

O-0952-23

TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO. UK00003747662

YORKS

IN THE NAME OF CHEUNG SIU KI HENRY

AND

AN OPPOSITION UNDER NO. 432719

BY RALF HELMUT NUTT

Background and pleadings

1. On 26 January 2022, Cheung Siu Ki Henry (“the applicant”) applied to register the trade mark shown on the cover page of this decision. The application was published for opposition purposes on 25 February 2022 for the following goods:

Class 14 Precious metals and their alloys; jewellery, precious and semi-precious stones; horological and chronometric instruments.

2. The Ralf Helmut Nutt (“the opponent”) filed a notice of opposition on 19 April 2022 on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all the goods in the application. For its claim under section 5(2)(b), the opponent relies upon the following goods covered by the United Kingdom (“UK”) trade mark:

Mark: YORXS

Registration No. 00910306736

Filing date: 30 September 2011

Registration date: 17 February 2012

Goods:

Class 14 Jewellery for personal adornment; Jewellery and Articles of jewellery with precious stones; Jewellery containing gold; Jewellery and Jewellery, pearls, beads; Jewellery for personal wear; Jewellery and Jewellery, Clocks, Wristwatches and Pocket watches; Jewellery of ornamental chains; Articles of jewellery with ornamental stones; Jewellery being articles of precious metals; Jewellery being articles of precious stones; Jewellery incorporating diamonds; Jewellery; Jewellery, precious stones; Necklaces (jewellery); Chains [jewellery, jewellery]; Chains in precious metals (jewellery); Chain mesh in precious metals (jewellery); Crosses (jewellery); Ear jewellery being in the form of jewellery; Personal jewellery; Rings (jewellery); Rings (jewellery) in precious metals; Rings (jewellery); Rings (jewellery); Key rings (trinket or fobs); Key holders of precious metal (jewellery or fobs);

Jewel pendants; Jewellery watches; Jewellery in precious metals; Jewellery; Jewellery of precious metals; Jewellery of precious metals; Articles of jewellery made of precious metal alloys; Articles of jewellery with precious stones; Jewellery in precious metals; Jewellery made from gold; Jewellery of semi-precious stones; Silver jewellery; Sterling silver jewellery; Articles of jewellery with precious stones; Jewellery for wearing on the body; Jewellery; Silver ornaments; Valuable jewellery.

3. Given its filing date, the above mark is an earlier trade mark in accordance with section 6 of the Act.
4. The opponent claims that the marks are similar and the goods are identical or highly similar, with the result that there is a likelihood of confusion.
5. The applicant filed a counterstatement denying the grounds of opposition.
6. The applicant is unrepresented and the opponent is represented by Pinsent Masons LLP. Only the opponent filed evidence. This decision is taken after careful reading of all the papers filed by the parties.
7. Although the UK has left the European Union (“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.

Evidence

8. The opponent’s evidence consists of the witness statement of Mr Ralf Helmut Nutt dated 27 February 2023. Mr Nutt is the opponent in these proceedings and is the owner of the goldsmith’s and jeweller’s shop named Ralf H. Nutt. Mr Nutt’s witness statement was unaccompanied by exhibits.

My approach on proof of use

9. As the opponent's mark has completed its registration process more than 5 years before the application date of the contested mark, it is subject to proof of use provisions contained in section 6A of the Act. The applicant has put the opponent to proof of use of only horological and chronometric instruments covered by its registration. As a result, the opponent cannot rely on those goods until it shows genuine use in respect of those goods. The applicant has not, however, put the opponent to proof of use of its remaining goods namely, precious metals and their alloys; jewellery, precious and semi-precious stones. This means that the opponent can rely on those goods without the need to show genuine use in relation to those goods.

10. In order to succeed a claim based on section 5(2)(b), the opponent's goods must be identical or similar to the applicant's goods. I will, therefore, return to proof of use provisions depending on the outcome of my analysis of identity or similarity between the conflicting goods.

Section 5(2)(b)

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.”

