

O-018-10

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2499802
BY K FASHION UK LTD TO REGISTER A
TRADE MARK IN CLASS 25**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 98762 BY CECIL GmbH**

BACKGROUND

1. On 8 October 2008, K Fashion UK Ltd (KF) applied to register the trade mark **ceci tokyo** for a specification of goods in class 24 which read:

“Womenswear clothing, fashion clothes.”

Following examination (during which time the application was transferred to class 25), the application was accepted and published for opposition purposes on 14 November 2008 in Trade Marks Journal No.6761.

2. On 16 February 2009, Cecil GmbH (Cecil) filed a notice of opposition. This consisted of a single ground based upon section 5(2)(b) of the Trade Marks Act 1994 (as amended) (the Act). In their Statement of Grounds Cecil indicate that the opposition is based upon the following trade mark:

Trade Mark	No.	Application Date	Registration Date	Goods
CECIL	CTM 5873377	03.05.07	29.01.09	For a range of goods in classes: 3, 9, 14, 16, 18, 24 and which includes the following goods in class 25: Clothing; footwear; headgear; swimming costumes; bathing trunks; bathrobes; bodies; brassieres; ladies' dresses; gloves; belts; neckerchiefs; blouses; shirts; trousers; jeans; hats; jackets; ties; leather clothing; coats; caps; pullovers; pyjamas; skirts; sandals; socks; stockings; boots; headbands; sweaters; t-shirts; underwear; shawls; handkerchiefs; slippers; waistcoats; cardigans; shorts.

3. I note that the opposition is directed against all of the goods contained in KF's application.

4. On 24 March 2009, KF filed a counterstatement in which they admit that the:

“goods covered by the earlier trade mark registration include goods identical to the goods specified in the applicant's application.”

5. Insofar as the respective trade marks are concerned, they say:

“It is denied that the mark applied for..is similar to the opponent's

earlier trade mark...The marks are readily distinguishable visually, phonetically and conceptually.”

6. Both parties filed evidence. While neither party asked to be heard, Cecil filed written submissions which I will refer to as necessary below. After a careful consideration of all the material before me, I give this decision.

EVIDENCE

Cecil’s evidence-in-chief

7. This consists of a witness statement, dated 26 May 2009, by Christopher Benson, a lawyer at Taylor Wessing LLP, Cecil’s professional representatives in these proceedings. Attached at Appendix 1 to his statement is a print taken from the Community Trade Mark Office’s database containing details of the trade mark upon which Cecil rely in these proceedings.

KF’s evidence-in-chief

8. This consists of a witness statement, dated 27 July 2009, by Karen Hong who is KF’s sole director, a position she has held since May 2004. Ms Hong confirms that she is authorised to speak on KF’s behalf, adding that the information in her statement comes from either her own knowledge or from company records.

9. In her statement Ms Hong makes the following points:

- That a review of Cecil’s website www.cecil.de (three pages from which were downloaded on 21 July 2009 and which are provided as exhibit KH1), suggests that Cecil may have no presence in the United Kingdom;
- That KF has traded in the United Kingdom since July 2004. Exhibit KH2 consists of pages taken from KF’s financial statements for the periods: 28 May 2004 to 31 May 2005 and for the years ending 31 May 2006, 2007 and 2008;
- That KF trades via its website at www.cecitokyo.com and also through a shop in Great Portland Street which was opened in 2006;
- That KF sells women’s wear on both a retail and wholesale basis. Exhibit KH3 consists of two pages. The first consists of an undated photograph of what is described by Ms Hong as a dress and which I note contains the trade mark the subject of the application (although not in the form applied for) on both the neck label and swing tag. The second consists of a page downloaded from the website www.asos.com on 15 July 2009 in which the trade mark appears (again not in the form applied for) in connection with a “Pintuck lace tea dress with patent bow belt.” Ms Hong explains that KF have “provided ASOS with women’s wear in the past”;

