

O/058/19

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NO. UK00003235743 BY  
JENNY BROWN LIMITED  
TO REGISTER:

**Jools**

AND THE OPPOSITION THERETO UNDER NO. 600000738 BY  
JOOLS JEWELLERY LTD

AND

IN THE MATTER OF REGISTRATION NO. UK00003017441 FOR THE MARK:

The logo consists of the word 'jools' in a lowercase, red, serif font. The 'j' has a distinctive hook that extends downwards and to the left.

AND REGISTRATION NO. UK00003213764 FOR THE MARK:

The logo consists of the word 'jools' in a lowercase, black, sans-serif font. The 'j' has a distinctive hook that extends downwards and to the left.

AND APPLICATIONS FOR A DECLARATION OF INVALIDITY THERETO UNDER  
NO. 501972 AND NO. 501973  
BY JENNY BROWN LIMITED

## **BACKGROUND AND PLEADINGS**

1. On 7 June 2017, Jenny Brown Limited (“JB”) applied to register the trade mark **Jools** in the UK. The application was published for opposition purposes on 25 August 2017. JB seeks to register its mark for the following goods:

Class 14      Precious metals and their alloys; jewellery, precious and semi-precious stones; jewellery made of non-precious stones; parts and fittings for all the aforesaid goods; none of the aforesaid being costume jewellery or jewellery of base metals.

2. The application was opposed by Denise Harris and Jonathan Tait with Jools Jewellery Ltd (together “JJL”). The opposition is directed against all of the goods for which registration is sought. The opposition is based upon sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”). JJL rely on the following earlier UK Trade Mark registrations:

UKTM registration no. 3017441



(“the 441 Mark”)

Filing date of 9 August 2013; registration date of 15 November 2013

The 441 Mark is registered for the following services:

Class 35      Retail services and online retail services in connection with the sale of jewellery and watches; retail services and online retail services in connection with the sale of ornaments, glasswear, silverwear, figurines.

UKTM registration no. 3213764

# jools

("the 764 Mark")

Filing date of 20 February 2017; registration date of 11 August 2017

The 764 Mark is registered for the following services:

Class 35      Retail services in relation to jewellery; Retail services relating to jewelry; Retail services in relation to time instruments; Online retail services relating to jewelry.

3. The following services for which the 441 Mark is registered are relied upon by JJJ for the purposes of their opposition:

"Jewellery, watches and silverware – retail sales and services and online retail sales and services."

4. The following services for which the 764 Mark is registered are relied upon by JJJ for the purposes of their opposition:

"Retail and online retail services relating to jewellery and time instruments (watches)."

5. JJJ argue that the respective services are identical or similar and that the marks are identical or similar.

6. JB filed a counterstatement denying the claims made.

7. On 8 February 2018, JB applied to have the 441 Mark and the 764 Mark declared invalid under s.47 of the Trade Marks Act 1994 ("the Act"). The applications for invalidation are based upon section 5(2)(b) and section 5(4)(a) of the Act. The invalidity is directed against all of the services for which the 441 Mark and the 764 Mark are registered.

8. For its application based upon section 5(2)(b) of the Act, JB relies upon UK trade mark registration no. 2650261 for the following mark:



(“the 261 Mark”)

9. The 261 Mark was filed on 25 January 2013 and was registered on 3 May 2013. It is registered for the following goods:

Class 14      Precious metals and their alloys; jewellery, costume jewellery, precious stones.

10. For its application based upon section 5(4)(a) of the Act against the 441 Mark and the 764 Mark, JB claims that the following signs have been used throughout the UK since 2003:

**Jools** (“the First Sign”)

**jools by Jenny Brown** (“the Second Sign”)



(“the Third Sign”)



(“the Fourth Sign”)



("the Fifth Sign")

11. In addition, for its application for invalidation against the 764 Mark based upon section 5(4)(a) of the Act, JB also relies upon the sign shown in paragraph 8 above ("the Sixth Sign"). In its Grounds of Invalidity, JB states that the Sixth Sign has been used in the UK since 2010.

12. JB claims that the Signs have been used in respect of the following goods:

Precious metals and their alloys; jewellery, precious and semi-precious stones; jewellery made of non-precious stones; parts and fittings for all of the aforesaid goods; none of the aforesaid being costume jewellery or jewellery made of base metals.

13. JIL filed counterstatements denying the claims made.

14. The opposition and the applications for invalidity were subsequently consolidated.

15. JIL were originally represented by Clarke Wilmott LLP but are now unrepresented. JB is represented by Trade Mark Direct. JB filed evidence in the form of the witness statement of Leopoldo Gliksman dated 6 July 2018. This was accompanied by written submissions also dated 6 July 2018. No evidence was filed by JIL. No hearing was requested and only JB filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

## **EVIDENCE**

16. JB's evidence consists of the witness statement of Leopoldo Gliksman dated 6 July 2018, with 35 exhibits. Mr Gliksman is a director of JB; a position he has held since 19 September 2001.

17. Exhibit 1 to Mr Gliksman's statement consists of company registration documents for a company called Bellelogo Limited. No explanation is provided as to the relationship between this company and JB.

18. Exhibit 2 to Mr Gliksman's statement consists of a screen shot of a JPEG image displaying the Fifth Sign. Mr Gliksman states that this is an extract from JB's catalogue. This displays a "Date Modified" date of 24 August 2002 and displays necklaces and rings.

