

BL O/0806/23

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION No. 3761154

BY

ROHIL ASLAM

TO REGISTER THE TRADE MARK:

ZILLIONAIRE

IN CLASSES 18, 25 AND 26

-AND-

THE OPPOSITION THERETO UNDER No. 434954

BY

PHILIPP PLEIN

Background and pleadings

1. Rohil Aslam (“**the Applicant**”) applied to register the trade mark ‘ZILLIONAIRE’ (“**the contested mark**”) in the UK on 23 March 2022. It was accepted and published in the Trade Marks Journal on 13 May 2022. The goods for which registration was sought were a variety of bags in Class 18; an extensive variety of clothing, footwear and headwear in Class 25; and a variety of haberdashery goods and hair adornments/accessories in Class 26.

2. Following a successful partial opposition against the application in unrelated proceedings before me, the applied-for specification was reduced to the following goods:¹


Class 25
Frames (Hat -) [skeletons]; Hat frames [skeletons]; Shoe uppers; Shoe soles; Stiffeners for shoes; Heel pieces for shoes; Masks (Sleep -); Face mask [clothing].
Class 26
Cloth patches for clothing; Buckles for clothing [clothing buckles]; Clothing buckles; Belt buckles [clothing accessories]; Belt buckles for clothing; Belt buckles [for clothing]; Belt buckles of precious metal [for clothing]; Belt clasps; Belt buckles; Belt clasp; Clasp (Belt -); Belt buckles of precious metals; Belt buckles not of precious metal; Strap buckles; Buckles (Shoe -); Hair buckles; Shoe buckles; buckles for bags; Buckles for bags; Buckles for clothing; Buckles [clothing accessories]; Buckles of precious metal [clothing accessories]; Arm bands [clothing accessories]; Hair bands; Bands (Hair -); Hat bands; Elasticated hair bands; Rubber bands for hair; Bands for the hair; Bands (Expanding -) for holding sleeves; Expanding bands for holding sleeves; Brooches [clothing accessories]; Feathers [clothing accessories]; Ostrich feathers [clothing accessories]; Birds' feathers [clothing accessories]; Birds' feathers as clothing accessories; Twisters [hair accessories]; Hair twisters [hair accessories]; Snap clips [hair accessories]; Claw clips [hair accessories].

3. On 9 August 2022, Philipp Plein (“**the Opponent**”) opposed the application under section 5(2)(b) of the Trade Marks Act 1994 (“**the Act**”). The opposition was directed at all the applied-for goods.

¹ See *Kira Sheppard v Rohil Aslam*, Case BL O/0523/23 (date of decision: 5 June 2023)

4. The opposition is based on the Opponent’s two comparable UK trade marks (EU),² shown below, which are both registered in respect of goods and services in Classes 3, 9, 14, 18, 25, 26, 35 and 41. For the purposes of this opposition, the Opponent relies solely on its goods in Classes 18, 25 and 26 (which are the same for both marks). Details of the Opponent’s registrations are as follows:³

Figurative Mark

Representation of the mark:	
Registration Number:	915607245
Filing date:	1 July 2016
Registration Date:	22 December 2017

Word Mark

Representation of the mark:	BILLIONAIRE
Registration Number:	915598675
Filing date:	30 June 2016
Registration Date:	25 January 2019

Goods

Class 18
Leather and imitation leather not included in other classes; Animal skins, hides; Casual bags; Backpacks; Travelling bags and other luggage; Handbags; Trunks and travelling bags; Attaché-cases, Briefcases, wallets; Purses; Cardholders;

² Following the end of the transition period of the UK’s withdrawal from the EU, all EU trade marks (“EUTM”) registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A ‘comparable trade mark (EU)’ retains the same filing date, priority date (if applicable) and registration date of the EUTM from which it derives.

³ The Opponent’s marks are earlier trade marks in accordance with section 6 of the Act.

Sport bags; Satchels; Toiletry kits; Umbrellas; Parasols; Walking sticks; Whips; Saddlery; Credit-card holders.

Class 25

Clothing, footwear, headgear.

Class 26

Brooches [clothing accessories]; Feathers [clothing accessories]; Buckles [clothing accessories]; Brassards; Birds' feathers [clothing accessories]; Ostrich feathers [clothing accessories]; Buckles of precious metal [clothing accessories]; Accessories for apparel, sewing articles and decorative textile articles.

5. The Opponent claims that the respective marks are highly similar and that its goods are either identical or highly similar to the applied-for goods giving rise to a likelihood of confusion.

