

O-154-17

TRADE MARKS ACT 1994

IN THE MATTER OF AN APPLICATION
BY OJW ENTERPRISES LIMITED
TO REGISTER No 3330128:



X
O L I V E R

IN CLASS 25:

AND OPPOSITION THERETO UNDER NO 414470
BY MCFL HOLDINGS LIMITED, OLIVER SWEENEY BRANDS LIMITED
AND OLIVER SWEENEY TRADING LIMITED

BACKGROUND

1. On 8 August 2018, OJW Enterprises Limited (the applicant) applied to register the above trade mark in the following class:¹

Class 25

Footwear; Footwear for men.

2. The application was published on 24 August 2018, following which MCFL Holding Limited, Oliver Sweeney Brands Limited and Oliver Sweeney Trading Limited (the opponents) filed a notice of opposition against all of the goods in the application.

3. The grounds of opposition are:

(i) Under s. 5(2)(b) of the Trade Marks Act 1994 (the Act) because there is a likelihood of confusion between the opponents’ earlier marks and the application used for identical or similar goods.


(ii) Under s.5(3) of the Act because the opponents’ earlier marks are identical with or similar to the application, the opponents have a reputation and the use of the later mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

(iii) Under s.5(4)(a) of the Act because the opponents have goodwill in an earlier sign which prevents the registration of the application, use of which would amount to a misrepresentation which would cause damage to the opponents.

4. Under section 5(2)(b) the opponents rely upon the following trade marks and goods:

Mark details and relevant dates	Goods relied upon
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¹ International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).

<p>EUTM: 4249199</p> <p>OLIVER SWEENEY</p> <p>Filed: 20 January 2005 Registered: 21 March 2006</p>	<p>Class 25</p> <p>Footwear; shoes; boots; half-boots; sports shoes and boots.</p>
<p>UKTM: 1333187</p>  <p>Filed: 27 January 1988 Registered: 17 August 1990</p>	<p>Class 25</p> <p>Footwear</p>
<p>UKTM: 2380566</p> <p>OLIVER SWEENEY</p> <p>Filed: 17 December 2004 Registered: 3 June 2005</p>	<p>Class 25</p> <p>Footwear; shoes; boots; half-boots; sports shoes and boots.</p>
<p>UKTM: 2552301</p> <p>OLIVER SWEENEY</p> <p>Filed: 8 July 2010 Registered: 8 October 2010</p>	<p>Class 35</p> <p>The bringing together, for the benefit of others, of a variety of goods, enabling customers conveniently to view and purchase those goods from a retail store environment, including by mail order or via a global communications system, specialising in the sale of footwear.</p>
<p>IR: 1069002</p> <p>OLIVER SWEENEY</p> <p>Date of designation of EU: 20 November 2010</p> <p>Date protection granted in the EU: 31 January 2012</p>	<p>Class 25</p> <p>Footwear; shoes; boots; half-boots; sports shoes and boots.</p> <p>Class 35</p> <p>The bringing together, for the benefit of others, of a variety of goods, enabling customers conveniently to view and purchase those goods from a retail store environment, including by mail order or via</p>

Priority date: 8 July 2010 (UK)	a global communications system, specialising in the sale of footwear.
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5. Under section 5(3) of the Act the opponents rely on three of the marks shown in the table above. These are EUTM 4249199, UKTM 1333187 and IR 1069002 which the opponents claim have a reputation for footwear.

6. For the purposes of the opposition under section 5(4)(a) of the Act, the opponents rely upon the following sign:

Oliver Sweeney

7. The opponents claim that the sign has been used since October 2009, throughout the UK, for footwear.

8. The applicant filed a counterstatement in which it denies the opponents' claims under all of the pleaded grounds and requested the opponents show proof of use of their UKTM 1333187. Proof of use was not requested for the other marks relied on by the opponents.

9. The opponent filed evidence. The applicant filed submissions, dated 9 August 2019. The opponents were represented by Bryers LLP. The applicant represented itself.

EVIDENCE AND CONCLUSIONS

10. The opponents' evidence is provided by Christopher Webster, the Managing Director of Oliver Sweeney Trading Limited. Fourteen exhibits marked CW1-CW14 are attached to Mr Webster's statement, which is dated 11 June 2019.

