

O-115-13

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2609222 IN THE NAME OF
MOIRA C & COUNTRYWIDE SECURITIES LTD**

AND

**OPPOSITION THERETO UNDER NO 103429
BY WIBANI INTERNATIONAL B.V.**

Background

1. Application No 2609222 has a filing date of 3 February 2012 and stands in the name of Moira C & Countrywide Securities Ltd (“the applicant”). The application seeks registration of the mark CHICHI’s in respect of *Clothing, footwear and headgear*.

2. Following publication of the application in the *Trade Marks Journal* on 16 March 2012, a notice of opposition was filed by Wibani International B.V. (“the opponent”). There is a single ground of opposition based on grounds under section 5(2)(b) of the Act. In support of its opposition, the opponent relies on the following Community trade mark (“CTM”) insofar as it is registered for the following goods:

No	Mark	Application/Registration dates	Goods relied upon
CTM 9215948	ChiQi	1 July 2010/13 December 2010	Clothing, footwear, headgear

3. The applicant filed a counterstatement in which it denies the claims made. Both parties filed witness statements. Neither party sought to be heard. I have considered all of the material before me in reaching my decision.

4. As much of the “evidence” filed by the parties consists of submissions rather than evidence of fact, I do not summarise it here but will refer to it as appropriate in this decision.

Decision

5. The single ground of opposition is brought under section 5(2)(b) of the Act which reads:

“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.”

6. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

- (a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark

in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(b)

(c)

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

7. The opponent relies on its CTM 9215948. This is an earlier mark within the meaning of the provisions of section 6 of the Act. As it had not been registered for five years at the date of publication of the application, the earlier mark is not subject to the provisions of section 6A of the Act: the opponent is not required to prove use of its earlier mark.

8. In determining the question under Section 5(2)(b), I take into account the guidance provided by the Court of Justice of the European Union (CJEU) in *Sabel v Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R 77, *Marca Mode CV v Adidas AG* [2000] E.T.M.R.723, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di Laudato & C. Sas v OHIM* C-334/05 (Limoncello), as cited with approval in *Och-Ziff Management Europe Ltd and Oz Management LP v Och Capital LLP, Union Investment Management Ltd and Ochoki* [2010] EWCH 2599 (Ch). It is clear from these cases that:

- (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, in certain circumstances, be dominated by one or more of its components;
- (f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks causes the public to 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

9. As each of the respective specifications are identically worded, there can be no dispute that the respective goods are identical.

The average consumer and the nature of the purchasing process

10. 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 these goods are likely to be selected by the average consumer in the course of trade.

11. Clothing, footwear and headgear are worn by the population at large and thus the general public is the average consumer for these goods. They are goods that are widely available, both from clothing stores and from supermarkets or department stores. As to the manner in which the goods are likely to be selected by the average consumer, this is most likely to consist of a visual act made on the basis of self selection in either a retail environment, from a catalogue or on-line (see for example the comments of the Appointed Person in *React Trade Mark* [2000] RPC 285).

12. In *New Look Ltd v Office for the Harmonization in the Internal Market* (Trade Marks and Designs) Joined cases T-117/03 to T-119/03 and T-171/03, the General

Court considered the level of attention taken when purchasing goods in the clothing sector:

“43 It should be noted in this regard that the average consumer’s level of attention may vary according to the category of goods or services in question (see, by analogy, Case C-342/97 Lloyd Schuhfabrik Meyer [1999] ECR I-3819, paragraph 26). As OHIM rightly pointed out, an applicant cannot simply assert that in a particular sector the consumer is particularly attentive to trade marks without supporting that claim with facts or evidence. As regards the clothing sector, the Court finds that it comprises goods which vary widely in quality and price. Whilst it is possible that the consumer is more attentive to the choice of mark where he or she buys a particularly expensive item of clothing, such an approach on the part of the consumer cannot be presumed without evidence with regard to all goods in that sector. It follows that that argument must be rejected.”

13. As the *New Look* case acknowledges, the cost of clothing can vary considerably, however, I must keep in mind goods across the whole price spectrum. While the average consumer’s level of attention is also likely to vary considerably, given the cost and nature of the particular item being bought, I consider that, even when selecting routine items, the average consumer is likely to be conscious of factors such as the size, colour, material and price of the article concerned and its suitability for purpose and ease of being laundered. The same types of consideration will apply to the purchase of footwear and headgear. Overall, I think the average consumer is likely to pay at least a reasonable degree of attention to the selection of all of the goods at issue.

Comparison of marks

14. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as wholes and does not pause to analyse their various details. In addition, the average consumer rarely has the chance to make direct comparisons between trade marks but must, instead, rely on the imperfect picture of them he may have kept in mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant elements of the respective trade marks and, with that conclusion in mind, I must go on to compare the respective trade marks from the visual, aural and conceptual perspectives.

15. For ease of reference, the marks to be compared are as follows:

Earlier mark	Application
ChiQi	CHICHI'S

16. As each of the respective marks are presented as single words, neither has any dominant elements: their distinctiveness rests in the marks as wholes.

17. The earlier mark consists of the letters ChiQi, presented as a word and with the letters C and Q capitalised. The marks applied for consists of the word CHICHI as if in possessive form i.e. followed by an apostrophe and final letter s. Both marks begin

with the same three letters CHI and, to this extent, there is a degree of visual similarity between them. The endings of each mark differ greatly: the earlier mark ending in the unusual combination of letters Qi with the letter Q capitalised which is itself unusual for a letter within a word and visually striking, whereas the application repeats the first 3 letters and adds the apostrophe and letter s. When considered as wholes, the respective marks are visually similar to a very low degree.

