

O-361-20

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3397140
BY MEREDA BROADBENT IN RESPECT OF THE FOLLOWING TRADE MARK**

CERVO NOIR

IN CLASS 25

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. 417245 BY
CHERVO' S.p.A**

BACKGROUND AND PLEADINGS

1) Mereda Broadbent (hereafter “the applicant”) applied, on 5 May 2019, to register the trade mark CERVO NOIR in respect of *Clothes* in Class 25. It was subsequently published for opposition purposes on 7 June 2019.

2) Chervo’ S.p.A (“the opponent”) opposed the application on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). It relies upon an EU trade mark (EUTM) 16930711, the relevant details of which are shown below.

EUTM 16930711
CHERVO’
Filing date: 29 June 2017 Date of entry in register: 12 October 2017
Class 3: ...
Class 9: ...
Class 14: ...
Class 25: <i>Waterproof clothing; Clothing of imitations of leather; Clothing of leather; Cyclists' clothing; Clothing for gymnastics; Dresses; Suits; Jumper dresses; Bath robes; Clothing; Bandanas [neckerchiefs]; Caps [headwear]; Berets; Underwear; Sweat-absorbent underwear; Boas [necklets]; Teddies [underclothing]; Leotards; Footwear; Training shoes; Stockings; Sweat-absorbent stockings; Socks; Sweat-absorbent socks; Breeches for wear; Bathing trunks; Shirts; Short-sleeve shirts; Bodices [lingerie]; Sports singlets; Hats; Coats; Hoods [clothing]; Belts [clothing]; Money belts [clothing]; Tights; Detachable collars; Headgear; Bathing suits; Beach clothes; Cravats; Bathing caps; Shower caps; Knickers; Headbands [clothing]; Pocket squares; Scarves; Gabardines [clothing]; Jackets [clothing]; Garters; Skirts; Overalls; Girdles; Gloves [clothing]; Mittens; Ski gloves; Ready-made clothing; Knitwear [clothing]; Jerseys [clothing]; Leggings [leg warmers]; Leggings [trousers]; Hosiery; Sports jerseys; Sweaters; Muffs [clothing]; Pelerines; Skorts; Pants; Slips [underclothing]; Underpants; Wet suits for water-skiing; Waistcoats; Trousers; Slippers; Ear muffs [clothing]; Parkas; Pelisses; Furs [clothing]; Pyjamas; Ponchos; Brassieres; Sandals; Bath sandals; Neck scarves [mufflers]; Footmuffs, not electrically heated; Shoes; Esparto shoes or</i>

sandals; Bath shoes; Gymnastic shoes; Beach shoes; Football shoes; Ski boots; Shawls; Collar protectors; Inner soles; Overcoats; Outerclathing; Petticoats; Trouser straps; Half-boots; Lace boots; Boots; Fur stoles; Tee-shirts; Combinations [clothing]; Veils [clothing]; Cap peaks; Wooden shoes; Suspenders; Skull caps.

3) The opponent's mark is an earlier mark within the meaning of section 6(1) of the Act because it has an earlier filing date than the contested application. It completed its registration procedure less than five years before the application date of the contested application and, as a result, it is not subject to the proof of use provisions contained in section 6A of the Act.

4) The opponent claims that:

- The applicant's *clothing* is identical to its Class 25 goods;
- the marks are highly similar, and;
- there exists a likelihood of confusion.

5) The applicant filed a counterstatement denying the opponent's claims and drawing attention that her mark contains the word CERVO which is Italian for deer. The applicant also points out that the current marketing strategies of the parties is different and that they are interested in different areas of the clothing sector.

6) The parties did not file evidence, but both filed written submissions that I will keep in mind and refer to as necessary. Neither party requested to be heard and I make my decision after careful consideration of the papers.

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”.

Comparison of goods

8) In the judgment of the Court of Justice of the European Union (“the CJEU”) in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, 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”.

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

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of 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.

10) In addition, I also keep in mind the guidance of the General Court (“the GC”) in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, when it stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut 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”

11) The applicant’s position is that the parties operate in different areas of the clothing industry, however, for the purposes of section 5(2)(b) of the Act I am required to undertake a notional analysis of the goods listed in the earlier registration and those listed in the application. The opponent’s specification includes the term *clothing* and the applicant’s specification consists of the term *clothes*, therefore, the goods covered by the respective terms are self-evidently identical. The opponent’s specification also includes many terms that describe various types of clothes. Applying the guidance from *MERIC*, these goods are also identical to the applicant’s *clothes*.

Comparison of marks

12) It is clear from *Sabel BV v. Puma AG*, Case C-251/95 (particularly paragraph 23), Case C-251/95, 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.”

13) It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take account of 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.