11. Mr Webster describes the opponents as 'affiliated companies and subsidiaries with a licence agreement in respect of the intellectual property.' He refers to the opponents jointly as Oliver Sweeney, throughout his statement.

12. Mr Webster says the following, with regard to the establishment of the company and its ethos:

“5. The company was started by Mr Oliver Sweeney in 1989, with the production of luxury footwear. In 2009 the product range expanded to include clothing, accessories and a collection for women. Our business philosophy is to ‘create classic timeless styles with a modern twist of something special; design beautiful shoes and have them made by the best shoemakers in the world from the finest materials.’ We combine classic shoemaking techniques with 21st century technology and innovation.”

13. He describes Oliver Sweeney as, “...a leading manufacturer of luxury footwear, clothing and accessories, including wallets, leather bags, keyrings, luggage tags, belts, socks, scarves, hats.”²

14. Mr Webster states that in 2005 the opponents launched an elite custom-made shoe service. He also gives details of a number of other products which have been added to the opponents’ range over the years, including leather wallets and luggage (1999), belts, socks and clothing (2004) and fragrance and knitwear (2015).

15. Mr Webster provides the following figures for turnover and advertising expenditure:

Year:	Turnover (£ Millions)	Expenditure (£)
2013/14	7.03	280,000
2014/15	7.71	468,000
2015/16	8.62	633,000
2016/17	8.73	533,000
2017/18	8.88	458,000

16. Mr Webster submits that the opponents’ trade marks regularly appear in national press and fashion magazines which include, The Observer, Elle, Esquire, Evening Standard, The Independent, The Sunday Times, GQ, The Telegraph, Time Out

² See paragraph 4 of Mr Webster’s witness statement.

London, Vogue and Hello!. This is supported by the evidence which shows, for example,

- a feature in the Evening Standard, dated 8 September 2014, about Oliver Sweeney's Hasketon Brown Derby Brogue under the heading 'Must-have men's shoes';
- an article from Esquire, dated 15 August 2014, about the Oliver Sweeney Hawby Chestnut Derby Brogue; and
- a feature, dated 25 November 2012, in the Observer magazine about the opponents' tan brogue.³

17. The opponents have six stores in London, Leeds, Manchester and Portsmouth. Their website domain name oliversweeney.com was registered on 18 April 2000. The opponents have a *Facebook* page which was created on the 29 July 2010 with the username @oliversweeney. It has more than 29K followers. Their *Instagram* page was created approximately March 2012 and has more than 30K subscribers. The opponents' *You Tube* page was created approximately June 2011 and has 1.3K subscribers. Its *Twitter* page was created June 2009 and has more than 15K followers.⁴

18. Mr Webster submits that the opponents' brand is sought by many celebrities who purchase and endorse the opponents' goods. These include, inter alia, Brad Pitt, Noel Gallagher, Will Smith, Sir Matthew Pinsent, Prince Harry, Boris Becker, Gary Barlow, Matt Smith, Sir Mo Farah, Will Young. He further submits that the opponents' branding appears on the inside and outside of the products which means they can be seen on television and in the press.⁵ The examples shown in evidence include 'Oliver Sweeney' in the description but cannot be seen on the goods themselves.

19. In 2003 Oliver Sweeney was the official provider of shoes for the England Rugby World Cup Team. In 2006 the opponents were the official provider of shoes to the English Cricket Team and in 2013 they embarked on a partnership with Saracens Rugby Team which continues to date.

³ See exhibit CW10.

⁴ See paragraphs 16-20 of Mr Webster's witness statement and exhibit CW9.

⁵ See exhibit CW11.

20. Mr Webster submits that in the last 10 years Oliver Sweeney has, 'embarked on many collaborations with other companies.' He says:

"...For each of these collaborations as is normal in the fashion industry we have used an 'X' to indicate such a collaboration..."

Jaguar – British car manufacturer	2013
Agi & Sam – catwalk collection	2013
Johnnie Walker – spirit producer	2014
School of Life	2014/15
Billam Jeans	2015 to date
Tallisker	2017
Nadav Kander	2017/18
Marcus Wareing	2018
Levison Wood	2018

21. Mr Webster says of the application (reproduced as written):

"27. We first became aware of the brand in August 2018, before the application of the trade mark when a third party @Menfashionista confused the brand in question with the Oliver Sweeney brand (Exhibit CW14)[...This] clearly indicates that the use of the mark has already caused confusion in the market and if this will mark was to proceed to registration there be further incidence of confusion in the market which is likely to cause damage and dilute our brand."