Section 5(2)(b) - Case law

12. The following principles are gleaned from the judgments 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 C3/03, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L.Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles:

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

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

(c) The average consumer normally perceives the 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

13. When making the comparison, all relevant factors relating to the services in the specifications should be taken into account. In *Canon*, the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

“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”.

14. Guidance on this issue has also come from Jacob J. (as he then was) in *British Sugar Plc v James Robertson & Sons Ltd* (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.

15. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“[...] Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks)* (IP TRANSLATOR) [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat

was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. 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 in question”.

16. 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”.

17. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C., sitting as the Appointed Person, noted 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”, whilst on the other hand:

“[...] it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together”.

Class 14

Precious metals and their alloys; Precious and semi-precious stones

18. The above-mentioned terms refer to raw materials that are used to make jewellery, such as articles of precious metals or stones and articles of jewellery made of precious metals, alloys or stones covered by the opponent’s specification, while the opponent’s goods are finished products worn to adorn the body. Their purpose would, therefore, be different. The applicant’s goods are more likely to be purchased by manufacturers rather than the general public, who would be the users of the opponent’s goods. However, precious and semi-precious metals and stones may also be bought as an investment by members of the public. The goods neither compete nor are they complementary. There would, in my view, be some shared trade channels as the respective parties’ goods may be bought from jewellers. Considering all these factors into account, I find that the competing goods are similar to a medium degree.

Jewellery

19. The term jewellery is contained in both specifications. The conflicting goods are identical.

Horological and chronometric instruments

20. Horological and chronometric instruments in the applicant’s specification will include watches. These are different in nature to jewellery in the opponent’s specification but will overlap in users due to both goods being worn (at least

partly) for decorative purposes. There will also be an overlap in trade channels. I consider the conflicting goods to be similar to a medium degree.

21. As mentioned at paragraph 10 of this decision, the applicant has put the opponent to proof of use of horological and chronometric instruments. I have found that horological and chronometric instruments in the applicant's specification are similar to the opponent's jewellery to a medium degree. I have found that the opponent's goods, which are not subject to proof of use provisions, are similar to all of the applicant's goods. Whilst a finding that the goods are identical would put the opponent in a better position, a medium degree of similarity might still be sufficient to conclude that there is a likelihood of confusion. I will therefore consider the opposition based on these goods and return to the proof of use only if it becomes necessary.

Average consumer

22. I will proceed to determine who the average consumer is for the respective parties' goods discussed above.

23. 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".

24. The average consumer of the conflicting goods is a member of the general public and professionals such as jewellers. The goods are likely to be purchased infrequently and might be of significant cost. The goods are more likely to be obtained by self-selection from jewellers, online or catalogue equivalent or gold refiners. Visual considerations are likely to dominate the selection process. However, I do not discount an aural element to the purchase, particularly when advice is sought from a sales representative, or a purchase is made further to a word-of-mouth recommendation. When making a purchase, factors such as the quality and value of metals and stones and the aesthetic appearance of the goods will be taken into account. These factors suggest that the average consumer will pay a medium level of attention when making their selection and professional users will pay a high degree of attention.

Comparison of marks

25. 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 marks must be assessed by reference to the overall impressions created by the 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.”

26. It would be wrong, therefore, artificially to 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.

Earlier mark	Contested mark
YORXS	YORKS

27. The earlier mark consists of the word YORXS. The overall impression of the mark lies in that word.

28. The contested mark consists of the word YORKS. The overall impression of the mark lies in that word.

29. Visually, both marks consist of 5 letters and share the first 3 and last letter. The only difference between the marks is introduced by letters 'X' and 'K', both in the 4th position from the left. Considering these factors, I find that the marks are visually similar to a high degree.

30. In an aural comparison, the opponent submits that the marks are aurally identical as the letters 'X' and 'K' are pronounced identically when pronouncing the respective marks as a whole.¹ I agree. Although 'X' and 'K' are pronounced differently as individual letters, they do not introduce a different pronunciation in the words YORXS and YORKS. Both marks sound like the word 'yawks'. I consider that the marks are aurally identical.