14) In the counterstatement, the applicant states that she intends to use a logo that incorporates an image of a deer and the initials “CN”. However, for the purposes of these proceedings I must consider the mark applied for. Therefore, the respective marks are:

Opponent’s mark	Applicant’s mark
CHERVO’	CERVO NOIR

15) The opponent’s mark consists of a single word and an apostrophe. The apostrophe plays a negligible role in the mark and the word CHERVO is, therefore, the dominant and distinctive element.

16) The applicant’s mark consists of the two words CERVO and NOIR. The applicant states that the word CERVO means “deer” in Italian. I will discuss the implications of this to the proceedings later but, for now, I will restrict my comments to record that this is not a word likely to be readily understood by the ordinary UK consumer. The word NOIR is likely to be widely understood by the UK consumer as the French word for “black”. The UK consumer is likely to be familiar with it because, for example, of its use in the phrase “film noir” (describing a genre of films¹). The word “Noir” will, therefore, create a concept of the colour black (that may designate a characteristic of clothing) and is consequently of low distinctive character. The word CERVO appears

¹ <https://www.lexico.com/definition/noir>

at the front of the mark and the General Court has commented that the consumer normally attaches more importance to the first part of marks². Taking that and my other comments into account, I find that the word CERVO is the dominant distinctive element of the applicant's mark.

17) Visually, there is similarity because the first word of the applicant's mark is CERVO and this is different only in that the letter "H" is missing when compared to the word CHERVO of the opponent's mark. The applicant's mark also contains the additional word NOIR that is absent in the opponent's mark. Taken all of this together, I find that the respective marks share a medium level of visual similarity.

18) The opponent relies upon the applicant's comment that "I am quite offended that [the opponent's] representation assume an English person would not know how to pronounce deer in Italian" claiming that it is implicit in the statement that it is an admission that there is phonetic similarity. By this, I assume the opponent is suggesting that the applicant's mark will be expressed as CHER-VO and that this is the same or highly similar to how its mark will be expressed. I agree that a person who has knowledge of the Italian language may do this but for most UK average consumers who have only the most rudimentary knowledge of the Italian language, if any, are not likely to express it this way. Rather, it is likely to be expressed as SER-VO with the letter "C" have a soft sound similar to the letter "S". I keep in mind that the applicant's mark also contains the word NOIR and that this introduces an aural difference between the marks. Taking all of this into account, I find that there is a low to medium level of aural similarity.

19) In respect of conceptual similarity, the opponent points to the comment of the applicant that "my customers will know it means deer". The opponent claims this is an admission that there is a conceptual similarity between CHERVO and CERVO. I do not agree. The UK average consumer is not likely to perceive CHERVO or CERVO as having any meaning and are both likely to be perceived as invented words. When this is factored into the analysis together with the fact that the

² *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02 at [81]

applicant's mark also contains the word NOIR that is likely to impart the concept of the colour black, I conclude that the respective marks share no conceptual similarity.

Average consumer and the purchasing act

20) 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 goods at issue are clothing and items of clothing. The consumer of such goods is the ordinary member of the UK public. Such goods are not targeted at any particular segment of the market (such as Italian nationals for example) and I conclude that the average consumer of clothing in the UK does not have a knowledge of the Italian language to the extent that they would be aware that CERVO is Italian for “deer”.

23) The purchasing process in respect of clothing is primarily visual in nature with the visual aesthetic of the product being an important consideration when purchasing. Clothing is selected from a shelf, clothes rail or similar in a physical shop or from images in an online equivalent. In certain limited situations aural

considerations may play a part, where the consumer asks for a particular brand or where a particular brand is promoted via radio advertising. The level of care and attention paid to the purchase of clothes is not high, nor particularly low and I would categorise it as a medium level of care and attention.

Distinctive character of the earlier trade marks

24) 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).”

25) The opponent has not provided any evidence of the scale of use of its mark and, therefore, I only need to consider its level of inherent distinctive character. It consists of the word CHERVO and an apostrophe. As I have already observed, the word is likely to be perceived as an invented word and, consequently, it is endowed with a

high level of distinctive character. The addition of the apostrophe does not disturb this finding and I conclude that the mark as a whole is endowed with a high level of inherent distinctive character.

Global assessment – Conclusions on Likelihood of Confusion

26) The following principles are obtained from the decisions of the CJEU 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 great degree of similarity between the marks, and vice versa;

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

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

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

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

27) 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). These factors must be assessed from the viewpoint of the average consumer who rarely has the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind. Confusion can be direct (which 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 and goods down to the responsible undertakings being the same or related).