6. The Applicant filed a counterstatement denying the claims made, stating that: *“I agree that the marks are quite similar in nature, in fact they differ by only one character. However, the earlier mark consists of an image whereas my application is for the word ZILLIONAIRE which differs not only visually but also phonetically and in meaning. [...] the overall impression conveyed to the public by the earlier mark would be dominated by its distinct style and lettering due to it being registered in that form. I believe this alongside our unique brand identities would alleviate any confusion for the public by means of association or otherwise.”*

7. Neither party filed evidence and only the Opponent elected to file submissions during the evidence rounds.⁴ No hearing was requested, and neither party elected to file submissions in lieu of a hearing. I make this decision following a careful consideration of the papers.

8. The Opponent is represented by CLIP.legal Marco Mario Locatelli. The Applicant has no professional legal representation in these proceedings.

9. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU

⁴ See the Preliminary Issues section of this decision with regard to the Opponent’s submissions, my paragraphs 10 – 11.

law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to the case law of the EU courts.

Preliminary Issue

10. The Opponent made submissions in relation to the distinctiveness of the earlier marks, namely that: *“the earlier signs are attributable to the [...] Philipp Plein fashion house, founded in 1998 and known worldwide in the luxury sector [...] Philipp Plein bought the “BILLIONAIRE” brand directly from the famous entrepreneur Flavio Briatore and revitalized it by creating a fashion line that has been raging in the world of fashion for years now [...] the BILLIONAIRE brand [...] is also worn by high-calibre celebrities.”* Included in its submissions was ‘evidence of fact’ to back up those statements.

11. A case management conference was held during the evidence rounds of these proceedings.⁵ The decision of the Hearing Officer, dated 22 March 2023 stated that the Opponent’s *“submissions contain what is considered evidence of fact (screenshots of web pages and social media pages and weblinks), which is not admissible in its current format and, given that the opponent has chosen not to file evidence, will not be taken into account by the Hearing Officer [in the final decision].”* As such, I shall disregard this material that is evidential in nature.

DECISION

Legislation and Case Law

12. Section 5(2)(b) and 5A of the Act are 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

⁵ Held on 22 March 2023.

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.”

13. I am guided by the following principles which 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:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when

- all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
 - (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
 - (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
 - (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
 - (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
 - (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
 - (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

14. In *Gérard Meric v Office for Harmonisation in the Internal Market*,⁶ (“**Meric**”), the General Court held to the effect that goods and services can be considered as identical when the goods and services designated by the earlier mark are included in a more general category, designated by the trade mark application and vice versa.

⁶ Case T- 133/05

15. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

- (a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification
- (b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.”

16. When considering whether goods and services are similar, all the relevant factors relating to the goods and services should be taken into account. Those factors include, inter alia:⁷

- (1) the physical nature of the goods or acts of service;
 - (2) their intended purpose;
 - (3) their method of use / uses;
 - (4) who the users of the goods and services are;
 - (5) the trade channels through which the goods or services reach the market;
 - (6) in the case of self-serve consumer items, where in practice they are found or likely to be found in shops and in particular whether they are, or are likely to be, found on the same or different shelves; and
 - (7) whether they are in competition with each other (taking into account how those in trade classify goods and services, for instance whether market research companies put them in the same or different sectors)
- or
- (8) whether they are complementary to each other.

⁷ See *Canon*, Case C-39/97, paragraph 23; and *British Sugar PLC v James Robertson & Sons Ltd.*, [1996] R.P.C. 281 – the “*Treat*” case

- (a) Complementary means *“there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”*.⁸
- (b) I note that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity,⁹ and that complementarity can be clearly distinguished from ‘use in combination’ – the latter being where goods/services are merely used together, whether by choice or convenience (e.g. bread and butter; or wine and wine glasses¹⁰), this means that they are not essential for each other.

17. When interpreting the terms in a specification I bear in mind:

- (1) that it is *“necessary to focus on the core of what is described [... and that] trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise”*, although *“where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods [and services] in question”*,¹¹
- (2) where *“the words chosen may be vague or could refer to goods or services in numerous classes [of the Nice classification system], the class may be used as an aid to interpret what the words mean with the overall objective of legal certainty of the specification of goods and services”*,¹²
- (3) the following applicable principles of interpretation:

⁸ *Boston Scientific Ltd v OHIM*, Case T-325/06, paragraph 82

⁹ *Kurt Hesse v OHIM*, Case C-50/15 P

¹⁰ As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amalia Mary Elliot v LRC Holdings Limited*, BL O/255/13 - *“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”*

¹¹ *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), paragraphs 11 - 12

¹² *Pathway IP Sarl (formerly Regus No. 2 Sarl) v Easygroup Ltd (formerly Easygroup IP Licensing Limited)*, [2018] EWHC 3608 (Ch), paragraph 94

