

O-036-17

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3136275 BY
VIVO FASHION LIMITED
TO REGISTER:**

ALEXANDER
——— CAINE ———

AS A TRADE MARK IN CLASSES 18, 25 & 35

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 405919 BY CKL HOLDINGS N.V.**

BACKGROUND & PLEADINGS

1. On 16 November 2015, Vivo Fashion Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision for the following goods and services:

Class 18 - Leather.

Class 25 - Suits; Clothing, footwear, headgear.

Class 35 - Retail services connected with the sale of clothing and clothing accessories.

The application was published for opposition purposes on 27 November 2015.

2. The application is opposed by CKL Holdings N.V. (“the opponent”). The opposition, which is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), is directed against all of the goods and services in the application. The opponent relies upon the goods (shown below) in the following United Kingdom trade mark application:

No. 3146477 for the trade mark: **Alexander** which was applied for on 27 January 2016 (claiming an International Convention priority date of 20 October 2015 from an earlier filing in the Benelux) and which is currently the subject of four oppositions.

Class 18 - Leather; trunks and suitcases; travelling cases; handbags; purses; wallets; umbrellas; parasols; walking sticks; whips; harness; saddlery.

Class 20 - Divans; sofas; armchairs; beds; ottomans; tables; chairs; chaises longues; furniture; mirrors; picture frames.

Class 25 - Clothing; footwear; headgear; swimwear; sportswear; leisurewear.

3. The applicant filed a counterstatement in which the basis of the opposition is denied.

4. In these proceedings the opponent has represented itself; the applicant is represented by HGF Ltd. Only the applicant filed evidence; both parties filed written submissions during the course of the evidence rounds. No hearing was sought, nor did either party file submissions in lieu of attendance at a hearing. I will bear all of the submissions mentioned in mind and refer to them, as necessary, below.

The applicant's evidence

5. This consists of a witness statement (accompanied by two exhibits) from Rachel Cockin, a trainee trade mark attorney at HGF. The evidence consists of printouts of a number of United Kingdom and European Union trade marks registrations which consist of the words "ALEXANDER WANG" (in the name of AW Licensing LLC) or "ALEXANDER McQUEEN"/"ALEXANDER MCQUEEN" (in the name of Autumnpaper Limited) and which are registered in a range of classes (exhibit RC1) and printouts obtained from www.net-a-porter.com on 8 May and 8 August 2016 showing these trade marks in use in relation to a range of goods (exhibit RC2).

DECISION

6. 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."

7. An earlier trade mark is defined in section 6 of the Act, which states:

“6. - (1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

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

8. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 2 above which has a filing date of 27 January 2016 (i.e. later than the application) but which claims an International Convention priority date of 20 October 2015 from an earlier filing in the Benelux. Section 35(1) of the Act reads as follows:

“35. - (1) A person who has duly filed an application for protection of a trade mark in a Convention country (a “Convention application”), or his successor in title, has a right to priority, for the purposes of registering the same trade mark under this Act for some or all of the same goods or services, for a period of six months from the date of filing of the first such application.”

9. Exhibit A to the opponent’s Notice of Opposition consists of an extract from the Benelux Trade Mark Office’s database confirming that on 20 October 2015, the opponent in these proceedings applied for the word trade mark “Alexander” in respect of the goods shown in paragraph 2 above. I am, as a consequence, satisfied that the opponent is entitled to rely upon the International Convention priority date claimed and that the trade mark upon which the opponent relies is an “earlier trade mark” under the

provision of sections 6(1)(a) and 6(2) of the Act. As the opponent's earlier trade mark has not yet achieved registration, the proof of use provisions do not apply and the opponent is, as a consequence, entitled to rely upon all the goods claimed.

Section 5(2)(b) – case law

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

The principles:

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

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

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in

mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

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

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

(i) mere association, in the strict sense that the later mark brings 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 and services

11. These are as follows:

The opponent's goods	The applicant's goods and services
<p data-bbox="188 472 795 667">Class 18 - Leather; trunks and suitcases; travelling cases; handbags; purses; wallets; umbrellas; parasols; walking sticks; whips; harness; saddlery.</p> <p data-bbox="188 743 795 888">Class 20 - Divans; sofas; armchairs; beds; ottomans; tables; chairs; chaises longues; furniture; mirrors; picture frames.</p> <p data-bbox="188 963 795 1052">Class 25 - Clothing; footwear; headgear; swimwear; sportswear; leisurewear.</p>	<p data-bbox="824 472 1101 501">Class 18 - Leather.</p> <p data-bbox="824 543 1338 611">Class 25 - Suits; Clothing, footwear, headgear.</p> <p data-bbox="824 653 1412 795">Class 35 - Retail services connected with the sale of clothing and clothing accessories.</p>

