

O-276-08

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2421925B
BY HANSON PARTNERS LIMITED
TO REGISTER THE TRADE MARK**



IN CLASSES 12, 23, 24, 35, 36, 39, 41 AND 45

AND

**THE OPPOSITION THERETO
UNDER NO 95323
BY ANSON'S HERRENHAUS KG**

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Introduction

1. On 16 May 2006, Hanson Partners Limited, which I will refer to as HP, applied to register the above trade mark. During the course of its examination, the application was divided. Divisional application 2421925B proceeded to publication for opposition purposes on 30 March 2007 with the following specification:

vehicle seat covers;

yarns and threads, for textile use;

textiles and textile goods, not included in other classes; seat, bed and table covers;

retail services connected with the sale of clothing, footwear and headgear, cars, razors, key rings, lighters, mobile phone accessories, computer accessories, containers for glasses, containers for contact lenses, sunglasses, jewellery, soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices, deodorants, scented candles, food and drink, printed matter, paper, cardboard and goods made from these materials, office requisites, clocks, watches, bags, umbrellas, rucksacks, cheque book holders, mirrors, picture frames, pictures, bedding, toothbrushes, games and playthings, tobacco, matches; office administration services; provision of serviced offices; rental of office equipment;

rental and sale of property;

storage services; warehousing; rental of storage space; rental of storage units and containers; packaging of goods; packing; consultancy services in relation to warehousing; information services in relation to storage; transportation and delivery of goods;

maintenance of archives;

hire and rental of clothing, footwear and headgear; hire and rental of menswear; hire and rental of ladies wear; hire and rental of children's wear; hire and rental of accessories for all the foregoing.

The above goods are in classes 12, 23, 24, 35, 36, 39, 41 and 45, respectively, of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2. On 2 July 2007, Anson's Herrenhaus KG, which I will refer to as AH, filed a notice of opposition to the registration of the trade mark for part of the specifications. The goods and services against which the opposition is directed are:

textiles and textile goods, not included in other classes;

retail services connected with the sale of clothing, footwear and headgear, sunglasses, jewellery, clocks, watches, bags, umbrellas and rucksacks;

hire and rental of clothing, footwear and headgear; hire and rental of menswear; hire and rental of ladies wear; hire and rental of children's wear; hire and rental of accessories for all the foregoing;

in classes 24, 35 and 45, respectively.

AH claims that registration of the trade mark would be contrary to section 5(2)(b) of the Act since there would be a likelihood of confusion on the part of the public resulting from the above goods and services being associated with its own earlier trade mark, Community Trade Mark (CTM) No 3292117. This earlier mark is:

Anson's

and is registered in class 35 for *retail trade services*.

It was filed on 29 July 2003 and was registered on 7 December 2004. Since its date of registration is less than five years before the application in suit was published in the *Trade Marks Journal*, there is no requirement for AH to prove use of its mark.

AH claims that the dominant element in the application is the word HANSON, that it is visually and phonetically similar to ANSON'S and that it is susceptible to imperfect recollection by the average consumer, its goods and services being similar to AH's 'retail trade services'.

3. HP filed a counterstatement, denying the grounds of opposition save for one admission:

"The Applicant admits one of the allegations made in Paragraph 3 of the Statement of Grounds of Opposition namely that the "Retail services connected with the sale of clothing, footwear and headgear, sunglasses, jewellery, clocks, watches, bags,

umbrellas, rucksacks” (Class 35) applied for under Application No. 2421925B are similar to the “retail trade services” (Class 35) covered by CTM Registration No. 3292117.”

4. Neither side filed evidence. The parties were advised that they had a right to a hearing and that if neither side requested a hearing a decision would be made from the papers and from any written submissions. Neither side requested a hearing and both filed written submissions. I have borne in mind the written submissions in reaching my decision, referring to them directly when necessary.

Decision

Section 5(2)(b) of the Act – likelihood of confusion

5. The relevant part of section 5(2)(b) of the Act is as follows:

“(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 marks 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.”

Section 6(1)(a) of the Act defines an earlier mark as:

“a registered trade mark, international trade mark (UK), 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”.

AH’s trade mark upon which it relies is an earlier mark as per section 6(1)(a).