“(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded.”¹³

18. For the purposes of making a comparison, the goods and services can be grouped together where the same reasoning applies.¹⁴

19. The goods to be compared are set out below:

Earlier Registration	Contested Application
<u>Class 18</u> Leather and imitation leather not included in other classes; Animal skins, hides; Casual bags; Backpacks; Travelling bags and other luggage; Handbags; Trunks and travelling bags; Attaché-cases, Briefcases, wallets; Purses; Cardholders; Sport bags; Satchels; Toiletry kits; Umbrellas; Parasols; Walking sticks; Whips; Saddlery; Credit-card holders.	
<u>Class 25</u> Clothing, footwear, headgear.	<u>Class 25</u> Frames (Hat -) [skeletons]; Hat frames [skeletons]; Shoe uppers; Shoe soles; Stiffeners for shoes; Heel pieces for shoes; Masks (Sleep -); Face mask [clothing].

¹³ See *Sky v Skykick* [2020] EWHC 990 (Ch), paragraph 56 (wherein Lord Justice Arnold, in the course of his judgment, set out a summary of the correct approach to interpreting broad and/or vague terms)

¹⁴ *Separode Trade Mark* BL O/399/10, paragraph 5

Class 26

Brooches [clothing accessories]; Feathers [clothing accessories]; Buckles [clothing accessories]; Brassards; Birds' feathers [clothing accessories]; Ostrich feathers [clothing accessories]; Buckles [clothing accessories]; Buckles of precious metal [clothing accessories]; Accessories for apparel, sewing articles and decorative textile articles.

Class 26

Cloth patches for clothing; Buckles for clothing [clothing buckles]; Clothing buckles; Belt buckles [clothing accessories]; Belt buckles for clothing; Belt buckles [for clothing]; Belt buckles of precious metal [for clothing]; Belt clasps; Belt buckles; Belt clasp; Clasp (Belt -); Belt buckles of precious metals; Belt buckles not of precious metal; Strap buckles; Buckles (Shoe -); Hair buckles; Shoe buckles; buckles for bags; Buckles for bags; Buckles for clothing; Buckles [clothing accessories]; Buckles of precious metal [clothing accessories]; Arm bands [clothing accessories]; Hair bands; Bands (Hair -); Hat bands; Elasticated hair bands; Rubber bands for hair; Bands for the hair; Bands (Expanding -) for holding sleeves; Expanding bands for holding sleeves; Brooches [clothing accessories]; Feathers [clothing accessories]; Ostrich feathers [clothing accessories]; Birds' feathers [clothing accessories]; Birds' feathers as clothing accessories; Twisters [hair accessories]; Hair twisters [hair accessories]; Snap clips [hair accessories]; Claw clips [hair accessories].

Class 25

20. The Applicant's specification contains the following goods:

"Frames (Hat -) [skeletons]; Hat frames [skeletons]".

- (1) These are goods that are not intended to be worn, rather they would be used as a foundation to make a hat. Notwithstanding the Opponent's specification contains the broad category "*headgear*", I do not consider the applied-for goods to be similar to the Opponent's.
- (2) The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing

those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different.¹⁵

- (3) The nature, intended purpose and method of use of the goods at issue are different, they are neither in competition with each other nor interchangeable. Even though the respective goods may belong to adjacent markets, they are not complementary, since the requirement of complementarity depends on the goods sharing the same consumer – the customers for the applied-for goods are likely to be milliners for example, rather than a customer who wishes to purchase a finished hat – therefore they cannot be considered to be complementary. The Applicant's goods are **dissimilar** to the Opponent's.

21. The Applicant's specification contains the following goods:

“Shoe uppers; Shoe soles; Stiffeners for shoes; Heel pieces for shoes”

- (1) These are parts, elements or components of shoes. The customers for these goods are likely to be cobblers that would use them to make shoes and/or repair shoes, rather than a person who wishes to purchase a finished pair of shoes.
- (2) Notwithstanding the Opponent's specification contains the broad category *“footwear”*, I do not consider the applied-for goods to be similar to the Opponent's. For example, a consumer wishing to purchase a pair of shoes, is unlikely to buy themselves a heel of a shoe instead.
- (3) Therefore, even though they may belong to adjacent markets, the nature, intended purpose and method of use of the goods at issue are different, they are neither in competition with each other nor interchangeable and they are not complementary. The Applicant's goods are **dissimilar** to the Opponent's.

