O/0935/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003763353

IN THE NAME OF EX-WIVES LTD

FOR THE FOLLOWING TRADE MARK:

IN CLASSES 9, 14, 16, 18, 20, 21, 25 AND 41

AND IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 434912

BY BEELINE GMBH

BACKGROUND AND PLEADINGS

1. On 8 March 2022, EX-Wives Ltd ("the applicant") applied to register the trade mark shown on the cover page of this decision, in the UK. The application was published for opposition purposes on 15 April 2022 and registration is sought in respect of the goods and services shown in the Annex to this decision.

2. On 11 July 2022, the application was partially opposed by Beeline GmbH ("the opponent") based upon section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opposition is directed at those goods underlined in the Annex to this decision. The opponent relies upon the following trade mark:

UKTM no. 901286301[1]
Filing date 23 August 1999; registration date 23 March 2001
Priority date: 24 February 1999 (Germany)
Relying upon some goods for which the mark is registered, namely:

Class 14 Jewellery and fashion jewellery, including chains and small chains, in particular chains for necklaces and bracelets, ankle chains and bikini chains, chain pendants, earrings, in particular ear studs, ear clips, creole necklaces, tie pins, scarf clips, cuff links, brooches, finger rings, bracelets, all the aforesaid goods in particular of silver, common metals, plastic, textile, leather,

[1] On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all rights holders with an existing EUTM. As a result of the opponent having an EUTM being protected as at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable trade mark shown here is now recorded on the UK trade mark register, has the same legal status as if it had been applied for and registered under UK law, and retains its original filing date.

rubber, glass, paste or a combination of these materials; Timepieces and Accessories therefor, included in class 14, In particular wristwatches, Watches, Watch straps, Clock cases, Chains for watches and Watch chains; Key rings [trinkets or fobs].

Class 18 Casual bags; Umbrellas; Pocket wallets and purses.

Class 25 Scarves, Neck scarfs [mufflers], Shawls, Boas.

Class 26 Decorative articles for the hair, Including bows for the hair, combs, Hair bands, Bands, Ribbons, Braces; Ornamental novelty badges; Artificial flowers, Namely corsages with brooch clips and decorative flowers.

3. The opponent claims that the marks are similar, and the goods and services are identical or similar, with the result that there is a likelihood of confusion.

4. The applicant filed a counterstatement denying the claims made and putting the opponent to proof of use of the earlier mark.

5. The applicant is represented by Clintons Solicitors and the opponent is represented by Carpmaels & Ransford LLP.

6. Only the opponent filed evidence. Neither party requested a hearing and only the opponent filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

EVIDENCE AND SUBMISSIONS

7. The opponent filed evidence in chief in the form of the witness statement of Maren Langenhagen dated 2 February 2023, which is accompanied by 14 exhibits. Ms Langenhagen is the Director of Finance & Legal for the opponent, a position she has held since November 2021. Ms Langenhagen's evidence goes to the use of the earlier mark.

8. The opponent filed written submissions in lieu dated 15 June 2023.

9. I have taken the evidence and submissions into account and will refer to them below where necessary.

RELEVANCE OF EU LAW

10. 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 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. This is why this decision continues to make reference to the trade mark case-law of EU courts.

DECISION

11. Section 5(2)(b) of the Act reads as follows:

> "5(2) A trade mark shall not be registered if because –
>
> (a)…
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

12. Section 5A of the Act is as follows:

> "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. The trade mark upon which the opponent relies qualifies as an earlier trade mark pursuant to section 6 of the Act. As the earlier mark had completed its registration process more than 5 years before the filing date of the mark in issue, it is subject to proof of use pursuant to section 6A of the Act.

Proof of use

14. I will begin by assessing whether there has been genuine use of the earlier mark. The relevant statutory provisions are as follows:

"(1) This section applies where:

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section "the relevant period" means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

a) use of a trade mark includes use in a form (the "variant form") differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services."

15. Section 100 of the Act states that:

"100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it."

16. As the earlier mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

> "7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.
>
> (2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—
>
> (a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and
>
> (b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.
>
> (3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —
>
> (a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and
>
> (b) the references in section 6A to the United Kingdom include the European Union".

17. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier mark is the five-year period ending with the filing date of the application in issue i.e. 9 March 2017 to 8 March 2022. By virtue of the above provisions, use in the EU will be relevant up until IP Completion Day i.e. 31 December 2020. After that date, only use in the UK will be relevant.

18. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

> "114. […] The CJEU has considered what amounts to "genuine use" of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp* v *Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.
>
> 115. The principles established by these cases may be summarised as follows:
>
> (1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].
>
> (2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].
>
> (3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it

guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or

preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32]."

