

**O-228-20**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF:**

**APPLICATION No. 3368796**

**BY FAPURO LIMITED**

**TO REGISTER:**

**character is beauty**

**AS A TRADE MARK IN CLASSES 3, 14, 16, 18 & 25**

**AND**

**OPPOSITION THERETO (UNDER No 416167)**

**BY MIROGLIO FASHION S.R.L.**

## **Background and pleadings**

1. There is only one ground of opposition in these proceedings (section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) – which requires there to be a likelihood of confusion), based on one earlier trade mark. The claimed conflict is, consequently, between the following marks:

<b>Applied for mark</b>	<b>Earlier mark</b>
<p>UK application 3368796</p> <p><b>character is beauty</b></p> <p>Applicant: Fapuro Limited</p> <p>Filing date: 21 January 2019</p> <p>Publication date: 1 February 2019</p>	<p>EU trade mark 7061922</p> <p><b>CARACTÈRE</b></p> <p>Opponent: Miroglio Fashion S.r.l</p> <p>Filing date: 14 July 2008</p> <p>Registration date: 6 April 2009</p>
<p><b>Opposed goods:</b></p> <p><b>Class 18:</b> Leather and imitations of leather, and not included in other classes; Animal skins, hides; Trunks and travelling bags; umbrellas and parasols; walking sticks; luggage, bags, wallets and other carriers; bags for clothes; bags for school; bags for umbrellas; bags made of imitation leather; bags made of leather; beach bags; belt bags and hip bags; canvas bags; book bags; Boston bags; barrel bags; changing bags; clutch bags; cosmetic bags; duffel bags; document suitcases; luggage bags; leather shopping bags; make-up bags; overnight bags; shaving bags sold empty; shoulder bags; sling bags; small bags for men; suit bags; suitcases; textile shopping bags; toiletry bags; tote bags; travelling bags made of leather; trunks [luggage]; cloth bags; evening bags; card wallets; key wallets; pocket wallets; wallets for attachment to belts; clutch purses; coin purses; cosmetic purses; evening purses; wrist mounted</p>	<p><b>Relied upon goods:</b></p> <p><b>Class 18:</b> Leather and imitations of leather, and goods made of these materials and not included in other classes</p> <p><b>Class 25:</b> Clothing, footwear, headgear</p>

purses; pilot cases; trolley cases; backpacks; business bags; wash bags; shopping bags; travel cases; luggage; holdalls; portmanteaux; valises; toilet bags; carrier bags; rucksacks; bum bags; casual bags; briefcases; attaché cases; music cases; satchels; beauty cases; carriers for suits, for shirts and for dresses; tie cases; credit card cases and holders; wallets; purses; bags; leather handbags; haversacks; hat boxes; handbags; key cases; leather laces; wheeled shopping bags; travelling cases; make-up cases; card cases; clothing for pets; animal apparel; belts; harnesses, collars, leads and muzzles; articles made from faux fur, namely, bags; presentation boxes made of leather; badges made of leather; faux furs; parts and fittings for all the aforesaid goods.

**Class 25:** Clothing, footwear, headgear; menswear; womenswear; childrenswear; bandanas; beach clothes; beach shoes; belts; money belts; bibs (not of paper); bodices; boot uppers; boots; leather shoes; suede shoes; canvas footwear; brassieres; camisoles; caps; berets; scarves; shower caps; coats; collars; corsets; wristbands; detachable collars; dresses; ear muffs; footmuffs; non-slipping devices for footwear; tips for footwear; heelpieces for footwear; gloves; dressing gowns; half-boots; hats; paper hats; headbands; heels; hoods; hosiery; inner soles; jackets; jerseys; jumper dresses; knitwear; lace boots; layettes; clothing of imitations of leather; clothing of leather; leggings; leg warmers; ready-made linings; mantillas; sleep masks; mittens; muffs; neckties; outerclothing; overcoats; pants; paper clothing; parkas; playsuits; cap peaks; pelerines; pelisses; petticoats; pocket squares; pockets for clothing; ponchos; pullovers; pyjamas; ready-made clothing; bath robes; sandals; saris; sarongs; scarfs; shawls; dress shields; shirt fronts; shirts; shoes; short-sleeve shirts; skirts; slippers; slips; socks; soles for footwear; stocking suspenders; stockings; suits; swimsuits; sweaters; tee-shirts; tights; togas; top hats; trouser straps; trousers; bathing trunks; turbans; underpants; underwear; uniforms; footwear uppers; veils; waistcoats / vests;

