

O-563-15

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 3061115
IN THE NAME OF RAY SHERLOCK
FOR REGISTRATION OF THE TRADE MARK



WHISTLE BLOWER

AND OPPOSITION THERETO UNDER NO 403179
BY WHISTLES LIMITED


Background

1. On 23 June 2014, Ray Sherlock (“the applicant”) sought registration of the trade mark shown on the front cover of this decision for the following goods:

Class 25

Bowties; Button down shirts; Caps [headwear]; Casual clothing; Casual jackets; Casual shirts; Casualwear; Hooded tops; Jumpers [pullovers]; Jumpers [sweaters]; Knitwear; Long sleeve pullovers; Menswear; Shirts; Tee-shirts; T-shirts; Vests.

2. The application was published in *Trade Marks Journal* 2014/032 on 1 August 2014 following which notice of opposition was filed by Whistles Limited (“the opponent”). The grounds of opposition are founded on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). In respect of the objections under sections 5(2) and (3), the opponent relies on the following UK and Community Trade Mark (“CTM”) registrations:

Mark and grounds	Dates	Specification relied upon
CTM 4421905 WHISTLES 5(2)(b) and 5(3)	Filing date: 5 May 2005 Date of entry in register: 24 May 2006	Goods in classes 3, 9, 14, 18, 25 and 35
CTM 904342  5(2)(b)	Filing date: 6 August 1998 Date of entry in register: 8 June 2000 Priority date: 19 June 1988 (UK)	Goods in classes 3, 14, 16, 18, 20, 21, 24 and 25
CTM 12002952 WHISTLES LONDON 5(2)(b)	Filing date: 22 July 2013 Date of entry in register: 28 January 2014 Priority date: 22 January 2013 (China)	Goods in classes 18 and 25 and services in class 35
1306213 WHISTLES 5(2)(b)	Filing date: 4 April 1987 Date of entry in register: 14 December 1990	Services in class 42
2306986 WHISTLES 5(2)(b) and 5(3)	Filing date: 1 August 2002 Date of entry in register: 3 January 2003	Goods in class 25 and services in class 35

3. The opponent relies under section 5(4)(a) of the Act on use of the mark WHISTLES since 31 December 1980 in London in relation to a range of goods and services.

4. The applicant filed a counterstatement in which it denies the claims made and puts the opponent to proof of some of its marks in relation to some of the goods and services.

5. Both parties filed evidence which I will refer to as necessary in this decision. The matter came before me for a hearing on 22 October 2015. The applicant was represented by his assistant Mr Dan Murphy, the opponent was represented by Mr Julius Stobbs of Stobbs.

The objection under section 5(2)(b)

6. At the hearing, the opponent agreed that it was sufficient to consider the opposition under this ground insofar as it is based on its earlier mark No 2306986 as if it does not succeed in respect of this mark it will be in no better position in respect of the others. Similarly, it is sufficient to consider the mark insofar as it is registered for goods in class 25. The applicant does not put the opponent to proof of use of this mark in relation to these goods.

7. Section 5(2)(b) of the Act states:

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

8. 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.

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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of the respective goods

9. The comparison I have to make is a notional one based on the specifications of goods as registered and applied for regardless of what use may have been made of them. The respective specifications are as follows:

Opponent's goods	Applicant's goods
Clothing; footwear; headgear	Bowties; Button down shirts; Caps [headwear]; Casual clothing; Casual jackets; Casual shirts; Casualwear; Hooded tops; Jumpers [pullovers]; Jumpers [sweaters]; Knitwear; Long sleeve pullovers; Menswear; Shirts; Tee-shirts; T-shirts; Vests

10. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court ("GC") stated:

"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 für 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”.

11. Each of the goods within the applicant’s specification is either an item of clothing or an item of headgear which are terms which are included within the specification of the opponent’s earlier mark. The respective goods are identical.

The average consumer and the nature of the purchasing process

12. 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 in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

13. 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.”

14. Both parties have specifications consisting, broadly speaking, of clothing and headgear. Such goods will be sold in a variety of ways including in traditional retail outlets on the high street, through catalogues and by way of the Internet. Given the respective specifications, I must keep all of these trade channels in mind. The average consumer of the goods at issue is a member of the general public who is likely to select the goods mainly by visual means though I accept that more expensive items may be researched or discussed with a member of staff. In this respect, I note that in *New Look Ltd v OHIM Cases- T-117/03 to T-119/03 and T-171/03*, the GC said this about the selection of clothing:

“50. 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.”

