

**O-152-17**

**TRADE MARKS ACT 1994  
IN THE MATTER OF  
TRADE MARK APPLICATION NO 3157654  
BY  
SMD TRADING LIMITED  
TO REGISTER**

**SARAH KLEIN**

**AS A TRADEMARK  
IN CLASS 25  
AND OPPOSITION THERETO (UNDER NO. 406841)  
BY  
CKL HOLDINGS N.V.**

## BACKGROUND AND PLEADINGS

1. SMD Trading Limited ('the applicant') applied to register the trade mark SARAH KLEIN on 1 April 2016. It was accepted and published in the Trade Marks Journal on 22 April 2016 in respect of the following goods in class 25:

*Clothing, hosiery, footwear, headgear*

2. CKL Holdings N.V. ('the opponent') opposed the trade mark under Section 5(2)(b) of the Trade Marks Act 1994 (the Act) against all goods in the application. This is on the basis of its earlier European Trade Mark set out below:

Opponent's trade mark details	Opponent's goods
EU014773386  <b>Sarah</b>  Filing date: 6 November 2015 Priority date (Benelux): 15 May 2015 Registration date: 21 March 2016	18: Trunks, suitcases, travelling cases, handbags, purses, wallets; umbrellas; parasols and walking sticks; whips, harness and saddlery.  25: Clothing; footwear and headgear; swimwear; sportswear and leisurewear.  38: Internet protocol television (IPTV) transmission services; simulcasting broadcast television over global communication networks and the Internet; television broadcasting.

3. The applicant filed a counterstatement admitting that its class 25 goods are identical to the opponent's goods but denying that they are similar to the opponent's goods in class 18 or their services in class 38. The applicant also denies that the marks are so similar as to cause likelihood of confusion. In particular, I note that the applicant states that "the opponent's mark does not identify a specific person having

the first name 'Sarah' whereas the applicant's mark identifies those persons [with] the family name 'Klein' and the first name 'Sarah'".

4. The opponent's trade mark is an earlier mark, in accordance with section 6 of the Act and, as it had not been registered for five years or more before the publication date of the applicant's mark, it is not subject to the proof of use requirements, as per section 6A of the Act.

5. Both parties filed written submissions and the applicant filed evidence. The evidence consists of examples of other 'Sarah' trademarks for class 25 goods on the register and in use on the internet. I may refer to the evidence later in my decision as necessary. No hearing was requested and so this decision is taken from the papers before me.

## **DECISION**

6. Section 5(2)(b) of the Act is as follows:

"5(2) A trade mark shall not be registered if because-

(b) it is similar to an earlier trade mark and is to be registered for goods 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.

7. The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *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.

## **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 a mark as a whole and does not proceed to analyse its various details;

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

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

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

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

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

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

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

(k) if the association between the marks creates a risk that the public 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**

8. The applicant has conceded that the respective goods in class 25 are identical.

## **AVERAGE CONSUMER AND THE PURCHASING ACT**

9. I must now consider the role of the average consumer and how the goods are purchased. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

10. 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. 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.”

11. The contested goods in this matter include clothing. 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 (‘GC’) stated:

“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.

53. Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

12. As stated by the General Court, items of clothing vary in price and quality. The same can be said of footwear and headgear. Ordinarily I would expect a normal level of attention to be paid by the consumer when selecting such goods. The purchasing act will be mainly visual as the goods are commonly purchased on the basis of their

aesthetic appeal. It is likely they will be selected after viewing of racks/shelves in retail establishments, or from photographs on Internet websites or in catalogues. However, I do not discount any aural considerations which may also play a part.

## COMPARISON OF THE MARKS

13. The marks to be compared are:

Opponent's mark	Applicant's mark
Sarah	Sarah Klein

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

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

15. 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.

16. The opponent's trade mark consists of a single word **Sarah** in title case. The overall impression of the mark and its distinctiveness rests solely on that word.

17. The applicant's trade mark consists of two words **Sarah Klein** in title case. The two words form a unit having a different meaning to the separate words of which the mark is composed. In my view, the overall impression of the applicant's trade mark and its distinctiveness rests on the unit, i.e. in the combination of the two words.

18. In a visual comparison, the marks share a common word 'Sarah' which is the only element of the opponent's mark and the first word of the applicant's mark. I find this to result in at least a medium degree of similarity between them.

19. In an aural comparison, again the marks share a common word 'Sarah'. The opponent states that 'the signs are highly similar' because 'the "Klein" element ... will be read second and, as such, be given less prominence'. In my view, although the word SARAH in the applicant's mark will be the first to impact on the ear, the word KLEIN also makes a significant aural impact. Bearing this in mind, I would not pitch the aural similarity as being high, as contended by the opponent, but there is at least a medium degree of similarity between the marks.

20. In a conceptual comparison, the opponent's trademark will be seen as a well-known female forename whereas the applicant's trade mark will be seen as the same female forename followed by a surname. The latter refers to a specific individual whereas the former does not. Overall, the marks are conceptually dissimilar.

## **DISTINCTIVE CHARACTER OF THE EARLIER TRADE MARK**

21. 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 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).”

22. The opponent did not file any evidence in support of their mark so I can only consider the inherent distinctiveness of the earlier mark.

23. The earlier mark consists of a female forename which does not describe or allude to the goods. Nevertheless, as personal names are a common form of trade mark and the name SARAH is a very common forename in the UK, it is fairly low in distinctiveness.

## **LIKELIHOOD OF CONFUSION**

24. I must now draw together my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors:

- a) The interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc*).

- b) The principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*).
- c) The factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*).

25. So far I have found that the goods at issue in class 25 are identical and that the average consumer is a member of the general public who will select the goods by primarily visual means whilst paying a normal degree of attention during the purchasing process.

26. I also found that the overall impression and distinctiveness of the opponent's mark lies in the single word, SARAH, itself. Whereas the overall impression and distinctiveness of the applicant's mark lies in the unit created by the combination of the words SARAH KLEIN.

27. In terms of the comparison of the marks, I found that they are visually and aurally similar at least to a medium degree. However, the concept of the opponent's trade mark is of a female forename and the applicant's mark of a female forename plus surname denoting a specific individual creating conceptual dissimilarity between the marks overall. In terms of the distinctiveness of the earlier mark, I concluded this to be fairly low.

28. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU's judgment in *Bimbo*, Case C-591/12P, on the court's earlier judgment in *Medion v Thomson*. The judge said:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

29. The competing trade marks both contain the word SARAH, leading to at least a medium degree of visual and aural degree of similarity. However the word SARAH is a very common female forename and as such has a fairly low degree of distinctive character. The opponent has filed no evidence to indicate that the trade mark enjoys any level of enhanced distinctiveness acquired through use. The word SARAH in the applicant’s trade mark does not have a distinctive significance independent of the whole. Its presence in the unit SARAH KLEIN would not lead to a likelihood of either

direct or indirect confusion. Therefore the opposition fails and is dismissed accordingly.

## **CONCLUSION**

30. The opposition has failed; subject to any successful appeal, the application will proceed to registration.

## **COSTS**

31. As the applicant has been successful, it is entitled to a contribution of the costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4/2007. Bearing in mind the guidance given in TPN 4/2007, but making no award to the applicant in respect of their evidence as it did not play any part in these proceedings, I award costs to the applicant as follows:

£200 for consideration of the Notice of Opposition and filing a counterstatement.  
£200 written submissions.

32. I order CKL Holdings N.V. to pay SMD Trading Limited the sum of £400. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 29th day of March 2017**

**June Ralph**  
**For the Registrar**  
**The Comptroller-General**