sleepsuits; bodysuits; blouses; anoraks; braces; costumes; fancy dress costumes; shoulder wraps for clothing;	
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2. The opponent's mark was filed before the applicant's mark, meaning that it qualifies as an earlier mark in accordance with section 6 of the Act.

3. According to section 6A of the Act, a trade mark that was registered more than five year before the filing date of an opposed application can only be taken into account to the extent that it has been used. Given that the opponent's mark was registered in 2009, this has potential application in these proceedings. In its statement of case, the opponent made a statement of use, claiming that it had used its mark for the goods it relies on (as set out in the table above) in the five years before the opposed application was filed. In its counterstatement, the applicant did not ask for this to be proved. Consequently, the earlier mark may be relied upon in these proceedings for the goods the opponent has identified, without having to prove use.

4. The main points in the opponent's statement of case are that:

- "character" and "CARACTÈRE" are visually very similar and aurally identical.
- CARACTÈRE is the French word for character and would be recognised as such by a significant number of consumers in the UK, so there is a high degree of conceptual similarity.
- The word "character" is the main element of the applied for mark on account of its position, and, also, because it is the element the words "is beauty" refer to.
- "character" retains an independent distinctive role within the applied for mark.
- The goods are all identical or similar.
- There is a likelihood of confusion.

5. The applicant filed a counterstatement denying that there is a likelihood of confusion. The counterstatement contained evidential material. The applicant was advised that this should be provided under the cover of a witness statement (or other form of acceptable evidence) and it was highlighted that an opportunity to provide evidence would be given; the evidence was later re-filed. The main points I note from the counterstatement are that:

- “Character is beauty” is the English translation of the Yoruba proverb “Iwa L’ewa”.
- The Yoruba people, language and culture originate in Nigeria.
- There are distinct visual and aural differences between the marks.
- That only a small percentage (0.3% of the population) understand French, and, even for those that do, the marks, as wholes, are still not conceptual equivalents.
- The other aspect of the applied for mark, “is beauty”, has an equally dominant role.

6. Both sides filed evidence. Neither side requested a hearing, both filing written submissions instead. The opponent has been represented by Boulton Wade Tennant. The applicant does not have legal representation, its counterstatement and submissions were made by its managing director, Dr Nathaniel Williams.

### **The evidence**

#### *Opponent’s evidence*

7. This comes from Ms Daniela Paul, a trade mark attorney working for the opponent. Her evidence contains various Wikipedia and dictionary references, from which I note the following:

- Exhibit DP1 contains information from Wikipedia and relates to the origins of the English language, and that its vocabulary has been influenced by Germanic languages and, to a greater extent, Latin and French.
- Exhibit DP2, again from Wikipedia, relates to English words of French origin, of which there are many. A source suggests that 45% of English words might be of French origin.
- Exhibit DP3, again from Wikipedia, shows that the word CHARACTER is one of the words identified as being of French origin.

- Exhibit DP4, from The Collins English Dictionary, identifies the meaning of the word CHARACTER as “the combination of traits and qualities distinguishing the individual nature of a person or thing”. There are other meanings though, including, moral force/integrity, a reputation, a person represented in a play or film etc, an outstanding person, an odd or eccentric person etc.
- Exhibit DP5 is an extract from Google Translate, with the first definition showing CARACTÈRE as CHARACTER.
- Exhibit DP6 contains an extract from the Collins Robert French Dictionary, showing the first translation of the word CHARACTER as CARACTÈRE.