22. The Applicant's specification contains the terms *“Masks (Sleep -)”* and *“Face mask [clothing]”*. Whilst these masks are contained in Class 25, I note that goods are not to be regarded as being similar to each other on the ground that they appear in the same class. Although masks are intended to be worn on the head, they are not items of

¹⁵ See the General Court case of *Les Éditions Albert René v OHIM*, Case T-336/03, paragraph 61.

clothing (i.e. they are not intended to clothe / dress a person's body) – for example, a consumer wishing to purchase clothes (such as a jumper and trousers), is unlikely to buy themselves a face mask instead. Whilst the 'face mask' term includes the word 'clothing' in square brackets, this is merely for classification purposes to indicate that they are not any other type of mask, such as cosmetic masks, swim masks, surgical masks or toy masks for example (all of which fall under different classes in the Nice Classification system i.e. Classes 3, 9, 10 and 28 respectively).

23. The purpose of a 'sleep mask' is to shade the wearer's eyes from light to aid sleep and the purpose of a 'face mask' is to shield the wearer's mouth and nose to protect them, and others, from breathable pollutants. Therefore the nature, intended purpose and method of use of these goods is different to any goods contained in the Opponent's specification. There is no justification to unnaturally strain the language of the term "*clothing*" contained in the Opponent's specification to extend to "*Masks (Sleep -); Face mask [clothing]*". I therefore consider the applied-for terms to be **dissimilar** to the Opponent's goods.

Class 26

24. As a Class heading can serve as an aid to interpretation, at this point I pause to note the wording of the Class 26 heading of the Nice Classification system and the accompanying 'Explanatory Note', namely:¹⁶

Class 26 heading:

"Lace, braid and embroidery, and haberdashery ribbons and bows; buttons, hooks and eyes, pins and needles; artificial flowers; hair decorations; false hair."

Explanatory Note:

"Class 26 includes mainly dressmakers' articles, natural or synthetic hair for wear, and hair adornments, as well as small decorative items intended to adorn a variety of objects, not included in other classes. This Class includes, in particular: wigs, toupees, false beards; barrettes, hair bands; ribbons and bows being

¹⁶ See the 'Nice Classification', a copy of which is available on the 'World Intellectual Property Organisation' website.

haberdashery or used as hair decorations, made of any material; ribbons and bows for gift wrapping, not of paper; hair nets; buckles, zippers; charms, other than for jewellery, key rings or key chains [...].”

25. 'Buckles'

- (1) *“Buckles [clothing accessories]; Buckles of precious metal [clothing accessories]”* appear in in both parties' specifications and are self-evidently **identical**.
- (2) *“Buckles for clothing [clothing buckles]; Clothing buckles; Buckles for clothing”* in the Applicant's specification are self-evidently **identical** to *“buckles [clothing accessories]”* in the Opponent's specification.
- (3) Before I proceed with comparing the remainder of the Applicant's 'buckle' terms with the Opponent's specification, I firstly I set out my interpretation of the relevant terms as follows:
 - (a) A 'buckle' (within the context of Class 26 goods) is a type of fastening that not only can be used on belts, but it can also be used on clothing as well as straps for shoes and bags such as handbags and backpacks for example. The functionality of the fastening remains the same, it does not alter. To illustrate my point, as a consumer, I am aware that a prong buckle (being one particular kind of buckle) for example, is a rim of metal, with a hinged tongue carrying one or more spikes, for securing a belt, strap, or ribbon, which passes through the rim and is pierced by the spike or spikes. This type of fastening operates in the same way, whether it is used on clothing, shoes or a bag, it does not alter.
 - (b) Similarly, a 'clasp' is a device with interlocking parts used for fastening things together. Therefore a 'belt clasp', within the meaning of Class 26, can be considered as being synonymous with a 'belt buckle'.
 - (c) *“Accessories for apparel”* in the Opponent's specification – 'Apparel' is another word for clothing / garments, therefore within the context of Class 26, I interpret this term as encompassing haberdashery items

such as ribbons and bows as well as fastenings such as buttons, zips, buckles, clasps, 'hooks and eyes' etc; it could also encompass clothing hardware items used to accessorise and/ or embellish clothing such as studs and buckles for example.

(4) With the above interpretations in mind, I consider:

(a) the following applied-for goods, namely:

“Belt buckles [clothing accessories]; Belt buckles for clothing; Belt buckles [for clothing]; Belt buckles of precious metal [for clothing]; Belt clasps; Belt buckles; Belt clasp; Clasp (Belt -); Belt buckles of precious metals; Belt buckles not of precious metal”

to be **identical** on the principle outlined in *Meric* to the following goods contained in the Opponent's specification:

“Accessories for apparel; Buckles [clothing accessories]; Buckles of precious metal [clothing accessories]”

This is on the basis that the respective goods are clothing accessories and they are also 'buckles'.

