

O-369-17

**TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO 3203395
BY CORI INTERNATIONAL LIMITED
TO REGISTER**

CORI

**AS A TRADE MARK
IN CLASSES 3, 14, 16, 25, 26, 38
AND OPPOSITION THERETO (UNDER NO. 60000587)
BY
DEWHURST DENT PLC**

BACKGROUND AND PLEADINGS

1. Cori International limited ('the applicant') applied to register the trade mark **CORI** on 21 December 2016. It was accepted and published on 6 January 2017 in respect of classes 3, 14, 16, 25, 26 and 38. For the purpose of this decision it is only necessary to set out the goods in class 25 as only this class is subject to opposition. The specification in class 25 reads:

Clothing; footwear; headgear; swimwear; sportswear; leisurewear.

2. Dewhurst Dent PLC ('the opponent') opposed the trade mark under Section 5(2)(b) of the Trade Marks Act 1994 (the Act) and under the fast track opposition procedure. The opposition is on the basis of its earlier European Union Trade Mark set out below. This mark is registered in classes 20, 24 and 25 but it is only class 25 which forms the basis of the opposition.

| Mark relied on | Goods relied on |
|--|--|
| EU TM No. 12901625 CORGI Filing Date: 23 May 2014 Registration Date: 15 October 2014 | Class 25 - Clothing; articles of outer-clothing; casual wear; socks; coats; scarves; hats; headgear; jumpers; knitwear; hosiery; gloves; belts (for wear); lingerie. |

3. The applicant filed a counterstatement denying the grounds of opposition.

4. The opponent's above mentioned trade mark is an earlier mark, in accordance with Section 6 of the Act, but is not subject to proof of use requirements as it had not been registered for five years or more before the publication date of the applicant's mark, as per section 6A of the Act.

5. Rules 20(1)-(3) of the Trade marks Rules ("TMR") (the provisions which provide for the filing of evidence) do not apply to fast track oppositions but Rule 20(4) does. It reads:

“(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 effect of the above is to require parties to seek leave in order to file evidence (other than the proof of use evidence which is filed with the notice of opposition) in fast track oppositions. No leave was sought in respect of these proceedings.

7. Rules 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 not requested nor considered necessary in this case. Only the opponent supplied written submissions. This decision is taken following a careful reading of all the papers.

9. The applicant represented themselves in these proceedings whilst the opponent was represented by Novagraaf UK.

SECTION 5(2)(B)

10. Section 5(2)(b) of the Act is 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.

11. The leading authorities which guide me are from the Court of Justice of the European Union (‘CJEU’): *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 THE GOODS

12. The goods to be compared in this case are:

| Opponent's goods | Applicant's goods |
|--|---|
| Class 25 - Clothing; articles of outer-clothing; casual wear; socks; coats; scarves; hats; headgear; jumpers; knitwear; hosiery; gloves; belts (for wear); lingerie. | Class 25 - Clothing; footwear; headgear; swimwear; sportswear; leisurewear. |

13. With regard to the comparison of goods, in *Canon*, the CJEU stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all

the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

14. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) 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;
- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

15. In their counterstatement the applicants submits that ‘swimwear’ and ‘sportswear’ should be considered differently to clothing at large because of the nature of the manufacturing process and distribution channels, viz.:

“...It is unlikely that the average consumer would assume that sportswear and swimwear would necessarily be sold by any clothing distributor or retail shops because the source of manufacturing is entirely different... Swimwear is subject to their own additional quality control and test, which contrasts the typical process for producing general clothing, i.e. t-shirts and trousers...”

And

“...with respect to sportswear the materials are fundamentally different to clothing in the sense that the sportswear materials may include dri-fit, spandex, latex. These materials are specifically tailored to high performances in sports. As such, clothing factories may not use these specific materials when producing general attire, such as casual wear. Moreover the nature of sportswear is entirely different as clothing is merely attire, whereas sportswear is clothing purposely used for sport...”

16. Whilst I note that the material (i.e. fabric) properties of swimwear or sportswear may be different, they are still considered to be garments for wear and as such should be considered in relation to ‘clothing’ at large. Furthermore I must compare the parties’ goods on the basis of notional and fair use of the goods listed in the parties’ specifications. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. stated that:

“78.the court must.... consider a notional and fair use of that mark in relation to all of the goods or services in respect of which it is registered. Of course it may have become more distinctive as a result of the use which has been made of it. If so, that is a matter to be taken into account for, as the Court of Justice reiterated in *Canon* at paragraph [18], the more distinctive the earlier mark, the greater the risk of confusion. But it may not have been used at all, or it may only have been used in relation to some of the goods or services falling within the specification, and such use may have been on a small scale. In such a case the proprietor is still entitled to protection against the use of a similar sign in relation to similar goods if the use is such as to give rise to a likelihood of confusion.”

17. In addition in *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06, the CJEU stated at paragraph 66 of its judgment that when assessing the likelihood of confusion under Section 5(2) it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered. In *Oakley v OHIM* (case T-116/06) it is made clear that consideration of likelihood of confusion is prospective and not to be restricted to the current marketing or trading patterns of the parties:

“...since the particular circumstances in which the goods covered by the marks are marketed may vary in time, and depending on the wishes of the proprietors of the trade marks, the prospective analysis of the likelihood of confusion between the two marks, ...cannot be dependent on the commercial intentions, whether carried out or not – and which are naturally subjective –of the trade mark proprietors...”

