

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2543782  
IN THE NAME OF MOOD CLOTHING CONCESSIONS LIMITED**

**AND IN THE MATTER OF JOINT OPPOSITION THERETO UNDER No. 100823  
BY PEEK & CLOPPENBURG KG AND CBM CREATIVE BRANDS MARKEN  
GMBH**

**AND IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON  
BY THE OPPONENT  
AGAINST A DECISION OF MR DAVID LANDAU  
DATED 4 AUGUST 2012**

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**DECISION**

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**Introduction**

1. This is an appeal against a decision of Mr. David Landau (BL O/269/11) acting for the Registrar, dated 4 August 2011, in which he rejected a joint opposition under number 100823 brought by Peek & Cloppenburg KG and CBM Creative Brands Marken GmbH against the registration of Application number 2543782 in the name of Mood Clothing Concessions Limited.
2. Mr. Landau referred to the joint opponents as “Peek” and the applicant as “Mood” and I shall do the same in this decision.
3. On 1 April 2010, Mood applied to register the designation PREVIEW for use as a trade mark in the UK in relation to the following goods:  
  
Class 25  
Articles of clothing; articles of outer clothing; articles of ladies clothing; blouses, shirts, trousers, slacks, skirts, jumpers, cardigans, pullovers, jackets and coats.
4. Following publication, the Application was opposed by Peek on 11 August 2010.
5. The ground of opposition was under Section 5(2)(b) of the Trade Marks Act 1994 that, because PREVIEW was similar to Peek’s earlier trade marks and to be registered for identical or similar goods, there existed a likelihood of confusion on the part of the public, which included the likelihood of association with the earlier trade marks.

6. For the purposes of Section 5(2)(b), Peek relied upon two earlier trade marks:
- (1) Community Trade Mark (“CTM”) number 000284307 for the designation Review registered on 15 February 2001 in respect of clothing in Class 25.<sup>1</sup>
  - (2) CTM number 005694377 registered on 28 January 2008 in respect of clothing, footwear and headgear in Class 25 as represented below:



### **The Hearing Officer’s decision**

7. In brief the Hearing Officer decided as follows:
- (1) The average consumer for the goods was the public at large who were reasonably well informed and reasonably circumspect and observant. The goods would vary widely in price and quality so that across their gamut the purchasing decision would not be particularly careful/highly educated. The possibilities for imperfect recollection were therefore increased. The purchase act was primarily visual.
  - (2) The respective goods were identical.
  - (3) Peek’s best case resided in CTM number 000284307 for the word trade mark Review.
  - (4) Both trade marks (PEVIEW/Review) comprised well known words and their distinctiveness lay in the marks overall. As a rule of thumb (applicable here), the beginnings of word marks were more important in considering similarity than the ends.
  - (5) The presentation of PREVIEW in upper case and Review in title case would have no effect on the perceptions of the average consumer.
  - (6) Due to the presence of the letters r-e-v-i-e-w in the same order the trade marks had visual similarity. The letters would be pronounced in the same manner so there was also phonetic similarity.
  - (7) The two trade marks had well known meanings that would readily be identified by the average consumer. The two words had clearly different meanings, which would enable the consumer to distinguish between them.

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<sup>1</sup> CTM 000284307 was subject to the proof of use requirements in Section 6A of the Act which the Hearing Officer held were satisfied for the full specification of goods, i.e., clothing.

- (8) In considering the likelihood of confusion various factors had to be taken into account, which were interdependent. The goods were identical and the earlier trade mark enjoyed a good deal of distinctiveness for the goods in respect of which it was registered. The average consumer would seldom be comparing the marks directly, instead relying on imperfect recollection.
- (9) There was phonetic and visual similarity between the marks but the first letter created a difference both phonetically and visually.
- (10) While a conceptual difference would not always trump visual and aural similarities, here the conceptual dissonance of the respective trade marks meant that there was not a likelihood of confusion and the opposition failed.

### **The appeal**

8. On 1 September 2011, Peek filed Notice of appeal to the Appointed Person under Section 76 of the Act. At the appeal hearing before me, Peek was represented by Mr. Simon Malynicz of Counsel instructed by Wynne-Jones, Lainé & James LLP<sup>2</sup>. Mood was neither represented nor appeared and made no written submissions beyond that the Hearing Officer's decision should be upheld for the reasons therein stated.
9. Peek claims that the Hearing Officer made serious errors of principle. Generally, he applied the law too mechanistically. Specifically, he misapplied the principle of conceptual counteraction. Additional errors were that he: (1) discounted the evidence of Gareth Peter Jenkins of Wynne-Jones, Lainé & James LLP, dated 15 April 2011; (2) should have considered the opposition under Section 5(2)(b) also on the basis of Peek's figurative mark, CTM number 005694377; and (3) wrongly decided that in the case of the word marks, the rule of thumb that the beginnings of marks are more important in the comparison than the ends, applied.