#### *Applicant's evidence*

8. This comes from Dr Williams, the applicant's managing director. I note the following:

- A number of documents (Exhibits CIB 1-4) are provided about the phrase “Iwa L’ewa”, a proverb from the Yoruba culture. Essentially, the proverb relates to a person's character as being the key aspect of their beauty. The applied for mark is the English translation of the proverb.
- An extract (Exhibit CIB 5) from the EUIPO's website relating to its opposition guidelines. The guidelines are not applicable here because these proceedings do not fall within the jurisdiction of the EUIPO. I note, however, that much of what is provided relates to the various factors for determining likelihood of confusion cases, which largely mirror the factors which I will come on to discuss.
- An extract (Exhibit CIB 6) from the British Council's website relating to a survey about British people's multilingual capabilities. In essence, the extract supports the general point that “Brits are famous for not speaking foreign languages”.

- An extract (Exhibit CIB 7) about what (other) languages British (more specifically English and Welsh people) speak. 0.3% of that population apparently speak French.
- Dictionary extracts (Exhibits CIB 8 & 9) which relate to the word CHARACTER, with Dr Williams highlighting the different meanings the word has (some of which I touched on earlier), which he says results in the meaning/concept of the word being ambiguous.
- A print from Google Translate which shows that the first translation of CHARACTER is PERSONAGE. However, I note that CARACTÈRE is the second definition, although, in the sense “Le caractère”.

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

9. The relevant parts of the Act read:

“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.”

10. Further relevant law can be seen in section 5A, as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

11. In his evidence, Dr Williams touched on some of the key principles for determining likelihood of confusion cases as set out in the EUIPO's opposition guidelines. I record below what I see as they key principles, which are gleaned from judgments 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:

(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 the earlier mark to mind, is not sufficient;

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

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

### **Comparison of goods**

12. All relevant factors relating to the goods should be taken into account when making the comparison. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* (Case C-39/97), the Court of Justice of the European Union (“the CJEU”) stated at paragraph 23 of its judgment:

“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.”

13. Guidance on this issue has also come from Jacob J where, in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, the following factors were highlighted as being relevant:

- (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.

14. In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v OHIM* Case T- 325/06, it was stated:

“It is true that goods are complementary if 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..”

15. In class 25, the applicant seeks registration for:

**Class 25:** Clothing, footwear, headgear; menswear; womenswear; childrenswear; bandanas; beach clothes; beach shoes; belts; money belts; bibs (not of paper); bodices; boot uppers; boots; leather shoes; suede shoes; canvas footwear; brassieres; camisoles; caps; berets; scarves; shower caps; coats; collars; corsets; wristbands; detachable collars; dresses; ear muffs; footmuffs; non-slipping devices for footwear; tips for footwear; heelpieces for footwear; gloves; dressing gowns; half-boots; hats; paper hats; headbands; heels; hoods; hosiery; inner soles; jackets; jerseys; jumper dresses; knitwear; lace boots; layettes; clothing of imitations of leather; clothing of leather; leggings; leg warmers; ready-made linings; mantillas; sleep masks; mittens; muffs; neckties; outerclothing; overcoats; pants; paper clothing; parkas; playsuits; cap peaks; pelerines; pelisses; petticoats; pocket squares; pockets for clothing; ponchos; pullovers; pyjamas; ready-made clothing; bath robes; sandals; saris; sarongs; scarfs; shawls; dress shields; shirt fronts; shirts; shoes; short-sleeve shirts; skirts; slippers; slips; socks; soles for footwear; stocking suspenders; stockings; suits; swimsuits; sweaters; tee-shirts; tights; togas; top hats; trouser straps; trousers; bathing trunks; turbans; underpants; underwear; uniforms; footwear uppers; veils; waistcoats / vests; sleepsuits; bodysuits; blouses; anoraks; braces; costumes; fancy dress costumes; shoulder wraps for clothing.

16. The opponent relies on the following of its goods in class 25:

Class 25: clothing, footwear, headgear.

17. As can be seen, all of the applied for goods comprise either clothing, footwear or headgear. They all, therefore, fall within the ambit of the terms covered by the earlier mark. They must, therefore, be considered identical as per the guidance in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05. I accept that some of the goods may be seen more as parts of clothing than clothing per se (such as, heels), however, even if they not caught by the broad terms, they are nevertheless highly similar to the item to which they are intended to fit.

