O-511-20

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3478892 BY
MILLENNIUM CASH & CARRY LIMITED

TO REGISTER:

MOLLIE

AS A TRADE MARK IN CLASS 33

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 600001418 BY
RICHARD LOMBARD-CHIBNALL

Background & pleadings

1. On 2 April 2020, Millennium Cash & Carry Limited ("the applicant") applied to register the trade mark **MOLLIE** for the goods shown in paragraph 12 below. The application was published for opposition purposes on 24 April 2020.

2. On 23 June 2020, the application was opposed under the fast track opposition procedure by Richard Lombard-Chibnall ("the opponent"). The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 ("the Act"), with the opponent relying upon all the goods (also shown in paragraph 12 below) in United Kingdom trade mark no. 3273008 for the words **MOLLY MALONE**, which has a filing date of 24 November 2017 and which was registered on 23 March 2018.

3. The applicant filed a counterstatement in which it admits "that the goods covered by the application are covered by the registration". It does, however, deny there is a likelihood of confusion.

4. In these proceedings, the opponent is represented by Murgitroyd & Company and the applicant by HGF Limited.

5. Rule 6 of the Trade Marks (Fast Track Opposition)(Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

> "(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit."

6. The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken.

7. In an official letter dated 3 July 2020, the parties were allowed until 31 July 2020 to seek leave to file evidence and/or request a hearing and until 3 September 2020 to provide written submissions. Although neither party requested a hearing or sought leave to file evidence, the opponent elected to file written submissions. In reaching a conclusion, I will bear in mind the contents of the various pleadings and written submissions.

DECISION

8. The opposition is based upon section 5(2)(b) of the Act, which reads 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.
>
> 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."

9. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

> "6.- (1) In this Act an "earlier trade mark" means –
>
> (a) a registered trade mark, international trade mark (UK) a European Union trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered."

10. The trade mark upon which the opponent relies qualifies as an earlier trade mark under the above provisions. As this earlier trade mark had not been registered for more than five years at the date the application was filed, it is not subject to the proof of use provisions contained in section 6A of the Act. The opponent is, as a consequence, entitled to rely upon it in relation to all of the goods indicated without having to prove that genuine use has been made of it.

Section 5(2)(b) – case law

11. The following principles are gleaned from the decisions of the courts of the European Union in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles:

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

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

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

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

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

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

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

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

(i) mere association, in the strict sense that the later mark brings 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. The competing goods are as follows:

The opponent's goods	The applicant's goods
Class 33 - Alcoholic beverages; Irish whiskey; excluding liqueurs.	**Class 33** - Alcoholic seltzer water; not whisky based.

13. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court ("GC") stated that:

> "29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".

14. As I mentioned earlier, in its counterstatement, the applicant admits "that the goods covered by the application are covered by the registration". As the applicant's goods would be included within the term "Alcoholic beverages" in the opponent's registration, the competing goods are, as the applicant accepts, to be regarded as identical.

The average consumer and the nature of the purchasing process

15. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods at issue; I must then determine the manner in which such goods are likely to be selected by the average consumer in the course of trade. 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."

16. The average consumer of the goods at issue is a member of the adult general public. Such goods are sold through a range of channels, including retail premises such as supermarkets and off-licences (where they are normally displayed on shelves) and on-line; in such circumstances, the goods will be obtained by self-selection. Such goods are also sold in public houses and bars (where they will be displayed on, for example, bottles and where the trade marks will appear on drinks lists etc.). When such goods are sold in public houses and bars, there will be an oral component to the selection process. However, there is nothing to suggest that such goods are sold in such a manner as to preclude a visual inspection. Consequently, while the goods may be ordered orally in public houses and bars, it is likely to be in the context of, for example, a visual inspection of the bottle or drinks lists prior to the order being placed. Considered overall, the selection process will, in my view, be a predominantly visual one, although aural considerations will play their part. Although the goods at issue are relatively inexpensive and bought fairly frequently, as an average consumer selecting such goods will wish to ensure they are selecting, for example, the correct type, origin and flavour of beverage, they will, in my view, pay a medium degree of attention to their selection.

Comparison of trade marks

17. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant

components. The Court of Justice of the European Union ("CJEU") stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*:

> ".....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."

18. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create. The competing trade marks are as follows:

The opponent's trade mark	**The applicant's trade mark**
MOLLY MALONE	MOLLIE

19. The opponent's trade mark consists of the words "MOLLY" and "MALONE" presented in block capital letters, no part of either word is highlighted or emphasised in any way. Both words make a roughly equal contribution to both the overall impression the trade mark conveys and its distinctiveness.

