

**O-412-20**

**TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION No. 3390855  
BY MADELEINE THOMPSON LIMITED  
TO REGISTER IN CLASS 25  
THE TRADE MARK**

MADELEINE  
THOMPSON

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER No. 417479  
BY  
MADELEINE MODE GMBH**

## BACKGROUND

1) On 9 April 2019, Madeleine Thompson Limited (hereinafter the applicant) applied to register the trade mark shown on the front page in respect of the following goods in Class 25: Clothing, footwear and headwear; woven clothing; woollen clothing; knitwear [clothing]; cashmere clothing; knit tops; jumpsuits; ponchos; jumpers; sweaters; cardigans; pants; all in one nightwear; dresses; scarves; wraps [clothing]; hats; beanies; knitted caps; headbands [clothing].

2) The applications were examined and accepted, and subsequently published for opposition purposes on 24 May 2019 in Trade Marks Journal No. 2019/021.

3) On 27 August 2019 Madeleine Mode GmbH (hereinafter the opponent) filed a notice of opposition. The opponent in these proceedings is the proprietor of the following trade mark:

Mark	Number	Dates of filing & registration	Class	Specification relied upon
<b>Madeleine</b>	EU 17997528	10.12.18 04.05.19	25	Clothing; Clothing of leather and imitations of leather; Articles of clothing made of fur; Gloves including those made of skin, hide or fur; Underwear; Foundation garments; Footwear; Shoe inserts for non-orthopedic purposes; Headgear; Pockets for clothing.

- a) The opponent contends that the mark in suit and the opponent's mark shown above are similar and that the goods applied for are identical and/or similar to the goods for which the earlier mark is registered. As such the mark in suit offends against Section 5(2)(b) of the Act.
  
- b) The opponent contends that because of the use of its trade mark it has reputation in it. It claims that the mark in suit will benefit from the opponent's advertising and promotion and will gain sales from the association with the opponent's mark. The opponent contends that use of the mark in suit could damage its reputation and it will reduce the distinctiveness of the opponent's mark. It contends that the mark in suit offends against section 5(3) of the Act.

c) The opponent contends it has used the sign MADELEINE since 2006 throughout the UK, and has goodwill in the sign. As the signs of the two parties are similar as are the goods there will be misrepresentation which will damage the opponent's goodwill in its sign. As such the mark in suit offends against section 5(4)(a).

4) On 4 November 2019 the applicant filed a counterstatement basically denying all the grounds of opposition. It did not put the opponent to proof of use.

5) Both parties filed evidence; both sides seek an award of costs in their favour. The matter came to be heard on 5 August 2020 when Mr Harbottle of Counsel instructed by Messrs Kilburn & Strode LLP represented the applicant; the opponent was represented by Mr Marsden of Messrs Wilson Gunn.

### **OPPONENT'S EVIDENCE**

6) The opponent filed two witness statements. The first, dated 21 January 2020, is by Till Oestereich the Finance Director of the opponent and also Managing Director of Madeleine Fashion Ltd the UK subsidiary of the opponent. He states he has been in charge of UK operations since 2008. He states that the opponent company was founded in Germany forty years ago. It predominantly sells directly to customer via its catalogues and website, in addition it owns a number of boutiques in Germany. The target market is professional women aged between 30-50. The opponent sells in Switzerland, Austria, France, Greece, Belgium, the Netherlands and the UK. He states that of its €175 million turnover in Europe only approximately €100 million is in Germany. He states that in 1988 the logo shown below was developed and has been used on the website, catalogues and most clothing in the range.