19. Mr Gliksman states that Exhibit 3 consists of extracts from the 'Jools' catalogue that was used by JB between 1999 and 2000. This displays the Fifth Sign and examples of what it describes as 'designer jewellery'. It states that the business was launched in 1998.

20. Exhibit 4 to Mr Gliksman's statement consists of an order placed with Noble Gift Packaging Ltd ("Noble") dated 19 August 2003, what appears to be a message to accompany jewellery sent to customers, two invoices issued by Noble and a witness statement provided by Mr Joseph Hackenbroch, Noble's Senior Sales Manager. The order placed with Noble, JB's packaging supplier, is for a variety of 'JOOLS designer jewellery' branded packaging. The message to customers references the JOOLS COLLECTION, but no further information is provided. The first invoice is dated 27 November 2006 for the sum of £781.21 and describes some of the goods as being "WITH JOOLS IN SILVER". The second is dated 31 January 2007 for the sum of £1069.96 and describes the goods as being "ALL ABOVE PRINTED WITH JOOLS LOGO". The goods described in the invoices are various types of jewellery boxes. In his statement, Mr Hackenbroch states:

"Noble Gift Packaging Limited (the Company) has been working with Jenny Brown Jewellery and Jenny Brown Ltd (this customer) before I began with the Company. Since the time I began with the Company, from my recollection of the Company, via myself, has been supplying this customer with jewellery gift boxes and gift packaging displaying the JOOLS imprint brand name."

21. Mr Gliksman states that Exhibit 5 is a Companies House change of address form for JB. However, this again, refers to the company Bellelogo Ltd and not JB.

22. Exhibit 6 shows product packaging which Mr Gliksman states was dated 2003, which displays the following marks:



23. Exhibit 7 consists of a selection of invoices, credit notes and statements issued by JB. Mr Gliksman states that these all relate to 'Jools' branded goods. They provide as follows:

<b>Document</b>	<b>Date</b>	<b>Total Amount Due (£)</b>
Invoice	01.08.2008	723.56
Invoice	18.07.2008	393.62
Credit Note	03.07.2009	219.99
Invoice	06.08.2009	139.15
Invoice	16.02.2009	85.10
Invoice	16.10.2009	285.66
Reminder (Statement)	24.11.2009	1,022.92
Statement	01.11.2010	242.05
Statement	06.04.2011	1,208.78

24. The invoices are all addressed to businesses located in the UK. The documents are all marked 'Jools', JOOLS DESIGNER JEWELLERY or show the following mark:



25. The invoices confirm sales of necklaces, bracelets, earrings, rings and beads. The 'Reminder (Statement)' does not confirm to what goods it relates. The statements also do not confirm to what goods they relate, but do show that they relate to a number of individual invoices that have been issued by JB.

26. Exhibit 8 is a print out of the JB website which Mr Gliksman states is dated 4 October 2010 (although no date is displayed on the page itself). The page displays the 261 Mark and shows the 'About Us' section which states "JOOLS has become a well known brand in the market" and "is now available across the UK".

27. Exhibit 9 consists of Financial Statements for JB dated between 2001 and 2017 and for the years 1999 to 2001 (prior to incorporation). These provide the total assets less current liabilities figures for the years going back to 2007:

<b>Date</b>	<b>Total assets less current liabilities (£)</b>
31.07.2017	276,265
31.07.2016	283,490
31.07.2015	256,086
31.07.2014	140,624
31.07.2013	105,239
31.07.2012	98,579
31.07.2011	63,120
31.07.2010	50,042
31.07.2009	7,507
31.07.2008	2,293
31.07.2007	8,990

28. I do not propose to reproduce any more of the financial information provided here, but I have taken it all into consideration.

29. Exhibit 10 is described by Mr Gliksman as a list of 'Jools' stockists as at 15 April 2009. This lists 7 businesses.

30. Exhibit 11 is a screenshot of what Mr Gliksman states is a wholesale agreement dated 24 January 2008 for the sale of 'Jools' branded goods by SKA, London. Only part of the document is visible and it is not clear whether the document is signed.



31. Mr Gliksman states that Exhibit 12 is an order form from one of JB's packaging suppliers for 'Jools' branded boxes dated 16 May 2008. It shows orders for 3,000 pendant/earring boxes, 2,500 ring/stud earring boxes, 2,000 bangle boxes and 2,000 necklace boxes.

32. Exhibit 13 is a wholesale agreement dated 16 February 2009 for the sale of 'Jools' branded jewellery by Charles Acland Agencies. The document is unsigned.

33. Mr Gliksman states that Exhibit 14 is an example of a 'Jools' branded advertising display dated 12 March 2010 (although the exhibit itself is undated). It is not clear whether this design was actually used.

34. Exhibit 15 shows examples of different stylisations of the word JOOLS. Mr Gliksman has highlighted the stylisation which was used going forward.

35. Exhibit 16 shows a draft message to existing 'Jools' customers which Mr Gliksman states was dated 28 May 2010. This offers customers the opportunity to register on JB's new website and offers a discount for orders placed before 30 July 2010.

36. Exhibit 17 consists of JB's terms and conditions and displays the 261 Mark. Mr Gliksman states that these are dated 2 March 2011.

