

BL O/1212/23

TRADE MARKS ACT 1994

IN THE MATTER OF
TRADE MARK APPLICATION
NO. UK00003610875 GEORGINE IN CLASSES 14, 18 & 25
IN THE NAME OF GEORGINE RATELBAND (“APPLICANT/RESPONDENT”)

AND OPPOSITION NO. OP000426414
BY WALMART APOLLO, LLC (“OPPONENT/APPELLANT”)

AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF
MS. BEVERLEY HEDLEY (O/0352/23) DATED 11TH APRIL 2023

MR. DANIEL BAILEY of Appleyard Lees IP LLP appeared on
behalf of Walmart Apollo, LLC.
GEORGINE RATELBAND did not appear and was not represented.
Hearing date: 3rd August 2023.

Introduction

1. This is an appeal by Walmart Apollo, LLC (“the Opponent”) against decision BL O/352/23 of Ms Beverley Hedley, sitting as a Hearing Officer on behalf of the Registrar of Trade Marks, dated 11 April 2023.
2. The Applicant’s application No. UK00003610875 GEORGINE (“the Contested Mark”) was filed on 16 March 2021 with a priority date of 2 January 2016 for the following specification:

Class 14: Jewellery, all aforementioned goods being high-end luxury goods.
Class 18: Luggage, bags, wallets and other carriers; all aforementioned goods being high-end luxury goods.
Class 25: Clothing; Footwear; Headgear; Hats; all aforementioned goods being high-end luxury goods.
3. The applications were opposed by the Opponent based on sections 5(2)(b), 5(3) and 5 (4) (a) of the Trade Marks Act 1994 (“the Act”).

4. These sections provide as follows:

S.5 (2) (b)

5 Relative grounds for refusal of registration.

...

(2) A trade mark shall not be registered if because...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier 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

...

(3) A trade mark which-

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

(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) [.....]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.

5. The Opponent relied on the following Earlier Trade Marks:

(i) UKTM no. UKTM 901282557 (“557”) GEORGE

Filing date: 18 August 1999

Date of entry in register: 04 January 2012

This registration covers a range of goods in classes 3, 9, 18, 21, 24, 25 & 26 but was referred to as relevant only for the identical goods:

Class 18: Leather and imitations of leather, and goods made of these materials; ... trunks and travelling bags; ...pocket wallets;...

Class 25: Clothing, footwear, headgear....

(ii) UKTM 2113516 (“516”) GEORGE

Filing date: 22 October 1996

Date of entry in register: 21 April 2000

This registration covers a range of goods in classes 14, 18 & 25 but in the event was relevant for the identical goods:

Class 14: Jewellery.

(iii) UKTM 2343417D (“ ‘417D”)

GEORGE

Filing date: 16 September 2003

Date of entry in register: 02 May 2008

This registration covers a range of retail and mail order services in class 35, but the Hearing Officer did not consider it added to the Opponent’s case, given the identity of goods.

The specifications are reproduced in full in the Annex.

6. Two of the Earlier Trade Marks relied on (‘516 and ‘417D) had completed the registration process more than 5 years before the priority date of the Contested Mark and the Applicant exercised its option to require the Opponent to prove that those Earlier Trade Marks had been put to genuine use.
7. The opposition under S. 5 (4) (a) relied on the use of GEORGE for various goods from 1990.
8. Only the Opponent filed evidence. Neither party requested to be heard on the matter at first instance, but the Opponent filed submissions in lieu of a hearing.
9. After considering the papers the Hearing Officer dismissed the Opposition in full.
10. On 9 May 2023 the Opponent filed a Notice to Appeal to the Appointed Person against the Decision under Section 76 of the Trade Marks Act 1994.
11. No Respondent’s Notice was filed.

