

O-050-13

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2595620

BY

ENWROUGHT LTD

TO REGISTER THE TRADE MARK:

HANSON ^{OF} LONDON

IN CLASSES 18 AND 25

AND

THE OPPOSITION THERETO

UNDER NO 103028

BY

ANSON'S HERRENHAUS KG

1) On 25 September 2011 Enwrought Ltd (Enwrought) filed an application for the registration of the trade mark:

HANSON ^{OF} LONDON

(the trade mark). The application for registration was published on 18 November 2011 with the specification:

leather accessories including handbags, luggage, purses, wallets, travelling bags, briefcases, rucksacks, umbrellas, whips, harness and saddlery, belts, clothing for animals, key rings, leather holders for travel documents;

articles of clothing, footwear and headgear.

The above goods are in classes 18 and 25 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) Anson's Herrenhaus KG (Herrenhaus) filed a notice of opposition to the registration of the application. It relies upon section 5(2)(b) of the Trade Marks Act 1994 (the Act), which states:

“(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.”

The opposition is based upon Community trade mark registration no 9230863 of the trade mark **Anson's**. The application for registration was filed on 7 July 2010 and the registration procedure was completed on 22 December 2010. Herrenhaus relies upon the following goods and services of the registration:

leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags, bags, handbags, pocket wallets, purses, key cases, rucksacks, bags; umbrellas, parasols and walking sticks; whips, harness and saddlery;

clothing, footwear, headgear,

advertising; business management services; business administration; office functions; retail services, including via websites and teleshopping, in relation to clothing, footwear, headgear, bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices, sunglasses, precious metals and their alloys and goods in precious metals or coated therewith, jewellery, precious stones, horological and chronometric instruments, leather and imitations of leather, and goods made of these materials, animal skins, hides, trunks and travelling bags, bags, handbags, wallets, purses, key cases, rucksacks, pouches, umbrellas, parasols and walking sticks, whips, harness and saddlery; arranging and conducting of advertising events and customer loyalty programmes.

The above goods and services are in classes 18, 25 and 35 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

3) Herrenhaus claims that the respective class 18 goods are identical or similar, the respective class 25 goods are identical and that the class 35 services are similar. It claims that the OF LONDON element would be seen by the average consumer as indicating from where the goods of Enwrought emanate. Herrenhaus claims that Hanson and Anson are well-known surnames “which evolved from each other”. It claims that the distinctive element of Enwrought’s trade mark is highly similar to its trade mark and that H is “verbally weak and often dropped or overlooked in pronunciation”.

4) Enwrought filed a counterstatement. It claims that the respective trade marks are not sufficiently similar for there to be a likelihood of confusion. Enwrought refers to two decisions of the registrar, BL O/276/08 and BL O/101/09, at some length. Enwrought claims that the opposition is “unnecessary and is a waste of costs”. It states that Herrenhaus is fully aware of the arguments because the same legal arguments were raised in the two decisions of the registrar and because they were raised by it in a letter to Herrenhaus. A copy of the letter is attached to the counterstatement. In this letter Enwrought stated that if Herrenhaus did not withdraw its opposition it would seek an award outwith the scale. Enwrought claims that, owing to the previous decisions of the registrar, the filing of the opposition was unreasonable. It claims that Herrenhaus filed the opposition with no bona fide belief that it was soundly based and that the filing of the opposition was “entirely unreasonable”.

5) Both parties filed evidence. Neither party requested a hearing. Neither party furnished discrete written submissions. However, the witness statements filed on

behalf of the parties contained submissions and the counterstatement of Enwrought gave detailed submissions to try to rebut the case of Herrenhaus.

Evidence

Witness statement of Gareth Peter Jenkins of 11 July 2012

6) Mr Jenkins is a trade mark attorney who is acting for Herrenhaus. All of the exhibits to the witness statement are described as referring to a witness statement of Talat Ismail; it is assumed that this is the result of a word processing error.

7) Mr Jenkins states that from an Internet search he ascertained that Anson and Hanson are spelling variations of the same surname. Exhibited at GJ-1 is an extract from the Internet relating to the meaning and etymology of British surnames. It refers to a source from 1857 in these terms: "The son of Ann, or the same as Hanson, the son of Hans or John – the "H" being dropped in pronunciation". Exhibited at GJ-2 are pages from houseofnames.com in relation to the name Anson. The exhibit advises that "[k]nown variations of the Anson family name include Anson, Hanson, Ansen, Eanson, Ansin and others". Mr Jenkins states that an Internet search shows that the names Hanson and Anson may also be personal names. He exhibits at GJ-3 material relating to this. The material advises that, according to the US census of 1990, neither Anson nor Hanson are popular first names but that both are very popular surnames.