37. Exhibit 18 is a screenshot of a JPEG image showing various pieces of jewellery on a display stand marked 'Jools'. Mr Gliksman states that this image was used as the Jools website front page and is dated 3 October 2011.

38. Exhibit 19 is a letter from JB to John Lewis Ltd introducing the 'Jools' jewellery collection dated September 2011.

39. Exhibit 20 provides details of display stands ordered by JB from one of their suppliers. The order is dated 12 January 2011.

40. Exhibit 21 consists of what appears to be a flyer offering 25% off goods for new customers. This displays the 261 Mark and Mr Glikzman states that it is dated 16 February 2011. The document description is 'A6 cards scotland n ireland email'.

41. Exhibit 22 is a wholesale agreement with Helen West Agencies and JB. Mr Glikzman states that it is dated 24 January 2008, but it is actually dated 17 March 2011. Again, this document is unsigned.

42. Exhibit 23 is a completed Conference Booking Form which is for an event on 5 January 2012. The name of the meeting is "JOOLS' – new agents".

43. Exhibit 24 consists of two print outs from the John Lewis website showing 'Jools by Jenny Brown' earrings for sale. The exhibit itself is undated but Mr Glikzman states that these are dated 6 December 2012 and 30 December 2012.

44. Exhibit 25 is a 'Jools by Jenny Brown' brochure displaying the 261 Mark which shows various items of jewellery. Mr Glikzman states that it is dated 23 August 2013.

45. Exhibit 26 is an email dated 12 January 2018 from an individual complaining about issues with an item of jewellery purchased from 'Jools'. The response is from JJL and is also dated 12 January 2018. It states:

"Unfortunately you are confusing our business with "Jools by Jenny Brown" as they have dropped the Jenny Brown from their name."

46. Exhibit 27 is a without prejudice letter from JJL to JB which is essentially a cease and desist letter. In any event, this letter does not assist JB in these proceedings.

47. Mr Glikzman states that Exhibit 28 consists of screenshots from various websites currently trading and offering timepieces, jewellery, ornaments, glasswear and figurines from the same store.

48. Exhibit 29 shows 'introduction cards' which Mr Glikzman states were attached to JB's silver jewellery items between 1999 and 2000. These show the following mark:



49. It also shows various photographs of a bracelet which Mr Gliksman states shows the JOOLS STAMP which has been embossed onto all jewellery since 2003. However, the print quality is poor and the stamp is not visible.

50. Exhibit 30 consists of photographs of boxes displaying the following marks:



51. Mr Gliksman states that these were provided by Noble for the sale of JB goods and relate to the boxes referred to in Exhibit 4.

52. Exhibits 31 and 32 show keyword search information for the website [www.joolsjewellery.online](http://www.joolsjewellery.online) and the number of views for the top viewed products between 1 July 2009 and 31 July 2018. The highest of these has 3863 views. The total number of views is 1,041,246.

53. Exhibit 33 is a sample of the orders received through the website [www.jennybrownjewellery.com](http://www.jennybrownjewellery.com) during 2010. The total sales shown amounts to over £5,500. Exhibit 34 consists of various statistical data for use of the previous websites [www.jennybrownjewellery.co.uk](http://www.jennybrownjewellery.co.uk) and [www.jennybrownjewellery.com](http://www.jennybrownjewellery.com) between 2009 and 2018.

54. Exhibit 35 consists of screen shots for the websites [www.jennybrownjewellery.com](http://www.jennybrownjewellery.com) and [www.impactjewellery.co.uk](http://www.impactjewellery.co.uk). Both show various jewellery products for sale and display the word JOOLS and the 261 Mark.

55. Mr Gliksman states that around 95% of the JB business is attributable to the Jools brands.

56. JB's evidence was accompanied by written submissions. JB also filed written submissions in lieu. Whilst I do not propose to summarise those here, I have taken them into account and will refer to them below as appropriate. JB also provided copies of various examples of decisions issued by this Tribunal and the judgment of other courts. I have taken these into account in so far as they are relevant.

## **PRELIMINARY ISSUES**

57. JB's evidence includes email correspondence which JB claims shows evidence of actual confusion between the marks. However, no context is provided as to how the consumer came into contact with the marks (for example, whether they appeared as registered or in some variant form). In any event, one individual mistaking one mark for the other would not be sufficient on its own to require a finding of confusion. I do not, therefore, consider that this evidence assists JB.

59. The outcome of JB's application to invalidate the registrations owned by JJJL may be determinative of the opposition brought by them as, if successful, it will remove from the register the registrations upon which JJJL rely as their earlier marks in the opposition. I will, therefore, deal with the applications for invalidation first.

## **DECISION**

### **THE INVALIDATION APPLICATIONS**

60. Section 5 of the Act has application in invalidation proceedings because of the provisions set out in section 47. The relevant legislation is set out below:

"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, or

(b) that there is an earlier right in relation to which the condition set out in section 5 (3) is satisfied

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

(2A) But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.”

61. Given the date of registration for the 261 Mark and the date of the applications, section 2A of the Act is satisfied. It is not subject to proof of use as the 261 Mark completed its registration period less than five years before the date on which the invalidation applications were made.