Conclusions from the opponents' evidence

22. The opponent established a footwear brand in 1989. Other products have been added to its range over the years but it is the footwear business which is the substantial part. There is evidence of the marks in use for clothing but I do not intend to consider it in any detail as the application is only made in respect of footwear and it is the opponents' footwear business which represents their strongest case given that it is identical to the applicant's goods.

23. In terms of the marks used, the store fronts, packaging and wrapping used for the goods all display the following sign:

Oliver Sweeney

24. The footwear goods bear the same sign on the outer sole and on the inside sole of each shoe. There is use of this sign and the opponent's plain word OLIVER SWEENEY marks in the brochures, in media commentary and advertising and on the sample sales receipts which have been provided.

25. The turnover figures are substantial, being in excess of £7 million each year since 2013, but they have not been broken down by category. However, the evidence is such that I am content to conclude that even if the opponent's footwear business were only half of its total sales (and I suspect it is a higher proportion), this is still a considerable turnover. This and the evidence of longevity, celebrity endorsement, advertising, sponsorship and press coverage means that the opponents have shown that they have had a considerable business under the Oliver Sweeney brand in the relevant period, with an emphasis on footwear.

26. I turn now to consider the particular marks used and what this means for the grounds relied on by the opponents.

Goodwill for the purposes of 5(4)(a)

27. The sign relied on by the opponents for their passing off claim under s.5(4)(a) is the one which the evidence shows is used most often on store fronts, brochures, advertising and the goods themselves:⁶

Oliver Sweeney

⁶ Since this opposition was filed the opponents have applied for and registered this mark, though it has no bearing on this opposition case as it has a later date than the contested application.

28. The evidence shows use of the sign from at least September 2012,⁷ and I have no hesitation in finding that the opponents' had strong goodwill in this sign, throughout the UK, at the relevant date.

Proof of use under s.5(2)(b)

29. In its counterstatement, the applicant did not request the opponents prove use of their plain word registrations for OLIVER SWEENEY. The opponents are therefore allowed to rely on these registrations for all of the goods and services for which they are registered.

30. I note also that the evidence includes use of the OLIVER SWEENEY marks in title and lower case. It is well established in trade mark law that such use is well within the bounds of fair and notional use of a mark registered in capital letters and I find that to be the case.

31. The opponent's marks are earlier marks which are subject to proof of use. This is because at the date of publication of the application, they had been registered for five years.⁸ However, the applicant only requested the opponents prove use for their UKTM 1333187 which appears as follows:

The image shows a handwritten signature in cursive script. The word 'Oliver' is written in a large, flowing style, and 'Sweeney' is written below it, also in cursive. The signature is centered on the page.

32. There is no use of this mark shown in the evidence filed by the opponents.

33. I will now consider whether use of this mark:

⁷ See exhibit CW7 which includes billboard advertising showing the sign and related comments on Instagram dated September 2012.

⁸ See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004: SI 2004/946) which came into force on 5th May 2004.

Oliver Sweeney

is:

(i) an acceptable variant of the opponents' OLIVER SWEENEY trade marks and

(ii) whether it is an acceptable variant of:



Point (i)

34. The presentation itself is a cursive version of the words OLIVER SWEENEY, which will be seen as a full name made up of a first name and surname. It is often used, inter alia, in black, on a contrasting background and there is also evidence of the sign embossed on the soles of the footwear goods and printed inside (in a colour which contrasts with the lining material). All of the examples in evidence show both words in the same colour and size with neither of them given any greater prominence. In my view, the use shown is within the parameters of fair and notional use of the registered mark.⁹ However, if I am found to be wrong in this, the law in relation to use of a mark in a differing form was considered in *Nirvana Trade Mark*, in which Mr Richard Arnold Q.C. (as he then was) as the Appointed Person summarised the test under s.46(2) of the Act as follows:¹⁰

"33.The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character.

⁹ See *Sadas v OHIM*, T-346/04 and *Peak & Cloppenburg v OHIM*, T-346/04 concerning marks presented in cursive form.

