

O-084-03

**IN THE MATTER OF APPLICATION NUMBER 2245968
IN THE NAME OF HEAVEN SCENT PERFUMES INC
TO REGISTER A TRADE MARK IN CLASS 3**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NUMBER 52206
BY dELIA*s Group Inc.**

**IN THE MATTER OF application number 2245968
in the name of Heaven Scent Perfumes, Inc. to register a trade mark in Class 3**

And

In the matter of opposition thereto under number 52206 by dELIA*s Group Inc.

Background

1. On 19 September 2000, Heaven Scent Perfumes, Inc. filed an application to register the trade mark ODELIA in Class 3 in respect of the following goods:

Deodorants, perfume, cologne, body lotion, body spray, bath and shower gels, essential oils.

2. On 2 March 2001, dELIA*S Group Inc. filed notice of opposition in which they say that they are the proprietors of two trade marks, details of which can be found below. The grounds of opposition are in summary:

Under Section 5(2)(b) because the opponent's earlier trade marks and the application in suit are similar and the application is sought to be registered for goods identical and similar to those covered by these earlier trade marks, as a result there exists a likelihood of confusion on the part of the public.

Under Section 5(4)(a) by virtue of the law of passing off.

3. The earlier marks relied upon by the opponents are as follows:

| Number | Mark | Class | Specification |
|---------------|---|--------------|--|
| 2144536 |  | 3 | Soaps, perfumes, colognes, toilet waters; cosmetics; non-medicated toilet preparations; non-medicated preparations for the care of the skin; preparations for the nails and hair; cotton wool and artificial cotton wool for cosmetic purposes; essential oils; preparations for perfuming the atmosphere; perfumed articles; anti-perspirants and deodorants for personal use; dentifrices. |
| 2144538 | DELIA'S | 3 | Soaps, perfumes, colognes, toilet waters; cosmetics; non-medicated toilet preparations; non-medicated preparations for the care of the skin; preparations for the nails and hair; cotton wool and artificial cotton wool for cosmetic purposes; essential oils; preparations for perfuming the atmosphere; perfumed articles; anti-perspirants and deodorants for personal use; dentifrices. |

4. The applicants filed a counterstatement in which they accept that the goods said by the opponents (in the statement of grounds) to be identical to those covered by their application, are in fact identical, but deny that those goods said to be similar are. But in any event, they deny all of the grounds on which the opposition is based. Both sides request that an award of costs be made in their favour.

5. Both sides filed evidence in these proceedings. The matter came to be heard on 26 September 2002. when the opponents were represented by Ms Thomas-Peter of Wildbore & Gibbons, their trade mark attorneys. The applicants were not represented.

Opponent's evidence

6. This consists of a Witness Statement dated 11 December 2001, and comes from Andrea Weiss, President of dELIA*s Group Inc. a position she has held since 2001 having been employed by the company for six months. Ms Weiss says that the contents of her statement come either from her own knowledge or from the records of her company.

7. Ms Weiss says that her company has used the marks DELIA'S and dELIA*s in relation to a range of clothing, accessories and cosmetics aimed at young girls and teenagers, available through mail order catalogues, via the Internet and through retail stores in the United Kingdom. She refers to exhibits AW1 and AW2, which consist of two catalogues dating from "Holiday 2001" and "Winter 2001", and a print taken from her company's Internet site on 10 December 2001, respectively. Apart from originating after the relevant date, there is nothing to indicate that they were available, accessed, or used within the United Kingdom.

8. Ms Weiss says that the first international mailing of the d'ELIA*s catalogue occurred in September 1997, and the first sales within the United Kingdom in October 1997. She goes on to list the value of sales within the United Kingdom for the years 1997 to 2001, which ranges from US\$1,630.00 in 1997, rising to US\$9,771.00 in 1999, the last full year prior to the relevant date. Sales for the following two years show a decline. Ms Weiss does not say what goods these sales are in respect of, nor how they were effected.

9. Ms Weiss describes her company's trade mark as being the possessive form of the female name Delia, and that ODELIA is phonetically very similar and would also be seen as a female name.

Applicant's evidence

10. This consists of a Witness Statement dated 10 April 2002 and comes from Jane More O'Ferrall, a partner in the firm of Haseltine Lake Trademarks, the applicant's representatives in these proceedings. Ms More O'Ferrall says that the facts set out are drawn from personal knowledge or from publicly accessible publications and databases.

11. Ms More O'Ferrall refers to the addition of DELIA in Collins English Dictionary in December 2001, exhibit JMOF1 being extracts from the Internet, downloaded on 27 February 2002 reporting this event. She goes on to say that the name DELIA is rarely given in the United Kingdom, a fact that she says is borne out by a guide to first names published by HMSO (exhibit JMOF2), which, she notes, does not show DELIA in the top 100 names. From this Ms More

O’Ferrall extrapolates that the public will associate the opponent’s trade marks as being the possessive form of the name that they know, whereas the same cannot be said of ODELIA. Ms More O’Ferrall goes on to set out what she sees as the differences in the respective marks that negate the likelihood of confusion.

Opponent’s evidence in reply

12. This consists of a Witness Statement dated 14 June 2002, which comes from Helen Thomas-Peter, a partner in the firm of Wildbore & Gibbons. Ms Thomas-Peter says that the evidence comes from her own knowledge and from publicly available publications or databases.

