

O/217/12

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION NO 2515338
BY
KURT GEIGER LIMITED
TO REGISTER THE TRADE MARK



IN CLASS 35
AND
IN THE MATTER OF OPPOSITION THERETO
UNDER NO 99854
BY
A-LIST CORPORATE LIMITED

BACKGROUND

1) On 06 May 2009 Kurt Geiger Limited (“the applicant”) applied to register the following mark, in respect of the shown list of services in class 35:



Class 35: Advertising and promotional services; sales incentive and loyalty schemes; the bringing together, for the benefit of others, of a variety of goods, namely, footwear, leather goods, luggage, travelling bags and travelling sets, umbrellas, handbags, purses, wallets, precious metals and their alloys; jewellery, costume jewellery, precious stones, horological and chronometric instruments, clocks and watches, key rings and accessories, enabling customers to conveniently view and purchase those goods in a retail shop or in a retail department store environment, by email order or via a global communications system.

2) The application was published on 04 September 2009 in the *Trade Marks Journal*, and a notice of opposition was later filed by A-List Corporate Limited (“the opponent”). The opponent claims that the application offends under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all of the applicant’s services.

3) In respect of Section 5(2)(b), one earlier mark is relied upon, the relevant details of which are as follows:

Mark details	Goods relied upon
<p>UK trade mark: 2440676</p>  <p>Date of application: 06 December 2006 Date of registration: 29 February 2008</p>	<p>Class 14: Boxes of precious metal; bracelets; chains; charms; tie-clips; earrings; jewellery; paste jewellery, costume jewellery; key rings of precious metal; necklaces; ornaments; pearls; precious stones; rings.</p> <p>Class 25: Bath robes; bath sandals; bath slippers; bathing drawers; bathing suits; beach clothes; beach shoes; belts; boots; caps; clothing of leather; coats; top-coats; hats; jackets; jersey shirts; jersey overcoats; jersey pants; jersey sweaters; jumpers [shirt fronts]; knitwear; lace boots; body-linen garments; overcoats; pants; pyjamas;</p>

	sandals; scarves; shirts; skirts; slippers; shoes (except sports shoes); sports shoes; stockings; suits; sweaters; swimsuits; tee-shirts; trousers; underpants; underwear; lingerie; panties; bras; crop tops; tank tops; camisoles; bodysuits.
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4) The opponent claims that the applicant’s mark is confusingly similar to the earlier mark and is applied for in respect of services related to identical or similar goods covered by the earlier mark.

5) At the date of publication of the application (04 September 2009) the opponent’s mark had not been registered for more than five years and is therefore not subject to the proof of use provision (Section 6A of the Act refers).

6) The applicant filed a counterstatement denying the ground of opposition. As part of its counterstatement, the applicant contends that the term ‘Boudoir’ is commonplace in the relevant field of trade.

7) Only the applicant filed evidence. Neither party requested to be heard. Only the opponent filed written submissions in lieu of a hearing. I therefore make this decision after conducting a thorough review of all the papers and giving full consideration to all submissions and evidence submitted.

Applicant’s Evidence

8) The applicant’s evidence consists of a witness statement, dated 21 December 2011, in the name of Sally McClymont, the Retail Director of Kurt Geiger Limited. There are no exhibits. Paragraph 4 of the witness statement provides the following figures which Ms Claymont states relate to approximate annual turnover figures of concessions sold in Debenhams Stores under the SHOE BOUDOIR LONDON brand (“the Brand”). She does not state whether those stores are based in the UK:

<u>Calendar Year</u>	<u>Turnover/£’s</u>
2009	£3, 126, 085
2010	£10, 545, 869
2011 (to date)	£11, 592, 459
Total	£25, 264, 403

9) The witness statement also contains a number of submissions which I will bear in mind and will refer to as and when appropriate in the decision which follows, but I will not detail them here.

DECISION

Section 5(2)(b)

10) This section of the Act states:

“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.”

11) The leading authorities which guide me in this ground are from the Court of Justice of the European Union (CJEU): *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, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO)*. It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

e) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*,

f) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*,

(g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(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; *Sabel BV v Puma AG*,

(i) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(j) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(k) further, 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; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(l) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

Comparison of goods and services

12) In making an assessment of the similarity of the goods/services, all relevant factors relating to the goods and services in the respective specifications should be taken into account. In *Canon Kabushiki Kaisha v. Metro- Goldwyn-Mayer* the 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.”

13) Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

- “(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.”*

14) Whether goods/services are complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), will depend on whether there exists a close connection or relationship such that one is important or indispensable for the use of the other (*Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 325/06*).

15) I bear in mind the guidance of the court in that, if a term clearly falls within the ambit of a term in the competing specification then identical goods must be considered to be in play (see *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-133/05*) even if there may be other goods within the broader term that are not identical. By extension, where the retailing of goods is described by a broad term, I will consider that that broad term may include more specific identical goods. I have also taken account of the comments of the General Court (GC) in *Oakley, Inc v OHIM T-116/06* regarding the similarity between goods and retail services connected with the sale of the same goods, where it was stated:

*“54. Clearly, in the present case, the relationship between the retail services and the goods covered by the earlier trade mark is close in the sense that the goods are indispensable to or at the very least, important for the provision of those services, which are specifically provided when those goods are sold. As the Court held in paragraph 34 of *Praktiker Bauund Heimwerkermärkte*, paragraph 17 above, the objective of retail trade is the sale of goods to consumers, the Court having also pointed out that that trade includes, in addition to the legal sales transaction, all activity carried out by the trader for the purpose of encouraging the conclusion of such a transaction. Such services, which are provided with the aim of selling certain specific goods, would make no sense without the goods”*

16) Turning to the instant case, the goods and services to be compared are:

Opponent’s goods	Applicant’s services
<p>Class 14: Boxes of precious metal; bracelets; chains; charms; tie-clips; earrings; jewellery; paste jewellery, costume jewellery; key rings of precious metal; necklaces; ornaments;</p>	<p>Class 35: Advertising and promotional services; sales incentive and loyalty schemes; the bringing together, for the benefit of others, of a variety of goods, namely, footwear, leather goods, luggage, travelling bags and travelling</p>

<p>pearls; precious stones; rings.</p> <p>Class 25: Bath robes; bath sandals; bath slippers; bathing drawers; bathing suits; beach clothes; beach shoes; belts; boots; caps; clothing of leather; coats; top-coats; hats; jackets; jersey shirts; jersey overcoats; jersey pants; jersey sweaters; jumpers [shirt fronts]; knitwear; lace boots; body-linen garments; overcoats; pants; pyjamas; sandals; scarves; shirts; skirts; slippers; shoes (except sports shoes); sports shoes; stockings; suits; sweaters; swimsuits; tee-shirts; trousers; underpants; underwear; lingerie; panties; bras; crop tops; tank tops; camisoles; bodysuits.</p>	<p>sets, umbrellas, handbags, purses, wallets, precious metals and their alloys; jewellery, costume jewellery, precious stones, horological and chronometric instruments, clocks and watches, key rings and accessories, enabling customers to conveniently view and purchase those goods in a retail shop or in a retail department store environment, by email order or via a global communications system.</p>
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17) I consider it convenient to make the comparison by addressing each of the terms within the specification of the application in turn, and, where appropriate and for the sake of expediency, grouping certain terms together (*Separode Trade Mark* BL O-399-10). I will compare those terms to those which I consider to be the most relevant within the opponent's specification:

Advertising and promotional services; sales incentive schemes.

18) The goods covered in classes 14 and 25 of the opponent's specification are tangible, physical objects whilst '*advertising and promotional services*' and '*sales incentive schemes*' in the application are not physically tangible. The respective goods and services are therefore not similar in their nature.

19) The opponent submits the following:

"Insofar as the Applicant's services "advertising and promotional services; sales incentive and loyalty schemes" are concerned the Opponent's goods in Classes 14 and 25 fundamentally implies trade in such goods whilst the Applicant's services relate to the addition of added values arising out of from a personal or professional activity. The services of the Applicant are not qualified and would include such services relating to the goods specified in Classes 14 and 25 of the Opponent's earlier trade mark. The distribution channels and sales outlets may be the same, for example, in a website or an on-line retail store in which the Opponent's goods may be sold and advertising, promotional services and sales incentive and loyalty schemes may be provided. The goods and services are complementary."