MADELEINE

7) He states that the opponent has rights in the UK dating back to 1980 via trade mark registrations assigned to it by the quelle group. Evidence of these registrations is at exhibit TO3. He states that although the UK subsidiary was set up in 2006 the company has been selling clothing in the UK since well before this date. He provides the following sales figures for the UK market, although he states that these figures also include sales of the PRIVACY brand but he states that this amounts to less than 1% of turnover:

Year	Number of items	Turnover in UK£ million
2009-10	N/A	1.2
2010-11	N/A	2.3
2011-12	N/A	3.6
2012-13	N/A	5.4
2013-14	N/A	6.9
2014-15	N/A	9.8
2015-16	N/A	11
2016-17	200,000	10.6
2017-18	225,000	11.3
2018-19	180,000	8.7

8) He states that the opponent launched its UK website in 2008. He states that the opponent issues its catalogue twice a year (Autumn/Winter and Spring/Summer). An average of over 1million of each catalogue has been issued in the UK in the period 2014-2019 inclusive. During the period 2016-2019 the opponent spent an average of approximately £445,000 per annum on advertising its catalogues, mostly by use of inserts (the sort of thing that falls out of newspapers and magazines) in publications such as, inter alia, *Daily Mail*, *Sunday Times*, *Woman and Home*, *Country Homes* and *Hello Fashion*. The opponent arranged for an average of approximately 9 million inserts per annum during the period 2016-2019 inclusive. He provides the following exhibits:

- TO4: Examples from the Internet Archive “Wayback machine” which shows use of the opponent’s UK website between 2008-2018.
- TO6: Undated photographs of clothing from the catalogue showing use of the opponent’s mark.
- TO8: Articles in newspapers, magazines such as *Woman’s weekly*, *Telegraph*, *Women and Home*, *Prima*, *Daily Express*, and TV programmes such as *Lorraine* and *Loose Woman* which featured the opponent’s goods, dated prior to the relevant date.

9) The second witness statement dated 20 January 2020 is by Volker Valk, the Chief Financial Officer of the opponent who simply confirms that he agrees with the statement of Mr Oestereich.

## **APPLICANT'S EVIDENCE**

10) The applicant filed a witness statement dated 30 March 2020 by Madeleine Thompson the founder and director of the applicant company. She provides a history of her company which has been trading under the mark MADELEINE THOMPSON since its inception in 2006, although the mark was altered in 2013 into the slightly stylised into the mark now sought to be registered. The goods have been sold throughout the UK and Europe, with sales in the UK averaging approximately £350,000 per annum for the five full years prior to the application being filed. In addition to selling via retailers the company also issue catalogues twice annually. She provides a number of exhibits including copies of websites from 2013 using the "wayback machine", screenshots from retailers who stock the applicant's products, pages from catalogues for 2015-2019, articles from press coverage from the period 2013-2019, and social media coverage which shows that the applicant has indeed been trading in the UK since 2013 in women's clothing. She also provides evidence from the Office of National Statistics which shows that Madeleine is a relatively common name in the UK.

## **OPPONENT'S EVIDENCE IN REPLY**

11) The opponent filed two witness statements, the first, dated 26 May 2020 is by Mr Oestereich who provided evidence earlier in this case. He points out that the opponent sells very similar items at very similar prices to the applicant. He makes other comments regarding the applicant's evidence which do not assist my decision.

12) The opponent filed a witness statement, dated 26 May 2020 by Voler Valk who has previously provided evidence in this case, He simply confirms the evidence of Mr Oestereich.

13) Two days prior to the hearing the opponent sought to file additional evidence in the form of a witness statement, dated 3 August 2020, by Mr Andrew Marsden, the opponent's Trade Mark Attorney, which I allowed into the case. The first exhibit consisted of details of a number of marks registered by the UKIPO and also the EUIPO. Such evidence is frequently referred to as "state of the register" evidence. The second exhibit is a copy of an entry from Wikipedia dated 3 August 2020 which states that THOMPSON is the fourteenth most common surname in the UK.

## **DECISION**

14) The first ground of opposition is under section 5(2)(b) which reads:

“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.”

15) 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.”

16) The opponent is relying upon its trade mark shown in paragraph 3 above which is clearly an earlier trade mark. The applicant did not put the opponent to proof of use of this mark.

