

**DECISION OF THE CONTROLLER OF PATENTS, DESIGNS AND TRADE MARKS
IN PROCEEDINGS UNDER THE TRADE MARKS ACT, 1996**

In the matter of an application for the registration of Trade Mark No. 248182 and in the matter of an Opposition thereto.

Nike Innovate C.V.

Applicant

Intermar Simanto Nahmias


Opponent

The Application

1. On 4 December 2012 Nike Innovate C.V. (hereinafter “Nike”), of One Bowerman Drive, Beaverton, Oregon 97005-6453, United States of America made application (No. 2007/03077) under Section 37 of the Trade Marks Act, 1996 (“the Act”) to register JUMPMAN as a trade mark in respect of “*Clothing, footwear, headgear; including apparel, namely, pants, shorts, shirts, t-shirts, pullovers, sweat shirts, sweat pants, underwear, sports bras, dresses, skirts, sweaters, jackets, socks, caps, hats, visors, sweatbands, gloves, belts, hosiery, arm bands, coats, vests, jerseys, wind-resistant jackets.*” in Class 25.
2. The application was for the conversion of a Community Trade Mark application filed on 12 September 2007 and this earlier date is deemed to be the Application Date and, therefore, the relevant date for the purpose of these proceedings.
3. Notice of Opposition to the registration of the mark, pursuant to Section 43 of the Act, was filed on 4 April, 2013 by Intermar Simanto Nahmias (hereinafter “Intermar”) of Trakya Serbest Ticaret Bolgesi, Ali Riza Bey Cad, Lot No. 589 Parcel 1, Block 1, Catalca-Istanbul, Turkey. The Applicant filed a counter-statement on 8 July, 2013 and evidence was then filed under Rules 20, 21 and 22 of the Trade Mark Rules, 1996 (“the Rules”). The Opponent filed written submissions in lieu of attending at the Hearing, while the Applicant attended a hearing of the matter on 22 March, 2016.
4. Acting for the Controller, I decided to uphold the opposition and to refuse to allow the application to proceed to registration in respect of all goods. The parties were informed of my decision by way of letter dated 6 April, 2016. I now state the grounds of my decision and the materials used in arriving thereat in response to a request by the Applicant in that regard pursuant to Rule 27(2) of the Rules.

Grounds of the Opposition

5. In its Notice of Opposition the Opponent identifies itself as the Proprietor of the following two European Union Trade Marks:

European Union Trade Mark Registration No. 002752145	JUMP	Class 25: Footwear, socks.	Registration Date: 25 June 2002
European Union Trade Mark Registration No. 002752152		Class 25: Footwear (except orthopaedic footwear); socks.	Registration Date: 25 June 2002

6. The Opponent then raises objection to the present application under Sections 8 and 10 of the Act, which I shall summarise as follows:

Section 8(1)(b) – *the mark is devoid of any distinctive character;*

Section 8(3)(b) – *the mark is of such a nature as to deceive the public;*

Section 8(4)(b) – *the application was made in bad faith by the Applicant;*

Section 10(2)(b) – *the likelihood of confusion on the part of the public, and the likelihood of association with the Opponent’s earlier JUMP marks;*

Section 10(3) – *use of mark would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the Opponent’s marks;*

Section 10(4)(a) – *use of mark is prohibited by virtue of the law of passing off;*

Section 37 – *the Applicant’s mark is neither being used nor is there any bona fide intention to use it.*

Counter Statement



7. In its Counter Statement the Applicant denies all the grounds of opposition and calls on the Opponent to provide proof of genuine use of the two marks, the existence of which the Opponent claims would cause a likelihood of confusion in the marketplace. The Applicant also claims the Notice of Opposition filed by the Opponent is vexatious.

