

O-454-14

**TRADE MARKS ACT 1994**

**APPLICATION NO 2526406 BY BOOHOO.COM UK LTD**

**TO REGISTER THE TRADE MARK 'MissBoo'**

**AND**

**OPPOSITION No. 100472 BY TONY VAN GULCK**

**TO THE REGISTRATION OF THE MARK**

**FOR GOODS AND SERVICES IN CLASSES 18 AND 35**

## Background

1. A decision was issued on behalf of the registrar in these opposition proceedings on 29 November 2012<sup>1</sup> in which the hearing officer decided that:

- Community trade mark 1592377 (“CTM”), being the mark BOO!, was entitled to protection in respect of ‘handbags’ in class 18 and ‘shoes for women’ in class 25;
- The CTM was an earlier trade mark compared with the applicant’s mark, MissBoo;
- The CTM was similar to the applicant’s mark and covered goods and services in classes 18 and 35 which were similar to the goods for which the earlier CTM was entitled to protection;
- There was a likelihood of confusion on the part of the public if the applicant’s mark was used in relation to such goods and services;
- The application should therefore be refused under section 5(2)(b) of the Trade Marks Act 1994 for those goods and services.

2. Wasabi Frog Ltd appealed to the Appointed Person in respect of some of the goods and services covered by the refusal. Mr Geoffrey Hobbs Q.C. issued a decision as the Appointed Person on 2 September 2014 in which he:

- Upheld the registrar’s decision to refuse registration of the applicant’s mark in relation to the goods in class 18 specified in the notice of appeal;
- Found that the registrar had compared the applicant’s retail services in class 35 covered by the appeal with the opponent’s goods in classes 18 and 25 on the wrong basis and therefore remitted that matter to the registrar for a further determination by a different hearing officer.

3. The applicant subsequently changed its name to Boohoo.Com UK Ltd (“the applicant”).

4. Tony Van Gluck (“the opponent”) filed evidence which was considered by the original hearing officer. Her findings on that evidence are set out in paragraphs 15-30 of her decision. In the light of the outcome of the appeal there does not appear to me to be any scope or need to re-examine this evidence. I therefore adopt the original hearing officer’s findings on the evidence for the purposes of this decision. The parties were asked if they wanted to be heard again by the registrar. Neither party

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<sup>1</sup> Published as BL O/474/12

did, although further written arguments were filed on behalf of the applicant. This decision has been made after a review of all the papers.

5. The applicant's services in class 35 covered by the appeal, and therefore also covered by this decision, are:

#### Class 35

The bringing together, for the benefit of others, a variety of goods, namely, cases, trunks and travelling bags, pouches, rucksacks, shopping bags, beach bags, briefcases, wallets, back packs; articles of clothing, lingerie, bras, pants, thongs, stockings, tights, suspender belts, camisoles, dressing gowns, negligees, corsets, night dresses, sleep shirts, sarongs, shoulder wraps, shorts, leggings, headgear, belts, trousers, shorts, jeans, wristbands, headbands, hats, gloves, jackets, coats, jumpers, shirts, t-shirts, sweaters, vests, trousers, skirts, waistcoats, waterproof clothing, bathing costumes, pyjamas, undergarments, scarves, socks, suits, dresses, blouses, sun visors, anoraks, articles of clothing for leisurewear, articles of clothing for casualwear, articles of clothing for sportswear, articles of outer clothing, articles of weatherproof clothing, blazers, denims, jerseys, knitwear, parkas, sweatshirts, tops, and windcheaters, enabling customers to conveniently view and purchase those goods by mail order or by means of telecommunications; the bringing together, for the benefit of others a variety of goods, namely, cases, trunks and travelling bags, pouches, rucksacks, shopping bags, beach bags, briefcases, wallets, back packs, articles of clothing, lingerie, bras, pants, thongs, stockings, tights, suspender belts, camisoles, dressing gowns, negligees, corsets, night dresses, sleep shirts, sarongs, shoulder wraps, shorts, leggings, headgear, belts, trousers, shorts, jeans, wristbands, headbands, hats, gloves, jackets, coats, jumpers, shirts, t-shirts, sweaters, vests, trousers, skirts, waistcoats, waterproof clothing, bathing costumes, pyjamas, undergarments, scarves, socks, suits, dresses, blouses, sun visors, anoraks, articles of clothing for leisurewear, articles of clothing for casualwear, articles of clothing for sportswear, articles of outer clothing, articles of weatherproof clothing, blazers, denims, jerseys, knitwear, parkas, sweatshirts, tops, and windcheaters, enabling customers to conveniently view and purchase those goods; retail services connected with cases, trunks and travelling bags, pouches, rucksacks, shopping bags, beach bags, briefcases, wallets, back packs, articles of clothing, lingerie, bras, pants, thongs, stockings, tights, suspender belts, camisoles, dressing gowns, negligees, corsets, night dresses, sleep shirts, sarongs, shoulder wraps, shorts, leggings, headgear, belts, trousers, shorts, jeans, wristbands, headbands, hats, gloves, jackets, coats, jumpers, shirts, t-shirts, sweaters, vests, trousers, skirts, waistcoats, waterproof clothing, bathing costumes, pyjamas, undergarments, scarves, socks, suits, dresses, blouses, sun visors, anoraks, articles of clothing for leisurewear, articles of clothing for casualwear, articles of clothing for sportswear, articles of outer clothing, articles of weatherproof clothing, blazers, denims, jerseys, knitwear, parkas, sweatshirts, tops, and windcheaters; mail order retail services connected

