

**TRADE MARKS ACT 1994**

**IN THE MATTER OF AN APPLICATION FOR PROTECTION IN THE UK OF  
INTERNATIONAL REGISTRATION NO. 885033 BY MIP METRO GROUP  
INTELLECTUAL PROPERTY GMBH & CO. KG**

**AND IN THE MATTER OF OPPOSITION NO. 71427 THERETO BY HACKETT  
LIMITED**

**APPEAL TO THE APPOINTED PERSON FROM THE DECISION OF MR  
OLIVER MORRIS FOR THE REGISTRAR, DATED 4 NOVEMBER 2009**

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**DECISION**

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**Introduction**

1. This is an appeal brought under section 76 of the Trade Marks Act 1994 (“**the Act**”) against a decision of Mr Oliver Morris, Hearing Officer for the Registrar, in which he found that an opposition under section 5(2)(b) of the Act to an application for protection in the United Kingdom of International Registration 885033 (“**the IR**”) succeeded in respect of some but not all of the goods that were the subject of the opposition.
2. MIP Metro Group Intellectual Property GmbH & Co. KG (“**the Applicant**”) is the registered proprietor of the IR, which has an international priority date of 24 August 2005. The Applicant designated the United Kingdom for protection of its IR on 25 January 2006. The IR is a device mark in the form set out below, including a claim for the colours “light yellow, light green, white”, for a range of goods in Classes 3, 9, 21, 24, 25, 26 and 27:



3. Hackett Limited (“**the Opponent**”) filed an opposition against the application for protection of the IR in the United Kingdom on 20 November 2006 (“**the Opposition**”). The Opposition was based on sections 5(2)(b) and 5(3) of the Act, relying on its earlier UK trade mark no. 2183456 (the “**Earlier Mark**” – depicted

below), and under section 5(4)(a) of the Act, relying on its use of a sign corresponding to the Earlier Mark since at least 1994.



4. The Earlier Mark was filed on 2 December 1998 and registered on 14 July 2000. The goods for which it is registered are as follows:

**Class 03:** Aftershaves.

**Class 14:** Cufflinks; clocks; silverware and men's jewellery.

**Class 18:** Leather and imitations of leather, and goods made of these materials; bags.

**Class 25:** Clothing and headgear.

5. The Opposition was directed only at the goods in Classes 3, 21, 24 and 25 for which the Applicant sought protection of the IR in the United Kingdom, as follows:

**Class 03:** Bleaching and other substances for laundry use; cleaning polishing, scouring and abrasive preparations; preparations for body and beauty care; soaps; perfumery products, scents of any kind, in particular perfume, eau de perfume, eau de toilette, deodorants; essential oils; cosmetics; skin creams; lotions for cosmetic purposes, preparations for shaving purposes and aftershaves; dentifrices; cosmetic bath additives; lipsticks; cotton swabs for cosmetic purposes; nail polish; shoe polish, make-up; cleansing tissues containing cosmetic lotions.

**Class 21:** Appliances for body and beauty care, included in this class, water apparatus for cleaning teeth and gums, sponges; brushes, combs, shoe shine kits; dishrags, dishtowels and glassware towels (for household purposes).

**Class 24:** Woven materials and textile goods, not included in other classes; table and bed linen; quilts, net curtains, curtains, decoration curtains, eiderdowns, bedding (included in this class), blankets, sheets, bedspreads, duvets, bedcovers, pillow cases, plaids for furniture, textile towels, bath towels and sauna towels, textile washcloths, tablecloths, table mats (table linen) made of cloth or plastic, textile cleansing tissues, pillow slips, textile napkins, toilet seat covers (slips).

**Class 25:** Headgear, in particular shower caps; shoes, in particular beach shoes, clothing; eye masks (for sleeping).

6. The Applicant defended the Opposition in full by Notice of defence and counterstatement filed on 11 April 2007. It required the Opponent to provide proof of use of the Earlier Mark in respect of the goods in relation to which the Opponent claimed to have used the mark, pursuant to section 6A of the Act, in order to be permitted to pursue the grounds based on that registration. These goods were stated in the Opponent's statement of use to be:

“(a) Aftershaves;

(b) Cufflinks;

(c) Goods made of leather and imitation leather; bags;

(d) Clothing

And other goods including the following:

Eau de toilette, sunglasses, ophthalmic frames, collar stiffeners, business card holders, key rings, tea measuring spoons, photographic frames, money clips, travelling bags, umbrellas, sticks, luggage, bags, cases, holdalls, briefcases, wallets, coin purses, card holders, attaché cases, key cases, towels, travelling rugs, handkerchiefs, scarves, belts, ties and braces.”

7. Both parties filed evidence. Neither side requested a hearing but both sides filed written submissions.
8. The Hearing Officer allowed the Opposition under section 5(2)(b) of the Act in respect of some but not all of the opposed goods, but otherwise dismissed the Opposition in a written decision dated 4 November 2009 (O/348/09 – “**the Decision**”). Both parties having achieved a measure of success, he did not give an award of costs in favour of either party.
9. On 2 December 2009, the Applicant gave notice of appeal to the Appointed Person, seeking to reverse part of the Decision, namely that the Opposition succeeds under section 5(2)(b) of the Act in respect of some of the goods in the specification for the IR.
10. The case came to me in March 2010 with some outstanding procedural issues to deal with. I gave my preliminary views on those issues and invited the parties to try to agree how to proceed. I also set a date of 26 April 2010 for a hearing. However, this was subsequently vacated at the joint request of the parties on the basis that they were “engaged in advanced settlement discussions”.
11. The appeal revived in August 2012, the parties having failed to reach a settlement. I held a case management conference by telephone on 19 September 2012, following which I made some directions relating to the hearing of the appeal, as recorded in my interim decision of 21 September 2012 (BL O-381-12). The Applicant amended its Notice of appeal pursuant to those directions and the appeal proceeded to a hearing before me on 26 November 2012. The Applicant was represented by Ms Denise McFarland, instructed by Marks & Clerk Solicitors LLP, and the Opponent was represented by Mr Guy Hollingworth, instructed by Nabarro.

