

O-088-19

TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO 3278564
BY INAM ALI
TO REGISTER



MISSD  **PE**

AS A TRADE MARK
IN CLASSES 14 & 25
AND OPPOSITION THERETO (UNDER NO. 411745)
BY
ILLUME HOLDING AB

Background & pleadings

1. Inam Ali ('the applicant') applied to register the trade mark outlined on the title page above on 18 January 2018. The mark was published on 26 January 2018 in classes 14 and 25 for the goods set out later in this decision.

2. ILLUME Holding AB ('the opponents') opposes the mark under section 5(2)(b) of the Trade Mark Act 1994 ('the Act') on the basis of its European trade marks set out below. The registered goods and services will be set out later in this decision. The opponent had also opposed the application on the grounds of section 5(3) and 5(4)(a) but these grounds were subsequently withdrawn in its written submissions dated 11 July 2018.

EU TM11339884

Do.pe

Filing Date: 13 November 2012

Registration Date: 13 May 2013

EU TM11518313

DOPE

Filing Date: 25 January 2013

Registration Date: 21 June 2013

EU TM 11518371

DOPE

Filing Date: 25 January 2013

Registration Date: 21 June 2013

EU TM 11333771



Filing Date: 9 November 2012

Registration Date: 13 May 2013

EU TM11333895



Filing Date: 9 November 2012

Registration Date: 13 May 2013

3. The opponent's trade marks are earlier marks, in accordance with section 6 of the Act but, as they have not been registered for five years or more at the publication date of the applicant's mark, they are not subject to the proof of use requirements, as per section 6A of the Act.

4. The applicant submitted a counterstatement in which he denied that the marks were similar.

5. In these proceedings the applicant is representing himself and the opponents are represented by Murgitroyd & Company.

6. Both parties provided written submissions and neither requested a hearing. I make this decision from a consideration of the papers before me.

Decision

7. Section 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 leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

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

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

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

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

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

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

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

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

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

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

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

9. The relevant case law relating to the comparison of goods and services is set out below.

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

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market

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

11. In *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM Case T-133/05) ('Merici'), the General Court ('GC') held:

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

12. 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".

13. 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.

14. In its written submissions dated 7 November 2018, the opponent lists all its goods and services (which are the same for each of its earlier marks) but only makes submissions in relation to its classes 25 and 35 as to the identity and complementarity with the applicant’s goods. In principle, where there is no similarity at all, there is no likelihood of confusion to be considered. I can see no similarity between the opponent’s classes 9, 28 and 41 goods and services and the applicant’s goods and as the opponent has made no submissions to that effect then I will not include those classes in my comparison below.

15. The goods and services to be compared are:

Opponent’s goods and services	Applicant’s goods
Class 25: Clothing, footwear, headgear; shirts, hoodies, jersey shirts; vests;	Class 14: Class 14: Necklaces; Necklaces [jewellery, jewelry (Am.)];

sweaters; braces for clothing; collars (clothing); underwear; clothing; sweat absorbent underwear; clothing apparel; outerwear; jackets; (other than for protection against accidents and injuries); headbands (clothing); clothing of imitations of leather; clothing of leather; t-shirts; camisoles; hats; caps; shirts; socks; beach wear; gloves (clothing); gloves (other than for protection against accidents and injuries); sports headgear (other than helmets); pants; jeans; tights; shorts; swimwear; shorts; footwear for use in snowboarding and skiing; sports and leisure shoes and boots

Necklaces [jewellery]; Necklaces [jewelry]; Necklaces of precious metal; Bib necklaces; Choker necklaces; Closures for necklaces; Gold necklaces; Gold-plated necklaces; Jewellery chain of precious metal for necklaces; Jewellery rope chain for necklaces; Silver necklaces; Silver-plated necklaces; Bracelets; Bracelets [jewellery, jewelry (Am.)]; Bracelets [jewellery]; Bracelets [jewelry]; Bracelets and watches combined; Bangle bracelets; Bead bracelets; Friendship bracelets; Gold bracelets; Gold plated bracelets; Jewellery chain of precious metal for bracelets; Jewellery rope chain for bracelets; Silver bracelets; Silver-plated bracelets; Watch bracelets; Wooden bead bracelets; Earrings; Earrings of precious metal; Clip earrings; Drop earrings; Gold earrings; Gold plated earrings; Gold-plated earrings; Hoop earrings; Jewelry clips for adapting pierced earrings to clip-on earrings; Pierced earrings; Silver earrings; Silver-plated earrings; Jewelry pins for use on hats; Finger rings; Friendship rings; Gold plated rings; Gold-plated rings; Key rings; Rings [jewellery]; Rings [jewellery] made of non-precious metal; Rings [jewellery] made of precious metal; Rings [jewelry]; Rings [trinket];