(b) the following 'buckles' in the Applicant's specification, namely:

“Strap buckles; Buckles (Shoe-); Shoe buckles; buckles for bags; Buckles for bags”

to be **identical** on the principle outlined in *Meric* to the following goods in the Opponent's specification:

“Buckles [clothing accessories]; Buckles of precious metal [clothing accessories]; Accessories for apparel”

This is on the basis that certain 'buckles' can operate in the same way, whether they are used on clothing, shoes or handbags – a belt buckle to accessorise clothing, may also be the same buckle used as a

fastening on the strap of a handbag or a shoe strap fastening for example. In the **alternative**, they are at least similar to a **high degree** because the respective goods overlap in nature, they may also overlap in method of use, user and share the same trade channels. They may also be in competition with each other, and be interchangeable.

26. 'Feathers'

- (1) "*Feathers [clothing accessories]; Birds' feathers [clothing accessories]; Ostrich feathers [clothing accessories]*" appear in in both parties' specifications and are self-evidently **identical**.
- (5) "*Birds' feathers as clothing accessories*" in the Applicant's specification is self-evidently **identical** to "*Birds' feathers [clothing accessories]*" in the Opponent's specification.

27. 'Clothing accessories / decorative textile articles'

- (1) "*Brooches [clothing accessories]*" appear in in both parties' specifications and are self-evidently **identical**.
- (2) "*Cloth patches for clothing*" in the Applicant's specification is **identical** on the principles outline in *Meric* to the Opponent's: "*sewing articles and decorative textile articles*".
- (3) "*Hat bands*" in the Applicant's specification relates to a decorative strip of material fastened around the circumference of a hat, positioned above the brim. I consider this term to be **identical** on the principles outlined in *Meric* to the Opponent's: "*decorative textile articles*". Or in the **alternative** they are at least **highly similar** due to their shared nature, purpose and use; they would likely have the same user and share the same trade channels.
- (4) I interpret the following terms in the Applicant's specification, namely: "*Bands (Expanding -) for holding sleeves; Expanding bands for holding sleeves*" as being sleeve garters, i.e. bands for holding up long sleeves when they are rolled back; and "*Arm bands [clothing accessories]*" as either a sleeve garter,

or as a piece of cloth to be worn on the sleeve. As such, I consider the aforementioned applied-for goods to be **identical** on the principles outlined in *Meric* to the Opponent's "*Accessories for apparel; brassards*" ('brassards' being the word to describe a band worn on the sleeve, for example, on the sleeve of a uniform).

28. "Hair adornments / accessories"

- (1) It is my understanding that the applied-for term "*hair buckles*" is another way of referring to 'hair barrettes' i.e. hair clips; it does not have the same meaning as the 'buckles' I have previously referred to.
- (2) The following applied-for terms are all hair accessories i.e. accessories for fastening, clipping, tying and adorning the hair:

"Hair buckles; Hair bands; Bands (Hair -); Elasticated hair bands; Rubber bands for hair; Bands for the hair; Twisters [hair accessories]; Hair twisters [hair accessories]; Snap clips [hair accessories]; Claw clips [hair accessories]."

- (3) Notwithstanding these terms are contained in Class 26, I consider them to be **dissimilar** to the Opponent's Class 26 goods. This is because they differ in nature, intended purpose, method of use and neither are those goods in competition with each other, nor interchangeable and they are not complementary (I also consider these terms to be dissimilar to the Opponent's Class 18 and 25 goods for these same reasons).
- (4) In reaching this conclusion, I do not disregard that in the fashion industry, goods such as hair accessories may be sold by the same undertaking (or fashion house) that produces clothing, footwear, headgear and handbags for example, however, the respective goods are nonetheless dissimilar.
- (5) In that regard, I refer to the decision of the General Court in *Compagnie des montres Longines, Francillon SA v OHIM*,¹⁷ where the General Court rejected the argument that sunglasses, jewellery and watches were similar

¹⁷ Case T-505/12, paragraphs 46 – 60.

to clothing. I think the same reasoning of the Court can be applied in relation to a comparison between the Applicant's 'hair accessories' and the Opponent's Class 18, 25 and 26 goods.

