

O-303-17

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 3031086
BY PIA HALLSTROM LIMITED TO REGISTER THE TRADE MARK

PIA HALLSTROM IN CLASSES 14, 18 AND 25

AND IN THE MATTER OF OPPOSITION THERETO UNDER NO 401741
BY JOHN RICHARD BEALE

DECISION

INTRODUCTION

1. On 18 November 2013, Pia Hallstrom Limited (“the applicant/respondent”) applied under the Trade Marks Act 1994 (“the Act”) for registration of the mark **PIA HALLSTROM** in respect of the following list of goods:

Class 14: Jewellery articles; Jewellery being articles of precious metals;
Jewellery being articles of precious stones.

Class 18: Handbags, purses and wallets.

Class 25: Clothing, footwear, headgear.

2. On 11 February 2014, John Richard Beale (“the opponent”) opposed the application on the grounds that it was contrary section 5(2)(b) of the Act because it was said to be too similar to two earlier marks in the name of the opponent and in respect of identical or similar goods and that, because of these similarities, a likelihood of confusion exists. The opponent also relied on section 5(4) of the Act. The relevant details of the two earlier marks relied upon are (as set out in the decision):

2311309 PIA Filing date: 21 September 2002 Date of entry in register: 7 March 2003	Class 14: Jewellery made from gold, silver, precious and semi-precious stones, costume jewellery, clocks and watches, silver plated trinket boxes and pill boxes. Class 18: Handbags, purses and travelling bags made of leather and of textile.
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and

Community Trade Mark (CTM) 4077996 PIA Filing date: 18 October 2004 Date of entry in register: 17 January 2006	Class 14: Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments. Class 18: Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery. Class 25: Clothing, footwear, headgear.
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THE APPEAL

3. The hearing officer rejected the opposition and the opponent appealed. The appeal came before me at a hearing on 3 May 2017. The opponent's Grounds of Appeal challenged each aspect of the decision.
4. The opponent was represented and provided a comprehensive skeleton argument as well as helpful and well-considered oral submissions. Ms Hallstrom's company, the applicant, was not represented. Owing to an administrative mix-up, there was no shorthand writer but the opponent agreed that the hearing could go ahead without.

APPROACH TO APPEAL

5. The approach to an appeal of this kind is not in dispute. In the following passage of *Apple Inc v Arcadia Trading Ltd* [2017] EWHC 440 (Ch) (10 March 2017) Arnold J approved the summary of the principles in *TT Education Ltd v Pie Corbett Consultancy Ltd* (O/017/17) which are as follows:

“Standard of review

The principles applicable on an appeal from the Registrar of Trade Mark were recently considered in detail by Daniel Alexander QC sitting as the Appointed Person in *TT Education Ltd v Pie Corbett Consultancy Ltd* (O/017/17) at [14]-[52]. Neither party took issue with his summary at [52], which is equally applicable in this jurisdiction:

"(i) Appeals to the Appointed Person are limited to a review of the decision of Registrar (CPR 52.11). The Appointed Person will overturn a decision of the Registrar if, but only if, it is wrong (Patents Act 1977, CPR 52.11).

(ii) The approach required depends on the nature of decision in question (*REEF*). There is spectrum of appropriate respect for the Registrar's determination depending on the nature of the decision. At one end of the spectrum are decisions of primary fact reached after an evaluation of oral evidence where credibility is in issue and purely discretionary decisions. Further along the spectrum are multi-factorial decisions often dependent on inferences and an analysis of documentary material (*REEF, DuPont*).

(iii) In the case of conclusions on primary facts it is only in a rare case, such as where that conclusion was one for which there was no evidence in support, which was based on a misunderstanding of the evidence, or which no reasonable judge could have reached, that the Appointed Person should interfere with it (*Re: B* and others).

(iv) In the case of a multifactorial assessment or evaluation, the Appointed Person should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions. In particular, where an Appointed Person has doubts as to whether the Registrar was right, he or she should consider with particular care whether the decision really was wrong or whether it is just not one which the appellate court would have made in a situation where reasonable people may differ as to the outcome of such a multifactorial evaluation (*REEF, BUD, Fine & Country* and others).

