

O-525-16

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK REGISTRATION NO 3076384

IN THE NAME OF NEXTCO LTD

FOR

THE TRADE MARK

CK Chair

IN CLASSES 20, 35 & 43

AND

**AN APPLICATION FOR A DECLARATION OF INVALIDITY THEREOF (UNDER
NO. 501100)**

BY

CALVIN KLEIN TRADEMARK TRUST

BACKGROUND

1) Nextco Ltd ('the proprietor') is the registered proprietor of the trade mark 'CK Chair' in respect of the following goods and services:

Class 20: Furniture namely, Chairs, Bar Stools, Benches, Chaises, Banquettes, Ottomans, Sofa Seating, Tables, Bars for Parties, Pillows/Cushions, coat racks, lecterns, Mirrors, Plinths, Screens, Garden Furniture, Lighted Furniture.


Class 35: Services for providing rental of furniture for business conferences, trade shows, exhibitions, parties and special events.

Class 43: Services for providing rental of furniture, garden furniture, rental of bars and catering services for use in temporary housing accommodations.

2) The trade mark was applied for on 10 October 2014. It was subsequently published in the Trade Marks Journal for opposition purposes on 07 November 2014. No opposition having been filed, it was entered on the register on 16 January 2015.

3) Calvin Klein Trademark Trust ('the applicant') claims that the trade mark registration offends under section 5(2)(b) of the Trade Marks Act 1994 ('the Act') and for that reason should be declared invalid under section 47(2)(a) of the Act.¹ Of the five earlier marks relied upon, the applicant, in its written submissions in lieu of a hearing, identifies the following European Union Trade Mark ('EUTM') as representing its best prospect of success:

¹ Other grounds under s.5(3) and 5(4)(a) were withdrawn by the applicant for invalidation in its submissions of 12 July 2016, paragraph 8.

EUTM details	Goods and services relied upon
<p data-bbox="204 309 459 338">EUTM No: 66753</p>  <p data-bbox="204 707 587 741">Filing date: 01 April 1996</p> <p data-bbox="204 763 754 848">Date of entry in the register: 19 July 1999</p>	<p data-bbox="852 309 1430 450">Class 8: Hand tools, cutlery, knives, forks, spoons and related eating utensils and related cooking utensils.</p> <p data-bbox="852 528 1366 613">Class 20: Furniture, mirrors, picture frames.</p> <p data-bbox="852 692 1417 1055">Class 21: Housewares and glass, combs, brushes, porcelain and related eating, cooking and decorative utensils, china, dinnerware, service pieces and the like, crystal, glassware, goblets, wine glasses, drinking utensils, pitchers and related items.</p> <p data-bbox="852 1133 1366 1330">Class 24: Textiles, fabric, linens, sheets, towels, bedspreads, duvets, shams, dust ruffles, blankets, pillow cases, comforters.</p> <p data-bbox="852 1408 1425 1991">Class 25: Women's, men's, boy's and girl's wearing apparel, jump suits, shirts, blouses, jackets, bathing suits, pants, shorts, warm-up suits, capes, walking shorts, jeans, suits, dinner jackets, raincoats, ties, socks, stockings/tights, hats, caps, outer coats, sweaters, skirts, coats, fur-trimmed coats, furs, vests, T-shirts, tennis and golf dresses, shorts, beach and swimming cover-ups, rainwear/raincoats, ponchos, tank tops,</p>