	<p>Rings coated with precious metals; Rings of precious metal; Key rings [trinkets or fobs]; Key rings [trinkets or fobs] of precious metal; Key rings and key chains, and charms therefor; Key rings of leather; Key rings of precious metal.</p>
<p>Class 35: Advertising; business management; business administration; office functions; dealer services and compilation of a variety of goods, on behalf of others (excluding the transport thereof), to enable customers to conveniently view and purchase video game consoles for use with large screen or monitor, computer programs and software regardless of recording media or dissemination purposes, face shield adapted for use with helmets, helmets, helmets for protection against accidents, protective helmets, protective helmets for cyclists, protective helmets for skiers, protective helmets for snowboarders, protective helmets for skateboarders, protective sports helmets, safety helmets, sports bags adapted (shaped) to contain protective helmets, sports helmets, sports bags adapted (shaped) to contain protective helmets, helmets for sports, protective helmets, sunglasses, visors, cases and bags adapted for products according to</p>	<p>Class 25: Class 25: Clothes; Shoes for casual wear; Shoes for leisurewear; Beach shoes; Canvas shoes; Dance shoes; Dress shoes; Flat shoes; High-heeled shoes; Jogging shoes; Platform shoes; Rain shoes; Riding shoes; Rubber shoes; Running shoes; Slip-on shoes; Shoes for casual wear; Shoes for leisurewear; Sport shoes; Sports shoes; Tennis shoes; Training shoes; Walking shoes; Waterproof shoes; Women's shoes; Scarves; Cashmere scarves; Head scarves; Mufflers [neck scarves]; Mufflers as neck scarves; Neck scarves; Neck scarves [mufflers]; Shoulder scarves; Silk scarves; Snoods [scarves]; Dresses; Dresses for evening wear; Cocktail dresses; Evening dresses; Jumper dresses; Ladies' dresses; Leather dresses; Leggings [leg warmers]; Leggings [trousers]; Coats; Coats for women; Coats made of cotton; Coats of denim; Cotton coats; Denim coats; Duffel coats; Evening coats; Fur coats; Leather coats; Rain</p>

<p>the above mentioned goods, eyeglass cases, eyeglasses, lenses, goggles for sports, eyeglass cords, spectacle frames, goggles, goggles for skiing, goggles for snowboarding, headphones, gloves for protection against accidents and injuries, cameras, clothing, footwear, headgear, shirts, hoodies, jersey shirts, vests, sweaters, braces for clothing, collars (clothing), underwear, clothing, sweat absorbent underwear, clothing apparel, outerwear, jackets, (other than for protection against accidents and injuries), headbands (clothing), clothing of imitations of leather, clothing of leather, t-shirts, camisoles, hats, caps, shirts, socks, beach wear, gloves (clothing), gloves (other than for protection against accidents and injuries), sports headgear (other than helmets), pants, jeans, tights, shorts, swimwear, shorts, footwear for use in snowboarding and skiing, sports and leisure shoes and boots, games and playthings, gymnastic and sporting articles, decorations for Christmas trees, skis, snowboard, skateboard, rods, accessories for skis, snowboards, skateboards and rods included in this class, namely, knee and elbow pads, wheels, skateboard trucks, wax and grip tape, through retail, wholesale, through mail order catalogs,</p>	<p>coats; Top coats; Trench coats; Wind coats; Winter coats; Bomber jackets; Denim jackets; Fur coats and jackets; Fur jackets; Heavy jackets; Knit jackets; Leather jackets; Long jackets; Rain jackets; Riding jackets; Sheepskin jackets; Shell jackets; Ski jackets; Sleeved jackets; Sleeveless jackets; Jackets; Jackets [clothing]; Sports jackets; Suede jackets; Wind jackets; Wind resistant jackets; Wind-resistant jackets; Windproof jackets; Baseball caps and hats; Baseball hats; Beanie hats; Bobble hats; Fake fur hats; Fashion hats; Fur hats; Party hats [clothing]; Small hats; Sports caps and hats; Top hats; Woolly hats; Lace boots; Ladies' boots; Rain boots; Riding boots; Snow boots; Walking boots; Waterproof boots; Wellington boots; Winter boots; Snow boots; Walking boots; Waterproof boots; Wellington boots; Winter boots.</p>
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via electronic media, websites or shopping programs via television; distribution of printed advertising material; distribution of samples.	
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16. The opponent has *clothing, footwear, headgear* in its class 25 goods which covers the applicant's class 25 goods. Therefore I find these goods identical under the *Meric* principle outlined above.