28) I have found that:

- The respective goods are identical;
- The word CHERVO is the dominant and distinctive element of the opponent's mark. The word CERVO is the dominant and distinctive element of the applicant's mark. The word NOIR is likely to be understood as meaning "black";
- The marks share a medium level of visual similarity, a low to medium level of aural similarity and no conceptual similarity;
- The average consumer is likely to be the ordinary member of the UK public who will pay a medium degree of care and attention during the purchasing process;
- The purchasing act is predominantly visual in nature, but aural considerations may play a part;
- The opponent's mark has a high level of inherent distinctive character.

29) In her counterstatement and written submissions, the applicant contends that there is no direct conflict between the marks because her business would be concentrated on evening wear and couture dresses whereas the opponent's goods are golfing and casual sportswear. This approach has been dismissed by the CJEU (see *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P at [59]) on the basis that marketing approaches may vary over time. The applicant's and opponent's specifications include terms that cover a broad range of clothing and neither specifications are limited to the fields identified by the applicant. Therefore, I reject the applicant's submission.

30) The applicant has submitted that her customers will know that CERVO means "deer". Whilst I accept that it is the Italian word for "deer", I must assess what impact this may have upon the UK average consumer. In doing so, I keep in mind the

following comments of Anna Carboni, sitting as the Appointed Person in *CHORKEE Trade Mark*, BL O-048-08:

“37. I have no problem with the idea that judicial notice should be taken of the fact that the Cherokee Nation is a native American tribe. This is a matter that can easily be established from an encyclopaedia or internet reference sites to which it is proper to refer. But I do not think that it is right to take judicial notice of the fact that the average consumer of clothing in the United Kingdom would be aware of this. I am far from satisfied that this is the case. No doubt, some people are aware that CHEROKEE is the name of a native American tribe (the Hearing Officer and myself included), but that is not sufficient to impute such knowledge to the average consumer of clothing (or casual clothing in the case of UK TM no. 1270418). The Cherokee Nation is not a common subject of news items; it is not, as far as I am aware, a common topic of study in schools in the United Kingdom; and I would need evidence to convince me, contrary to my own experience, that films and television shows about native Americans (which would have to mention the Cherokee by name to be relevant) have been the staple diet of either children or adults during the last couple of decades.”

31) Similarly in the current proceedings, I take judicial notice that the word CERVO means “deer” in Italian. However, in the absence of evidence to illustrate that the average UK consumer would know this, I find that it does not have an impact upon the issue of likelihood of confusion.

32) The applicant also submits that because the opponent relies on an EU mark and because the UK is leaving the EU the respective marks will be “further separated and should not overlap in laws”. This is incorrect for several reasons. Firstly, following the end of the transition period on 31 December 2020, all EU marks will have a comparable mark created on the UK register to protect proprietors’ interests in the UK. Therefore, the opponent’s rights in its mark will remain valid in the UK after that date. Secondly, the relevant date of these proceedings is the filing date of the contested mark, namely, 5 May 2019. At that date, the opponent had a valid earlier mark.

33) With the exception of the word NOIR in the applicant's mark, neither mark is likely to create any conceptual identity that will differentiate them. Their dominant distinctive elements differ only by the additional letter "H" appearing as the second letter of the opponent's mark. They share a low to medium similarity and they share a medium level of visual similarity. This points to a finding of the a likelihood of confusion, however, the addition of the word NOIR is likely to be sufficient to avoid the consumer confusing one mark for the other and I find that there is no direct confusion.

34) In respect of indirect confusion, I keep in mind the following comments of Iain Purvis QC, 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.

35) The word NOIR in the applicant's mark is likely to be perceived as designating a characteristic of the clothes for which the mark is used or, possibly, as a sub brand. Regardless of which of these perceptions dominates in the mind of the consumer, the dominant CERVO element, when taking account of imperfect recollection, is likely to create the impression that the goods sold under the mark originate from the same or linked undertaking as those provided under the CHERVO' mark. In light of this, I find that there is a likelihood of indirect confusion.

36) Were the word CERVO to be understood as meaning “deer” and where it would be pronounced as CHER-VO, this would only increase further the likelihood of confusion. In such circumstances, the likelihood of CERVO/CHERVO being expressed in the same way is increased. This would also have the effect of increasing the likelihood of the consumer making a conceptual link between the marks.

Summary

37) The opposition succeeds in its entirety

Costs

38) The opponent has been wholly successful and is entitled to an award of costs. Awards of costs are made on a contributory basis as set out in the scale published in Tribunal Practice Notice 2/2016. I keep in mind that neither side filed evidence but that both filed written submissions and that neither side requested to be heard. I award costs as follows:

Preparing statement and considering counterstatement (including statutory fee):	£350
Preparing written submissions:	£400
TOTAL	£750

39) I, therefore, order Mereda Broadbent to pay Chervo’ S.p.A the sum of £750. The above sum should be paid within 2 months of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 27th day of July 2020

Mark Bryant
For the Registrar
The Comptroller-General