20) Insofar as '*Advertising and promotional services*' and '*Sales incentive schemes*' are concerned, I do not agree with the opponent's submissions. '*Advertising and promotional services*' are intended to communicate the claimed benefits and/or

advantages of the products or services of a commercial undertaking to an audience of potential consumers. ‘Sales incentive schemes’ are a business tool used to motivate and encourage sales professionals to meet targets and maximise sales. It is important to stress that the internal administration of ‘sales incentive schemes’ within a business is not the same as the provision of such a service to third parties. These services are not offered through the same trade channels as the goods covered by the opponent’s earlier mark. The opponent’s goods, on the most part, are those which will be offered for sale by retailers to the general public, while ‘advertising and promotional services’ and ‘sales incentive schemes’ are offered to businesses through specialist trade channels, which the general public are unlikely to access. It follows that their respective customers will not be the same. Furthermore, there is no complementary relationship (in the sense that one is dependent upon the other) between the respective goods and services. There is no similarity between these services and the goods of the opponent’s earlier mark.

The bringing together for the benefit of others, of a variety of goods, namely, footwear, leather goods, precious metals and their alloys, jewellery, costume jewellery, precious stones, key rings and accessories.

21) The opponent’s earlier mark covers ‘shoes’. ‘Shoes’ and ‘footwear’ can be considered identical as the former falls within the ambit of the latter. Applying the guidance provided by the GC in *Oakley* I find that ‘shoes’ are similar to ‘*the bringing together...footwear...*’ to a good degree. Accordingly the same reasoning can be applied to conclude that ‘*clothing of leather*’ and ‘*the bringing together...leather goods...*’ are similar. ‘*Precious metal*’ and ‘*the bringing together of... precious metals and their alloys...*’ are similar. ‘*Jewellery*’ and ‘*the bringing together of...jewellery, costume jewellery*’ are similar. ‘*Precious stones*’ and ‘*the bringing together of...precious stones*’ are similar. ‘*Key rings of precious metals*’ and ‘*the bringing together...key rings and accessories*’ are similar. There is a good degree of similarity between the respective goods and services. Furthermore, the respective goods and services are complementary in the sense that the respective goods are dispensable or important for the provision of the retailing of the same (*Boston Scientific*).

Loyalty schemes

22) In respect of ‘loyalty schemes’, the opponent’s submissions (set out at paragraph 19 above) have some force. These are services which are used as a business tool to retain customers. Such schemes are commonly run as an ancillary service or ‘add on’ to a retail service. The general public may be a member of such a scheme, enjoying certain benefits as a result of transactions made with a retailer. Accordingly, the general public are likely to utilise the services of a ‘loyalty scheme’ as part of their retail experience. Moreover, in order to reap the benefits of membership of such a scheme, the consumer may need to purchase certain goods (which could include those covered by the opponent’s earlier mark). As a consequence of purchasing those certain goods, the customer may be ‘rewarded’ for their loyalty to the retailer. Such a ‘reward’ may take the form of ‘points’ (which can be accrued and given a monetary value which may be used to pay for future purchases) or vouchers. It follows that, in the same way as with retail services, the channels of trade and the end users for ‘loyalty schemes’ and the opponent’s goods are likely to be the same. Furthermore, the respective goods and services may be considered complementary

because, as I have already stated, in order to receive the benefits of a 'loyalty scheme' the consumer will, ordinarily, have to purchase certain goods. It follows then that the goods are indispensable to the provision of the 'loyalty scheme' service. Accordingly, I conclude that there is a reasonable degree of similarity between 'loyalty schemes' and the goods of the opponent's earlier mark and the respective goods and services are complementary (Boston Scientific).

The bringing together for the benefit of others, of a variety of goods, namely, clocks and watches.

23) The earlier mark covers 'jewellery'. 'Jewellery' is purchased on the basis of its appearance for the purpose of personal adornment. It is commonly sold through retailers both on the high street and online.