19. Proven use of a mark which fails to establish that "the commercial exploitation of the mark is real" because the use would not be "viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark" is, therefore, not genuine use.

20. I note the following from the opponent's evidence:

a) The opponent was established in 1990, in Germany. By 2011, the opponent was selling its goods in France, Italy, Spain, Portugal, Ireland and the UK.

b) The opponent sells its goods under three main brands, of which SIX is one. The SIX band was launched in 1998. Ms Langenhagen states:

"SIX is principally a fashion jewellery brand, however, other products are sold under the brand such as accessories, scarves, handbags, and decorative articles for hair."

She also confirms that the earlier mark has been used continuously in the EU since 1998 and in the UK since 2017.

c) The opponent has been selling its SIX products in the UK through Tesco stores since August 2017.[2]

[2] Exhibit ML3

d) Photographs of jewellery and hair accessories displayed under the earlier mark have been provided, taken from DV8 stores (which has 50 stores, including in Northern Ireland and Scotland, although it is not clear whether all 50 are in the UK).[3]

e) Undated screenshots from Amazon show a wide range of goods available (such as hats and purses), but there is no information confirming when these goods were first offered for sale.[4]

f) The opponent's approximate annual EEA gross sales are provided as follows:

Year end 31 December	Total Gross Sales (Euros)
2017	€ 130 Million
2018	€ 133 Million
2019	€ 130 Million
2020	€ 86 Million

g) The opponent's approximate UK gross sales are provided as follows:

Year end 31 December	Total Gross Sales (Euros)
2021	€ 14 Million
2022 (January till April)	€ 4 Million

h) A representative sample of invoices have been provided.[5] These are addressed to customers located in Germany and the UK and are dated between 2019 and

[3] Exhibit ML4
[4] Exhibit ML5
[5] Exhibits ML6, ML7 and ML10

May 2022 (those related to Germany are dated prior to IP Completion Day). The earlier mark does not appear on all of the invoices, nor does the word SIX. However, Ms Langenhagen's unchallenged narrative evidence is that all of these sales related to the SIX brand. Of the goods that I am able to identify, I note that the vast majority relate to jewellery (totalling over 600 units including almost 400 earrings/earcuffs, over 90 rings, over 25 bracelets, over 25 nose rings/studs and over 70 necklaces). There are various other sales including approximately 45 units of bags, approximately 55 units of hair accessories (head bands, hair bands, hair clips etc.) and approximately 20 purses/wallets.

i) A selection of receipts have also been provided for sales made in the opponent's Dusseldorf store in 2018.[6] Of those goods that I am able to identify, there are over 20 sales of jewellery (rings, earrings, bracelets etc), 2 wallets, 2 scarves, 3 gloves, 5 items of headwear, 3 bags, 1 pair of slippers and 2 hair accessories.

j) Ms Lagenhagen has given the following figures for the advertising expenditure incurred in relation to the SIX brand:

Media spendings 2021, 2022
Brand: SIX

Channel	2021	2022
Google (SEA, GDN, Google Shopping)	343.905,00 €	262.125,00 €
META (FB, META Paid Social Ads)	312.776,00 €	339.377,00 €
Display (incl. Programmatic paid Ads, Video Ads)	201.993,00 €	433.607,00 €
TOTAL	**858.674,00 €**	**1.035.109,00 €**

However, I note that there is no breakdown by jurisdiction or product type.

k) The opponent also promotes its brand through social media.[7]

21. The burden is on the opponent to demonstrate that the mark has been used, in the relevant territory, during the relevant period, in relation to the particular goods

[6] Exhibits ML8 and ML9
[7] Exhibit ML13

relied upon. There are clearly issues with the opponent's evidence in this regard. Firstly, the opponent's evidence is that it sells goods under three (main) marks. However, turnover figures have been provided for the opponent, but no explanation is provided as to what proportion of these figures relate to goods sold under the earlier mark. Secondly, the turnover and advertising figures provided are not broken down by product category. Consequently, it is impossible for me to assess the extent of use in relation to the particular goods relied upon. I am, therefore, heavily reliant upon the invoices filed to attempt to identify the extent of the use made in relation to the different categories of goods for which the opponent is attempting to demonstrate genuine use of the earlier mark.

22. Ms Lagenhagen gives evidence that SIX is predominantly a jewellery brand. That is apparent from the invoice/receipt evidence filed, which overwhelmingly relate to jewellery goods. Taking the evidence as a whole into account, and given Ms Lagenhagen's evidence that the invoices provided are only a representative sample, I am prepared to find that there has been genuine use of the earlier mark in relation to jewellery. The evidence of other goods (such as bags, hair accessories etc) being sold is so thin that I am unable to find that the use is warranted to create or maintain a share in the market concerned.