62. The invalidations are based on section 5(2)(b) and section 5(4)(a) of the Act. Section 5(2)(b) reads as follows:

“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.”

63. 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.”

64. Given the filing date of the 261 Mark, it qualifies as an earlier trade mark under section 6 of the Act.

65. Section 5(4)(a) of the Act reads as follows:

“5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

b) ...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark”.

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

66. 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 greater 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 to mind the earlier mark, 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**

67. The competing goods and services are as follows:

<b>JB's goods (the invalidation applicant)</b>	<b>JJL's services (the registered proprietor)</b>
<u>Class 14</u>	<b>The 441 Mark</b> <u>Class 35</u>



<p>Precious metals and their alloys; jewellery, costume jewellery, precious stones.</p>	<p>Retail services and online retail services in connection with the sale of jewellery and watches; retail services and online retail services in connection with the sale of ornaments, glasswear, silverwear, figurines.</p> <p><b>The 764 Mark</b>  <u>Class 35</u>  Retail services in relation to jewellery;  Retail services relating to jewelry; Retail services in relation to time instruments;  Online retail services relating to jewelry.</p>
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68. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“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.”

69. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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 service;

(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.

70. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“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.”

71. 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 observation 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.”

72. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), 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.”

73. 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.”

74. 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 the responsibility for those goods lies with the same undertaking.”

75. 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-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.”

### The 441 Mark

76. “Retail services and online retail services in connection with the sale of jewellery and watches” in J JL’s specification will need to be dealt with as two separate types of retail services. “Retail services and online retail services in connection with the sale of jewellery” will share the same users as “jewellery, costume jewellery, precious stones” in JB’s specification, that is, people intending to purchase jewellery. The method of use and nature of the goods and services will, of course, differ. However, they will be available through the same trade channels. Further, the goods are indispensable to the retail services relating to them and there is, therefore, a complementary relationship between them. I consider the goods and services to be similar to a medium degree. “Retail services and online retail services in connection with the sale of...watches” will share only a superficial degree of overlap in users with “jewellery, costume jewellery, precious stones” in JB’s specification, in that they will both be used by members of the general public. Whilst I recognise that there is a degree of similarity between watches and jewellery, the services for the sale of watches on the one hand and jewellery on the other are clearly further removed. The uses will differ. Whilst they

may, in some circumstances, be available through the same trade channels this is not sufficient on its own for a finding of similarity. It is the similarity in trade channels combined with the complementary relationship between jewellery and retail services in relation to jewellery which gives rise to the similarity between them. There is no such indispensable relationship between jewellery and retail services in relation to watches to give rise to a finding of complementarity. In my view, there is no similarity between “retail services and online retail services in connection with the sale of...watches” in JJJ’s specification and “jewellery, costume jewellery, precious stones” in JB’s specification. There is no similarity with any of JJJ’s other services.

77. “Retail services and online retail services in connection with the sale of ornaments, glasswear, silverwear, figurines” in JJJ’s specification and “Jewellery” in JB’s specification may have the same users on a superficial level as they will both be used by members of the general public. However, this is not sufficient on its own for a finding of similarity. JB has provided examples of businesses that sell both jewellery and ornaments and figurines. In my view, the evidence provided by JB is not sufficient to demonstrate that this is usual practice. The nature and method of use of the goods and services will be different. “Jewellery” cannot be said to be indispensable to the sale of ornaments, glasswear, silverwear and figurines. I do not, therefore, consider there to be a complementary relationship between the goods and services. There is no competitive relationship between them as you would not purchase one as an alternative for the other. In my view, there is no similarity between the goods and services. I have considered the other goods in JB’s specification and I see no further point of similarity which would put it in a stronger position.

78. As some degree of similarity between the goods and services is necessary to engage the test for likelihood of confusion<sup>1</sup>, the application for invalidation must fail in respect of “retail services and online retail services in connection with the sale of...watches” and “retail services and online retail services in connection with the sale of ornaments, glasswear, silverwear, figurines” in JJJ’s specification.

#### The 764 Mark

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<sup>1</sup> *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

79. For the same reasons set out at paragraph 76 above, “Retail services in relation to jewellery”, “retail services relating to jewelry” and “online retail services relating to jewelry” in JJJ’s specification will be similar to “jewellery” in JB’s specification to a medium degree.

80. That leaves, “retail services in relation to time instruments” in JJJ’s specification. “Time instruments” will include watches. Watches will be the closes goods within the category of “time instruments” to jewellery. As noted above, watches and jewellery clearly share a degree of similarity. Other time instruments within this category will be further removed in terms of their similarity to jewellery. However, this case does not concern the similarity between watches and jewellery, but the similarity between retail services relating to time instruments on the one hand and jewellery on the other. The use of retail services for time instruments and jewellery clearly differ. They differ in nature and method of use. The goods and services are not complementary as one is not indispensable for the other. There is no competitive relationship between them. They may, in some circumstances, be available through the same trade channels but this is not sufficient on its own to give rise to a finding of similarity. I therefore consider that there is no similarity between “retail services in relation to time instruments” in JJJ’s specification and “Jewellery” in JB’s specification. I do not consider “retail services in relation to time instruments” to be similar to any of JB’s other goods. As noted above, some degree of similarity is required to engage the test for a likelihood of confusion and so the application for invalidation must fail in respect of “retail services in relation to time instruments” in JJJ’s specification.