- Exhibit KH4 consists of two documents. The first is an extract from Cassell's New French-English/English-French dictionary in which the word "ceci" in the French language is defined as: "This, this thing" in English. The second is an extract downloaded from the on-line encyclopaedia Wikipedia on 21 July 2009 in relation to the fashion and portrait photographer Cecil Beaton;
- That there are other companies using trade marks which are closer to Cecil's trade mark and these companies trade in the United Kingdom. Exhibit KH5 consist of pages downloaded on 21 July 2009 from the websites of www.mossbros.co.uk and www.drapersonline.com in relation to the use by Moss Bros of the trade mark Cecil Gee;
- That there are other trade marks containing the ceci element in use in respect of clothing in the United Kingdom. Exhibit KH6 consists of two pages downloaded on 21 July 2009 from the website www.shop.cecipaolo.com/ in relation to the Ceci Paolo store in Ledbury;
- Exhibit 7 consists of a page downloaded on 23 July 2009 from the website www.topshop.com in which the CiCi element is being used in relation to dresses.

Cecil's evidence-in-reply

10. This consists of a further statement, dated 21 October 2009, from Mr Benson. As it consists of submissions rather than evidence of fact, it is neither necessary nor appropriate for me to summarise it here; I will, of course, bear its contents in mind when reaching a decision.

11. That concludes my summary of the evidence filed to the extent that I consider it necessary.

DECISION

12. The opposition is based solely upon section 5(2)(b) of the Act which 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."

13. 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.”

14. In these proceedings Cecil is relying on the registered trade mark shown in paragraph 2 above, which has an application date of 3 May 2007 i.e. prior to that of the application for registration which was filed on 8 October 2008; as such, it qualifies as an earlier trade mark under the above provisions. The application for registration was published for opposition purposes on 14 November 2008 and Cecil’s earlier trade mark was registered on 29 January 2009. As a result, Cecil’s earlier trade mark is not subject to The Trade Marks (Proof of Use, etc) Regulations 2004.

Section 5(2)(b) – case law

15. The European Court of Justice (ECJ) has provided guidance in a number of judgments germane to this issue. The principal cases are: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Mayer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).

It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all the relevant factors: *Sabel BV v. Puma AG*, paragraph 22;

(b) the matter must be judged through the eyes of the average consumer of the good/services in question; *Sabel BV v. Puma AG*, paragraph 23, who is deemed to be reasonably well informed and 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* paragraph 27;

(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*, paragraph 23;

(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*, paragraph 23;

(e) when considering composite marks, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element; *Shaker di L. Laudato & Co. Sas (C-334/05)*, paragraph 42;

(f) an element of a mark may play an independent distinctive role within it without necessarily constituting the dominant element; *Medion AG V Thomson multimedia Sales Germany & Austria GmbH*, paragraph 30;

(g) 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*, paragraph 17;

(h) 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*, paragraph 24;

(i) 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*, paragraph 26;

(j) 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 + Adidas Benelux BV*, paragraph 41;

(k) 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*, paragraph 29.

The average consumer and the nature of the purchasing decision

16. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods; I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. In reaching a conclusion on this point, I must proceed on the basis that the respective parties' trade marks will be used on all the goods for which they have

either been applied for or are registered. I note that in their written submissions Cecil say:

“9. Given the goods in question, the relevant average consumers in this case are the general public.”

17. The goods at issue in these proceedings are all items of clothing. I note from KF’s evidence that they conduct their trade on both a retail and wholesale basis. As Cecil’s specification of goods in class 25 is unlimited, it would clearly encompass both trading methods. I agree with Cecil that as these are the sort of goods which will be bought by the general public, they then are the average consumer for such goods.

18. The evidence KF has provided supports my own experience of how the goods at issue are likely to be selected by the average consumer i.e. the process is most likely (initially at least) to consist of a visual act made on the basis of self selection in either a retail environment, from a catalogue or on-line (see the comments of the Appointed Person in *React Trade Mark* [2000] RPC 285). Whilst this is likely, in my view, to be the principal means by which the goods are selected by the average consumer, as orders may also be placed by telephone, aural considerations will also play a part in the selection process.