17. With regard to the applicant's goods in class 14, the opponent submits that these goods are complimentary to its class 25 goods on the basis that,

"The jewellery and key rings of interest to the applicant are often worn together with that of the opponent goods in class 25. The uses are the same in that you wear both the opponents and applicants goods on the person. The users are the same in that they are ordinary members of the public. The marketplaces are the same in that most retail outlets sell both the applicants class 14 goods and the opponents class 25 goods in the same store and in close proximity of each other because they are selling a style to be worn, the goods being worn with each other to compliment the other".

18. In relation to the complementarity between class 14 and class 25 goods, the GC has already examined this approach in *Compagnie des montres Longines, Francillon SA v OHIM*, Case T-505/12, where they rejected the argument that sunglasses, jewellery and watches were similar to clothing. The court stated that:

"46 In that regard, it must be stated at the outset that the goods which have to be compared in the present case, namely, on the one hand, the 'optical sunglasses' and 'clothing and footwear' in, respectively, Classes 9 and 25 of the Nice Agreement and, secondly, the various horological and jewellery goods, listed in paragraph 6 above, in Class 14 of that agreement, belong to adjacent market segments.

47 It may also be stated, by analogy with what the Court held in the context of an assessment relating to Article 8(5) of Regulation No 207/2009 in the case which gave rise to the judgment of 27 September 2012 in *El Corte Inglés v OHIM — Pucci International (Emidio Tucci)*, T-373/09, EU:T:2012:500, paragraph 66, that, even though those categories of goods are different, each of them includes goods which are often sold as luxury goods under the famous trade marks of renowned designers and manufacturers. That fact shows that there is a certain proximity between the goods at issue, in particular in the luxury goods sector.

48 Likewise, the Court held, still in the context of an assessment relating to the provision referred to in paragraph 47 above, in paragraph 79 of its judgment of 27 September 2012 in *Pucci International v OHIM — El Corte Inglés (Emidio Tucci)*, T-357/09, EU:T:2012:499, that, in the luxury items sector, goods like glasses, jewellery and watches are also sold under the famous trade marks of renowned designers and manufacturers and that clothing manufacturers are therefore turning towards the market for those goods. The Court deduced from that there was a certain proximity between the goods at issue.

49 However, notwithstanding the fact that the goods covered by the trade mark application and those protected by the earlier mark, which are referred to in paragraph 46 above, belong to adjacent market segments, it must, in the first place, be held that the Board of Appeal did not err in stating that they differed in their nature, their intended purpose and their method of use.

50 First, the raw materials from which they are manufactured are different, except for some similarities between certain materials which may be used both in the manufacture of optical sunglasses and for certain horological goods or jewellery, such as glass.

51 Secondly, clothing and footwear in Class 25 are manufactured to cover, conceal, protect and adorn the human body. Optical sunglasses are above all produced to make it easier to see, to provide users with a feeling of comfort in certain meteorological conditions and, in particular, to protect their eyes from rays of sunlight. Watches and other horological goods are designed, inter alia, to measure and indicate the time. Lastly, jewellery has a purely ornamental function

(see, to that effect, judgment in *nollie*, cited in paragraph 41 above, EU:T:2010:114, paragraph 33 and the case-law cited).

52 In the second place, it must be pointed out that as the nature, intended purpose and method of use of the goods at issue are different, they are neither in competition with each other nor interchangeable.

53 The applicant has not shown that it is typical, notwithstanding the abovementioned differences, for a consumer who, for example, intends to buy himself a new watch or some jewellery, to decide, suddenly, to buy himself, on the contrary, clothing, footwear or optical sunglasses, and vice versa.