## **Legislative basis**

12. The relevant part of the Act that I need to consider is section 5(2)(b), which provides as follows:

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.

13. This provision is derived from the predecessor to article 4(1)(b) of First Council Directive 2008/95/EC of 22 October 2008 to approximate the laws of the Member States relating to trade marks (codified version). A parallel provision in relation to Community trade marks is found at article 8(1)(b) of Council Regulation (EC) No. 207/2009 on the Community trade mark.

## **The Decision**

14. The Hearing Officer set out the background to the Opposition and summarised the grounds relied on. He then summarised the parties' evidence in some detail. No criticism is made of this summary by either party, so I do not propose to repeat the exercise here.

15. Paragraphs 28 to 36 of the Decision deal with the question of whether, and the extent to which, the Opponent had satisfied the proof of use requirement in section 6A of the Act. The Hearing Officer concluded (at paragraph 36) that there had been genuine use of the mark across a wide range of goods within the relevant period and that a fair specification reflecting that use was:

**Class 3:** Aftershaves

**Class 14:** Cufflinks

**Class 18:** Wallets, passport holders and attaché cases, all being made from leather or imitations of leather; bags.

**Class 25:** Clothing; headgear; all for men

16. There is no challenge to this conclusion.

17. The Hearing Officer then dealt with the three grounds of opposition in turn. In relation to the section 5(3) and 5(4)(a) grounds, he found in favour of the Applicant. The Opponent has not appealed this decision and so I will not discuss these aspects of the Decision further.

18. The Hearing Officer started his analysis of the section 5(2)(a) ground of opposition by setting out the relevant legislation and citing a series of well-established applicable authorities. He then considered the identity of the average consumer and the nature of the purchasing decision. He found (at paragraph 39) that the “average consumer will ... be a member of the general public”. In relation to the act of purchasing, the Hearing Officer said (excluding footnotes):

40. In terms of the purchasing act, most of the goods will be self-selected from a shelf, online, or from a catalogue, so making this a visual act of purchase. This is certainly the case in relation to clothing. This means, potentially, that any degree of visual similarity/dissimilarity may play a more significant role in the assessment of a likelihood of confusion than oral similarity/dissimilarity. Other goods may, however, have slightly different considerations. For example, aftershave may be selected from a shelf or it may be located behind a counter so requiring oral request. Here the visual and oral aspects of similarity/dissimilarity will have an equal role to play.

19. The Hearing Officer then undertook a thorough comparison of the goods set out in the IR (save in relation to a relatively small number which the Opponent had conceded in its written submissions were dissimilar to the goods of the Earlier Mark) and the goods covered by the Earlier Mark (after taking into account the proof of use provisions). He set out the relevant factors that, according to established case law, should be taken into account in making the comparison. For clarity, when making his assessment (at paragraph 47 of the Decision), the Hearing Officer divided the goods into eleven categories, in relation to each of which he set out in a table whether the goods were “identical”, “identical/similar to a reasonably high degree”, “reasonably similar”, had “a low degree of similarity”, had “no similarity” or were “not similar”, explaining his reasons in each case. The Hearing Officer’s findings have not been challenged.

20. As Mr Hollingworth, for the Opponent, noted in his skeleton argument:

4. ...there is no appeal against the Hearing Officer’s findings that:

- (a) the [Earlier] Mark has been used for relevant goods (paragraph [36] of the Decision);
- (b) the average consumer is a member of the general public (paragraph [39] of the Decision);
- (c) the goods in question are similar or identical (paragraph [47] of the Decision). In particular:
  - i. ‘Preparations for body and beauty care; cosmetics; skin creams; lotions for cosmetic purposes’ are *reasonably similar* to ‘aftershave’ (Category 1 in the table under paragraph [47])
  - ii. ‘Perfumery products, scents of any kind, in particular perfume, eau de perfume, eau de toilette, deodorants are *identical/similar to a reasonably*

*high degree* to ‘aftershave’ (Category 7 in the table under paragraph [47])

- iii. ‘Preparations for shaving purposes and aftershaves’ are *identical* to ‘aftershave’ (Category 8 in the table under paragraph [47]); and
- iv. ‘Headgear; shoes, in particular beach shoes, clothing’ are *identical* to ‘clothing’ (Category 10 in the table under paragraph [47]).

21. The Hearing Officer then went on to consider whether the marks in question were similar. As a first step, he set out the legal test by which he must make the assessment, namely that he must assess the similarity “by reference to the visual, aural and conceptual similarities between the respective marks bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*, paragraph 23)”, and then set out certain key elements of the arguments that had been raised by each party:

49. MIP’s submissions focus on the differences between the marks created by the three lines either side of the box in its mark together with the presence of colour. Furthermore, it argues that the letter H that appears in both marks is low in inherent distinctiveness so making smaller differences more important and so making it easier for a distinction to be drawn between the two.

50. Hackett, on the other hand, argue that the additional lines on the side of the box in MIP’s mark are insufficient to assist in distinguishing and that even if they were noticed they play only a background role. It argues that colour does not assist in distinguishing and, in any event, Hackett’s mark being in black and white means that normal and fair use includes use in any colour. It adds that there is no real conceptual difference between the marks and that the marks would be pronounced the same, namely as “boxed H”/ “H in a box” or simply “H”.