6. The leading authorities which guide me in this ground are from the European Court of Justice (ECJ): *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). It is clear from these cases that:

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

(b) the matter must be judged through the eyes of the average consumer of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has

the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

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

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

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

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*,

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

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

(i) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

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

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

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

Comparison of goods and services

7. Following the established tests in *Canon* and in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281, I must consider the nature of the goods and services, their intended purpose, their method of use, whether the goods or services are in competition with or complementary to each other and also the nature of the users and the channels of trade.

8. The criteria identified in the *Treat* case for assessing similarity between goods and services were:

- (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, taking into account how goods/services are classified in trade.

9. The above criteria do not represent a 'one size fits all' approach, but are of general applicability, some being more relevant than others in particular cases. For example, point (e) will be more relevant in the case of a comparison between retail services and/or consumer goods, as is the case here, than it will be between services where there is no tangible element. I also bear in mind that in *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16 Jacob J held that:

“...definition of services....are inherently less precise than specifications of goods. The latter can be, and generally are, rather precise, such as “boots and shoes”.

In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

The specifications for the services in classes 35 and 45 which are opposed are confined quite specifically; if not quite Jacob J's “boots and shoes”, they are the sale and hire of boots and shoes and other consumer goods which one would find in any real or virtual shopping centre or department store:

retail services connected with the sale of clothing, footwear and headgear, sunglasses, jewellery, clocks, watches, bags, umbrellas and rucksacks;

hire and rental of clothing, footwear and headgear; hire and rental of menswear; hire and rental of ladies wear; hire and rental of children's wear; hire and rental of accessories for all the foregoing.

In contrast, the opponent's single-class registration is for 'retail trade services', not limited to any particular sphere of retail. The applicant has conceded that 'retail trade services' is similar to its retail services connected with the sale of clothing, footwear and headgear, sunglasses, jewellery, clocks, watches, bags, umbrellas and rucksacks. In addition to deciding to what degree they are similar, I must also assess whether there is similarity between textiles and textile goods and retail trade services and also between clothing hire services and retail trade services. In the normal course of events I would be required to compare the services covered by AH's earlier mark against the opposed goods and services in HP's application, without restriction, based upon the principle of notional and fair use. How far does the concept of notional and fair use extend when interpreting an unlimited retail services specification?

10. There is a historical perspective to the wording of the parties' respective class 35 'retail' specifications. AH's earlier mark was registered on 7 December 2004. On 7 July 2005, the ECJ handed down its judgment in *Praktiker Bau – und Heimwerkermärkte AG*, C-418/02. The following questions had been referred to the court:

- “1. Does retail trade in goods constitute a service within the meaning of Article 2 of the directive? If the answer to this question is in the affirmative:
2. To what extent must the content of such services provided by a retailer be specified in order to guarantee the certainty of the subject-matter of trade mark protection that is required in order to:
 - (a) fulfil the function of the trade mark, as defined in Article 2 of the directive, namely, to distinguish the goods or services of one undertaking from those of other undertakings, and
 - (b) define the scope of protection of such a trade mark in the event of a conflict?
3. To what extent is it necessary to define the scope of similarity (Article 4(1)(b) and Article 5(1)(b) of the directive) between such services provided by a retailer and
 - (a) other services provided in connection with the distribution of goods, or
 - (b) the goods sold by that retailer?”

11. The ECJ gave answers to the first and second questions, but not the third, since in the *Praktiker* case it was unnecessary to rule on the concept of similarity between goods and retail services. Its answers to the first two questions were:

- “49. for the purposes of registration of a trade mark covering services provided in connection with retail trade, it is not necessary to specify in detail the service(s) for which that registration is sought. To identify those services, it is sufficient to use general wording such as ‘bringing together of a variety of goods, enabling customers to conveniently view and purchase those goods’.
50. However, the applicant must be required to specify the goods or types of goods to which those services relate by means, for example, of particulars such as those contained in the application for registration filed in the main proceedings (see paragraph 11 of this judgment).
51. Such details will make it easier to apply Articles 4(1) and 5(1) of the directive without appreciably limiting the protection afforded to the trade mark. They will also make it easier to apply Article 12(1) of the directive, which states that ‘[a] trade mark shall be liable to revocation if, within a continuous period of five years, it has not been put to genuine use in the Member State in connection with the ... services in respect of which it is registered, and there are no proper reasons for non-use’.
52. The answer to the first two questions referred for a preliminary ruling must therefore be that the concept of ‘services’ referred to by the directive, in particular in Article 2, covers services provided in connection with retail trade in goods.

For the purposes of registration of a trade mark for such services, it is not necessary to specify the actual service(s) in question. However, details must be provided with regard to the goods or types of goods to which those services relate.”

