

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 2399575 IN THE
NAME OF CHORKEE LTD**

**AND IN THE MATTER OF OPPOSITION NO. 94024 THERETO BY
CHEROKEE INC.**

**OPPONENT'S APPEAL TO AN APPOINTED PERSON FROM THE DECISION
OF MR DAVID LANDAU DATED 30 AUGUST 2007**

DECISION

Case history

1. On 17 August 2005 the Applicant, Chorkee Ltd, applied to register the following sign as a trade mark:



2. The representation of the sign on the Form TM3 was accompanied by the following written description: "The colours shown in the mark are yellow Pantone Process Yellow C, red Pantone 172 and black". Accordingly there is no doubt that the application was for registration of the sign in colour.
3. The application, recorded under no. 2399575, covers the following goods in Classes 16 and 25:

Class 16: Paper, cardboard and goods made from these materials, not included in other classes; printed matter; book binding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks.
Class 25: Clothing, footwear, headgear.
4. The Opponent, Cherokee Inc., opposed the entire application by Notice of Opposition (Form TM7) dated 29 December 2005, raising objections under sections

5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”) based on the four United Kingdom (“UK”) and Community trade mark (“CTM”) registrations summarised in the following table:

UK or CTM reg. no.	Sign	Application and registration dates	Class/specification
UK 1270418	CHEROKEE	app. 02.07.1986 reg. 27.07.1990	<i>25: articles of clothing; but not including footwear.</i>
UK 1182781	CHEROKEE	app. 04.10.1982 reg. date not given, but over 5 years before publication of the opposed mark	<i>25: footwear being articles of clothing.</i>
CTM 1490184	CHEROKEE	app. 03.02.2000 reg. 13.04.2005	<i>3, 9, 14, 18, 24 & 25, including clothing, footwear, headgear.</i>
CTM 2480218	 CHEROKEE	app. 21.11.2001 reg. 01.08.2003	<i>3, 9, 14, 18, 20, 24 & 25, including a variety of specified types of men’s and women’s clothing; and men’s, women’s, children’s and infant’s footwear and headwear.</i>

5. Since both of the UK trade marks had been registered for more than five years before publication of the opposed application, the Opponent was required to make a statement of use pursuant to section 6A(3)(a) of the Act and rule 13(2)(e) of the Trade Marks Rules 2000 in relation to each of them. In the Form TM7 the Opponent claimed to have used the mark in relation to all of the goods listed in the registration in each case.
6. The Opponent claimed more specifically in its Statement of Grounds that it had been using the mark CHEROKEE in both word and logo form in the United Kingdom extensively in relation to “a wide range of products including clothing, accessories etc, housewares” and that the mark was increasingly in use in connection with “small electronics etc.”. Products under the CHEROKEE brands were said to be “widely marketed in the UK through the Tesco supermarket chain”.

7. The Applicant defended the opposition by Notice of defence and counterstatement (Form TM8) dated 6 April 2006. Only the Opponent filed evidence. Neither party requested a hearing. The Opponent filed written submissions.
8. Mr David Landau acting for the Registrar dismissed the opposition in a written decision dated 30 August 2007 (O/251/07).
9. On 25 September 2007, the Opponent gave notice of appeal to an Appointed Person under section 76 of the Act. The hearing of the appeal took place on 16 January 2008, at which the Opponent was represented by Mr John Groom of Groom Wilkes & Wright LLP. The Applicant did not attend and was not represented, but its trade mark attorneys had filed written submissions in advance, asking for the Registrar's decision to be upheld.

Sections 5(2)(b) and 5(3) of the Act

10. Sections 5(2)(b) and 5(3) of the Act provide as follows:

(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 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.

(3) A trade mark which is identical with or similar to an earlier trade mark shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

11. These provisions implement Articles 4(1)(b), 4(3) and 4(4)(a) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks.

The Hearing Officer's decision

12. The Hearing Officer summarised the Opponent's evidence, which consisted of a witness statement made by the Intellectual Property Manager of Tesco, Emer Kelly, with exhibits.

13. In relation to the scope of the goods for which each of the UK trade marks should be treated as being registered pursuant to section 6A of the Act, the Hearing Officer made the following findings:

- (1) There was no indication that the trade mark CHEROKEE had been used on anything other than clothing (paragraph 15).
 - (2) In particular, there was no indication that the trade mark CHEROKEE had been used in the United Kingdom on footwear and therefore UK trade mark no. 1182781 could not be taken into account in the proceedings (paragraph 19).
 - (3) It was clear that large quantities of clothing had been sold in the United Kingdom under the trade mark CHEROKEE, but it was difficult to ascertain the precise nature of the clothing that had been sold at the date of publication (paragraph 18).
 - (4) A recognisable sub-category of clothing and a fair specification for which UK trade mark no. 1270418 should be treated as being registered for the purpose of section 6A was, “casual clothing; but not including footwear” (the exclusion arising out of the original specification) (paragraph 20).
14. These findings were also relevant to the question of reputation of the UK trade marks, in relation to which the Hearing Officer made the following additional findings:
- (1) There was no evidence at all of use of the stylised word and device depicted in CTM no. 2480218, so the Opponent could not claim a reputation in respect of that mark (paragraph 16).
 - (2) The requisite reputation under section 5(3) for a CTM must be shown in the European Union, not just in the United Kingdom: *Mobis Trade Mark*, BL O/020/07. The Opponent’s evidence failed to address use of CTM no. 1490184 (for the word alone) beyond the United Kingdom, which was fatal to the Opponent’s objection under section 5(3) in relation to this mark (paragraph 16).
 - (3) Although the evidence showed use of the CHEROKEE trade mark only in Tesco stores, the size and market position of Tesco was a notorious fact. This, together with the annual reviews, financial statements and turnover figures set out in the evidence, was sufficient to establish that UK TM no.1270418 had the requisite reputation in respect of “casual clothing; but not including footwear” for the purpose of section 5(3) (paragraph 21).
15. The Hearing Officer pointed out that CTM no. 2480218 includes a device element and a stylisation of the word element, and therefore that the Opponent’s position under section 5(2)(b) in relation to that trade mark would be worse than in relation to CTM no. 1490184 for the word alone (paragraph 23).

