

**O-389-18**

**TRADE MARKS ACT 1994  
IN THE MATTER OF REGISTRATION No. 3185224  
STANDING IN THE NAME OF  
RHONA SUTTON**

**AND**

**IN THE MATTER OF A REQUEST FOR A DECLARATION  
OF INVALIDITY THERETO UNDER No.501700  
BY VICTORIA LEYSHON**

## BACKGROUND

1) The following trade mark is registered in the name of Rhona Sutton (hereinafter Ms Sutton):

Mark	Number	Filing & registration date	Class	Specification
LITTLE STAR	3185224	12.09.16 10.03.17	14	Jewellery; bracelets; watches; charms and beads made wholly or partly of precious metal; jewellery boxes; jewellery cases.
			25	Clothing; footwear; headgear; swimwear; resortwear.

2) By an application dated 23 June 2017 Victoria Leyshon (hereinafter Ms Leyshon) applied for a declaration of invalidity in respect of this registration. The ground of opposition is in summary:

a) Ms Leyshon is the registered proprietor of the following trade mark:

Mark	Number	Date of filing & registration	Class	Specifications relied upon
	3159472	14.04.16 15.07.16	14	Jewellery.

b) Ms Leyshon contends that the goods in class 14 of both parties are identical. It contends that as the marks are highly similar the mark in suit offends against Section 5(2)(b) of the Act. The invalidity only relates to class 14 goods.

3) Ms Sutton provided a counterstatement, dated 18 January 2018, in which she denies that the marks are similar. She states that Ms Leyshon's mark has "a stylised rabbit with a star above its right paw, and the strapline "MADE TO CHERISH" below the script wording "Little Star" where the "s" is a continuation of the line drawing of the rabbit".

4) Only Ms Leyshon filed evidence. Both sides ask for an award of costs. The matter came to be heard on 14 June 2018 when Mr Gallafent of Messrs Gallafents Limited represented Ms Sutton; Ms Leyshon was represented by Mr Stacey of Messrs Barron Warren Redfern.

### **Ms Leyshon's Evidence**

5) Ms Leyshon filed two witness statements. The first, dated 5 December 2017, is by Victoria Leyshon. She states that she is a director of Little Star Jewellery Ltd along with her husband Robert John Walker. She states that she has authorised the company to use her mark and that Mr Walker is authorised to make a statement on her and the company's behalf.

6) The second witness statement, dated 5 December 2017, is by Robert John Walker a director of Little Star Jewellery Ltd since its inception in summer 2016. He states that the company has the domain name littlestarjewellery.com registered and that it went live on 15 January 2017. He confirms that the company also has a presence on Facebook, Twitter and Instagram. He states that the company retails through what he terms as "high-end" jewellers such as Fraser Hart, Wharton Jewellers, Forum Jewellers as well as online retailers. He states that the company supplies 28 independent retailers throughout the UK. He states that since commencing the business in September 2016 they have spent over £100,000 on marketing. He states that Ms Sutton sells via Argos, which is, he claims, moving away from selling via a catalogue to more on-line retailing. He claims that when searching on-line the marks of the two parties are impossible to differentiate. He provides the following exhibits:

- LSJ 03-04: Details of retailers in the UK showing coverage of the whole of the UK.

- LSJ 05: A media report suggesting that exposure of the brand had reached 6 million people based upon circulation figures, although most of the report relates to features and advertisements in 2017.
- LSSJ 06: Examples of press coverage dating from October 2016.
- LSJ 07 & 8: Results of google searches from November 2017 (after the date Ms Sutton's mark was filed).

7) That concludes my summary of the evidence filed, insofar as I consider it necessary.

## **DECISION**

8) The invalidity is brought under section 47 and the only ground of opposition is under Section 5(2)(b) both of which read:

**“47. - (1)** The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

(2) The registration of a trade mark may be declared invalid on the ground-

- (a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or
- (b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.”