22. The Hearing Officer analysed in turn the dominant and distinctive components of each mark, before conducting the usual visual, aural and conceptual comparison of the marks. He ultimately formed the view that the marks have “a good degree of visual similarity”, are “aurally identical” and “to the extent that there is any conceptual meaning associated with the respective marks, this is identical”. He concluded as follows:

59. The net effect of all this is that, overall, I consider there to be a reasonably high degree of similarity between the marks.

23. For the purpose of assessing whether there was a likelihood of confusion, the Hearing Officer first considered again the distinctiveness of the Earlier Mark, as the more distinctive it is, the greater the likelihood of confusion (*Sabel BV v Puma AG* [1998] R.P.C. 1999). His analysis focused on both inherent distinctiveness and acquired distinctiveness. He concluded that the Earlier Mark fell within the category of mark that, whilst distinctive, its distinctiveness lies at the lower end of the spectrum. Further, he did not consider that, on the evidence put before him, there

was any enhancement of distinctive character. Of particular note, in relation to inherent distinctiveness, he said:

61. ...The mark in question here falls, in my view, into the category of mark that whilst distinctive, its distinctiveness lies at the lower end of the spectrum. Whilst a mark does not have to be imaginative, invented, or fanciful to be regarded as distinctive per se, the inherent quality of the letter H does not strike me as one which would be regarded by the average consumer as being particularly distinctive – it is fairly unremarkable. Much of my reasoning has focused on the letter H, however, I stress that the mark as a whole has been considered (the assessment being made in relation to the goods in question) but I do not consider that the plain boarder (sic.) adds any significant distinctiveness.

24. In his assessment of likelihood of confusion, the Hearing Officer, again, began by setting out the relevant law, which is not disputed, and the position that each side was taking. He then set out his application of the law to the facts as he saw them. He said:

70. I will deal firstly with the goods that are identical or highly similar in categories 7, 8 & 10 namely aftershave (and other shaving preparations), perfuming products (including perfume and deodorant), and clothing. I have found the marks to be similar to a high degree but the earlier mark has only a low degree of distinctiveness. I must bear in mind the concept of imperfect recollection given that consumers rarely have the chance to make direct comparisons between trade marks but must instead rely on an imperfect picture of them he or she may keep in mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.*) The nature of the purchasing act is also important and I have already found that at least a reasonable degree of care and attention will be utilised and that the goods are often self-selected by the eye (particularly in relation to clothing purchases).

71. Having considered all these factors, my finding is that there is a likelihood of confusion. Although there is a visual difference between the marks, and although visual considerations have more importance here, the differences which exist are effectively in the borders of the respective marks and when considered against the concept of imperfect recollection, this means that the average consumer may mistake one mark for the other. Even though some of the goods are not identical, they are close enough, all things considered, to be confused. This is so, even though (in relation to perfume) that one is a ladies product whereas aftershave is for men. The closeness of purpose means that to the average consumer this will simply represent a different but associated (in an economic sense) product range. I have considered the argument that smaller differences may do more to distinguish when the shared elements are of only low distinctiveness. However my view that the shared elements represent the dominant and distinctive elements of the marks mitigates against this proposition.

25. The Hearing Officer then went on to find, on the same basis, there to be a likelihood of confusion in relation to the goods in his “category 1” (skin lotions and wider terms that would cover this product), particularly as he found the relevant goods to have a reasonable degree of similarity. However, he concluded that there would be no likelihood of confusion in relation to the categories of goods that he had

determined to be similar to only a low degree to the goods of the Earlier Mark. In particular, he said:

74. ... I have found the respective marks to be similar to a reasonably high degree. However, I have also found that the earlier mark only possesses a degree of distinctiveness at the lower end of the scale. A mark of a highly distinctive character is more likely to lead to a finding of confusion. This is an important point and applied to the case here is (sic.) strikes me that in circumstances where the respective goods are not sold side by side or even particularly close to each other, where the respective goods do not compete or complement (in the sense described by the case-law), and where the earlier mark has only a low degree of distinctiveness and memorableness, then the average consumer is unlikely, therefore, to be confused notwithstanding the reasonably high degree of similarity between the marks. In all these circumstances, the strong degree of similarity between the marks is not enough, having regard to all the relevant factors, to offset the low degree of similarity between the goods. Therefore, I find that there is no likelihood of confusion.

26. The Hearing Officer did not need to deal with those goods which he had determined were dissimilar, since section 5(2)(b) does not apply in such a case.
27. In conclusion, the Hearing Officer held that the Opposition under section 5(2)(b) succeeded in relation to the following goods of the IR:

**Class 3:** Preparations for body and beauty care; cosmetics; skin creams; lotions for cosmetic purposes; perfumery products, scents of any kind, in particular perfume, eau de perfume, eau de toilette, deodorants; preparations for shaving purposes and aftershaves.

**Class 25:** Headgear; shoes, in particular beach shoes, clothing.

### **Approach to this Appeal**

28. As the Applicant accepts, the role of the Appointed Person is to review the Decision, not to re-hear the case. I 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”: *REEF Trade Mark* [2002] EWCA Civ 763, [2003] RPC 5 at [28]. A decision does not contain an error of principle merely because it could have been better expressed.
29. Ms McFarland conceded in her arguments before me that the Applicant has not identified any error of law and cannot say that the Hearing Officer failed to look at the right case law or set out his quotations wrongly. However, she submitted that the Hearing Officer erred in the sense that, whilst he correctly identified the relevant case law, he failed to approach matters or apply the law in the proper way, particularly in relation to his examination of the similarity of marks. The Applicant relied on the guidance of Lindsay J in *Esure Insurance Ltd v Direct Line Insurance Plc* [2007] EWHC 1557 where he stated that: “an error of principle such as to justify or require departure from the decision...[occurs] ...where it is plain that no tribunal

properly instructing itself could, in the circumstances, have reasonably arrived at the conclusion that [the tribunal] reached”.