Rule 20 Evidence

8. Evidence filed by the Opponent under Rule 20 consists of a brief Statutory Declaration, dated 8 August 2014, of Simanto Hahmias, owner of Intermar, and four exhibits labelled “ISM1” to “ISM4”. Mr. Nahmias says his company is a very substantial manufacturer of

footwear and is using its trade mark JUMP in the European Union, namely in Bulgaria. He states the Opponent intends to use its trade mark in other parts of the European Union, including Ireland. The four exhibits attached to his declaration contain examples of invoices and catalogue extracts showing sales of footwear bearing the mark (“ISN1”), photographs showing use of the JUMP mark in a prominent retail unit (“ISN2”), examples of brochures showing an extensive range of footwear sold under the trade mark JUMP (“ISN3”) and examples of transit documents proving export of footwear from Turkey to Bulgaria (“ISN4”).

Rule 21 Evidence

9. Evidence submitted by the Applicant under Rule 21 consists of a Statutory Declaration, dated 20 March 2015, of Jaime Lemons, Manager of Nike, and eight accompanying exhibits marked “NICV1” to “NICV8”. Mr. Lemons states that Nike is the world’s leading manufacturer of sports shoes and apparel, and also carries on business in respect of a large variety of other goods, including headgear, bags, eyewear, watches and other electronic products, as well as other sports equipment.
10. Mr. Lemons says the mark JUMPMAN is associated with the famous Nike mark , which he claims is known as the Jumpman Design. The mark represents a silhouette of the famous basketball player Michael Jordan in action. He says the Jumpman Design was first used as early as 1987 and has been and is used and registered in many countries/territories, including the European Union. He attaches at “Exhibit NICV1” an extract from the European Union Trade Mark database in respect of the registration (No. 277913) of the figurative mark  for “*clothes, shoes, hats*” in Class 25, which was registered on 23 November 1998.
11. Mr. Lemons states that Nike is also the proprietor of European Union Trade Mark Registration No. 10150431 in respect of JUMPMAN23.COM, which was registered on 7 December 2011, also in respect of “*clothing; footwear; headgear*” in Class 25, details of which he attaches at “Exhibit NICV2”.
12. Mr. Lemons attaches at “Exhibit NICV3” an extract from *http://who.is* which shows that Nike Inc., the parent company of the Applicant, is the owner of the domain name

www.jumpman23.com which was registered on 15 December 1997 and has been accessible to Irish consumers for many years. He says Nike has been using the JUMPMAN23.COM website in connection with the JORDAN and JUMPMAN brands since at least as early as 1998, thus evidencing the long and close association between the JUMPMAN word mark and the famous Jumpman Design brand.

13. Mr. Lemons says the JUMPMAN word mark was first used by Nike in Ireland in 1999 and has been so used since that time. He claims sales figures in the order of USD \$107,000 from 1999 to 2012 in respect of goods bearing the mark JUMPMAN in Ireland, though he does not support this statement with any material evidence. He also states that Nike spent, and continues to spend, large sums of money advertising the products sold under the JUMPMAN mark. From 2006 through 2012 advertising expenditure relating to the promotion of JORDAN branded products, including products bearing the JUMPMAN word mark, throughout the world was in excess of USD \$273 million.
14. Mr. Lemons states the Opponent's JUMP European Union Trade Marks (EUTM's) were both registered in 2006. At that time and between 1994 and 2007 the approximate total sales of products bearing Nike's JUMPMAN mark in the EU were in excess of USD \$12,700,000. He says that, to the best of his knowledge, despite such sales there has not been any instance of confusion in the EU between the goods sold under the JUMPMAN mark and the Opponent's mark.
15. Mr. Lemons then turns to the Opponent's evidence under Rule 20. He states the claimed use by the Opponent of its marks in Bulgaria is not relevant to these proceedings and voices his suspicions the Opponent has included evidence of purported use in Bulgaria in the event it is put on proof of use of its EU Trade Marks. He then carries out an appraisal of the quality, quantity and probative value of the Opponent's evidence.
16. His appraisal centres on "Proof of Use" of the Opponent's marks and the extent to which the evidence submitted by the Opponent establishes whether there has been genuine use of the relied upon marks during the five-year period preceding 13 February 2013 (the date of publication of the applied for mark). He maintains that the evidence advanced by the Opponent to support use of its marks is so sparse, deficient and unclear that it is not sufficient to justify a finding that the Opponent's marks have been put to genuine use in the European Union during that period. He notes the Opponent has not produced anything to

indicate it advertised its marks and that the two invoices and the transit documentation submitted do not bear either of the marks relied upon. All materials are of very poor quality and cannot be deciphered. Also, all documentation appears to be in Turkish and no certified English translations were provided.

