

O/200/12

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2583001  
BY  
WILSON IMPORTS LIMITED  
TO REGISTER THE TRADE MARK**

**FALLEN STAR**

**IN CLASSES 18 AND 25**

**AND**

**THE OPPOSITION THERETO  
UNDER NO 102151  
BY  
DES COMERFORD**

**Trade Marks Act 1994**  
**In the matter of application no 2583001**  
**by Wilson Imports Limited**  
**to register the trade mark:**  
**FALLEN STAR**  
**in classes 18 and 25**  
**and the opposition thereto**  
**under no. 102151**  
**by Des Comerford**

**BACKGROUND**

1. On 31 May 2011, Wilson Imports Limited (the applicant) applied to register the above trade mark in classes 18 and 25 of the Nice Classification system<sup>1</sup> as follows:

**Class 18**

Leather and imitations of leather, and goods made of these materials and not included in other classes; trunks and travelling bags; umbrellas, parasols; bags, briefcases, document cases, portfolios, school bags and satchels; holdalls, haversacks, backpacks, rucksacks, knapsacks; handbags, shoulder bags, clutch bags, tote bags; sports bags, athletic bags, beach bags, shopping bags; wallets, purses.

**Class 25**

Clothing, footwear, headgear, swimwear, beach wear, sportswear, leisure wear, belts for clothing; scarves, gloves, hats and mittens; accessories (clothing).

2. Following publication of the application on 1 July 2011, Des Comerford (the opponent) filed notice of opposition against the application.
3. The ground of opposition was brought under section 5(2)(b) of the Trade Marks Act 1994 (the Act).
4. The opposition is directed against all of the applicant's goods. The opponent relies on the following earlier mark:

<b>MARK DETAILS AND RELEVANT DATES</b>	<b>GOODS RELIED UPON</b>
<p><b>CTM:</b> 4411104</p> <p><b>Mark:</b> FALLEN HERO</p> <p><b>Date of application:</b> 24 May 2005</p>	<p><b>Class 18:</b> Leather and imitations of leather, and goods made of these materials and not included in other classes; trunks and travelling bags; hand bags; umbrellas.</p>

<sup>1</sup> International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).

<b>Date of registration:</b> 22 February 2011	<b>Class 25:</b> Clothing, footwear, headgear.
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5. In its notice of opposition the opponent states:

*“1. The mark of the subject application FALLEN STAR is phonetically, visually and conceptually similar to the mark FALLEN HERO of the Opponent's earlier Community Trade Mark Registration. In particular, both Marks are prefixed by the word FALLEN followed by a four letter word. The word FALLEN is prominent in both Marks and is the prominent element in each Mark.”*

6. On 15 September 2011, the applicant filed a counterstatement in which it denies that the marks are similar. It states:

*“11... The English speaking consumer will pay greater attention to the noun that follows the adjective in both Marks. There is no similarity between the nouns contained in the respective Marks. The marks are not therefore visually, phonetically or conceptually confusingly similar in totality.”*

7. The opponent's mark is an earlier mark which is not subject to proof of use because, at the date of publication of the application, it had not been registered for five years.<sup>2</sup>

8. While neither party filed evidence both filed written submissions in the proceedings; only the applicant filed written submissions in lieu of a hearing. I will refer to these as necessary below.

## **DECISION**

9. Section 5(2)(b) of the Trade Marks Act 1994, states:

*“(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.”*

10. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd - BL O/330/10* (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital*

<sup>2</sup> See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004: SI 2004/946) which came into force on 5th May 2004.

*LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the CJEU cases mentioned) on the basis indicated below:

### **The CJEU cases**

Sabel BV v Puma AG [1998] RPC 199; Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc [1999] RPC 117; Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V. [2000] F.S.R. 77; Marca Mode CV v Adidas AG & Adidas Benelux BV [2000] E.T.M.R. 723; Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-6/01; Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH C-120/04; Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P.