24) '*The bringing together for the benefit of others, of a variety of goods, namely, clocks and watches...*' are services offered for the purpose of encouraging and concluding a transaction between the retailer and the consumer in relation to those goods. It is common for retail stores providing those services to sell other goods of a similar nature or intended purpose. The primary purpose of clocks and watches is to function as timepieces. However, unlike clocks, watches may also be bought for the purpose of personal adornment in much the same way as jewellery. Indeed, it is not uncommon for a watch face to be incorporated within certain items of jewellery, such as bracelets. The trade channels of jewellery and clocks will converge to a certain degree (bearing in mind that some jewellers may also sell clocks), however, it will not be to the same extent of the convergence between jewellery and watches which are commonly sold together in large quantities in close proximity, particularly in jewellers shops. Taking all of these factors into account, I find that 'jewellery' and 'the bringing together...watches' share a reasonable degree of similarity and that 'jewellery' and 'the bringing together...clocks' share a low degree of similarity.

25) The earlier mark also covers *Ornaments*. These goods are purchased on the basis of their aesthetic appeal but are intended to be displayed in a room rather than on the person. Ornaments vary greatly in size and physical form and can be found in a wide variety of retailers, including, inter alia, department stores, home furnishing stores and jewellers.

26) Retailers selling clocks may also sell ornaments and therefore the trade channels may sometimes converge. The goods themselves are similar to a limited extent in that both are bought for the purpose of being displayed in a room and some decorative clocks may also function as ornaments, indeed certain clocks are categorized as ornamental. However, bearing in mind that clocks are primarily bought for the purpose of telling the time rather than as ornaments, and that the convergence of trade channels is likely to be low, I find there to be a low similarity between 'ornaments' and 'the bringing together...clocks'.

The bringing together for the benefit of others, of a variety of goods, namely, horological and chronometric instruments

27) '*Horological and chronometric instruments*' can be deemed to be identical to 'watches' by virtue of the fact that the latter falls within the ambit of the former. I have

already found that 'jewellery' and 'the bringing together...watches' is similar to a reasonable degree. It follows that I must also find that 'jewellery' and 'the bringing together...horological and chronometric instruments...' is also similar to a reasonable degree.

The bringing together for the benefit of others, of a variety of goods, namely, handbags, purses.

28) The earlier mark covers, inter alia, 'belts, clothing of leather, coats, hats, jackets, shirts, skirts, scarves, knitwear, overcoats, suits, trousers, shoes, boots'. These goods are all intended for personal adornment, are bought based on aesthetic appeal and intended to be worn on the person. They will be purchased by the general public through retailers on the high street and on-line and can be categorized as fashion items.

29) The primary purpose of handbags and purses is to carry personal belongings, however, it can also be concluded that they may also be purchased based on their aesthetic appeal. Handbags are worn on the person, and may form part of an overall outfit as an accessory to clothing. There are also certain purses which are large and may be clutched in the hand as an accessory to an outfit. Consequently, handbags and purses are often sold by the same retailers of clothing items, particularly fashion retailers. It follows that the trade channels involved between the respective goods and services may be the same and their users may be very similar, if not the same. Taking into account all of the aforesaid factors, I find there to be a reasonable level of similarity between the clothing items identified and 'the bringing together... handbags and purses'.

The bringing together, for the benefit of others, of a variety of goods, namely luggage, travelling bags and travelling sets, umbrellas, wallets.

30) Luggage, travelling bags and travelling sets and wallets are purchased for the purpose of carrying belongings, and umbrellas for the purpose of sheltering from precipitation. While aesthetics may play a part in the purchasing act, the consumer will predominantly purchase these goods for their functional purpose rather than as an accessory to an outfit or as a fashion item. Their trade channels are unlikely to converge with the goods covered by the opponent's earlier mark to any significant extent. These are also not likely to be sold in close proximity to the opponent's goods. I therefore find that the above retail services are not similar to the opponent's goods, however, if I found to be wrong, there would only be a very low degree of similarity.

Average consumer and the purchasing process

31) It is necessary to consider these matters from the perspective of the average consumer of the goods and services at issue (*Sabel BV v. Puma AG*). The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect, but his/her level of attention is likely to vary according to the category of goods.

32) The opponents' goods in class 25, being specific items of clothing, footwear and headgear, are those which will be purchased by the general public. These goods vary greatly in price and the consumer may try on items to ensure that they are the correct fit and suitable for the intended purpose and occasion. On the whole, a reasonable level of attention will therefore be paid to their purchase.