17. Mr. Lemons also provides his own evidence to counter some of the materials adduced by the Opponent. He notes the Opponent only appears to have sold goods to one trader in the EU - a footwear retailer located in the Paradise Centre in Sofia, Bulgaria. He points out that, of the nine photographs attached at "Exhibit ISN2", eight are of the interior of the retailer's footwear store, while the ninth shows the exterior of the Paradise Centre. He attaches at "Exhibit NIC4" an extract from the Paradise Centre's own website that shows the centre opened for business on 28 March 2013. This he says is well outside the five year period within which the Opponent is required to put the relied upon marks to genuine use and, therefore, this evidence should not be taken into account.
18. Mr. Lemons says the Opponent also opposed the Applicant's United Kingdom Trade Mark Application No. 2652113 JUMPMAN on the basis of the Opponent's EUTM No. 2752145 JUMP (one of the marks upon which the Opponent is relying in these proceedings) which covered the exact same goods as the instant Irish application. In deciding the matter the UK Intellectual Property Office (UKIPO) held that "*the very small scale, very geographically limited use shown, over just 16 months of the relevant 5 year period, is insufficient to constitute real commercial exploitation of the mark in the EU and therefore genuine use. The consequence of this is that the earlier mark cannot be relied upon in these proceedings and the opposition must, therefore, be dismissed.*" He attaches at "Exhibit NICV5" a copy of the UKIPO decision.
19. Mr. Lemons states the Opponent's mark JUMP consists of an ordinary dictionary word and he attaches at "Exhibit NICV6" an extract from Collin's English Dictionary which defines the word as "*to leap or spring clear of the ground or other surface by using the muscles in the legs and feet*". As the average consumer would normally jump whilst wearing footwear or socks, the mark is descriptive of the goods covered by the registration and has a low level of distinctiveness for those goods. This he says is further evidenced by the fact that the term JUMP is very common for trade marks covering footwear and socks and to support his assertion he attaches at "Exhibit NICV7" a list containing approximately 20 trade marks registrations (International Trade Mark registrations designating the EU or EU

or Irish marks) that incorporate the term JUMP and which are registered for footwear and/or socks.

20. Mr. Lemons says the Opponent also opposed the Applicant's Swiss Trade Mark Application No. 566121 JUMPMAN and the Swiss Federal Institute of Intellectual property found *"the common element 'JUMP' must be considered as weak element in relation to shoes, as it can evoke the quality and determination of these shoes, especially 'jumping shoes, sports shoes'. Hence, the two trademarks are identical only in this weak element. In such a case, even a small difference between the trade marks may be sufficient to avoid the likelihood of confusion. In this case the contested trade mark, which is a combination of the words 'JUMP' with another word 'MAN', must be considered as a new word element, phonetically and visual distinct from the separate word 'JUMP'. In addition, also the respective meanings of the two signs are different. In addition the cited mark includes special writing (bold font) and graphical representation (black dot and diagonal lines). Consequently, taking into account the fact that the common element JUMP has limited distinctive character in relation to the respective goods, the above differences are sufficient to avoid a likelihood of confusion despite the fact that the products are the same / similar."* He attaches at "Exhibit NICV8" a copy of the decision, which dismisses the opposition, together with an English translation.

21. He concludes his evidence by stating there have been no instances of confusion between the Opponent's JUMP mark and the Applicant's JUMPMAN mark in Ireland.

Rule 22 Evidence

22. Evidence filed under Rule 22 consists of a Statutory Declaration, dated 25 September 2015, of Peter MacLachlan, Trade Mark Attorney of MacLachlan & Donaldson, and one exhibit labelled "PM1". Mr. MacLachlan states that Mr. Lemons is clearly under the mistaken impression that the Opponent is required to prove that its trade mark has been used in the Community. There is no provision in the Trade Marks Act, 1996 which corresponds to provisions in the Community Trade Mark Regulations requiring an Opponent to provide proof of use of its trade mark in Ireland or in the Community, if the opposition is based on a trade mark which is more than 5 years old at the date of publication of the opposed application. He says under Rule 20, the Opponent merely established the fact that its trade mark has been used in the Community.