31. In a conceptual comparison, the opponent argues that its mark does not have a meaning while the applicant's mark would be understood as an abbreviation to 'Yorkshire' or referring to 'Yorkshire'.² While I think the word Yorks alludes to Yorkshire, a city in northern England, I have already agreed with the opponent's submission that the conflicting marks are pronounced identically. When aurally referring to the opponent's mark, which is also pronounced as 'Yorks', both marks would convey an identical meaning to consumers. On that basis, I find that the marks are conceptually identical.

¹ Statement of grounds, paragraph 9.

² Statement of grounds, paragraph 10.

Distinctive character of earlier mark

32. The distinctive character of the earlier mark must be considered. The more distinctive the mark is, either inherently or through use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). 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 I-0000, 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 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).”

33. Invented words usually have the highest degree of distinctive character, while words which are allusive of the goods have the lowest. Distinctiveness can also be enhanced through the use of the mark.

34. The opponent’s mark consists of the word YORXS. Although the opponent has filed evidence of use, it has not claimed an enhanced distinctive character of its

mark. The opponent submits that its mark has a normal degree of distinctiveness.³ So, I only have the inherent position to consider. I have already concluded that the mark is given an identical pronunciation as the word ‘Yorks’, which is allusive of Yorkshire. However, it does not appear, nor is there evidence, that Yorkshire has a geographic connotation in relation to the opponent’s goods. I, therefore, find that the mark possesses a medium/normal degree of inherent distinctive character.

Likelihood of confusion

35. In determining whether there is a likelihood of confusion, I need to bear in mind several factors. 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 trade marks and vice versa (*Canon* at [17]). It is also necessary for me to bear in mind the distinctive character of the opponent’s trade mark, as the more distinctive the trade mark is, the greater the likelihood of confusion (*Sabel* at [24]). I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks, relying instead upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

36. Confusion can be direct (which occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods/services down to the responsible undertaking being the same or related).

37. Earlier in the decision, I have found the respective marks to be visually similar to a high degree and aurally identical. I also found that the marks are conceptually identical. The goods will be selected primarily by visual means, with a medium degree of attention by the general public and high degree of

³ Statement of grounds, dated 19 April 2022, paragraph 13

attention by professionals. The goods are either identical or similar to a medium degree. I also concluded that the inherent distinctiveness of the earlier mark is medium.

38. I have already found that a proportion of average consumers are likely to purchase the goods further to word-of-mouth recommendations. In those circumstances, the aural identity between the marks is likely to lead those average consumers to think that it is the same undertaking that offers identical or similar goods. I, therefore, find that there is a likelihood of direct confusion when marks are referred to aurally.

39. Where visual considerations are likely to dominate the selection process, I find that there is also a likelihood of direct confusion. The visual difference of one letter between the marks is likely to be misremembered by the average consumer who pays a medium degree of attention to the selection process. The confusion is still likely even where a high degree of attention is paid. The visual similarity between the marks together with the aural and conceptual identity is likely to lead the average consumer to mistake one mark for the other.

Conclusion

40. The opposition has been successful.

The application is refused in respect all the goods, namely,

Class 14: Precious metals and their alloys; jewellery, precious and semi-precious stones; horological and chronometric instruments.

Costs

41. The opponent has been successful than the applicant and is entitled to a contribution towards its costs. Awards of costs are governed by Tribunal Practice Notice (“TPN”) 2/2016. While awarding costs I bear in mind that the opponent’s evidence was light and did not contain any exhibits. I award costs to the opponent on the following basis:

Official fee	£100
Preparing a statement of case and Considering other side's statement:	£200
Filing evidence:	£200
Total:	£500

42. I order cheung siu ki henry to pay Ralf Helmut Nutt the sum of £500. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 5th day of October 2023

**Karol Thomas
For the Registrar
The Comptroller-General**