(v) Situations where the Registrar's decision will be treated as wrong encompass those in which a decision is (a) unsupportable, (b) simply

wrong (c) where the view expressed by the Registrar is one about which the Appointed Person is doubtful but, on balance, concludes was wrong. It is not necessary for the degree of error to be 'clearly' or 'plainly' wrong to warrant appellate interference but mere doubt about the decision will not suffice. However, in the case of a doubtful decision, if and only if, after anxious consideration, the Appointed Person adheres to his or her view that the Registrar's decision was wrong, should the appeal be allowed (*Re: B*).

(vi) The Appointed Person should not treat a decision as containing an error of principle simply because of a belief that the decision could have been better expressed. Appellate courts should not rush to find misdirections warranting reversal simply because they might have reached a different conclusion on the facts or expressed themselves differently. Moreover, in evaluating the evidence the Appointed Person is entitled to assume, absent good reason to the contrary, that the Registrar has taken all of the evidence into account. (*REEF, Henderson and others*)."

GROUND OF APPEAL

6. I will consider the grounds of appeal in turn, albeit grouping some of the points and arguments made together, where appropriate. The central point made by the opponent is that the hearing officer wrongly evaluated the likelihood of confusion (Ground 3 of the Grounds of Appeal) as a result of an erroneous approach to one or more of the factors involved in that analysis. I therefore consider those alleged errors based on the Grounds of Appeal and then consider the position more broadly.

A. Section 5(2)(b) - principles

7. The Hearing Officer summarised the law as follows and no criticism is made of it.

"12). 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:

(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.”

8. The Hearing Officer went on to consider whether the goods were identical or similar and unsurprisingly found that they were identical, correctly rejecting an argument that the different position in the market of the respective jewellery products led to dissimilarity. However, he found that, having regard in particular to the nature of the marks, there was no likelihood of confusion. The opponent submitted that the hearing officer was wrong for the following reasons.

(i) The mark as a name of a person (Grounds 1 and 2, part of Ground 3)

9. First it is contended that the hearing officer wrongly held that the mark applied for was the name of a person or, more strictly, that it would be perceived as such by the average consumer.

10. This issue was analysed in detail by the hearing officer in a passage which bears setting out in full.

“25) The opponent’s mark consists of the single word PIA and this is obviously the dominant and distinctive element of the mark. The applicant’s mark consists of the two words PIA HALLSTROM. This is likely to be perceived by the average consumer as a full name of an individual. Neither of these words appear to be common names in the UK and certainly there is no evidence to suggest that they are. Surnames have generally been accepted to have greater distinctive character than forenames (see, for example, *El Corte Inglés, SA v OHIM*, Case T-39/10, paragraph 54). However, recent decisions from the GC and High Court in *Giovanni Cosmetics Inc. v OHIM, Vasconcelos & Gonçalves SA*, T-559/13 (“GIOVANNI”) and in *Whyte and Mackay Limited v Origin Wine UK Limited & Dolce Co Invest Inc*, [2015] EWHC 1271 (Ch) (“WHYTE AND MACKAY”) respectively suggest that this should not be a general rule.

26) In the *MEDION* case (paragraph 30) the CJEU stated that “it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant part”. The court went on to comment that a finding of likelihood of confusion should not be subject upon the condition that the part of the mark that is represented by the earlier mark should be the dominant part of the mark. However, Arnold J in his recent judgment in [*WHYTE AND MACKAY*], when discussing this principle, stated: “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)”.

27) In light of the very recent nature of the *WHITE AND MACKAY* and *GIOVANNI* cases, the parties were given the opportunity of commenting on their relevance to the current proceedings. The applicant submitted that both cases appeared to support the understanding that surnames are more distinctive than first names and that, when there are two components in a mark, one component is qualified by the second component.

28) The opponent submitted that in paragraph 20 of his decision, Arnold J was merely stating the legal arguments of the Appellant in respect of the first ground for appeal in that case. That is not the case. His reference to “this principle” related to the principle established in *MEDION* and his reference to “The second point” is a reference to what he perceives as the second of three points that the CJEU confirmed in its *BIMBO* judgment. In other words, Arnold J was discussing the relevant case law and not the legal arguments of the Appellant.