with cases, trunks and travelling bags, pouches, rucksacks, shopping bags, beach bags, briefcases, wallets, back packs, articles of clothing, lingerie, bras, pants, thongs, stockings, tights, suspender belts, camisoles, dressing gowns, negligees, corsets, night dresses, sleep shirts, sarongs, shoulder wraps, shorts, leggings, headgear, belts, trousers, shorts, jeans, wristbands, headbands, hats, gloves, jackets, coats, jumpers, shirts, t-shirts, sweaters, vests, trousers, skirts, waistcoats, waterproof clothing, bathing costumes, pyjamas, undergarments, scarves, socks, suits, dresses, blouses, sun visors, anoraks, articles of clothing for leisurewear, articles of clothing for casualwear, articles of clothing for sportswear, articles of outer clothing, articles of weatherproof clothing, blazers, denims, jerseys, knitwear, parkas, sweatshirts, tops, and windcheaters; electronic shopping retail services connected with cases, trunks and travelling bags, pouches, rucksacks, shopping bags, beach bags, briefcases, wallets, back packs, articles of clothing, lingerie, bras, pants, thongs, stockings, tights, suspender belts, camisoles, dressing gowns, negligees, corsets, night dresses, sleep shirts, sarongs, shoulder wraps, shorts, leggings, headgear, belts, trousers, shorts, jeans, wristbands, headbands, hats, gloves, jackets, coats, jumpers, shirts, t-shirts, sweaters, vests, trousers, skirts, waistcoats, waterproof clothing, bathing costumes, pyjamas, undergarments, scarves, socks, suits, dresses, blouses, sun visors, anoraks, articles of clothing for leisurewear, articles of clothing for casualwear, articles of clothing for sportswear, articles of outer clothing, articles of weatherproof clothing, blazers, denims, jerseys, knitwear, parkas, sweatshirts, tops, and windcheaters.

## **The law**

6. 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, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

## **The case law**

7. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

## The principles

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either *per se* or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) however, if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

## Comparison of goods and services

7. There is no doubt as to the basic matters which must be taken into account when deciding whether goods and services are similar. As the Court of Justice of the European Union (“CJEU”) stated in *Canon*<sup>2</sup>, the correct approach is as follows:

“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”.

8. 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”.

The purpose of examining whether there is a complementary relationship between goods/services is therefore to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited*<sup>3</sup>:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

9. In *Oakley, Inc v OHIM*<sup>4</sup>, the General Court held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

10. Mr Hobbs reviewed the case law concerning retail services versus goods in the appeal in this case. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of

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<sup>2</sup> Case C-39/97, at paragraph 23 of the judgment

<sup>3</sup> BL O/255/13

<sup>4</sup> Case T-116/06, at paragraphs 46-57

**MissBoo** for the Listed Services is considerably more complex [than the position with regard to the use of the marks in relation to goods in class 18]. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent's earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are 'similar' to goods are not clear cut."

However, on the basis of the European courts' judgments in *Sanco SA v OHIM*<sup>5</sup>, and *Assembled Investments (Proprietary) Ltd v. OHIM*<sup>6</sup>, upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd*<sup>7</sup>, Mr Hobbs concluded that:

- i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;
- ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services, it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;
- iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X.

11. Mr Hobbs rejected the opponent's submission that the consequence of the General Court's findings in *Oakley* was that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered)<sup>8</sup>.