The Hearing Officer’s Decision

12. In summary, the Hearing Officer decided as follows:
 - a) Genuine use only needed to be determined for ‘516 in class 14 and in that regard, the fair specification was ‘Jewellery’.
 - b) Under S. 5 (2) (b)
 - i) The goods of the Contested Mark were either identical or highly similar to the goods of ‘557/’516.
 - ii) The average consumer was the general public, purchasing mostly by visual reference (without ruling out aural interaction), showing a medium degree of attention.
 - iii) The mark GEORGE had normal inherent distinctiveness.

- iv) The distinctiveness of GEORGE had had been enhanced to a high degree in relation to ‘clothing, footwear and headgear’ at the relevant date, but not for other goods in classes 14 and 18.
 - v) GEORGE and GEORGINE were visually highly similar.
 - vi) Phonetically there was a medium degree of aural similarity.
 - vii) Conceptually, the marks were different.
 - viii) Given the conceptual difference, there was no likelihood of direct or indirect confusion.
 - ix) The S. 5 (2) (b) opposition failed.
- c) Under S. 5 (3):
- i) The respective marks were visually similar to a high degree, aurally similar to a medium degree and conceptually different.
 - ii) The goods ranged from identical, to low, to no similarity ;
 - iii) GEORGE had a strong reputation at the relevant date in relation to “clothing, footwear and headgear”.
 - iv) The conceptual difference in the marks negated or reduced to “fleeting” any link between the marks.
 - v) The S. 5 (3) opposition therefore failed.
- d) Under S. 5 (4) (a):
- i) The opponent had the requisite goodwill in the UK at the relevant date in relation to a business selling clothing, footwear, headgear, jewellery and certain bags and purses and that GEORGE was distinctive of that goodwill.
 - ii) It was unlikely that a substantial number of the opponent’s customers would be misled into purchasing any of the applicant’s goods in the belief that they are those of the opponent, “for essentially the same reasons that I set out when considering the likelihood of confusion under section 5(2)(b)”.
 - iii) This ground of opposition also failed.
- e) As the unsuccessful party, the Opponent was ordered to pay costs of £300.

Grounds of Appeal

13. The basis of the Appeal was essentially that the Hearing Officer was “materially wrong” in the assessment of the conceptual comparison or the parties’ marks and that if the Hearing Officer had properly assessed the conceptual similarity of the marks, taken with her other findings the Opposition would have succeeded in full under all of the Grounds.

14. None of the other findings of the Hearing Officer as to the similarity of marks/goods, average consumer, the distinctiveness of the earlier mark, reputation, etc were challenged.

Standard of Review

15. The appropriate standard is well established. An appeal is by way of review, not re-hearing. Numerous cases set out the standard and authorities in equally numerous and occasionally nuanced ways. The judgment of Joanna Smith J. in *Axogen Corporation v Aviv Scientific Limited* [2022] EWHC 95 (Ch) at [24] is an appropriate summation:

"24. Although I was referred to numerous cases on the subject the approach of the appeal court to a statutory appeal under section 76(1) of the TMA is uncontroversial. I bear the following principles, relevant to the issues before me, firmly in mind:

i) The appeal is by way of a review, not a rehearing;

ii) The appeal court will allow an appeal where the decision of the lower court was "wrong" (see CPR 52.11). Neither surprise at a Hearing Officer's conclusion, nor a belief that he or she has reached the wrong decision suffices to justify interference;

iii) The decision of the lower court will be "wrong" if the judge makes an error of law, which might involve asking the wrong question, failing to take account of relevant matters or taking into account irrelevant matters. Absent an error of law, the appellate court would be justified in concluding that the decision of the lower court was wrong if the judge's conclusion was "outside the bounds within which reasonable disagreement is possible";

iv) The approach required by the appeal court depends on a number of variables including the nature of the evaluation in question. There is a "spectrum of appropriate respect for the Registrar's determination depending on the nature of the decision", with decisions of primary fact at one end of the spectrum and multi-factorial decisions (of the type which the parties agree were made in this case by the Hearing Officer) being further along the spectrum.