12. AH’s class 35 retail services specification was registered pre-*Praktiker*, and is unrestricted, whilst HP’s application is post-*Praktiker* and the actual goods which are the subject of the retail service are specified, complying with the answers given by the ECJ.

13. AH submits that, since its retail services are unqualified as to the field of trading, its registration should be given its full scope and therefore covers the sale of textiles and textile goods. The applicant, unsurprisingly, takes the opposite view and cites in support Communication No. 3/01 from the President of the Community Trade Mark Office (Office for the Harmonization of the Internal Market (Trade Marks and Designs)), which predated *Praktiker* but was referred to with approval by Advocate General Leger in paragraph 99 of his Opinion in that case (although, as noted above, the question was not dealt with by the ECJ in its judgment). The President’s Communication reads:

“The limitation of applications and registrations for such services by indicating the field of activity of retail or other selling services will reduce the likelihood of conflicts because the risk of confusion between, for example, retail sales of meat on the one hand and of electrical goods on the other is non-existent.

As regards conflicts between services and goods, the Office takes the view that, while a "similarity" between goods sold at retail and retail services cannot be denied in the

abstract, the risk of confusion is unlikely between retail services on the one hand and particular goods on the other except in very particular circumstances, such as when the respective trade marks are identical or almost so and well-established in the market. Each case that arises will of course be dealt with on its own merits.

Given that situation those requesting registration of marks for retail (or similar) services should not expect that they thereby obtain protection against the use or registration of marks for goods. If such protection is required as well, it is clear that registration for goods must be requested as well.”

14. The opposing views of the parties in this case capture the dilemma. However, the unanswered issue of similarity between retail services and goods has recently been considered by the Court of First Instance (CFI) in *Oakley, Inc v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-116/06. The court’s judgment in this cancellation action dealt with the similarity between goods and a retail services specification which was both unrestricted and restricted in scope. The conflict was between an earlier mark which was registered for goods in classes 18 and 25 and a later mark which had been registered for “Retail and wholesale services, including on-line retail store services; retail and wholesale of eyewear, sunglasses, optical goods and accessories, clothing, headwear, footwear, watches, timepieces, jewellery, decals, posters, athletic bags, backpacks and knapsacks, and wallets’. The CFI upheld OHIM’s decision that the goods in classes 18 and 25 were similar to “retail and wholesale of eyewear, sunglasses, optical goods and accessories, clothing, headwear, footwear, watches, timepieces, jewellery, decals, posters, athletic bags, backpacks and knapsacks, and wallets” since there is a complementary relationship between retail of the goods and the goods themselves:

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

Having established the similarity between goods and the sale of those specified goods, the CFI went on to consider the unrestricted retail services part of the later registration: “Retail and wholesale services, including on-line retail store services”. It said:

“59 In the second place, with regard to the comparison of ‘retail and wholesale services, including on-line retail store services’ with the goods in question, it must be recalled that the Court held, in paragraph 50 of *Praktiker Bau- und Heimwerkermärkte*, paragraph 17 above, that the applicant for the Community trade mark must be required to specify the goods or types of goods to which those services relate.

60 In that regard, it must be pointed out that the applicant has, as correctly stated by the Board of Appeal in paragraph 32 of the contested decision, failed to provide any

specification whatsoever of the goods or types of goods to which the ‘retail and wholesale services, including on-line retail store services’ relate.

61 Thus, it must be held that ‘retail and wholesale services, including on-line retail store services’, on account of the very general wording, can include all goods, including those covered by the earlier trade mark. Therefore, it must be held that ‘retail and wholesale services, including on-line retail store services’, display similarities to the goods concerned.

62 It follows from all of the foregoing that the Board of Appeal was right to consider that services consisting of ‘retail and wholesale of clothing, headwear, footwear, athletic bags, backpacks and knapsacks and wallets’, and ‘retail and wholesale services, including on-line retail store services’, are similar to the goods covered by the earlier trade mark.”

15. AH has not specified the goods or types of goods to which its retail trade services relate. Following the CFI judgment above, AH’s specification “on account of the very general wording, can include all goods” including those opposed in class 24 of the application. I am therefore bound to find that retail trade services covers retail of textiles and textile goods, which is similar to the textiles and textile goods themselves. Following this logic, and bearing in mind the applicant’s admission that its class 35 services which are opposed are similar to those of the opponent, I also find that there is a material similarity between the retail trade services of AH and “retail services connected with the sale of clothing, footwear and headgear, sunglasses, jewellery, clocks, watches, bags, umbrellas and rucksacks.”