29) In respect of the *GIOVANNI* case, the opponent submits that difficulty exists because of a conflicting line of decisions following *MEDION*. As the opponent points out, the principle set out in *MEDION* is that there may be likelihood of confusion where the contested mark is composed of an element that constitutes a company name with a registered mark and where that company name “does not determine the overall impression conveyed by the composite mark, but still has an independent distinctive role. The key point in the current proceedings is that, as per Arnold J’s comment in paragraph 20 in *WHYTE AND MACKAY*, the word PIA does not have an independent distinctive role in the mark PIA HALSTROM because it merely functions as part of a unit to identify the name of a particular person. This is different to all the marks discussed in the case law cited by the opponent, namely *GLAXO WELLCOME*, *BULLOVER ACCUTRON*, *DEBUR UVEDA* and *THOMSON LIFE*. In all these examples, each word was considered to have independent distinctive character, unlike in the current case. My finding in this case is reinforced by the comments of Mr Geoffrey Hobbs QC in *Novartis Seeds BV’s Application* [2006] ETMR 82 (and mentioned with approval by Arnold J in *Avida Corp v Debur India Ltd* [2013] EWHC 589 (Ch) where he concluded that in the mark *ERIC CANTONA CANTO* that *ERIC CANTONA* had independent significance. The implication being that the word *ERIC* alone did not.

30) In summary, having regard for the comments in both the *GIOVANNI* and *WHITE AND MACKAY* judgments and also the parties’ submissions in respect of these together with the historical case law on the point, I conclude that the two words PIA HALLSTROM

make up a full name, functioning as a unit to identify a particular individual to the average consumer and neither element has a greater relative weight than the other.

31) Visually and aurally, both marks contain the word PIA and this creates an element of visual and aural similarity. In addition the applicant's mark also includes the word HALLSTROM. This is absent in the opponent's mark and is, therefore, a point of dissimilarity. The word PIA is relatively short in length, whereas the word HALLSTROM is of longer length. Taking these factors into account, I conclude that the respective marks share a reasonable low level of visual and aural similarity.

32) Conceptually, it is not clear to me that, when the word PIA is used alone, that it will be perceived as a forename at all, however, even if it is, it will be perceived as a reference to any individual whose forename is PIA. On the other hand, the applicant's mark relates to a specific individual named PIA HALLSTROM, where the word PIA appears before a family name, reinforcing the impression that it is a first name. It is not clear to me that such an impression attaches to the word PIA when it is not juxtaposed with a family name (and such a view appears to be consistent with the submissions of the opponent). It is my view that these similarities and differences combine to create only a low degree of conceptual similarity."

11. The opponent's central criticism is that the hearing officer was not entitled to reach the conclusion he did in para. 32 of the decision because it was not based on how the average consumer would perceive the sign and was, instead, illegitimately based on the hearing officer having read the evidence provided by the applicant that the two words form a name. Thus, it is argued, the hearing officer was not putting himself into the position of the average consumer and was basing his views on impermissible evidence.

12. I am not persuaded by that criticism for the following reasons.

13. First, there is no doubt that "PIA HALLSTROM" is, in fact, the name of the individual behind the applicant and the opponent does not on this appeal contend that it is not. I am unable to accept the opponent's submission that the hearing officer was not entitled to find that it was a name on the material before him. Although it is true that there is no evidence that the forename "PIA" is a common name in the UK, the opponent did not contend that it was a completely unknown name here. "HALLSTROM" is not a well-known term either but

combined with “PIA”, as a whole, it has the feel of a name. It is true, as the opponent submits, that the commonness or otherwise of this element of the “PIA” name is not a matter of which judicial notice may be taken but, in my judgment, that is not the key issue. The key point is whether the mark, taken as a whole, would appear to the average consumer to be what it is namely a full name. In my judgment, the hearing officer was entitled to hold, as he did in effect, that it would be so taken. He did not fall into error in taking as his starting point that the respective marks would be taken by the average consumer to be the kind of marks that in fact they were (in this case, for “PIA HALLSTROM”, a name).

14. Second, in this connection, the goods for which the mark is proposed to be registered are, in broad terms, fashion articles. For such articles, there is a well-established practice, of which in my view any tribunal is entitled to take judicial notice, of the use of two-word brands comprising the full names (forename and surname) of the designer of the products in question. Although in some cases such designers may also have brands which comprise one or other, but not both, of first name or surname, the average consumer of the goods in question is likely to be well accustomed to treating such two-word marks as names, comprising a first name and a surname. That would provide support for the average consumer’s perception of the applicant’s mark which the hearing officer used for his evaluation.