12. The applicant's list of services in class 35 is long and repetitive. For the sake of convenience I reproduce below the core list of services.

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<sup>5</sup> Case C-411/13P

<sup>6</sup> Case T-105/05, at paragraphs [30] to [35] of the judgment

<sup>7</sup> Case C-398/07P

<sup>8</sup> Another Appointed Person, Ms Anna Carboni, had earlier made a similar finding in Case BL O/264/14, *Giant UK Ltd v Major League Baseball Properties, Inc.*, at paragraph 44 of the judgment.

### Class 35

The bringing together, for the benefit of others, a variety of goods, namely, cases, trunks and travelling bags, pouches, rucksacks, shopping bags, beach bags, briefcases, wallets, back packs; articles of clothing, lingerie, bras, pants, thongs, stockings, tights, suspender belts, camisoles, dressing gowns, negligees, corsets, night dresses, sleep shirts, sarongs, shoulder wraps, shorts, leggings, headgear, belts, trousers, shorts, jeans, wristbands, headbands, hats, gloves, jackets, coats, jumpers, shirts, t-shirts, sweaters, vests, trousers, skirts, waistcoats, waterproof clothing, bathing costumes, pyjamas, undergarments, scarves, socks, suits, dresses, blouses, sun visors, anoraks, articles of clothing for leisurewear, articles of clothing for casualwear, articles of clothing for sportswear, articles of outer clothing, articles of weatherproof clothing, blazers, denims, jerseys, knitwear, parkas, sweatshirts, tops, and windcheaters, enabling customers to conveniently view and purchase those goods by mail order or by means of telecommunications (emphasis added).

13. I will firstly consider the similarity between *'handbags'* and *'the bringing together, for the benefit of others, a variety of goods, namely, travelling bags, shopping bags and beach bags'*. Each of these products is a type of bag that may be carried in the hand. They are, therefore, literally *'handbags'*. In *YouView TV Ltd v Total Ltd*<sup>9</sup>, Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

14. I find that *travelling bags, shopping bags and beach bags* are types of handbags and are therefore covered by that term. If that is right, then on the same basis as *Oakley* I find that *the bringing together, for the benefit of others, a variety of goods, namely, travelling bags, shopping bags and beach bags* is a complementary service to *handbags*. If that is not right, the goods to which these retail services relate are highly similar to handbags. They are likely to be sold alongside, and as alternatives to, some kinds of handbags. They are therefore likely to be the subject of the same retail services as handbags. In these circumstances the applicant's retail services may be important for the sale of the opponent's goods. It is therefore plausible that the relevant public might believe that the undertaking which sells *handbags* under a

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<sup>9</sup> [2012] EWHC 3158 (Ch)

particular trade mark is the same undertaking, or a connected undertaking, to one that provides (under the same or a similar mark) the service of *bringing together, for the benefit of others, a variety of goods, namely, travelling bags, shopping bags and beach bags*'. There is therefore a degree of complementarity between the applicant's retail services and the opponent's *handbags*.

15. Nevertheless, the nature, purpose and method of use of these goods are different to retail services. Further, the respective goods and services are not in competition. Therefore there is only a low degree of similarity between, on the one hand, *the bringing together, for the benefit of others, a variety of goods, namely, travelling bags, shopping bags and beach bags*' and on the other hand, *handbags*.

16. I understand a pouch to be hand held bag without a handle. *Pouches* and *wallets* are alternatives to certain types of handbags, all being used to carry personal belongings. *Pouches* and *wallets* are therefore highly similar to *handbags*, likely to be sold alongside *handbags*, and likely to be the subject of the same retail services as *handbags*. Therefore for the reasons set out in paragraph 14 above, there is also a degree of complementarity between on the one hand, *the bringing together, for the benefit of others, a variety of goods, namely, pouches and wallets* and, on the other hand, *handbags*. Nevertheless, the nature, purpose and method of use of *hand bags* are different to these retail services. Further, the respective goods and services are not in competition. Therefore there is only a low degree of similarity between the respective goods and associated retail services.

17. I next consider '*articles of clothing*', '*articles of clothing for leisurewear*', '*articles of clothing for casualwear*', '*articles of clothing for sportswear*', '*articles of outer clothing*' and '*articles of weatherproof clothing*'. These are very general descriptions, wide enough to cover various types of '*shoes for women*'. On the basis of *Oakley*, there is therefore a clear degree of complementarity between the opponent's *shoes for women* and the applicant's *the bringing together, for the benefit of others, a variety of goods, namely, articles of clothing, articles of clothing for leisurewear, articles of clothing for casualwear, articles of clothing for sportswear, articles of outer clothing and articles of weatherproof clothing*. Nevertheless, the nature, purpose and method of use of *shoes for women* are different to the applicant's retail services. Further, the respective goods and services are not in competition. Therefore there is only a low degree of similarity between these goods and the applicant's services.