16. Based on the findings summarised above, the Hearing Officer restricted his consideration of the case under section 5(2)(b) to CTM no. 1490184 and UK trade mark no. 1270418.

17. The Hearing Officer commented on the characteristics of the average consumer and the purchasing process for the goods concerned, as follows:

24) The goods in question are bought by the public at large. In my experience there is a good deal of brand consciousness in relation to clothing, headgear and footwear, the brand often being as important or even more important than the actual garment; this is indicated by the propensity of brand owners to put the trade mark on the outside of clothing and footwear. The purchasers of clothing take a reasonable degree of care and interest in the purchasing of clothing and footwear. The case law holds that in relation to clothing it is the visual impression of the trade mark is important.

(A footnote referred to Case T-57/03 *Société provençale d'achat and de gestion SA v OHIM and React Trade Mark* [2000] RPC 285.)

18. Comparing the goods covered by the application with those covered by the Opponent's earlier trade marks (as restricted under section 6A in the case of no. 1270418), the Hearing Officer made the following findings:

(1) The goods in the class 25 specification for CTM no. 1490184 were identical to the goods applied for (paragraph 25).

(2) "Clothing" in the application was identical to the restricted goods of UK trade mark no. 1270418 (paragraph 25)

(3) None of the other goods of the application were identical to the restricted goods of UK trade mark no. 1270418. However, "footwear" and "headgear" were similar to such goods, taking into account their respective uses, users, sales outlets and distribution channels and the complementary nature of the goods (paragraph 26).

19. Turning to compare the trade marks, the Hearing Officer summarised the guidance provided by the European Court of Justice in a number of cases (including Case C-251/95 *SABEL BV v Puma AG* [1998] RPC 199; Case C-342/97 *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77; Case C-39/97 *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117; and Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ETMR 585) and then held as follows:

30) Inc states in its submissions that "[t]he meaning and how the word is pronounced will be lost on the average customer and most likely children." I assume that Inc is referring to the meaning of its trade mark. I find it

difficult to envisage that the average consumer for the goods will not be aware that the Cherokee Nation is a native American tribe. Native Americans have long been a staple of the films and television shows, many of which are aimed at children. I consider that Cherokee has a well-known meaning and that Inc's trade mark will be inextricably linked to that meaning. I am of the view that there is no individual distinctive and dominant component of Inc's trade mark; the distinctiveness lies in the trade mark as a whole. CL's trade mark includes a coloured oval background, for which colour has not been claimed. I am of the view that the oval will be seen primarily as a background and that the distinctive and dominant element of the trade mark is the invented word CHORKEE. I cannot see that this word can be divided into different elements in respect of distinctiveness and dominance.

31) CHEROKEE as (sic.) a well-established and readily grasped meaning. CHORKEE has no meaning. Consequently, there is a conceptual dissimilarity; although not the extreme dissimilarity of conceptual dissonance where each trade mark has a meaning and those meanings have different conceptual associations.

32) The well-known meaning of CHEROKEE means that it is likely to be pronounced in a standard fashion of CHE – RO – KEY or CHE – ROH – KEY. It will be spoken as a three syllable word. CHORKEE has two syllables. In its counterstatement CL claimed that its trade mark is likely to be pronounced as chalky. It seems to me that this is the most likely manner of pronunciation and, as chalky is common English word, CL's trade mark is likely to be heard as chalky. Hearing is a perception, one is not just considering sound recorded on a graph; as a perception it engages what the brain has learnt. So if two sounds are heard with divergent meanings the brain is going to distinguish between them, after all this is the basis of language. Consequently, if CHEROKEE and chalky are heard, then the listener will clearly distinguish between them; will not confuse the two sounds. The sounds of the two trade marks will create a conceptual dissonance. Therefore, in my view, any apparent similarity in sound will be lost in the processing of the sound by the brain and lead to the sounds being perceived differently.

33) All of the letters of CL's trade mark occur in the trade mark of Inc. The visual difference lies in additional E and the inversion of the letters OR. I am of the view that there is a good deal of visual similarity between the respective trade marks.