- (6) In reaching its conclusion, the Court considered that the goods differed in their nature, their intended purpose and their method of use; and it was held that as the nature, intended purpose and method of use of the goods were different, they were neither in competition with each other nor interchangeable.
- (7) The Court rejected the argument that the goods were interchangeable on the basis that it was not proven that it is typical for a consumer who intends to buy themselves sunglasses, jewellery or a watch, to suddenly decide to buy themselves clothing instead and vice versa; and that to accept that they are interchangeable "*is manifestly contrary to the principle of speciality of marks [...] and would improperly extend the area of protection of trade marks.*"

Conclusion on the comparison of goods

29. I have found the applied-for goods in Class 25 to be dissimilar to the Opponent's goods. With the exception of the Applicant's 'hair accessory' goods (which I have found to be dissimilar to the Opponent's goods), I have found identity between the respective Class 26 goods, and I have found an alternative finding of a high degree of similarity in respect of some of those goods.

30. Since some similarity between the goods is required for the purposes of a section 5(2)(b) claim, the opposition must fail in respect of the dissimilar goods identified above.¹⁸ I therefore proceed to consider a likelihood of confusion only in relation to the goods that are identical or similar.

The average consumer and the nature of the purchasing act

31. Trade mark questions, including the likelihood of confusion, must be viewed through the eyes of the average consumer of the goods in question. The average

¹⁸ See *Waterford Wedgwood plc v OHIM* – C-398/07 P (CJEU); and *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, paragraph 49.

consumer is deemed to be reasonably well informed and reasonably observant and circumspect. The word “average” merely denotes that the person is typical,¹⁹ which in substance means that they are neither deficient in the requisite characteristics of being well informed, observant and circumspect, nor top performers in the demonstration of those characteristics.²⁰

32. It is therefore necessary to determine who the average consumer of the respective goods is, and how the consumer is likely to select those goods. It must be borne in mind that the average consumer’s level of attention is likely to vary according to the category of goods in question.²¹

33. The average consumer of the Class 26 goods at issue will be a member of the general public as well as professionals such as dressmakers and businesses such as clothing manufacturers.

34. The goods would to be sold through a range of retail outlets, wholesale outlets (and their online equivalents) such as haberdashers, drapers, department stores, as well as online market places and catalogues. The goods are likely to be displayed on shelves or on rails, where they will be viewed and self-selected by the consumer. A similar process will apply online and with catalogues where the consumer will select the goods having viewed an image displayed on a webpage/page.

35. Given the nature and the purpose of the goods, the selection process is likely to involve considerations such as aesthetics, quality and functionality, therefore it is likely that the purchasing process will be predominantly visual; and even where the consumer makes an aural request for the goods to staff, the selection process prior to purchase would still be visual in nature.

36. Whilst it is true that the goods will range in price from inexpensive to luxury high-end prices (particularly considering that the specifications contain some goods made from ‘precious metal’), for the most part the goods are not particularly costly. Where the average consumer is a member of the general public, such as a hobbyist

¹⁹ *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), paragraph 60

²⁰ *Schutz (UK) Ltd v Delta Containers Ltd* [2011] EWHC 1712, paragraph 98

²¹ *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97

dressmaker, the goods are likely to be purchased less frequently than a clothing manufacturer for example.

37. Although the average consumer (whether they are an individual or a clothing manufacturer for example) will be paying attention to the aesthetics and functionality of the goods, their level of attention when selecting and purchasing them is likely to be between low and medium, and will likely be on the upper or lower end of that scale depending on the cost of the item (goods made from precious metals are likely to cost more than goods made of plastic for example, therefore the level of attention paid to more expensive items is likely to be on the upper end of that scale) – but even in those circumstances, the relevant average consumer will not typically demonstrate more than a medium level of attention.


Comparison of marks

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

39. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

40. The respective trade marks are shown below:

Earlier trade marks	Contested trade mark
<p data-bbox="199 338 434 371"><u>Figurative mark:</u></p>  <p data-bbox="199 562 370 595"><u>Word Mark:</u></p> <p data-bbox="392 633 592 667">BILLIONAIRE</p>	<p data-bbox="997 432 1197 465">ZILLIONAIRE</p>

41. I will firstly approach the comparison with the earlier figurative mark since I consider this mark to represent the Opponent's best case.

42. In *HERNO S.p.A. v Miss Sparrow Ltd*,²² Mr Iain Purvis KC, sitting as the Appointed Person, considered a comparison between a word-only mark and a figurative mark, where the figurative mark consisted of a word in a stylised font. He concluded that the correct approach of a tribunal when faced with such a comparison is to simply consider the similarity of the word itself to the figurative mark, bearing in mind that the particular font in which the word-only mark happens to be presented on the Register is irrelevant.²³

Overall impression

43. The earlier figurative mark is as follows:



Whilst it is referred to by the parties as 'BILLIONAIRE', the first character of the mark is not a complete letter 'B', which in my opinion alters the overall impression of the mark as the word BILLIONAIRE. This is because the stylisation of the first character is such that it could be perceived as an 'incomplete' letter 'B'; or it could also be

²² BL O/954/22

²³ *Ibid.*, paragraphs 36 – 42.

perceived by a significant proportion of the relevant public as a cursive letter 'Z' i.e. a 'Z' which resembles the number '3' with a looped tail.