20. The applicant's trade mark consists of the word "MOLLIE" presented in block capital letters. As no part of the trade mark is highlighted or emphasised in any way, the overall impression it conveys and its distinctiveness lies in the single word of which it is composed.

Visual similarity

21. The applicant's trade mark consists of a six letter word, the first four letters of which are identical to the first four letters of the first word in the opponent's trade

mark i.e. “MOLL”. The trade marks differ in that after the letters “MOLL” the applicant’s trade mark contains the letters “IE” and the opponent’s trade mark, the letter “Y”. The word “MALONE” in the opponent’s trade mark is alien to the applicant’s trade mark. Weighing the similarities and differences including the positioning of the conflicting component, results in what I regard as a medium degree of visual similarity between the competing trade marks.

Aural similarity

22. In its counterstatement, the applicant admits that the words “MOLLY” and “MOLLIE” “would be pronounced identically”; I agree. As I am satisfied the word “MALONE” will be well known to the average consumer, its pronunciation is predictable. Having again weighed the similarities and differences, it results in a medium degree of aural similarity between the trade marks at issue.

Conceptual similarity

23. In its counterstatement, the applicant states:

> “The trade mark MOLLY MALONE is strongly associated with a character in the well-known and popular Irish folk song ‘Cockles and Muscles’, which is the unofficial song of the City of Dublin. A statute of ‘Molly Malone’ can be found on Suffolk Street in Dublin in the Republic of Ireland. The Applicant does not intend to request leave to file evidence to this fact but would simply contend it should be within the knowledge of the Hearing Officer considering this matter. The trade mark MOLLIE has no such conceptual meaning. In short, the trade mark MOLLY MALONE would be seen by the purchasing public as identifying a specific historic or musical person or character (whether real or fictional), whereas MOLLIE would simply be viewed as a non-specific name, which is indeed spelt differently to the MOLLY element of the Opponent’s trade mark.”

24. In its written submissions, the opponent states:

> "6. MOLLIE/MOLLY is an unusual girl's name, now relatively old fashioned, and not one which appears in the top 100 of girls names. It is therefore the dominant distinctive element, and even if the name MOLLY MALONE is that of a fictional/historical character from a song, the name MOLLY/MOLLIE is sufficiently distinctive not to detract from that. Furthermore, the average consumer would not be sure that the MOLLY element in MOLLY MALONE should be spelt MOLLY or MOLLIE. Given this, the inclusion of a surname does not alter the fact that there is still significant conceptual similarity."

25. I am satisfied that both "MOLLY" and "MOLLIE" are alternative spellings of a feminine forename with which the average consumer will be very familiar. I am also satisfied that the average consumer will be very familiar with the word "MALONE" and will treat it as a surname. However, even if the applicant is correct and a character called "MOLLY MALONE" appears in an Irish folk song, there is no evidence to show whether this meaning will be well-known to the average consumer. Based on the guidance of the Appointed Person in *Chorkee Ltd v Cherokee Inc.,* BL O/048/08, I am not, therefore, prepared to accept on judicial notice that the average consumer will be familiar with this meaning. While for some consumers who are familiar with the Irish folk song and the character of "MOLLY MALONE" the opponent's trade mark may evoke the specific concept the applicant suggests, for those consumers with no such familiarity, it will simply evoke the concept of a female whose forename is "MOLLY" and whose surname is "MALONE"; it is on that latter basis I must proceed. While the competing trade marks are conceptually similar to the limited extent that they evoke the concept of a female whose first name is "MOLLY"/ "MOLLIE", the opponent's trade mark is more specific in that it identifies a female called "MOLLY" whose surname is "MALONE".

Distinctive character of the earlier trade mark

26. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v*

OHIM (LITE) [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

27. As the opponent has filed no evidence of any use it may have made of the trade mark upon which it relies, I have only its inherent characteristics to consider. As personal names are one of the oldest forms of trade marks, the opponent's trade mark is possessed of a medium degree of inherent distinctive character.

Likelihood of confusion

28. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

29. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related. Earlier in this decision I concluded:

- The competing goods are identical;

- The average consumer is a member of the adult general public who, whilst not forgetting aural considerations, will select the goods at issue by predominantly visual means whilst paying a medium degree of attention during that process;

- The competing trade marks are visually and aurally similar to a medium degree and conceptually similar to the extent they evoke the concept of a female whose first name is “MOLLY”/“MOLLIE”;

- The earlier trade mark is possessed of a medium degree of inherent distinctive character.