8) Mr Jenkins states that from his personal knowledge and experience, it is common practice for companies to be named after their founders and to include a geographical reference, such as of London, of Paris or of New York. He states that, from an Internet search, he sees that it is common for such companies to call themselves by the surname element of their names only, and for them to be referred to in this way by consumers. He exhibits material relating to Maybelline New York, L'Oreal Paris, Hermes of Paris, Aspinall of London.

Witness statement of Aine Mary Hanson of 9 August 2012

9) Ms Hanson is a director and shareholder in Enwrought. Her witness statement contains no evidence of fact. It consists of submission and so no summary of the contents is appropriate. However, the submissions, and those of the counterstatement, are borne in mind in reaching a decision.

Witness statement of Gareth Peter Jenkins of 14 September 2012

10) Parts of the witness statement are submission rather than evidence of fact and, while the submissions are taken into account, it is not appropriate to record them here. The evidence relates to London having a reputation for fashion and

that many trade marks include the word London. There is also evidence that the applicant, the subject of the two decisions of the registrar, is in liquidation.

Likelihood of confusion – section 5(2)(b) of the Act

Average consumer, nature of purchasing decision and standard for likelihood of confusion

11) The average consumer “is deemed to be reasonably well informed and reasonably circumspect and observant”ⁱ. The class 25 goods and the majority of the class 18 goods could be of low or high cost and the average consumer for the most part will be the public at large¹. If of low cost there will not necessarily be a particularly careful and educated purchasing decision. The nature of the goods will not militate greatly against the effects of imperfect recollection. In relation to class 25 goods the General Court (GC) stated in *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs) Joined Cases T-117/03 to T-119/03 and T-171/03*:

“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 that 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.”

In the same decision the GC stated:

“49 However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other

¹ An exception to this is *whips, harness and saddlery* but nothing turns upon this.

hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

The goods will be primarily bought from displays or rails in stores, from mail order catalogues and via the Internet. Consequently, they will be bought primarily by the eye and visual similarity will have greater weight than aural similarity in the consideration of likelihood of confusion.

Comparison of goods

12) The class 25 goods of the application are covered by the goods of the earlier registration. The class 18 goods of the application are either encompassed by the goods of the earlier registration or include goods that are covered by terms in the specification of the earlier registration; eg *clothing for animals* will include such goods made of leather and the earlier registration includes all goods made of leather that fall within the class. Goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark applicationⁱⁱ. Consequently, all of the goods are identical or must be considered to be identical. Owing to this identity, it is not necessary to consider the services upon which Herrenhaus relies.

Comparison of trade marks

13) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various detailsⁱⁱⁱ. 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^{iv}. Consequently, there cannot be an artificial dissection of the trade marks, although it is necessary to take into account any distinctive and dominant components. The average consumer rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he/she has kept in his/her mind and he/she is deemed to be reasonably well informed and reasonably circumspect and observant^v. The assessment of the similarity of the trade marks must be made by reference to the perception of the relevant public^{vi}.

14) The trade marks to be compared are:

HANSON ^{OF} LONDON

Anson's

15) The trade mark of Herrenhaus consists of the possessive form of the surname Anson. The public are used to the use of the possessive form and will attach little weight to it. The dominant and distinctive component of the trade mark is Anson. The average consumer will see OF LONDON as identifying the geographical base of the undertaking supplying goods under the Hanson name. London is the capital and largest city of the United Kingdom. Identifying a business as being OF LONDON will have little effect upon the perception or recall of the average consumer. OF LONDON has no distinctiveness in the context of the trade mark and the goods. Hanson is a surname and will be seen as identifying the source of the goods. Hanson is the dominant and distinctive component of the trade mark of Enwrought.

16) Herrenhaus comments upon the two surnames having the same derivation. The average consumer is not going to know this, no more than he is going to know that some people use these names as forenames. The fundamental meaning of Hanson and Anson is as surnames; different surnames. Surnames are one of the most fundamental ways of distinguishing between persons and undertakings; that they are both surnames does not bring about a conceptual identity or similarity that will have an effect upon the likelihood of confusion as their differences identify different persons or undertakings by their nature. As they are different surnames they are, effectively, conceptually different.