	<p>shoes, boots, slippers, blazers, pants, shirts, handkerchiefs, belts, gloves, dresses, shearling coats and jackets, scarves/shawls, sports jackets; men's and boy's underwear, underwear, sleepwear, loungewear including but not limited to briefs, boxers, athlete underwear, sport knits, T-shirts, tank tops, undershirts, basic underwear and robes, knitted and woven sleepwear, sleep shirts, pajama tops, pajama bottoms, breakfast jackets, smoking jackets, bed jackets, cover-ups, knitted and woven loungewear, lounging pants and tops, lounge jackets; women's and girl's underwear, intimate apparel and sleepwear, loungewear, bodywear, foundations, bras, girdles, garter belts, all in-ones, corselettes, body stockings, control briefs, control hipsters, contarter bikinis, bra slips, bra top camisoles, waist cinchers, bustiers, merry widows, camisettes, leotards and unitards, daywear - including but not limited to culottes, bikinis, hipsters, briefs, slips, blouse slips, camisole slips, chemise slips, culotte slips, evening slips, maternity slips, panty slips, princess slips, shadow panel slips, strapless slips, suit slips, tailored slips, half slips, petti-slips, bra slips, chemises, teddies, camisoles, bra top camisoles, braletts, tap pants and petti-pants, daywear,</p>
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	<p>loungewear, sleepwear and bodywear - including but not limited to nightgowns, toga nightgowns, night shirts, pajamas, shortie pajamas, baby-doll pajamas, T-shirt pajamas, french maid sleepers, harem pajamas, hostess culottes, lounging pajamas, rompers, sleep shorts, peignoirs, bed jackets, caftans, jumpsuits, teddies, bath robes, dressing gowns, kimonos, housecoats, beach togas, beach wrap-ups, breakfast coats, brunch coats, cocoons, dusters, hostess robes, kabuki robes, lounging robes, monk's robes, bra tops, crop tops and leggings.</p> <p>Class 27: Floor coverings, carpets, rugs, drapes, curtains, window and wall coverings.</p> <p>Class 35: Advertising and business services, advertising and promotional services.</p> <p>Class 42: Design and related services.</p>
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4) The trade mark relied upon by the applicant is an earlier mark in accordance with section 6 of the Act and, as it completed its registration procedure more than five years prior to the publication date of the contested mark, it is subject to the proof of use conditions, as per section 6A of the Act. The applicant made a statement of use in respect of all of the goods it relies upon.

5) The proprietor filed a counterstatement denying, with explanation, any likelihood of confusion under section 5(2)(b) of the Act. In answer to question 7 of the Form TM8 which states “Do you want the opponent to provide “proof of use”?” the proprietor ticked “Yes”. In the box underneath, it stated “Trade Mark ‘CK Chair’”. The official letter of 15 April 2016 informed the proprietor that proof of use can only be requested in respect of the marks being relied upon by the applicant. The proprietor was provided with an opportunity to clarify, for which of the applicant’s earlier marks, proof of use was being requested and to address a number of other deficiencies. The proprietor subsequently filed an amended Form TM8 and counterstatement addressing the other deficiencies but maintaining the request for proof of use for the trade mark “CK Chair”. The official letter of 12 May 2016 informed the proprietor that, as that is not a mark being relied upon by the applicant, the case would proceed “on the basis that there is no proof of use request...” The proprietor gave no response to that letter. The effect of this is that the applicant is entitled to rely on the full breadth of goods and services for which it made a statement of use without having to prove in evidence that it has used its mark for any of those goods or services.

6) Both parties filed written submissions only during the evidential rounds. The proprietor’s submissions are identical to those in the counterstatement. Neither party requested to be heard. Only the applicant filed written submissions in lieu of a hearing. I now make this decision on the basis of the papers before me.

Preliminary points

7) The proprietor asserts the following:

- It operates in a “completely different industry” to the applicant and therefore there cannot be a likelihood of confusion.
- It does not sell any goods, it only rents/hires out chairs to the event industry.

These submissions do not assist the proprietor. The applicant has not had to file proof of use, for the reasons given above, meaning that I must take into account the full breadth of goods and services covered by the registration. Further, I am required

to make the assessment of the likelihood of confusion under section 5(2)(b) notionally and objectively solely on the basis of the marks and goods and services as they appear before me. The actual goods and services which either party may currently be providing in the marketplace is irrelevant to that assessment. The reason for this approach is that marketing strategies are temporal and may change with the passage of time. Further, as a trade mark registration is a form of property, it could potentially be sold to a third party at some point in the future who may use it in a different way to that of the current proprietor. See for instance, *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, where the Court of Justice of the European Union stated:

“59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

DECISION

8) Sections 47(2)(a) and 5(2)(b) of the Act state:

“47(2) The registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, ...

(b)...

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.”

And:

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

(a)....

(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.”

9) The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

10) The goods and services to be compared are:

Applicant's goods	Proprietor's goods and services
<p>Class 8: Hand tools, cutlery, knives, forks, spoons and related eating utensils and related cooking utensils.</p> <p>Class 20: Furniture, mirrors, picture frames.</p> <p>Class 21: Housewares and glass, combs, brushes, porcelain and related eating, cooking and decorative utensils, china, dinnerware, service pieces and the like, crystal, glassware, goblets, wine glasses, drinking utensils, pitchers and related items.</p> <p>Class 24: Textiles, fabric, linens, sheets, towels, bedspreads, duvets, shams, dust ruffles, blankets, pillow cases, comforters.</p> <p>Class 25: Women's, men's, boy's and girl's wearing apparel, jump suits, shirts, blouses, jackets, bathing suits, pants, shorts, warm-up suits, capes, walking shorts, jeans, suits, dinner jackets, raincoats, ties, socks, stockings/tights, hats, caps, outer coats, sweaters, skirts, coats, fur-trimmed coats, furs, vests, T-shirts, tennis and golf dresses, shorts, beach and swimming cover-ups, rainwear/raincoats, ponchos, tank tops,</p>	<p>Class 20: Furniture namely, Chairs, Bar Stools, Benches, Chaises, Banquettes, Ottomans, Sofa Seating, Tables, Bars for Parties, Pillows/Cushions, coat racks, lecterns, Mirrors, Plinths, Screens, Garden Furniture, Lighted Furniture.</p> <p>Class 35: Services for providing rental of furniture for business conferences, trade shows, exhibitions, parties and special events.</p> <p>Class 43: Services for providing rental of furniture, garden furniture, rental of bars and catering services for use in temporary housing accommodations.</p>

shoes, boots, slippers, blazers, pants, shirts, handkerchiefs, belts, gloves, dresses, shearling coats and jackets, scarves/shawls, sports jackets; men's and boy's underwear, underwear, sleepwear, loungewear including but not limited to briefs, boxers, athlete underwear, sport knits, T-shirts, tank tops, undershirts, basic underwear and robes, knitted and woven sleepwear, sleep shirts, pajama tops, pajama bottoms, breakfast jackets, smoking jackets, bed jackets, cover-ups, knitted and woven loungewear, lounging pants and tops, lounge jackets; women's and girl's underwear, intimate apparel and sleepwear, loungewear, bodywear, foundations, bras, girdles, garter belts, all in-ones, corselettes, body stockings, control briefs, control hipsters, contarter bikinis, bra slips, bra top camisoles, waist cinchers, bustiers, merry widows, camisettes, leotards and unitards, daywear - including but not limited to culottes, bikinis, hipsters, briefs, slips, blouse slips, camisole slips, chemise slips, culotte slips, evening slips, maternity slips, panty slips, princess slips, shadow panel slips, strapless slips, suit slips, tailored slips, half slips, petti-slips, bra slips, chemises, teddies, camisoles, bra top camisoles, braletts, tap pants and petti-pants, daywear,

loungewear, sleepwear and bodywear - including but not limited to nightgowns, toga nightgowns, night shirts, pajamas, shortie pajamas, baby-doll pajamas, T-shirt pajamas, french maid sleepers, harem pajamas, hostess culottes, lounging pajamas, rompers, sleep shorts, peignoirs, bed jackets, caftans, jumpsuits, teddies, bath robes, dressing gowns, kimonos, housecoats, beach togas, beach wrap-ups, breakfast coats, brunch coats, cocoons, dusters, hostess robes, kabuki robes, lounging robes, monk's robes, bra tops, crop tops and leggings.

Class 27: Floor coverings, carpets, rugs, drapes, curtains, window and wall coverings.

Class 35: Advertising and business services, advertising and promotional services.

Class 42: Design and related services.

11) In the judgment of the CJEU in *Canon*, Case C-39/97, the Court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their

intended purpose and their method of use and whether they are in competition with each other or are complementary”.

12) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

13) In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

14) In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267, Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

15) In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

16) In *Kurt Hesse v OHIM*, Case C-50/15 P, The CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

17) In *Sanco SA v OHIM*, Case T-249/11, the General Court indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the

goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

18) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05 (*‘Meriç’*), the General Court stated that:

“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”.

19) Finally, I also bear in mind that, where it is not obvious to me that there is similarity between any of the respective goods and services, the onus is on the applicant to present evidence in support of its contentions that there is similarity (see, for example, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97, paragraph 22).

20) I will assess the similarity between the respective goods and services by addressing each of the classes in the proprietor’s registration in turn, beginning with class 20.

21) The applicant's specification includes 'furniture' in class 20. The proprietor submits that this term is vague. It is true that 'furniture' is a broad term but it is not vague in the sense that it is not clear what is or is not covered by it. As all of the proprietor's goods in class 20 are items of furniture (indeed, the specification begins with the phrase 'Furniture namely...'), they are encapsulated by the applicant's broad term 'furniture'. The goods are identical in accordance with *Meric*.