54 In that regard, in particular, it must also be stated that the applicant has not proved its claim that, in the luxury and fashion sector, it is generally the trade mark and its prestige among consumers that motivate the consumer's decision to purchase a specific item and not the actual necessity to purchase that item, inter alia for its functionalities and to fulfil a very specific need. Likewise, it is necessary to reject as not proved the applicant's claim that, as the appearance and value of the goods prevail over other factors relating to their nature, consumers in the sector concerned are principally in search not of specific goods, but of satisfaction for their 'hedonistic needs' or that they seek the instant gratification generated by an impulse purchase.

55 Moreover, it must be stated that to accept that such claims are well-founded would be tantamount, in essence, to rendering irrelevant any differentiation between goods which belong to the luxury sector and are protected by the respective marks, since the applicant's theory relating to the impulse purchase aimed at the instant gratification of consumers leads to the conclusion that a likelihood of confusion may actually exist irrespective of the goods concerned, on the sole condition that they all fall within that sector. Such an approach, by which the applicant in actual fact alleges that all the goods at issue are interchangeable, is manifestly contrary to the principle of speciality of marks which the Court must take into account in its analysis in accordance with Article 8(1)(b) of Regulation No 207/2009 and would improperly extend the area of protection of trade marks. For the same reasons, it is necessary to reject as

irrelevant the applicant's claim that the goods are interchangeable inasmuch as each of them may be given as a gift and the consumer impulsively chooses one or other of them. To accept such a vague connection would lead to holding that goods which are manifestly different in their nature and intended purpose are similar.

56 What is more, it must be stated that the relevant market within which the abovementioned goods fall cannot be limited to the 'luxury' or 'haute couture' market segment alone and that specific significance cannot, in addition, be attributed to that market segment in the present case, since the categories of goods protected by the marks at issue are defined in a manner which is sufficiently broad to include both 'consumer' goods falling within a generally affordable price range and certain 'inexpensive' goods. The applicant has not claimed, in relation to the 'basic' goods falling within those market segments, that they are also purchased by consumers acting in an impulsive and hedonistic manner, with the result that those consumers may indiscriminately replace some goods with others.

57 In the third place, it must be pointed out that, by its other arguments, the applicant attempts, in essence, to establish a complementary connection between the goods at issue.

58 It must be borne in mind that, in accordance with the case-law, complementary goods or services are those which are closely connected in the sense that one is indispensable or important for the use of the other in such a way that consumers may think that the same undertaking is responsible for manufacturing those goods or for providing those services. By definition, goods intended for different publics cannot be complementary (see, to that effect, judgment in *Emidio Tucci*, cited in paragraph 48 above, EU:T:2012:499, paragraph 50 and the case-law cited).

59 Furthermore, according to the case-law, aesthetic complementarity between goods may give rise to a degree of similarity for the purposes of Article 8(1)(b) of Regulation No 207/2009. Such aesthetic complementarity must involve a genuine aesthetic necessity, in the sense that one product is indispensable or

important for the use of the other and consumers consider it ordinary and natural to use those products together. That aesthetic complementarity is subjective and is determined by the habits and preferences of consumers, to which producers' marketing strategies or even simple fashion trends may give rise (see judgment in *Emidio Tucci*, cited in paragraph 48 above, EU:T:2012:499, paragraph 51 and the case-law cited).

60 However, it is important to point out that the mere existence of aesthetic complementarity between the goods is not sufficient to conclude that there is a similarity between them. For that, the consumers must consider it usual that the goods are sold under the same trade mark, which normally implies that a large number of the producers or distributors of the goods are the same (see judgment in *Emidio Tucci*, cited in paragraph 48 above, EU:T:2012:499, paragraph 52 and the case-law cited).

19. On the basis of the guidance given above, I do not find there is complementarity between the applicant's class 14 goods and the opponent's class 25 goods or its class 35 services for the retail of clothing, footwear and headgear.

The average consumer and the purchasing process

20. I now consider the average consumer and how the goods are purchased. 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*, Case C-342/97.

21. 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.”

22. The guidance given in *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03 is also appropriate here as the goods in that case were also clothing. The GC stated that:

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

And

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

23. The average consumers for the contested goods in this case are the general public. The goods can be sold in traditional bricks and mortar retail clothing stores as well as online and through mail order. As set out above in *New Look*, the act of purchasing clothing will be a primarily visual process and factors such as aesthetics, functionality and fit in addition to the cost will come into play. In traditional bricks and mortar retail premises, the average consumer will be viewing and handling the clothing and possibly trying garments on. In an online website or mail order catalogue, a consumer will be viewing images of the goods before selection. Given that clothing prices can vary from garment to garment, I conclude that an average consumer will be paying a reasonable degree of attention during the purchasing process. Although I have found the purchasing process to be primarily visual, I do not discount any aural consideration such as word of mouth recommendations.

