

**O-248-18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 3202679**

**BY CLEOPATRA PARTNERS LIMITED**

**TO REGISTER THE TRADE MARK**

**CLEOPATRA**

**IN CLASSES 3, 9, 14, 16, 25, 26, 35, 38 & 41**

**AND**

**IN THE MATTER OF OPPOSITIONS**

**THERE TO UNDER No. 408922 & 408923 BY**

**MR NABIL BAKIR**

## BACKGROUND

1) On 16 December 2016, Cleopatra Partners Limited (hereinafter the applicant) applied to register the trade mark CLEOPATRA in respect of the following goods and services:

Class 3: Perfumery; essential oils; cosmetics; make-up; eye make-up; eyeliners; blushers; lipsticks; hair lotions; soaps.

Class 9: Computer hardware; computer software; computer peripherals; electronic data processing equipment; computer networking and data communications equipment; computer components and parts; electronic memory devices; electronic control apparatus; programmed-data-carrying electronic circuits; wires for communication; electrodes; telephones; aerials; batteries; micro processors; keyboards.

Class 14: Precious metals; precious stones; chronometric instruments.

Class 16: Paper; cardboard; printed publications and printed matter relating to technology; computer printers (Inking ribbons for -); bookbinding materials; adhesives for stationery or household purposes; artists' paint brushes; music sheets; music scores; periodical magazines; photographs; stationery and educational supplies; typewriters; Instructional and teaching material (except apparatus); plastic materials for packaging; printing blocks.

Class 25: Clothing; footwear; headgear; swimwear; sportswear; leisurewear.

Class 26: Lace; embroidery; ribbons; braid; buttons; hooks and eyes; pins; needles; artificial flowers.

Class 35: Provision of information and advice to consumers regarding the selection of products and items to be purchased; exhibitions for commercial or advertising purposes; arranging of exhibitions for commercial purposes; demonstration of goods for promotional purposes; Publicity and sales promotion services; provision of business and commercial information; business consultancy services; assistance and advice regarding business organization and management; advertising; advertising particularly services for the promotion of goods; arranging of contracts for the purchase and sale of goods and services, for others; market research and marketing studies; compilation of computer databases; office functions; risk management consultancy

[business]; employment agency services; personnel recruitment services; temporary personnel employment services; placement of permanent personnel.

Class 38: Telecommunication services; communication services for the electronic transmission of voices; transmission of data; electronic transmission of images, photographs, graphic images and illustrations over a global computer network; transmission of data, audio, video and multimedia files; simulcasting broadcast television over global communication networks, the Internet and wireless networks; provision of telecommunication access to video and audio content provided via an online video-on-demand service; satellite communication services; telecommunications gateway services.

Class 41: Film distribution; arranging and conducting of congresses.

2) The application was examined and accepted, and subsequently published for opposition purposes on 24 February 2017 in Trade Marks Journal No.2017/008.

3) On 3 April 2017 Mr Nabil Bakir (hereinafter the opponent) filed two notices of opposition, subsequently amended. The opponent is the proprietor of the following trade marks:

Mark	Number	Dates of filing and registration	Class	Specification relied upon
cleopatra	2588350	19.07.11 09.11.12	38	Telecommunications services; chat room services; portal services; e-mail services; providing user access to the Internet; radio and television broadcasting.
cleopatra	11903671	17.06.13 03.10.13	25	Clothing, footwear, headgear.

a) The opponent contends that the mark applied for and his two marks are identical and the respective goods and services are identical and/or similar. As such he contends that the application offends against Section 5(2)(a) of the Act.

4) On 4 July 2017 the applicant filed counterstatements, which accepted that the marks of the two parties are visually, phonetically and conceptually identical. In respect of the class 25 goods the

applicant accepts that there are some similarities in the specifications of the two parties, but states that “simply because common language is used in the list of goods and services specified does not suffice in and of itself to indicate that the goods and services provided to the public are identical”. With regard to the services in class 38 it accepts that “there are some similarities in the specifications of the two marks” and also that “the services listed in class 38 are broadly similar as they concern telecommunication services”. However, the applicant denies that there is a likelihood of confusion as the services are different. The applicant put the opponent to proof of use.

5) Both parties seek an award of costs in their favour. Neither party filed evidence or wished to be heard. Both parties provided written submissions in their counterstatements or separately which I shall refer to as and when necessary in my decision.

## **DECISION**

6) The only ground of opposition is under section 5(2)(a) which reads:

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

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

(b) .....