v) In the case of a multifactorial assessment or evaluation, involving the weighing of different factors against each other, the appeal court should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions.

vi) An error of principle is not confined to an error as to the law but extends to certain types of error in the application of a legal standard to the facts in an evaluation of those facts. The evaluative process is often a matter of degree upon which different judges can legitimately differ and an appellate court ought not to interfere unless it is satisfied that the judge's conclusion is outside the bounds within which reasonable disagreement is possible;

vii) Another variable to be taken into account will be "the standing and experience of the fact-finding judge or tribunal". Expert tribunals are charged with applying the law in the specialised fields and their decisions should be respected unless it is quite clear that they have misdirected themselves in law. Appellate courts should not rush to find such misdirections simply because they might have reached a different conclusion on the facts.

viii) The appellate court should not treat a judgment as containing an error of principle simply because of its belief that the judgment or decision could have been better expressed; "The duty to give reasons must not be turned into an intolerable burden". The reasons need not be elaborate. There is no duty on a judge, in giving her reasons, to deal with every argument presented by counsel in support of his case. It is sufficient if what she says shows the basis on which she has acted. The issues the resolution of which were vital to the judge's conclusions should be identified and the manner in which she resolved them explained.

ix) In evaluating the evidence, the appellate court is entitled to assume, absent good reason to the contrary, that the first instance judge has taken all of the evidence into account".

16. I keep these principles in mind.

Merits

17. Central to the Hearing Officer's decision was her finding that GEORGE and GEORGINE were conceptually different. The Opponent says this finding was "materially wrong". The word "materially" adds nothing of substance to the appeal. The issue for me to determine is whether the Hearing Officer was "wrong" in an appellate sense.

18. As noted above, the decision below will be "wrong" if the Hearing Officer makes an error of law, which might involve failing to give reasons, a gap in logic, asking the wrong question, failing to take account of relevant matters, or taking into account irrelevant matters. Absent an error of law, I would be justified in concluding that the decision below was wrong if the Hearing Officer's conclusion was "outside the bounds within which reasonable disagreement is possible".

19. In its written submissions to the Hearing Officer on S. 5 (2) (b) the Opponent argued:

"Conceptually, the two marks under consideration relate to the substantially identical name of Greek origin, as shown below.

George

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Gender

Meaning

Boy
From the Greek name Georgios. from georgos, meaning
"farmer, earthworker", which is from ge, meaning "earth" and
ergon, meaning "work".

Pronounced: jaw r j

ThinkBaby Names thinking of names? oAn •Name

What does Georgine mean?

Georgine '44 as a girls' name is of Greek derivation, and the meaning
of the name Georgine is "farmer". Georgine is a version of [Georgii!](#)

(Greek): Latinate feminine variant

of [g](#) - Georgine is also a variation of [Georgina](#) (Greek).

STARTS WITH .G..e.:_

ASSOCIATED WITH gre_e,k

24. The Earlier Mark, GEORGE, is a name of Greek origin and means "farmer". The Opposed Mark, Georgine, is the feminine variant of GEORGE, which also means "farmer".

25. The Opposed Mark is simply the feminine variant of the Earlier Mark, and this would be readily understood by English speaking consumers."

4

20. Thus the Opponent squarely laid out its arguments that the two marks were simply male/female variants of the same name. The same point was essentially taken for the other opposition grounds.

21. The Hearing Officer dealt with the conceptual comparison of the parties' marks under S. 5 (2) (b) at [38]:

"38) The opponent's mark is likely to be perceived as a well-known forename (most likely a male one). The applicant's mark is also likely to be perceived as a forename (most likely a female one). Whilst the names may share a common origin, as submitted by the opponent (fn7), the average consumer will nevertheless recognise that they are different names, referring to different individuals. I therefore do not agree with the opponent that the marks are conceptually identical or at least highly similar. I find that the marks are conceptually different (fn8) .