23. Mr. MacLachlan also refers to the UKIPO decision cited by Mr. Lemons and identified by him as concerning similar circumstances to those of the instant proceedings. Mr. MacLachlan says the two cases are substantially different in that, in the UK case, the Opponent was required to furnish proof of use under Section 6A of the UK Trade Marks Act, 1994. However, there is no corresponding provision in the Trade Marks Act, 1996. He adds that he is informed and verily believes the UK decision has been appealed.
24. Mr. MacLachlan acknowledges the Applicant's reference to the decision of the Swiss Federal Institute, but notes the Application has not referred to the judgment of the General Court of the European Union dated 25 May 2012, a copy of which he attaches at "Exhibit PM1". That decision upholds the European Union Intellectual Property Office's decision to refuse to allow the Applicant's JUMPMAN mark to proceed to registration on the basis of an opposition thereto founded on the Opponent's JUMP mark.
25. He concludes his evidence by stating he is informed and believes that decisions to the effect that the trade marks JUMP and JUMPMAN are confusingly similar have been rendered in the Opponent's favour in Lithuania, Estonia, Latvia, Bulgaria, Slovakia, Denmark, Hungary, Slovenia, Sweden, Czech Republic, Romania and France. He states he is also informed that these decisions have been appealed.

Preliminary Issues


26. Before turning to the substantive matter of these proceedings I must address a couple of preliminary issues. Firstly, the Opponent, in its evidence, questioned the extent of use of the Opponent's marks in Ireland and the European Union (EU) and the level of proof of such use. It is clear from the Opponent's evidence that it has made no use whatsoever of its marks in Ireland. It is also clear that the full extent of use of the Opponent's marks in the EU is confined to a single customer in Bulgaria. The level of use of the earlier marks is at the lowest possible level, but nonetheless, for the purposes of these proceedings it must be deemed "use".
27. The question of proof of use was also addressed by other national offices in parallel proceedings between the parties. The Applicant was successful in a number of those cases on the basis that the Opponent was required to provide proof of use of its mark(s) but failed to provide evidence that was deemed sufficient to justify the refusal of the registration of the Applicant's JUMPMAN mark. However, in other European Union jurisdictions the

Opponent successfully opposed the mark at issue. This case clearly highlights differences regarding how the competent authorities across the EU deal with similar cases and identifies the need for greater convergence in practice so that users will receive consistent results and will be able to predict with a greater degree of certainty the likely outcome of identical cases prosecuted before a number of authorities.

28. Unfortunately for the Applicant, the provisions of the 1996 Act do not allow me to consider “proof of use”. In that regard my hands are tied and I must reach a decision in this case on the basis that the Opponent has earlier marks, irrespective of whether or not those marks have been put to genuine use in Ireland or the European Union. Whether or not the “use” is sufficient to be declared “genuine use” is not a question that concerns me. That is a matter to be taken up by interested parties in cancellation proceedings before the EUIPO.

29. Secondly, the Applicant sought at every opportunity to link its JUMPMAN mark to its figurative trade mark  and its JUMPMAN23.COM trade mark, and its long-standing use of both. The Applicant is clearly attempting to claim a right to register its JUMPMAN mark on the basis of prior rights in these other two marks. However, while consumers may identify the  logo mark as Michael Jordan in silhouette, or as the trade mark for Nike’s Jordan or Air Jordan ranges of goods, I am not satisfied that the evidence shows that, outside of Nike, the logo is actually known as “the JUMPMAN”. Also, I am not satisfied that the Applicant’s  logo is merely the mark at issue in figurative form as, in my opinion, it is a completely different mark.