### **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, 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 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 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.”

### **The average consumer and the nature of the purchasing act**

11. In accordance with the above cited case law, I must determine who the average consumer is and consider the nature of the purchasing process. The average consumer is reasonably well informed and reasonably circumspect and observant, but with a level of attention likely to vary according to the category of goods. The attention paid is likely to vary depending on price and, to some extent, the nature of the goods and the frequency of the purchase.

12. The average consumer will be members of the general public who buy clothes bags and accessories. In considering the level of attention that will be paid to such a purchase and the nature of the purchasing act, I am mindful of the General Court’s (GC) decision 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 in which it commented:

*“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.”*

13. As none of the specifications are limited in any way, they will include goods across all price spectrums. Given the nature of the goods at issue which are (broadly speaking) fashion items of one sort or another, the average consumer will, in my view, pay at least a reasonable degree of attention to their purchase, to the extent that they will need to consider, inter alia, size, material and colour; in accordance with the decision in *New Look*, the visual aspect of the competing marks is likely to be of more importance than aural considerations.

### Comparison of goods

14. For ease of reference, the goods are shown below:

The opponent's goods	The applicant's goods
<p><b>Class 18:</b> Leather and imitations of leather, and goods made of these materials and not included in other classes; trunks and travelling bags; hand bags; umbrellas.</p> <p><b>Class 25:</b> Clothing, footwear, headgear.</p>	<p><b>Class 18:</b> Leather and imitations of leather, and goods made of these materials and not included in other classes; trunks and travelling bags; umbrellas, parasols; bags, briefcases, document cases, portfolios, school bags and satchels; holdalls, haversacks, backpacks, rucksacks, knapsacks; handbags, shoulder bags, clutch bags, tote bags; sports bags, athletic bags, beach bags, shopping bags; wallets, purses.</p> <p><b>Class 25:</b> Clothing, footwear, headgear, swimwear, beach wear, sportswear, leisure wear, belts for clothing; scarves, gloves, hats and mittens; accessories (clothing).</p>

15. In its submissions dated 10 April 2012 the applicant states:

*“We admit that the goods in classes 18 and 25 of the respective parties...are identical and/or similar.”*

16. In reaching a conclusion I bear in mind the following guidance provided by the General Court (GC) in *Gérard Meric v OHIM*, Case T-133/05 where the court held that:

*“29. ...goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”*

17. The applicant's goods in class 25 are all goods which fall within the broader term 'clothing, footwear, headgear' in the opponent's specification. In accordance with the guidance in *Meric* these are identical goods.

18. The wording in class 18 of both specifications is identical in respect of “*leather and imitations of leather, and goods made of these materials and not included in other classes; trunks and travelling bags; umbrellas*” and “*hand bags*”. The remaining goods are identical on a number on bases. Terms such as ‘bags’ in the applicant’s specification are broad terms which encompass the types of bags mentioned in the opponent’s specification and are identical on the *Meric* principle. Additionally, all of the remaining goods can be made from those materials identified in the opponent’s specification and are identical on that basis. Having carried out such an assessment, ‘parasols’ are the only goods remaining in class 18 of the application. They are, in my view, highly similar to ‘umbrellas’ in that they are similarly constructed, used to shield the body from effects of the weather, are held in the hand and will be displayed in similar areas of a shop or website.

19. In conclusion, the goods in class 18 are identical, or highly similar, to those contained in the opponent’s class 18 specification. The respective goods in class 25 are identical.