19. The cost of the goods at issue may vary from very small sums (for a pair of socks for example) to many thousands of pounds (for, for example, a bespoke suit). The factors the average consumer in this context would be conscious of when selecting such goods are likely to be, *inter alia*, brand, cost, design, material, size, colour, compatibility with other items of clothing and, ultimately, if the goods are suitable for their purposes. All of these factors point, in my view, to this average consumer paying a reasonably high but not the highest level of attention to their purchase. As the cost of the goods increases so one assumes will the level of attention the average consumer is likely to pay to their selection.

Comparison of goods

20. The goods to be compared are as follows:

KF’s goods	Cecil’s goods
Womenswear clothing, fashion clothes.	Clothing; footwear; headgear; swimming costumes; bathing trunks; bathrobes; bodies; brassieres; ladies' dresses; gloves; belts; neckerchiefs; blouses; shirts; trousers; jeans; hats; jackets; ties; leather clothing; coats; caps; pullovers; pyjamas; skirts; sandals; socks; stockings; boots; headbands; sweaters; t-shirts; underwear; shawls; handkerchiefs; slipovers; waistcoats; cardigans; shorts.

21. As all of KF's goods are encompassed by the goods contained in Cecil's registration, the respective goods are therefore identical; a point KF admits in their counterstatement.

Comparison of trade marks

22. For the sake of convenience, the trade marks to be compared are as follows:

KF's trade mark	Cecil's trade mark
ceci tokyo	CECIL

23. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant, but perceives trade marks as a whole and does not pause to analyse their various details. In addition, he/she rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he/she has kept in his or her mind. In reaching a conclusion on similarity, I must also identify what I consider to be the distinctive and dominant components of the respective trade marks.

24. In reaching a conclusion on the degree of similarity between the respective trade marks, I must, as the case law dictates, compare them from the visual, aural and conceptual perspectives. While KF have elected not to file written submissions in these proceedings, I note the following comments which appeared in Ms Hong's statement:

"7...the trade marks CECIL and ceci tokyo are different visually, phonetically and conceptually. [KF's] trade mark comprises two words whereas [Cecil's] trade mark comprises only one. The first word of [KF's] trade mark contains four letters, whereas [Cecil's] contains five.

The ceci part...would be pronounced "sessy" whereas CECIL would be pronounced "sessill."

CECIL is a man's name or a surname, whereas ceci is a French word meaning "this". To many English speakers, therefore, it is likely to have no meaning at all.

25. In approaching the comparison I am mindful of the fact that KF's trade mark consists of two words, and that the second word in their trade mark is completely alien to Cecil's trade mark. In their written submissions Cecil refer me to the decision of the Court of First Instance (CFI) in Case T-6/01 *Matratzen Concord v OHIM – Hukla Germany* in which the Court said:

"32. In this context, the Court of Justice has held that the assessment of the similarity between two marks must be based on the overall impression created by

them, in light, in particular, of their distinctive and dominant components (SABEL, paragraph 23, and Lloyd Schuhfabrik Meyer, paragraph 25).

33. Consequently, it must be held that a complex trade mark cannot be regarded as being similar to another trade mark which is identical or similar to one of the components of the complex mark, unless that component forms the dominant element within the overall impression created by the complex mark. That is the case where that component is likely to dominate, by itself, the image of that mark which the relevant public keeps in mind, with the result that all the other components of the mark are negligible within the overall impression created by it.

34. It should be made clear that that approach does not amount to taking into consideration only one component of a complex trade mark and comparing it with another mark. On the contrary, such a comparison must be made by examining the marks in question, each considered as a whole. However, that does not mean that the overall impression created in the mind of the relevant public by a complex trade mark may not, in certain circumstances, be dominated by one or more of its components.

35. With regard to the assessment of the dominant character of one or more given components of a complex trade mark, account must be taken, in particular, of the intrinsic qualities of each of those components by comparing them with those of other components. In addition and accessorially, account may be taken of the relative position of the various components within the arrangement of the complex mark.”

26. I would add to this the comments of the CFI in *José Alejandro SL v Office for Harmonization in the Internal Market (Trade Marks and Designs), Anheuser-Busch Inc Intervening* (Case T-129/01) [2004] ETMR 15 when they said:

“The Court notes that the public will not generally consider a descriptive element forming part of a complex mark as the distinctive and dominant element of the overall impression conveyed by that mark.”