30. The existence of the JUMPMAN23.COM mark, which is clearly further distanced from the Opponent’s JUMP mark than the Applicant’s JUMPMAN mark, does not, in the matter of these proceedings, provide any assistance to the Applicant. Little was offered by way of evidence to suggest Irish consumers are aware of the JUMPMAN23.COM trade mark, let alone bought any goods bearing it. All that was offered was evidence of the registration of the website www.jumpman23.com and a statement that Irish consumers could access the site. However, no evidence was offered to show that Irish consumers actually visited the site. In the absence of hard evidence, in my opinion, it is unlikely that Irish consumers are aware of this site and I am satisfied that if they were looking for Nike products they would most likely just visit the main www.nike.com site or known stockist of Nike goods.

31. In any event there is no specific provision in the Act to allow the registration of marks on the basis of an Applicant's earlier marks and, irrespective of the use and reputation of the Applicant's  and JUMPMAN23.COM marks, I must treat them as immaterial as regards the matter at hand.

Written Submissions and the Hearing

32. Peter MacLachlan filed written submissions on behalf of the Opponent, in lieu of attending at the Hearing, while at the Hearing the Applicant was represented by David Flynn, Trade Mark Attorney of FRKelly.

33. In its written submissions the Opponent concentrates solely on the ground of opposition in respect of Section 10(2)(b), which was in line with the approach adopted by the Opponent during the evidence filing phase. While the other grounds of opposition were neither supported by evidence nor argument they were not formally abandoned. However, I am completely satisfied that the only ground of opposition upon which I need to determine this matter is Section 10(2)(b). Therefore, without further ado, I dismiss the opposition in respect of all other grounds.

Section 10(2)(b) – likelihood of confusion

34. The relevant part of Section 10(2) of the Act, insofar as the present application is concerned, reads as follows:

(2) A trade mark shall not be registered if because –

(a) ...

(b) it is similar to an earlier trade mark and would 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 of the later trade mark with the earlier trade mark.

35. The principles of interpretation to be applied in determining an objection under Section 10(2)(b) of the Act are not in dispute. They have been set out in detail in several decisions of the Court of Justice of the European Union (CJEU)¹ and their applicability in an Irish context has been affirmed by the High Court (Finlay Geoghegan J) in *Cofresco*

¹ including Case No. C-251/95, *Sabel BV v Puma AG and Rudolf Dassler Sport*, Case No. C-39/97, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* and Case No. C-342/97, *Lloyd Schufabrik Meyer & Co. GmbH v Klijsen Handel BV*

*Frischalteprodukte GmbH & Co. KG –v- The Controller of Patents, Designs and Trade Marks and Reynolds Metals Company*². In summary, the principles are:

- (i) the likelihood of confusion must be appreciated globally, having regard to all of the relevant factors, including the degree of similarity between the marks and between the goods, the likelihood that the public will make an association between the earlier mark and the mark seeking registration, and the distinctiveness of the earlier mark;
- (ii) the similarity between the marks must be determined by reference to the degree of visual, aural and conceptual similarity between them and the importance to be attached to each of these elements must be assessed by reference to the category of goods and the circumstances in which they are marketed;
- (iii) the assessment must be made from the perspective of the average consumer of the goods in question, who must be deemed to be reasonably observant and circumspect but who rarely has the chance to make a direct comparison of the marks and must rely, instead, on the imperfect picture of them that he keeps in his mind;
- (iv) the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components, because the average consumer normally perceives a mark as a whole and does not analyse its various details;
- (v) the higher the distinctiveness of the earlier mark, whether inherent or acquired through use, the greater the protection granted to it, and vice versa.

36. There are four basic requirements which must be met in order for an objection under Section 10(2)(b) to succeed. The first of these conditions is there must be an earlier mark. The Opponent's European Union Trade Marks Nos. 2752145 and 2752152 share a registration date of 25 June 2002. By virtue of Section 11(1)(b) of the Act, they are earlier trade marks as against the present application for the purposes of Section 10.

37. The second requirement is there must be similarity between the goods. Looking at the specification of goods in Class 25 in respect of both parties' marks it is apparent the goods are identical as both specifications include footwear and socks (being items of clothing).

