 15(1) and 51(1)(a) of the Regulation use the word “genuine”, other language versions use words which convey a somewhat different connotation: for example, “ernsthaft” (German), “efectivo” (Spanish), “sérieux” (French), “effettivo” (Italian), “normaal” (Dutch) and “sério/séria” (Portuguese). As the Court of Justice noted in *Ansul* at [35], there is a similar difference in language in what is now recital (9) of the Directive.

219. I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetzky-Orden v Bundesvereinigung Kameradschaft 'Feldmarschall Radetzky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v*

Centrotherm Clean Solutions GmbH & Co KG [EU:C:2013:592], [2014] ETMR 7, as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector

concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

31. As two of Unisa America’s marks are EU Trade Marks, the comments of the Court of Justice of the European Union (“CJEU”) in *Leno Merken BV v Hagelkruis Beheer BV*, Case C149/11, are relevant. It noted that:

“36. It should, however, be observed that [...] the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use”.

And

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark”.

And

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77)”.

32. The court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to 'genuine use' within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity".

Sufficiency of Use

33. Although some of the exhibits are undated or dated from December 2017 which is outside of the relevant period, clearly there has been use both in the UK and a number of other EU member states during the relevant period. The turnover is stated as approximately €50m in 2012 rising to €60m in 2016. Invoices confirm that there have been sales in the UK and the EU. Evidence was also provided by way of product catalogues and product placements in various publications. Overall I am satisfied that there has been genuine use of the word mark and the figurative mark set out in paragraph 2 of this decision.

Fair specification

34. The next stage is to decide whether Unisa America's use entitles it to rely on all of the goods for which it has made a claim. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

"In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of

the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

35. The evidence demonstrates that Unisa America has used its marks on footwear and handbags. No exhibits were provided to indicate use on either purses or wallets, the two other goods relied on in Unisa America’s UK TM. Neither is there any evidence corroborating sales of these two goods in the invoices provided in exhibit GF8. Therefore I find that Unisa America may rely on footwear in class 25 and handbags in class 18 in its specification.

Section 5(2)(b)

36. Section 5(2)(b) of the Act is 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.

37. The leading authorities which guide me are from the CJEU: *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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

38. The case law relating to the comparison of goods and services is set out below. In *Canon*, the CJEU 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”.

39. In *Gitana SA, v OHIM*, Case T-569/11, the General Court (‘GC’) stated that:

“45. Moreover, in respect of the relationship between the ‘goods in leather and imitations of leather’ in Class 18 covered by the trade mark sought and the goods in Class 25 covered by the earlier mark, it is apparent also from settled case-law that the ‘goods in leather and imitations of leather’ include clothing accessories such as ‘bags or wallets’ made from that raw material and which, as such, contribute, with clothing and other clothing goods, to the external image (‘look’) of the consumer concerned, that is to say coordination of its various components at the design stage or when they are purchased. Furthermore, the fact that those goods are often sold in the same specialist sales outlets is likely to facilitate the perception by the relevant consumer of the close connections between them and support the impression that the same undertaking is responsible for the production of those goods. It follows that some consumers may perceive a close connection between clothing, footwear and headgear in Class 25 and certain ‘goods made of these

materials [leather and imitations of leather] and not included in other classes' in Class 18 which are clothing accessories. Consequently, clothing, shoes and headgear in Class 25 bear more than a slight degree of similarity to a category of 'goods made of these materials [leather and imitations of leather] and not included in other classes' in Class 18 consisting of clothing accessories made of those materials (see, to that effect, *PiraÑAM diseño original Juan Bolaños*, paragraph 42 above, paragraphs 49 to 51; *exē*, paragraph 42 above, paragraph 32; and *GIORDANO*, paragraph 42 above, paragraphs 25 to 27)."

40. The goods to be compared are set out below.

Unisa America's goods relied on	Univa International's registered goods
18: handbags 25: footwear	25: clothing; headgear; swimwear; sportswear; leisurewear; clothing for children; infant wear; articles of clothing for women; sleepwear, lingerie; hosiery; nightwear; sports clothing; gymwear; beach clothing; belts [clothing]; underwear; gloves; men's and women's jackets, coats, trousers, vests

41. Although Univa International has no equivalent class 18, it is clear from the *Gitana* case outlined above that goods such as handbags are considered as similar to at least a medium degree to clothing because they are thought to be accessories for clothing and are generally sold in the same retail environment to the same consumers leading them to think that the respective goods are produced by the same undertaking.

42. Regarding class 25, I also find footwear to be similar to clothing per se and the various articles of clothing listed in Univa International's specification as they have the same purpose, the same consumers and will usually have the same channels of

trade as clothing. The relevant consumers are likely to think that the goods are produced by the same undertaking.