(fn 7 See the opponent's submissions in lieu, paragraphs 23- 24)

*(fn 8 In this connection, I note the decision of Daniel Alexander QC (as he then was) in BL O-040-20, (paragraph 49) in an appeal against an earlier decision of mine (in BL O-344/19). Whilst the marks at issue in that case were not the same as here, **it seems to me that the same reasoning is applicable in the instant case.**”(emphasis added)*

22. I note the Hearing Officer does appear to acknowledge, in *fn7* the Opponent’s submission that the marks may have a “common origin” and that the marks are likely to be seen as male/female forenames. However, as Mr Bailey submitted, there is no express acknowledgement of the Opponent’s additional point that GEORGE/GEORGINE may be, conceptually, male/female variants of the same name.

23. The paragraph in BL O/040/20 (ZOHARA) to which the Hearing Officer referred reads as follows:

*“49. It was agreed before the hearing officer that the marks would each be perceived as female names, a concession in the appellant’s favour - although I am not convinced that ZOHARA would be immediately recognized as such by all likely consumers. It is therefore said that the hearing officer should have attributed greater conceptual similarity to the marks than she did. **She held, in essence, that they would be recognized as being different names and were therefore conceptually different. I agree. If the names are recognized as female first names, I think the average consumer would recognize that they were different names.** If they were not both recognised to be female first names, their conceptual difference would be greater. So on either basis, although there were similarities, this is a case in which the differences as to concept dominate such similarity as there is (emphasis added).*

24. On appeal, Mr Bailey for the Opponent submitted that the Hearing Officer’s analysis was materially incorrect because notwithstanding ZOHARA, it does not automatically follow that two names are conceptually different based solely on the fact that consumers perceive them as different names. Instead there could be conceptual similarity when the marks were perceived as different versions of the same name, even where the names indicated different individuals.

25. Mr Bailey referred me to a number of prior decisions by way of example/comparison, including:

- a) Case O-276-18 SANDRO in which Ms Emma Himsworth KC, sitting as the Appointed Person said at [34] *...In fact, it seems to me that members of the public could regard SANDRA and SANDRO as different versions of the same name or names derived from the same root such that it would have been open to the Hearing Officer to find that the marks were conceptually similar.*

b) General Court Case T-204/14 *VICTOR/VICTORIA*, in which the court said:

“[131]... The fact that the earlier mark may also convey other concepts, as the applicant claims, cannot remove the conceptual similarity of the marks at issue, at least for the part of the relevant public that will understand those marks as being the male and female versions of the same forename.

26. Mr Bailey also referred me to EUIPO Opposition Decision No B 2 685 140 between the parties to these proceedings and concerning, in essence the same subject matter, in which it was held:

The Opposition Division considers that a low degree of conceptual similarity can be established given that both signs refer to the first names deriving from the same root and having the same origin, but in its female and male form.

27. Of course that Decision is not binding on me, not least because the determination was one of fact, not law, but it does serve to illustrate a gap in the Hearing Officer’s logic, namely if there is a common origin/root distinguished only by conventions of gender stylisation, how does it follow that there is no conceptual similarity?

28. As I read the Hearing Officer’s decision, she may have taken as a principle (from *ZOHARA*) that names which can be seen to be different *per se* are inevitably conceptually different.

29. Alternatively, the Hearing Officer may have identified *ZOHARA* as being factually “on all fours” with the instant case.

30. In my view, neither approach is correct.

31. As I understand *ZOHARA* the *only* argument for conceptual similarity was that both marks would be perceived as female forenames, without any additional submission that they were equivalent, variants, shared a root or were similar in any other way. As Ms Himsworth noted in *SANDRO* at [28] “...the mere fact that the marks the subject of the comparison can be grouped under a common generic term of ‘names’ does not automatically lead to a finding of conceptual similarity”. That being the case, *ZOHARA* is entirely understandable – the fact both terms were female forenames was not, of itself enough. But that was as far as it went. There was no other point of conceptual similarity to consider.