16. This leaves the class 45 services (hire of clothing, footwear and headgear) to consider. AH submits that the average consumer may also associate these services of HP with AH’s retail services because its retail services cover retail of clothing, footwear and headgear. As part of its submissions on this point, AH includes various website prints, which show clothing hire companies selling ex-hire outfits; a department store’s bridal department; and an insurance company’s trade classification, putting clothing hire and retail in the same insurance category. Such material should properly have been filed as evidence from the opponent to demonstrate trade practices; as it is, the applicant has not had an opportunity to respond to it. All of the material is dated after the relevant date. AH invites me to take judicial notice of the facts contained within this material; I think AH means that I do not need the material to take judicial notice of clothing retail/clothing hire trade links. I am not prepared to say on a judicial notice basis, from my own knowledge of one or two large formal clothing hire establishments, that these or any clothing hire establishment also sell clothing.

17. The opponent has not filed any evidence of its own area of trade activity to assist me in assessing whether rental/hire of clothing, footwear and headgear are similar to retail trade services. However, I can see that because the term retail services (at large) covers the retail of clothing that there may be a complementary trade relationship between the retail of clothing and the hire of clothing. That is the highest I can put it without properly filed evidence. I find that there is a modicum of similarity between retail trade services and hire and rental of clothing, footwear and headgear; hire and rental of menswear; hire and rental of ladies wear; hire and rental of children's wear; hire and rental of accessories.

Average consumer

18. Based upon the above assessment, it follows that the average consumer for the retail services at issue will be the general public since the items offered for sale are general consumer items. That is also the case for the goods and for the hire of clothing. The level of attention will vary according to the particular nature of the item being purchased or hired. Tea towels and oven gloves will be subjected to a reasonable level of attention, for example, since although of relatively low cost, they are likely to have to function well and to fit in with a decorative scheme; alternatively, if they are for professional use, the purchaser's considerations will be different. Clothing, sunglasses, watches and jewellery will also be a considered purchase. The level of attention of a hirer of clothing may again vary; from someone needing a tuxedo for an event whose main concern may be to get a suit that fits the purpose (and the wearer), to the level of attention of a bride, where it will be high.

Similarity of marks

19. The authorities direct that, in making a comparison between the marks, I must have regard to each mark's visual, aural and conceptual characteristics. I have to decide which, if any, of their components I consider to be distinctive and dominant. The likelihood of confusion must be appreciated globally by evaluating the importance to be attached to those different elements, taking into account the degree of similarity in the goods and services, the category of goods and services in question and how they are marketed. However, I should guard against dissecting the marks so as to distort the average consumer's perception of them; the average consumer perceives trade marks as wholes and rarely has the opportunity to compare marks side by side, relying instead upon the imperfect picture he has of them in his mind.

20. The marks to be compared are:

AH's	HP's
Anson's	

AH's mark is clearly a word mark in plain type whilst HP's mark is comprised of words in plain type and the device of a heraldic lion. In HP's mark, the word HANSON is presented in larger type than partners and is also emboldened, appearing darker than all the other elements of the mark. I agree with AH's submission that HANSON is the dominant element of the application. 'Partners' plays a subordinate role; the lion is a distinctive element, but the mark overall is dominated by the word HANSON.

21. AH also submits that the application contains the entirety of its mark. This cannot literally be true, since AH's mark contains an apostrophe and a genitive 's'. What AH presumably means is that ANSON is contained within HANSON. I agree that there is a slight degree of visual similarity between ANSON'S and HANSON, the only point of

convergence between the marks. However, the average consumer does not generally dissect marks and I bear in mind that my visual comparison must be made by comparing AH's mark with the whole of the application, which is a complex mark with more than one distinctive element. I find that there is a low level of visual similarity.

22. AH contends that many English speakers drop their 'aitches' so that an accurate oral comparison would be between ANSON'S and ANSON. I agree that is a relevant consideration; there are several UK areas where a dropped H is a natural dialect feature. In addition, 'h' is a soft consonant, more easily missed aurally than harder consonants. Its position in HP's mark means that, spoken or heard, it creates less of a distance between the marks in the way that harder consonants would do. I find that there is a higher level of aural similarity between the marks than is the case visually, notwithstanding PARTNERS, which plays a subordinate role. Since there are word elements in the mark, it is unlikely that the average consumer would choose to refer to HP's mark by reference to the heraldic lion, since the word elements provide a much more natural and accessible way to articulate the mark.