22) The proprietor's services in class 35 are 'Services for providing rental of furniture for business conferences, trade shows, exhibitions, parties and special events'. These services appear to have been classified incorrectly. According to the Nice Classification, they are proper to class 43. The applicant argues that these services are similar to its 'furniture'. I agree. Whilst the nature of the respective goods and services is different, not least because one is tangible and the other is not, the users will be the same and the trade channels will overlap. There is also complementarity given that furniture is indispensable to the proprietor's services and the goods and services may also be in competition e.g. a consumer may choose between purchasing furniture and renting it. There is a medium degree of similarity between the proprietor's 'Services for providing rental of furniture for business conferences, trade shows, exhibitions, parties and special events' and the applicant's 'furniture'.

23) The proprietor's services in class 43 (which have been correctly classified) are 'Services for providing rental of furniture, garden furniture, rental of bars and catering services for use in temporary housing accommodations.' Again, the applicant submits that these are similar to its 'furniture'. With the exception of the underlined services, I find that all of the proprietor's services in this class are similar to a medium degree to the applicant's 'furniture' for the reasons given in the preceding paragraph. As regards the underlined services, in the absence of any evidence before me showing otherwise, I struggle to see how these are similar to the applicant's 'furniture'. Bearing in mind the guidance in *Avnet*, the core meaning of the proprietor's underlined services is the provision of food and drink. Whilst the users may be the same, the nature and intended purpose is very different and there is no competitive relationship. In terms of complementarity, whilst certain caterers may, on occasion, also provide items of furniture such as tables and chairs, and, to that extent the trade channels may sometimes converge, I find that this is insufficient to

conclude that the respective goods and services are “indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods [and services] lies with the same undertaking.” Bearing in mind all factors, I find that there is no real similarity, within the parameters of the relevant case law, between the proprietor’s ‘catering services for use in temporary housing accommodations’ and the applicant’s ‘furniture’.

24) The applicant also asserts, without any supporting explanation, that its ‘design and related services in class 42’ are similar to the proprietor’s ‘catering services for use in temporary housing accommodations’. Suffice to say, it is far from obvious to me that there is any similarity between these services; I find them to be dissimilar.

25) As there can be no likelihood of confusion where there is no similarity between goods and services, the opposition fails at this point in relation to the proprietor’s ‘catering services for use in temporary housing accommodation’. To this end, see, for example, *Waterford Wedgwood plc v OHIM* – C-398/07 P, where the CJEU stated:

“35....Since the Court of First Instance found, in paragraph 35 of the judgment under appeal, that the goods in question were not similar, one of the conditions necessary in order to establish a likelihood of confusion was lacking (see, to that effect, *Canon*, paragraph 22) and therefore, the Court of First Instance was right to hold that there was no such likelihood.”

Average consumer and the purchasing process

26) It is necessary to determine who the average consumer is for the respective goods and services and the manner in which they are likely to be selected. 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.”

The average consumer for the relevant goods and services is both the general public and businesses (such as those in the event industry). Furniture is a broad term covering a wide range of items. Whilst most items of furniture are likely to be purchased for their functional purpose, generally speaking, I would expect the aesthetics of the product to also play a part in the consumer’s decision making process. Bearing this in mind, I would expect the purchasing act to be mainly visual for these goods, whether that be through selection of the goods by the eye in a high street retailer or from the pages of a website, for example. That is not to say, though, that aural considerations will be ignored. Furniture will vary greatly in price depending on the item in question. As the consumer may take into account factors such as functionality, size, colour and the material from which the goods are made (wood or plastic, for instance), generally speaking, I would expect the purchase to be a reasonably considered one. Insofar as the proprietor’s services are concerned, similar considerations apply given the connection between those services and furniture *per se*. Again, I would expect the purchase to be mainly visual given that the consumer is likely to seek out the services through visual inspection of internet pages (for example) and that the purchase is likely to be a reasonably considered one.

Comparison of marks



27) 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 the marks, bearing in mind their distinctive and dominant

components. The 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.”

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

28) For ease of reference, the marks to be compared are:

Applicant's mark	Proprietor's mark
 The logo consists of the letters 'C' and 'K' in a bold, serif font. The 'C' is positioned to the left of the 'K', and they are both rendered in a dark, solid color.	 The text 'CK Chair' is displayed in a standard, sans-serif font. 'CK' is in a larger size than 'Chair', and both are in a dark, solid color.