32. However, it is also the case that the mere fact names exhibit structural differences, or identify different individuals, does not automatically lead to a finding of conceptual dissimilarity. Names can be conceptually similar even if they refer to different individuals and, to quote Ms Himsworth again

at [30] *“It is therefore necessary to make an assessment of conceptual similarity between names on the basis of each individual case.”*

33. I have no doubt that at a general level, when applied to individuals GEORGE and GEORGINE are “different” names. At the very least, one is likely to signify a male, the other a female, absent any other context. The very purpose of names is to differentiate between individuals, and consumers real and notional are adept at spotting these differentiations. Indeed, even if they are confronted with identical forenames, consumers do not automatically assume that all bearers of such names are one and the same person. At another level, however, they do recognise that many different people have names which are nevertheless conceptually the same or similar. To quote Ms Himsworth again at [28] in *SANDRO*:

“This is well illustrated by the examples given in Part C, Section 2, Chapter 4 Comparison of Signs of the Guidelines for Examination of European Trade Marks issued by the EUIPO on 1 October 2017 where the names FRANK and MIKE are identified as being names which would not lead to a finding of conceptual similarity because the public is not likely to make a conceptual link between the two words; whereas the contrary is the case where the names in issue are FRANK and FRANKIE one being a different version of the other such that public is likely to make a conceptual link. (emphasis added).”

34. Thus, consumers do notice common or similar concepts in names, themes, or roots and these might influence them in the context of the names’ use as trade marks for goods and services even if, when encountering them as personal names, they apply them to different people.
35. What the Hearing Officer should have done, was to consider whether the male/female equivalence of the signs had any bearing on the conceptual comparison.
36. It is not clear from the Decision that this was taken in to account at all. If it was, there is no reasoning to explain why it was discounted, beyond the reference to *ZOHARA*. In my judgment, if *ZOHARA* was relied on as authority for a principle that the ability of names to denote different individuals led inexorably to a finding of conceptual dissimilarity, that was erroneous.
37. Alternatively, if and insofar as the Hearing Officer thought the facts and reasoning of *ZOHARA* were on “all fours”, this too was erroneous, because here there was an additional common theme or equivalence which was not present in *ZOHARA* .
38. Furthermore, in my judgment the Decision as to the conceptual comparison was wrong in the sense that it is beyond the bounds of reasonable disagreement. The marks are self-evidently conceptually similar to at least a low degree by reason of their male/female equivalence. I consider the similarity

to be low because relatively small differences in otherwise commonly rooted forenames names are usually sufficient to dilute that similarity, but conceptual similarity is still clearly present.

39. The Appeal therefore succeeds to this extent.

Disposal

40. The appeal having succeeded, it falls to me to determine whether to decide the matter or to remit it to the Registrar. Mr Bailey urged the former course of action on me. As for the Applicant, they have taken no part in the proceedings (beyond their counterstatement) so I take it they are content for matters to take their course.

41. The Hearing Officer limited herself to the apparent conflict between classes 14, 18 and 25, and did not make any assessment as regards other classes relied on – in particular class 35 – by the Opponent.

42. Nevertheless since Mr Bailey was content, on the Opponent's behalf, for me to determine the matter myself (despite the finality of this Appeal) I shall do so, limiting myself to the three classes concerned (14, 18 and 25). I do not think, in any event, that the Opponent would have been in any better position for those other classes.

S. 5 (2) (b)

43. I adopt the Hearing Officer's findings that:

- a) The goods are identical.
- b) The marks are visually similar to a high degree.
- c) The marks are phonetically similar to a medium degree.
- d) The average consumer is a member of the general public paying a medium degree of attention during a purchase, which could be by visual or aural means.
- e) GEORGE is of ordinary inherent distinctive character.
- f) GEORGE 's distinctive character had been enhanced to a high degree in relation to 'clothing, footwear and headgear' at the relevant date.