### **Witness statement of Gareth Peter Jenkins**

10. Peek complains that the Hearing Officer took no account of the witness statement of Gareth Peter Jenkins, dated 15 April 2011. The Hearing Officer stated in relation to this evidence:

“25) Mr. Jenkins is a registered trade mark attorney. Mr. Jenkins exhibits a number of references for the meaning of the words preview and review. At the hearing Mr. Malynicz did not rely upon this evidence, accepting that review and preview clearly were commonly known words, the meanings of which were well known.”
11. Mr. Malynicz denies that he gave any indication to the Hearing Officer at the hearing that he was not seeking to rely on the evidence of Mr. Jenkins. However, he accepts that since no transcript of the hearing exists, he has no way of proving this. He believes that the Hearing Officer may have misunderstood a point that he did make, which was that PREVIEW and Review were marks with clear meanings – they were

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<sup>2</sup> Peek's same representatives as below.

well understood words, there was nothing obscure about them and Mr. Jenkins' evidence merely provided examples of that.

12. At paragraphs 4 – 5 of his statement, Mr. Jenkins provided dictionary definitions from various online dictionaries. Peek drew my attention in particular to the definitions from *YourDictionary.com*: “preview” – “a previous or preliminary view”; “review” – “a looking back on; a retrospective view”. Peek’s point was that this fed back into the conceptual aspect since both marks related to “view” albeit differing in point of time.
13. However, it seems to me that Hearing Officer was not blind to such arguments. For example, he said:

“49) Mr. Malynicz accepted that the two trade marks had well-known meanings that would be readily known to the average consumer. He argued that conceptually the two words were similar as they could both be used in relation to the same event eg one could attend a preview of a film or read a review of a film. Such argument is clearly syllogistic. Preview for the average consumer will mean seeing or hearing something prior to its official release or opening. Review for the average consumer will mean a critique of some event. The two words have clearly different meanings and the average consumer will distinguish them ...”

14. I have already mentioned the lack of a transcript but I do not detect any material error in any event.

#### **CTM number 005694377**

15. The Hearing Officer’s reasoning in relation to Peek’s earlier figurative trade mark was as follows:

“43) In relation to the stylised trade mark Mr Malynicz submitted that the trade mark of Mood could be in the same font as that of Peek.

44) There are a number of judgments of the GC which are contrary to this position (although though there are some supportive of it), eg in *Calvin Klein Trademark Trust v Office for Harmonization in the Internal Market* (Trade Marks and Designs) (OHIM) Case T-185/07 the GC stated:

“48 In that regard, it is important to point out, as the Board of Appeal stated in paragraph 23 of the contested decision, that the examination of the similarity of the marks at issue takes into consideration those marks in their entirety, as they have been registered or as they have been applied for. A word mark is a mark consisting entirely of letters, of words or of associations of words, written in printed characters in normal font, without any specific graphic element. The protection which results from registration of a word mark concerns the word mentioned in the application for registration and not the specific graphic or stylistic elements accompanying that mark. **The graphic representation which the mark applied for may have in the future must not, therefore, be taken into account for the purposes of the**

**examination of similarity** (see to that effect, Case T-211/03 *Faber Chimica v OHIM – Naberska (Faber)* [2005] ECR II-1297, paragraphs 36 and 37; Case T-353/04 *Ontex v OHIM – Curon Medical (CURON)* [2007], not published in the ECR, paragraph 74; and Case T-254/06 *Radio Regenbogen Hörfunk in Baden v OHIM (RadioCom)*, not published in the ECR, paragraph 43).”

(emphasis added).

(This judgment was subject to appeal to the CJEU (Case C-254/09 P) which rejected the grounds of appeal.)