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

7) An “earlier trade mark” is defined in section 6, the relevant part of which states:

“6.-(1) In this Act an "earlier trade mark" means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark

in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

8) The opponent is relying upon its trade marks listed in paragraph 3 above which are clearly earlier filed trade marks. Although the applicant sought proof of use (pou), the interplay between the dates of the instant mark being published and the opponent’s marks being registered mean that the pou requirements do not bite as at the point of the instant mark being advertised the opponent’s marks had not been registered for five years. The opponent is therefore able to rely on the specifications of the earlier marks without having to show genuine use.

9) When considering the issue under section 5(2)(a) I take into account the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

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

negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

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

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

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

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

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

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

10) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods/services. I must then determine the manner in which these goods/services are likely to be selected by the average consumer in the course of trade.

11) I shall first consider the goods at class 25 which are, broadly speaking, clothing, footwear and headgear. The average consumer for such goods will be the public at large. Such goods will typically be offered for sale in retail outlets, in brochures and catalogues as well as on the internet. The initial

selection is therefore primarily visual. I accept that more expensive items of clothing, footwear and headgear may, for example, be researched or discussed with a member of staff or be made to measure. The latter, along with personal recommendations, bring aural considerations into play. I note that in *New Look Ltd v OHIM Cases T-117/03 to T-119/03 and T-171/03*, the General Court (GC) said this about the selection of clothing:

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

12) In the same case the Court also commented upon the degree of care the average consumer will take when selecting clothing. It said:

“43. It should be noted in this regard that the average consumer’s level of attention may vary according to the category of goods or services in question (see, by analogy, Case C 342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26). As OHIM rightly pointed out, an applicant cannot simply assert that in a particular sector the consumer is particularly attentive to trade marks without supporting that claim with facts or evidence. As regards the clothing sector, the Court finds it comprises goods which vary widely in quality and price. Whilst it is possible that the consumer is more attentive to the choice of mark where he or she buys a particularly expensive item of clothing, such an approach on the part of the consumer cannot be presumed without evidence with regard to all goods in that sector. It follows that that argument must be rejected.”

13) Clearly, the average consumer’s level of attention will vary considerably depending on the cost and nature of the item at issue. However, to my mind even when selecting routine inexpensive items of clothing/footwear/headgear such as socks/slippers/caps the average consumer will pay attention to considerations such as size, colour, fabric and cost. **Overall the average consumer for these types of goods is likely to pay an average degree of attention to the selection of items of clothing, footwear and headgear.**

14) Turning to the services in class 38, these are, broadly speaking, telecommunication and broadcasting services. To my mind, the average consumer for these services would be the general public, including businesses. Such services would be sold in a wide variety of ways such as retail outlets, via the internet, via telesales or face to face. However, it is likely that the initial selection will be a visual one as it is most likely to be viewed on-line or via advertising, although I must also take into account word of mouth recommendations, and telesales. Therefore, whilst I consider the visual aspect as being the most important in selection, aural considerations also apply. The prices of the services will vary enormously as will the level of attention which the average consumer will pay to the selection, **but to my mind the average consumer for these types of services is likely to pay at least an average degree of attention to the selection of such services.**

15) I have decided not to deal with the average consumers for the goods and services applied for in classes 3, 9, 14, 16, 26, 35 & 41 for reasons which will become apparent later.

### **Comparison of goods and services**

16) When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*, the CJEU stated at paragraph 23 of its judgement:

“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”.

17) Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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.

18) In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question”.

19) In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) OHIM*) case T-133/05, the General Court (“GC”) stated:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T110/01 *Vedial V OHIM*

France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

20) I note that in its counterstatement the applicant stated that ““simply because common language is used in the list of goods and services specified does not suffice in and of itself to indicate that the goods and services provided to the public are identical” and then claimed that if the actual goods/services provided are different then this has to be taken into account. As the applicant did not file any evidence all I have to compare are the specifications.

21) I shall first compare both sides’ class 25 specifications, which are as follows:

Opponent’s goods	Applicant’s goods
Clothing, footwear, headgear.	Clothing; footwear; headgear; swimwear; sportswear; leisurewear

22) Clearly both specifications share the same words “clothing; footwear; headgear”. The balance of the opponent’s specification (swimwear; sportswear; leisurewear) would be encompassed by the terms in the opponent’s specification. **The class 25 goods of the two parties are identical.**

23) I next turn to the class 38 services of the two parties, which for ease of reference are set out below.