The average consumer and the purchasing process

43. I now consider who the average consumer is for the contested goods and how they are purchased. 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*.

44. 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.”

45. The contested goods here are clothing. The average consumer will be the general public. 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 GC stated:

“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.

53. 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.”

46. As stated by the GC, items of clothing vary in price and quality. Ordinarily I would expect a normal level of attention to be paid by the consumer when selecting such goods. The purchasing act will be mainly visual as the goods are commonly purchased on the basis of their aesthetic appeal, their fit and suitability for purpose. It is likely they will be selected after viewing of racks/shelves in traditional retail establishments, or from images on Internet websites or in catalogues. However, I do not discount any aural considerations, such as word-of-mouth recommendations which may also play a part.

Comparison of the marks


47. 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.”

48. 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 marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

49. The marks to be compared are:

Unisa America's marks	Univa International's mark
<p data-bbox="209 1245 384 1301">UNISA</p> 	<p data-bbox="724 1245 868 1301">Univa</p>

50. Unisa America's word mark is presented in capital letters and in plain font. The overall impression resides in this word. Its figurative mark is presented in a stylised curved font with the letter S tilted on an angle making it appear to slant to the right. The overall impression is based on this presentation.

51. Univa International's mark is presented in title case and in plain font. The overall impression resides solely in this word.

52. Regarding a visual comparison, the marks share U, N, I and A as their first, second, third and fifth letters. The fourth letter in each case is different; one being a letter V and the other an S. Indeed, the fourth letter S in Unisa America's figurative mark is markedly different in visual terms. But overall taking these factors into account I find there is a medium degree of similarity.

53. Turning to an aural comparison, Unisa America contends in its submission (paragraph 24) that,

"The only difference in the respective mark is the central letters 'S' and 'V' which, when pronounced in the context of the marks are aurally very similar. Given the above the marks are therefore aurally almost identical."

54. I am guided here by *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, when 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.

55. I find that the beginning of the marks in this case, that is the letters UNI, will likely be pronounced identically as YOU-NEE and the last letter A will share an AH sound. There is some slight difference between the pronunciation of an S and V, the S being a softer sibilant sound and the V a harder fricative sound. But overall, I find there is an aural similarity to a medium to high degree.

56. With regard to the conceptual comparison, the marks are invented words and as such have no concept. Therefore, I find them to be conceptually neutral.

Distinctiveness of the earlier marks

57. The distinctive character of the earlier mark must be considered. The more distinctive it is, either inherently or through use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular 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).”

58. Unisa America’s marks are invented words which have no meaning in relation to the goods so I consider them to be inherently distinctive to a high degree. Although evidence was filed showing use of the earlier marks, it does not put Unisa America in any stronger position with regard to the distinctiveness of the earlier marks.

Likelihood of confusion

59. I now draw together my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors and those outlined in paragraph 37:

- a) The interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon*).
- b) The principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*).
- c) Imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer*).

60. Confusion can be direct (when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related).

61. Further I note in *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C., sitting 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.”

62. 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.

63. So far, I have found the contested goods are similar to a medium degree and that an average consumer will pay a normal degree of attention in a primarily visual purchasing process. I have also found that the marks are conceptually neutral but are visually similar to a medium degree and aurally similar to a medium to high degree.

64. Based on the marks and the goods before me and considering the assessments I have made and the comments in the *Kurt Geiger* case set out above, I find that there is a likelihood of direct confusion. There is a single letter difference between the marks and it is contained in the middle of the respective words. This single letter difference could be easily overlooked and lead to one mark being mistaken for the other. I refer back to bullet point (b) in paragraph 37 regarding the consumer rarely

having the chance to make direct comparisons between marks but instead relying on an imperfect recollection. I consider that to be the case here.

Section 5(3)

65. As the invalidation is successful in its entirety based upon section 5(2)(b), there is no need to consider the remaining section 5(3) ground as it does not materially improve Unisa America's position.

Conclusion

66. The application for invalidation has succeeded in full and class 25 of the registered mark is declared invalid. The remainder of the classes are unaffected and remain registered.

Costs

67. As Unisa America has been successful in its application to invalidate class 25 of the registered mark, it is entitled to a contribution towards the costs incurred in these proceedings. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. Bearing in mind the guidance given in TPN 2/2016, I award costs as follows:

£200 official fee for filing form TM26(I) invalidity application

£200 preparing statement of grounds

£400 preparing written submissions and considering other party's submissions

£800 preparing evidence

£1600 total

68. I order Univa International Ltd to pay Unisa America, Inc the sum of £1600. This sum is to be paid within 14 days of the expiry of the appeal period or within 14 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 3rd day of September 2018

**June Ralph
For the Registrar,
The Comptroller General**