30. In this regard it is worth mentioning the guidance provided in two further cases. First, in *Galileo International Technology, LLC v European Union (formerly European Community)* [2011] EWHC 35 (Ch), a case which was not referred to by either party, but which I consider to be of assistance, Floyd J, concluded at [14]:

... unless I am satisfied that the Hearing Officer made an error of principle, I should be reluctant to interfere. I should interfere if I consider that his decision is clearly wrong, for example if I consider that he has drawn inferences which cannot properly be drawn, or has otherwise reached an unreasonable conclusion. I should not interfere if his decision is one which he was properly entitled to reach on the material before him.

31. Secondly, as noted by Mr Hollingworth in his skeleton argument and which I do not understand to be disputed by the Applicant, it was said in *English v Emery Reimbold & Strick Ltd* (and two other appeals heard with it) [2002] EWCA Civ 605, and further quoted in *REEF* at [29]:

... the judgment must enable the appellate court to understand why the judge reached his decision. This does not mean that every factor which weighed with the judge in his appraisal of the evidence has to be identified and explained. But the issues the resolution of which were vital to the judge's conclusion should be identified and the manner in which he resolved them explained. It is not possible to provide a template for this process. It need not involve a lengthy judgment. It does require the judge to identify and record those matters which were critical to his decision.

32. Mr Hollingworth, for the Opponent, also noted the principle set out in *In re B (A Minor) (Adoption: Natural Parent)* [2002] 1 WLR 258, stated to apply beyond cases relating to children and to include cases in which the evidence at first instance was in written form rather than oral, that:

... where no error occurred at first instance [an unsuccessful litigant] may [not] have a second trial of the same issue by different judges under the guise of an appeal. The mere fact that appellate judges might have reached a different conclusion had they been carrying out the evaluation and balancing exercise does not mean that the first instance judge fell in to error. That fact does not, of itself, require or entitle the Court of Appeal to intervene.

33. Further, I will also bear in mind the observation of Daniel Alexander QC (sitting as a Deputy High Court Judge) in *Digipos Store Solutions Group Ltd v Digi International Inc.* [2008] EWHC 3371 (Ch) at [6] that:

In the context of appeals from the Registrar relating to section 5(2)(b) of the Act, alleged errors that consist of wrongly assessing similarities between marks, attributing too much or too little discernment to the average consumer or giving too much or too little weight to certain factors in the multi-factorial global assessment are not errors of principle warranting interference.

## **Grounds of Appeal**

34. The Applicant raised numerous objections to the Hearing Officer's reasoning. These were initially set out by way of five subparagraphs in the Notice of appeal but were expanded upon in the Applicant's skeleton argument and in oral submission with somewhat different structure and emphasis. I will, where possible, follow the structure of the arguments as they appeared in the skeleton argument and were presented in the oral submissions. I have nevertheless taken account of all the grounds raised in the Notice of appeal, as well as considering all the authorities raised before me.
35. Broadly, the Applicant's objections focus on the following key aspects of the Decision: (1) similarity of marks and (2) conclusion of a likelihood of confusion. As an overall criticism, the Applicant submitted that "no reasonable person could have concluded as [the Hearing Officer] did on those parts of the Decision which are subject to this appeal". In particular, the Hearing Officer was wrong to characterise the marks under comparison as both being simply "Hs" or "Hs in a border".

### Similarity of marks

36. The Applicant argued that the Hearing Officer failed to:
- (1) afford proper weight to the colour and shading of the IR;
  - (2) properly assess each of the marks as a whole;
  - (3) give proper weight to the three thick bars which extend outwards from the sides of the square component of the IR in the analysis of the distinctive and dominant components of the IR; and
  - (4) properly apply the legal principles to the facts.

### Colour

37. The Applicant claims that the Hearing Officer was wrong to conclude that colour played no part in his considerations of the issues before him, and that this was an "erroneous over simplification of matters". The Applicant contends that the combination of colours and the effect of the layout of colours as part of the general design of the IR should not have been dismissed.
38. Ms McFarland summarised the Applicant's position in her skeleton, as follows: "the choice and layout of colours...creates an enhanced configuration and impacts on the degree to which each of the 3 elements of the mark in suit will be remarked upon and/or recollected by the eye/mind of the notional consumer." The "3 elements"

referred to were: (a) the H element; (b) the squared border line; and (c) the Wings. She further broke this down into two slightly different limbs:

(1) First, she submitted that the colour combinations of the IR had an impact upon the eye-appeal, look or other distinguishing feature of the mark as a whole. She said the mark will always appear as a highlighted letter on a slightly darker background with even darker bars or ‘wings’ and this shape configuration/visual impact would be preserved even when colour combinations per se are removed. In contrast, the Earlier Mark, no matter what colour it appeared in, would appear in the “conventional” manner, i.e. a darker representation on a light background.

(2) Secondly, even discounting colour, Ms McFarland argued that the different shading present in the IR means that there is an impact on the degree of the prominence (or lack of relative prominence) of the H element of the device.

39. The Hearing Officer dealt with colour relatively briefly in the Decision. He said, in paragraph 56 (excluding footnotes):

In terms of colour, Hackett’s mark (the protected earlier mark) is registered in respect of its shape and configuration, it is not registered with regard to colour. This means that any later mark, even if it has colour as an aspect of it, cannot escape a finding of identity or similarity based on the identity or similarity of the configuration between the respective marks. The issue of colour is, therefore, not relevant.

