

**O-264-19**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3292166  
BY JENNY AVES LIMITED  
TO REGISTER:**

**JENNY AVES**

**AS A TRADE MARK IN CLASSES 20, 21, 24, 25, 27 & 42**

**AND**

**OPPOSITION THERETO (UNDER NO. 412748) BY  
ARA AG**

## Background and pleadings

1. The subject proceedings relate to an opposition against the registration of the trade mark JENNY AVES under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), with the opponent relying on one earlier mark, EU trade mark registration 12153854. Consequently, the question to be determined is whether there is a likelihood of confusion between the following marks:

The application	The earlier mark
<b>JENNY AVES</b>	<b>Jenny</b>
Class 25: Clothing; Footwear; Headgear; Children’s wear; Children’s footwear; Children’s headwear; Infantwear.  The other goods and services of the application are not subject to opposition.	Class 10: Orthopaedic articles, in particular orthopaedic shoes and shoe inserts  Class 25 : Footwear
Filed on 23 February 2018  Published for opposition purposes on 16 March 2018	Filed on 19 September 2013  Registered on 8 April 2016
<b>Applicant:</b> Jenny Aves Limited	<b>Opponent:</b> ara AG

2. The opponent contends that the marks are similar on account of the earlier mark being incorporated in the later mark (with the common element being the first element) and that both are for “Jenny” marks. It contends that the applied for goods

are identical or similar to the goods of the earlier mark. It contends that there exists a likelihood of confusion as a result of all this.

3. The applicant filed a counterstatement denying the grounds of opposition. It accepts that there is an overlap in the goods, but that this applies only to footwear, with the other goods not being similar or identical. However, it believes that there will be no likelihood of confusion on account of its mark containing the uncommon surname Aves in addition to the forename Jenny.

4. Both sides filed written submissions during the evidence rounds. Neither side elected to be heard, with both filing written submissions in lieu. The opponent has been represented by Dolleymores, the applicant by Novagraaf UK.

## **Decision**

5. Section 5(2)(b) of the Act states that:

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

...

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

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

6. An “earlier trade mark” is defined in section 6 of the Act:

6(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) 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.

7. The registration upon which the opponent relies qualifies as an earlier trade mark under the above provisions. As the earlier mark was registered within the five years before the date on which the applicant's mark was published, it is not subject to proof of use. The opponent is therefore entitled to rely upon its mark for all the goods for which it is registered.

### **Section 5(2)(b) case law**

8. The following principles are gleaned from the decisions of the courts of the European Union 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. The average consumer 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.

### **Comparison of goods**

9. All relevant factors relating to the goods should be taken into account when making the comparison. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the

Court of Justice of the European Union (“the CJEU”), Case C-39/97 stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

10. Guidance on this issue has also come from Jacob J where, in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, the following factors were highlighted as being relevant:

- (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.

11. In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or

relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v OHIM* Case T- 325/06, it was stated:

“It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking..”

12. The applicant seeks registration in relation to:

Class 25: Clothing; Footwear; Headgear; Children's wear; Children's footwear; Children's headwear; Infantwear.

13. The opponent's mark covers, inter alia, footwear in class 25.

14. It is clear that, at the very least, the applied for footwear and children's footwear are identical to the goods of the earlier mark. Children's wear and infant wear are broad terms which could encompass footwear (wear being a broad term indicating anything that can be worn) and, as such, these goods may also be considered identical on an inclusion basis<sup>1</sup>. That leaves clothing, headgear and children's headwear. Whilst clearly different from footwear, they are all still items that clothe the body (albeit different parts), often sold through the same trade channels to the same consumers; they may also be complementary. I consider there to be at least a low degree of similarity here.

15. The opponent also made submissions in relation to the similarity of the applied for goods with its class 10 goods. However, I do not see how such items could be any more similar to the opponent's footwear in class 25 on which I have already made findings. As such, I say no more.

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<sup>1</sup> See, for example, Case T- 133/05 of the General Court

## **Average consumer and the nature of the purchasing act**

16. In accordance with the case law cited in paragraph 8, I must determine who is the average consumer and the nature of the purchasing act. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods in question<sup>2</sup>.

17. The goods at issue are in the clothing/footwear field. The average consumer is a member of the general public. Such items are not, generally speaking, greatly expensive. Some care will be taken in respect of style, colour, fitness for purpose etc. I consider that this equates to a reasonable, no higher or lower than the norm, level of care and consideration. The goods will be perused in traditional bricks and mortar retail establishments and their online equivalents. The goods and the marks used in relation to them may be seen in advertisements and on websites. This means that the visual impression of the marks may take on more significance, but the aural impact of the marks should not be ignored from the assessment completely.