² Unreported decision dated 14 June, 2007

Similarity of the marks

38. Turning now to the third requirement: the mark applied for must be similar to the earlier mark. I have compared the respective marks on the criteria of visual, aural and conceptual similarity and have attempted to make an overall assessment of the extent to which they should be regarded as similar or different. It is important to stress that this is an assessment of the overall impression the marks make on me, having put myself in the shoes of the average consumer of the goods for which the Applicant seeks registration.
39. Notwithstanding the detailed comparisons I make below I am mindful that the CJEU has noted in *Sabel*³ that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. Having acknowledged that, the marks at issue are not complex and neither contains any specific points of detail that are likely to go unnoticed by the average consumer.
40. In their respective submissions, Mr. MacLachlan and Mr. Flynn conducted an assessment of the marks and reached different conclusions. Mr. MacLachlan argued the marks share a high degree of similarity because of the presence of the word JUMP at the beginning of both. On the other hand Mr. Flynn maintained that, because of the different length of the marks, the different number of syllables comprising each and the fact that the Applicant's mark contains two common words as against the single word of the Opponent's marks, the respective marks are visually and phonetically different. Also, Mr. Flynn argued that conceptually the marks are different.
41. In carrying out an assessment of the respective marks I am satisfied that I can confine my analysis to the comparison between the Applicant's mark and the Opponent's word-only mark JUMP. Of the Opponent's two marks, this mark is clearly visibly closer to the disputed mark than the Opponent's JUMP (logo) mark and there is no possibility that I would uphold the opposition on the basis of the logo mark while rejecting it on the basis of the word-only mark.
42. Clearly the marks share some visual similarity as both begin with the word JUMP. The only element that distinguishes the marks is the presence of the word MAN in the Applicant's mark. They are both depicted in uppercase characters using a plain and

³ *Sabel BV v Puma AG and Rudolf Dassler Sport Case C-251/95*

unremarkable typeface. In my opinion, from a visual perspective, the marks are far more similar than dissimilar and I would rate the level of similarity as high.

43. The aural difference between the marks is also centred on the inclusion, in the Applicant's mark, of the word MAN. Again, I find from an aural point of view, the marks are far more similar than dissimilar. I would assess the degree of aural similarity as medium high to high.

44. Furthermore, the fact that the shared visual and aural similarities are found at the start of the marks and, being mindful that consumers tend to place greater emphasis on the beginning of pure verbal marks than to their ending, this would accentuate the high level of similarity.

45. In his written submission Mr. MacLachlan argued the word JUMP has precisely the same meaning in each of the respective marks and therefore the marks are conceptually almost identical.

46. Mr. Flynn argued that, conceptually, the Opponent's mark will be understood by consumers as referring to the verb jump. Most people who jump wear footwear and socks to protect their feet when impacting with the ground. Therefore, he argued, JUMP on its own is of low distinctive character and is a weak mark for such goods because these goods would be closely associated with the act of jumping. On the other hand, the Applicant's mark relies heavily on the combination of the terms JUMP and MAN and combining the two words into one makes it clear the mark is to be read as a noun – JUMPMAN. He went further and argued that consumers, when encountering the mark, will think the term is referring to a superhero, like Spiderman, Batman, Superman or Ironman. This is precisely the intention of the Applicant as the mark derives from Michael Jordan, a superman and legendary figure in the basketball world. Sticking with the superhero theme, Mr. Flynn argued that the prior registration of the words spider, bat, super or iron, would absolutely not prevent the registration and use of Spiderman, Batman, Superman or Ironman. Therefore, in his opinion, the claim by the Opponent that the marks are almost conceptually identical is clearly erroneous when the actual facts of the case are considered.

47. It is the case that both marks contain common dictionary words. The conjoining of the words JUMP and MAN in the Applicant's mark may be viewed as an invention and to

constitute a fanciful word, but in reality the term JUMPMAN can be considered to have a real and specific meaning, that being a man who jumps or a man who looks after jumps, say at horse-racing or equestrian events. The message conveyed by the Opponent's mark is that it has to do with the act of jumping or a physical obstacle known as a jump. The mark at issue relates to a man who participates in jumping or who is responsible for jumps. Though I accept that some may also view it in a similar fashion to the superheroes mentioned by Mr. Flynn.