Section 5(2)(b) – case law

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

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

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

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

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

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

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

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

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

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

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

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

Comparison of goods

24. In light of my findings above, the competing goods are as follows:

Opponent's goods	**Applicant's goods**
Class 14 Jewellery	Class 14 Jewellery; keyrings. Class 18 Bags; cases; suitcases; travelling bags; backpacks; athletic bags; beach bags; book bags; duffel bags; gym bags; tote bags; shopping bags; leather and imitations of leather, and goods made of these materials (included in Class 18). Class 25 Clothing; articles of clothing; t-shirts; sweatshirts; sweaters; dresses; footwear; headgear; hats; caps.

25. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the Court of Justice of

the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

> "In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary."

26. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

> (a) The respective uses of the respective goods or services;
>
> (b) The respective users of the respective goods or services;
>
> (c) The physical nature of the goods or acts of service;
>
> (d) The respective trade channels through which the goods or services reach the market;
>
> (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;
>
> (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

27. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal*

Market (Trade Marks and Designs) (OHIM), Case T-325/06, the General Court ("GC") stated that "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."

Class 14

Jewellery

28. This term appears identically in the specifications of both marks.

Keyrings

29. There may be an overlap in trade channels and user with the opponent's "jewellery". The method of use and purpose of the goods differ, as the opponent's goods are used to adorn the body, whereas the applicant's goods are used as a decorative accessory and to securely hold the user's keys. The nature of the goods may overlap to the extent that they may be made from the same materials. The goods are neither in competition, nor complementary. I consider them to be similar to a medium degree.

Class 18

Bags; cases; suitcases; travelling bags; backpacks; athletic bags; beach bags; book bags; duffel bags; gym bags; tote bags; shopping bags; leather and imitations of leather, and goods made of these materials (included in Class 18).

30. These goods may be sold through the same trade channels as the opponent's goods, as some retailers will sell a range of fashion goods (such as clothing, jewellery, or bags). The user will clearly be the same. However, the method of use will differ as one is used to adorn the body whilst the other is carried to store smaller articles. The

purpose of the goods may overlap to the extent that they may all involve an aesthetic consideration, but their specific purposes clearly differ. There is no competition or complementarity. Consequently, I consider there to be a low degree of similarity between the goods.

Class 25

Clothing; articles of clothing; t-shirts; sweatshirts; sweaters; dresses; footwear; headgear; hats; caps.

31. The same applies to these goods as set out in paragraph 30 above. However, I note that there is some degree of overlap in method of use to the extent that both the applicant's goods and the opponent's goods will be worn on the body. Consequently, I consider the goods to be similar to between a low and medium degree.

The average consumer and the nature of the purchasing act

32. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited,* [2014] EWHC 439 (Ch), Birss J (as he then was) described the average consumer in these terms:

> "60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

33. The average consumer for the goods will be a member of the general public. The goods are likely to vary in cost and frequency of purchase. However, considerations such as materials, aesthetics and functionality are likely to be taken into account. Consequently, I consider that at least a medium degree of attention is likely to be paid during the purchasing process. However, I recognise that it may be higher for goods such as jewellery which may attract a particularly high cost.

34. The goods are likely to be self-selected from the shelves of a retail outlet or their online equivalent. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount that there may also be an aural component to the purchase given that advice may be sought from retail assistants.

Comparison of trade marks

35. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

> "… it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

36. It would be wrong, therefore, to artificially dissect the trade marks, 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.

37. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
	

38. The opponent's mark consists of the word SIX beneath a series of six circles. The eye is naturally drawn to the element of the mark that can be read, and so the word SIX plays the greater role in the overall impression, with the device playing a slightly lesser role. The applicant's mark consists of the word SIX. The letter I is slightly shorter than the other two letters, and has a crown device above it. The text is presented in white on a purple background and the device is presented in gold. The word SIX plays the greater role in the overall impression due to its size, with the device and use of colour playing a lesser role.

39. Visually, the marks coincide in the presence of the word SIX. However, the differing devices and fonts act as a point of visual difference. As the applicant submits, the size of the respective word and device elements is also a point of difference. Consequently, I consider the marks to be visually similar to between a medium and high degree.

40. Aurally, the word SIX will be given its ordinary English pronunciation, which will be identical for both marks.

41. Conceptually, the word SIX will be recognised as a number. I do not consider that any real conceptual message will be conveyed by the devices. Consequently, I consider the marks to be conceptually identical, to the extent that the word SIX has any real concept.