18. In his witness statement, Mr Matthew Gardner, a trade mark agent in the employ of Trade Marks Bureau, the applicant's legal representatives in these proceedings, states that the earlier mark:

"...is likely to be seen and pronounced as CHEEKY. The traditional use of the letter Q is usually preceded by the letter U but when not the letter Q is usually pronounced as a hard K as in Iraq, Qwerty, Qatar. The mark ChiQi is most likely to be seen as a fanciful alternative to the word CHEEKY and it is likely to be pronounced as CHEEKY by the relevant English speaking consumer in the United Kingdom".

In contrast, he states that the mark of the application:

"will be pronounced as "chee-chee" or "shee-shee".

19. On behalf of the opponent, Grazyna K Poplawska, a trade mark attorney in the employ of Stevens Hewlett & Perkins, rejects Mr Gardner's submissions. She submits:

"in the English language it is common for the pronunciation [of] a letter to change depending on the letters that follow it in the word."

She goes on to submit:

"The English public is familiar with the word "Qi", which is a well-known concept of Chinese culture. The word "Qi" is pronounced as "CHI" in English. For this reason, the English speaking UK consumer will most likely pronounce the earlier mark "ChiQi" as "CHICHI" by reference to the pronunciation of the existing word "Qi" rather than by reference to the pronunciation of words that do not contain the combinations "qi". ...For the same reasons, it is unlikely that the English speaking consumer will pronounce the earlier mark as "CHEEKY".

20. At GKP 02, Ms Poplawska exhibits an extract from the Wikipedia.org website and comments that it states:

"qi is also spelt as "chi" or "ch'i" and that: "Qi is pronounced as /'tʃi/ in English (...). The approximate English pronunciation of qi [is] similar to "chee" in cheese (...)."

21. Qi might, as Ms Poplawska submits, be a concept of Chinese culture, however, I am not prepared to accept, absent evidence, that the average consumer for the goods at issue in these proceedings will be familiar with such aspects of that culture (see the comments of Ms Anna Carboni sitting as an appointed person in *Chorkee*

O-048-08). Whilst I accept that some people who may be familiar with it, may pronounce the letters Qi in the way the extract suggests, others may, given for example the existence of the popular television programme QI, pronounce it as separate letters. The matter is, however, somewhat academic as the mark before me is not Qi but ChiQi. This presents as an unusual combination of letters to the English speaker and the different spellings of each syllable making up the mark is likely to encourage the average consumer to pronounce each syllable differently. In my view, the earlier mark may be pronounced variously by the average consumer as “chee-key” or “chee-kwee”. In contrast, the word chichi is a dictionary word in common usage and the mark of the application is likely to be pronounced “she- shees”.

22. I am not aware that the earlier mark is anything other than an invented word. It does not resemble any word that I am aware of in the English language and is unlikely to bring any particular image to mind. The word chichi is, as indicated above, an ordinary dictionary word well known as meaning trendy, chic, stylish or flashy and this is the image that will be brought to mind even with though the mark appears in the grammatically incorrect possessive form. The respective marks are conceptually distinct.

The distinctive character of the earlier mark

23. The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which it has been acquired and, secondly, by reference to the way it is perceived by the relevant public (see *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods and services for which it has been registered as coming from a particular undertaking and thus to distinguish those goods and services from those of other undertakings (see *Windsurfing Chiemsee v Huber and Attenburger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585).

24. No evidence of any use of the earlier mark has been filed and therefore I have only the mark’s inherent distinctive character to consider. As an invented word, it is a mark with a relatively high degree of inherent distinctive character.

Likelihood of confusion

25. In determining whether there is a likelihood of confusion, a number of factors have to be borne in mind. The first is the interdependency principle whereby 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. I also have to factor in the distinctive character of the earlier mark as the more distinctive it is, the greater the likelihood of confusion. 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 and must instead rely on the imperfect picture of them he has retained in mind.

26. Earlier in this decision, I found:

- the respective marks to be visually similar to a very low degree, aurally similar to a low degree and to be conceptually distinct;
- that the earlier mark has a relatively high degree of inherent distinctive character which has not been enhanced through use;
- that the respective goods are identical;
- that the average consumer will take at least a reasonable degree of care in the purchasing process;
- that the purchasing process is primarily a visual one.

27. Taking all matters into account, I consider that the differences between the marks are such that there is no likelihood of confusion either direct (where one mark is mistaken for the other) or indirect (where one mark is considered to be from the same or an economically linked undertaking) even where identical goods are concerned. The objection based on section 5(2)(b) of the Act fails.

Costs

28. The opposition having failed, the applicant is entitled to an award of costs in its favour. In making the award, I take into account that the “evidence” filed consisted mainly of submissions and that no hearing took place. I make the award on the following basis:

For filing a counterstatement and reviewing the notice of opposition:	£300
Filing/ reviewing evidence/submissions:	£500
Total:	£800

29. I order Wibani International B.V. to pay Moira C & Countrywide Securities Ltd the sum of £800. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 13th day of March 2013

**Ann Corbett
For the Registrar
The Comptroller-General**