44. As to the conceptual comparison, I reiterate that I consider the marks are conceptually similar to a low degree.

45. Drawing all these threads together, I find that:

- a) There is no likelihood of direct confusion. The average consumer will not mistake GEORGE for GEORGINE for any goods, even allowing for imperfect recollection. This is so even allowing for the enhanced distinctive character of GEORGE for 'clothing, footwear and headgear'.

- b) As for indirect confusion, I remind myself that in *L A SUGAR* (BL O/375/10) Mr Iain Purvis KC described the general thought process of the average consumer thus:

“The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark”

and that whilst he set out some examples, these were not exhaustive.

- c) I find that a significant number of average consumers may conclude that GEORGINE is another or variant brand of the Opponent, most likely perceiving it as indicative of a female variant or aimed at female consumers. Therefore, there is a likelihood of indirect confusion.

46. The opposition under S. 5 (2) (b) succeeds.

S. 5 (3)

47. I adopt the Hearing Officer’s findings that;

- a) the Earlier Marks have a “strong” reputation for “clothing footwear, headgear” only.
- b) whilst the Applicant’s class 25 goods are similar, their class 14 and 18 goods are dissimilar to those for which the Opponent has a reputation. Although Mr Bailey made arguments to the effect that the Opponent’s reputation extended to such goods, the Hearing Officer’s findings were not challenged by way of appeal so I take those submissions no further..

48. Given my finding of a likelihood of confusion the necessary link is made out.

49. Taking class 25 first, given the Hearing Officer’s finding on reputation and my finding on the link, in my view the use of GEORGINE in relation to the contested goods in class 25 would give rise to an unfair advantage by transferring the benefit of that reputation to the Applicant’s goods, without the benefit of any form of compensation for the Opponent’s investment in the GEORGE trade mark. Further, I consider that for those goods the use of GEORGINE would tend to erode the distinctive character of GEORGE.

50. No “due cause” is put forward by the Applicant.

51. Therefore, I find that the use of GEORGINE in relation to Clothing; Footwear; Headgear; Hats; all aforementioned goods being high-end luxury goods” would, without due cause, take unfair advantage of

the reputation of GEORGE for “clothing footwear, headgear” and would be detrimental to the distinctive character or the repute of the earlier trade marks by way of blurring or dilution.

52. However, there is nothing to suggest detriment by “tarnishing” would occur.

53. Turning now to goods in classes 14 and 18, the Hearing Officer’s finding that these were dissimilar to the Opponent’s class 25 goods having a reputation was not appealed, so I adopt that finding.

54. Notwithstanding the presence of a link, if GEORGINE is likely to call the name GEORGE to mind, I concur with the Hearing Officer that it would be so weak/fleeting as to be incapable of giving rise to any of the heads of damage for such goods.

55. The outcome is that the S. 5 (3) ground succeeds for “Clothing; Footwear; Headgear; Hats; all aforementioned goods being high-end luxury goods” only.

S. 5 (4) (a)

56. The Hearing Officer (at [47]) accepted that the opponent had the requisite goodwill in the UK at the relevant date in relation to a business selling clothing, footwear, headgear, jewellery and certain bags and purses and that GEORGE was distinctive of that goodwill. As the Hearing Officer acknowledged, in practical terms the tests for S. 2 (b) and S 5 (4) (a) are the same. That being the case, applying my findings under S. 5 (2) (b) I find the S. 5 (4) (a) ground of opposition succeeds.

Conclusion

57. The Appeal has been successful. The Contested Mark is refused in full.

Costs

58. The Opponent has been successful and is entitled to its costs.

59. Below, the Hearing Officer awarded the Applicant £300. The Opposition having succeeded, that order is set aside.

60. As regards the Opposition and the Appeal, I award the Opponent at total of £3000, that sum to be paid by the Applicant to the Opponent within 21 days of the date of this Decision.

Philip Harris

Appointed Person

28 December 2023