27. In their written submissions Cecil say:

“14. ..In contrast the word Tokyo is a geographical indicator and is likely to be perceived descriptively as simply referring to clothing or a line of fashion emanating from Tokyo. (This likelihood is all the more so when one considers that Tokyo (like, for example, New York or Paris) is known for fashion. The public does not generally regard a descriptive element of a complex mark as the distinctive and dominant component in the overall impression of that mark..The addition of the word Tokyo in the mark applied for is thus of little or limited differentiating value.”

28. Bearing in mind the guidance in the case law mentioned above, I agree with Cecil's submissions to the effect that given its nature (I take judicial notice of the fact that it is well known as the capital of Japan), and its positioning (as the suffix element), the word tokyo appearing in KF's trade mark is (to use Cecil's words) "of little or limited differentiating value." While I am mindful of the comments in the case identified at paragraph 15(e) above, it is the word ceci that is, in my view, the distinctive and dominant element of KF's trade mark, and I intend to conduct the comparison with that conclusion in mind.

Visual similarity

29. KF's trade mark consists of the words ceci and tokyo presented in lower case, whereas Cecil's trade mark consists of the single word CECIL presented in upper case. In their written submissions Cecil say:

"7. The respective marks are visually very similar in that they have the same four letters (C-E-C-I) at the start. Such letters form the first word of the mark applied for and the majority of the registered mark – in other words save for the letter "I" the word CECI in the mark applied for is identical to the mark CECIL. The absence of the last letter makes little visual impact, particularly bearing in mind the average consumer will rarely make a direct detailed comparison and relies on the imperfect picture of the marks in his mind. Moreover, it is settled case law that it is the first syllables or the beginning of words to which consumers pay most attention and that are thus in general of most importance.."

30. Insofar as the distinctive and dominant element of KF's trade mark and the trade mark of Cecil is concerned, I agree with Cecil that consisting as they do of four and five letter words respectively, and as the first four letters in each word are identical, there is a high degree of visual similarity between them. Given my conclusion above on the very limited contribution the word tokyo is likely to make to KF's trade mark, **overall this results in a high degree of visual similarity between the respective trade marks.**

Aural similarity

31. In their written submissions Cecil say:

"8. The words CECIL and CECI are similar aurally and phonetically: both words have two syllables – the first syllable (CE) is identical and the second syllable varies only by the soft consonant "I" which makes limited phonetic or aural difference. Further, both words have the same (e/i) vowel pattern and aural rhythm.

9....The relevant territory is the UK since domestic protection is sought and the relevant language is accordingly English..."

32. Once again I agree with Cecil. In my view the distinctive and dominant element of KF's trade mark and the trade mark of Cecil are aurally similar to a high degree. One need look no further for confirmation of this point (as pointed out by Mr Benson in his second statement) than Ms Hong's comment when she says:

"The ceci part...would be pronounced "sessy" whereas CECIL would be pronounced "sessill."

33. If the distinctive and dominant element of KF's trade mark is pronounced in the manner Ms Hong suggests, and I see no reason to doubt her views in this regard, and given my views on the limited contribution the word Tokyo is likely to make to KF's trade mark, **overall it will result in a high degree of aural similarity between the respective trade marks.**

Conceptual similarity

34. In her statement Ms Hong argues that although ceci is a word in the French language meaning "this" in English (exhibit KH4 refers), this meaning is, in her view, unlikely to be known by many English speakers. At exhibit KH4 she also provides evidence to establish that the word CECIL is a male forename. The conclusion Ms Hong wants me to draw from this evidence is, I presume, that the respective trade marks can be distinguished on a conceptual level, as one is a well known male forename, and the other is likely to be treated as an invented word.

35. In their written submissions Cecil say:

"10. Conceptually, the mark CECIL represents a name. The word CECI is meaningless in the English language. It is however recognisable as a girl's name, both of itself and as an abbreviation for the name Cecillia. Cecillia is in turn the female gender equivalent of the name Cecil. In the premises, it is submitted that there are conceptual similarities between the marks (both being (equivalent) names), alternatively that any conceptual differences (i.e. name versus meaningless word) are neutral, and do not override the above identified visual, aural and phonetic similarities. Average consumers of the goods in question are likely to perceive the word CECI as conceptually similar to the mark CECIL or as conceptually neutral."

