

**O-039-18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF:**

**TRADE MARK APPLICATION 3196234**

**BY UPO FURNITURE LIMITED**

**TO REGISTER THE FOLLOWING TRADE MARK IN CLASSES 14, 21 AND 25:**

**ARIELE**

**AND**

**OPPOSITION THERETO (NO. 408269) BY**

**CARLONT TRADING LIMITED**

## Background and pleadings

1. UPO FURNITURE LIMITED (the applicant) applied to register the trade mark **ARIELE** in the UK on 11 November 2016. It was accepted and published in the Trade Marks Journal on 18 November 2016 in respect of the following goods:

Class 14 - Precious metals; jewellery; precious stones; chronometric instruments.

Class 21 - Household utensils; household containers; glassware for household purposes; tableware of porcelain; earthenware; bone china tableware [other than cutlery].

Class 25 - Clothing; footwear; headgear; swimwear; sportswear; leisurewear.

2. CARLONT TRADING LIMITED (the opponent) opposes the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (the Act)<sup>1</sup>. This is on the basis of its earlier European Union (formerly Community) Trade Mark 012111571, for the mark **ARIELLA**, which was filed on 3 September 2013 and registered on 30 September 2014. The following goods and services are relied upon in this opposition:

Class 3 - Soaps for personal use, perfumes, eau de cologne, essential oils, cosmetics, after shave lotion, hair lotions, dentifrices, personal deodorants, bath and shower gel, body creams, shampoos.

Class 14 - Jewellery and fancy jewellery included rings, key-rings, buckles, ear rings, cuff links, bracelets, charms, brooches, necklaces, médaillons; horological and chronometric instruments included straps for wrist-watches, watches, wrist-watches, clocks, alarm clocks, cases for watches and watch-making.

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<sup>1</sup> The opponent initially relied upon sections 5(3) and 5(4)(a) in addition, but these grounds were subsequently withdrawn.

Class 18 - Handbags, purses and wallets.

Class 25 - Clothing, headgear; footwear not in relation to athletics or sports.

Class 35 - Advertising; Business management; Business administration; Office functions.

3. Given its date of filing, the opponent's mark constitutes an earlier mark in accordance with Section 6 of the Act. Further, given its date of registration, it is not subject to the requirement to show that genuine use has been made of it as per Section 6A of the Act.

4. The opponent argues that the applicant's mark is highly similar to its mark and is to be registered for goods in Classes 14, 21 and 25 which are identical and/or similar to its goods. It argues that the similarities between the marks and the goods means there is a likelihood of confusion which includes a likelihood of association.

5. The applicant filed a counterstatement denying the claims made. It argues that the marks are neither visually nor phonetically similar and that they differ conceptually. It argues that there is no similarity between the earlier mark's goods/services and the applied for Class 21 goods. It goes on to argue that the exclusion in Class 25 of the earlier mark, 'not in relation to athletics or sports', 'naturally narrows the goods set forth in Class 25', and that 'the average consumer would not associate swimwear, sportswear and leisurewear listed in the mark with the earlier mark'.

6. The applicant is self-represented. The opponent is represented by Briffa. Neither side filed evidence or requested a hearing. Both sides filed written submissions (although the opponent described its submissions as a skeleton argument) which will not be summarised but will be referred to as and where appropriate during this decision. This decision is, therefore, taken following a careful perusal of the papers.

## **Section 5(2)(b)**

7. Sections 5(2)(b) of the Act is 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”.

8. The following principles are gleaned from the decisions of the EU 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 might 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

9. The competing specifications read as follows:

Applicant's goods	Opponent's goods/services
	Class 3 - Soaps for personal use, perfumes, eau de cologne, essential oils, cosmetics, after shave lotion, hair lotions, dentifrices, personal deodorants, bath and shower gel, body creams, shampoos.
Class 14 - Precious metals; jewellery; precious stones; chronometric instruments.	Class 14 - Jewellery and fancy jewellery included rings, key-rings, buckles, ear rings, cuff links, bracelets, charms, brooches, necklaces, médaillons; horological and chronometric instruments included straps for wrist-watches, watches, wrist-watches, clocks, alarm clocks, cases for watches and watch-making.
	Class 18 - Handbags, purses and wallets.
Class 21 - Household utensils; household containers; glassware for household purposes; tableware of porcelain; earthenware; bone china tableware [other than cutlery].	
Class 25 - Clothing; footwear; headgear; swimwear; sportswear; leisurewear.	Class 25 - Clothing, headgear; footwear not in relation to athletics or sports.
	Class 35 - Advertising; Business management; Business administration; Office functions.

10. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court (GC) 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 fur 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”.

11. In the judgment of the Court of Justice of the European Union (CJEU) in *Canon*, 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 uses of the respective goods or services;
- b) The respective users of the respective goods or services;
- c) The physical nature of the goods or acts of services
- d) The respective trade channels through which the goods or services reach the market
- e) 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;
- f) 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 *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion 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 GC 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”.

14. In *Sanco SA v OHIM*, Case T-249/11, the GC 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-O-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”.



15. In its written submissions, the applicant states that the goods in Class 21 of the subject mark “differ on purpose and nature of the goods and services registered under the earlier mark” [sic]. It also says that all of the goods listed in Class 25 of the earlier mark may not be aimed at the same target market, given that sportswear, leisurewear and swimwear would be specific to those who partake in sports.

16. The opponent states in its skeleton argument that its Class 14 goods are identical or very highly similar to the applicant’s Class 14 goods, and that its Class 25 goods are identical or very highly similar to the applicant’s Class 25 goods. It also states that some of its goods in Classes 3 and 14 have some similarity to the applicant’s Class 21 goods, for reasons that I will come on to.

17. I will now consider the applicant’s and opponent’s arguments in respect of each of the applied for Classes.

#### Class 14

18. The applicant’s Class 14 specification covers jewellery and chronometric instruments which are also listed in the earlier mark and, as such, are identical.

19. The applicant’s Class 14 specification also includes precious metals and precious stones. The opponent does not specifically address the question of similarity between “precious metals” and “precious stones” to its goods beyond its general submission that its Class 14 specification is identical or very highly similar to the applicant’s Class 14 goods. Jewellery and chronometric instruments are often made from precious metals and frequently include precious stones. For example, an engagement ring or a watch will often contain both precious metals and precious stones. In my experience, retailers of jewellery commonly also deal in precious metals/stones, such as buying and selling bullion and jewels. Further, it would not be uncommon for a consumer to select precious stones/metal to incorporate into a particular item of jewellery. In view of all this, there is at least some similarity in terms of the channels of trade and, also, some complementarity. To my mind, “precious metals” and “precious stones” are moderately (between low and medium) similar to the opponent’s goods in class 14.

## Class 21

20. When considering the similarity of the applicant's Class 21 specification to the goods of the opponent's registered mark, the opponent states that "Class numbers are only administrative and so there is no reason why indications with different Class numbers cannot be held to be similar". Whilst I do not disagree with this general point, I note that in the Court of Appeal, Lord Justice Mummery observed in *Altecnic Ltd's Trade Mark Application* [2002] RPC 34 that the Class number also serves to interpret the scope of the specification in the case of any ambiguity.

21. The opponent argues that there is a degree of similarity between the applicant's Class 21 goods and some of the opponent's goods in Classes 3 and 14, in particular that 'household containers' in the applicant's Class 21 specification might cover containers for bath and shower gel, perfumes and shampoos, goods which are claimed in the opponent's Class 3 specification, and may also cover cases for watches and watch-making (and are therefore similar to watches in Class 14). The opponent does not discuss any other potential areas of conflict, but instead extrapolates that there is some similarity between Class 21 of the application and its registered goods.

22. I do not agree that there is any similarity between Class 21 of the application and the opponent's registered goods. I shall start with the claimed clash with the class 3 goods. The opponent's Class 3 specification does not include containers for bath and shower gel, perfumes and shampoos, but instead includes the goods themselves. These goods are usually packaged into containers by the producer prior to sale in order for the consumer to take the goods home. Household containers, whilst a fairly broad term, covers domestic items such as kitchen storage containers, refuse containers, etc. Whilst I accept that perfume bottles and shampoo/gel dispensers fall in Class 21, it would be a strain of the language to construe them as a "household container". Thus, there is nothing relevant (in relation to perfume, shampoo and shower gel) within the scope of "household containers" with which any similarity can arise. I accept that Class 21 also covers "soap containers" which could arguably fall within "household containers". However, whereas soap is purchased to clean the user, a soap container is used simply to hold the product once opened.