15. Third, if the term “PIA” on its own is perceived to be a name, it does not follow that the average consumer would imagine that the only person with such a name would be the person behind (or the person after whom) the opponent’s business was named. Thus, the mere fact that the name “JOHN” is likely to be perceived by most people as a name does not thereby mean that an average consumer would automatically or probably suppose that goods branded “JOHN SMITH” would come from the same trade source as those branded “JOHN”. In some contexts and depending on the particular evidence in a case, such a finding with might be warranted but I do not consider that there is a general rule. The hearing officer was right, in this context, to say that the authorities did not establish any

such general rule and, in the case of marks of this kind, it would not be right to proceed on this basis.

16. For these reasons, I also do not accept the submission that the hearing officer's decision was internally inconsistent as to the character of the word "PIA". It is true that he said that it was not clear that the word "PIA" used alone would not necessarily be perceived as a forename. But that does not seem to me to be inconsistent with the view that "PIA HALLSTROM" would be taken to be a mark comprising a forename and a surname.
17. The hearing officer concluded at para. 34 that the distinctive character of the respective marks was not particularly high because forenames serve to indicate any number of individuals. That, as the opponent contends, is not easy to square, as a matter of language, with the hearing officer's conclusion that "PIA" would not necessarily be perceived as a forename taken alone. However, in my view, what the hearing officer was really saying in that passage was that in so far as the similarity of the marks rested on a similarity in the "PIA" element, there were good reasons for the average consumer not to treat that element as distinctive. To that extent he was justified. Moreover, he did not rest his finding on this since he also concluded that the name "PIA" struck him as "somewhat unusual" and that its level of distinctiveness would be higher than for a more common forename. That was the right approach.
18. It was not therefore necessary for the hearing officer to undertake a further separate analysis in terms of independent distinctive significance of the kind discussed in *Medion*. He was entitled to take the respective marks and compare them as a whole, having regard to how each, taken as a whole, would be perceived. There is nothing in the judgment of the CJEU in that case which suggests that the mere fact that marks share a common element means that they will be treated as confusingly similar. In many composite marks, the common element has no or very limited independent distinctive role. In effect, that is what the hearing officer held was the case here and he cannot be criticised for doing so.

(ii) The nature of the average consumer (part of Ground 3)

19. The hearing officer addressed the question of the average consumer as follows:

“20) 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 or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. 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.”

21) As I explained in paragraph 18, above, I must undertake a notional analysis of the respective goods. This notional analysis will require me to also consider who the average consumer is for such notional goods. Such an analysis will preclude me finding that, because the applicant’s activity is actually in high-end, expensive jewellery, then the average consumer is highly sophisticated and the purchasing process is carefully considered. Both parties’ specifications cover goods from across the cost spectrum. Therefore, whilst I keep in mind that some of these goods may be high-end and expensive, the majority of such goods are not and the average consumer pays a reasonable, but not the highest level of attention during the purchasing process for such goods. For goods in all three classes, it is essentially a visual purchase with all the goods being either fashion items or personal decorative items where aesthetic qualities are important. That said, I do not ignore that in some circumstances, aural considerations may be a factor.”

20. The opponent criticises this analysis on the basis that the hearing officer was thereby substituting his own views for those of the average consumer. The opponent drew attention to the particular difficulties in the tribunal putting itself into the position of, for example, “a 17 to 25 year old female living in the North of England” (in the words of Warren J in *Wasbi Frong v. Miss Boo* [2009] EWHC 2767 at [25]).

21. I am not persuaded by this criticism. In this section, the hearing officer was merely drawing attention to the fact that the goods in question were of a kind to which an average degree of attention would be paid in selecting them and that a purchase would primarily be undertaken visually rather than orally. These were justified observations.

22. Moreover, I do not consider that the hearing officer fell into error in attributing to the average consumer characteristics leading to an understanding of the respective marks discussed above for the reasons I have given. It is true that he did not have much material to go on but his conclusion was a reasonable one, which cannot be described as wrong.

(iii) Comparison of signs (part of Ground 3)

23. The Hearing Officer then made a detailed comparison of the marks “PIA” and “PIA HALLSTROM” with a view to determining whether they were sufficiently similar to lead to confusion within the meaning of section 5(2)(b).

24. He dealt with this issue particularly comprehensively with reference to the discussion in the recent High Court case law where a sign is said to be similar in virtue of sharing an identical common element. The key aspects of the reasoning are set out above.

25. Such an issue has arisen in the context of composite marks of various kinds including personal names involving first and surname element but each case turns on its facts, including the specific characteristics of the mark applied for and the earlier mark, the nature of the goods or services for which it is proposed to be registered and the context of the market. His evaluation was, again, not open to criticism.