15. Mr Stobbs accepted the visual aspects of the purchase were “very important”.

16. The GC also commented in the *New Look Ltd* case on the degree of care the average consumer will take when selecting clothing. It said:

“43. It should be noted in this regard that the average consumer’s level of attention may vary according to the category of goods or services in question (see, by analogy, Case C 342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26). As OHIM rightly pointed out, an applicant cannot simply assert that in a particular sector the consumer is particularly attentive to trade marks without supporting that claim with facts or evidence. As regards the clothing sector, the Court finds 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.”

17. Clearly, the average consumer’s level of attention will vary considerably depending on the cost and nature of the item concerned, however, even when selecting routine and relatively inexpensive items of clothing such as socks, I consider the average consumer will pay attention to considerations such as size, colour, style, material and cost. Overall, the average consumer is likely to pay a reasonable degree of attention to the goods which are such as will be bought on a fairly regular basis.


Comparison of the respective marks

18. 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 them, bearing in mind their distinctive and dominant components. The Court of Justice in the European Union (“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.”

19. It would be wrong, therefore, artificially to dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of them and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by them.

20. The marks to be compared are as follows:

Opponent's mark	Applicant's mark
WHISTLES	 <p data-bbox="954 562 1262 589">WHISTLE BLOWER</p>

21. The opponent's earlier mark consists of an ordinary dictionary word WHISTLES presented in plain block capitals. No part of the mark is highlighted in any way and its distinctiveness rests in its whole. The applicant's mark consists of a number of elements. There is the letter W which is underlined and placed centrally within a circular border. Underneath this, and in smaller letters but extending wider than the circle above it, are the two words WHISTLE and BLOWER again in block capitals. The word BLOWER appears in a lighter font than the remainder of the mark. The underlined W within the circle has a degree of prominence due to its size and location and is a distinctive element, however, the words WHISTLE and BLOWER also make up a distinctive element.

22. Visually and aurally, there is a point of similarity between the two marks in that both contain the letters W-H-I-S-T-L-E. There are also points of dissimilarity in that the letter S at the end of the opponent's mark is missing from the word WHISTLE as it appears within the applicant's mark. This latter mark also contains the additional word BLOWER along with the underlined W within a circle. Taking all matters into account, the respective marks have a low degree of visual similarity. The applicant's mark could be articulated in a number of ways. The high point of the aural comparison rests in circumstances where the average consumer would refer to the mark as WHISTLE BLOWER i.e. not articulating the W element. In that case, there would be a reasonable degree of aural similarity. The words WHISTLES which makes up the opponent's mark brings to mind either the plural of the noun whistle, being an instrument which produces such a sound, or part of the related verb. The image brought to mind by the applicant's mark will rest in the words WHISTLE BLOWER which, despite the emboldening of only one of the two words, form a unit which is well-known term meaning someone who informs on someone or someone who brings to the attention of someone in authority a process which is regarded as unlawful or immoral. Conceptually, the respective marks are dissimilar.

The distinctiveness of the earlier mark

23. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated:

“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).

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)."

24. The opponent's evidence is given by Phil Mickler who is the company's Chief Financial Officer, a position he has held for five years. Mr Mickler states that the opponent is a fashion retailer which launched in 1976 (other parts of the evidence suggest it was 1978 but nothing rests on this) when it opened a single store in London. He states that at the time of making his witness statement, (March 2015), the company had 49 independent stores and 57 concessions in major stores such as John Lewis, Harvey Nichols, Harrods and Selfridges around the country. In 2007 it became an online retailer.

25. Mr Mickler states the company is, primarily, a clothing business though it also produces footwear and fashion accessories such as bags and jewellery. He states that until the relevant date (23 June 2014) it had traded only in women's fashion but it launched a menswear range in September 2014.