48. Clearly there is some level of conceptual similarity. I am satisfied the marks share a high degree of conceptual similarity. This, when considered in conjunction with what I have found as regards the verbal and visual similarities, leads me to find the marks share a high degree of overall similarity.

Likelihood of confusion

49. The basic ingredients of an objection under Section 10(2)(b) of the Act – *earlier similar trade and identical or similar goods* – are all present in this case and the issue now rests on whether, as a consequence, there is a likelihood of confusion on the part of the purchasing public.

50. The kind of confusion that Section 10(2)(b) seeks to avoid is concerned solely with the commercial origin of goods, whereby the average consumer, being familiar with goods sold under the earlier mark and, because of the similarity in the respective marks, attributes to the goods offered under the disputed mark the qualities and characteristics that he associates through experience with the goods offered under the earlier mark. The question is whether the average person, who knows of products sold under the Opponent's trade mark JUMP and who then encounters the Applicant's similar or identical products for sale under the trade mark JUMPMAN, would assume that the latter goods were connected with the former in the sense that they were both put on the market by the same undertaking or by commercially related undertakings.

51. The criteria against which the question should be answered has been enunciated in a number of decisions of the CJEU⁴ in this area and include the following:

⁴ Sabel BV –v- Puma AG and Rudolph Dassler Sport (Case C-251/95) [1998] 1 CMLR 445; Canon Kabushiki Kaisha –v- Metro-Goldwyn-Mayer Inc. (Case C-39/97) [1999] 1 CMLR 77; Lloyd Schuhfabrik Meyer & Co. GmbH –v- Klijsen Handel BV (Case C-342/97) [1999] 2 CMLR 1343

- i. A lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks, and vice versa;
- ii. The more distinctive the earlier mark, the greater will be the likelihood of confusion;
- iii. In determining the distinctive character of the earlier mark, it is necessary to make an overall assessment of its capacity to identify the goods for which it is registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings;
- iv. In making that assessment, account should be taken of the inherent characteristics of the mark; the market share held by it; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested in its promotion; the proportion of the relevant public which, because of the mark, identifies the goods as originating from a particular undertaking; and statements from chambers of commerce and industry and other trade and professional associations;
- v. A global appreciation of the likelihood of confusion must, as regards the visual, aural and conceptual similarity of the marks in question, be based on the overall impression created by them, and the importance to be attached to each of those elements must take account of the category of goods and the way in which they are marketed;
- vi. The assessment must be made from the perspective of the average consumer who is deemed to be reasonably well-informed, observant and circumspect but who rarely has the chance to make a direct comparison of the marks and must rely on the imperfect picture that he has of them in his mind;
- vii. The likelihood of confusion must be appreciated globally, taking into account all of the factors relevant to the circumstances of the case.

52. In applying those criteria to the facts of the present case, I have reached the following conclusions:

- (a) The Opponent's mark has a low level of inherent distinctiveness in respect of the goods for which it is registered, but nonetheless has the capacity to identify these goods as being those of a particular undertaking and thus to distinguish the goods from those of other undertakings.
- (b) The Opponent's mark is completely unknown in the State and has been used to a miniscule level in the EU. It does not hold any appreciable market share nor has its use extended beyond one location in Sofia, Bulgaria. There is no evidence of any

investment in its promotion. All in all, the proportion of the relevant public that would identify goods bearing the mark as originating from a particular undertaking is practically zero.

(c) The contested goods are typically purchased in-store and often, particularly in the case of footwear, with the assistance of retail staff.

(d) The overall impression created by the marks in question is that they are very similar. Visually, verbally and conceptually they share an overall high level of similarity.

53. The Applicant claims that as it has not been made aware of any incidents of confusion that confusion has not occurred and is therefore unlikely to occur in the future. I am satisfied that no confusion has actually arisen and, if the Opponent continues to use its mark in Bulgaria alone, no confusion is ever likely to occur.

54. However, the law as it stands, does not allow me to reach any conclusions based on a lack of actual incidents of reported confusion or allow me to predict or speculate about the likelihood of future incidents of confusion arising based on the current usage of the respective marks.