And:

“5.-(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 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, the relevant part of which states:

“6.-(1) In this Act an "earlier trade mark" means -

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

10) Ms Leyshon is relying upon her trade mark listed in paragraph 2 above which is clearly an earlier trade mark. Given the interplay between the dates of the instant mark being published and Ms Leyshon’s mark being registered mean that the proof of use requirements do not bite as at the point of the instant mark being advertised Ms Leyshon’s mark had not been registered for five years. Ms Leyshon is therefore able to rely on the specification of the earlier mark without having to show genuine use.

11) When considering the issue under section 5(2)(b) I take into account the following principles which 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.

### **The average consumer and the nature of the purchasing decision**

12) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. 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.”

13) The goods in the instant case are Jewellery (including jewellery boxes and cases) and watches. To my mind, the average consumer for these goods would be the general public, including businesses. Such goods can vary enormously in terms of price, however

they would usually be sold in retail outlets or via the internet. The initial selection will therefore be a visual one, although I must also take into account word of mouth recommendations. Therefore, whilst I consider the visual aspect as being the most important in selection, aural considerations also apply. **The level of attention which the average member of the public will pay to the selection will vary dependent on whether the jewellery is for a special occasion such as a wedding etc or simply a self-purchase, but to my mind it will range from a low to medium degree of attention. The business consumer will pay more attention to the selection of such items as quality will be far more important. Such buyers will pay at least a medium degree of attention to the selection of such goods.**

### **Comparison of goods**

14) In the judgment of the CJEU in *Canon*, Case C-39/97, the court 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”.

15) 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.

16) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court stated that:

“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”.

17) In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that “complementary” means:

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

18) The goods of the two parties are as follows:

Ms Leyshons specification	Ms Suttons specification
Class 14: Jewellery;	Class 14: Jewellery; bracelets; watches; charms and beads made wholly or partly of precious metal; jewellery boxes; jewellery cases.

19) Clearly both specifications have the term “jewellery” in them. This term must also include “bracelets; charms and beads made wholly or partly of precious metal”. Mr Gallafent contended that “charms and beads made wholly or partly of precious metal” were but parts of items, and not jewellery in themselves. However, charms and beads are sold individually, as they can be put upon a bracelet, a necklace or simply kept as a good luck piece. To my mind, these **must be regarded as identical**.

20) Watches are, to my mind a form of jewellery, frequently made of precious metal (or pretending to be) and sometimes set with precious stones. They are usually sold in jewellery shops and in catalogues are found in the same section as jewellery. I am also aware that some watches do not have a strap as such but a bracelet, and ladies watches in particular are often more of a bracelet with a watch in it than a watch with a bracelet. Mr Gallafent contended that they are also sold in watch shops, which I accept. **To my mind, watches are highly similar to jewellery**.

21) Lastly, I turn to consider “Jewellery boxes and cases”. These are sold in the same outlets / section of the catalogue as jewellery, are sold via the same trade channels and to the same users. Jewellery boxes and cases are clearly specifically designed to house items of jewellery and is how such items are packaged before being handed to the consumer. The terms also refer to housings for one’s jewellery collection and are often themselves highly ornate. They are clearly complementary to jewellery. **I regard these items as being at least similar to a medium degree**.

### **Comparison of trade marks**

22) 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 them, 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.”

23) 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 them. The trade marks to be compared are:

Ms Sutton’s mark	Ms Leyshon’s mark
<p><b>LITTLE STAR</b></p>	

24) Ms Leyshon’s mark has two distinct elements of equal dominance. The device of a rabbit/bunny playing/bouncing a star, and the words “LITTLE STAR” in script form. The words “made to cherish” are in small print and will, for the most part, be paid very little attention by the average consumer, as it is a common banal strapline, of low importance and distinctiveness. I accept that the old maxim that words speak louder than devices does not always hold true, particularly where the words are descriptive or of weak distinctive character. In the instant case the words “LITTLE STAR” which are highly visible in both marks have no meaning in terms of the goods in question. The fact that the