20. In assessing the likelihood of confusion, the Hearing Officer referred to several more European Court authorities (including Case T-117/02 *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91; Case T-185/02 *Succession Picasso v OHIM – DaimlerChrysler (PICARO)* [2005] ETMR 22; and Case T-135/04 *GfK AG v OHIM*), particularly in relation to the relevance of the distinctive character of the earlier trade mark, stating: “the more distinctive the earlier trade mark (either by nature or nurture) the greater the likelihood of confusion”. As to the capacity of the

trade mark CHEROKEE to distinguish the relevant goods from those of other undertakings, he stated the following:

34) CHEROKEE does not allude to the class 25 goods, as a well-known word it has the ability to hook onto the memory of the purchaser. I consider that it has a good degree of inherent distinctiveness. If the trade mark was not at the top end of the distinctiveness scale intrinsically, it would be pushed there, in the United Kingdom, by the reputation that it has. Reputation can also come into play where there is a distance between the respective goods; in this case the goods are either identical or very similar.

21. In his concluding paragraph under section 5(2)(b), the Hearing Officer held:

35) “[G]enerally, the purchase of an item of clothing involves a visual examination of the marks.” The respective trade marks are not conceptually similar; owing to the conceptual dissonance that would arise in oral use, they are not phonetically similar (although they might have phonetic similarities). Inc’s case rests very much on the visual similarity, something which is of importance in relation to the respective goods. It has been well established that conceptual differences can counteract visual and aural similarities, as long as the meaning is clear and can be grasped immediately. In this case the meaning of CHEROKEE will be grasped immediately. In oral use there is a conceptual dissonance between the words CHEROKEE and chalky. One has both a lack of conceptual similarity and conceptual dissonance on one side and a good deal of visual similarity on the other. In considering whether trade marks are similar the perception of the relevant public has to be taken into account and so I take into account the average consumer and the nature of the purchasing process. I also have to take into account that trade marks are rarely compared directly, the average consumer will be prey to imperfect recollection. The average consumer, whether directed in his or purchase by a child (as suggested in the submissions of Inc) will have conceptual hooks in relation to the earlier trade mark upon which the memory can hang. **I consider that taking all the factors of this case into consideration that there is not a likelihood of confusion and that the grounds of objection under section 5(2)(b) of the Act should be dismissed.**

22. The Hearing Officer dealt with section 5(3) of the Act in relation to UK trade mark no. 1270418 (as restricted to “*casual clothing; but not including footwear*”) as follows:

38) Likelihood of confusion is not a requirement in respect of section 5(3) of the Act. However as with likelihood of confusion it is necessary to make a global appreciation. In order to succeed under section 5(3) it is necessary to establish that the relevant section of the public would make a link between the earlier trade mark and the later trade mark. It needs to be a link that affects economic behaviour. Lindsay J has held that there has to be an additional link. Unfortunately, despite repeated reading of Lindsay J’s judgment I am unable to grasp exactly what this additional link is. The damage or advantage must be more than a mere hypothetical possibility. In a global appreciation Inc’s best case must lay with the goods that are the

closest to those for which it has a reputation, the identical goods ie *articles of clothing* of the application. Taking into account all the factors that need to be considered in the global appreciation, I consider that owing to the differences in the respective trade marks, as discussed in relation to likelihood of confusion, that the relevant public in most unlikely to make a link between the respective trade marks in respect of even identical goods. **Consequently, the grounds of opposition under section 5(3) of the Act must be dismissed.**

23. I should add that the above paragraph contained a number of cross-references to footnotes containing authorities and further commentary by the Hearing Officer. I do not reproduce these here, since the citations are extensive and the footnotes lengthy, but I have reviewed them and I mention those that require it for the purpose of my decision. In particular, the Hearing Officer referred to the guidance given by the European Courts in Case C-408/01 *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd* [2004] ETMR 10, Case C-375/97 *General Motors Corp v Yplon SA* ("Chevy") [1999] E.C.R. I-5421 and Case T-67/04 *SpA Monopole v OHIM (SPA-FINDERS)*; and by the English courts in *Electrocoin Automatics Ltd v Coinworld Ltd* [2005] ETMR 31, *Intel Corporation Inc v CPM United Kingdom Ltd* [2006] ETMR 90 and *esure Insurance Limited v Direct Line Insurance plc* [2007] EWHC 1557 (Ch). (The reference to Lindsay J in the above quote was to his decision in *eSure*.)

Appeal decision

24. This appeal is not a re-hearing, but a review of the Hearing Officer's decision. As a case in which there was no oral evidence, I should show "a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle": *REEF Trade Mark* [2002] EWCA Civ 763, [2003] RPC 5 at [28]. A decision does not contain an error of principle merely because it could have been better expressed.

25. The Opponent's Grounds of Appeal filed on 25 September 2007 sought a reversal of the entire decision. However, in the skeleton argument submitted on 11 January 2008, the Opponent stated that it was not pursuing its claim against the application insofar as it covers Class 16. I therefore limit my review to the Hearing Officer's decision to refuse the application in relation to the goods in Class 25.

26. The Opponent accepted in its written and oral submissions for the appeal:

- (1) that the Hearing Officer was correct to find that the CTM registrations were of no assistance to the case under section 5(3), in the absence of evidence of use outside the United Kingdom;

(2) that it was reasonable for the Hearing Officer to describe the goods in relation to which use of the CHEROKEE mark had been established as “casual clothing”; and

(3) that it was “not unreasonable” for the Hearing Officer to consider only UK trade mark no. 1270418 and CTM no. 14901804 in reaching his decision.