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

81. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods and services. I must then determine the manner in which these goods and services are likely to be selected by the average consumer. 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”.

82. I have no submissions from either party on the average consumer or the purchasing process for the goods and services in issue. In my view, the average consumer will be a member of the general public. The goods and services are likely to be purchased fairly infrequently and will vary significantly in cost. The level of attention paid by the average consumer is likely to be at least average.

83. The goods are, in my experience, most likely to be obtained by self-selection from the shelves of a retail outlet or a website or catalogue equivalent. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount that there may be an aural component to the purchase of the goods, given that advice may be sought from sales assistants or representatives. The services are likely to be purchased from specialist retail outlets or their online equivalents. The purchasing process for the services is likely to be dominated by visual considerations, as the average consumer is likely to select the services at issue following inspection of the premises' frontage on the high street, on websites and in advertisements (such as flyers, posters or online adverts). However, given that word-of-mouth recommendations may also play a part, I do not discount that there will be an aural component to the selection of the services.

### **Comparison of the trade marks**

84. 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 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.”

85. It would be wrong, therefore, to artificially dissect the trade marks, 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.

86. The respective trade marks are shown below:

<b>JB’s trade mark (the invalidation applicant)</b>	<b>JJL’s trade marks (the registered proprietor)</b>
 <p data-bbox="379 1541 608 1574">("the 261 Mark")</p>	 <p data-bbox="983 1480 1214 1514">("the 441 Mark")</p> <p data-bbox="983 1704 1214 1738">("the 761 Mark")</p>

87. I have lengthy submissions from JB on the similarity of the marks. Whilst I do not propose to reproduce those here, I have taken them all into account in reaching my decision.



## Overall Impression

88. The 261 Mark consists of the word JOOLS in large white font on a black rectangular background with the words BY JENNY BROWN in smaller font beneath the word JOOLS and offset to the right. All of the text is presented in a lower case, slightly stylised font. The 'dot' on the letter 'j' in the word JOOLS has been replaced with the silhouette of a diamond. However, it is clearly still the letter 'j'. In its Grounds of Invalidity, JB refers to a 'heart device' present in the 261 Mark. There does not appear to me to be any heart device in the 261 Mark as registered and it is not, therefore, clear what this is a reference to. The overall impression lies in the combination of these elements, but the word JOOLS plays a greater role due to its size. The other elements play a lesser role in the overall impression.

89. The 441 Mark consists of the word JOOLS presented in a lower case stylised font in red. The overall impression is dominated by the word itself, with the stylisation and the use of colour playing a lesser role.

90. The 764 Mark consists of the word JOOLS presented in a lower case stylised font in black. The overall impression is dominated by the word itself, with the stylisation playing a lesser role.

## Visual Comparison

### *The 261 Mark and the 441 Mark*

91. The dominant element of both marks is the word JOOLS. The difference is created by the other additional wording BY JENNY BROWN in the 261 Mark and its presentation in white on a black rectangular background and the use of the colour red in the 441 Mark. However, these elements play a lesser role in the overall impression of the marks. Further, registration in black and white covers use in any colour<sup>2</sup> and so JB's mark could be used in red. In my view, there is a high degree of visual similarity between the marks.

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<sup>2</sup> *Specsavers* [2014] EWCA Civ 1294

### *The 261 Mark and the 764 Mark*

92. The dominant element of both marks is the word JOOLS. The difference is created by the additional wording in the 261 Mark and the presentation in white on a black background and the stylisation in the 764 Mark. However, these elements play a lesser role in the overall impression of the marks. In my view, there is a high degree of visual similarity between the marks.

#### Aural Comparison

93. Aurally, the word JOOLS will be pronounced identically in all three marks, in the same way as the ordinary English word JEWELS (JEW-LS). This is the only element of the 441 Mark and the 764 Mark. It is possible that this will be the only element of the 261 Mark that will be pronounced. In that case, the marks will be aurally identical. If the wording BY JENNY BROWN in the 261 Mark is pronounced, then the marks will be aurally similar to a medium degree.

#### Conceptual Comparison

94. As noted above, the word JOOLS will be pronounced identically to the ordinary dictionary word JEWELS. This has a connection with the jewellery related goods and services for which the marks are registered/applied for. However, I consider it unlikely that this meaning will be attributed to the marks given the different spellings. The word JOOLS may also be seen as a shortening of the popular English female names Julie, Julia or Judith, but I consider it unlikely that this will be recognised as a name. This is particularly the case for the 261 Mark which already contains the name JENNY BROWN. The words BY JENNY BROWN will be understood to be the individual behind the business or products to which the mark relates. If I am wrong and there will be a meaning attributed to the word JOOLS then it will be identical for all of the marks. The presence of the diamond device used as the 'dot' on the 'j' in the 261 Mark may indicate that the mark relates to jewellery based goods. In my view, the marks are conceptually highly similar (with the only differences being that Jenny Brown will be identified as the individual behind the 261 Mark and its use of a diamond as the 'dot' on the 'j' may convey the nature of the goods for which the mark is registered).

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

95. 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-2779, 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 promotion of 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).”

96. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

97. JB has not pleaded that the distinctiveness of its mark has been enhanced through use. In any event, the evidence provided falls short of demonstrating that the distinctiveness of the mark has been enhanced through use. The accounts provided do not show sufficient sales to justify a finding of enhanced distinctiveness, given the

size of the market concerned. Further, JB has provided no indication of market share or evidence of how geographically widespread use of its mark has been.

98. I can, therefore, only consider the inherent distinctiveness of the earlier mark. The word JOOLS is a made-up word with no apparent meaning. As noted above, it is similar aurally to the ordinary dictionary word JEWELS which has a connection with the jewellery related goods for which the mark is registered. However, in my view, this connection is unlikely to be recognised by the average consumer. As noted above, if the consumer recognises that the 'dot' on the 'j' has been replaced with the silhouette of a diamond then this will be allusive of the jewellery related goods for which the mark is registered. I consider that the mark has at least a medium degree of inherent distinctive character.

### **Likelihood of confusion**

99. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where 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 services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade marks, the average consumer of the goods and services and the nature of the purchasing process. In doing so, I must be alive to 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 that he has retained in his mind.

100. I have found the parties marks to be visually and conceptually highly similar. I have found the marks to be aurally identical or similar to a medium degree, depending on whether the words BY JENNY BROWN in the 261 Mark are pronounced. I have

found the opponent's marks to have at least a medium degree of inherent distinctive character. I have identified the average consumer to be a member of the general public who will select the goods and services primarily by visual means (although I do not discount an aural component). I consider that at least an average degree of attention will be paid during the purchasing process. I have found the parties' goods and services to be similar to a medium degree (except for those that I do not consider share any similarity).

101. Notwithstanding the principle of imperfect recollection, I consider that the differences between the marks are sufficient to avoid the marks being misremembered or mistakenly recalled as the other. This is particularly so given that I have found that at least an average degree of attention will be paid during the purchasing process. I am satisfied that the consumer will not simply mistake one mark for another. I do not, therefore, consider that there is a likelihood of direct confusion.

102. It now falls to me to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

103. The dominant element of all three marks is the word JOOLS (albeit presented in different styles and along side additional matter). Taking into account my findings

summarised at paragraph 100 above, I consider that in respect of those goods and services which are similar to a medium degree, the consumer will view the marks as different configurations of the same mark which is being used by a single undertaking. There is, therefore, a likelihood of indirect confusion in respect of those goods and services which are similar to a medium degree.

104. The application for invalidation against the 441 Mark succeeds in respect of the following services:

Class 35      Retail services and online retail services in connection with the sale of jewellery.

105. The application for invalidation against the 764 Mark succeeds in respect of the following services:

Class 35      Retail services in relation to jewellery; Retail services relating to jewelry; Online retail services relating to jewelry.

106. I will now proceed to consider JB's applications for invalidation based on section 5(4)(a) of the Act in relation to the following services only:

The 441 Mark

Class 35      Retail services and online retail services in connection with the sale of watches; Retail services and online retail services in connection with the sale of ornaments, glasswear, silverwear, figurines.

The 764 Mark

Class 35      Retail services in relation to time instruments.

## **Section 5(4)(a)**

107. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “a substantial number” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

108. Whether there has been passing off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Daniel Alexander QC, sitting as the Appointed Person, considered the relevant date for the purposes of section 5(4)(a) of the Act and concluded as follows:

“43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceeding as follows:

“Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.”

109. The relevant date for assessing whether section 5(4)(a) applies, therefore, is the date of the application which is the subject of these proceedings – 8 February 2018.

## **Goodwill**

110. The House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) provided the following guidance regarding goodwill:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in customers. It is the one thing which distinguishes an old-established business from a new business at its first start.”

111. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C. 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not



occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

112. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

113. Goodwill arises as a result of trading activities. JB's claim to goodwill is supported by the financial information and invoices provided. These are low given the size of the market in question and in my view, JB has demonstrated only a small degree of goodwill. However, a small business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing off<sup>3</sup>. Mr Gliksman has confirmed that 95% of the JB business is attributable to the 'Jools' brands. The evidence shows various examples of the word 'Jools' being used by JB. The First Sign is shown on orders to packaging suppliers, invoices, website print-outs and communications with customers. Taking all of the evidence into account, I am satisfied that JB has demonstrated that it has acquired a small degree of goodwill in relation to jewellery and that the First Sign relied upon is distinctive of that goodwill. I will not consider the Second, Third, Fourth and Fifth Signs, as these do not improve JB's position.

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<sup>3</sup> *Stacey v 2020 Communications* [1991] FSR 49

## Misrepresentation

114. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

115. In *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA), Millet L.J. made the following findings about the lack of a requirement for the parties to operate in a common field of activity, and about the additional burden of establishing misrepresentation and damage when they do not:

“There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff's business. The expression “common field of activity” was coined by *Wynn-Parry J. in McCulloch v. May* (1948) 65 R.P.C. 58, when he dismissed the plaintiff's claim for want of this factor. This was contrary to numerous previous authorities (see, for example, *Eastman Photographic Materials Co. Ltd. v. John Griffiths Cycle Corporation Ltd.* (1898) 15 R.P.C. 105 (cameras and bicycles); *Walter v. Ashton* [1902] 2 Ch. 282 (The Times newspaper and bicycles) and is now discredited. In the *Advocaat* case Lord Diplock expressly recognised that an action for passing off would lie although “the plaintiff and the defendant were not competing traders in the same line of business”. In the *Lego* case *Falconer J.* acted on evidence that the public had been deceived into thinking that the plaintiffs, who were manufacturers of plastic toy construction kits, had diversified into the manufacture of plastic irrigation equipment for the domestic garden. What the plaintiff in an action for passing off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties.