40. In concluding that the issue of colour was not relevant, the Hearing Officer referred to *Mary Quant Cosmetics Japan Ltd v. Able C&C Co Ltd* (BL O-246-08) [2011] RPC 4. Geoffrey Hobbs QC said in paragraph 10 of this judgment:

The present oppositions under 5(2)(b) are based on the rights conferred by registration of a device mark recorded in the register in black-and-white. It follows that colouring is immaterial to the distinctiveness of the opponent’s device mark as registered and therefore irrelevant for the purposes of the assessment of similarity in both oppositions.

41. In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (BL O-333-10) [2011] RPC 5, Geoffrey Hobbs QC confirmed his assessment that “registration in black-and-white provides protection unrelated to colour”.

42. Further, Kitchin LJ has more recently stated in *Specsavers International Healthcare Ltd & Others v Asda Stores Ltd* [2012] EWCA Civ 24 at [96] that:

A mark registered in black and white is, as this court explained in *Phones 4U* [2007] R.P.C. 5, registered in respect of all colours.

43. Mr Hollingworth drew my attention to a statement in paragraph 9 of *Mary Quant*, where Geoffrey Hobbs QC referred to the mark as having a “template or pattern”. As Mr Hollingworth submitted, provided that the template or pattern (or shape and configuration, to which Ms McFarland referred in her oral submissions) of the

Earlier Mark are not lost, the registration for the Earlier Mark covers the use of the mark in any other colours, including for example, a white box and a white H on, say, a green background.

44. This does not appear to be disputed by the Applicant. Ms McFarland said herself in her skeleton: “[the Earlier Mark] is protected whatever colours are used and so it could be used with the H in white and the border in light green with the background in light yellow ie; as a colour replica of the mark in suit”.
45. Accordingly, I am not persuaded by the Applicant’s arguments in relation to the colour or shading of the marks being compared and I do not consider that the Hearing Officer erred in his judgment on this issue.

*Assessment of the marks as a whole*

46. The Applicant’s criticisms of the way in which the Hearing Officer assessed the marks for similarity can be consolidated into the following two key issues:
- (1) The Applicant contends that the Hearing Officer appeared on the one hand to accept the Opponent’s own description of its mark as a “boxed H” and to adopt it as a description of the Earlier Mark in a large number of places in his judgment, but then on the other hand, to disregard this description when making his assessment of similarity, instead seeming to focus simply on two H marks.
  - (2) The Applicant argues that the Hearing Officer gave insufficient regard to the three elements that make up the IR, namely the H element, the squared border line and the three wings extending horizontally from the sides of the border (the “wing element”), which, when assessing the IR as a whole, should have been given due deliberation and description. Most notably, Ms McFarland suggests greater weight should have been given to the wing element of the mark. For example, in her skeleton, Ms McFarland explains that whilst the Hearing Officer said, in paragraph 56 of the Decision, that the wing element would be noted on a side by side comparison, she says he misdirected himself to wrongly conclude that: (a) any noticeable difference would not impact on “imperfect recollection”; (b) the side by side comparison was the limited and **only circumstances** in which the elements would be noted; and (c) “The lines are only part of the border of the mark”.
47. The Applicant argues that these failings impact on each of the visual, aural and conceptual analysis of the marks in suit.
48. This is what the Hearing Officer actually said about the two marks (excluding footnotes):

49. MIP's submissions focus on the differences between the marks created by the three lines either side of the box in its mark together with the presence of colour. Furthermore, it argues that the letter H that appears in both marks is low in inherent distinctiveness so making smaller differences more important and so making it easier for a distinction to be drawn between the two.

50. Hackett, on the other hand, argue that the additional lines on the side of the box in MIP's mark are insufficient to assist in distinguishing and that even if they were noticed they play only a background role. It argues that colour does not assist in distinguishing and, in any event, Hackett's mark being in black and white means that normal and fair use includes use in any colour. It adds that there is no real conceptual difference between the marks and that the marks would be pronounced the same, namely as "boxed H"/ "H in a box" or simply "H".

51. I must bear in mind the distinctive and dominant components of the marks. From a pure dominance perspective it seems to me that the dominant element in both marks is the letter H. It is certainly the element that is most likely to be focused upon in Hackett's mark given that the square border is fairly unremarkable. In MIP's mark, whilst the additional lines either side of the square do contribute to the mark's impact, the letter H is, at the very least, one of its dominant elements (I would say the most dominant element). The case-law, though, talks of the dominant and distinctive elements of a mark. This is relevant here in view of MIP's arguments regarding the distinctiveness of the letter H. In this regard, MIP highlights a number of marks on the register for stylized letter Hs and it also highlights the following extract from the registrar's examination practice on single letter marks:

"Where a letter is not distinctive, a plain rectangular or oval border is unlikely to make the mark distinctive. However, a fancy or unusual border may be enough. Colour may also assist in providing the mark as a whole with the necessary power to individualise the goods/services of one undertaking."

52. I do not feel it necessary to say too much about the state of the register evidence. It has been held on a number of occasions that this is irrelevant. In relation to the registrar's practice set out above, I note that the extract refers to letters which have been determined as being non-distinctive, not that all single letters are necessarily non-distinctive. Indeed, in the preceding paragraph of the examination practice it is stated that:

"There is no bar to the acceptance of single letters as trade marks. Each case must be considered individually".