18. In class 18, the applicant seeks registration for:

**Class 18:** Leather and imitations of leather, and not included in other classes; Animal skins, hides; Trunks and travelling bags; umbrellas and parasols; walking sticks; luggage, bags, wallets and other carriers; bags for clothes; bags for school; bags for umbrellas; bags made of imitation leather; bags made of leather; beach bags; belt bags and hip bags; canvas bags; book bags; Boston bags; barrel bags; changing bags; clutch bags; cosmetic bags; duffel bags; document suitcases; luggage bags; leather shopping bags; make-up bags; overnight bags; shaving bags sold empty; shoulder bags; sling bags; small bags for men; suit bags; suitcases; textile shopping bags; toiletry bags; tote bags; travelling bags made of leather; trunks [luggage]; cloth bags; evening bags; card wallets; key wallets; pocket wallets; wallets for attachment to belts; clutch purses; coin purses; cosmetic purses; evening purses; wrist mounted purses; pilot cases; trolley cases; backpacks; business bags; wash bags; shopping bags; travel cases; luggage; holdalls; portmanteaux; valises; toilet bags; carrier bags; rucksacks; bum bags; casual bags; briefcases; attaché cases; music cases; satchels; beauty cases; carriers for suits, for shirts and for dresses; tie cases; credit card cases and holders; wallets; purses; bags; leather handbags; haversacks; hat boxes; handbags; key cases; leather laces; wheeled shopping bags; travelling cases; make-up cases; card cases; clothing for pets; animal apparel; belts; harnesses, collars, leads and muzzles; articles made from faux fur, namely, bags; presentation boxes made of leather; badges made of leather; faux furs; parts and fittings for all the aforesaid goods.

19. The opponent relies on the following of its goods in class 18:

**Class 18:** Leather and imitations of leather, and goods made of these materials and not included in other classes

20. Clearly, the applied for leather and imitations of leather, animal skins and hides are identical to leather and imitations of leather covered by the earlier mark. Faux fur is also highly similar to leather. This identity/similarity is based on the respective goods being pieces of those materials.

21. The remainder of the applied-for goods in class 18 are various finished items, which, I accept, could be made from leather or imitations of leather. However, I find no similarity between such goods and leather/imitations of leather *pe se*, as one is a finished item, the other a piece of material. Whilst such a finding may not always follow between finished articles and the materials of which they are made, in this case it is not common for the consumer to make a competitive choice between buying leather/imitations of leather to make goods, or whether to buy the finished article itself. Further, it is not common, in my experience, for the trade channels to be the same, and it is not common for the consumer to believe that the same undertakings would be responsible for both. If I am wrong on this then any similarity would, in any event, be low.

22. The earlier mark's specification covers "goods made from these materials not included in other classes". Notionally, this covers every good in class 18 that could potentially be made from leather/imitation leather. However, In *Chartered Institute of Patent Attorneys v Registrar of Trade Marks*, Case C-307/10, the CJEU held that:

"64. Therefore, the answer to the questions referred is that:

- Directive 2008/95 must be interpreted as meaning that it requires the goods and services for which the protection of the trade mark is sought to be identified by the applicant with sufficient clarity and precision to enable the competent authorities and economic operators, on that basis alone, to determine the extent of the protection conferred by the trade mark;
- Directive 2008/95 must be interpreted as meaning that it does not preclude the use of the general indications of the class headings of the Nice Classification to identify the goods and services for which the protection of the trade mark is sought, provided that such identification is sufficiently clear and precise;
- an applicant for a national trade mark who uses all the general indications of a particular class heading of the Nice Classification to identify the goods or services for which the protection of the trade mark is sought must specify

whether its application for registration is intended to cover all the goods or services included in the alphabetical list of that class or only some of those goods or services. If the application concerns only some of those goods or services, the applicant is required to specify which of the goods or services in that class are intended to be covered”.