18. In *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM Case T-133/05) (*‘Meric’*), the General Court (*‘GC’*) held:

“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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

19. Both the opponent’s and applicant’s specifications contain the identical terms ‘clothing’ and ‘headgear’. With regard to the applicant’s remaining terms, namely ‘footwear; swimwear; sportswear; leisurewear’, these will be covered by the opponent’s term ‘clothing’ which covers the goods at issue and therefore falls under the *Meri*c principle outlined above.

AVERAGE CONSUMER AND THE PURCHASING PROCESS

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*.

21. 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.”

22. The contested goods in this case are ‘clothing; footwear; headgear; swimwear; sportswear; leisurewear’ which I have concluded are all covered by the term ‘clothing’ at large. 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 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.

53. 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.”

23. The average consumer for the contested goods are the general public. As stated by the GC, items of clothing vary in price and quality. The same would apply to footwear and headgear. Ordinarily I would expect a normal level of attention to be paid by the consumer when selecting such goods. The purchasing act will be mainly visual and will likely be based on the aesthetic appeal of an item, its fit and style as well its suitability for use in different activities. It is likely that goods will be selected after perusal of racks/shelves in retail establishments, or from images on Internet websites or in catalogues. However, I do not discount aural considerations which may also play a part.

COMPARISON OF THE MARKS

24. The marks to be compared are:

| Opponent's mark | Applicant's mark |
|-----------------|------------------|
| CORGI | CORI |

25. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated 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.”

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

27. The opponent's mark consists of the word **CORGI** in plain block capitals. The overall impression is based solely on this word. The applicant's mark consists of the letters **CORI** in plain block capitals. The overall impression is based solely on this combination of letters.

28. In a visual comparison of the marks, the point of similarity are the letters C, O, R and I. These letters form the whole of the applicant's mark and four out of five letters of the opponent's mark. In their counterstatement, the applicant submits that:

“the shorter a sign, the more easily the public is able to perceive all its single elements”,

whereas the opponent contends in their submissions that:

“the difference is contained within the middle of the mark and bearing in mind the imperfect recollection of consumer, could easily be overlooked”.

Both marks consist of short words but in my view a single letter difference in a short word will have a greater visual impact than it might in a longer word. Overall I find there is only a medium degree of visual similarity.

29. In an aural comparison of the mark, the opponent's mark will be verbalised as 'corg-ee' as the average consumer will recognise the word as a well-known breed of dog and accord it the usual pronunciation. The applicant's mark is likely to be perceived as an invented word and may be pronounced either as 'coree' or 'coreye'. If the pronunciation is 'coree' then it becomes much closer to the opponent's mark in an aural comparison. If however the mark is pronounced 'coreye' then it becomes less similar. Overall I find there to be at least a medium degree of aural similarity.

30. In a conceptual comparison and as stated previously the average consumer will recognise the opponent's mark as the well-known breed of small dog. The applicant has stated that his mark, CORI, is "a Gaelic female baby name". It may be the case that some average consumers will recognise CORI as a forename. However it is not a common forename in the UK, therefore in my view a significant proportion of average consumers will not recognise it as such and the word not have an immediately graspable concept¹ to them. Overall I find that there is no conceptual similarity between the marks.

DISTINCTIVE CHARACTER OF THE EARLIER MARK

31. The distinctive character of the earlier mark must be considered. The more distinctive it is, either inherently or through use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer*, the CJEU stated that:

"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined

¹ It has been highlighted in numerous judgments such as *The Picasso Estate v OHIM*, Case C-361/04 that it is only concepts capable of immediate grasp by the consumer that are relevant.

Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

32. The opponent did not file any evidence showing use of the earlier mark for the services relied on as these are fast track opposition proceedings, so I can only consider the inherent distinctiveness of the earlier mark.

33. Although the word **CORGI** is descriptive of a particular breed of dog, it is not descriptive of the goods at issue in class 25. On that basis, I find that there is an average level of inherent distinctiveness.

LIKELIHOOD OF CONFUSION

34. I must now draw together my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors and those outlined in paragraph 9:

- a) The interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon*).
- b) The principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*).

- c) The factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer*).

35. So far I have found that the goods at issue in class 25 are identical and that the average consumer is a member of the general public who will select the goods by primarily visual means whilst paying a normal degree of attention during the purchasing process. In addition, I have found that the opponent's mark is of average distinctiveness. With regard to the comparison of the marks I have found that the marks are visually similar to a medium degree, aurally similar to a medium degree and conceptually dissimilar.

36. I have reviewed my findings in conjunction with the principles outlined above and in paragraph 9 especially in relation to points (c) and (d). As these are both short, single word only marks, the average consumer will perceive them as a whole. From the overall impression created by the opponent's mark, the consumer will perceive the well-known dictionary word 'corgi'. In relation to the overall impression of the applicant's mark, a minority of average consumers may possibly perceive a forename but the majority are more likely to see it as an invented word. Therefore I do not consider there to be a likelihood of direct confusion between the applicant's mark and the opponent's mark, on the part of an average consumer paying a normal level of attention. Nor do I consider that the average consumer will be indirectly confused and is unlikely to believe that the respective goods come from the same or linked undertakings.

CONCLUSION

37. The opposition fails under section 5(2)(b) of the Act.

COSTS

38. As the applicant has been successful, it is entitled to a contribution to its costs. Awards of costs in Fast Track Proceedings are governed by Tribunal Practice Notice

(TPN) 2/2015. Bearing in mind the guidance given in TPN 2/2015, I award costs to the applicant as follows:

£200 for consideration of the Notice of Opposition and filing a counterstatement.

39. I order Dewhurst Dent PLC to pay Cori International Limited the sum of £200. 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 7th day of August 2017

**June Ralph
For the Registrar
The Comptroller-General**