45) Mr Malynicz agreed that there would be a limit to the forms that it could be considered that a trade mark in a standard font could be used. He accepted that if the speculated use would not support a defence under section 11(1) of the Act or would be in a form differing in elements which alter the distinctive character of the mark in the form in which it was applied, then the speculated use would be outside the limits in which the trade mark could be considered to be used. In this case, the stylised word of [Peek] is highly stylised. The lettering is not clear and it is only knowledge of the word review that would lead the average consumer to perceive of it immediately as the word review. It is not considered that use of the trade mark of Mood in the format of Peek’s stylised trade mark would fall within the above parameters. Consequently, it is not considered that the comparison of the trade marks can be made on the basis of considering Mood’s trade mark as being in the same format as the stylised trade mark of Peek. Consequently, Peek’s better case must rest with the non-stylised trade mark. If it does not succeed in relation to that trade mark it will not be able to succeed in relation to the other trade mark. The comparison will, therefore, be made only with the non-stylised trade mark.”

16. Mr. Malynicz says that it was not necessary to assume PREVIEW as being in the same stylised form as Peek’s earlier figurative CTM, merely in lower case cursive script (e.g., a standard one in Word), which it was legitimate to imagine. Even if that were the case, I cannot see where it gets Peek who can in any case rely on the earlier Review word mark. I believe this was accepted by Mr. Malynicz at the appeal hearing.

### **Beginnings of words more important**

17. In Case T-336/03, *Les Éditions Albert René v. OHIM* [2005] ECR II-4667, when comparing the word marks OBELIX and MOBILIX, the General Court of the Court of Justice of the EU (“GC”) observed that the attention of the consumer is usually directed to the beginning of the word in question (para. 75; and see more recently Case T-41/09, *Hipp & Co KG v. OHIM*, 28 March 2012, para. 36). However, the GC has recognised that this is not an invariable rule (Case C-438/07, *Spa Monopole, compagnie fermière de Spa SA/NV v. OHIM* [2009] ECR II-4155, para. 23, Case T-214/09, *COR Sitzmöbel Helmut Lübke GmbH & Co. KG*, para. 58, 20 October 2011).

18. Peek took issue with the last two sentences of the following paragraph in the Hearing Officer's decision:

“46) Both trade marks are well-known words. The average consumer will not divide them up. They do not have separate distinctive and dominant components: their distinctiveness lies in the trade marks as a whole. It is, however, a rule of thumb that the beginnings of words are more important, in considering similarity, than the ends. In this case, there is no reason that the rule of thumb should not apply.”

19. Mr. Malynicz says that the Hearing Officer fell into error because he treated the statement that the consumer normally attaches more importance to the first part of words in *OBELIX/MOBILIX* and other cases as a rule that needed to be displaced in order not to apply, rather than an observation to be assessed in the particular circumstances of the case. He says that those circumstances include a visual similarity between the letters “P” and “R” and that the letter “P” in *PREVIEW* is pronounced as a fricative sound by which he means that it is enunciated and then quickly disappears.
20. I am with Mr. Malynicz insofar as the Hearing Officer used unfortunate terminology. However, I believe the context of, and his footnote to, the two sentences in question at paragraph 46 make clear that he was merely seeking to express the GC's points described in paragraph 17 above. In particular, there is nothing in the decision to indicate that he was unduly influenced by the facts of *OBELIX/MOBILIX*, or at all.
21. The fact here remains that *PREVIEW* has the extra letter “P”, which the Hearing Officer was entitled to find in the circumstances and viewing the marks as a whole, would not go unnoticed by the average consumer either visually or aurally.
22. I consider therefore that any criticism that can be made of this part of the Hearing Officer's decision is a matter of expression only.

### **Conceptual counteraction**

23. This was the main ground of appeal. Again, Peek says that the Hearing Officer applied conceptual counteraction mechanistically as a rule without regard to the other circumstances of the case. In so doing, he attached undue importance to the conceptual aspect in his global appreciation of likelihood of confusion which instead involved a balancing of factors in that particular case.
24. In order to assess the merits of this ground of appeal, it is necessary to consider the Hearing Officer's conclusion on the existence of likelihood of confusion. He said:

“50) In considering whether there is a likelihood of confusion various factors have to be taken into account. There is the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa. In this case the respective goods are identical.

51) It is necessary to consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade mark the greater the likelihood of confusion. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the goods for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods from those of other undertakings. In this case review is neither descriptive nor allusive of clothing, it has a greater capacity to identify the goods for which it is registered and so enjoys a good deal of inherent distinctiveness. It is important to bear in mind that the average consumer will seldom be comparing trade marks directly but will be relying upon imperfect recollection.