17) 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**

18) 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.”

19) Both parties' specifications have individual items of clothing, footwear and headgear named but also contain, the three words “clothing, footwear and headgear”. Such goods will be sold in, inter alia, traditional retail outlets on the high street, through catalogues and on the Internet. The specifications of both parties are unlimited, and so I must keep all of these trade channels in mind. The average consumer of the goods at issue is a member of the general public (including businesses) who is likely, in my opinion, to select the goods mainly by visual means. I accept that more expensive items may be researched or discussed with a member of staff. In this respect I note that in *New Look Ltd v OHIM Cases- T-117/03 to T-119/03 and T-171/03*, the General Court (GC) said this about the selection of clothing:

“49. However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the

conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

And

“50..... 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.”

20) In the same case the Court also commented upon the degree of care the average consumer will take when selecting clothing. It said:

“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 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.”

21) Clearly, the average consumer’s level of attention will vary considerably depending on the cost and nature of the item at issue. However, to my mind even when selecting routine inexpensive items of clothing such as socks, a woollen hat or a pair of slippers; the average consumer will pay attention to considerations such as size, colour, fabric and cost. **Overall the average consumer is likely to pay a medium degree of attention to the selection of items of clothing, footwear and headgear.**

## Comparison of goods and services

22) In the judgment of the Court of Justice of the European Union (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”.

23) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (GC) 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 fur 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”.

24) The specifications of the two parties are as follows:

Applicant's specification in class 25	Opponent's specification in class 25
Clothing, footwear and headwear; woven clothing; woollen clothing; knitwear [clothing]; cashmere clothing; knit tops; jumpsuits; ponchos; jumpers; sweaters; cardigans; pants; all in one nightwear; dresses; scarves; wraps [clothing]; hats; beanies; knitted caps; headbands [clothing].	<b>Clothing</b> ; Clothing of leather and imitations of leather; Articles of clothing made of fur; Gloves including those made of skin, hide or fur; Underwear; Foundation garments; <b>Footwear</b> ; Shoe inserts for non-orthopedic purposes; <b>Headgear</b> ; Pockets for clothing.

25) The applicant's specification starts with the words "Clothing, Footwear and Headgear". All of the items listed after this are items of either clothing, footwear or headgear. The opponent's specification also contains the same three words (shown in bold). Neither specification has any form of limitation and so **the specifications of the two parties are identical**.

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

26) 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)."

27) The opponent's mark has no meaning that I am aware of in respect of the goods for which it is registered. Although not a common name in the UK it is not unusual and would be, in my opinion, familiar to the average consumer. To my mind, it **has an average degree of inherent distinctiveness**. The opponent has provided some evidence of use which averages at approximately £7million per annum for the period 2009-2019, and an average of approximately 200,000 items of clothing, footwear and headgear. The opponent has failed to put the evidence of turnover into context of market share, or even to comment upon the size of the UK market for such products. Even if all the sales related to clothing, and the witness refers to "clothing and fashion accessories" it is obvious that

the market share will be extremely small, given the vast size of the UK clothing market. To my mind, the opponent **cannot benefit from an enhanced degree of distinctiveness through use in relation to the goods for which its mark is registered.**

### Comparison of trade marks

28) 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.”

29) It would be wrong, therefore, to artificially 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.

Opponent's trade mark	Applicant's trade mark
<b>Madeleine</b>	MADELEINE THOMPSON

30) In *Harman International Industries, Inc v OHIM*, Case C-51/09P, the Court of Justice of the European Union found that:

“Although it is possible that, in a part of the European Union, surnames have, as a general rule, a more distinctive character than forenames, it is appropriate, however, to take account of

factors specific to the case and, in particular, the fact that the surname concerned is unusual or, on the contrary, very common, which is likely to have an effect on that distinctive character. That is true of the surname ‘Becker’ which the Board of Appeal noted is common”.