53. The above is consistent with the judgment of the CFI in Case T-23/07, *BORCO-Marken-Import Matthiesen GmbH & Co. KG v OHIM* where it was stated:

"45. The refusal, as a matter of definition, to accept that single letters can have any distinctive character, stated without reservation and without undertaking the examination based on the facts, mentioned in paragraph 39 above, is contrary to the wording of Article 4 of Regulation No 40/94, which ranks letters as being among the signs, capable of being represented graphically, of which a mark may consist, provided that such signs are capable of distinguishing the goods and services of one undertaking from those of other undertakings."

and

“52. The Board of Appeal was not therefore entitled to rely, as against the registration of the letter ‘α’, on the argument relating to the availability of signs, since that argument in no way precludes the need for an examination as to whether, on the facts, the sign at issue is capable of identifying the product or service in respect of which registration is sought as originating from a particular undertaking and of distinguishing that product or service from those of other undertakings.”

54. There can be no automatic rejection of single letters possessing distinctive character. Nor can the limited availability of letters be a significant factor. The matter must be assessed on its own merits. There is no evidence of fact as to why the letter H will not distinguish or why it would not be seen as a distinctive element of the mark. As far as I am aware, it is not a letter which has any meaning or even a suggestive quality in relation to any of the goods of either mark. I note from the registrar’s examination practice that the letter H is given as an example of a non-distinctive letter in relation to footwear because this letter is a width fitting – however, MIP have not even argued this point let alone filed any evidence to support it. The letter H as a width fitting is not, in my view, a notorious fact of which I can take account. In my view, the average consumer will attach distinctiveness (in a trade origin sense) to the letter H that appears in each of the respective marks. I do not say that it has the strongest or highest degree of inherent distinctiveness, but it is distinctive none the less.

55. This leads me to the view that the letter H, as represented in each of the marks, forms one of the dominant and distinctive elements in the marks, indeed, it is likely to be seen as the most dominant and distinctive element. In any event, the degree of similarity is not increased or decreased by the distinctive character of elements in a mark. It is still, though, a whole mark comparison which must be made as I do not consider that the other elements would be completely negligible (in the terms set out in *Shaker di L. Laudato & Co. Sas*) in the overall impression that they convey.

49. The Hearing Officer went on to conclude that there was a reasonably high degree of similarity between the marks. In doing so, he looked at each of the visual, aural and conceptual similarities in turn. In relation to visual similarity, he concluded (excluding footnotes):

56. In terms of the visual similarity between the marks, it is clear that both contain a prominent letter H. The letter is presented in a very similar (although unremarkable) font – the plainness of the letter is shared. Both marks have a square or rectangular border which presents a further point of similarity – both marks, therefore, contain a boxed H. There is a clear point of difference though given that MIP’s mark has three thick lines either side of its rectangular box. This will certainly be noticed on a side by side comparison. Although not negligible, the additional lines are only part of the border of the mark and the concept of imperfect recollection may have a role to play here (I will return to this). In terms of colour, Hackett’s mark (the protected earlier mark) is registered in respect of its shape and configuration, it is not registered with regard to colour. This means that any later mark, even if it has colour as an aspect of it, cannot escape a finding of identity or similarity based on the identity or similarity of the configuration between the respective marks. The issue of colour is, therefore, not relevant. In my view, the differences between the marks are insufficient, from a visual perspective, to counterbalance the similarities. I view the marks as having a good deal of visual similarity.

50. The Hearing Officer does make numerous references to the Earlier Mark as a ‘boxed H’. However, I do not consider that he simply disregarded this description, or the boxed element of the IR, when making his assessment of similarity between the two marks. He does not say that the Earlier Mark is simply an H, nor, in my opinion, is it implicit in his judgment that this is the basis of his decision. Instead, in paragraph 51 of the Decision, the Hearing Officer makes it clear that he considers the dominant element in both marks to be the letter H. He goes on to explain that the H is “the element that is most likely to be focused upon in Hackett’s mark given that the square border is fairly unremarkable”. In relation to the IR, he says, in paragraph 55, that “a whole mark comparison” must be made, and that he does not consider that the other elements (i.e. the squared border line or the wing element) would be completely negligible in the overall impression that they convey. It is quite clear in his conclusion on visual similarity in paragraph 56 that he is not assessing the marks on the basis that they are simply two H marks.
51. In relation to the Applicant’s second argument, the Hearing Office was clearly aware of the weight the Applicant wanted him to place on the wing elements of the IR in making his assessment. He notes this in paragraph 49 of his Decision. Further, it is clear that the Hearing Officer went on to consider the IR as a whole, including the three aspects focused on by the Applicant. In paragraph 56, he notes that both marks have a square or rectangular border and expressly highlights the wing element of the IR as a “clear point of difference” between the marks, and one that would “certainly be noticed on a side by side comparison”. He then comments, again, that this difference is “not negligible”, but goes on to hold that this difference would not prevent the conclusion that the average consumer may mistake one mark for the other due to the concept of imperfect recollection. I am therefore not persuaded by this argument either.
52. It is true that the Hearing Officer does say that the wing element of the IR is “only part of the border of the mark”. However, this statement should not be taken out of context. In the context of the whole of paragraph 56, and the analysis in the paragraphs preceding it, this statement does not establish that the Hearing Officer gave the wing element of the IR insufficient weight, or was a reason in itself as to why he found the marks to be similar.
53. In relation to the Hearing Officer’s conclusion that any noticeable difference would not impact on “imperfect recollection”, another key criticism from the Applicant is that, having raised the role of imperfect recollection in paragraph 56, the Hearing Officer did not return to give it proper prominence, which he ought to have done. However, I consider this argument to be unfounded. The Hearing Officer did return to explain the concept in paragraphs 70 and 71. He explained:

70. ... I have found the marks to be similar to a high degree but the earlier mark has only a low degree of distinctiveness. I must bear in mind the concept of imperfect recollection given that consumers rarely have the chance to make direct comparisons between trade marks but must instead rely on an imperfect picture of them he or she may keep in mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.*) The nature of the purchasing act is also important and I have already found that at least a reasonable degree of care and attention will be utilised and that the goods are often self-selected by the eye (particularly in relation to clothing purchases).