The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration

‘...whether there is any kind of association, or could be in the minds of the public any kind of association, between the field of activities of the plaintiff and the field of activities of the defendant’:

*Annabel's (Berkeley Square) Ltd. v. G. Schock (trading as Annabel's Escort Agency)* [1972] R.P.C. 838 at page 844 per *Russell L.J.*

In the *Lego* case *Falconer J.* likewise held that the proximity of the defendant's field of activity to that of the plaintiff was a factor to be taken into account when deciding whether the defendant's conduct would cause the necessary confusion.

Where the plaintiff's business name is a household name the degree of overlap between the fields of activity of the parties' respective businesses may often be a less important consideration in assessing whether there is likely to be confusion, but in my opinion it is always a relevant factor to be taken into account.

Where there is no or only a tenuous degree of overlap between the parties' respective fields of activity the burden of proving the likelihood of confusion and resulting damage is a heavy one. In *Stringfellow v. McCain Foods (G.B.) Ltd.* [1984] R.P.C. 501 Slade L.J. said (at page 535) that the further removed from one another the respective fields of activities, the less likely was it that any member of the public could reasonably be confused into thinking that the one business was connected with the other; and he added (at page 545) that

‘even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.’

In the same case Stephenson L.J. said at page 547:

‘...in a case such as the present the burden of satisfying Lord Diplock's requirements in the *Advocaat* case, in particular the fourth and fifth requirements, is a heavy burden; how heavy I am not sure the judge fully appreciated. If he had, he might not have granted the respondents relief. When the alleged “passer off” seeks and gets no benefit from using another trader's name and trades in a field far removed from competing with him, there must, in my judgment, be clear and cogent proof of actual or possible confusion or connection, and of actual damage or real likelihood of damage to the respondents' property in their goodwill, which must, as Lord Fraser said in the *Advocaat* case, be substantial.’”

116. I recognise that similarity of goods and services is not necessary for the application for invalidation to succeed under section 5(4)(a) of the Act. However, I bear in mind the comments of Millett L.J. (above) that “where there is no or only a tenuous degree of overlap between the parties' respective fields of activity the burden of proving the likelihood of confusion and resulting damage is a heavy one”.

117. In light of the small degree of goodwill demonstrated by JB and the differing fields of activity of the respective parties (in respect of those services for which JJJ's marks remain valid), I do not consider that members of the public would be misled into purchasing the goods of JB in the belief that they are the services of JJJ. The applications for invalidation based on section 5(4)(a) of the Act must, therefore, fail.

### **THE OPPOSITION**

118. Section 5(1) of the Act provides as follows:

“(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.”

119. Section 5(2) of the Act provides as follows:

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

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

(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,

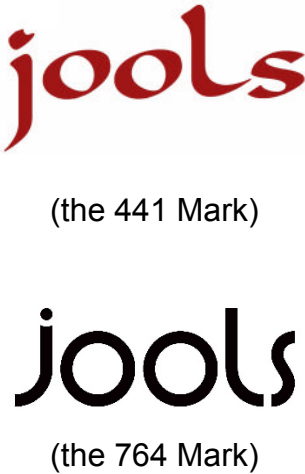
there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

120. Given the filing dates of the 441 Mark and the 764 Mark, they qualify as earlier trade marks under section 6 of the Act.

**Sections 5(1) and 5(2)(a)**

**Comparison of trade marks**

121. The parties’ respective trade marks are as follows:

<b>JJL’s Marks (the earlier marks)</b>	<b>JB’s Mark (the applied for mark)</b>
 <p>(the 441 Mark)</p> <p>(the 764 Mark)</p>	<p>Jools</p>

122. It is a prerequisite of section 5(1) and section 5(2)(a) of the Act that the trade marks are identical. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union (“CJEU”) held that:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where,

viewed as a whole, it contains differences so insignificant that they may go unnoticed by the average consumer”.

123. Visually, the marks all consist of the word JOOLS. As notional and fair use covers use in any standard typeface, differences created by the use of upper and lower case in the marks will not be relevant. In its written submissions, JB denies that the marks are identical and states that “the stylisation is distinctive and memorable and of equal dominance to the word elements in the Prior Marks as a whole”. I disagree. The stylisation used in the 441 Mark and the 764 Mark is minor and, in my view, not so unusual that it could not be covered by notional and fair use of JB’s mark. The use of colour in the 441 Mark does not create a significant point of visual difference between the marks. The Court of Appeal has stated on two occasions following the CJEU’s judgment in *Specsavers*<sup>4</sup> (see paragraph 5 of the judgment of the Court of Appeal in *Specsavers* [2014] EWCA Civ 1294 and *J.W. Spear & Sons Ltd v Zynga, Inc* [2015] EWCA Civ 290 at paragraph 47) that registration of a trade mark in black and white covers use of the mark in colour. Consequently, JB’s mark should be considered on the basis that it could be used in any colour. In my view, the marks are visually identical.