30. In their written submissions, both parties referred me to, inter alia, the decision of the CJEU in *Harman International Industries, Inc v OHIM,* Case C-51/09P in which the court stated:

> “Although it is possible that, in a part of the European Union, surnames have, as a general rule, a more distinctive character than forenames, it is appropriate, however, to take account of factors specific to the case and, in particular, the fact that the surname concerned is unusual or, on the contrary, very common, which is likely to have an effect on that distinctive character. That is true of the surname ‘Becker’ which the Board of Appeal noted is common”.

31. In *El Corte Inglés, SA v OHIM*, Case T-39/10, the GC found that:

> “54. As the applicant asserted in its pleadings, according to the case-law, the Italian consumer will generally attribute greater distinctiveness to the surname than to the forename in the marks at issue (Case T-185/03 Fusco v OHIM – Fusco International (ENZO FUSCO) [2005] ECR II-715, paragraph 54). The General Court applied a similar conclusion concerning Spanish consumers, having established that the first name that appeared in the mark in question was relatively common and, therefore, not very distinctive (Case T-40/03

Murúa Entrena v OHIM – Bodegas Murúa (Julián Murúa Entrena) [2005] ECR II-2831, paragraphs 66 to 68).

55. Nevertheless, it is also clear from the case-law that that rule, drawn from experience, cannot be applied automatically without taking account of the specific features of each case (judgment of 12 July 2006 in Case T-97/05 Rossi v OHIM – Marcorossi (MARCOROSSI), not published in the ECR, paragraph 45). In that regard, the Court of Justice has held that account had to be taken, in particular, of the fact that the surname concerned was unusual or, on the contrary, very common, which is likely to have an effect on its distinctive character. Account also had to be taken of whether the person who requests that his first name and surname, taken together, be registered as a trade mark is well known (Case C-51/09 P Becker v Harman International Industries [2010] ECR I-5805, paragraphs 36 and 37). Likewise, according to the case-law cited in the previous paragraph, the distinctive character of the first name is a fact that should play a role in the implementation of that rule based on experience."

32. I shall keep my conclusions in paragraph 29 above and the guidance in the above cases in mind in reaching a conclusion. In is written submissions at paragraph 24 above, the opponent argues that:

"MOLLIE/MOLLY is an unusual girl's name, now relatively old fashioned and not one which appears in the top 100 of girl's name."

33. The opponent has, however, filed no evidence in support of those submissions. In my experience which, I am satisfied is not atypical, the forenames "MOLLY"/"MOLLIE" are relatively commonplace and ones with which the average consumer is likely to be very familiar. It follows that I do not agree with the opponent that "it is therefore the dominant distinctive element" in its trade mark. Rather, as I explained above, the distinctiveness of the opponent's trade mark stems from a combination of the two words of which it is composed.

34. Notwithstanding the identical goods at issue and the degree of visual, aural and conceptual similarity between the competing trade marks I have identified earlier and reminding myself that the average consumer will pay a medium degree of attention during the selection process (thus making him less prone to the effect of imperfect recollection), the inclusion of, in particular, the word “MALONE” in the opponent’s trade mark is, in my view, more than sufficient to avoid direct confusion.

35. That leaves indirect confusion to be considered. 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.”

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

37. An average consumer who has noticed the competing trade marks are different is, in my view, most unlikely to assume that the identical goods at issue come from the same or related undertakings simply because the applicant’s trade mark contains

a variant spelling of the well-known and relatively commonplace female forename "MOLLY". There is, in my view, no likelihood of indirect confusion.

Closing remarks

38. In its Notice of opposition, the opponent states:

> "The applicant originally filed the mark as MOLLY…but withdrew the application after being contacted by the opponent on 4 March 2020 and refiled for the amended spelling…"

39. In this regard, I agree with the following comment which appeared in the applicant's counterstatement:

> "The applicant's filing of UK trade mark application [mentioned above] has no relevance to these proceedings."

Conclusion

40. The opposition has failed and, subject to any successful appeal, the application will proceed to registration.

Costs

41. As the applicant has been successful, it is entitled to an award of costs. Awards of costs in fast track opposition proceedings are governed by Tribunal Practice Notice ("TPN") 2 of 2015.

42. Applying the guidance in that TPN, I order Richard Lombard-Chibnall to pay to Millennium Cash & Carry Limited the sum of **£200** in respect of its consideration of the Notice of opposition and the filing of a counterstatement. This sum is to be paid

within twenty one days of the expiry of the appeal period or within twenty one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 15th day of October 2020

C J BOWEN
For the Registrar