12. Both parties' specifications in class 18 contain the word "leather"; the goods are identical. The applicant's specification in class 25 includes the terms "clothing, footwear, headgear" which also appears in the opponent's specification in class 25; these goods are also identical. As "suits" in class 25 of the applicant's specification would be encompassed by the term "clothing" which appears in the opponent's specification in class 25, these goods are also to be regarded as identical for the reasons explained by the General Court ("GC") in *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05.

13. That leaves the applicant's retail services in class 35 to consider. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular

goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘*similar*’ to goods are not clear cut.”

14. However, on the basis of the European courts’ judgments in *Sanco SA v OHIM*¹, and *Assembled Investments (Proprietary) Ltd v. OHIM*², upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd*³, Mr Hobbs concluded that:

i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer’s point of view, they are unlikely to be offered by one and the same undertaking;

¹ Case C-411/13P

² Case T-105/05, at paragraphs [30] to [35] of the judgment

³ Case C-398/07P

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

15. In its Notice of opposition, the opponent stated:

"10. Further, the services for which the applicant seeks protection under class 35 are to be considered as complementary as well, due to the close connection between them in the sense that one is important for the use of the other and is not merely auxiliary or ancillary...Customers may think that the responsibility for "retail services connected with the sale of clothing and clothing accessories" would belong to the same entity that produces the "clothing"...After all, it is very common in the fashion/clothing industry that a manufacturer of clothes is at the same time also the entity who retails or sells the said goods on the market."

16. Although in its counterstatement the applicant took issue with some of the opponent's claims regarding the similarity in the competing goods and services, it did not deny the opponent's claims in respect of its retail services in class 35 (as shown above). That was a sensible approach as the position adopted by the opponent reflects my own experience of the matter. I therefore find that the applicant's "retail services connected with the sale of clothing and clothing accessories" in class 35 are

complementary to the opponent's goods in class 25 and, as a consequence, similar to them to a medium degree.

The average consumer and the nature of the purchasing act

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

18. The average consumer of all the goods and services at issue in these proceedings is a member of the general public. In *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, the GC stated that in relation to the selection of clothing in class 25:

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

Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

19. That reflects my own experience of the matter in relation to the selection of clothing; as I have no submissions to assist me, I see no reason why, in principle, the same would not be true of the selection of “leather” in class 18. As the GC made clear, however, aural considerations must also be kept in mind (for example, in the form of word-of-mouth recommendations or requests to sales assistants). Similar considerations apply in relation to the selection of retail services in class 35 which, once again in my experience, are most likely to be selected having considered, inter alia, websites, advertisements and signage on the high street but may also, for example, be the subject of word-of-mouth recommendations.

20. As to the degree of care the average consumer will display when selecting such goods and services, in its counterstatement, the applicant states:

“18. Fashion related goods are considered purchases. Consumers who purchase such products consider the look, quality, durability and price of the goods and whether such characteristics suit their style, intended use of the garment and budget. Therefore, the average consumer of the goods at issue in this opposition will employ a greater level of attention when comparing the marks when applied to the respective goods...”

21. The above submission focuses on the goods in class 25, the cost of which can vary considerably. That said, I agree that the average consumer for such goods will be alive to, inter alia, the factors identified by the applicant. Considered overall, I think the average consumer will pay a normal degree of attention to the selection of such goods. I have no submission to assist me as to the degree of care that will be deployed when selecting “leather” in class 18. However, given (at the very least) the likely inherent cost of leather, I am inclined to reach a similar conclusion to that above. Finally, in relation to the selection of retail store services, the average consumer is likely to be conscious of

factors such as the breadth of goods/brands stocked, customer reviews, delivery times/costs and in relation to a bricks and mortar outlet, proximity to their home, opening times, parking etc. all of which, once again suggests, at least a normal degree of care in relation to the selection of such services.

Comparison of trade marks

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

23. 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.

24. The trade marks to be compared are as follows:

Opponent's trade mark	Applicant's trade mark
Alexander	

25. Before conducting the comparison I have reminded myself of, but do not intend to repeat here, the parties' competing submissions on this issue.