26. Mr Mickler states that the WHISTLES trade mark has been used consistently since the business started with the focus of the business being on own-branded products. He states that approximately 700 product options are available each season with each store holding around 250 of them (other parts of the evidence give figures of 500 and 200 respectively - see e.g. PM3 but again, nothing rests on this). He states that "almost all" products are available online. At PM5, Mr Mickler exhibits a photocopy of the summer 2007 booklet which shows a range of women's clothing. The trade mark appears typically on sewn-in labels, swing tickets, on the bags the products are put into at the till and on till receipts as well as appearing in store. At PM6 are exhibited such items which show the WHISTLES trade mark.

27. Mr Mickler gives annual turnover as follows:

UK Total Turnover (inc. VAT)	UK turnover, excluding bags, jewellery (inc. VAT)
2008	£42m
2009	£39m
2010	£45m
2011	£48m

2012	£59m (Material at PM3 suggests £56m)
2013	£61m
2014	£62m

The 2014 figure is likely to include substantial turnover from after the relevant date given that date is approximately half way through the year.

28. Mr Mickler states that the mark has been advertised and promoted in a number of ways including, for the last five years, in the UK version of *Grazia* magazine. At PM8 is an extract taken from the publisher's own website which indicates the magazine had a readership of 371,000 in the period October 2013 to March 2014. The opponent also has a presence on social media, via a company newsletter sent weekly to some 152,000 customers and via its website which is visited by some 140,000 unique users. The company also organises preview events to launch and promote new collections to which the press and some members of the public are invited. Advertising and promotional spend is given as follows:

2008	£0.4m
2009	£0.5m
2010	£0.5m
2011	£0.6m
2012	£0.7m
2013	£0.9m
2014	£1.5m

Again, the 2014 figure is likely to include substantial expenditure incurred after the relevant date.

29. Mr Mickler also states the company and its products are regularly featured in the wider press. At PM10 he exhibits samples of such coverage. There are 16 pages. Most either post-date the relevant date, are not dated and/or no information is given which allows me to identify the particular publication involved. That said, at page 15 is a photocopy of a page taken from the August 2013 edition of *Vogue* which shows a picture of and refers to a "Whistles camo shirt". At PM11 are press articles which refer to the company's CEO. This material is subject to the same criticism as that in PM10 but there is an article from the Sunday Times business section dated 17 February 2013 which refers to the company and its products.

30. It is clear, and there is no dispute, that the opponent has sold its products under the WHISTLES trade mark for many years. The turnover figures provided are not contextualised in terms of the relevant market but are consistent and not insignificant. The same is true for the opponent's advertising and promotional expenditure. There is no dispute that the mark appears on both the garments themselves as well as on swing tags etc. attached to them. I have no doubt that the distinctive character of the trade mark, which, as an ordinary dictionary word is, inherently, of an average level (not the high level as claimed by Mr Stobbs), will have been enhanced through its use. That use has been shown to be exclusively in relation to clothing for women.

Likelihood of confusion

31. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

32. In his submissions at the hearing, Mr Murphy made reference to the fact that "At the time we registered (sic) the mark, the opponent did not even retail any menswear. There was nothing on the market, from the opponent's point of view, consisting of menswear goods". Mr Stobbs submitted that the fact that the opponent did not retail menswear at that time "was an important part of the adoption and choice of the mark" and that the applicant acknowledges that this is "the main reason, in their minds, for any lack of perceived overlap between these businesses". My decision, of course, does not concern the "overlap of businesses" but the likelihood of confusion between the trade mark as applied for and the earlier mark as registered. As to that, Mr Stobbs submitted that both marks had "a simple presentation" whilst Mr Murphy submitted that the marks were "distinctly different" and went on to submit that "we were looking at different marks".

33. Earlier in this decision I found:

- The respective goods are identical;
- The goods are primarily bought by eye therefore the visual consideration plays a greater role in the purchasing process though not to the exclusion of the other factors;
- The purchasing process is one carried out with a reasonable degree of attention;
- The respective marks have a low degree of visual similarity, a reasonable degree of aural similarity and are dissimilar conceptually;
- The earlier mark has an average degree of inherent distinctive character which has been enhanced through use in relation to clothing for women.

