

O-286-16

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3129221 BY
DEAR CHOO LIMITED**

TO REGISTER:

DEAR CHOO

AS A TRADE MARK

IN CLASS 25

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 600000364 BY
J. CHOO LIMITED**

BACKGROUND & PLEADINGS

1. On 30 September 2015, Dear Choo Limited (“the applicant”) applied to register the trade mark **DEAR CHOO** for the following goods in class 25:

Clothing; shirts; jackets; underwear; shoes; hats; hosiery; scarves; shawls; girdles; swimsuits; gloves.

The application was published for opposition purposes on 25 December 2015.

2. The application is opposed in full by J. Choo Limited (“the opponent”) under the fast track opposition procedure. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The trade mark and goods relied upon are shown below:

European Union Trade Mark (“EUTM”) no. 12062832 for the trade mark:

CHOO

which was applied for on 13 August 2013 and which was entered in the register on 8 January 2014:

Class 25 – Clothing, footwear and headgear; scarves; gloves, hats, swimming hats; raincoats, hosiery, sashes for wear, wedding dresses.

3. In its Notice of Opposition, the opponent stated:

“The earlier mark CHOO is contained entirely in the later mark DEAR CHOO. The word DEAR is typically used as a form of address and/or used at the beginning of a written greeting, which emphasises the, albeit rare, surnominal significance of the word CHOO, and the word DEAR would only be accorded a very low level of distinctiveness. The word DEAR is also used as a synonym for “expensive”, and in this instance, would merely be seen as descriptive of an expensive item being sold under the brand CHOO, being identical to the opponent’s earlier trade mark...”

4. The applicant filed a counterstatement in which the basis of the opposition is denied. As these are the only comments I have from the applicant, they are reproduced below in full as presented:

“The applicant deems that the applied trade mark is quite different from the opponent’s registered trade mark. Here are the grounds:

The applied mark consists of the word of “DEAR CHOO” while the opponent's mark consists of the stylized wording “CHOO”. It is easy to tell the difference at the first sight of the two marks and thus, they will not cause any confusions in the market.

Therefore, we deem that the applied will not create any confusion in the mark with the opponent's trade mark and the opponent' opposition could not be workable.”

5. Rule 6 of the Trade Marks (Fast Track Opposition)(Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

6. The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions. No leave was sought in respect of these proceedings.

7. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise written arguments will be taken. A hearing was neither requested nor considered necessary; the opponent filed written submissions which I will refer to, as necessary, below.

DECISION

8. The opposition is based upon section 5(2)(b) of the Act, which reads as follows:

“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.”

9. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“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,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

10. The trade mark upon which the opponent relies qualifies as an earlier trade mark under the above provisions. As this earlier trade mark is not subject to proof of use, the opponent is entitled to rely upon all of the goods it has identified.

Section 5(2)(b) – case law

11. The following principles 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.

The principles:

(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.

Comparison of goods

12. The competing goods are as follows:

Opponent's goods	Applicant's goods
Class 25 - Clothing, footwear and headgear; scarves; gloves, hats, swimming hats; raincoats, hosiery, sashes for wear, wedding dresses.	Class 25 - Clothing; shirts; jackets; underwear; shoes; hats; hosiery; scarves; shawls; girdles; swimsuits; gloves.

13. In *Gérard Meric v Office for Harmonisation in the Internal Market*, 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 trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".

14. As all of the applicant's goods would, at the very least, be encompassed by the phrase "clothing, footwear and headgear" appearing in the opponent's specification, the competing goods are to be regarded as identical on the principle outlined in *Meric*.

The average consumer and the nature of the purchasing act

15. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods at issue; I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

16. The average consumer for the goods at issue is a member of the general public. As to the manner in which such an average consumer will select these goods, in *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs)* Joined cases T-117/03 to T-119/03 and T-171/03, the GC considered the level of attention paid to and the manner in which clothing is selected. It stated:

“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 that 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.

50. The applicant has not mentioned any particular conditions under which the goods are marketed. 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.”

17. As items of clothing, footwear and headgear are, most likely to be the subject of self-selection from traditional retail outlets on the high street, catalogues and websites, visual considerations are likely to dominate the selection process, though not to the extent that aural considerations can be ignored (for example, when orders are placed by telephone or during interactions with sales assistants). The cost of the goods at issue can vary considerably. Nevertheless, as factors such as material, size, colour, cost and compatibility with other items may all come into play, the average consumer, in my experience, will pay an average degree of attention when making their selection. This level of attention, also in my experience, is likely to increase as the cost and importance of the item increases.

Comparison of trade marks

18. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“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.”

19. It would be wrong, therefore, artificially to dissect the trade 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 trade marks. The trade marks to be compared are as follows:

Opponent's trade mark	Applicant's trade mark
CHOO	DEAR CHOO

20. The opponent's trade mark consists of the letters “CHOO” presented in upper case in a non-standard but unremarkable typeface; as no part of the trade mark is highlighted or emphasised in any way, its distinctiveness and the overall impression it will convey, lies in its totality. The applicant's trade mark consists of two words “DEAR” and “CHOO” presented in upper case. In its submissions, the opponent states that:

“6. The earlier mark CHOO...retains an independent and distinctive role within the contested mark...CHOO constitutes the dominant and distinctive element of the contested mark.”