27. Although the Opponent criticised one aspect of the Hearing Officer’s assessment of the evidence of Ms Kelly, in relation to whether Tesco customers would see CHEROKEE signage when passing through the clothing area of the store, its acceptance of the section 6A limitation for UK trade mark no. 1270418 to “casual clothing; but not including footwear” and of the similar finding in relation to reputation of the CHEROKEE mark makes such a criticism superfluous. The Applicant’s written submissions do not challenge the Hearing Officer’s findings on these points. In those circumstances, and having reviewed the findings in relation to the evidence, I agree with them, and I also agree with the Hearing Officer’s approach of focusing on UK trade mark no. 1270418 and CTM no. 14901804.

Section 5(2)(b)

28. The Opponent contends that the Hearing Officer erred in not taking into account that CTM no. 1490184 was not subject to the proviso of section 6A of the Act. This contention appears to arise out of the Hearing Officer’s conclusion at the end of paragraph 27, as follows (the bold type being in the original):

Taking into account the nature of the trade and various other points of conjunction, I consider that there is a good deal of similarity between casual clothing; but not including footwear and footwear and headgear.

29. My own reading of paragraph 27 is that it deals exclusively with UK trade mark no. 1270418 and not with CTM no. 1490184. The Hearing Officer had already dealt with the CTM in the first sentence of paragraph 25, where he said:

Registration no 1490184’s class 25 specification is identical to that of the application, so the goods are identical.

30. When subsequently considering the likelihood of confusion arising out of the combined effect of the similarity of both the trade marks and the goods, at paragraph 34, the Hearing Officer stated in terms:

In respect of the Community trade mark the respective goods are identical, in respect of the United Kingdom trade mark there are identical and highly similar goods.

31. It therefore is clear that the Hearing Officer was well aware that the CTM was not subject to the section 6A proviso and that he considered the full scope of the

“clothing, footwear, headgear” goods in the Class 25 specification for that trade mark rather than a specification restricted to “casual clothing; but not including footwear”.

32. The Hearing Officer did on the other hand make an error in his comparison of the goods covered by the application and those in the section 6A specification for UK trade mark no. 1270418. He relied on the CFI’s statement in Case T-133/05 *Gerard Meric v OHIM* that “goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application” to conclude that “clothing” of the application was identical to “casual clothing” of the section 6A specification. If “clothing” had been the specification for the earlier mark and “casual clothing” that for the application, then it would have been correct to consider all of the goods of the application to be identical to a sub-set of those of the earlier mark. However, the situation is the other way around: “clothing” of the application is broader than “casual clothing” of the section 6A specification for UK TM no. 1270418, so this element of the specification for the application encompasses both identical and similar goods.
33. As will be seen, this error makes no difference to the outcome of this appeal.
34. In relation to the similarity of marks and the likelihood of confusion arising out of the combined comparison of the marks and the goods, the Opponent contended that, although the Hearing Officer recited the correct case law and tests to be applied, he did not apply these to the facts appropriately. A number of errors were highlighted, which seem to me to be best tackled in the following order:
 - (1) the Hearing Officer did not take into consideration the strong distinctive character of the mark CHEROKEE acquired through use;
 - (2) he relied on his own knowledge and experience of films and television shows to reach an incorrect finding that the average consumer for casual clothing would be aware that the Cherokee Nation is a native American tribe;
 - (3) he made too detailed a comparison of the way in which the marks would be pronounced, leading to an incorrect assumption that CHORKEE would be pronounced as “chalky” which would thereby contribute further to the conceptual dissimilarity with CHEROKEE;
 - (4) he gave disproportionate weight to the conceptual differences between the two marks;
 - (5) in general his overall approach was over-analytical, in a way which does not reflect the approach of the average consumer in the real world.

35. The first complaint is unfounded. The Hearing Officer found that the mark CHEROKEE had a reputation in the United Kingdom in relation to “casual clothing; but not including footwear” (paragraph 21), a finding which the Opponent accepts; he correctly stated the ECJ guidance that the more distinctive the earlier trade mark (either by nature or nurture) the greater the likelihood of confusion (paragraph 34); and, when applying the tests to the facts, he clearly took into account not only the inherent distinctiveness of the mark (which he thought was high) but also the enhanced distinctiveness resulting from its reputation (paragraph 34, as quoted in paragraph 20 of this decision).
36. The next three criticisms all relate to the Hearing Officer’s assessment of conceptual similarity between the mark applied for and the earlier trade marks. While the Applicant contended in its Counterstatement that the earlier marks would be recognised to refer to the Cherokee tribe and that the tribe was well known to the general public, no evidence was submitted to support this. By accepting this as fact, without evidence, the Hearing Officer was effectively taking judicial notice of the position. Judicial notice may be taken of facts that are too notorious to be the subject of serious dispute. But care has to be taken not to assume that one’s own personal experience, knowledge and assumptions are more widespread than they are.
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.
38. I therefore agree with the Opponent that the Hearing Officer was wrong to find that the earlier trade marks would give rise to the concept of the native American tribe by the same name in the mind of the average consumer and that he should not have relied on his own knowledge and experience to do so.