23. I agree with AH that both marks suggest surnames. I consider that especially to be so for HP's mark because HANSON qualifies PARTNERS and it is common practice for trade marks which identify partnerships to do so by the partners' surnames. My view is that the marks share a similar surnominal identity. However, the surnames themselves are not similar. At a high level of conceptual generality, the marks both contain a surname; however, a conclusion on this basis that the marks are conceptually similar would, I think, lead to a skewed result, since the surnames are different and surnames possess intrinsic qualities of identification. I will say more about this below.

Likelihood of confusion

24. To assist me in deciding whether there is a likelihood of confusion, AH has included with its submissions a translation of a decision taken by the OHIM Fourth Board of Appeal, 20 July 2007, R 85/2007-4, which involved AH's opposition against a CTM application for the trade mark HANSON (by an applicant in the Czech Republic). The opposition was decided in AH's favour. AH relied upon its earlier trade mark Anson's (CTM 1001999). Firstly, unlike the present case, the CTM application was for goods in classes 18 and 25 and AH's earlier right was registered in classes 18 and 25 for identical goods. Secondly, the CTM was for the word HANSON, without any additional elements, unlike the present application. Thirdly, I also bear in mind what was said by Geoffrey Hobbs Q.C., sitting as the Appointed Person in *Zurich Private Banking* BL 0/201/04, on the matter of decisions in different jurisdictions:

“However, the position as between different national registries and the Community Trade Marks Office is that they are not competent to adjudicate on the correctness of each other's determinations and, as a corollary of that, not required to treat each other's determinations as binding upon them in the independent exercise of their own powers. That is not to say that each of them should or will simply ignore the determinations of the others. The general principle is that each of them should give determinations of the others such weight (if any) as they might fairly and properly be said to bear in the decision-taking processes they are required to undertake independently of one another.”

For both these reasons, the decision of the OHIM is of limited assistance.

25. In considering the likelihood of confusion, I have to bear in mind the nature of the goods and services, the purchasing process and the relevant consumer, which have been dealt with above. I have to weigh the proximity of the goods and services against the relative distance between the marks - the interdependency principle – whereby a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon*). I must consider what is the relative importance that the phonetic and visual similarities have in relation to the goods and services during the purchasing process. I must also appraise the distinctive character of the earlier mark, because the more distinctive it is (either *per se* or by reputation), the greater will be the likelihood of confusion (*Sabel*). The distinctive character of a mark must be assessed by reference to the particular goods or services to which it is attached and by reference to the relevant consumer’s perception of the mark.

26. I have found that the goods and services are those bought by the general public – they are consumer items bought via consumer retail channels of trade (a retail service is a channel of trade in itself). I have also found that the level of attention of the buyer varies according to the nature of the item being bought.

27. In my assessment of the marks, I said that there was an appreciably greater degree of aural similarity than visual similarity. However, the ECJ cautions against approaching an assessment of a likelihood of confusion on the basis of aural similarity alone in *Mülhens GmbH & Co KG v OHIM* Case C-206/04 P:

“21 It is conceivable that the marks’ phonetic similarity alone could create a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see, in respect of Directive 89/104, *Lloyd Schuhfabrik Meyer*, paragraph 28). However, it must be noted that the existence of such a likelihood must be established as part of a global assessment as regards the conceptual, visual and aural similarities between the signs at issue. In that regard, the assessment of any aural similarity is but one of the relevant factors for the purpose of that global assessment.

22 Therefore, one cannot deduce from paragraph 28 of the judgment in *Lloyd Schuhfabrik Meyer* that there is necessarily a likelihood of confusion each time that mere phonetic similarity between two signs is established.”

In deciding the relative weight which should be accorded to visual or aural perception of the marks, I am guided by the CFI in *Quelle AG v OHIM* Case T-88/05:

“57 Furthermore, it is settled case-law that a complex mark and another mark which is identical or similar to one of the components of the complex mark may be regarded as being similar where that component forms the dominant element within the overall impression given by the complex mark. That is the case where that component is likely to dominate, by itself, the image of that mark which the relevant public keeps in mind, with the result that all the other components of the mark are negligible within the overall impression given by it. That approach does not amount, however, to taking into consideration only one component of a complex trade mark and comparing it with another mark. On the contrary, such a comparison must be made by examining the marks in question, each considered as a whole (*MATRATZEN*, paragraph 55 supra, paragraphs 33 and 34, and *Representation of a cowhide*, paragraph 52 supra, paragraph 27).