Opponent’s services	Applicant’s services
Telecommunications services; chat room services; portal services; e-mail services; providing user access to the Internet; radio and television broadcasting.	Telecommunication services; communication services for the electronic transmission of voices; transmission of data; electronic transmission of images, photographs, graphic images and illustrations over a global computer network; transmission of data, audio, video and multimedia files; simulcasting broadcast television over global communication networks, the Internet and wireless networks; provision of telecommunication access to video and audio content provided via an online video-on-demand service; satellite communication services; telecommunications gateway services.

24) I note that the applicant accepts that the services are broadly similar. The term “telecommunications services” in the opponent’s specification is identical to the same term in the

applicant's specification and also, to my mind, encompasses the whole of the opponent's specification. However, it is also clear that the terms "radio and television broadcasting" in the opponent's specification wholly encompasses the following of the applicant's services "communication services for the electronic transmission of voices; transmission of data; electronic transmission of images, photographs, graphic images and illustrations over a global computer network; transmission of data, audio, video and multimedia files; simulcasting broadcast television over global communication networks, the Internet and wireless networks; provision of telecommunication access to video and audio content provided via an online video-on-demand service; satellite communication services" and as such these are identical. **The services of the two parties in class 38 are identical.**

25) When comparing the opponent's class 25 & 38 goods and services to the applicant's goods and services in classes 3, 9, 14, 16, 26, 35 & 41 I take into account the comments in *Commercy AG, v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-316/07, where the General Court pointed out that:

"43. Consequently, for the purposes of applying Article 8(1)(b) of Regulation No 40/94, it is still necessary, even where the two marks are identical, to adduce evidence of similarity between the goods or services covered by them (see, to that effect, order of 9 March 2007 in Case C-196/06 P *Alecansan v OHIM*, not published in the ECR, paragraph 24; and Case T-150/04 *Mülhens v OHIM – Minoronzoni(TOSCA BLU)* [2007] ECR II-2353, paragraph 27)."

26) Thus where the similarity between the respective goods or services is not self-evident, the opponent must show how, and in which respects, they are similar. The opponent has made no submissions regarding why these goods and services should be regarded as similar, and to my mind they are not similar. I therefore take into account the views expressed in *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, where Lady Justice Arden stated that:

"49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

27) **The oppositions under section 5(2)(a) cannot succeed in respect of the goods and services applied for in classes 3, 9, 14, 16, 26, 35 & 41.**

### **Comparison of trade marks**

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

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

29) The marks of the two parties both consist of the word “cleopatra” written in lower (both opponent’s marks) and upper (applicant’s mark) case. The difference in terms of case is unimportant as it falls within what would be considered to be fair and normal use of a mark. In its counterstatement the applicant accepted that the marks of the two parties are visually, phonetically and conceptually identical. **I therefore find that the marks are identical.**

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

30) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-

108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

31) The word “Cleopatra” has no meaning for either the class 25 goods or class 38 services in this case. The opponent has not filed any evidence of use. **I find that both the opponent’s marks have an average degree of distinctiveness but cannot benefit from enhanced distinctiveness through use.**

### **Likelihood of confusion**

32) In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent’s trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision, I concluded that:

- the average consumer is a member of the general public (including businesses), who will select the goods and services by predominantly visual means, although not discounting aural considerations and that they will pay at least an average degree of attention to the selection of such goods and services.

- the opponent's marks have an average degree of inherent distinctiveness, but cannot benefit from an enhanced distinctiveness through use.
- The mark in suit is identical to both of the opponent's marks.
- The class 25 goods and class 38 services of the two parties are identical.

33) In view of the above, in respect of both the opponent's marks there is a likelihood of consumers being confused into believing that any of the class 25 goods and class 38 services applied for under the mark in suit and provided by the applicant are those of the opponent or provided by some undertaking linked to it. **The oppositions under Section 5(2) (a) in respect of these goods and services succeeds.**

## **CONCLUSION**

34) The oppositions under Section 5(2)(a) were successful in relation to all the goods and services sought to be registered in classes 25 & 38.

35) The goods and services applied for in classes 3, 9, 14, 16, 26, 35 and 41 are not similar to the opponent's goods and services (see paragraphs 25-27 above) and so the oppositions under section 5(2)(a) failed.

## **COSTS**

36) The opponent has been partly successful and would normally be entitled to a contribution towards his costs. However, as the opponent is not professionally represented he was sent a pro-forma inviting him to set out the number of hours spent on the different stages of these oppositions. The opponent was informed that no award of costs would be made unless it completed the pro-forma. The pro-forma was not returned. I take this to mean that the opponent has not made an application for costs. Consequently, I direct that each side should bear its own costs.

**Dated this 23<sup>rd</sup> day of April 2018**

**George W Salthouse**  
**For the Registrar,**  
**the Comptroller-General**