44. I do not discount that the first character may well be perceived as a stylised filigree scroll device or as the number '3' (although this is less likely because the average consumer is more likely to perceive it as either a 'B' or a 'Z' in order to complete the word, and make sense of the letters that follow it). As such, it is likely that the earlier figurative mark could be perceived as the word 'BILLIONAIRE' or as the word 'ZILLIONAIRE' by a significant proportion of the relevant public.

45. The contested mark is the word 'ZILLIONAIRE', therefore the overall impression of the mark rests solely in that word.

Visual comparison

46. The visual difference between the respective marks rests in the first letter/ character (which could be perceived as either a 'B' or a 'Z'). The font and stylisation of the remainder of the letters making up the earlier mark – 'ILLIONAIRE' – are not distinguishing features and that sequence of letters remains visually identical to the same sequence in the contested mark.

47. The stylisation of the first character of the earlier mark creates a visual impact, such that it creates a visual difference between the respective marks, regardless of how the first character of the earlier mark is perceived (whether it is perceived as a letter 'B' or a letter 'Z'). Either way, the presence of the same root 'ILLIONAIRE' in both marks gives rise to a strong visual similarity. The marks are visually similar to a high degree.

Aural comparison

48. Aurally, the marks are identical where the earlier mark is perceived as 'ZILLIONAIRE'; they are similar to a high degree where it is perceived as 'BILLIONAIRE'. This is because they contain the same sequence of ten letters – 'ILLIONAIRE' – with the only aural difference being attributed to the first letter sound. 'BILLIONAIRE' would be pronounced as 'BILL-YON-AIR'; and 'ZILLIONAIRE' as

'ZIHL-YON-AIR'. Even if the first letter is perceived as a 'B', the letters 'B' and 'Z' are aurally similar because they both have a soft sound.

Conceptual comparison

49. Both parties are in agreement as to the meaning of the word 'ZILLIONAIRE' i.e. that it is a person of immeasurable wealth; and 'BILLIONAIRE' i.e. a person possessing assets worth at least a billion pounds.

50. Where the earlier mark is perceived as 'ZILLIONAIRE', the concept between the two is self-evidently identical; where it is perceived as 'BILLIONAIRE' – whilst there is a subtle change in concept, 'billionaire' nonetheless refers to a person with immense wealth and therefore the concepts are highly similar.

Conclusion on the comparison of the marks

51. In the event that the earlier figurative mark is perceived as 'ZILLIONAIRE', the respective marks are visually similar to a high degree; and aurally and conceptually identical.

52. Where it is perceived as 'BILLIONAIRE', the marks are visually similar to a high degree, and are also aurally and conceptually similar to a high degree. My conclusions in relation to a comparison between contested mark and the Opponent's earlier word mark 'BILLIONAIRE' are the same.

Distinctive character of the earlier mark

53. The degree of distinctiveness of an earlier mark is one of the factors that must be taken into account when assessing whether there is a likelihood of confusion. This is because the more distinctive it is, the greater the likelihood of confusion may be, although it is the distinctive character of a component that is similar between the marks that is particularly relevant.

54. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

55. Although the Opponent intimated at a claim for enhanced distinctiveness in its submissions, this claim was not supported by evidence, therefore I only have the inherent distinctiveness of the earlier marks to consider.

56. The distinctive character of the earlier figurative mark lies predominantly in the word itself, which, due to the stylisation, could be perceived in two ways. Whichever way it is perceived, the meaning of the word is likely to be understood as people of enormous/ immeasurable wealth, and therefore it makes no descriptive or obviously allusive reference to the Opponent's goods. The same reasoning applies to the earlier word mark.

57. I find that the earlier marks are inherently distinctive to a medium degree. I do not find that the stylisation of the earlier figurative mark elevates the distinctiveness of the word beyond medium.

Likelihood of Confusion

58. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them that they have kept in mind.²⁴ I must also consider the average consumer of the services, the nature of the purchasing process and bear in mind that 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.²⁵

59. Making an assessment as to the likelihood of confusion is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. The global assessment is supposed to emulate what happens in the mind of the average consumer on encountering the later mark with an imperfect recollection of the earlier mark in mind.