17) It is common for people to drop h's in speech. The apostrophisation of Anson will have limited effect in oral use. OF LONDON has to be taken into account. However, it will have little effect upon the perception of the average consumer. Bearing in mind the dominant and distinctive components of the respective trade marks, there is a good deal of aural similarity between the trade marks.

18) Visually the OF LONDON of Enwrought's trade mark must be taken into account; however, it will have little effect on the perception of the average consumer. Equally the apostrophe s in Herrenhaus's trade mark will have little perceptual impact upon the average consumer. The presence of the letter H in Hanson has an important effect, as the visual impact cannot be divorced from the perception of the average consumer, seeing a common surname. The anson element is common to the two trade marks. The distinctive and dominant

components have a good deal of visual similarity as letters outside the context of their use as surnames. However, they will not be perceived as abstract letters forming invented words. They will be perceived as common surnames. Consequently, the h in the trade mark of Enwrought has a significant effect and, in terms of the perception of the average consumer, the respective trade marks have limited visual similarity.

Conclusion

19) In considering whether there is a likelihood of confusion various factors have to be taken into account. There is the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa^{vii}. The respective goods are identical. The sequitur of this degree of similarity is not that the trade marks have to be very different to avoid a finding of likelihood of confusion^{viii}. It is necessary to consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade mark the greater the likelihood of confusion^{ix}. 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^x. In determining the distinctive character of a 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 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^{xi}. The trade mark of Herrenhaus consists of an ordinary surname in the possessive form. The trade mark does not allude to the goods and services of the registration. Surnames are a fundamental and common way to identify the products and services of undertakings. The public are used to relying upon them to identify goods and services. The trade mark of Herrenhaus enjoys a reasonable deal of distinctiveness.

20) As the public are used to relying upon surnames to identify goods and services, so are they used to distinguishing between surnames.

21) Owing to the nature of the goods, in considering the likelihood of confusion, the visual aspect is of more importance than the aural aspect. In *Mülhens GmbH & Co KG v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case C-206/04 P the Court of Justice of the European Union stated:

“21 It is conceivable that the marks’ phonetic similarity alone could create a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see, in respect of Directive 89/104, *Lloyd Schuhfabrik Meyer*, paragraph 28). However, it must be noted that the existence of such a likelihood must be established as part of a global assessment as regards the conceptual, visual and aural similarities between the signs at issue. In

that regard, the assessment of any aural similarity is but one of the relevant factors for the purpose of that global assessment.

22 Therefore, one cannot deduce from paragraph 28 of the judgment in *Lloyd Schuhfabrik Meyer* that there is necessarily a likelihood of confusion each time that mere phonetic similarity between two signs is established.....

....35 That global assessment means that conceptual and visual differences between two signs may counteract aural similarities between them, provided that at least one of those signs has, from the point of view of the relevant public, a clear and specific meaning, so that the public is capable of grasping it immediately (see, to that effect, Case C-361/04 P *Ruiz Picasso and Others v OHIM* [2006] ECR I-0000, paragraph 20).”

In this case conceptually the respective trade marks will be readily distinguished as they are different surnames. This conceptual difference will militate against any visual confusion, as it will have a definite effect upon the perception of the average consumer. These conceptual and effective visual differences will counteract the aural similarity between the trade marks. **There is not a likelihood of confusion. The ground of opposition under section 5(2)(b) of the Act is dismissed.**

Costs

22) Enwrought has requested costs outwith the scale. It submits, inter alia, that it was forced to seek legal assistance as a result of the filing of the opposition. An applicant should be aware from the extensive information on the Intellectual Property Office website that an application might be the subject of legal proceedings. It was the choice of Enwrought to seek legal assistance; it could have prosecuted the case itself, as many others do. Enwrought also submits that the opposition was unreasonable. It does not consider that the basis of the opposition was clearly and extensively argued. The statement of grounds of Herrenhaus gives a full basis of the opposition; it is difficult to envisage what else could have been added. Enwrought raises the issue of two earlier cases. These cases involved the same trade mark that was being opposed by Herrenhaus; a device and word trade mark. There were two oppositions as the original application had been divided. This hardly represents a tranche of cases. It is trite, but correct, that each case must be judged on its own facts. There is nothing fanciful about the opposition of Herrenhaus; there is a clear issue as to the phonetic similarity of the dominant and distinctive components of the respective trade marks. There has been nothing abusive in the behaviour of Herrenhaus. Costs will not be awarded outwith the scale.