18. Further, that low degree of similarity would be removed altogether if *the bringing together of footwear* was excluded from the applicant's list of retail services.

19. I find that the service of *the bringing together etc. of socks* is complementary to *shoes for women* because it is customary for retailers offering a range of socks to also offer a range of shoes, the former sometimes intended to match with, or to be suitable for wear with, the latter. In these circumstances the applicant's retail

services may be important for the sale of the opponent's goods. Nevertheless, the nature, purpose and method of use of *shoes for women* are different to the retail services in question. Further, the respective goods and services are not in competition. Therefore there is only a low degree of similarity between, on the one hand, *the bringing together, for the benefit of others, a variety of goods, namely, socks* and on the other hand, *shoes for women*.

20. Further, that low degree of similarity would be removed altogether if *the bringing together of footwear* was excluded from the applicant's list of retail services.

21. I cannot see anything other than, at most, a trivial degree of complementarity between any of the other contested retail services and *handbags* and *shoes for women*. If there is any complementarity, it is insufficiently pronounced that, from the consumer's point of view, the services and goods are likely to be offered by one and the same undertaking. The nature, purpose and method of use of *handbags* and *shoes for women* are different to any of the retail services shown without underlining in paragraph 12 above. These services are therefore dissimilar to the goods for which the CTM is entitled to protection.

### Comparison of marks

22. It well established that it is necessary to examine the visual, aural and conceptual similarities (and differences) between the marks. 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. The respective trade marks are shown below:

BOO!	MissBoo
Earlier trade mark	Contested trade mark

24. I find that there is a fairly high degree of visual, aural and conceptual similarity between the marks. This is because the earlier mark consists essentially of the word BOO, and this word is immediately apparent as a separate component of the applicant's mark (despite being conjoined with the word Miss).

25. In reaching this conclusion, I have taken into account that the word ‘Miss’ appears before the word ‘Boo’ in the applicant’s mark and the distinguishing effect that this has on the look and sound of the applicant’s mark.

26. I have also taken account of the exclamation mark at the end of the earlier mark, which might be said to result in the likelihood of the earlier mark being expressed with a certain degree of stress. However, I doubt that this will have much effect on the sound of the earlier mark in the context of its use as a trade mark. Similarly, I find that the exclamation mark has only a marginal effect on the look of the earlier mark.

27. The word BOO is widely understood as a word used in order to create a reaction of surprise. This meaning is reinforced by the exclamation mark in the earlier mark. I consider that the word has the same meaning, albeit to a lesser degree, in the applicant’s mark. I do not accept that the name format of the applicant’s mark wholly displaces the usual meaning of the word BOO so that the mark will be seen only as the name of someone called Miss Boo. This is because, so far as I am aware, Boo is not a recognised name, whereas its other meaning is very well known.

#### **Average consumer and the purchasing act**

28. 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 & Co. GmbH v Klijsen Handel BV*<sup>10</sup>.

29. I find that the average consumer of the goods and retail services at issue is a member of the general public who will pay an average level of attention when selecting the respective goods and services.

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

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

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<sup>10</sup> Case C-342/97

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).”

31. The earlier mark is not in any way descriptive of the goods for which it is protected. It is a slightly odd and therefore quite memorable trade mark. I therefore find that the earlier mark has a relatively high degree of inherent distinctive character. The opponent filed some evidence of use of its trade mark in the UK, but like the original hearing officer, I do not accept that the level of use shown has elevated the distinctive character of the earlier mark to the UK public.

### **Likelihood of Confusion**

32. I have found that the earlier mark has a relatively high degree of distinctive character. In *Kurt Geiger v A-List Corporate Limited*<sup>11</sup>, 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”.

33. Applying the same logic to the applicant’s mark, I find that the distinctive character of MissBoo is distributed more heavily on the Boo component than on the prefix ‘Miss’. This is because, particularly in the context of retail services aimed

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<sup>11</sup> BL O-075-13

primarily at selling products for young females, the word 'Miss' is likely to be seen as semi-descriptive and therefore of limited distinctiveness.