¹⁰ S.46(2) states: "For the purpose of subsection (1) use of a trade mark includes use in a form (the 'variant form') differing in elements which do not alter the distinctive character of the mark in the form in which it was registered..."

As can be seen from the discussion above, this second question breaks down into the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

35. The distinctive character of the registered mark rests in the words OLIVER SWEENEY, which will be seen as a full name. The presentation of the words in the cursive style shown in evidence will still be seen by the average consumer as simply the name OLIVER SWEENEY with no material added or subtracted which alters its concept or pronunciation. The presentation is such that it is easy to read. The fact that the average consumer would notice the change of typeface does not automatically lead to a finding that the distinctive character of the registered mark has been altered. In both presentations the distinctive character resides in the name OLIVER SWEENEY. I find the use of the cursive version to be an acceptable variant which does not alter the distinctive character of the mark as registered.

Point (ii)

36. In my view, the same cannot be said of the earlier cursive trade mark relied upon by the opponents. Whilst it is still the name Oliver Sweeney, the consumer must work harder to read the first name. The letters between 'O' and 'er' are less obvious than they are in the cursive version which has been used by the opponents. In addition, the presentation is curved and the second word is underlined. The first of these factors is fairly insignificant, but the underlining of 'Sweeney' serves to emphasise it in a way which cannot be seen in the cursive mark which has been used, where both 'Oliver' and 'Sweeney' have equal weight and emphasis in the mark as a whole.

37. Accordingly, I do not find that the cursive mark used by the opponents can be held to be an acceptable variant of the earlier registered cursive mark on which the opponents rely.

38. In short, the opponents may rely on their 'OLIVER SWEENEY' marks under s.5(2)(b), for which *Oliver Sweeney* is an acceptable variant.

The opponents may rely on their OLIVER SWEENEY marks IR1069002 and EU424199 under s.5(3) for which *Oliver Sweeney* is an acceptable variant and they may rely on the unregistered sign *Oliver Sweeney* under s.5(4).

DECISION

39. I will deal first with the opposition under section 5(2)(b) of the Act, which states:

“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.”

40. 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.”

Section 5(2)(b) case law

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

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

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

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

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

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

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

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

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

The average consumer and the nature of the purchasing act

42. In accordance with the above cited case law, I must determine who the average consumer is for the goods and services at issue and also identify the manner in which they will be selected in the course of trade.

43. 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*¹¹, Birss J. described the average consumer in these terms:

¹¹ [2014] EWHC 439 (Ch)

“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 word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”

44. The average consumer for footwear is a member of the general public. The goods may be bought from a bricks and mortar store, where the selection is likely to be made by the consumer from a shelf. They may also be bought from a website or mail-order catalogue, where the consumer will also select the goods visually. I do not rule out that there may be a verbal element to the purchase where the consumer seeks advice or uses a custom service.

45. The level of attention paid to the purchase will vary depending on the nature of the goods. Footwear will include expensive bespoke footwear of the type provided by the opponents’ custom shoe services and also cheaper ‘off the shelf’ footwear, which themselves may vary in cost from a few pounds to many hundreds of pounds. Both parties’ specifications include goods across the full range of cost and exclusivity and I find that, allowing for the full range of possible goods, the level of attention paid to the purchase will be at least average, to ensure, inter alia, the correct materials, size, style and fit.

Comparison of goods

46. The application is made for ‘footwear’ and ‘footwear for men’. The first of these is identical to the term ‘footwear’ which is included in the specifications of all of the opponents’ earlier marks. ‘Footwear for men’ is included within the broader term ‘footwear’ in the earlier marks and is identical on the *Meric* principle which is defined in the following terms:

47. In *Gérard Meric v Office for Harmonisation in the Internal Market*,¹² the General Court (GC) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

Comparison of marks

48. 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.”

49. It would be wrong, therefore, to dissect the trade marks artificially, 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. The competing marks are:

Opponents’ mark(s)	Applicant’s mark
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¹² Case T- 133/05



50. The application comprises a circular device which contains cursive script letters which slant upwards and to the right. The first letter is clearly a letter 'O'. The second could be an 'L' (lower case) or an 'e', the third could be 'i', 'r' or 'v'. In the context of the mark as a whole, which includes the word 'OLIVER' it is likely to be seen as 'Oli'. Below the circle is a letter X or a kiss and below that is the word 'OLIVER' in upper case. The device and the word 'OLIVER' make an equal contribution to the mark, with the letter 'X' playing a slightly smaller role, given its size and position.