Distinctive character of the earlier mark

42. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR 1-2779, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

43. 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 and services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

44. The earlier mark consists of the word SIX presented beneath six circles. The word SIX is a common dictionary word. Consequently, I consider it to be inherently distinctive to a medium (or average) degree. I do not consider the device raises the distinctiveness of the mark to any material extent.

45. I have summarised the opponent's evidence of use above. I also note the following from the opponent's evidence:

a) The opponent has collaborated with social media influencers to promote its SIX brand.[8] However, no information is provided about whether these influencers would be known to the UK average consumer.

b) The opponent has provided information about the impact of its social media promotions, but there is nothing to link this to the UK market specifically.[9] Indeed, the references to websites linked in the social media posts refer to ".de" indicating that they are targeted at the German market.

c) The opponent has provided a survey which identifies the opponent's SIX brand as having a "similar perception" with UK consumers to other brands in the market.[10] However, it is not clear in what circumstances this data was obtained or what this means in terms of public recognition.

46. The relevant market for assessing enhanced distinctiveness is the UK market. I have no market share figure for the UK, no advertising expenditure for goods sold under the SIX brand in the UK and no turnover figures for the UK market specifically. The survey evidence filed by the opponent does not, in my view, counterbalance these clear deficiencies and it is not sufficiently clear to suggest that the distinctiveness of the earlier mark has been enhanced through use in relation to the goods relied upon.

[8] Exhibit ML11
[9] Exhibits ML12 and ML13
[10] Exhibit ML14

Likelihood of confusion

47. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertaking being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective goods may be offset by a greater degree of similarity between the marks and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

48. I have found as follows:

a) The goods vary from being identical to similar to a low degree.

b) The average consumer will be a member of the general public who will pay at least a medium degree of attention during the purchasing process (although I recognise it may be higher for expensive goods such as jewellery).

c) The purchasing process will be predominantly visual, although I do not discount an aural component to the purchase.

d) The marks are visually similar to between a medium and high degree and aurally identical. To the extent that the word SIX conveys any concept, the marks will be conceptually identical.

e) The earlier mark is inherently distinctive to a medium degree.

49. Given that the dominant element of both marks is the word SIX, where they are used on identical goods or goods that are similar to a medium degree, I consider that they are likely to be mistakenly recalled or misremembered as each other. This is because, bearing in mind the principle of imperfect recollection, the average consumer is likely to recall the dominant element – SIX – and overlook the differing device/presentational elements. Consequently, there is a likelihood of direct confusion. However, where the goods are similar to only a low degree, I consider the goods to be sufficiently different to offset the similarity of the marks and to avoid a likelihood of direct or indirect confusion.

CONCLUSION

50. The opposition is successful in relation to the following goods for which the application is refused:

Class 14 Jewellery; keyrings.

51. The application may proceed to registration for the following goods in relation to which the opposition was unsuccessful and which were unopposed:

Class 9 Apparatus for recording; transmission; reproduction of sound or images; CDs, CD-ROMs, DVDs, DVD-ROMs, floppy disks, USB sticks, records, audio and video discs and cassettes; compact discs; audio cassettes; records; sound and/or video recordings; pre-recorded television programmes; cinematographic films; publications in electronic form; laser discs; CD ROMs; discs containing interactive software; computers and peripheral devices thereto; headphones; headsets for portable media players ; MP3 players and mobile phones; data-processing apparatus; computer software (recorded programs); software downloaded or downloadable via the internet, and via remote communications devices; bags for protecting and transporting computers, computer equipment and portable media players and MP3 players; mobile telephone accessories; portable media players and MP3

players; smart phones (including mobiles with music players); decorative magnets; bags and cases specially adapted for holding or carrying portable telephones and telephone equipment and accessories; bags adapted for laptops.

Class 16 Posters; prints; albums; photographs; printed matter and printed publications; books, song books, magazines, leaflets, brochures, journals and event programmes; flyers; post cards; stationery; pens; stickers; sheet music; photo albums and collectors' albums.

Class 18 Bags; cases; suitcases; travelling bags; backpacks; athletic bags; beach bags; book bags; duffel bags; gym bags; tote bags; shopping bags; leather and imitations of leather, and goods made of these materials (included in Class 18).

Class 20 Picture frames; figurines and ornaments.

Class 21 Cups; mugs; bowls; glassware, porcelain and earthenware (included in Class 21).

Class 25 Clothing; articles of clothing; t-shirts; sweatshirts; sweaters; dresses; footwear; headgear; hats; caps.