71. Having considered all these factors, my finding is that there is a likelihood of confusion. Although there is a visual difference between the marks, and although visual considerations have more importance here, the differences which exist are effectively in the borders of the respective marks and when considered against the concept of imperfect recollection, this means that the average consumer may mistake one mark for the other. ...

54. In relation to aural similarity, the Hearing Officer concluded:

57. From an aural perspective, I consider it unlikely that the average consumer will attempt to pronounce the marks beyond the letter H. I consider the marks to be aurally identical.

55. The Applicant submits that, as a result of the key criticisms mentioned above, the Hearing Officer should have concluded that the average consumer, if asked to describe the two marks would have described each of them differently. Ms McFarland said at paragraph 19 of her skeleton, in relation to the Earlier Mark, that the average consumer may describe it as a “Boxed H logo” or he or she could also say something like “An H in a Square”, “A block capital H in a Box” or “a letter H inside a black line border” or some similar wording”. In contrast, in relation to the IR, the expected response could/would be along the lines of “An H in a square with horizontal arms either side” or “a box with flashes or three stripes and an H inside” or “the letter H in capitals with some sort of wings either side”.

56. However, these submissions muddle the distinction between the visual, aural and conceptual similarities of the marks under comparison.

57. Mr Hollingworth drew my attention to Case T-424/10 *Dosenbach-Oschner AG v OHIM*, which concerned marks comprising pictures of elephants without any verbal elements. In paragraph 46 of this case, the General Court said:

A figurative mark without word elements cannot, by definition, be pronounced. At the very most, its visual or conceptual content can be described orally. Such a description, however, necessarily coincides with either the visual perception or the conceptual perception of the mark in question. Consequently, it is not necessary to examine separately the phonetic perception of a figurative mark lacking word elements and to compare it with the phonetic perception of other marks.

58. I agree. Consideration of the aural characteristics of a trade mark does not entail considering how it would be described, but how it would be heard, which is only a relevant factor if it is capable of being spoken. A purely pictorial mark is intended to

be viewed rather than heard, and thus there is no aural attribute to be considered. A mark comprising a combination of letters or words and figurative elements will usually be capable of being spoken and thus heard. If the average consumer is likely to hear the mark when used in trade, its aural attributes must be taken into account when considering similarity in the context of the test of likelihood of confusion. However, the aural characteristic of such a mark will usually play a lesser role than the visual and conceptual characteristics, given that a combined word and figurative mark is generally intended to have more of an impact on the eye and the mind than on the ear.

59. Both parties' marks in this case are what would commonly be described as logos. They both contain the letter 'H', which is liable to be spoken by the reader/trader and heard by the listener/consumer, and would be pronounced identically for both marks. I agree with the Hearing Officer's assessment that the marks are aurally identical.
60. The fact that the Hearing Officer, and the Opponent itself, referred to the Earlier Mark as a "boxed H" is not inconsistent with this conclusion, as suggested by the Applicant. In my opinion the Hearing Officer used the term "boxed H" as a way of identifying the Earlier Mark, probably following the use of this term by Mr Owens in his evidence for the Opponent. This was not intended as an indication of how the average consumer would perceive the mark from an aural perspective.
61. By way of comparison, I note that in Case T-115/02 *Avex Inc v OHIM*, which concerned an application for a mark consisting of a white letter "a" depicted in a solid black oval which was opposed on the basis of a prior registration for a mark consisting of a white letter "a" depicted in a solid black square, the Court of First Instance said, in relation to the aural (and conceptual) comparison, that "the signs are, from those points of view, clearly identical". There was no suggestion, nor did the court consider, in this case that the fact that the letters appeared in a black oval and a black square respectively should have any bearing on the aural assessment.
62. Moving on to the conceptual analysis, the Hearing Officer concluded that:
58. In terms of conceptual similarity, there is no specific meaning beyond the presence of the letter H. Nevertheless, this does give both marks a conceptual (and shared) hook which will form part of the cue that the average consumer stores away for future recall. Therefore, to the extent that there is any conceptual meaning associated with the respective marks, this is identical.
63. The Applicant submits that the concept or idea of the IR would be intrinsically linked with the wing element of the mark, reminding the average consumer of a pilot-, airforce-, or "Thunderbirds-" style logo. This criticism is not based on any alleged misapplication of the law. The Hearing Officer has demonstrated in the

preceding paragraphs that he considers the wing-element to be a “clear point of difference” between the marks and he will have been aware of this factor when making the conceptual comparison. Whilst it is possible that some consumers may be reminded of a ‘badge’ or ‘pilot wings’, others may not. I consider he was entitled to come to the decision that he did, and in the absence of a discernible error, I do not propose to substitute another view, and indeed my own does not differ.

64. In summary, I am not persuaded that the arguments put forward by the Applicant are good grounds for reversing the Hearing Officer’s decision on similarity of marks. The Hearing Officer has considerable experience in the application of *Sabel v Puma* to different pairs of marks in factual scenarios and so cannot be assumed to have done so incorrectly without some stronger indication that an error has occurred.

*Distinctive and dominant components of the IR*

65. In the Notice of appeal, the Applicant raised a separate criticism of the Hearing Officer for not attributing enough significance to the wing element of the IR when assessing its distinctive and dominant components. Instead the Hearing Officer is said to have analysed the Earlier Mark and simply concluded that the IR had the same distinctive and dominant elements.

66. I have already dealt with this point in the discussion of the objections to the analysis of similarity between the marks. In short, it is plain from paragraphs 51 to 55 of the Decision (set out above) that the Hearing Officer considered the wing element of the IR in his assessment of the marks. His assessment of the Earlier Mark was both reasoned and reasonable. Accordingly, I reject this ground of appeal.