51. The opponents' marks consist of two elements: OLIVER and SWEENEY. Neither is presented in a way which makes it stand out more than the other (beyond OLIVER being the first part of the mark). The combination means that the average consumer will see the mark as referring to one individual. The overall impression rests in the mark as a whole.

Visual and aural comparisons

52. With regard to visual similarity the opponents submit that OLIVER is present in both parties' marks and that 'Oli' in the application is contained within the opponents' marks. Further, they submit that both parties' marks, "...share the 'Oli' element at the prefix of the mark". They go on to contend that the stylisation of the 'Oli' element in the application is highly similar to the opponents' earlier cursive trade mark and conclude that for the relevant consumer, "more emphasis would be placed on the prefix".¹³

¹³ See page 2 of the statement of grounds attached to the TM7.

53. I have already concluded above, at paragraphs 32 and 37, that the opponents are unable to rely on the earlier registered cursive mark. However, even if they could rely on it, I do not find it helpful. In neither mark are the letters 'Oli' a prefix. The application contains the stylised letters in a circle at the top of the mark, forming a device element. This cannot be considered a 'prefix'. The opponents' marks all take the form of the name, 'Oliver Sweeney', in plain text and in a regular cursive typeface. The first three letters of the first name 'Oliver' are exactly that, the first three letters of a name which will be easily understood by the average consumer. They are not a prefix. It is well understood that mark comparisons must have a mind to marks in their totality and must avoid artificial dissection of those marks. Removing the first three letters of a name and comparing them to a separate device in another mark is to my mind a clear example of artificial dissection of marks.

54. Visual similarity rests in the fact that both parties' marks contain the name OLIVER. Visual differences rest in addition of the circular device and 'X' in the application and the word 'SWEENEY' after the word OLIVER in the earlier marks. I find these marks to be visually similar to a low to medium degree.

55. The opponents make a similar argument based on the 'prefix' of their marks when considering the aural similarity and conclude that the marks are aurally highly similar. I disagree. The opponents' earlier marks will be articulated as the name 'OL-I-VER' and 'SWEE-KNEE'. The application is likely to be pronounced 'OL-EE' 'EX' 'OL-I-VER' or, 'X' 'OLIVER' if the consumer elects not to pronounce the letters in the circular device. I find these marks to be aurally similar to a medium degree.

Conceptual comparison

56. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.¹⁴ The assessment must be made from the point of view of the average consumer who cannot be assumed to know the meaning of everything.¹⁵

¹⁴ This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.

¹⁵ See the comments of Anna Carboni, sitting as the Appointed Person in *Chorkee, BL O/048/08*, paragraphs 36 and 37.

57. With regard to conceptual similarity, the opponent submits that in the footwear field, “it is normal practice to use the character ‘x’ to demonstrate a collaboration between two parties.” No evidence has been filed in support of this submission. The opponents are, in effect, asking me to take judicial notice of the fact that ‘we all know’ that ‘x’ means a collaboration. I refer to the *Chorkee* case¹⁶ in which Anna Carboni, sitting as the Appointed Person, stated in relation to the word CHEROKEE:

“36...By accepting this as fact, without evidence, the Hearing Officer was effectively taking judicial notice of the position. Judicial notice may be taken of facts that are too notorious to be the subject of serious dispute. But care has to be taken not to assume that one’s own personal experience, knowledge and assumptions are more widespread than they are.

37. I have no problem with the idea that judicial notice should be taken of the fact that the Cherokee Nation is a Native American tribe. This is a matter that can easily be established from an encyclopedia or internet reference sites to which it is proper to refer. But I do not think that it is right to take judicial notice of the fact that the average consumer of clothing in the United Kingdom would be aware of this. I am far from satisfied that this is the case. No doubt, some people are aware that CHEROKEE is the name of a native American tribe (the Hearing Officer and myself included), but that is not sufficient to impute such knowledge to the average consumer of clothing (or casual clothing in the case of UK TM no. 1270418). The Cherokee Nation is not a common subject of news items; it is not, as far as I am aware, a common topic of study in schools in the United Kingdom; and I would need evidence to convince me, contrary to my own experience, that films and television shows about native Americans (which would have to mention the Cherokee by name to be relevant) have been the staple diet of either children or adults during the last couple of decades.”