58 However, that does not mean that the overall impression created in the mind of the relevant public by a complex trade mark may not, in certain circumstances, be dominated by one or more of its components. Furthermore, with regard to the assessment of the dominant character of one or more given components of a complex trade mark, account must be taken, in particular, of the intrinsic qualities of each of those components by comparing them with those of other components. In addition and accessorially, account may be taken of the relative position of the various components within the arrangement of the complex mark (*MATRATZEN*, paragraph 55 supra, paragraphs 34 and 35, and Case T-31/03 *Grupo Sada v OHIM – Sadia (GRUPO SADA)* [2005] ECR II-1667, paragraph 49).

....

68 Therefore, in the global assessment of the likelihood of confusion, the visual, phonetic or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (Case T-129/01 *Alejandro v OHIM – Anheuser Busch (BUDMEN)* [2003] ECR II-2251, paragraph 57, and *NLSPORT, NLJEANS, NLACTIVE and NLCollection*, paragraph 53 supra, paragraph 49). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing marks are marketed. If the goods covered by the marks in question are usually sold in self-service stores where consumers choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any phonetic similarity between the signs (*NLSPORT, NLJEANS, NLACTIVE and NLCollection*, paragraph 53 supra, paragraph 49).

69 Likewise, the degree of phonetic similarity between two marks is of less importance in the case of goods which are marketed in such a way that, when making a purchase, the relevant public usually perceives visually the mark designating those goods (*BASS*, paragraph 56 supra, paragraph 55, and Case T-301/03 *Canali Ireland v OHIM – Canal Jean (CANAL JEAN CO. NEW YORK)* [2005] ECR II-2479, paragraph 55). That is the case with respect to the goods at issue here. Although the applicant states that it is a mail order company, it does not submit that its goods are sold outside normal distribution channels for clothing and shoes (shops) or without a visual assessment of them by the relevant consumer. Moreover, while oral communication in respect of the product and the trade mark is not excluded, the choice of an item of clothing or a pair of shoes 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 (*NLSPORT, NLJEANS, NLACTIVE and NLCollection*, paragraph 53 supra, paragraph 50). The same is true of catalogue selling, which involves as much as does shop selling a visual assessment of the item purchased by the consumer, whether clothing or shoes, and does not generally allow him to obtain the help of a sales assistant. Where a sales discussion by telephone is possible, it takes place usually only after the consumer has consulted the catalogue and seen the goods.

The fact that those products may, in some circumstances, be the subject of discussion between consumers is therefore irrelevant, since, at the time of purchase, the goods in question and, therefore, the marks which are affixed to them are visually perceived by consumers.”

28. The marks are used to market decorative items, personal items (such as sunglasses and bags) and clothing. These are the categories of goods at which the opposition is directed and the purchase of such goods will be largely visual. Hire of clothing is also likely to be on the basis of visual selection. The visual similarity between the marks in this case is therefore of greater importance than it is aurally since the average consumer’s perception of the marks will be formed on the basis of visual inspection of the goods and a visual encounter with the marks under which they are marketed.

29. The intrinsic qualities of the dominant components of the marks are that they signify surnames. Surnames form one of the earliest methods of differentiating one’s goods from those of another (it was common practice in Ancient Greece for potters to inscribe their names on the base of their pots to encourage the spread of their reputation). Consumers are accustomed to their use as natural tools of differentiation, whether in trade (the trade marks of department stores and larger retailers, where a great variety of consumer items are sold, are often personal names/surnames) or in other walks of life. I consider that variations between surnames are unlikely to pass unnoticed. In this case, the surnames differ and the application’s additional elements, perceived visually, also help to put a distance between the marks.

30. Balancing the similarities between the goods and services with the low level of similarity between the marks, my overall conclusion is that there is not a likelihood of confusion. The opposition therefore fails.

Costs

31. The opposition having been failed, HP is entitled to a contribution towards its costs.

Considering notice of opposition	£200
Statement of case in reply	£300
Written submissions	£200
Total	£700

Accordingly, I order Anson’s Herrenhaus KG to pay to Hanson Partners Limited the sum of £700. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 10th day of October 2008

Judi Pike
For the Registrar,
the Comptroller-General