### **Dominant and distinctive components**

20. The opponent's mark consists of two words 'FALLEN' and 'HERO'. The applicant's mark also consists of two words i.e. 'FALLEN' and 'STAR', both marks are presented in plain block capitals and neither is possessed of any stylisation or any additional matter. In its submissions, dated 20 January 2012, the applicant states:

*“4. The word FALLEN is an adjective (descriptive word). Therefore an English speaking consumer will place lesser importance on the descriptive word fallen than on the word following it...”*

21. This is reiterated in the applicant's submissions in lieu of a hearing in which it states:

*“17. ...since the word FALLEN is an adjective, the words to be compared by the average circumspect, well informed and observant English speaking consumer are STAR and HERO, because these are the dominant and distinctive parts of the respective marks.”*

22. The word 'FALLEN' is an adjective, the main syntactic purpose of which is to qualify a noun. However, it would be a non sequitur to conclude that as a consequence the word 'FALLEN' is descriptive in a trade mark sense and must therefore be excluded, or given lower value, in my overall assessment of the marks.

23. Both marks consist of a combination of words in which the word 'FALLEN' qualifies the word that follows it i.e. 'STAR' and 'HERO'. As, in my view, the respective combinations “hang together”, it follows that the distinctiveness of each mark resides in the totality of the mark.

## Visual and aural similarities

24. In its submissions the opponent argues that the marks are visually and aurally similar as they start with the same word and are both followed by a four letter word.

25. The applicant submits that the average consumer will not count the number of letters in the marks. It contends that as the first word is an adjective, greater attention will be paid to the second word in the marks, which are different.

26. As I have already discussed above, the marks must be considered in their totality and in my view, the average consumer will not apportion greater weight to the second word in the marks. Any similarity in the marks, visually and aurally rests in the presence of the word 'FALLEN' at the beginning of each mark. The subsequent words 'STAR' and 'HERO' are clearly different. Taking all of these factors into account, I consider there to be a moderate degree of visual and aural similarity between the marks.

## Conceptual similarities

27. With regard to the conceptual similarities between the marks the opponent submits:

*“Conceptually, the common first element “FALLEN” of the Marks is identical, as it will be associated with one of the following definitions:*

- 1. having sunk in reputation or honour*
- 2. killed in battle with glory*
- 3. Defeated*
- 4. The past participle of the verb to fall*

*The phrase FALLEN HERO could mean a military person who has died in battle, or someone who was greatly respected and admired at one point in life, but whose actions later caused him or her not to be.*

*The phrase FALLEN STAR could mean a name for meteor or shooting star or it could refer to a disgraced former celebrity or other well known and respected person who has fallen from grace.*

*Therefore, there is a conceptual link between FALLEN HERO and FALLEN STAR as they can both refer to someone who has ‘fallen from grace’. i.e. someone who was greatly respected and admired at one point in life, but whose actions later caused him or her not to be. The Marks therefore share a conceptual similarity with one another.”*

28. The applicant's submissions, dated 20 January 2012, state:

*“9. The adjective (descriptive word) FALLEN has a different meaning when used in combination with the word STAR, as opposed to the word HERO, because in combination with the word STAR, it refers to the dropping of a star (from the sky) in the past tense, i.e. something physically having fallen from the sky. However, a FALLEN HERO does not physically fall, the term FALLEN in this context conveys the idea of a hero who’s reputation has been tarnished or who has, in some other way, become disgraced. Whilst we note the Opponent’s contentions regarding the possibility that FALLEN STAR, rather than meaning the obvious (i.e. a meteor or shooting star), may refer to a disgraced former celebrity or other well-known respected person, on first encountering the Mark FALLEN STAR, unless directed otherwise by the context, the average consumer will understand the meaning conveyed by it, referring to a meteor or shooting star.”*

29. For a conceptual meaning to be relevant it must be capable of being immediately grasped by the average consumer.<sup>3</sup> I have already concluded that these marks must be considered in their totality and that neither possesses a distinctive and dominant element. I must consider the conceptual message which each mark, in its totality, would convey to the average consumer.

30. I accept that the meaning of the phrase FALLEN STAR may be ambiguous. However, I agree with the applicant that the immediate conceptual meaning the words FALLEN STAR will convey to the average consumer will be an astronomical body i.e. the average consumer of the goods at issue will consider them to be referring to a star which has fallen from the sky.