Comparison of the marks

24. It is necessary to compare the marks. 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.”

25. 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.

26. The marks to be compared are:

Opponent's marks	Applicant's mark
EU TM11339884 Do.pe	
EU TM11518313 DOPE	
EU TM 11518371 DOPE	
EU TM 11333771 	
EU TM11333895 	

27. The applicant's mark is a composite arrangement consisting of the letters MISSDPE with a pink coloured diamond device standing in place of a letter O inside

a diamond shaped black border. This whole element is positioned above a second set of the letters MISSDPE with a pink coloured diamond standing in place of a letter O. In terms of identifying the dominant elements, I find that the black diamond border is an unremarkable device therefore the strength of this mark resides in the repeated MISSDOPE word elements and the pink diamond device letter replacement. It is likely that the MISSDOPE elements will be seen as a conjoining of the words MISS and DOPE, giving the mark the impression of a name. In my view these two elements combine to form a distinctive concept of its own.

28. The opponent's mark ending '884 consists of the letters DO and PE separated by a full stop. There are no other aspects to this mark. The overall impression resides in this presentation.

29. The opponent's mark ending '313 consists of the word DOPE presented in capital letters. There are no other aspects to this mark. The overall impression resides solely in this word.

30. The opponent's mark ending '371 consists of the word DOPE presented in emboldened capital letters. There are no other aspects to this mark. The overall impression resides solely in this stylisation.

31. The opponent's mark ending '771 consists of a stylised arrangement of the letters D, O, P and E in a rounded font, presented in a vertical manner. There are no other elements to the mark so the overall impression resides solely in this stylisation.

32. The opponent's mark ending '895 consists of a stylised arrangement of the word DOPE. There are no other elements to the mark so the overall impression resides solely in this stylisation.

Visual similarity

33. The mark all have the letters D, P and E in common. The opponent's marks each have four letters whereas the applicant's mark has two word elements of seven letters length, or eight if you count the diamond device as a letter. The pink diamond device in the applicant's mark is clearly used as a replacement for a letter O,

rendering the mark readable as MISSDOPE. However in my view this device/letter replacement is quite visually impactful as it is wider than the letters either side of it and has pointed angles rather than the roundness of the letter O. The applicant submits that “the way it is inverted, the boldness and larger font size compared to the rest of the letters make it unique and different”.

34. There are other visual differences such as the two lots of additional letters MISS in the applicant’s mark which are absent in any of the opponent’s marks and the very stylized nature of the opponent’s marks ending ‘771 and ‘895 which look quite different from the applicant’s mark.

35. The additional MISS letters at the front of the applicant’s word elements are significant as in *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the GC noted that the beginnings of words tend to have more visual and aural impact than the ends. The court stated:

“81. It is clear that visually the similarities between the word marks MUNDICOLOR and the mark applied for, MUNDICOR, are very pronounced. As was pointed out by the Board of Appeal, the only visual difference between the signs is in the additional letters ‘lo’ which characterise the earlier marks and which are, however, preceded in those marks by six letters placed in the same position as in the mark MUNDICOR and followed by the letter ‘r’, which is also the final letter of the mark applied for. Given that, as the Opposition Division and the Board of Appeal rightly held, the consumer normally attaches more importance to the first part of words, the presence of the same root ‘mundico’ in the opposing signs gives rise to a strong visual similarity, which is, moreover, reinforced by the presence of the letter ‘r’ at the end of the two signs. Given those similarities, the applicant’s argument based on the difference in length of the opposing signs is insufficient to dispel the existence of a strong visual similarity.

82. As regards aural characteristics, it should be noted first that all eight letters of the mark MUNDICOR are included in the MUNDICOLOR marks.

83. Second, the first two syllables of the opposing signs forming the prefix 'mundi' are the same. In that respect, it should again be emphasised that the attention of the consumer is usually directed to the beginning of the word. Those features make the sound very similar.

36. Clearly the letters MISS are not present in the opponent's mark and following the guidance in the *El Corte* extract above on the beginnings of words in addition to the visual impact of the diamond device letter 'O' replacement, I find there is a low degree of visual similarity between the marks overall.