39. This error flowed through to the Hearing Officer's finding of "conceptual dissonance" between the sounds of the earlier trade mark CHEROKEE and the word element of the mark applied for, CHORKEE (at paragraph 32). He accepted the Applicant's submission that CHORKEE would be pronounced like the normal English word "chalky" and went on to conclude that the differences in aural perception of the two words would be processed by the average consumer's brain so as to create a conceptual dissonance, because of the differences in the respective meanings of "Cherokee" and "chalky".
40. Underlying this conclusion is not only the assumption that I have found to be erroneous, that the average consumer would know what CHEROKEE meant, but also the idea that the fact that CHORKEE would be pronounced CHOR-KEY (or perhaps it is better represented as CHAW-KEY) means that consumers would automatically think of the similarly pronounced normal word "chalky". Again, I am not satisfied that this is correct. The average consumer would be well aware that many brand names for clothes are invented words and, without some additional visual or other cue to tell them that the brand has some connection with chalk, I am doubtful that many would necessarily think of it in the context of clothing, footwear or headgear.
41. With its written submissions defending the appeal, the Applicant submitted a sample product and packaging to which the CHORKEE mark had been applied. This consisted of a child's T-shirt with a rubberised (or plasticised) front and a set of coloured chinks, with instructions on how to use the front of the T-shirt like a chalk board. Faced with such cues, there is little doubt that a consumer would understand the conceptual link between CHORKEE and "chalky". However, I may not take this item into account. It was not submitted to the Registry or the Opponent at first instance and so was not before the Hearing Officer. Further, there is nothing within the trade mark application itself to suggest that the mark would only be used on items to be sold with chinks. The Applicant submitted that it had previously offered to amend its application to limit it to "clothing, footwear or headgear, all of which is specifically adapted to be written on". Without commenting on whether such a limitation would have made any difference to this case, I simply observe that the specification under consideration by the Hearing Officer and in this appeal is "clothing, footwear, headgear" without limitation. In any event, the use of visual cues on the intended products is irrelevant to the consideration of conceptual (dis)similarity of the trade marks themselves.
42. The mistaken assumptions and findings in relation to the respective meanings of the words CHEROKEE and CHORKEE did, I believe, result in the Hearing Officer giving disproportionate weight to the issue of conceptual (dis)similarity, as the Opponent contends.

43. Despite agreeing with the Opponent on some of the particular criticisms of the decision, I do not agree with the Opponent's general submission that the Hearing Officer's approach was over-analytical. That is a very easy charge to lay at the door of anyone required to explain how he has come to a decision under section 5(2)(b) of the Act or the equivalent provisions of Directive 89/104 or indeed the Community trade mark Regulation 40/94/EEC. The ECJ guidance requires consideration of each of the visual, aural and conceptual similarities of the marks concerned and the relative importance of each; it requires consideration of the distinctive and dominant components of the respective marks; and indeed it requires "all factors relevant to the circumstances of the case" to be taken into account. The Registrar's hearing officers are required to give reasons for their decisions, and the convention is for them to do so in some detail.
44. It is inevitable that a written explanation of the process that is required by the case law in this area is disproportionately long when compared to the actual time that would be spent by a consumer in considering the relevant trade mark when purchasing an item of clothing. It is also the case that the sort of step by step analysis that is required by the case law can appear artificial and over-analytical. But that is in the nature of any exercise which seeks to reduce to writing a summary of what is understood to be going on, both consciously and sub-consciously, in the mind of a consumer when faced with choosing a product by reference to a trade mark. If the Hearing Officer's decision can be criticised for being over-analytical, in my view this is a criticism of his manner of expression rather than an example of a material error.
45. Nevertheless, I have found some distinct errors in the Hearing Officer's analysis, which contributed to his rejection of the section 5(2)(b) objection and as such are material. It is therefore necessary for me to reconsider this objection myself. In doing so, I bear in mind the ECJ guidance in the cases referred to in paragraphs 19 and 43 above, as well as those referred to specifically in the following paragraphs.
46. My conclusions on similarity of goods can be stated briefly. All of the goods in the class 25 specification of the application match "clothing, footwear, headgear" in the class 25 specification for CTM no. 1490184 and are therefore identical goods. As stated in paragraph 32 above, a sub-set of the clothing covered by the application is identical to the restricted section 6A specification of UK trade mark no. 1270418, "casual clothing; but not including footwear". The remainder of the goods covered by the generic term "clothing" should be considered as very similar to "casual clothing". And I leave in place the Hearing Officer's unchallenged finding that there is a good deal of similarity between "footwear" and "headgear" of the application and "casual clothing; but not including footwear" of UK trade mark no. 1270418.

47. I should mention that I have considered the following argument that was put by the Applicant in its written submissions:

The opponent's trade mark CHEROKEE has only been used in Tesco stores and does not appear in use on clothing outside the particular stores established where clothing outlets are included. Therefore the opponent's mark is inextricably linked with the TESCO brand. Our clients' products are not sold through Tesco's stores. The goods of interest to the opponents are fashion clothing for men, women and children. The goods of interest to the applicant are novelty clothing items, they are sold through different trade channels and are used for different purposes.

48. I do not believe that this was directed specifically at the Hearing Officer's finding of similarity of goods, but it appears to be so directed on its face. The Applicant is seeking here to introduce information about its own planned use of the mark, which is outside the scope of the comparison that can be conducted in an opposition under section 5(2)(b). I have to assume normal use and usual trade channels for clothing, footwear and headgear generally. The Applicant's trade mark specification is not limited to novelty clothing items; and the Opponent's specifications are not limited to clothing sold through Tesco stores. My conclusions set out above are made on that basis.