23) The witness statement furnished by Enwrought was not evidence of fact and rehearsed part of what had been said in the counterstatement. Nothing will be

awarded in respect of this witness statement. Costs are awarded upon the following basis:

Preparing a statement and considering the other side's statement:	£600
Considering the evidence of Herrenhaus:	£200
Total:	£800

Anson's Herrenhaus KG is to pay Enwrought Ltd the sum of £800. 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 31st day of January 2013

David Landau
For the Registrar
the Comptroller-General

ⁱ *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* Case C-342/97.

ⁱⁱ *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-133/05 paragraph 29.

ⁱⁱⁱ *Sabel BV v Puma AG* Case C-251/95.

^{iv} *Sabel BV v Puma AG* Case C-251/95.

^v *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* Case C-342/97.

^{vi} *Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02.

^{vii} *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97.

^{viii} See *Meda Pharma GmbH & Co KG c Office de l'harmonisation dans le marché intérieur (marques, dessins et modèles) (OHMI)* Dans les affaires jointes T-492/09 et T-147/10:

« 50 La requérante soutient que, en cas d'identité de produits, il est nécessaire, pour exclure tout risque de confusion, que les signes présentent une plus grande différence que dans une situation où l'écart entre les produits est important. Or, dans les circonstances de l'espèce où l'identité des produits n'est pas contestée, la chambre de recours aurait dû conclure au risque de confusion, à l'instar de ce qui a été considéré dans la décision R 734/2008-1 de la première chambre de recours de l'OHMI, du 14 septembre 2009 (Alleris et Allernil). Selon la requérante, plusieurs décisions de l'OHMI

démontrent que les décisions attaquées s'écartent de la pratique décisionnelle de l'OHMI, ce qui viole les principes d'égalité et de non-discrimination.

51 Il ressort de la jurisprudence que l'OHMI est tenu d'exercer ses compétences en conformité avec les principes généraux du droit de l'Union. Si, eu égard aux principes d'égalité de traitement et de bonne administration, l'OHMI doit prendre en considération les décisions déjà prises sur des demandes similaires et s'interroger avec une attention particulière sur le point de savoir s'il y a lieu ou non de décider dans le même sens, l'application de ces principes doit toutefois être conciliée avec le respect du principe de légalité. Au demeurant, pour des raisons de sécurité juridique et, précisément, de bonne administration, l'examen de toute demande d'enregistrement doit être strict et complet afin d'éviter que des marques ne soient enregistrées de manière induue. C'est ainsi qu'un tel examen doit avoir lieu dans chaque cas concret. En effet, l'enregistrement d'un signe en tant que marque dépend de critères spécifiques, applicables dans le cadre des circonstances factuelles du cas d'espèce, destinés à vérifier si le signe en cause ne relève pas d'un motif de refus [voir, en ce sens, arrêt de la Cour du 10 mars 2011, *Agencja Wydawnicza Technopol/OHMI*, C-51/10 P, non encore publié au Recueil, points 73 à 77, et la jurisprudence citée, et arrêt du Tribunal du 22 novembre 2011, *LG Electronics/OHMI (DIRECT DRIVE)*, T-561/10, non publié au Recueil, point 31).

52 Or il apparaît que, dans la présente affaire, la chambre de recours a correctement pris en compte les circonstances de l'espèce. À cet égard, elle a, à juste titre, constaté l'identité des produits concernés en l'espèce, elle a aussi retenu une similitude très faible des signes en cause sur les plans phonétique et visuel et une impossibilité de comparaison de ces mêmes signes sur le plan conceptuel, comme il ressort des points 40, 41 et 46 ci-dessus. Dès lors, comme le soutient à juste titre l'OHMI, l'identité entre les produits désignés est compensée par un très faible degré de similitude entre les signes en cause et la chambre de recours a pu conclure à bon droit à l'absence de tout risque de confusion, d'autant que le degré d'attention du public est accru et qu'il n'est pas démontré que la marque antérieure présente un caractère distinctif élevé. »

^{ix} *Sabel BV v Puma AG* Case C-251/95.

^x *Rewe Zentral AG v OHIM (LITE)* Case T-79/00.

^{xi} *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97.