58. Consequently, I am unable to take judicial notice of it. It is not the type of notorious fact that can be accepted without evidence of it. In my view, some average consumers would know the reference, but I am unable, without evidence, to conclude that their

¹⁶ BL O-048/08

numbers would be significant. It is more likely that the average consumer will see it as the letter 'x' with a meaning which in the context of the whole mark, is not clear. Alternatively, it may be seen to represent a kiss.

59. There is a clear point of similarity with the shared forename OLIVER, which is the last word of the application and the first in the earlier marks. But there are also obvious differences, namely, the device element and the 'x' in the application and the second word (name) 'SWEENEY' in the earlier marks.

60. The two names OLIVER and SWEENEY are most likely to be considered to refer to a first name and surname. The conceptual impression that the average consumer will take from the two names will be that of a specific individual, namely, an OLIVER whose surname is SWEENEY. The combination of elements in the application are the forename OLIVER, an 'x' and a cursive element, which will most likely be seen as 'Oli' being a shortened form of Oliver. The conceptual impression is simply that the mark is something to do with the first name Oliver. It does not relate to or identify a particular individual. Any conceptual similarity is low to medium.

Distinctive character of the earlier mark

61. 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 and services for which it has been used as coming from a particular undertaking and thus to distinguish those goods and services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger*.¹⁷

62. 'OLIVER SWEENEY' will be seen as a name. In the context of goods which are footwear this is likely to be taken to mean the designer or brand owner/originator. The mark has a medium degree of inherent distinctive character.

63. The evidence filed by the opponent shows a long-standing trade in footwear throughout the UK (over several decades). There has been prominent use of the

¹⁷ *Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.*

OLIVER SWEENEY trade marks throughout this time and turnover and advertising figures are significant. The evidence shows that the opponents have enhanced the distinctive character of their marks to a higher than medium degree.

Likelihood of confusion

64. The factors assessed so far have a degree of interdependency¹⁸ and a global assessment of them must be made when determining whether a likelihood of confusion exists.¹⁹ It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

65. The parties' goods are identical, all being footwear. The marks have a low to medium degree of visual and conceptual similarity and are aurally similar to a medium degree. I have found the average consumer to be a member of the general public and the level of attention paid to the purchase to be at least average. The purchase will be primarily a visual one, though I do not rule out aural considerations. The earlier mark has a medium degree of inherent distinctive character which has been enhanced due to the use made of it.

66. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. The differences between the parties' marks are too great for there to be direct confusion. I do not find that the average consumer would mistake one mark for the other.

67. The concept of indirect confusion was explained by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc.*,²⁰ as follows:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has

¹⁸ *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc.*, C-39/97, paragraph 17

¹⁹ *Sabel BV v. Puma AG*, C-251/95, paragraph 22

²⁰ BL O/375/10.

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

68. In *Duebros Limited v Heirler Cenovis GmbH*, the Appointed Person emphasised the importance of envisaging the instinctive reaction in the mind of the average consumer when encountering the later mark with an imperfect recollection of the earlier. Ultimately, the assessment is whether the average consumer will make a connection between the marks and assume that the goods or services in question are from the same or economically linked undertakings. He stressed that a finding of indirect confusion should not be made simply because the two marks share a common element. He pointed out that it is not sufficient that a mark merely calls to mind another mark as this is mere association not indirect confusion.

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

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

70. 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.

71. With regard to trade marks which are made up of names, I bear in mind the comments of Mr Daniel Alexander QC, sitting as the Appointed Person, in *Pia Hallstrom*,²¹ where at paragraph 37, when summing up the nature of the overall evaluation that had to be made, he stated:

“Moreover, if a trader chooses a forename as a trade mark, the average consumer is not particularly likely to think that another trader who uses a full name incorporating that forename is thereby denoting goods or services from the first undertaking rather than those connected with someone else who happens to share that forename. That is a problem which arises as a result of a choice of mark which, precisely because it is a name which others either do or could reasonably wish to use to denote themselves, does not start high on the distinctiveness scale. Large-scale use of such a mark does not, as such, enhance its distinctiveness in a relevant way, namely so as to increase the likelihood of confusion (see above).”