(iv) The opponent’s reputation (part of Ground 3)

26. The opponent criticizes the hearing officer for having under-evaluated the reputation of the “PIA” mark and, it is said, overlooked or wrongly analysed key evidence about turnover. As the opponent submitted, in the 5 years up to the end of 2013, its turnover exceeded £50 million and between 2006-2013, the

opponent had spent over £10 million on advertising of its mark. The evaluation of the evidence in paragraph 35 of the decision appears to have erroneously understated the full extent of sales. The hearing officer concluded in that paragraph that the mark “had a presence in the UK sufficient to result in an enhanced level of distinctive character, but taking account of the size of the fashion/jewellery/clothing sector, such use still indicates a very small proportion of the market sector.” However, the hearing officer went on to say that, because of this, any enhancement to distinctive character “will not be significant”.

27. Again, in my judgment, the hearing officer’s approach cannot be criticized in substance. It is true that he did not have material against which to judge the significance of this sort of turnover in the fashion/jewellery/clothing sector but it is well-known that major high street brands have turnovers orders of magnitude greater than this. More fundamentally, it is well established that mere volume of use does not, of itself, increase the propensity of marks to cause confusion. Extensive use may increase the distinctiveness in the sense that it may make the mark more well-known but it does not follow that it will therefore be afforded a greater scope of protection under section 5(2)(b).

28. There is, in my judgment, nothing in the nature of the use of the “PIA” mark, as opposed to its extent, which is likely to increase the likelihood of the average consumer treating the sign “PIA HALLSTROM” as confusingly similar to it. That is to say, even had the enhanced extent of reputation been taken into account, I do not consider that it would have made a difference to the evaluation. Moreover, the hearing officer would have been entitled to conclude, even on the basis of the larger figures of turnover and advertising, that the mark had only a modest degree of enhanced distinctiveness. He therefore took that factor properly into account.

(v) Indirect confusion (part of Ground 3)

29. The opponent criticizes the hearing officer for failing explicitly to deal with the possibility of indirect confusion whereby the average consumer would (for example) consider that “PIA HALLSTROM” was a brand extension of the “PIA” brand, with the “HALLSTROM” element indicating the sub-brand. The

opponent contended that the hearing officer had failed to follow the approach set out in *Whyte and Mackay* and that the average consumer would treat “HALLSTROM” as (for example) a range of handbags or shoes of the “PIA” brand or the name of a shop in which “PIA” goods were sold. That seems to me inherently unlikely unless the words “PIA” and “HALLSTROM” were presented in some way separately or differently and there is nothing in the mark as such which suggests that this is to be expected.

30. The hearing officer carefully analysed the *Whyte and Mackay* case law and other recent cases (see passages cited above) and applied it to the facts. The hearing officer said at paras. 39-40:

“39) The opponent submits that it is not uncommon for companies to have premium brands alongside a more affordable brand and where the same partial branding is used. The argument has some support from the GC, for example, in *Zero Industry Srl v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-400/06*, where it commented:

78 Second, the Board of Appeal also pointed out in paragraph 25 of the contested decision that, as regards the conditions in which the goods in question are marketed, it is not unusual in the clothing business for the same mark to be configured in various ways according to the product it designates. It is also common, in its view, for the same clothing manufacturer to use sub-brands in order to distinguish its various lines from those of others. It therefore concluded that it is conceivable that consumers may associate zero^{rh+} and zero and regard the marks at issue as designating different ranges of products coming from the same manufacturer.

40) I must give full regard for all the factors in the global appreciation test, I am of the view that the differences between the marks are sufficient for the consumer to not confuse one mark with the other, so called “direct confusion”. Neither do I find that there is any indirect confusion whereby the consumer is likely to believe that goods provided under the respective marks originate from the same or linked undertaking. It is not clear to me that when the word PIA is used alone that it will be seen as a forename and therefore any connection with the mark PIA HALLSTROM is lost. The mark PIA HALLSTROM however, will be perceived as a unit that is a full name. I note the submission that use of sub brands is reasonably common in the field of interest to the parties. However, this does not automatically lead to a finding of confusion. It is but one factor to take into account in the global appreciation of the facts of the case. Even if use of the word PIA alone would be seen as use of a forename, because it can be a reference to any one individual bearing the name, it will do no more than prompt the

average consumer to wonder about a connection to the mark PIA HALLSTROM. Such a weak connection falls short of resulting in a likelihood of confusion. Therefore, having regard for this and taking account the recent guidance from the courts in *Giovanni Cosmetics Inc. v OHIM, Vasconcelos & Gonçalves SA, Whyte and Mackay Limited v Origin Wine UK Limited & Dolce Co Invest Inc* and, of course *MEDION*, I conclude that there is no likelihood of confusion.