*Application of the legal principles to the facts*

67. The Applicant contends that the Hearing Officer purported to follow the applicable legal principles, but in reality paid only “lip service” to them and did not properly apply the law to the facts.

68. In her skeleton argument, Ms McFarland suggested the following, in particular:

- (1) the Hearing Officer failed to correctly apply the principle that any degree of visual dissimilarity may play a more significant role than oral dissimilarity in the assessment of likely confusion where the goods in question are usually self-selected by the consumer;
- (2) the Hearing Officer failed to correctly apply the principle that the whole mark must be compared and that all elements must be taken into proper account in assessing the overall impression they convey; and

(3) no one could legitimately describe the wing element of the IR as “only” being part of the border on any reasonable analysis.

69. In oral submission, Ms McFarland suggested, somewhat more broadly, that the decision was perverse, particularly in the way that the Hearing Officer described, defined and analysed the IR.

70. The second and third specific criticisms above are simply re-statements of grounds of appeal that I have already dealt with and rejected. As to the first, which appears to be a suggestion that the Hearing Officer took too much account of the oral identity of the marks and too little account of the visual differences between them, I do not think that is what he did. He correctly considered each of the visual, aural and conceptual similarities and differences in turn and then reached a conclusion based on his overall assessment of the two marks. Then, when assessing the likelihood of confusion, he took particular account (at paragraph 70) of the fact that the goods concerned are often self-selected by the eye and (at paragraph 71) that “visual considerations have more importance” in this case – as he had previously identified at paragraph 40.

71. In my opinion the Decision is set out clearly. The Hearing Officer has considerable experience in applying the relevant law to a variety of factual scenarios and clearly knew that he had to do so in the light of the factual scenario in front of him. I believe that he did so properly. Whilst, I accept that different people may view the two marks concerned in different ways, I consider the Hearing Officer was entitled to come to the decision that he did, and further, that he was correct to do so. For the reasons I have given elsewhere in this judgment in relation to the more specific objections, I do not consider the Hearing Officer to have come to an unreasonable or improper conclusion. I therefore reject this ground of appeal.

#### Likelihood of Confusion

72. The Applicant argued that, as a result of the Hearing Officer’s failure to give proper weight to the differences between the Earlier Mark and the IR, he erred in his conclusion that there is a likelihood of confusion between the two marks. For the reasons given above, the Applicant has failed to persuade me that the Hearing Officer gave incorrect weight to the differences between the marks, such that I should overturn his decision on similarity. Accordingly, I reject this ground of appeal as well.

73. The Applicant also claimed (in the Notice of Appeal, but not in the skeleton or oral argument) that, as a result of the Hearing Officer’s error in identifying the distinctive and dominant elements of the IR, the Hearing Officer erroneously dismissed the argument that smaller differences may do more to distinguish when the shared

elements of the marks are of only low distinctiveness. Again, the Applicant has not persuaded me that the Hearing Officer made any error in his analysis, so this argument also fails.

*Dopat SA v TODs SPA and Avex Inc v OHIM*

74. Ms McFarland drew my attention to *Dopat, S.A. v TOD'S S.p.A.* (OHIM Opposition Division decision dated 14 September 2011 on opposition number B1 363 722) on the basis that the facts were similar, involving a comparison of two figurative 'H' marks, and so may provide me with some persuasive assistance. She acknowledged that the decision is not binding on me, and would not have been binding on the Hearing Officer either.
75. Mr Hollingworth, on the other hand argued that the case is of no assistance, being a first instance decision in relation to different marks to those in issue here, and urged me instead to have regard to *Avex Inc v OHIM* (referred to at paragraph 61 above) if I wanted to use another case as a comparator.
76. The Applicant is not contending in this appeal that the Hearing Officer got the law wrong. Instead, this appeal is, in the main, based on the contention that the Hearing Officer failed to apply the law to the facts correctly, or gave insufficient weight to certain facts, in his assessment of the similarity of the marks. This criticism is therefore clearly very fact specific. I do not find either of the cases put before me to be particularly helpful on this point, and neither provides any basis for changing the decision I have reached and set out above.

**Conclusion**

77. In conclusion, I reject the Applicant's appeal in its entirety, and uphold the Hearing Officer's decision that opposition no. 71427 by Hackett Ltd succeeds in relation to the following goods:

**Class 3:** Preparations for body and beauty care; cosmetics; skin creams; lotions for cosmetic purposes; perfumery products, scents of any kind, in particular perfume, eau de perfume, eau de toilette, deodorants; preparations for shaving purposes and aftershaves.

**Class 25:** Headgear; shoes, in particular beach shoes, clothing.

78. The Applicant's appeal having failed, I shall leave the Hearing Officer's decision as to costs in place, to the effect that neither party has to make a contribution to the other in respect of the first instance proceedings.
79. So far as the appeal is concerned, having been successful, the Opponent is entitled to a contribution to its costs, which include the costs relating to the Case Management Conference held on 19 September 2012, which I reserved to be dealt with at the end

of the appeal. Bearing in mind the arguments presented, the representation by solicitors at the Case Management Conference, and the appearance by Counsel at the appeal hearing, I order the Applicant to pay a contribution to the Opponent's appeal costs of £1,500. This sum will be payable within 14 days of the Applicant receiving notice of this decision.



ANNA CARBONI

31 May 2013

The Applicant (Appellant) was represented by Counsel, Ms Denise McFarland, instructed by Marks & Clerk Solicitors LLP.

The Opponent (Respondent) was represented by Counsel, Mr Guy Hollingworth, instructed by Nabarro.