## **Comparison of marks**

18. 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 the marks, bearing in mind their distinctive and dominant components. The CJEU stated in *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

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<sup>2</sup> *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*, C-342/97, para. 26

that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.<sup>3</sup>

19. It would be wrong, therefore, to artificially dissect the marks, although, it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

20. The respective marks are shown below:

## **Jenny v JENNY AVES**

21. The earlier mark Jenny comprises just one word and, consequently, is the only thing that contributes to its overall impression. The applied for mark, JENNY AVES, comprises two words. They clearly combine to form a full name, as the applicant submits. Neither the forename nor the surname is presented in a way which gives either greater impact. Whilst I do not necessarily disagree with the applicant's submission that AVES is a more unusual surname than JENNY is a forename, it does not follow that AVES dominates the mark. Both elements make a roughly equal contribution to the overall impression of the full name of which the mark consists.

22. The common presence of the name Jenny creates some visual and aural similarity. However, there is also a difference on account of the absence/presence of the surname AVES which is of more than the "slight" significance submitted by the opponent. There is a medium degree of visual and aural similarity. In making this assessment, I have borne in mind the opponent's submission that the beginnings of marks tend to have more focus. However, I do not consider that in this case the rule of thumb mentioned by the opponent material skews the overall impression of the mark or the degree of visual and aural similarity I have found. I also note that the parties have made submissions in relation to the decision in *Berg Outdoor* T139-16. However, I do not need to go into this in any detail as the opponent relies on this only for the purpose of submitting that there is some similarity (because one

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<sup>3</sup> C-591/12P, para. 34

component is reproduced in the other), which I have held (of a medium degree) – the applicant does not say that there is no similarity at all, just that there is no likelihood of confusion, something which I come on to later.

23. Conceptually, both marks make reference to a person called Jenny. However, conceptual similarity on this basis is low given that the applied for mark refers to a specific Jenny whose surname is Aves, whereas the earlier mark does not.

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

24. It is necessary to determine the distinctive character of the earlier mark, in order to make an assessment of the likelihood of confusion. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, the ECJ stated that:

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).

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).<sup>4</sup>

25. I have only the inherent characteristics of the mark to consider, no evidence having been filed. The earlier mark is for the forename JENNY. Names are commonly used as trade marks. They would not ordinarily be seen as greatly distinctive trade marks. Although there is no evidence to illustrate how common the name Jenny is, it does not strike me as a particularly unusual name. I consider that the earlier mark has, at best, a medium degree of inherent distinctiveness. This finding elides with the submission of the applicant, although, I should add that I have placed little weight on the state of the register evidence it attached to its written submissions as this does not necessarily reflect the state of the market.

### **Conclusions on likelihood of confusion**

26. I have so far considered the factors that need to be taken into account when assessing the likelihood of confusion and now come to a global assessment. As the CJEU stated:

“A global assessment of the likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between these goods or services. Accordingly, a lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the marks, and vice versa. The interdependence of these factors is expressly mentioned in the tenth recital of the preamble to the Directive, which states that it is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion, the appreciation of which depends, in particular, on the recognition of the trade mark on the market and the degree of similarity between the mark and the sign and between the goods or services identified.<sup>5</sup>”

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<sup>4</sup> C-342/97, paras. 22-23

<sup>5</sup> *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, C-39/97, para. 17

27. There are two types of confusion that must be considered:

- direct confusion, where one mark is mistaken for another; and
- indirect confusion, where the similarities lead the consumer to believe that the goods or services come from the same, or a related, undertaking.

28. It is useful at this juncture to set out some applicable guidance relating to the treatment of conflicts which involve forenames and full names. In *Harman International Industries, Inc v OHIM*, Case C-51/09P, the CJEU found that:

“Although it is possible that, in a part of the European Union, surnames have, as a general rule, a more distinctive character than forenames, it is appropriate, however, to take account of factors specific to the case and, in particular, the fact that the surname concerned is unusual or, on the contrary, very common, which is likely to have an effect on that distinctive character. That is true of the surname ‘Becker’ which the Board of Appeal noted is common”.

29. In *El Corte Inglés, SA v OHIM*, Case T-39/10, the General Court found that:

“54. As the applicant asserted in its pleadings, according to the case-law, the Italian consumer will generally attribute greater distinctiveness to the surname than to the forename in the marks at issue (Case T-185/03 *Fusco v OHIM – Fusco International (ENZO FUSCO)* [2005] ECR II-715, paragraph 54). The General Court applied a similar conclusion concerning Spanish consumers, having established that the first name that appeared in the mark in question was relatively common and, therefore, not very distinctive (Case T-40/03 *Murúa Entrena v OHIM – Bodegas Murúa (Julián Murúa Entrena)* [2005] ECR II-2831, paragraphs 66 to 68).

55. Nevertheless, it is also clear from the case-law that that rule, drawn from experience, cannot be applied automatically without taking account of the specific features of each case (judgment of 12 July 2006 in Case T-97/05

Rossi v OHIM – Marcorossi (MARCOROSSI), not published in the ECR, paragraph 45). In that regard, the Court of Justice has held that account had to be taken, 14 in particular, of the fact that the surname concerned was unusual or, on the contrary, very common, which is likely to have an effect on its distinctive character. Account also had to be taken of whether the person who requests that his first name and surname, taken together, be registered as a trade mark is well known (Case C-51/09 P Becker v Harman International Industries [2010] ECR I-5805, paragraphs 36 and 37). Likewise, according to the case-law cited in the previous paragraph, the distinctive character of the first name is a fact that should play a role in the implementation of that rule based on experience.”