words are in script form in Ms Leyshon's mark does not affect the ability of the average consumer to immediately read the words "Little star". The image of a rabbit is very clear and has no meaning in relation to the goods in question. The fact that it is playing / bouncing a star with its paw merely serves, in my view, to emphasise the "STAR" message contained in the words. The strap line will be seen as precisely that, a typical piece of marketing gibberish of no consequence. There are obvious visual differences, but also identical words. Whilst Mr Gallafent tried to convince me that the average consumer would pronounce the mark as Rabbit Little Star, I regard this as nonsense, the device element will not be verbalised. Phonetically the initial words in Ms Leyshon's mark are identical to those in Ms Sutton's mark, albeit there are then additional words in the mark of Ms Leyshon. I do not believe that the average consumer will verbalise the image of the rabbit/bunny and star. Conceptually, there is an identical element in the "little star" image that the wording conjures in the mind, and also the image of a rabbit/bunny in the mark of Ms Leyshon. When considered overall I believe that the **marks of the two parties are similar to at least a medium degree.**

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

25) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 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 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).”

26) In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.’

40. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out”.

27) Ms Leyshon’s mark consists of a device of a rabbit holding / playing with a star device. Underneath are the words “Little star” written in cursive script, and beneath this in much smaller block capitals the words “MADE TO CHERISH”. The words used are well known dictionary words, none of which have any meaning when used upon goods in class 14. Although Ms Leyshon has provided evidence of use of her mark she has not

provided turnover figures, nor is it clear what the marketing spend was prior to the filing date of Ms Sutton. **Overall Ms Leyshon's mark is inherently distinctive to a medium degree, it cannot benefit from enhanced distinctiveness.**

### **Likelihood of confusion**

28) 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 ACL's trade marks as the more distinctive the 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. Earlier in this decision, I concluded that:

- the average consumer for the services is a member of the general public including businesses who will select the goods by predominantly visual means, although I do not discount aural considerations and that they are likely to pay a varying degree (ranging from low to medium) of attention to the selection of such goods.
- the marks of the two parties are similar to at least a medium degree.
- Ms Leyshon's mark has a medium level of inherent distinctiveness but cannot benefit from an enhanced distinctiveness through use.
- the following goods in Ms Sutton's specification are identical to those of Ms Leyshon: "jewellery; bracelets; charms and beads made wholly or partly of precious metal".
- the following goods in Ms Sutton's specification are highly similar to those of Ms Leyshon: "Watches".

- the following goods in Ms Sutton’s specification are similar to a medium degree to those of Ms Leyshon: “Jewellery boxes and cases”.

29) Ms Sutton points to the absence of any confusion between the two parties in the marketplace. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. stated that:

“80. ....the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in *Specsavers* at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a likelihood of confusion. But conversely, the absence of actual confusion despite side by side use may be powerful evidence that they are not sufficiently similar to give rise to a likelihood of confusion. This may not always be so, however. The reason for the absence of confusion may be that the mark has only been used to a limited extent or in relation to only some of the goods or services for which it is registered, or in such a way that there has been no possibility of the one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur.”

30) In the absence of any sales figures from either party it is not clear that they have both been sufficiently active in the market place so that confusion would have occurred. Indeed I note that Ms Leyshon had only just started her business in the same month as Ms Sutton applied for her mark.

31) In view of all of the above, and allowing for the concept of imperfect recollection there is a likelihood of consumers being confused into believing that the goods for which Ms Sutton’s mark is registered are those of Ms Leyshon or provided by some undertaking linked to it. The ground of invalidity under section 5(2)(b) succeeds.

## **CONCLUSION**

32) The class 25 goods were not part of the invalidity action and so the registration in respect of these goods still stands.

33) The ground of invalidity under section 5(2)(b) in respect of the goods in class 14 is successful. As the invalidity has succeeded against the goods in class 14 the Register will be amended so that the mark will be registered only for the goods in class 25.

## **COSTS**

34) As Ms Leyshon has been successful she is entitled to a contribution towards her costs.

Preparing a statement and considering the other side's statement	£300
Expenses	£200
Preparing evidence	£400
Attending the hearing	£600
<b>TOTAL</b>	<b>£1500</b>

35) I order Rhona Sutton to pay Victoria Leyshon the sum of £1,500. This sum 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 26<sup>th</sup> day of June 2018**

**G W Salthouse**  
**For the Registrar**  
**the Comptroller-General**