23. In *Advance Magazine Publishers, Inc. v OHIM*, Case T-229/12, the General Court held that ‘accessories’ is a vague term and that the OHIM Board of Appeal had, therefore, erred in law by comparing it with ‘umbrellas’. Given this, it therefore appears that where a term is not sufficiently precise to identify the characteristics of the goods at issue, that term cannot be the subject of a finding that it covers goods which are similar to other goods/services. That applies here. The term is vague because it is simply identified as “goods”. All one knows is what they are made from, not what they are. I consequently cannot make a comparison and, thus, can make no finding that the remaining goods in class 18 are similar or identical to the goods of the earlier mark.

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

24. 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. 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.”

25. For the class 25 goods, the average consumer will be a member of the general public. Generally, such items are not greatly expensive. Some care will be taken in respect of style, colour, fitness for purpose etc. I consider that this equates to a reasonable, no higher or lower than the norm, level of care and consideration. The goods will be perused in traditional bricks and mortar retail establishments and their online equivalents. The goods and the marks used in relation to them may be seen in advertisements and on websites. This means that their visual impression is likely to take on more significance, although, I do not discount their aural impact completely.

26. In relation to where I have found identity/similarity in class 18, these are unfinished products such as leather, hides, fur etc. The average consumer will be someone who wishes to turn such goods into something, most probably a businessperson, but could also be a hobbyist. The goods will be inspected to check fitness for purpose, quality, colour etc. Some materials will be more expensive than others, but not to a prohibitively high degree. There is a medium degree of care and consideration. Again, the marks will be encountered via a range of media with the visual impact likely to be most important, but not to such an extent that aural considerations should be ignored.

### **Comparison of marks**

27. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

28. 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 they create. The respective marks are set out below:

## **character is beauty**

v

## **CARACTÈRE**

### Overall impression

29. The earlier mark has just one component, so that is the only thing that contributes to its overall impression.

30. The applied-for mark comprises three words, none of which are presented in a way which increases their impact. The opponent submits that “character” is the distinctive and dominant part of the mark, and that that word plays an independent distinctive role within it. I disagree with both these submissions. Given its structure and semantic content, the applicant’s mark, as it submits, will be seen as a phrase. Consequently, the word “character” does not play an independent distinctive role. Neither in my view should it be regarded as the dominant element. Whilst bearing in mind the opponent’s submission that the word character is at the beginning of the mark, and is the word which “is beauty” refers to, my view is that the average consumer will see it for what it is, a three word phrase in which all the words (particularly the words character and beauty) play an equal role in the phrase that is produced.

### Visual similarity

31. I agree with the opponent’s submission that there is some visual similarity between the words character and CARACTÈRE. However, the comparison must be made on the basis of the marks as a whole. Consequently, there are similarities in that both marks begin with a word of similar length which share a number of letters (C, A, R, A,



C,T and E). However, there are differences in terms of different letters in those first words (an additional H and E), that the shared E has an accent in the earlier mark, plus there are two additional words in the applied for mark (is beauty). When this is added up, there are some very noticeable and clear distinguishing points. I consider any visual similarity to be very low.

### Aural similarity

32. The words “character is beauty” will be pronounced in the conventional way for those words. I accept, again, that there are some similarities between the first word of each mark, although, I do not accept the opponent’s submission that the pronunciation is exactly the same. This is because of the French flourish that UK average consumers will attempt to give the earlier mark, plus, there will be differences in the way the last syllable, in particular, is pronounced. Further again, and as per the visual assessment, there is another important difference on account of the presence/absence of the words “is beauty”. There may be marginally more aural similarity than visual similarity, but there is, still, only a low degree of aural similarity between the marks.