30. I also note a decision of Mr Daniel Alexander QC, sitting as the Appointed Person, in *Pia Hallstrom* BL O/303/17, where at paragraph 37, when summing up the nature of the overall evaluation that had to be made, he stated:

“Moreover, if a trader chooses a forename as a trade mark, the average consumer is not particularly likely to think that another trader who uses a full name incorporating that forename is thereby denoting goods or services from the first undertaking rather than those connected with someone else who happens to share that forename. That is a problem which arises as a result of a choice of mark which, precisely because it is a name which others either do or could reasonably wish to use to denote themselves, does not start high on the distinctiveness scale. Large-scale use of such a mark does not, as such, enhance its distinctiveness in a relevant way, namely so as to increase the likelihood of confusion (see above).”

31. The applicant also highlights another case involving names: *JULIA BO* [BL-O-227-18] which was held not to conflict with the mark JULIA. I bear this in mind also, however, as this was just a decision of a fellow hearing officer, it is not binding and its persuasive value is limited. Also, in its final written submissions, it referred to another case of a fellow hearing officer which involved the full name ASTON MARTIN; in that case it was held that the forename ASTON was more distinctive

than the surname MARTIN (which, it goes on to submit, is the reverse of the subject proceedings because AVES is more unusual than JENNY).

32. Although not a case based on names, I also note the judgment of Mr Justice Arnold in *Whyte & MacKay Ltd v Origin Wine UK Ltd and Dolce Co Invest Inc* [2015] EWHC 1271 (Ch) where he issued further guidance in relation to the treatment of marks comprising more than one component in circumstances where confusion might arise upon the sharing of one of those components with the other mark. I particularly note what he said in paragraph 20:

“20. The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).”

33. For its part, I note that in its final written submissions the opponent highlights the decision of the Second Board of Appeal in *Hatty + Tom* (a conflict between that mark and the mark HATTY) and, in particular, paragraph 35 which states:

“In relation thereto, it is of particular importance that the earlier mark’s sole element ‘HATTY’ is included in the contested sign. It should be recalled in this respect, that, according to case-law, where a composite sign is composed by juxtaposing one element and another trade mark, that latter trade mark, even if it is not the dominant element in the composite sign, may still have an independent distinctive role in that sign. In such a case, the composite sign and said other trade mark may be deemed to be similar 06/10/2005, C-120/04, Thomson Life, EU:C:2005:594, § 30 and 37). It should be pointed out that the ‘Thomson Life’ judgment concerned a situation in which the earlier mark had been reproduced identically in the composite sign, as in the case at hand.”

34. I initially consider the position in relation to footwear, goods which are identical to goods of the earlier mark. Having considered the matter, my finding is that the average consumer, notwithstanding the concept of imperfect recollection, is more than capable of not directly confusing the respective marks. One will be remembered and recalled as just the name Jenny, the other as a full name of which Jenny is the forename.

35. In terms of indirect confusion, the opponent gives the example of a number of designer names, and illustrates its point by submitting that there may well be confusion between CALVIN KLIEN and CALVIN and, in a similar way, JENNY AVES may be seen as a brand connected to the opponent's brand JENNY. I do not consider the example given to be on a par with the subject proceedings given the fame that may attach to CALVIN KLIEN. In any event, it is my view that whether the example is a good one or not, the average consumer will not put the sharing of the name JENNY down to the responsible undertakings being the same or being related. They will put the commonality down to a co-incidental sharing of a not uncommon female forename with nothing to suggest a same-stable relationship. As Mr Alexander stated in *Pia Hallstrom*:

“..the average consumer is not particularly likely to think that another trader who uses a full name incorporating that forename is thereby denoting goods or services from the first undertaking rather than those connected with someone else who happens to share that forename”.

36. The above finding is re-enforced because I agree with the applicant that the surname AVES is the more unusual part of the name, with JENNY being more commonplace. The more commonplace nature of the name JENNY lessens further the average consumer assuming a trade connection. In relation to the HATTY + TOM example, I am not persuaded that this is relevant, particularly given that in that case the Board of Appeal held that HATTY performed an independent role within the mark, which does not apply to JENNY in JENNY AVES. The opposition under section 5(2)(b) fails.

## **Costs**

37. The applicant has been successful and is entitled to a contribution towards its costs. Awards of costs in proceedings commenced on or after 1 July 2016 are governed by Tribunal Practice Notice (TPN) 2/2016. My assessment is as follows:

*Preparing a statement and considering the other side's statement - £200*

*Written submissions - £600 (covering both sets filed)*

***Total: £800***

38. I therefore order ara AG to pay Jenny Aves Limited the sum of £800. The above sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

**Dated 20 May 2019**

**Oliver Morris**

**For the Registrar,**

**the Comptroller-General**