Class 41 Live stage shows; presentation of live performances; theatre productions; cinema entertainment; entertainment information; entertainment in the nature of live performances by artists and groups; audio and sound recording and production; record production; videotape production; production and publishing of music; providing online entertainment, namely providing sound and video recordings in the field of entertainment; entertainment services, namely providing online non-downloadable pre-recorded musical sound and video recordings via a global computer network; production of television and radio programs; distribution of television and radio programs for others; production of motion picture films; distribution of motion picture films; television

program syndication; entertainment in the nature of ongoing television programs in the field of music and entertainment; entertainment, namely a continuing entertainment show distributed over television, satellite, audio, and video media; publication of books and magazines; entertainment in the nature of ongoing radio programs; entertainment services, namely, provision of performances, videos, film clips, photographs, and other multimedia materials via a website; entertainment services, namely, providing online reviews of music, musical artists and music videos; entertainment services, namely, providing pre-recorded music, information in the field of music, and commentary and articles about music, all online via a global computer network; entertainment services namely live, televised and movie appearances by a professional entertainer publishing of web magazines; distribution of sound recordings and video recordings; production and distribution of movies, television programmes and audio and/or visual recordings; providing audio and visual images online and via mobile phones; provision of video content to mobile phones; production of television, movie and entertainment services.

COSTS

52. As the applicant has enjoyed the greater degree of success it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. I have made an appropriate reduction for the only partial success. In the circumstances, I award the applicant the sum of **£500**, calculated as follows:

Considering the Notice of opposition and filing a counterstatement	£150
Considering the opponent's evidence	£350
Total	**£500**

53. I therefore order Beeline GmbH to pay EX-Wives Ltd the sum of £500. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 3rd day of October 2023

S WILSON
For the Registrar

ANNEX

Class 9

Apparatus for recording; transmission; reproduction of sound or images; CDs, CD-ROMs, DVDs, DVD-ROMs, floppy disks, USB sticks, records, audio and video discs and cassettes; compact discs; audio cassettes; records; sound and/or video recordings; pre-recorded television programmes; cinematographic films; publications in electronic form; laser discs; CD ROMs; discs containing interactive software; computers and peripheral devices thereto; headphones; headsets for portable media players ; MP3 players and mobile phones; data-processing apparatus; computer software (recorded programs); software downloaded or downloadable via the internet, and via remote communications devices; bags for protecting and transporting computers, computer equipment and portable media players and MP3 players; mobile telephone accessories; portable media players and MP3 players; smart phones (including mobiles with music players); decorative magnets; bags and cases specially adapted for holding or carrying portable telephones and telephone equipment and accessories; bags adapted for laptops.

Class 14

Jewellery; keyrings.

Class 16

Posters; prints; albums; photographs; printed matter and printed publications; books, song books, magazines, leaflets, brochures, journals and event programmes; flyers; post cards; stationery; pens; stickers; sheet music; photo albums and collectors' albums.

Class 18

Bags; cases; suitcases; travelling bags; backpacks; athletic bags; beach bags; book bags; duffel bags; gym bags; tote bags; shopping bags; leather and imitations of leather, and goods made of these materials (included in Class 18).

Class 20

Picture frames; figurines and ornaments.

Class 21

Cups; mugs; bowls; glassware, porcelain and earthenware (included in Class 21).

Class 25

Clothing; articles of clothing; t-shirts; sweatshirts; sweaters; dresses; footwear; headgear; hats; caps.

Class 41

Live stage shows; presentation of live performances; theatre productions; cinema entertainment; entertainment information; entertainment in the nature of live performances by artists and groups; audio and sound recording and production; record production; videotape production; production and publishing of music; providing online entertainment, namely providing sound and video recordings in the field of entertainment; entertainment services, namely providing online non-downloadable pre-recorded musical sound and video recordings via a global computer network; production of television and radio programs; distribution of television and radio programs for others; production of motion picture films; distribution of motion picture films; television program syndication; entertainment in the nature of ongoing television programs in the field of music and entertainment; entertainment, namely a continuing entertainment show distributed over television, satellite, audio, and video media; publication of books and magazines; entertainment in the nature of ongoing radio programs; entertainment services, namely, provision of performances, videos, film clips, photographs, and other multimedia materials via a website; entertainment services, namely, providing online reviews of music, musical artists and music videos; entertainment services, namely, providing pre-recorded music, information in the field of music, and commentary and articles about music, all online via a global computer network; entertainment services namely live, televised and movie appearances by a professional entertainer publishing of web magazines; distribution of sound recordings and video recordings; production and distribution of movies, television programmes and audio and/or visual recordings; providing audio and visual images online and via mobile phones; provision of video content to mobile phones; production of television, movie and entertainment services.