33) The opponent's goods in class 14 are, on the most part, goods which will also be purchased by the general public. I would expect costume jewellery, tie-clips and key rings of precious metal to generally be at the lower end of the cost scale. As such, these goods may be a fairly frequent inexpensive purchase and will therefore afford a lower degree of attention than the purchase of, for example, a platinum engagement ring which will be significantly more expensive and where I would expect the level of attention to be higher. The price of other jewellery items, boxes of precious metal and ornaments will vary considerably depending on the exact nature of the item and the material of which it is made. Taking the opponent's class 14 specification as a whole, I would expect the average consumer to pay a reasonable, but not an exceptional, level of attention to the purchase however, where precious stones and pearls are concerned, which are likely to be purchased by designers or makers of jewellery, I would expect the level to be higher.

34) The goods covered by the applicant's retail specification are, on the most part, consumer goods which will be purchased by the general public. A reasonable level of attention but not the highest level will be paid and the purchase will be primarily visual. The exception to this would be *precious stones and precious metals and their alloys* which will be purchased by designers or jewellery makers; as such these goods will attract a higher level of attention during the purchasing act than the other consumer goods covered by the retail specification.

35) It follows that the average consumer for the majority of the opponent's goods and the applicant's services will be the same. The purchasing act in relation to all of the goods and services covered by the respective marks will be primarily visual as the goods in question are commonly bought based on their aesthetic appeal however, I do not discount that aural considerations may play a part.

Comparison of marks

36) For ease of reference, the respective marks are:

Opponent's mark	Applicant's mark
	

37) In making a comparison between the marks, I must take account of the respective marks' visual, aural and conceptual similarities with reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*). However, I must not engage in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

Dominant and distinctive components

38) The opponent's mark consists of the word 'Boudoir' in a large fancy font, positioned above the two words 'BY DISAYA' which are presented in a smaller standard font. Although smaller, the font of the latter is bolder than the former. The difference in font size is such that the word 'Boudoir' constitutes a larger proportion of the mark than the words 'BY DISAYA'. Upon considering the mark as a whole, I consider that it is the word 'Boudoir' which constitutes the dominant distinctive element by virtue of its positioning above the words 'BY DISAYA' and being in a larger font. The words 'BY DISAYA', whilst not being the dominant element, are clearly visible and distinctive and must therefore be considered in the overall comparison.

39) The applicant's mark consists of three words stacked above one another. Reading from top to bottom, the words are 'Shoe', 'Boudoir' and 'LONDON'. The words 'Shoe' and 'Boudoir' are presented in the same large fancy font. The word 'LONDON' is presented in a smaller standard font such that it takes up a much smaller proportion of the mark as a whole. All three words are presented on a black background. I consider that the dominant distinctive element of the mark as a whole is the phrase 'Shoe Boudoir'. These two words are presented in the same large fancy font in a prominent position inviting the eye to read through both words as a phrase. The word 'LONDON' is much smaller and positioned in a less prominent position when considering the mark as a whole. However, although not a dominant element, 'LONDON' is clearly visible and must therefore be considered in the overall comparison.

Visual

40) A clear point of similarity is that both marks contain the word 'Boudoir' in a very similar fancy font with the shape and slant of the letters being highly similar. The word 'Boudoir' is large and prominent in both marks. Points of difference are that the opponent's mark contains the words 'BY DISAYA' which are absent from the applicant's mark and the applicant's mark contains the words 'Shoe' and 'LONDON' which are absent from the opponent's mark. Taking all of these factors into account, I find there to be a reasonably high degree of visual similarity between the marks.

Aural

41) Turning to the aural comparison, the opponent's mark consists of six syllables in total and will be pronounced as BOOD-WHAR BI DIS-AY-AH.

42) The applicant's mark consists of five syllables in total and will be pronounced as SHOO BOOD-WHAR LUND-UN.

43) Consequently, the respective marks are similar in that both contain the BOOD-WHAR element but differ in the pronunciation of the syllables which follow the word 'Boudoir'. The applicant's mark also contains the single syllable word 'Shoe' which precedes the word 'Boudoir' and will be pronounced as SHOO. The word 'Shoe' is absent from the opponent's mark. Taking account of these similarities and differences, I conclude that the marks share a moderate degree of aural similarity.

Conceptual

44) Collins English Dictionary¹ defines the word '*Boudoir*' as:

"A woman's bedroom or private sitting room. [C18: from French, literally: room for sulking in, from boudier to sulk]."