31) In *El Corte Inglés, SA v OHIM*, Case T-39/10, the General Court found that:

“54. As the applicant asserted in its pleadings, according to the case-law, the Italian consumer will generally attribute greater distinctiveness to the surname than to the forename in the marks at issue (Case T-185/03 *Fusco v OHIM – Fusco International (ENZO FUSCO)* [2005] ECR II-715, paragraph 54). The General Court applied a similar conclusion concerning Spanish consumers, having established that the first name that appeared in the mark in question was relatively common and, therefore, not very distinctive (Case T-40/03 *Murúa Entrena v OHIM – Bodegas Murúa (Julián Murúa Entrena)* [2005] ECR II-2831, paragraphs 66 to 68).

55. Nevertheless, it is also clear from the case-law that that rule, drawn from experience, cannot be applied automatically without taking account of the specific features of each case (judgment of 12 July 2006 in Case T-97/05 *Rossi v OHIM – Marcorossi (MARCOROSI)*, not published in the ECR, paragraph 45). In that regard, the Court of Justice has held that account had to be taken, in particular, of the fact that the surname concerned was unusual or, on the contrary, very common, which is likely to have an effect on its distinctive character. Account also had to be taken of whether the person who requests that his first name and surname, taken together, be registered as a trade mark is well known (Case C-51/09 P *Becker v Harman International Industries* [2010] ECR I-5805, paragraphs 36 and 37). Likewise, according to the case-law cited in the previous paragraph, the distinctive character of the first name is a fact that should play a role in the implementation of that rule based on experience.”

32) I also note that in *Andrea Incontri Srl v EUIPO*, case T-197/16, the General Court annulled the decision of the Fourth Board of Appeal at the EUIPO, which had upheld the office’s decision to refuse ANDREA INCONTRI as a trade mark for cosmetics on the basis of opposition by the proprietor of the earlier trade mark ANDREIA (also for cosmetics).

33) I take into account that in *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU’s judgment in *Bimbo*, Case C-591/12P, on the court’s earlier judgment in *Medion v Thomson*. The judge said:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

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).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

34) I further note that in *Anncó, Inc. V OHIM*, Case T-385/09, the General Court considered an appeal against OHIM’s decision that there was no likelihood of confusion between ANN TAYLOR LOFT and LOFT (both for clothing and leather goods) and found that:

“48. In the present case, in the light of the global impression created by the signs at issue, their similarity was considered to be weak. Notwithstanding the identity of the goods at issue, the Court

finds that, having regard to the existence of a weak similarity between the signs at issue, the target public, accustomed to the same clothing company using sub-brands that derive from the principal mark, will not be able to establish a connection between the signs ANN TAYLOR LOFT and LOFT, since the earlier mark does not include the 'ann taylor' element, which is, as noted in paragraph 37 above (see also paragraph 43 above), the most distinctive element in the mark applied for.

49 Moreover, even if it were accepted that the 'loft' element retained an independent, distinctive role in the mark applied for, the existence of a likelihood of confusion between the signs at issue could not for that reason be automatically deduced from that independent, distinctive role in that mark.

50 Indeed, the likelihood of confusion cannot be determined in the abstract, but must be assessed in the context of an overall analysis that takes into consideration, in particular, all of the relevant factors of the particular case (*SABEL*, paragraph 18 above, paragraph 22; see, also, Case C-120/04 *Medion* [2005] ECR I-8551, paragraph 37), such as the nature of the goods and services at issue, marketing methods, whether the public's level of attention is higher or lower and the habits of that public in the sector concerned. The examination of the factors relevant to this case, set out in paragraphs 45 to 48 above, do not reveal, *prima facie*, the existence of a likelihood of confusion between the signs at issue."