13. Ms Thomas-Peter refers to the evidence relating to Delia Smith , accepting that she is famous in relation to cooking but saying that this does not detract from the distinctiveness of the opponent’s mark in relation to goods in Class 3. She says that ODELIA is not an invented word, but as shown by exhibit HTP1, is derived from the name of the patron saint of the blind. Ms Thomas-Peter accepts that neither DELIA nor ODELIA are common forenames in the United Kingdom. She refers to exhibit HTP2 which shows that ODELIA is a name derived from the old German for “little wealthy one” and from the Hebrew for “praise God”. Ms Thomas-Peter goes on to cite instances where ODELIA has been used, including as a forename, details of which are shown as exhibit HTP3.

That concludes my summary of the evidence insofar as it is relevant to these proceedings.

Decision

14. At the hearing Mr Malynicz withdrew the ground under Section 5(4)(a), leaving the ground under Section 5(2)(b) That section reads as follows:

“5.-(2) A trade mark shall not be registered if because-

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

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

15. An earlier trade mark is defined in Section 6 of the Act as follows:

“6.- (1) In this Act an “earlier trade mark” means-

(a) a registered trade mark, international trade mark (UK) or Community trade mark 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,

16. In my consideration of a likelihood of confusion or deception I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] 45 F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723. It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*,
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,
- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG*,
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,

17. The opponents rely on two earlier trade marks, which, at the time that these proceedings were launched were also the subject of opposition proceedings, but have subsequently proceeded to registration. Both of these registrations are for the word DELIA'S, one in a stylised form, the other in plain block capitals. At the hearing Mr Malynicz stated that he intended to rely on the

word in plain block capitals. I believe this to be a sensible approach, for if the opponents cannot succeed in respect of the mark in this form, they will be in no better a position in respect of the stylised version.

18. The earlier trade mark registration relied upon by the opponents and the application that they oppose are both in respect of goods to be found in Class 3. The applicants concede that the goods cited in the statement of grounds as being identical to those covered by their application are, in fact identical, although do not say whether this is in respect of all, or only some of the goods that they specify, but deny that those said to be similar, are in fact so. In my view all of the goods detailed in the application are identical to those covered by the opponent's earlier mark, being either specifically mentioned or covered by the more general descriptions, such as "non-medicated toilet preparations". In neither case has the specification been limited in any way, and I must therefore proceed on the basis that from manufacturer through to the consumer the respective goods notionally occupy the same market sector, from manufacturer to consumer.

19. Whilst in any comparison it is inevitable that particular elements of a mark will be referred to, and should be if they are the distinctive and dominant components, it is clear from the above cases, that the average consumer normally perceives a mark as a whole, and that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions that they create.

20. Perhaps, with the exception of perfume which I know to be a product most usually, although not only, available by enquiry, the other goods are likely to be obtained by self-selection which makes the visual similarity of the respective marks of primary importance.

21. The opponent's earlier trade mark is for the word DELIA's, which is the possessive or pluralised form of the female forename DELIA. The applicants say that this is a rarely given name in the United Kingdom, but whether or not this is the case, as they themselves point out, it is a forename that has achieved public recognition through the fame of Delia Smith. In this connection I would agree with the opponents; it does not matter that Ms Smith has achieved public recognition in any particular field of endeavour, what is relevant is that it has established DELIA as a female forename in the minds of the public.

22. The mark applied for is the word ODELIA which the opponent's evidence shows also to be a female forename, although is not, to my knowledge, a commonly given name in the United Kingdom, a position generally accepted by both sides. Whilst the consumer may not analyse the detail of a word, where it has no meaning the consumer will determine the significance by impression, often relying on their knowledge or experience as a point of reference. There is no evidence that ODELIA has any meaning other than as a name, and rare or not, I take the view that a consumer who is aware that DELIA is a female forename will use this knowledge and be likely to regard ODELIA as also being a name, be it as a variant or longer form of DELIA, or a different name altogether. That the opponent's earlier mark is the name in the pluralised or possessive form will not, in my view, have any significant effect on this conceptual similarity; it will still be seen as the name.

23. The respective marks are clearly not identical in appearance although to the extent that the mark applied for contains the singular form of the opponent's earlier mark, there is a degree of

visual similarity. They are similar in length, the most significant difference being the letter O at the beginning of the mark applied for, followed by the termination of the opponent's mark. Compared as a whole I would say that they are more similar than dissimilar in appearance.

24. The initial letter O in ODELIA has a soft sound, the main emphasis and strongest sound being found in DELIA. I do not consider that the apostrophe and letter "S" has a significant effect on the sound of the opponent's mark when spoken, particularly so given their positioning at the termination of the word. It has long been the case that the endings of words have been considered to be of less significance when considering aural similarity, but this is not a hard and fast rule and can be affected by factors such as the strength of the beginning, the length of the word, the familiarity of the public with the word, etc. Viewing the marks as a whole, I would say that aurally the two words will sound very similar when spoken.

25. Female forenames have been considered to have a low threshold of distinctiveness as trade marks for perfumes and the like products, but there is no dispute in this case that in relation to the goods at issue, the name is distinctive. The opponents are silent on the use that they may have made of their earlier mark, and consequently, I am unable to say it has become more distinctive by virtue of the use they may have made of it, or the reputation it has acquired.

26. Taking all of the above factors into account and applying the "global" approach advocated in the cases referred to above, I come to the view that the similarities are such, and particularly when allowance is made for the possibility of imperfect recollection, that should the applicant use the mark applied for in respect of the goods covered by their application, that the public will be led to believe that the respective goods are those of the opponents, or some economically linked undertaking, and that there is a real likelihood of confusion. The objection under Section 5(2)(b) therefore succeeds.

27. The opposition having been successful the opponents are entitled to a contribution towards their costs. I order the applicants to pay the opponents the sum of £2,200 as a contribution towards their costs. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 2ND day of April 2003

**Mike Foley
for the Registrar
The Comptroller General**