36. In reaching a conclusion on this point I have kept in mind the comments of the CFI in *Phillips-Van Heusen Corp v Pash Textilvertrieb und Einzelhandel GmbH* Case T-292/01 [2004] ETMR 60 when they said:

"54. Next, it must be held that the conceptual differences which distinguish the marks at issue are such as to counteract to a large extent the visual and aural similarities pointed out in paragraphs 49 and 51 above. For there to be such a counteraction, at least one of the marks at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is

capable of grasping it immediately. In this case that is the position in relation to the word mark BASS, as has just been pointed out in the previous paragraph. Contrary to the findings of the Board of Appeal in paragraph 25 of the contested decision, that view is not invalidated by the fact that that word mark does not refer to any characteristic of the goods in respect of which the registration of the marks in question has been made. That fact does not prevent the relevant public from immediately grasping the meaning of that word mark. It is also irrelevant that, since the dice game Pasch is not generally known, it is not certain that the word mark PASH has, from the point of view of the relevant public, a clear and specific meaning in the sense referred to above. The fact that one of the marks at issue has such a meaning is sufficient - where the other mark does not have such a meaning or only a totally different meaning - to counteract to a large extent the visual and aural similarities between the two marks.”

37. In relation to the conceptual message the distinctive and dominant element of KF's trade mark and that of Cecil is likely to convey to the average consumer is concerned, the parties agree that CECIL is a name. However, while Cecil say that ceci is meaningless in the English language, they go on to argue that Ceci is recognisable as a girl's name both of itself and as an abbreviation for Cecilla, that Cecilla is the female gender equivalent of the name Cecil, and that these factors combine to create conceptual similarity; in the alternative, they argue that any conceptual differences are neutral.

38. I have no evidence on how either trade mark is likely to be perceived by the average consumer. That said, turning first to the word CECIL, I agree with the parties that it would be seen as a name. In my experience it is more often used as a forename (albeit a slightly old fashion one); that said, I accept that it is also a surname, albeit not in my experience a very common one. While I have submissions from Cecil as to how they think ceci will be construed by the average consumer, these are not matters of which I am prepared to take judicial notice and, as I mentioned above, no evidence has been provided to support these contentions. In those circumstances, I do not see how the messages the respective trade marks convey can be considered, as Cecil argue, conceptually neutral. **While CECIL is likely to send a clear conceptual message as either a forename or surname, absent evidence to the contrary, ceci is unlikely, in my view, to send any conceptual message.**

Distinctive character of Cecil's trade mark

39. I must now assess the distinctive character of Cecil's trade mark. As Cecil are not relying on any evidence of the use they may have made of their trade mark, I have only the inherent characteristics of the trade mark to consider.

40. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002]

ETMR 91. 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 for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

41. I have already accepted that the word CECIL is likely to be known as either a forename or surname. Given that it is a well established practice for traders to use their forenames or surnames (or a combination of the two) as trade marks, Cecil's trade mark is likely to be readily perceived as such by the average consumer. As I mentioned above, its use as a forename is, I think, slightly old fashioned and it is not, as far as I am aware, a common surname. **In those circumstances, I think it is a trade mark possessed of a reasonable level of inherent distinctive character.**

Likelihood of confusion

42. 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 Cecil'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 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 they have retained in their mind.

43. In summary, I have concluded that:

- (i) the respective goods at issue are identical (paragraph 21);
- (ii) the average consumer is a member of the general public (paragraph 17);
- (iii) given the nature of the goods at issue the visual aspect of the comparison is likely to be the most important although aural considerations will also play a part in the selection process (paragraph 18);
- (iv) the average consumer is likely to pay a reasonably high level of attention to the selection of the goods (paragraph 19);
- (v) the word ceci is the distinctive and dominant element of KF's trade mark (paragraph 28);
- (vi) as a consequence of the conclusion at (v) above, there is a high degree of both visual and aural similarity between the respective trade marks (paragraphs 30 and 33);

(vii) Cecil's trade mark is likely to be seen by the average consumer as either a forename or surname and that to the average consumer the ceci element of KF's trade mark is unlikely to have any meaning (paragraph 38);

(viii) absent use Cecil's trade mark is possessed of a reasonable level of inherent distinctive character (paragraph 41).