Thus, the purpose differs, as do the nature and method of use. The goods do not compete and they are usually found in a different shop or in a different area of a shop. The only potential argument I can see relates to complementarity. However, whilst they are often used together, the nature of the relationship is not one where the relevant public is liable to believe that responsibility for the goods lies with the same undertaking or with economically connected undertakings, in the same way that wine and wine glasses are not complementary for trade mark purposes.

23. The opponent also argues that the description 'household containers' in Class 21 might also include 'cases for watches and watch making'. However, it is clear from the Nice Classification that watch cases fall in class 14. They would certainly not fall within household containers in Class 21. Further, I can see no meaningful similarity between household containers and watches (or watch cases).

24. For these reasons, I do not consider the applicant's Class 21 specification to be similar to any of the goods or services in the opponent's registered mark. Furthermore, I can see no meaningful similarity between the applicant's goods in class 21 and the remaining goods and services in the earlier specification. In the absence of any obvious similarity or submissions on the point, I find that they are not similar.

### Class 25

25. The opponent's Class 25 specification reads:

Clothing, headgear; footwear not in relation to athletics or sports.

26. In its counterstatement the applicant submitted that the exclusion in the opponent's specification "naturally limits" the Class 25 goods and, therefore, the average consumer would not associate swimwear, sportswear and leisurewear (some of its goods) with those of the earlier mark. However, the semi-colon between 'headgear' and 'footwear not in relation to athletics or sports' separates the terms. This means that the limitation 'not in relation to athletics or sports' only applies to 'footwear', and does not limit the scope of either 'clothing' or 'headgear'.

27. The applicant states in its written submissions that 'all of the goods listed by the earlier mark in Class 25 may not be aimed at the same target market, given that sportswear, leisurewear and swimwear would be specific to those that were to partake in sports.' This submission appears to stem from the applicant's interpretation of the opponent's exclusion, a submission with which I have disagreed. Regardless, the fact of the matter is that the opponent's clothing (and headgear) is not limited in any way. Sportswear, leisurewear and swimwear are all types of clothing and, therefore, fall within the broad term 'clothing' covered by the earlier mark. These goods are therefore identical on the principle outlined in *Meric*. It follows that the terms 'clothing' and 'headgear' in both specifications are also identical.

28. The applicant has also applied for the term 'footwear' at large, while the opponent has registered 'footwear not in relation to athletics or sports'. Despite the points made by the applicant in relation to the exclusion, the goods are still identical on the *Meric* principle because the applied-for term still covers the goods of the earlier mark. It is not as though the applicant has limited its footwear to specific items that have nothing to do with athletics or sports. However, even if the applicant had sought to exclude athletic or sports footwear, I agree with the opponent's argument that 'footwear not in relation to athletics/sports' is commonly sold via the same channels of trade as footwear generally, and that these goods are often displayed close to each other and have a similar purpose. Therefore, any non-identical items of footwear would still be at least moderately (between low and medium) similar, with some footwear no doubt being much closer.

29. For these reasons, I agree with the opponent's submission that their Class 25 goods are identical (subject to what I have said in the previous paragraph regarding footwear).

### **Average consumer and the purchasing act**

30. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention

is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*.

31. 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.”

32. The average consumer of the majority of the applicant’s goods is likely to be the general public. However ‘precious metals’ and ‘precious stones’ may also be purchased by an intermediary. The goods in Classes 21 and 25 are everyday consumer items, whereas the goods in Class 14 are more likely to be less frequent purchases. There is likely to be an average level of care in purchasing the goods in Classes 21 and 25, and a slightly above average level of care in purchasing the goods in Class 14. I say only slightly because although jewellery and chronometric instruments can be relatively expensive, I must also consider those which are less so, but, nevertheless, they are still likely to be relatively considered purchases as they are purchased less frequently and with greater thought. I accept that for precious metal and stones the degree of care is high. All the goods could be selected from general merchandise stores, specialist stores, online stores, or perused in catalogues or brochures etc. There is a skew towards the purchase of the majority of the goods being more visual than aural, however the aural impact of the marks is still important to consider in the overall assessment.