49. Turning to the comparison between the marks, I note first that the earlier trade marks in issue both comprise the pure word mark CHEROKEE, whereas the application comprises a stylised version of the word CHORKEE in a brightly coloured oval logo. I should not therefore compare just the word element of the application with the earlier trade mark unless the stylisation and colour/logo elements of the application are negligible: Case C-334/05P *OHIM v Shaker di L. Laudato & C. Sas* (12 June 2007) at paragraph 42. In my view they are not: there is a material difference in appearance between the mark applied for and the mere word CHORKEE.

50. However, given the prominence of the word CHORKEE in the logo, the word plainly has an independent distinctive role within it. As the only indication in the mark of the 'name' of the goods to which it is applied, and given the uncontested finding of the Hearing Officer that there is a good deal of brand consciousness among consumers in relation to clothing, headgear and footwear, the Hearing Officer was correct, in my view, in finding that CHORKEE was the dominant element. The average consumer is likely to remember the mark as a logo incorporating the word CHORKEE. The fact that the word dominates the mark must be taken into account when conducting the global assessment of the likelihood of confusion: see most recently, Case C-234/06P *Il Ponte Finanziaria SpA v OHIM* [2008] ETMR 13 at paragraph 33. It is therefore appropriate to make the direct comparison between the

CHORKEE element of the mark and CHEROKEE, but always bearing in mind that it is the Applicant's mark as a whole that is involved in the overall assessment.

51. It is obvious that CHEROKEE and CHORKEE both start with CH, end with KEE, and have the common letters O and R in the middle (albeit in the opposite order). This results in a significant element of both visual and aural similarity. If there is a hurdle of similarity to be cleared by the Opponent (a matter on which the authorities need some reconciliation), I am in no doubt that it would be cleared in this case, even it were right that the two words were conceptually far apart.
52. It will be clear from my review of the Hearing Officer's assessment of conceptual similarity that I do not agree that it is appropriate to assume that the relevant average consumer would think of the Cherokee Nation tribe when faced with the earlier trade marks. I stated at the hearing that I had expected to find some reference to Cherokee Jeeps, my own assumption being that many people would think of these vehicles in response to seeing the name CHEROKEE on clothing. Mr Groom rightly was not receptive to that suggestion. Like the Hearing Officer's assumption of the average consumer's awareness of the Cherokee Nation tribe, my assumption of their awareness of the Cherokee Jeep was not a fact of which I could take judicial notice in the absence of evidence.
53. So where does that leave the position on conceptual similarity? In the absence of any assumption of a known meaning of the word CHEROKEE, I believe that a first time viewer would see it as an invented word. But, given the finding of extensive use and reputation of the CHEROKEE name in relation to casual clothing, the average consumer should be taken to appreciate the fact that CHEROKEE is a pre-existing trade mark that is distinctive of an existing casual clothing line. In contrast, the mark applied for would be perceived as containing a new brand name, comprising an invented word. The distinctiveness of CHEROKEE therefore contributes a degree of dissimilarity from an otherwise neutral comparison of two unusual and apparently invented words.
54. As the Hearing Officer stated, it has been held in previous cases that the visual impression of a trade mark is important in relation to clothing (see paragraph 17 above). This accords with common sense. People choose clothing, and also footwear and headgear, by looking at it, sometimes trying it on, and often according to whether it has a brand name that is considered appropriate for the image that the purchaser is trying to achieve. The sound of the trade mark cannot be ignored, though, since consumers may ask in a department store to be shown to the section that displays clothing of a particular brand, or may make purchases and enquiries on the telephone. The conceptual meaning of a trade mark for clothing, footwear and

headgear plays a lesser role, save to the extent that a mark with a reputation calls to mind the image of the brand itself.

55. I must now consider in the light of everything that has gone before whether the similarities of the respective goods and trade marks are such that there is a likelihood of confusion between them. For these purposes I first take the Opponent's best case, which would arise if the Applicant's mark were applied to casual clothing.
56. The Opponent asked me to consider the point made by Richard Arnold QC in *ExxonMobil Oil Corporation v Hyundai Mobis Co. Ltd* (BL O/020/07) that the human eye has a tendency to see what it expects to see and the human ear has a tendency to hear what it expects to hear. I have done so. That was a case where the opposed mark (MOBIS) and the opponent's mark (MOBIL) both had two syllables, they started with the same four letters, they had an identical first syllable, and the beginning of the second syllable was the same. The human eye and ear could be expected in such a case to 'finish off' the mark in accordance with expectations.
57. In contrast, in this case: the Opponent's mark has three syllables but the opposed mark has only one; the Opponent's mark starts with the letter string and syllable CHER- (pronounced as in "cherry") but the opposed mark starts with the different letter string and syllable CHOR- (pronounced as in "chortle"); and the opponent's mark comprises just a word but the opposed mark is a stylised word in a logo. In my view the human eye and ear of our notional average consumer would notice these differences, even on the basis of imperfect recollection, and would not be likely to misread or mishear CHORKEE as CHEROKEE or to consider them so close that a trade connection would be assumed.
58. The Opponent pointed to paragraph 21 of the Hearing Officer's decision where he stated, "... I note that CHEROKEE goods have not been available in Tesco stores", when he clearly intended to refer to the Applicant's (CHORKEE) goods. In the Opponent's view this demonstrated that the Hearing Officer had confused the two marks. I prefer the other terminology that the Opponent used: "an unfortunate slip". No matter how carefully one proofreads a piece of writing, it is only too easy for slips to occur. Many of us have read judgments where "Claimant" and "Defendant" or "Appellant" and "Respondent" are mistakenly switched at some point. That does not mean the judge mistook one party for the other. In the Opponent's own skeleton argument for the appeal (paragraph 5.5), there is a reference to the Hearing Officer having "heard" in arriving at a conclusion, when I expect the word was meant to be "erred". I do not believe that this slip can be taken as evidence of a likelihood of confusion.
59. I can understand why the Opponent brought this opposition and appeal, given the similarities that undoubtedly do exist between the word elements of the marks, and I