45) It is a word of French origin and is one which I consider the average consumer in the UK will be reasonably familiar with however, they may not be aware of its exact definition. It is, in my view, likely to immediately evoke in the minds of those consumers the general concept of a bedroom or other similar kind of private room but not necessarily a woman's room. This general concept is common to both marks.

46) In addition to the word 'Boudoir', the opponent's mark also contains the words 'BY DISAYA' which are not present in the applicant's mark. The word 'DISAYA' does not have a dictionary meaning and may be perceived as an invented word or, in the context of the phrase 'BY DISAYA', it may also be perceived as an unusual name. The word 'BY' usually precedes the name of a person responsible for creating a particular thing. Whether the perception is of the former or latter kind, the consumer will perceive the mark as a whole as 'Boudoir', *created* BY DISAYA, where DISAYA is a person's name or invented name.

47) In the applicant's mark, the word 'Boudoir' is qualified by the preceding term 'Shoe' to result in the phrase 'Shoe Boudoir'. The concept portrayed by this phrase is one of a boudoir (being a bedroom or other similar private room) containing shoes. The additional word 'LONDON' will be seen as merely indicating the geographical origin of the services delivered under the mark.

48) Taking into account the above similarities and differences, I find that the marks share a moderately high level of conceptual similarity.

49) In summary, I have found that the respective marks share a reasonably high degree of visual similarity, a moderate degree of aural similarity and a moderately high degree of conceptual similarity. This combines to create a reasonably high degree of similarity overall between the respective marks.

¹ 'boudoir' 2000, in *Collins English Dictionary*, Collins, London, United Kingdom, viewed 09 May 2012, <from <http://www.credoreference.com/entry/hcengdict/boudoir>>

Distinctive character of the earlier mark

50) I must consider the distinctive character of the opponent's mark. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). The distinctive character of a trade mark must be assessed by reference to the goods or services in respect of which registration is sought and by reference to the way it is perceived by the relevant public (*Rewe Zentral AG v OHIM (LITE)* Case T-79/00 [2002] ETMR 91). No evidence of use has been filed by the opponent, so I have only to consider the inherent level of distinctiveness.

51) As I have already stated, the opponent's mark, as a whole will be perceived as 'Boudoir', created BY DISAYA where DISAYA may be viewed as an invented name or an unusual name of a person. The 'BY DISAYA' element of the mark is not descriptive or allusive of the goods in any way.

52) With regard to the 'Boudoir' element, this is a word in the English language meaning 'A woman's bedroom or private sitting room'. Whilst it does not enjoy the highest level of distinctiveness of an invented word, it does not describe the goods covered by the opponent's mark and neither is it allusive of those goods. Taking into account all the aforementioned factors, I conclude that, considering the mark as a whole, it enjoys a high level of inherent distinctiveness.

Likelihood of confusion

53) In determining the likelihood of confusion, I must take the global approach advocated by case law (*Sabel BV v Puma AG*) and take into account that marks are rarely recalled perfectly with the consumer relying instead on the imperfect picture of them he has kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27).

54) In paragraph 8 of her witness statement, and in an apparent attempt to support the submissions made in the counterstatement, Ms McClymont states:

"...we believe, the term "BOUDOIR" is itself quite commonplace and non-distinctive in the marketplace. This belief is supported by the fact that there are, apparently, (and as advised to me by our Solicitors and representatives in this action), a number of other "BOUDOIR" marks on the UK Trade Marks Register covering either identical or closely similar goods to those offered by the Opponent and to the services offered by my Company. A quick search on the Internet will also reveal a number of other uses of the term "BOUDOIR" in the same or similar areas, such as luella's boudoir and Vivienne westwood boudoir.

It is because we knew that the term boudoir on its own is fairly generic in this area that we adopted the Brand"

55) No evidence has been provided to illustrate whether the marks referred to are actually in use in the UK and what the relevant public's perception of these marks may be in relation to the goods and services in question. Ms McClymont's statement

that 'luella's boudoir' and 'Vivienne westwood boudoir' can be found on the Internet is unsupported. In the absence of further evidence regarding the nature and scale of use of these terms, I am unable to give any weight to these claims.

56) State of the register evidence is rarely relevant. In this regard I refer to the following comments of the court in *Zero Industry Srl v OHIM* Case T-400/06:

“As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II-4865, paragraph 68, and Case T-29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II-5309, paragraph 71).”