72. I have found that the opponents have increased the distinctive character of their earlier marks by the use made of them. However, it is important to remember that the distinctiveness rests in the whole mark, ‘Oliver Sweeney’, which clearly identifies a single individual. The common element ‘OLIVER’ is a fairly common forename. The average consumer will not put the sharing of that name down to the responsible undertakings being the same or being related. They will put the commonality down to a co-incidental sharing of a not uncommon male forename with nothing to suggest a same-stable relationship. The addition of the ‘Oli’, the shortened form of the same name and the ‘x’ in the application and the removal of the second name ‘Sweeney’,

²¹ *BL O/303/17*

are not changes which would lead the average consumer to consider either mark to be a brand extension of the other. Furthermore, it is safe to conclude that in the footwear industry, in my experience, the use of peoples' names used to denote the brand origin of goods is not unusual and accordingly, the average consumer is used to distinguishing between them. As Mr Alexander stated in *Pia Hallstrom*, 'the average consumer is not particularly likely to think that another trader who uses a full name incorporating that forename is thereby denoting goods or services from the first undertaking rather than those connected with someone else who happens to share that forename". This is applicable in the case before me.

73. In making this finding I have borne in mind the opponents' evidence of actual confusion. One example is provided in which an Instagram fashion page posted a photograph of the applicant's goods and tagged the opponent into the message. It is not clear whether or not the page is a customer of the opponents, but a single example does not seem to indicate a quantitatively significant level of confusion. A finding of no likelihood of confusion by a hearing officer, weighing up all of the competing factors, does not mean that there can never be a single instance of confusion in the marketplace. The legal test used to identify the average consumer, by definition, excludes the least attentive consumers who are the most likely to be confused. I do not find that this exhibit disturbs my finding.

The opposition under section 5(2)(b) fails.

The opposition under s.5(3)

74. The opponent clearly has the necessary reputation to get an opposition based on s.5(3) off the ground.²² That reputation is for footwear. I bear in mind that a finding that there is no likelihood of confusion under s.5(2)(b) does not mean that a case under s.5(3) is bound to fail, but it is a factor to consider. The UK public is used to distinguishing both individuals and undertakings by their given names. Consequently, the coincidence of the OLIVER element in both parties' marks, would not be sufficient to result in the necessary link being established where one mark refers to a non-specific use of OLIVER and 'Oli' and the other identifies a particular individual, 'OLIVER

²² See General Motors, Case C-375/97

SWEENEY'. Even if there was a 'bringing to mind' it would be so fleeting as to be insignificant. The opposition under s.5(3) fails.

The opposition under s.5(4)(a)

75. I have given much consideration to the opponents' position under this ground in determining whether or not there is a case to be made which improves their position under s.5(2)(b). There was certainly potential for that to be the case.

76. The opponents have provided evidence of a number of collaborations between Oliver Sweeney and other, often well-known, brands. In most examples the 'x' symbol has been used by the opponents to denote that collaboration. Had the opponents demonstrated that such a practice was one which their customers would associate with them, I would have gone on to consider whether the presentation of the application including that 'x' element led to a misrepresentation in the minds of the relevant public (being the opponents' customers for the purposes of the s.5(4)(a) assessment).

77. However, rather than pointing to use of 'x' being a practice reminiscent of the opponents, the opponents' submissions point out that this use of 'x' is common within the fashion (and footwear) industry, to the point where the average consumer will cease to give it any significance. Whilst there is no evidence of this being common practice, it is clear that the opponents are not making any claim to proprietary interest in the practice of using 'x' to denote a brand relationship. Consequently, I am unable to consider its only case under s.(5)(4)(a) which would advance its position beyond the finding I have already made under s.(5)(2)(b) and I decline to deal with the ground any further.

CONCLUSION

78. The opposition fails under sections 5(2)(b) and 5(3).

COSTS

79. The opposition having failed, the applicant is entitled to a contribution towards its costs. I bear in mind that the applicant filed minimal submissions relating to a trade mark application not relevant to these proceedings and that the decision was made from the papers.

80. I award costs on the following basis:

Preparing a counterstatement and considering the other side's statement: £400

Total: £400

81. I order Oliver Sweeney Brands Ltd to pay OJW Enterprises Limited the sum of £400. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 11th day of March 2020

**Al Skilton
For the Registrar,
The Comptroller-General**