believe that this is a case where different tribunals might come out with different results, given the unavoidable element of subjectivity that arises in any comparison between marks, particularly in the absence of any evidence of actual confusion. But, doing my best to put myself into the shoes of the notional average consumer, and taking all the circumstances into account, my overall conclusion is that the differences in overall impression of the trade marks in issue are sufficient to avoid a real likelihood of confusion, even in relation to “casual clothing”.

60. Having found that there is no likelihood of confusion on the Opponent’s best case, I therefore conclude that the section 5(2)(b) objection is not made out in relation to any of the earlier trade marks relied on by the Opponent.

Section 5(3)

61. The Opponent contends that the Hearing Officer erred in his assessment of the case under section 5(3) because he believed it to be necessary for an “additional link” to be made between the earlier trade mark and the mark applied for (referring to the decision of Lindsay J in *eSure*), whereas this is not required. Mr Groom expanded on the Opponent’s position at the hearing. He argued that in all cases under section 5(3) (whether dealing with identical, similar or non-similar goods), there are two essential hurdles to get over: reputation of the earlier mark and a degree of similarity with the opposed mark. Having overcome these, you go on to ask, “is there a link?”. Where one is dealing with identical goods, as in this case, a link can automatically be assumed. The combination of reputation and similarity gives rise to it without the need for more.

62. I asked Mr Groom in the hearing whether he thought that any of the cases had gone this far and he conceded that they had not. I am not aware of any that have done so and the authorities that do exist tell me that the section 5(3) test is not that simple, even where identical goods are concerned.

63. Although I do not agree with the Opponent’s approach, the question remains whether the Hearing Officer’s approach was correct. He correctly stated that it was necessary to apply a global appreciation test, and identified the key authorities at the time (see paragraph 23 above). But, as highlighted by the Opponent, the Hearing Officer stated in relation to the *eSure* case, “Lindsay J has held that there has to be an additional link. Unfortunately, despite repeated reading of Lindsay J’s judgment I am unable to grasp exactly what this additional link is”. While one can sympathise with the predicament of the Hearing Officer in what is undoubtedly a difficult area, this statement immediately gives rise to concern that he was applying a test that he did not fully understand and therefore may have fallen into error. Furthermore, the Court of Appeal has subsequently issued further guidance as to the nature of the “link” that must be established under section 10(3) of the Act (the infringement

equivalent of section 5(3)), which is not entirely consistent with Lindsay J's approach and which avoids the "additional link" terminology: *L'Oréal SA and others v Bellure NV and others* [2008] ETMR 1. That case involved identical goods and is therefore particularly relevant here.

64. The Hearing Officer also set out an extract from the OHIM case, *Mango Sport System SRL v Diknah SL* (Case R 308/2003-1) [2005] ETMR 5, which he said contained a very helpful summary of the factors to be considered. Whilst it can be appropriate to refer to OHIM decisions for assistance, we now have to treat the *Mango* decision with particular care in the light of Jacob LJ's view expressed in *L'Oréal v Bellure* (at paragraph 90) that "the Mango test" is not necessarily correct.
65. In addition to the uncertainty over the "additional link" test that the Hearing Officer may have applied and the intervening Court of Appeal decision, there is a third reason why it is appropriate for me to consider the section 5(3) objection afresh. This is the fact that the Hearing Officer's conclusion that the relevant public was "most unlikely to make a link between the respective trade marks in respect of even identical goods" was based in part on his finding that the trade marks in issue were conceptually very different, which I have found to be flawed.
66. For my own assessment, I start with the findings made by the Hearing Officer and upheld above that the Opponent's UK trade mark no. 1270418 (now the only trade mark relied on under section 5(3)) has a reputation in the United Kingdom in relation to "casual clothing; but not including footwear", and that there is a notable degree of visual and aural similarity with the mark applied for. As the Hearing Officer did, I consider first the Opponent's best case, concerning "casual clothing".
67. In *Adidas-Salomon v Fitnessworld*, the ECJ said of the equivalent infringement provision to section 5(3):

29. The infringements referred to in article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them: see, to that effect, *General Motors Corp v Yplon SA* (Case C-375/97) [1999] ECR I-5421, 5445- 5446, para 23.

30. The existence of such a link must, just like a likelihood of confusion in the context of article 5(1)(b) of the Directive, be appreciated globally, taking into account all factors relevant to the circumstances of the case: see, in respect of the likelihood of confusion, *SABEL*, para 22, and *Marca Mode*, para 40.

31. The answer to question 2(a) must therefore be that the protection conferred by article 5(2) of the Directive is not conditional on a finding of a

degree of similarity between the mark with a reputation and the sign such that there exists a likelihood of confusion between them on the part of the relevant section of the public. It is sufficient for the degree of similarity between the mark with a reputation and the sign to have the effect that the relevant section of the public establishes a link between the sign and the mark.

