

**O-414-17**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3205987 BY  
EUDICOTS LTD**

**TO REGISTER:**

**Hollyz**

**AS A TRADE MARK IN CLASS 25**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 600000644 BY  
CBM CREATIVE BRANDS MARKEN GMBH**

## **Background & pleadings**

1. On 11 January 2017, Eudicots Ltd (“the applicant”) applied to register the trade mark **Hollyz** for the goods shown in paragraph 12 below. The application was published for opposition purposes on 3 February 2017.

2. On 3 May 2017, the application was opposed in full under the fast track opposition procedure by CBM Creative Brands Marken GmbH (“the opponent”). The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon European Union Trade Mark (“EUTM”) registration no. 11306545 for the trade mark **HOLY** which has an application date of 30 October 2012 and registration date of 13 March 2013. Although registered for a range of goods and services in classes 18, 25 and 35, the opponent only relies upon the goods shown in paragraph 12 below.

3. The applicant filed a counterstatement in which the basis of the opposition is denied.

4. In these proceedings, the opponent is represented by Burges Salmon LLP; the applicant represents itself.

5. Rule 6 of the Trade Marks (Fast Track Opposition)(Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

6. The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions. No leave was sought in respect of these proceedings.

7. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings

requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary; only the opponent filed written submissions which I will refer to, as necessary, below.

## **DECISION**

8. The opposition is based 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.”

9. 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.”

10. The registration upon which the opponent relies qualifies as an earlier trade mark under the above provisions. As this earlier trade mark is not subject to proof of use, the opponent is entitled to rely upon all of the goods it has identified.

### **Section 5(2)(b) – case law**

11. The following principles are gleaned from the decisions of the European courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

### **The principles:**

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public 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**

12. The competing goods are as follows:

<b>The opponent's goods</b>	<b>The applicant's goods</b>
<b>Class 25</b> - Clothing, footwear, headgear.	<b>Class 25</b> - Boys' clothing; Children's clothing; Childrens' clothing; Clothes; Clothing; Clothing for babies; Formal

	evening wear; Formalwear; Ladies' clothing; Ladies' outerclothing; Silk clothing; but not including footwear; Capes; Capes (clothing); Children's headwear; Denim coats; Denim jackets; Ladies' dresses; Ladies' suits; Scarfs; Shirts; Shirts and slips; Shorts [clothing]; Headwear.
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13. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the General Court (“GC”) stated:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedral v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

14. The terms “clothes” and clothing” appearing in the application are either identical to, or a synonym of, “clothing” which appears in the opponent’s specification. As: (i) “Boys' clothing; Children's clothing; Childrens' clothing; Clothing for babies; Formal evening wear; Formalwear; Ladies' clothing; Ladies' outerclothing; Silk clothing; but not including footwear; Capes; Capes (clothing); Denim coats; Denim jackets; Ladies' dresses; Ladies' suits; Scarfs; Shirts; Shirts and slips; Shorts [clothing]” and (ii) “Children's headwear” and “Headwear in the application would be encompassed by (i) “clothing” and (ii) “headgear” which appear in the opponent’s specification, they too are either identical or to be regarded as identical on the principles outlined in *Meric*.

## **The average consumer and the nature of the purchasing act**

15. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods at issue; 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 *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.”

16. In its decision in *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, the GC stated:

“50. The applicant has not mentioned any particular conditions under which the goods are marketed. Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

17. I agree with the opponent that the average consumer of the goods at issue is a member of the general public. As such goods will, for the most part, be obtained by self-selection i.e. from the shelves of a bricks and mortar retail outlet or from the equivalent pages of a website or catalogue, visual considerations are likely to dominate the selection process. That said, as such goods may also be the subject

of, for example, word-of-mouth recommendations or oral requests to sales assistants, aural considerations must not be forgotten. As to the degree of care the average consumer will display when selecting such goods, as the opponent points out, the cost of the goods can vary considerably. However, as the average consumer will be alive to factors such as cost, size, colour, material and compatibility with other items of clothing, they will, in my view, pay at least a normal degree of attention to their selection.

### **Comparison of trade marks**

18. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“CJEU”) stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

19. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account 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 they create. The trade marks to be compared are as follows:



The opponent's trade mark	The applicant's trade mark
HOLY	Hollyz

20. The opponent's trade mark consists of the well-known English language word HOLY presented in block capital letters which the opponent accepts will be associated with "the concept of something religious". I agree. The overall impression it conveys and its distinctiveness lies in the word itself.

21. The applicant's trade mark consists of the word Hollyz presented in title case (although as the opponent points out, notional and fair use would also include the word presented in, inter alia, block capital letters). Like the opponent's trade mark, the overall impression it conveys and its distinctiveness lies in the word itself.