124. The marks will all be pronounced in the same way – JEW-LS. The marks are aurally identical.

125. I do not consider that the consumer will attribute any particular meaning to the word JOOLS in any of the marks. The made-up word JOOLS is identical aurally to the ordinary dictionary word JEWELS, although I consider it unlikely that this meaning will be identified by the average consumer. Similarly, the word JOOLS may be viewed as a shortening for the names Julie, Judith or Julia, although, again, I consider it unlikely that this meaning will be identified by the average consumer. However, If I am wrong and there will be a meaning attributed to the word JOOLS then the meaning will be the same for all of the marks. I consider the marks to be conceptually identical.

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<sup>4</sup> *Specsavers International Healthcare Limited & Others v Asda Stores Limited*, Case C-252/12

126. The requirements of section 5(1) and section 5(2)(a) for the marks to be identical are, therefore, satisfied.

### **Comparison of goods and services**

127. In its Notice of Opposition, JIL sought to rely upon the following services for which the 441 Mark is registered:

“Jewellery, watches and silverware – retail sales and services and online retail sales and services.”

128. In relation to the 764 Mark, JIL sought to rely upon the following services for which the mark is registered:

“Retail and online retail services relating to jewellery and time instruments (watches).”

129. These descriptions are not taken directly from the specifications of the marks. They are general descriptions. I will, therefore, use those services in the specifications which most closely relate to those listed above (and for which the marks have not been found invalid). The competing goods and services are, therefore, as follows:

<b>JIL's services (the earlier marks)</b>	<b>JB's goods (the applied for mark)</b>
<b><u>The 441 Mark</u></b> <u>Class 35</u> Retail services and online retail services in connection with the sale of watches; Retail services and online retail services in connection with the sale of ornaments, glasswear, silverwear, figurines.	<u>Class 14</u> Precious metals and their alloys; jewellery, precious and semi-precious stones; jewellery made of non-precious stones; parts and fittings for all the aforesaid goods; none of the aforesaid being costume jewellery or jewellery of base metals.
<b><u>The 764 Mark</u></b>	



<u>Class 35</u>	
Retail services in relation to time instruments	

130. Whilst I recognise that the specification for the applied for mark differs to that of the 261 Mark relied on by JB in the applications for invalidation, the same points apply to the similarity of the present specification with the specification of JLL's marks. I do not consider there to be any similarity between the goods and services. As section 5(1) of the Act requires the goods and services for which the marks are registered/applied for to be identical, the opposition based upon this section must fail. Similarly, as some degree of similarity between the goods and services is necessary to engage the test for likelihood of confusion<sup>5</sup>, the opposition based upon section 5(2)(a) of the Act must fail in its entirety.

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

131. As some degree of similarity between the goods and services is necessary to engage the test for the likelihood of confusion under section 5(2)(b) of the Act also, the opposition under this section will fail in its entirety for the same reasons as the opposition under section 5(2)(a).

**CONCLUSION**

132. The application for invalidation against registration UK00003017441 has succeeded in relation to some of the services. **The registration is hereby declared invalid in respect of the following:**

**Class 35      Retail services and online retail services in connection with the sale of jewellery.**

133. The mark will remain registered for the following services:

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<sup>5</sup> *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

Class 35 Retail services and online retail services in connection with the sale of watches; Retail services and online retail services in connection with the sale of ornaments, glasswear, silverwear, figurines.

134. The application for invalidation against registration UK00003213764 has succeeded in relation to some of the services. **The registration is hereby declared invalid in respect of the following:**

**Class 35 Retail services in relation to jewellery; Retail services relating to jewelry; Online retail services relating to jewelry.**

135. The mark will remain registered for the following services:

Class 35 Retail services in relation to time instruments.

**136. The opposition has been unsuccessful and the application can proceed to registration.**

## **COSTS**

137. JB has been partly successful in its applications for invalidation and entirely successful in the opposition. It has, therefore, enjoyed the greater degree of success. Consequently, it is entitled to a contribution towards its costs, with a reduction to reflect the partial success. The opposition was originally governed by the fast track scheme. However, proceedings were consolidated under section 62(1)(g) of the Trade Mark Rules 2008 which provides as follows:

“(1) Except where the Act or these Rules otherwise provide, the registrar may give such directions as to the management of any proceedings as the registrar thinks fit, and in particular may -

[...]

(g) consolidate proceedings provided that where a fast track opposition is consolidated with other non-fast track proceedings, it shall no longer be treated as a fast track opposition”

138. The opposition is, therefore, no longer a fast track opposition and costs will be based upon the scale published in Tribunal Practice Notice 2/2016. I award JB the sum of £1,650 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Preparing a statement of case in the invalidation and opposition proceedings and considering the other side’s statements	£250
Preparing evidence	£700
Preparing written submissions in lieu of a hearing	£300
Official fee for invalidation (x2)	£400
<b>Total</b>	<b>£1,650</b>

139. I therefore order Denise Harris and Jonathan Tait and Jools Jewellery Ltd (jointly and severally) to pay Jenny Brown Ltd the total sum of £1,650. This sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

**Dated this 28<sup>th</sup> day of January 2019**

**S WILSON**  
**For the Registrar**