29) The proprietor's mark consists of the words 'CK Chair' in a standard font. In the context of goods which are chairs or services relating to the same, the descriptive nature of the word 'Chair' is such that it plays little role in the overall impression; in those circumstances the mark is dominated strongly by the letters 'CK'. For goods which are other types of furniture or services related to the same, the CK element would still be the more distinctive element having the greater weight in the mark's overall impression.

30) The applicant's mark consists of the letters 'CK' presented in such a way that the letter K is much larger than the letter C. Although the presentation of the letters plays a role in the overall impression, it is the letters themselves which have far more weight in the overall impression of the mark.

31) The marks coincide in respect of the letters 'CK' and differ to the extent that the proprietor's mark contains the word 'Chair' which is absent from the applicant's mark. While the particular presentation of 'CK' in the applicant's mark (small 'c' preceding the enlarged 'K') is absent from the proprietor's mark, the presence of those letters in both marks results in a good degree of visual similarity. As to the way in which the marks will sound when vocalised, again the presence of the letters 'CK' in both marks, which will be pronounced identically, results in a good degree of aural similarity between them notwithstanding the presence of the word 'Chair' in the proprietor's mark which is absent from the applicant's mark.

32) Turning to the conceptual position, I remind myself that a conceptual message is only relevant if it is capable of immediate grasp². The proprietor submits that the letters 'CK' in its mark stand for 'Chiavari Killer' and that 'Chiavari' is a well-known type of chair used in the event industry. In the absence of any evidence before me to indicate that the average consumer would perceive that meaning from the letters 'CK' in the proprietor's mark, I cannot attribute such knowledge to the average consumer. 'CK Chair' does not combine to form a unit in which the overall meaning is different to the two elements taken separately. The word 'Chair' creates a degree of conceptual difference between the marks (although where the goods are chairs or the services are related to chairs that concept will be entirely descriptive and therefore not a distinctive difference). The letters 'CK' will not evoke any immediately graspable concept in either of the marks; to that extent, there is neither conceptual similarity nor conceptual difference between the marks.

² This is highlighted in numerous judgments of the GC and the CJEU, including *Ruiz Picasso v OHIM* [2006] e.c.r. –I-643; [2006] E.T.M.R. 29.

Distinctive character of the earlier mark

33) The distinctive character of the earlier mark must be considered. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“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).

23. 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).”

As there is no evidence of use before me, I can only take into account the inherent qualities of the applicant's mark. The mark is not particularly high in distinctiveness given the propensity of many undertakings to adopt letters as indicators of trade origin, but neither is it particularly low in distinctiveness, given that it does not describe or allude to the goods covered by the earlier mark in any way. To my mind, the mark is possessed of a normal level of distinctive character.

Likelihood of confusion

34) I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

35) I have found that the marks are visually and aurally similar to a good degree. In terms of concept, I found that, whilst the word 'Chair' in the proprietor's mark creates a degree of conceptual difference between the marks (although where the goods are chairs or services are related to chairs that concept will be entirely descriptive and therefore not a distinctive difference), the letters 'CK' will not evoke any immediately graspable concept in either of the marks and, to that extent, there is neither conceptual similarity nor conceptual difference between the marks. I have also found that the relevant goods and services are either identical or similar to a medium degree and that the earlier mark has a normal degree of distinctive character. Weighing all of these factors against each other, I find that, despite the purchase being a reasonably considered one, there is a likelihood of confusion on the part of the average consumer.

OUTCOME

36) The application for invalidation succeeds against the following goods and services (these will be removed from the register):

Class 20: Furniture namely, Chairs, Bar Stools, Benches, Chaises, Banquettes, Ottomans, Sofa Seating, Tables, Bars for Parties, Pillows/Cushions, coat racks, lecterns, Mirrors, Plinths, Screens, Garden Furniture, Lighted Furniture.

Class 35: Services for providing rental of furniture for business conferences, trade shows, exhibitions, parties and special events.

Class 43: Services for providing rental of furniture, garden furniture, rental of bars

37) The application for invalidation fails against the following services (the mark will remain registered for these services):

Class 43: Catering services for use in temporary housing accommodations.

COSTS

38) As the applicant has been largely successful, it is entitled to a contribution towards its costs. Using the guidance in Tribunal Practice Notice 4/2007, I award the applicant costs on the following basis:

Official fee (TM26I)	£200
Preparing the application for invalidation and considering the counterstatement	£200
Written Submissions	£300
Total:	£700

39) I order Nextco Ltd to pay Calvin Klein Trademark Trust 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 9th day of November 2016

**Beverley Hedley
For the Registrar,
the Comptroller-General**