52) There is the conceptual dissonance of the respective trade marks to be considered. In *Phillips-Van Heusen Corp v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-292/01 the GC stated:

“54. Next, it must be held that the conceptual differences which distinguish the marks at issue are such as to counteract to a large extent the visual and aural similarities pointed out in paragraphs 49 and 51 above. For there to be such a counteraction, at least one of the marks at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately. In this case that is the position in relation to the word mark BASS, as has just been pointed out in the previous paragraph. Contrary to the findings of the Board of Appeal in paragraph 25 of the contested decision, that view is not invalidated by the fact that that word mark does not refer to any characteristic of the goods in respect of which the registration of the marks in question has been made. That fact does not prevent the relevant public from immediately grasping the meaning of that word mark. It is also irrelevant that, since the dice game ‘Pasch’ is not generally known, it is not certain that the word mark PASH has, from the point of view of the relevant public, a clear and specific meaning in the sense referred to above. The fact that one of the marks at issue has such a meaning is sufficient - where the other mark does not have such a meaning or only a totally different meaning - to counteract to a large extent the visual and aural similarities between the two marks.”

It is to be noted that conceptual difference does not always trump visual and aural similarities, as per the judgment of the GC in *Nokia Oyj v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-460/07:

“66 Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded

as making it possible to neutralise the visual and aural similarities previously established (see, to that effect, Case C-16/06 P *Éditions Albert René* [2008] ECR I-0000, paragraph 98).”

In this case there is a clear conceptual dissonance which will mean that the average consumer will have different conceptual hooks with which to recall the trade marks. Clear conceptual hooks that will militate against imperfect recollection. There is phonetic and visual similarity, however, the first letter is clearly different both phonetically and visually.

[ ...]

54) The conceptual dissonance outweighs the visual and aural similarities to the extent that there is not a likelihood of confusion.”

25. With hindsight, I agree with Mr. Malynicz that use of the term “trump” by the Hearing Officer in connection with conceptual counteraction was ill-advised.
26. However, after a careful review of the decision<sup>3</sup>, I am unconvinced that the Hearing Officer either treated conceptual counteraction as an inevitable rule, or afforded it undue prominence in his global appreciation of likelihood of confusion. In the end, he decided that the marks’ respective meanings coupled with their first letters sufficed to avert any likelihood of confusion, despite the identity of the goods, the good distinctive character of the earlier mark and some imperfect recollection (lessened by the different meanings of the marks). In my judgment, he did not err in arriving at those findings. Any shortcomings identified by Peek were matters of expression.

### **Other points**

27. Mr. Malynicz made two further points. First, the Hearing Officer wrongly attributed the comments of Arnold J. in *Och-Ziff Management Europe v. Och Capital LLP* [2010] EWHC 2599 (Ch) that “the human eye has a tendency to see what the brain expects to see” (para. 120; and see also *KENNEDY FRIED CHICKEN*, BL O/227/04) to the conceptual aspect whereas it pertained to the visual aspect. The Hearing Officer actually said:

“53) ... To some extent this is an aspect of imperfect recollection. In this case the dissonant conceptual meanings of the two trade marks will militate against this cerebral expectation.”
28. A difference in meaning of words can affect their visual appreciation. Also in both of the authorities relied upon by Mr. Malynicz the respective trade marks enjoyed significant reputation, which was not claimed in this case. I do not consider that the Hearing Officer made a material error in this respect.
29. Second, Mr. Malynicz pointed out that the Hearing Officer made no finding as to the degree of similarity in the marks. That may not be surprising since he recognised that the marks had the letters r-e-v-i-e-w in common and to that extent had visual and

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<sup>3</sup> Including the Hearing Officer’s footnotes not reproduced in this decision.

phonetic similarity. However, their first letters were different. Further there was a difference in the marks conceptually. Again, I do not find anything here to justify my interference. As Mr. Malynicz reminded me in his skeleton argument:

“... 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.” Floyd J., *Galileo Technology LLC v. European Union* [2011] EWHC 35 (Ch), paragraph 14

### **Conclusion**

30. In the result the appeal fails and the decision of the Hearing Officer is upheld. Since Mood played no part in it, I will make no order for costs in respect of the appeal.

Professor Ruth Annand, 19 June 2012

Mr. Simon Malynicz of Counsel instructed by Wynne-Jones, Lainé & James LLP appeared on behalf of the joint opponents

The applicant was not represented and did not appear