68. In terms of the nature of the “link” that must be established, Jacob LJ stated in *L’Oréal v Bellure*, as follows:

79. So the question of "similar to" has been glossed into asking whether a "link" is established for the relevant section of the public. As I pointed out in the *Intel* case reference [2007] ETMR 59 (where the marks were the same, but the goods/services dissimilar) the English cases have considered that it is not enough merely that the defendant's mark "calls to mind" the registered mark. There must be at least some effect on the economic behaviour of consumers. That makes sense: for unless there is, there is no reason why trade mark law should get involved. A mere "bringing to mind" having no other effect in the long or short term, ought to go untouched by trade mark law.

80. Of course if the average consumer is, at least in part "moved in any degree to buy" (the memorable phrase of Learned Hand J in *Crescent Tool v Kilborn & Bishop* (1917) 147 F. 299) by reason of the similarity between sign and mark, then a more substantial link is established. And there will be an effect on economic behaviour, even though it may be only of the defendant's customers – see the discussion of "free-riding" above.

81. For my part I think it sufficient in this case, to say that "a link" is established only if consumers are, or are likely to be, moved in any depth to buy by reason of use of the defendants' signs. That is not the same question as whether consumers would be deceived, though it includes it.

69. Another possible effect on economic behaviour that was not expressly mentioned by Jacob LJ, but that would I believe satisfy the broader requirement of a link that has “an effect on economic behaviour”, would be if consumers were likely to be turned away from the Opponent’s goods by reason of use of the Applicant’s trade mark.

70. So the question I must ask is whether the Opponent has established that the respective trade marks are sufficiently similar that consumers – although not necessarily deceived into believing that the goods are connected in trade with the Opponent – are likely to be moved to buy the Applicant’s clothing or to refrain from buying the Opponent’s clothing by reason of the similarity of the Applicant’s CHORKEE (and device) mark with the Opponent’s earlier CHEROKEE trade mark.

71. I do not think that it has. The differences between the trade marks that I highlighted in my consideration of section 5(2)(b) are such that I cannot envisage that consumers, who I have already decided will not be confused, would buy the Applicant’s clothing because of their awareness of the CHEROKEE mark. Similarly,

there is no reason why consumers should turn away from the Opponent's goods once the Applicant's trade mark is used.

72. The question of the effect of any "link" between the marks feeds into the alternative limbs of section 5(3) that the use of the Applicant's sign must take unfair advantage of, or be detrimental to, the distinctive character or repute of the trade mark. A link that causes consumers to buy the Applicant's goods might go on to satisfy the "unfair advantage" limb, and one that causes consumers to avoid the Opponent's goods might satisfy the "detrimental" limb.

73. At the hearing, Mr Groom claimed only "detriment", arguing that, as a mark with a reputation, CHEROKEE has an "aura" around it, which would be adversely affected by use of the applicant's mark on identical and similar goods. This is usually referred to in the cases as blurring or erosion of the distinctive character of the trade mark.

74. As the CFI stated in Case T-215/03 *Sigla SA v OHIM*:

46. ..., it must be noted that the purpose of Article 8(5) of Regulation No 40/94 is not to prevent registration of any mark which is identical or similar to a mark with a reputation. The objective of that provision is, notably, to enable the proprietor of an earlier mark with a reputation to oppose the registration of marks which are likely either to be detrimental to the repute or the distinctive character of the earlier mark or to take unfair advantage of that repute or distinctive character. In that connection, it should be made clear that the proprietor of the earlier mark is not required to demonstrate actual and present harm to his mark. He must however adduce prima facie evidence of a future risk, which is not hypothetical, of unfair advantage or detriment (*SPA-FINDERS ...*).

75. The only evidence that the Opponent has presented is of reputation. Without anything else to help me, I have found that the similarity between the trade marks is insufficient to create the necessary link that would affect consumers' buying behaviour. I am therefore unable to accept that there is more than a merely hypothetical risk that any blurring or other form of detriment would be caused to the distinctive character or repute of the Opponent's CHEROKEE trade mark by use of the Applicant's mark.

76. There is one additional element that was not discussed by the Hearing Officer, but which appears in section 5(3): this is the requirement that the use of the Applicant's mark would need to be "without due cause" for the ground of objection to be established. Little has been said about this requirement in the authorities, though Jacob LJ found it to be a point of significance in *L'Oréal v Bellure*. It plainly cannot be ignored in a case where the other requirements are satisfied. Since they are not satisfied in this case, I do not need to deal with it any further.

77. I therefore conclude that the section 5(3) objection is not made out.

Conclusion

78. Although I have found that the Hearing Officer did make some errors in reaching his decision to reject the opposition under both grounds, I agree with the outcome of the case under both section 5(2)(b) and 5(3) and accordingly dismiss the appeal.

79. The Hearing Officer ordered the Opponent to pay the Applicant the sum of £750 as a contribution to its costs of the proceedings below. I leave that order in place in view of the outcome of the appeal. The Applicant has had to consider the Notice of Appeal, and has incurred the cost of its representatives preparing and filing the written submissions. By way of contribution to those costs, I order the Opponent to pay the Applicant an additional sum of £250.

ANNA CARBONI

8 February 2008

John Groom of Groom Wilkes & Wright LLP appeared for the Opponent (Appellant).
The Applicant (Respondent) was not represented.