55. I must determine this matter on the basis of notional use of the parties' marks and of a likelihood of confusion arising if the marks were used in a normal and fair manner. The confusion in question may be direct confusion, whereby the Applicant's goods are mistaken for those of the Opponent, or indirect confusion, whereby the Applicant's goods are associated in the mind of the consumer with that of the Opponent and a common commercial origin is inferred. I must look at the question of likelihood of confusion from a practical perspective in the context of the marketplace for the goods in question and put myself in the shoes of the average consumer.

56. There are many authorities that deal with the likelihood of confusion. One of particular interest which was brought to my attention by Mr. Flynn is the decision of the Controller in EASYMOVES (Application No. 226996) where the marks at issue were EASY and EASYMOVES / EASYMOVE. He argued that there are obvious parallels between that case and the instant case and that the decision of the Controller in EASYMOVES provides ample guidance, which should be followed in these proceedings, regarding the likelihood of confusion. In EASYMOVES the Controller found as follows:

In view of the fact that it designates in common parlance a desirable characteristic of the goods and services in respect of which it is protected, the trade mark EASY must be seen as having a very low level of distinctiveness. In Case No. C-251/95, Sabel BV –v- Puma AG and Rudolf Dassler Sport, the European Court of Justice noted that the more distinctive the earlier trade mark is, the greater will be the likelihood of confusion arising from the use of a similar trade mark. The reverse must also hold and it may be assumed, therefore, that a relatively slight difference between the present mark and the Opponent’s trade mark EASY should be sufficient to obviate any likelihood of confusion arising. In my opinion, the difference between EASYMOVES/EASYMOVE and EASY is more than slight. The former is a specific and defined message of ease in relation to movement (of goods) while the latter evokes the notion of easiness in an unspecified and unlimited way. It does not seem likely that EASYMOVES/EASYMOVE would evoke recollection of EASY, per se, or that the average consumer would assume a connection between the two.

57. I agree with Mr. Flynn that there are similarities between the present case and EASYMOVES. Both concern an earlier mark that consists of a short, common and easily understood word that appears at the start of the later mark, the only difference being the addition of another short, common and easily understood word as a suffix in the later mark. On first appearances the similarities between the cases would seem compelling. However, the assessment of the likelihood of confusion cannot be conducted without reference to the actual goods covered by each mark. In this case the goods are articles of footwear, clothing and headgear. Consumers of these goods are the general public. In the present case, unlike in EASYMOVES, there is a clear distinction between how these goods are retailed (whether on the high street or online) in relation to men, women and children. The goods for each of the three categories of customers are invariably separated and offered for sale in a different part of a store or website, or through dedicated men’s, lady’s or children’s outfitters.

58. In my opinion, this is a very important factor that is fundamental to this case. And, having considered all the facts, evidence and the arguments of both parties, I find it is one that I cannot ignore. When purchasing any of the goods at issue a man will go to the appropriate section of a department store or to a dedicated man’s shop. Also, it is not usual for fashion retailers or fashion suppliers to create a male version of their brand dedicated to male consumers, for example, NEXT / NEXT MAN, TOPSHOP / TOP MAN and A-WEAR / A-MAN. Therefore, in the context of the goods at issue the MAN element of the Applicant’s JUMPMAN mark would be seen as serving the particular purpose of indicating that the

goods bearing the mark were part of the JUMP brand directed specifically towards male consumers.

Decision

59. Therefore, it is clear to me that, if a consumer was familiar with the trade mark JUMP in respect of footwear or socks and encountered the trade mark JUMPMAN on footwear, clothing or headgear (all goods very similar if not identical to the Opponent's goods), they would be likely to believe that the JUMPMAN brand was a sub-brand targeted at the male population and that the products emanate from a single source or that the proprietors of the marks were economically linked. This is precisely the scenario that would inevitably lead to the type of confusion that Section 10(2)(b) seeks to avoid.

60. Accordingly, I have decided to refuse the application in respect of all the goods for which registration was sought as it offends against Section 10(2)(b) of the Act.

Dermot Doyle

Acting for the Controller

9 September, 2016