34. In *Whyte and Mackay Limited v Origin Wine UK Limited and Dolce C Invest Inc* ("*JURA ORIGIN*") [2015] EWHC 1271 (Ch) (6.5.15), Arnold J stated:

"18. The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19. The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20. The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21. The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

35. I do not consider that the average consumer, when presented with the applicant’s mark, would see the word WHISTLE as an independent element within the mark. Despite the words WHISTLE and BLOWER being presented with the word WHISTLE emboldened, when considering the mark as a whole, the word WHISTLE does not stand out. If anything, it is the word BLOWER not being emboldened that is more noticeable within the mark. Even then, the two words being presented differently does not outweigh the fact that they form a term which itself is well-known and in common use.

36. Whilst I have found that there is a degree of visual (low) and aural (reasonable) similarity between the respective marks, I also found they were conceptually dissimilar. In *The Picasso Estate v OHIM*, Case C-361/04 P, the Court of Justice of the European Union held:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

37. Taking all matters into account, I consider that the similarities between the respective marks are far outweighed by the differences such that I find there is no likelihood of confusion. The opposition based on section 5(2)(b) of the Act fails.

The objection under section 5(3) of the Act

38. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC), in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

39. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark’s ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure*).

40. Again, the opponent limits its objection under this ground and relies only on its earlier registration no. 2306986. It claims that the applicant's mark would, without due cause, take unfair advantage of the distinctive character or repute of the opponent's earlier trade mark and free ride on that reputation in the "clothing and fashion space". This, it claims, would be detrimental to the distinctive character of the earlier trade mark, would adversely affect the economic behaviour of the relevant public and would be detrimental to the "carefully cultivated reputation" of the opponent's mark.

41. The applicant accepts that the opponent has a reputation in its mark in relation to clothing for women. I proceed on that basis.

42. In my consideration of the respective marks in relation to the objection under section 5(2)(b) of the Act, I found that there was not a likelihood of confusion between them. In *Intra-Press SAS v OHIM*, Joined cases C-581/13P & C-582/13P, the CJEU, referring to the equivalent part of the Regulation to that of section 5(3) of the Act, stated (at paragraph 72 of its judgment):

"The Court has consistently held that the degree of similarity required under Article 8(1)(b) of Regulation No 40/94, on the one hand, and Article 8(5) of that regulation, on the other, is different. Whereas the implementation of the protection provided for under Article 8(1)(b) of Regulation No 40/94 is conditional upon a finding of a degree of similarity between the marks at issue so that there exists a likelihood of confusion between them on the part of the relevant section of the public, the existence of such a likelihood is not necessary for the protection conferred by Article 8(5) of that regulation. Accordingly, the types of injury referred to in Article 8(5) of Regulation No

40/94 may be the consequence of a lesser degree of similarity between the earlier and the later marks, provided that it is sufficient for the relevant section of the public to make a connection between those marks, that is to say, to establish a link between them (see judgment in *Ferrero v OHMI*, C-552/09 P, EU:C:2011:177, paragraph 53 and the case-law cited).”

43. Mr Stobbs submitted that a link would be made between the respective marks because of the “whistle element in both marks”. He submitted that it was reasonably foreseeable that there could be a change in economic behaviour and the risk was not hypothetical.

44. Whilst it is clear that the marks share the letters W-H-I-S-T-L-E, the points of similarity between them are relatively minor and far outweighed by their differences having regard to their distinctive characters. Those differences are such that I consider that no link would be made even where identical goods are involved. That being the case, the objection under this ground also fails.

The objection under section 5(4) of the Act

45. At the hearing, Mr Stobbs accepted that the objection under this ground added little to the objection already considered under section 5(2) of the Act and, on this basis, I decline to deal with it further.

Summary

46. The opposition has failed. Subject to any successful appeal, the application will proceed to registration.

Costs

47. The opposition having failed, Mr Sherlock is entitled to an award of costs in his favour. In making the award, I note that whilst he had an assistant to speak on his behalf at the hearing, he has not been professionally represented during the course of these proceedings. I make the award on the following basis:

For filing a counterstatement and reviewing the opponent’s statement of grounds:	£200
For filing and reviewing evidence:	£300
For preparation for and attending the hearing:	£200
Total:	£700

48. I order Whistles Limited to pay Ray Sherlock the sum of £700. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of

the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 2nd day of December 2015

**Ann Corbett
For the Registrar
The Comptroller-General**