### **The visual, aural and conceptual comparison**

22. The competing trade marks consist of four and six letters respectively, the first three letters are identical and both include the letter "Y/y" in the fourth and fifth letter positions respectively. They differ to the extent that the applicant's trade mark contains an additional letter "l" in the fourth letter position and a letter "z" in the sixth letter position. The opponent characterises the degree of visual similarity as "moderate to a high degree"; in my view, moderate is a more appropriate description.

23. As to the aural comparison, I agree with the opponent that both parties' trade marks consists of two syllables and "share a similar rhythm and phonetic structure"; I further agree with the opponent that they are "aurally reasonably similar."

24. Finally, the conceptual comparison. The opponent has already concluded (and I have agreed), that its trade mark will be understood as relating to religion. As to the applicant's trade mark, the opponent notes the comment contained in the counterstatement i.e. that it was named "after our founder's daughter Holly Zang" and correctly points out that "the derivation of a mark is, of course, irrelevant." While its submission that it will be seen "as a contrived word" is not unreasonable, given what is likely to be the average consumer's familiarity with the female forename

“Holly” together with the propensity of those in trade to substitute the letter “z” for an “s” and notwithstanding the absence of an apostrophe symbol between the letters “y” and “z”, I think it entirely possible that many average consumers will understand it as the possessive form of the female forename “Holly”. However, for reasons which will become clear shortly, I shall proceed on the basis that the opponent’s trade mark sends a clear conceptual message and the applicant’s trade mark does not.

### **Distinctive character of the earlier trade mark**

25. 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.

26. These are fast track opposition proceedings in which it was not necessary for the opponent to provide evidence of the use it may have made of its earlier trade mark. As a consequence, I have only the inherent characteristics of its trade mark to consider. Although a very well-known word with a very well-known meaning, I agree with the opponent that it is neither descriptive nor non-distinctive for the goods at issue. It is, in my view, a trade mark possessed of a normal level of distinctiveness.

### **Likelihood of confusion**

27. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the

opponent's trade mark, as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision I concluded that:

- the competing goods are identical;
- the average consumer of the goods at issue is a member of the general public who will select the goods at issue by predominately visual means and who will pay at least a normal degree of attention during that process;
- the overall impression conveyed by both parties' trade marks and their distinctiveness stems from the single words of which they are composed;
- the competing trade marks are visually similar to a moderate degree and aurally similar to a reasonable degree;
- the opponent's trade mark will send a clear conceptual message and I am proceeding on the basis that the applicant's trade mark does not;
- the opponent's trade mark is possessed of a normal level of distinctiveness.

28. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.

29. In its submissions, the opponent refers to, inter alia, the following factors which it states will lead to a likelihood of confusion: (i) for the purposes of comparison, the general rule is that the first part of a trade mark is normally more important than the ending, (ii) goods which fall at the lower end of the price spectrum must be kept in mind and (iii) when used upon the goods in question, the trade marks may appear "in

a comparatively small font”. I agree that all of the above are important considerations which I must keep in mind.

30. In its submissions, the opponent states:

“17. The respective signs are visually and aurally similar. These similarities are not counteracted by conceptual differences...”

31. Although not cited by the opponent, that submission is likely to stem from the findings in two well-known cases. In the first, *The Picasso Estate v OHIM*, Case C-361/04 P, the CJEU found that:

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

32. In the second case, *Nokia Oyj v OHIM*, Case T-460/07, the GC stated:

“Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established (see, to that effect, Case C-16/06 P *Éditions Albert René* [2008] ECR I-0000, paragraph 98).”

33. In my view, the high point of the opponent’s case rests in the proposition that the competing trade marks appear in a relatively small font on goods which fall at the lower end of the price spectrum (in relation to which the average consumer will be more prone to the effects of imperfect recollection) with the average consumer according no conceptual meaning to the applicant’s trade mark. However, even in those circumstances, the concrete conceptual message conveyed by the opponent’s trade mark (which will fix itself in the average consumer’s mind and act as an aid to

prompt the average consumer's recall) is, in my view, more than sufficient to neutralise the degree of visual and aural similarities between the competing trade marks, even allowing for the effects of imperfect recollection. The position is, of course, even more pronounced if the average consumer conceptualises the applicant's trade mark as the possessive form of the well-known female forename Holly (which I think is entirely possible). There is no likelihood of confusion on either basis.

### **Overall conclusion**

34. The opposition has failed and, subject to any successful appeal, the application will proceed to registration.

### **Costs**

35. Awards of costs in fast track opposition proceedings filed after 1 October 2015 are governed by Tribunal Practice Notice ("TPN") 2 of 2015. Using that TPN as a guide, but bearing in mind the nature of the Notice of opposition and the applicant's response to it, I award costs to the applicant on the following basis:

Preparing a statement and considering                      £100  
the opponent's statement:

36. I order CBM Creative Brands Marken GmbH to pay to Eudicots Ltd the sum of £100. 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 6<sup>th</sup> day of September 2017

**C J BOWEN**  
**For the Registrar**