57) I have concluded that the purchasing act for all of the respective goods and services will be primarily visual. Consequently, the visual factor may be given a higher level of importance in the overall assessment. I have found the marks to be visually similar to a reasonably high degree and that 'Boudoir' and 'Shoe Boudoir' are the respective dominant and distinctive elements. In reaching this conclusion I have taken account of all elements present in both marks and the overall impressions conveyed by each mark. I have not discounted the presence of the words 'BY DISAYA' in the opponent's mark or 'LONDON' in the applicant's mark. All elements of both marks are clearly visible however it is the 'Boudoir' and 'Shoe Boudoir' elements which are the most prominent and contribute greatest to the overall visual impact. In this regard, I take account of the comments of the GC in *Ontex NV v OHIM* Case T- 353/04, where it was stated:

*“68. It must be pointed out that although, strictly speaking, the visual impression of a sign consists of the overall impression it produces, **the fact that some of its constituents produce a greater or lesser visual impact cannot be ruled out.**”*

58) Furthermore, the GC stated in *Capital Markets Holding, SA v OHIM* Case T-563/08:

*“36 Assessment of the similarity between two marks means more than taking just one component of a complex trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, **which does not mean that the overall impression conveyed to the relevant public by a complex trade mark may not, in certain circumstances, be dominated by one or more of its components** (see Case C-334/05 P OHIM v Shaker [2007] ECR I-4529,*

paragraph 41 and the case-law cited). It is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element (OHIM v Shaker, paragraph 42, and judgment of 20 September 2007 in Case C-193/06 P Nestlé v OHIM, not published in the ECR, paragraph 42)”.

59) I have also found that the marks share a moderately high level of conceptual similarity. With regard to the aural comparison, I have concluded that there is a moderate degree of similarity between the marks. On the most part, a reasonable level of attention will be paid to the respective goods and services during the purchasing act and the consumer will be the general public. The only exception would be in relation to *‘precious metal, pearls, precious stones’* and *‘the bringing together for the benefit of others...precious metals and their alloys, precious stones...’* where the level of attention will be higher and the consumer is likely be a designer or jewellery maker. I have also concluded that the earlier mark enjoys a high level of inherent distinctiveness.

60) Having taken into account all of the above factors, I conclude that where I have found no or low similarity between the respective goods and services, the opposition fails as there is unlikely to be any confusion on the part of the average consumer. The differences in nature, intended purpose, methods of use, users and channels of trade of the respective goods and services concerned are such that they outweigh any similarities between the marks.

61) The opposition is therefore unsuccessful in relation to the following services covered by the applicant’s mark:

‘Advertising and promotional services; sales incentive schemes; the bringing together for the benefit of others, of a variety of luggage, travelling bags and travelling sets, umbrellas, wallets and clocks enabling customers to conveniently view and purchase those goods in a retail shop or in a retail department store environment, by email order or via a global communications system’

62) Conversely, where I have found that the respective goods and services are similar to a good or reasonable degree, I conclude that the differences between the marks are not sufficient to avoid a likelihood of confusion. Both marks contain the same word ‘Boudoir’ in a very similar font. I have taken account of the differences between the marks in respect of the ‘BY DISAYA’, ‘Shoe’ and ‘LONDON’ elements. In this regard, I bear in mind that, in the fashion and jewellery industries, the use of sub-brands and mark variants on different ranges of goods and services is commonplace. The differences are therefore not sufficient to counteract the similarities between the marks. The consumer is likely to believe that the goods and services emanate from the same or linked undertaking.

63) The opposition is therefore successful in relation to the following services covered by the applicant’s mark:

‘Loyalty schemes; the bringing together for the benefit of others, of a variety of goods, namely footwear, leather goods, handbags, purses, precious metals and their alloys, jewellery, costume jewellery, precious stones, horological and chronometric

instruments and watches, key rings and accessories, enabling customers to conveniently view and purchase those goods in a retail shop or in a retail department store environment, by email order or via a global communications system'

COSTS

64) In light of the parties having achieved a reasonably equal level of success, I consider that both parties should bear their own costs and I therefore decline to make an order.

Dated this 30th day of May 2012

**Beverley Jones
For the Registrar,
the Comptroller-General**