### Conceptual comparison

33. In terms of assessing a likelihood of confusion, matters must be judged from the perspective of the notional UK average consumer. However, it does not follow that all average consumers will have the same understanding of a trade mark. In *Soulcycle Inc v Matalan Ltd*, [2017] EWHC 496 (Ch), Mann J. approved the approach of the Hearing Officer at first instance in considering the reactions of average consumers who did, and did not, recognise the word SOUL within the mark SOULUXE. The judge said:

“27. I do not consider that the Hearing Officer made an error of principle in this respect. In considering the question of the effect of the mark within the class, by reference to proportions who did not share the same view, he was following the same line as that pursued by Arnold J at first instance in *Interflora Inc v Marks and Spencer plc* [2013] EWHC 1291 (Ch) . Arnold J considered at some length whether there was a "single meaning rule" in trade mark law under which

the court had to identify one, and one only, perception amongst the relevant class of average consumer, and judge confusion accordingly. At paragraph 213 he found there is no such rule and then set out his reasoning over the following paragraphs. Paragraph 224 set out important parts of his conclusion; the references to Lewison LJ is to that judge's judgment in an earlier case.

"224 ... Thirdly, Lewison LJ expressly accepts that a trade mark is distinctive if a significant proportion of the relevant public identify goods as originating from a particular undertaking because of the mark. Thus he accepts that there is no single meaning rule in the context of validity. As I have said, that is logically inconsistent with a single meaning rule when one comes to infringement. Fourthly, the reason why it is not necessarily sufficient for a finding of infringement that "some" consumers may be confused is that, as noted above, confusion on the part of the ill-informed or unobservant must be discounted. That is a rule about the standard to be applied, not a rule requiring the determination of a single meaning. If a significant proportion of the relevant class of consumers is confused, then it is likely that confusion extends beyond those who are ill-informed or unobservant. Fifthly, Lewison LJ does not refer to many of the authorities discussed above, no doubt because they were not cited. Nor does he discuss the nature of the test for the assessment of likelihood of confusion laid down by the Court of Justice. The legislative criterion is that "there exists a likelihood of confusion on the part of the public". As noted above, the Court of Justice has held that "the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion". This is not a binary question: is the average consumer confused or is the average consumer not confused? Rather, it requires an assessment of whether it is likely that there is, or will be, confusion, applying the standard of perspicacity of the average consumer. It is clear from the case law that this does not mean likely in the sense of more probable than not. Rather, it means sufficiently likely to warrant the court's intervention. The fact that many consumers of whom the average consumer is representative would not

be confused does not mean that the question whether there is a likelihood of confusion is to be answered in the negative if a significant number would be confused ." (my emphasis)

28. That justifies a consideration of confusion in relation to a proportion of the class of average consumer by reference to perceptions, in the manner in which the Hearing Officer went about the matter. It also justifies applying the same technique (where appropriate on the facts) to validity and infringement proceedings alike."

34. The applicant's evidence and submissions highlight that "character is beauty" is the English translation of a Yoruba proverb. However, there is nothing to suggest that the average consumer in the UK will be aware of this. Neither is there any evidence demonstrating the degree of knowledge of Yoruba culture within the UK. Thus, I cannot even hold that the phrase will be known by a significant proportion of average consumers in the UK.

35. Irrespective of the above, and as stated earlier, it is still my view that the average consumer will regard the applied-for mark as a phrase. It sends, in my view, a clear message akin to the Yoruba proverb. They will understand the mark as referring to a person's beauty being based upon their own personal [good] character traits.

36. Notwithstanding the opponent's submissions regarding French being a strong influencer on the English language, the average consumer in the UK will not know that the word CARACTÈRE is a French translation of the word CHARACTER. As per Dr William's evidence, the knowledge of the French language is not particularly high. Whilst some French words may have slipped into the English-speaking consciousness, this is not the case with the word at issue and neither do I consider that it so closely resembles the word CHARACTER that they are bound to be approximated to one another.

37. The percentage of people who speak or understand French is small, and I therefore doubt that the number of consumers who know that a possible translation of the earlier mark is "character" will represent a significant enough number to warrant

the intervention of the Tribunal. That said, even for such people, I do not consider that they will see any great degree of conceptual similarity between the marks when the whole construction of the applied for mark is considered.

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

38. Having compared the marks, it is necessary to determine the distinctive character of the earlier mark, in order to make an assessment of the likelihood of confusion. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, the CJEU stated that:

“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).