## Comparison of marks

33. 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.”

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

35. The respective trade marks are shown below:

<b>ARIELLA</b>	<b>ARIELE</b>
Earlier trade mark	Contested trade mark

36. The opponent has claimed that the earlier mark is identical to the contested trade mark because the differences are so insignificant that they are unlikely to be noticed by the average consumer. However, the opposition has been made under Section 5(2)(b) of the Act, and so I have not addressed the question of identity of the marks.

37. The applied-for mark is made up of the word ARIELE. The opponent's mark is made up of the word ARIELLA. In terms of the marks' overall impressions, each mark is comprised of a single word which is the only thing which contributes to their respective overall impressions.

38. Visually, the first five letters of both marks are identical, being the letters 'A', 'R', 'I', 'E' and 'L'. The applicant's mark consists of six letters in total, the final letter being 'E'. The opponent's mark consists of seven letters in total, the final two letters being 'L' and 'A'. The two marks are visually similar to a medium to high degree.

39. Aurally, the first five letters of both marks are likely to be articulated as 'AH-REE-ELL'. However, the final 'e' of the applicant's mark is likely to be silent whereas the final syllable of the earlier trade mark is likely to be articulated as 'AH'. I find the marks to be similar aurally to a medium to high degree.

40. Conceptually, the marks appear to be similar to a medium to high degree. Both marks are likely to be appreciated by the majority of consumers as European female forenames, with a similar root. I accept that for some (likely the minority of) consumers the marks may be seen purely as invented words, in which case the marks are neither conceptually similar nor dissimilar.

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

41. In *Lloyd Schuhfabrik Meyer* 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).”

42. As no evidence has been filed, I have only the inherent characteristics of the earlier mark to consider. I have no specific submissions from the applicant or the opponent regarding this factor.

43. With regard to the inherent position, I bear in mind that, whilst not allusive of the goods, the earlier mark consists of a female forename. Names do not, generally speaking, make for the most distinctive of trade marks. However, since the name does not strike me as a common one, I consider the earlier mark to have a medium degree of inherent distinctive character.

#### **Conclusions on Likelihood of Confusion.**

44. I must now draw together my earlier findings into the global assessment of the likelihood of confusion, keeping in mind all the relevant factors. The marks are visually and aurally similar to a medium to high degree. The marks are both female forenames with a similar root and this will be appreciated by the majority of consumers. The earlier mark has a medium degree of inherent distinctive character. Given the marks' similarities, there is likely to be direct confusion between them, particularly when one bears in mind the concept of imperfect recollection. This is undoubtedly the case where the goods are identical. However, even for goods which are only similar (to the degree set out earlier) and even accepting that some of the goods represent a more considered purchase, imperfect recollection is still a factor which would lead, in my view, to a likelihood of confusion. I should add that even if I



am wrong on my conceptual assessment and, in fact, the average consumer would not regard the marks as names, I still consider the various factors to combine to create a likelihood of confusion.

45. There is no likelihood of confusion between the marks for the Class 21 goods. There is because there is no similarity between these goods and the goods and services relied on by the opponent, which means that there can be no likelihood of confusion.

## **Summary**

46. The application is to be refused for the following goods:

Class 14: Precious metals; jewellery; precious stones; chronometric instruments.

Class 25: Clothing; footwear; headgear; swimwear; sportswear; leisurewear.

47. Subject to appeal, the application may proceed to registration for the following goods:

Class 21: Household utensils; household containers; glassware for household purposes; tableware of porcelain; earthenware; bone china tableware [other than cutlery].

## **Costs**

48. The opponent has been partially (and in my view, the most) successful party and is, therefore, entitled to a contribution towards its costs. My assessment (based on the published scale) is set out below, adjusted to reflect the partial nature of the success:

Opposition fee: £100<sup>2</sup>

Preparing a statement of case and considering the counterstatement: £150

Filing written submissions: £200

49. I order UPO Furniture Limited to pay Carlont Trading Limited the sum of £450 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 18<sup>th</sup> day of January 2018**

**Oliver Morris**

**For the Registrar,**

**The Comptroller-General**

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<sup>2</sup> Although £200 was paid, this was because the opposition was initially based on additional grounds, which were then dropped. In such circumstances the opponent is not entitled to the full fee.