41) In reaching this conclusion I have kept in mind that the respective goods are identical goods, that the marks will both be perceived as names, that the opponent's mark consists of a word that is present in the applicant's mark and that, as a forename, it does not appear to be particularly common."

31. The hearing officer clearly took account of this and he was right to say that it was only a factor in the global appreciation. I am not satisfied that the hearing officer was wrong in the conclusion he reached in this respect.

(vi) Overall evaluation (part of Ground 3)

32. Evaluations of a likelihood of confusion are not always easy when there is limited evidence to establish how actual consumers perceive respective marks. There was, in this case, no evidence to suggest that there was a likelihood of confusion between the marks and, in my view, they are not inherently likely to confuse.

33. 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).

34. Accordingly, stepping back from the individual grounds of appeal and looking at the matter in the round, I do not consider that the hearing officer was wrong to hold that there was no likelihood of confusion.

35. The grounds of appeal under section 5(2)(b) are not made out.

B. PASSING OFF (section 5(4)(a)) (Ground 4)

36. The hearing officer reached the same conclusion under this head for similar reasons to those analyzed above. The appellant criticizes the hearing officer's decision under this head on two grounds, principally the latter.

(i) Goodwill

37. First, it is said that the hearing officer did not properly evaluate the extensive goodwill of the opponent in the mark PIA. The hearing officer said at para. 47:

“Details of the scale of the opponent's use of the mark are provided by Mr Beale in his evidence. This illustrates that the opponent has used its PIA mark in the UK since at least 2005 (there is a claim to use from 2002) in respect of various items of ladies clothing (as well as jewellery). There is also evidence of promotional activities in the UK in national publications and that the opponent has 15 stores in the UK where its own brand goods are sold. Whilst the UK turnover figures are not broken down to reflect the various categories of goods the opponent provides, when taking all the evidence into account, I have little hesitation in concluding that it has demonstrated the requisite goodwill.

38. The opponent draws attention to the unchallenged evidence relating to the extensive sales and marketing of jewellery by the opponent both through its stores and online, under the mark PIA. However, the hearing officer found unequivocally, even on the basis of the somewhat lower figures he referred to in the decision than those the opponent says should have been used that the opponent “undoubtedly” had the requisite goodwill. I do not think that the understatement of turnover (for example) to which I have drawn attention above made a difference and, ultimately, this was not suggested to be a separate basis for challenging the decision.

(ii) Misrepresentation

39. Second, the opponent contends that the hearing officer's conclusion that there would be no misrepresentation was flawed for the same reasons as those relied

on with respect to section 5(2)(b). The opponent accepts that the hearing officer cited the correct law (he used the summary in *Neutrogena* referred to at para. 48 of the decision). He also accepted that the arguments under this head are, on the facts of the present case, essentially the same as those applicable to section 5(2)(b) since the key question in each case is whether there would be a likelihood of confusion; in one case, for the average consumer and, in the other, for a sufficiently substantial number of members of the relevant public.

40. The hearing officer referred to the reasons he had given at para. 40 of the decision, reproduced above, and said that they were equally applicable to passing off. In my judgment he was justified in doing so in this case. Given that he had held that the nature of the marks and how they would be perceived by the average consumer would not lead to a likelihood of confusion, it was reasonable to hold that likewise a substantial number of members of the public would not be likely to be confused as a result of the common element “PIA” in the respective marks.

41. For these reasons, this ground of appeal under section 5(4) is also not made out.

OVERALL CONCLUSION

42. The appeal must be dismissed.

Costs

43. As to costs, it is not clear that the applicant incurred any substantial costs in defending this appeal. However, it would have been necessary to consider the written submissions of the opponent and the grounds of appeal. The hearing officer provided for a contribution to the costs of this aspect in the modest sum of £100. The same sum is appropriate on this appeal. Accordingly, including the total costs of £450 awarded before the hearing officer, I award the applicant the total sum of £550 by way of costs, which should be paid within 14 days.

DANIEL ALEXANDER QC
APPOINTED PERSON

26 June 2017

Bernard Whyatt of Brand Protect for the opponent; the applicant was not represented.