26. The opponent's trade mark consists of a single word presented in title case; that is the overall impression it conveys and where its distinctiveness lies.

27. The applicant's trade mark consists of the word "ALEXANDER" presented in block capital letters below which, but much smaller, there appears the word "CAINE" also presented in block capital letters and which is placed between the letters "X" and "N" of the word which appears above it. To the left and right of the word "CAINE" and radiating from the centre of the letters "C" and "E" and extending the full length of the word which appears above it are two thin faint lines.

28. The two faint lines will go largely unnoticed and will make little or no contribution to the overall impression the trade mark conveys or its distinctiveness. Notwithstanding that the word "ALEXANDER" appears at the top of the trade mark and is much larger than the word "CAINE" which appears below it, in my view, the words form a "unit", with the "unit" having a different meaning to the separate words of which it is composed (I shall return to this point below). In my view, the overall impression the applicant's trade mark conveys and its distinctiveness lies in the combination the words "ALEXANDER CAINE" creates.

29. When considered from the visual and aural standpoints, the fact that the competing trade marks either consist exclusively of the word “Alexander” or contain this word (which will be articulated first in the applicant’s trade mark), leads to at least a medium degree of visual and aural similarity between them. As to conceptual similarity, the opponent’s trade mark consists of a word which will be very well-known to the average consumer as either a common male forename or common surname, whereas the applicant’s trade mark will be understood as consisting of a common male forename and, in my experience, a relatively common surname i.e. CAINE; considered overall, it will be understood as a full name referring to a specific individual i.e. “ALEXANDER CAINE.”

Distinctive character of the earlier trade mark

30. 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. As the opponent has filed no evidence in these proceedings, I have only the inherent characteristics of its trade mark to consider.

31. In its counterstatement, the applicant states:

“8...The opponent’s trade mark is simply made up of a forename. The name “Alexander” is a common forename in the United Kingdom thus has a low distinctive character.”

32. As I mentioned earlier, the opponent's trade mark will be understood as either a common male forename or as a common surname. Considered on either basis, it is, in my view, possessed of a fairly low degree of inherent distinctive character.

Likelihood of confusion

33. 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 services 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 this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, 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. Earlier in this decision, I concluded that:

- the competing goods in classes 18 and 25 are identical and the applicant's services in class 35 are similar to the opponent's goods in class 25 to a medium degree;
- the average consumer is a member of the general public who will select the goods and services at issue by predominately visual means whilst paying a normal degree of attention during the selection process;
- the overall impression conveyed by the opponent's trade mark and its distinctiveness lies in the word itself;

- the overall impression conveyed by the applicant’s trade mark and its distinctiveness lies in the “unit” created by the combination of the words “ALEXANDER CAINE”;
- the competing trade marks are visually and aurally similar to at least a medium degree;
- the opponent’s trade mark will be understood as a common male forename or common surname whereas the applicant’s trade mark will be understood as a reference to a specific individual;
- the opponent’s earlier trade mark is possessed of a fairly low degree of inherent distinctive character.

34. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU’s judgment in *Bimbo*, Case C-591/12P, on the court’s earlier judgment in *Medion v Thomson*. He stated:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole,

and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).”

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

35. The competing trade marks consist of or contain the word “Alexander” or “ALEXANDER”, leading to at least a medium degree of visual and aural similarity between them. However, the word Alexander (as either a forename or surname) is commonplace in this country and, as a consequence, has a fairly low degree of inherent distinctive character. As the opponent has filed no evidence to indicate that its trade mark enjoys an enhanced level of protection and as the word “Alexander” in the applicant’s trade mark does not have a distinctive significance independent of the whole, its mere presence in the “unit” the applicant’s trade mark creates, would not, in my view, lead to a likelihood of either direct or indirect confusion. As a consequence of those conclusions, the opposition fails and is dismissed accordingly.

Conclusion

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

Costs

37. As the applicant has been successful it is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice ("TPN") 4 of 2007. Bearing the guidance in that TPN in mind, but making no award to the applicant in respect of its evidence which as one can see played no part in these proceedings, I award costs to the applicant on the following basis:

Considering the Notice of opposition and filing a counterstatement;	£200
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Written submissions:	£200
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Total:	£400
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38. I order CKL Holdings N.V. to pay to Vivo Fashion Limited the sum of **£400**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 31st day of January 2017



C J BOWEN

For the Registrar

The Comptroller-General