44. I must now apply the global approach advocated to my findings to determine whether direct confusion (where one trade mark is mistaken for the other) or indirect confusion (where the goods would be assumed to come from economically linked undertakings) is likely to occur.

45. In their written submissions Cecil refer me to the decision of the CFI in the case mentioned at paragraph 26 above when the court said:

"57. It is appropriate, however, to examine the objective conditions under which the marks may be in opposition on the market. It must be observed that it is common in the clothing sector for the same mark to be configured in various different ways according to the type of product which it designates. It is also common for a single clothing manufacturer to use sub-brands (signs that derive from a principal mark and which share with it a common dominant element) in order to distinguish his various lines from one another (women's, men's, youth). In such circumstances it is conceivable that the relevant public may regard the clothing designated by the conflicting marks as belonging, admittedly, to two distinct ranges of products but as coming, none the less, from the same undertaking (see, to this effect, Fifties, paragraph 49). Accordingly, the Board of Appeal was right to find that the public might believe that the products designated by the mark BUDMEN formed part of a new range of products and were marketed by the proprietor of the 'BUD' mark or by an economically-linked undertaking (paragraph 22 of the contested decision). "

46. Cecil go on to say:

"18. The point applies with force in the present case. Average consumers of clothing are used to derivative or associated trade marks and take such marks to signify different product ranges or lines rather than different undertakings..CECIL is distinctive for the class 25 goods for which it is registered. Taken as a whole the mark CECI TOKYO is likely to lead average consumers to believe that [KF's] goods are an associated sub range of [Cecil] or that it refers to a new alternative clothing line emanating from [Cecil] or a linked undertaking.."

47. Earlier in this decision I summarised the evidence provided by KF in relation to their use of the ceci tokyo trade mark since 2004, together with their references to the use by others of trade marks not in issue in these proceedings; this latter evidence is of little value and I need say no more about it. As to the first issue, this was dealt with recently

in Tribunal Practice Notice (TPN) 4 of 2009. In the context of opposition proceedings, and in relation to a defence based on use of the application under attack which precedes the date of use or registration of the opponent's trade mark, the TPN says:

“4. The viability of such a defence was considered by Ms Anna Carboni, sitting as the appointed person, in *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09. Ms Carboni rejected the defence as being wrong in law.

5. Users of the Intellectual Property Office are therefore reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker's mark, or having used the trade mark before the attacker used or registered its mark are wrong in law. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker's mark.”

48. I need comment no further on this aspect of KF's case because, as the comments of the Appointed Person in the case mentioned above make it clear, such a defence is wrong in law.

49. In reaching a conclusion, I am of course aware that in certain circumstances conceptual differences between trade marks can have the effect of counteracting “to a large extent the visual and aural similarities” between them. However, in the circumstances of this case, I have concluded that notwithstanding that CECIL is likely to send a clear conceptual message to the average consumer whereas ceci is not, given the identity in the goods, the high degree of both visual and aural similarity, the nature of the purchasing process, the traits of the average consumer when purchasing the goods and the reasonable level of inherent distinctive character Cecil's trade mark possesses, that confusion is still likely to occur. In this regard, I think that this confusion is likely to result in the average consumer either mistaking one trade mark for the other, or assuming that the goods of KF emanate from an undertaking linked to Cecil.

50. In summary, the opposition has been successful and the application should be refused in its entirety.

Costs

51. As Cecil have been successful they are entitled to a contribution towards their costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, I award costs to Cecil on the following basis:

Preparing a statement and considering the other side's statement:	£200
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Official fee:	£200
Preparing evidence:	£500
Written submissions:	£500
Total:	£1400

52. I order K Fashions UK Ltd to pay to Cecil GmbH the sum of £1400. This sum is 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 20 day of January 2010

**C J BOWEN
For the Registrar
The Comptroller-General**