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).”<sup>1</sup>

39. No evidence has been filed of the use of the earlier mark, so I have only its inherent characteristics to consider. The average consumer will see the mark as a

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<sup>1</sup> C-342/97, paras. 22-23

foreign word, the meaning of which is not known to them. I consider this equates to a reasonably high degree of inherent distinctive character. Even for those who might know of its meaning, a trade mark, in French, for the word in question is still, in my view, of a reasonably high degree of distinctiveness.

### **Likelihood of confusion**

40. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. Confusion can be direct (which effectively occurs 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/services down to the responsible undertakings being the same or related). In terms of indirect confusion, this was dealt with by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 where he noted 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”.

41. In its written submissions the opponent says little in terms of how confusion might manifest, beyond saying that the combination of similarity between the marks and similarity/identity between the goods, will give rise to confusion. I do note, however, that in its submissions when comparing the marks, at paragraph 11, it submitted:

“The average consumer will perceive the sign the subject of the application as a variation of the registered trade mark for marketing purposes rather than as originating from a different trade source.”

42. The above exemplification of how confusion might arise (variation for marketing purposes) seems to suggest that the opponent’s argument is more about indirect confusion than it is about direct confusion. However, even if I have misinterpreted the submission, I come to the view that the average consumer will not be directly confused. Notwithstanding the identical goods in play in classes 18 and 25, the average consumer is unlikely to misrecall/misremember the marks as each other, not only because of the visual and aural differences between them, but also because of the conceptual meaning of the applicant’s mark as a whole, and the phrase it creates. There is no likelihood of direct confusion.

43. In terms of indirect confusion, this requires the average consumer, having appreciated, as Mr Purvis put it in the case-law above, that “[t]he later mark is different from the earlier mark, but also has something in common with it” will conclude, via a “mental process of some kind”, that the commonality between them is indicative that “it is another brand of the owner of the earlier mark”. The mental process as submitted by the opponent is described above, a variation for marketing purposes. I do not agree. The vast majority of consumers will not even know that the earlier mark might translate as the word “character”, so I see no reason at all why they would put the shared letters down to a brand variation. Even for those that may know of that translation, I do not accept that they represent a sufficient enough number to warrant the intervention of the Tribunal. However, if I am wrong on that, it is in my view highly unlikely that they would come to the conclusion suggested by the opponent. There are too many steps for the average consumer to make and analyse in order to reach that conclusion. There is no likelihood of indirect confusion

## **Conclusion**

44. The opposition fails. As such, and subject to appeal, the applied-for mark may proceed to registration.

## **Costs**

45. I have determined these proceedings in favour of the applicant. It is, therefore, entitled to an award of costs. Given the applicant was not professionally represented, it was asked, if it wished to claim costs, to complete a proforma indicating the length of time expended on certain activities during the conduct of these proceedings. The form was duly returned. I set out below my assessment on the claim made. However, it should be noted that a costs award is intended to be a contribution towards costs rather than full compensation. I also note that the applicant claimed a sum of £30 per hour, but no explanation given of how this figure was derived. I will, therefore, award costs of the basis of £19 per hour which is the minimum allowed under The Litigants in Person (Costs and Expenses) Act 1975.

- The applicant claimed 4 hours for considering the notice of opposition, and 14 hours for filings its defence. Whilst I consider the former is a reasonable claim, 14 hours for the notice of defence would, in my view, be an excessive amount to award. Further, much of the material filed with the notice of defence was more akin to evidence, which was then filed later in the proceedings. I will allow four hours for considering the notice of opposition, seven hours for the defence.
- The applicant has claimed a total of 35 hours for filing evidence and submissions, and considering those of the other party. Again, I consider it would be excessive to reward all the hours claimed to have been expended. Further, I also note that some of the evidence was not particularly helpful, including the evidence relating to the meaning of the mark. I will award 20 hours in total.
- The total hours expended = 31 @ £19 per hour
- The total award = £589

46. I therefore order Miroglio Fashion S.r.l. to pay Fapuro Limited the sum of £589. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 9<sup>th</sup> day of April 2020**

**Oliver Morris**

**For the Registrar**

**the Comptroller-General**