Aural similarity

37. The aural similarity is based on the identical pronunciation for the word DOPE, assuming the last four characters of the applicant's word elements are seen as that word and this seems very likely. None of the device elements will be verbalised so the only other aural difference are the additional letters MISS in the applicant's mark which will be verbalised. The *El Corte* case refers to the aural aspect as well as the visual and the same principle applies as regards the importance of the beginnings of words. With that in mind, I find there is a low degree of aural similarity between the marks overall.

Conceptual similarity

38. Both the application and the opponent have given dictionary definitions for the word DOPE. As all the marks contain that element, whatever concept is brought to mind, then it will be the same for all marks. However, as previously stated, the use of MISS in the applicant's mark is also likely to bring to mind the notion of a female title making the whole a name. Taking that into account, although there is an identical concept for the shared element DOPE, the conceptual impact created by the addition of MISS is such that I find there to be only a low degree of conceptual similarity for the marks overall.

Distinctive character of the earlier mark

39. The distinctive character of the earlier marks must be considered. The more distinctive they are, either inherently or through use, the greater the likelihood of

confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

40. There is no evidence before me in relation to the earlier marks so I have only the inherent position to consider. The earlier marks consist of an ordinary dictionary word which is not descriptive or allusive of the goods or services for which they have been registered. As such I find the marks to be inherently distinctive to an average degree.

Likelihood of confusion

41. I now draw together my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors and those outlined in paragraph 8:

- a) The interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon*).
- b) The principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*).
- c) Imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer*).

42. Confusion can be direct (when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related). In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“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.

43. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., also as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

44. So far, I have found that that the contested goods in class 25 are identical but that the class 14 goods have no similarity to the opponent's goods or services. So for those goods the opposition fails. For those contested goods in class 25 which I found to be identical the average consumer will be paying a reasonable degree of attention in a primarily visual purchasing process. Additionally, I have found that the earlier marks are inherently distinctive to an average degree and that the marks in this case are visually and aurally similar only to a low degree and that the marks are only conceptually similar to a low degree overall.

45. Having weighed all of the relevant factors, I conclude that whilst there is at least a degree of similarity between the marks for the shared letter elements, this is outweighed by my finding that the visual, aural and conceptual similarity between the respective marks is low. In particular in relation to the level of visual similarity because the purchase of the goods and services at issue is likely to be mainly visual, and so the level of visual similarity is of particular importance¹. There is also the concept of the applicant's mark forming a name thus giving a distinct conceptual identity different from the earlier marks. Taking these factors into account, together with the average level of distinctiveness of the earlier marks, I do not consider there to be a likelihood of direct confusion between the applicant's mark and the opponent's marks, on the part of an average consumer paying a reasonable level of attention. I also do not consider that the average consumer is likely to believe that the respective goods come from the same or linked undertakings. The common element, DOPE, is not "strikingly distinctive"² but merely averagely so, the applicant's mark does not "simply add a non-distinctive element to the earlier mark"³, the applicant's mark does not appear to me as being "entirely logical and consistent

¹ In *New Look Ltd v OHIM* Joined cases T-117/03 to T-119/03 and T-171/03, the GC stated: "49 However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs."

² *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, [16].

³ *ibid*

with a brand extension”⁴ of the opponent’s marks and I cannot see any other reason why the marks are likely to be indirectly confused as there is a different conceptual hook for the applied for mark. I am reassured in my conclusion by the guidance given in the *Duebros* extract given above that bringing to mind the same element is more association than indirect confusion.

Conclusion

46. The opposition fails in its entirety under section 5(2)(b) so the application can proceed to registration.

Costs

47. The applicant has been successful and is therefore, in principle, entitled to a contribution towards his costs. As the applicant is unrepresented, at the conclusion of the evidence rounds the tribunal invited him, in the official letter dated 11 October 2018, to indicate whether he wished to make a request for an award of costs, and if so, to complete a pro-forma including a breakdown of his actual costs, including providing accurate estimates of the number of hours spent on a range of given activities relating to the defence of the opposition; it was made clear to the applicant that if the pro-forma was not completed “no costs will be awarded”. The applicant did not respond to that invitation. Consequently, I make no order as to costs.

14th of February 2019

June Ralph

For the Registrar

The Comptroller-General

⁴ *ibid*