35) The opponent contends that the name MADELEINE is not common in the UK on the basis that it has not been in the top 100 girl's names in the UK according to the Office of National Statistics during the period 1904-1994. However, the applicant has shown that the same government office showed the name at number 72 in 2006, although its popularity has waned since. The opponent also contends that the second element of the applicant's mark is a very common surname in the UK. The opponent further contended that it is common practice in the fashion industry to use forenames and surnames and also a mixture of the two. It postulated that the applicant's mark could be shortened to MADELEINE or that it would be taken as being the full name of the opponent. They referred me to a number of cases where the first name or surname had been regarded as common and therefore reliance placed on the other part of the mark. To my mind, the cases referred to do not add to the summary of the law as set out earlier in my decision and were determined on their own merits and evidence. The opponent also felt that the two names in the applicant's mark being one above the other instead of in a line was significant and would lead to confusion. I do not accept this view.

37) It is clear that the marks share the identical first element and that the applicant's mark differs in having a second element. There are obvious aural and visual similarities and differences. Conceptually, they are similar in that both will be seen by the average consumer as a name, just the first name in the opponent's mark and the person's full name in the applicant's mark. The average consumer will view the applicant's mark as clearly referring to the individual behind the company or the designer of the clothing, whereas the opponent's name is simply as girl's first name and not specific to an individual.

### **Likelihood of confusion**

38) 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 services 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 the trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, 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 goods 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
- the marks have similarities and differences
- the opponent's mark has an average degree of inherent distinctiveness but cannot benefit from an enhanced distinctiveness through use.
- the specifications of the two parties are identical

39) I must also consider the issue of indirect confusion which was set out in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, where Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

40) In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

41) In view of all of the above, and allowing for the concept of imperfect recollection, even when the applicant’s mark is used on identical goods there is, in my opinion, no likelihood of consumers being directly or indirectly confused into believing that the goods applied for and provided by the applicant are those of the opponent or provided by an undertaking linked to it. The average consumer is well used to differentiating between names, and whilst Madeleine is not that common a forename it is not particularly unusual. The addition of even a relatively common surname is enough, in my view, for the consumer to Distinguish between the parties. I am fortified in my view by the fact that prior to the opposition the applicant had used its mark on identical goods to those of the opponent for fifteen years in the UK, yet the opponent did not file any evidence of confusion which surely would have come to its attention, if it existed, during such a long period of common use. **The opposition under Section 5(2) (b) therefore fails.**

42) The next ground of opposition is under section 5(3) which reads:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a

European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

43) The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Addidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark’s ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average

consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure*).

44) I must firstly consider whether the opponent has met the test for reputation. In *General Motors, Case C-375/97*, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade

mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

45) Earlier in this decision I noted that:

"The opponent has provided some evidence of use which averages at approximately £7million per annum for the period 2009-2019, and an average of approximately 200,000 items of clothing, footwear and headgear. The opponent has failed to put the evidence of turnover into context of market share, or even to comment upon the size of the UK market for such products. Even if all the sales related to clothing, and the witness refers to "clothing and fashion accessories" it is obvious that the market share will be extremely small, given the vast size of the UK clothing market."

46) The reputation hurdle is, regrettably, very low these days and the evidence provided is sufficient for the opponent to get over this hurdle. As such I will continue on with the question of whether a significant part of the public will form a link between the two marks. The relevant case law for section 5(3) can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the

proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

47) In determining whether the public will make the required mental 'link' between the marks I must take account of all relevant factors. The factors identified in *Intel* are:

- i) The degree of similarity between the conflicting marks
- ii) The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public
- iii) The strength of the earlier mark's reputation
- iv) The degree of the earlier mark's distinctive character, whether inherent or acquired through use.

48) Regarding the similarity of the marks I take into account case C-408/01, *Adidas-Salomon*, where the CJEU held that:

“28. The condition of similarity between the mark and the sign, referred to in Article 5(2) of the Directive, requires the existence, in particular, of elements of visual, aural or conceptual similarity (see, in respect of Article 5(1)(b) of the Directive, Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 23 in fine, and Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraphs 25 and 27 in fine).