60. Confusion can be direct, which is a simple matter of the consumer mistaking one mark for another, or indirect, which is where the consumer notices that the marks are

²⁴ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*, Case C-342/97, paragraph 27

²⁵ *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, Case C-39/97, paragraph 17

different, but the later mark and the earlier mark share common elements that lead the consumer to conclude that it is another brand of the owner of the earlier mark.²⁶

61. I found that the earlier figurative mark can be seen either as the word 'BILLIONAIRE' or as the word 'ZILLIONAIRE', with both perceptions belonging to a significant proportion of the relevant public. The overall impression of the earlier marks is dominated by the word 'BILLIONAIRE' / 'ZILLIONAIRE' (depending on how the first element of the figurative mark is perceived) which I have found to be distinctive to a medium degree. The overall impression of the contested mark lies in the word 'ZILLIONAIRE'.

62. The parties' respective marks are at least visually similar to a high degree. The contested mark is aurally and conceptually similar, to a high degree, to: (1) the earlier word mark 'BILLIONAIRE'; and (2) the earlier figurative mark (where the earlier figurative mark is perceived as 'BILLIONAIRE'). The respective marks are identical aurally and conceptually where the earlier figurative mark is perceived as 'ZILLIONAIRE'.

63. With regard to the relative weight to be given to the visual, aural and conceptual comparison I note that generally speaking, the goods are chosen by the consumer for their aesthetics and for their functionality, therefore the selection is visual in nature, and a visual perception of the marks will generally take place prior to purchase. Accordingly, the visual aspect plays a greater role in the global assessment of the likelihood of confusion for such goods.²⁷ (In any event, if the goods are requested orally, the marks sound either identical or highly similar.)

64. I have found that the contested Class 26 goods are for the most part identical and in the alternative, some goods are similar to a high degree. I have determined the average consumer will typically, for the most part, demonstrate a low to medium level of attention when purchasing those goods.

²⁶ See *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, paragraphs 16 to 17 wherein Mr Iain Purvis QC, sitting as the Appointed Person, dealt with the distinction between direct and indirect confusion

²⁷ See *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, paragraphs 49 – 50.

65. The differences between the marks are such, that they are insufficient to preclude a finding of confusion. Taking all the above into account and allowing for imperfect recollection, whilst bearing in mind the principle of interdependency; I find that the average consumer – or at least a significant proportion thereof – will mistake one mark for the other and be confused as to the origin of the goods.

OUTCOME

66. The opposition under section 5(2)(b) of the Act against the goods applied for in Classes 25 and 26 has been partially successful.

67. Accordingly, subject to appeal, the application will be allowed to proceed to registration in respect of the following goods in Classes 25 and 26:

Class 25
Frames (Hat -) [skeletons]; Hat frames [skeletons]; Shoe uppers; Shoe soles; Stiffeners for shoes; Heel pieces for shoes; Masks (Sleep -); Face mask [clothing].
Class 26
Hair buckles; Hair bands; Bands (Hair -); Elasticated hair bands; Rubber bands for hair; Bands for the hair; Twisters [hair accessories]; Hair twisters [hair accessories]; Snap clips [hair accessories]; Claw clips [hair accessories].

68. The application will be refused registration in respect of the following goods in Class 26:

Class 26
Cloth patches for clothing; Buckles for clothing [clothing buckles]; Clothing buckles; Belt buckles [clothing accessories]; Belt buckles for clothing; Belt buckles [for clothing]; Belt buckles of precious metal [for clothing]; Belt clasps; Belt buckles; Belt clasp; Clasp (Belt -); Belt buckles of precious metals; Belt buckles not of precious metal; Strap buckles; Buckles (Shoe -); Shoe buckles; buckles for bags; Buckles for bags; Buckles for clothing; Buckles [clothing accessories]; Buckles of precious metal [clothing accessories]; Arm bands [clothing accessories]; Hat bands; Bands (Expanding -) for holding sleeves; Expanding bands for holding sleeves; Brooches [clothing accessories]; Feathers [clothing accessories]; Ostrich feathers [clothing accessories]; Birds' feathers [clothing accessories]; Birds' feathers as clothing accessories.

COSTS

69. The Opponent has been successful and is entitled to a contribution towards its costs in bringing the proceedings. I award the Opponent the sum of £600 based on the contributory scale set out in Tribunal Practice Notice (2/2016) as follows:

Official fee	£100
Preparing the statement of grounds and considering the counterstatement	£200
Preparing written submissions	£300
TOTAL	£600

70. I therefore order Rohil Aslam to pay Philipp Plein the sum of **£600**. This sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 23rd day of August 2023

Daniela Ferrari

For the Registrar