And:

“11...The word DEAR is of low distinctive character. The surname CHOO is relatively rare in the UK and is the dominant element of the contested mark.”

21. A number of the opponent's submissions are based on the premise that the average consumer will know that “CHOO” is a surname. Despite the opponent's submission that: “...CHOO is a surname which is common in Asia” (paragraph 9), it accepts that it “is relatively rare in the UK” (paragraph 11). As to the word “DEAR”,

this has a number of meanings with the opponent pointing to its usage in forms of address/written greetings or as a synonym for expensive.

22. If the average consumer is aware that “CHOO” is a surname, I am prepared to accept it is possible that the words “DEAR CHOO” may be construed as a form of address or, as the opponent submits, may “be understood by the average consumer as a written greeting to a person” (paragraph 9), albeit, in my view, a somewhat unusual form of address or written greeting, as it would be much more normal to also include, for example, a title (such as Mr, Mrs etc.) or a forename. However, if the applicant’s trade mark is construed in this manner, it “hangs-together” to form a unit and the distinctiveness and overall impression created will stem from the trade mark as a whole. Less likely, in my view, is that the word “DEAR”, as the opponent submits, would be construed as meaning expensive. If it were, however, it is likely that once again the distinctiveness and overall impression conveyed by the applicant’s trade mark will stem from the trade mark as a whole e.g. expensive products from a person whose surname is Choo.

23. Notwithstanding the above, in my view, it is equally likely that while the average consumer will be familiar with the word “DEAR”, many will treat “CHOO” as invented. In those circumstances, the components will not “hang together” to form a unit and both are likely to retain an independent role in the applicant’s trade mark. However, as the meaning of the word “DEAR” will be well known and as it may be treated as meaning expensive, it is likely to have less distinctive character than “CHOO”, which, as a consequence, is likely to make a more significant contribution to the overall impression the applicant’s trade mark conveys.

The visual, aural and conceptual comparison

24. Regardless of how the applicant’s trade mark is construed (and notwithstanding that “CHOO” is the second component in its trade mark), the fact that it contains a component which is identical to the opponent’s trade mark, inevitably leads, in my view, to at least an average degree of visual and aural similarity between the competing trade marks. As to the conceptual position, I have explored the various possibilities above. If the average consumer is aware that “CHOO” is a surname, the addition of the word “DEAR” to create a form of address or written greeting (albeit an unusual one) or as a synonym for expensive, does nothing to change the surnominal significance of “CHOO” leading, in my view, to a fairly high degree of conceptual similarity between the trade marks at issue. If the average consumer, however, is unaware that “CHOO” is a surname and they treat it as invented, neither trade mark, in my view, will convey any concrete conceptual message.

Distinctive character of the earlier trade mark

25. 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 – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade 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 trade 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 - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

26. These are fast track opposition proceedings in which it was not necessary for the opponent to provide evidence of the use it may have made of its earlier trade mark. Although in its submissions the opponent states: "The opponent is a well-known luxury goods manufacturer (paragraph 10), as no leave was sought by the opponent to file evidence in support of this claim, I have only the inherent characteristics of the earlier trade mark to consider. Considered on that basis, and even if the average consumer is aware that "CHOO" is a surname, as it is not, in my experience a common surname in this country (and there is no evidence or submissions to the contrary), it is possessed of an above average degree of inherent distinctive character. If treated as invented, "CHOO" is possessed of a high degree of inherent distinctive character.

Likelihood of confusion

27. 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 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, 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.

28. I begin by reminding myself that earlier in this decision I concluded that: (i) the competing goods are identical, (ii) the average consumer is a member of the general public who will select the goods by predominantly visual means and who will pay an average degree of attention during that process, (iii) the competing trade marks are visually and aurally similar to at least an average degree and potentially conceptually similar to a fairly high degree and (iv) the opponent's earlier trade mark is (at worst) possessed of an above average degree of inherent distinctive character.

29. Irrespective of how the average consumer treats "CHOO", the presence of the word "DEAR" in the applicant's trade mark, in my view, is unlikely to go unnoticed and its presence militates against direct confusion i.e. where one trade mark is mistaken for the other. However, if the average consumer treats "CHOO" as a surname, its presence in the applicant's trade mark (which may lead to it being treated as either a form of address, written greeting or as meaning expensive goods from..) will, in my view, result in a likelihood of indirect confusion i.e. in which the similarities between the competing trade marks (arising from the use of the (at least) above averagely distinctive component "CHOO") will lead the average consumer to assume that the identical goods at issue are from the same or economically linked undertakings. I reach the same conclusion even where the average consumer does not accord "CHOO" surnominal significance. In those circumstances, the "CHOO"

component retains an independent and distinctive role in the applicant's trade mark, once again leading to a likelihood of indirect confusion.

Overall conclusion

30. The opposition succeeds in full and, subject to any successful appeal, the application will be refused.

Costs

31. As the opponent has been successful, it is entitled to a contribution towards its costs. Awards of costs in fast track opposition proceedings filed after 1 October 2015 are governed by Tribunal Practice Notice ("TPN") 2 of 2015. Using that TPN as a guide, I award costs to the opponent on the following basis:

Official fee:	£100
Preparing a statement and considering the applicant's statement:	£200
Written submissions:	£200
Total:	£500

32. I order Dear Choo Limited to pay to J. Choo Limited the sum of **£500**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 14th day of June 2016

C J BOWEN
For the Registrar