29. The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23).”

49) Whilst in *Intra-Press SAS v OHIM*, Joined cases C-581/13P & C-582/13P, the Court of Justice of the European Union stated (at paragraph 72 of its judgment) that:

“The Court has consistently held that the degree of similarity required under Article 8(1)(b) of Regulation No 40/94, on the one hand, and Article 8(5) of that regulation, on the other, is different. Whereas the implementation of the protection provided for under Article 8(1)(b) of Regulation No 40/94 is conditional upon a finding of a degree of similarity between the marks at issue so that there exists a likelihood of confusion between them on the part of the relevant section of the public, the existence of such a likelihood is not necessary for the protection conferred by Article 8(5) of that regulation. Accordingly, the types of injury referred to in Article 8(5) of Regulation No 40/94 may be the consequence of a lesser degree of similarity between the earlier and the later marks, provided that it is sufficient for the relevant section of the public to make a connection between those marks, that is to say, to establish a link between them (see judgment in *Ferrero v OHMI*, C-552/09 P, EU:C:2011:177, paragraph 53 and the case-law cited).”

50) In short, the similarity of signs under Section 5(3) must be assessed in the same way for section 5(2). The level of similarity required for the public to make a link between the marks for the purposes of 5(3) may be less than the level of similarity required to create a likelihood of confusion, but there must be similarity when the marks are compared overall.

51) The goods of the two parties are identical, being clothing, footwear and headgear. The average purchaser of such is the general public, the opponent’s mark has an average degree of distinctiveness but cannot benefit from enhanced distinctiveness, it has a low degree of reputation in the UK and there are visual and aural similarities and differences, whilst both would be seen as names, in the opponent’s case a first name only and in the applicant’s case the full name of a person. These findings mean that I conclude that there is no possibility of the average consumer making a link between the marks of the two parties. **The opposition under section 5(3) therefore fails.**

52) In reaching this decision I am fortified by the comments of Mr Geoffrey Hobbs Q.C. (sitting as a Deputy Judge) in *Electrocoin Automatics Limited and Coinworld Limited and Others* [2005] FSR 7:

“102. I think it is clear that in order to be productive of advantage or detriment of the kind prescribed, ‘the link’ established in the minds of people in the market place needs to have an effect on their economic behaviour. The presence in the market place of marks and signs which call each other to mind is not, of itself, sufficient for that purpose.”

53) Given that the two parties have been trading in the UK for a period of approximately fifteen years using the marks currently in dispute, albeit at low levels of activity, one would have thought that a change in the economic behaviour of consumers would have been noticed by the opponent and would have formed part of its case.

54) Lastly, I turn to the ground of opposition under section 5(4)(a). In respect of section 5(4)(a) Halsbury's Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

“The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.”

55) Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

56) I have already found that the opponent has goodwill and reputation in its mark, albeit to a lesser extent than contended by the opponent I also found earlier in this decision that use of the mark in suit, actual or on a fair and notional basis would not result in confusion with the opponent’s marks. Accordingly, it seems to me that the necessary misrepresentation required by the tort of passing off will not occur. **The opposition under Section 5(4)(a) of the Act must fail.**

## **CONCLUSION**

57) The opposition under sections 5(2)(b), 5(3) and 5(4)(a) all fail.

## **COSTS**

58) As the applicant has been successful it is entitled to a contribution towards its costs.

Preparing a statement and considering the other side’s statement	£300
Considering the other sides evidence	£400
Attendance at hearing	£900
<b>TOTAL</b>	<b>£1,600</b>

59) I order Madeleine Mode GmbH to pay Madeleine Thompson Limited the sum of £1,600. This sum to be paid within twenty- one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 27th day of August 2020**

**George W Salthouse**  
**For the Registrar,**  
**the Comptroller-General**