31. Turning to the opponent’s mark FALLEN HERO, whilst also ambiguous, in my view, the immediate conceptual meaning these words will convey to the average consumer will be that of a person who is a member of the military who has been killed or injured in battle.

32. While I accept that both parties’ marks are susceptible to different conceptual meanings, in my view, the meanings that will immediately occur to the average consumer of the goods at issue will be those mentioned above, and as such, not only is there no conceptual similarity, the competing marks are, in my view, conceptually dissonant.

### **Distinctive character of the earlier mark**

33. I must now assess the distinctive character of the opponent’s earlier trade mark. The distinctive character of a trade mark must be appraised first, by reference to the goods in respect of which it has been registered and, secondly by reference to the way it is perceived by the relevant public – *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 for which it has been registered as coming from a particular undertaking and thus to

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<sup>3</sup> *This is highlighted in numerous judgments of the GC and the CJEU including Ruiz Picasso v OHIM [2006] e.c.r. –I-643; [2006] E.T.M.R. 29.*

distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

34. I have to consider whether the opponent's mark has a particularly distinctive character either arising from the inherent characteristics of the mark or because of the use made of it. As the opponent has filed no evidence in these proceedings I have only the earlier mark's inherent distinctiveness to consider.

35. In its submissions dated 10 April 2012, the applicant states:

*"We do not deny that the mark FALLEN HERO is distinctive."*

36. I agree. The words 'FALLEN' and 'HERO' are dictionary words which when combined create a mark which, in its totality, is neither descriptive of nor non-distinctive for the goods at issue. I find it to be a trade mark with a normal level of distinctiveness.

### **Likelihood of confusion**

37. In assessing the likelihood of confusion I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind.<sup>4</sup> I must also keep in mind the average consumer for the goods, the nature of the purchasing process and have regard to the interdependency principle i.e. 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.

38. I have found that the marks share a moderate degree of visual and aural similarity and have found there to be conceptual dissonance. I have also identified a normal level of distinctive character in the opponent's earlier mark. In respect of the goods, I have concluded that the parties' goods are identical or highly similar, according to the principles in *Meric*. I have identified the average consumer, namely a member of the general public who buys clothing, bags and accessories. I have concluded that the purchasing act will, generally, be visual but may also include an aural element. The purchase will involve a reasonable degree of care and attention, given that the average consumer will consider size, colour, materials, etc.

39. Taking all the above factors into account, considering the marks as a whole, and the nature of the purchasing process, I conclude that the differences between the marks outweigh the similarities. In my view the parties' marks both have clear specific meanings which differ from each other and which the average consumer would - immediately grasp. In reaching such a decision I am guided by the comments of the CJEU in Case C-361/04 *The Picasso Estate v OHIM* in which they said:

*"56. Such conceptual differences can in certain circumstances counteract the visual and phonetic similarities between the signs concerned. For there to be*

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<sup>4</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

*such a counteraction, at least one of the signs at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately [Case T-292/01 Phillips-Van Heusen v OHIM — Pash Textilvertrieb und Einzelhandel (BASS) [2003] ECR II-4335, paragraph 54].”*

40. In my view the average consumer will not (either directly or indirectly) confuse the mark of one of these undertakings for that of the other and there will be no likelihood of confusion.

## **CONCLUSION**

### **41. The opposition fails.**

#### **Costs**

42. The opposition having failed, the applicant, is entitled to a contribution towards its costs. I have taken into account that no hearing has taken place, but that the applicant filed written submissions in lieu of a hearing. I make the award on the following basis.

Preparing a statement and considering the other side’s statement:	£200
Written submissions:	£400
<b>Total:</b>	<b>£600</b>

43. I order Des Comerford to pay Wilson Imports Limited the sum of £600. 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 11<sup>th</sup> day of May 2012**

**Ms Al Skilton  
For the Registrar,**