34. Taking this into account, and also the relatively high distinctiveness of the earlier mark, I find it likely that an average consumer of the applicant's similar services will, despite their low degree of similarity to the opponent's goods, believe that the retail services underlined in paragraph 12 above, if offered under the mark MissBoo, are services provided by the undertaking which uses the mark BOO! in relation to *handbags* and *shoes for women*, or by an economically linked undertaking.

35. I therefore find that there is a likelihood of confusion to the extent that the application covers the following retail services.

The bringing together, for the benefit of others, a variety of goods, namely travelling bags, pouches, shopping bags, beach bags, wallets, articles of clothing, socks, articles of clothing for leisurewear, articles of clothing for casualwear, articles of clothing for sportswear, articles of outer clothing, articles of weatherproof clothing.

36. The opposition under section 5(2)(b) succeeds to this extent.

37. The opposition fails against the remaining services in class 35 because they are not similar to the goods for which the opponent's mark is entitled to protection, and there is no likelihood of confusion.

## **Outcome**

38. Taking account of:

- i) My findings;
- ii) The services against which there was no appeal from the original decision; and
- iii) The practice set out in paragraph 3.2.2(b) of Tribunal Practice Notice 1/2012;

I find that the application may proceed to registration in class 35 for:

Class 35

The bringing together, for the benefit of others a variety of goods, namely soaps, cosmetics, perfumery, essential oils, eau de parfum, eau de toilette, cologne, fragrances and fragrance products for personal use, massage oils, hair lotions, dentifrices, cosmetic preparations for skin care, skin care cosmetics, skin care preparations, astringents for cosmetic purposes, preparations for the bath and shower, shower gel, bath gels, scented body lotions and creams, scented moisturizing skin cream, moisturisers, body lotions and creams, moisturising creams, scented skin soap, body oil, face, lip and cheek make-up, face powder, face glitter,

lipstick, lip gloss, non-medicated lip balm, lip pencils, perfumed shimmer sticks, eye shadow, eye pencils, mascara, eye make-up, eyeliners, eye creams, eye gels, eye balms, highlighter, masks, cleansers, toners, clarifiers, exfoliators, foundation make-up, blusher, compacts, make-up remover, fragrance sachets, room fragrances, beauty care preparations, beauty care products, beauty creams, beauty tonics for application to the body, beauty tonics for application to the face, non-medicated beauty preparations, non-medicated skin care beauty products, skin care products for personal use, namely, face, eye and lip moisturisers, face and skin creams, lotions and serums, anti-aging treatments, foundation for the face, hair care products, shampoo, hair conditioners, hair gel and hair spray, nail care preparations, nail polish, nail strengtheners and nail polish remover, shaving cream, shaving gel, after-shave preparations, after-shave lotion, depilatory preparations, personal deodorant, antiperspirants, potpourri, sun tanning preparations, cosmetic preparations for skin tanning, artificial tanning preparations, jewellery and imitation jewellery, precious stones, goods of precious metal or coated therewith, watches and clocks, wrist watch bands, tie clips, cuff links, key rings of precious metal, watch straps, tie pins, catalogues, calendars, printed matter, pages downloaded from the internet, printed publications, magazines, pamphlets, stationery, posters, transfers, decalcomanias, diaries, pencil cases, pencils, pens, erasers, notebooks, paperweights, staplers, writing paper, envelopes, albums, binders, cardboard articles, packaging, files, fountain pens, hat boxes of cardboard, holders for cheque books, mats for beer glasses, coasters of paper, greeting cards, napkins of paper, newsletters, note books, packing paper, writing pads, passport holders, pictures, photographs, stands for pens and pencils, tissues of paper for removing make-up, artists materials, wrapping paper, bags of paper or plastic for packaging, boxes of paper or card or plastic for packaging, leather and imitation leather, cases, trunks, rucksacks, briefcases, umbrellas, parasols, walking sticks, back packs, hat boxes, animal skins, articles of clothing (other than footwear), lingerie, bras, pants, thongs, stockings, tights, suspender belts, camisoles, dressing gowns, negligees, corsets, night dresses, sleep shirts, sarongs, shoulder wraps, shorts, leggings, headgear, belts, trousers, shorts, jeans, wristbands, headbands, hats, gloves, jackets, coats, jumpers, shirts, t-shirts, sweaters, vests, trousers, skirts, waistcoats, waterproof clothing (other than footwear), bathing costumes, pyjamas, undergarments, scarves, suits, dresses, blouses, sun visors, anoraks, articles of clothing for leisurewear (other than footwear), articles of clothing for casualwear (other than footwear), articles of clothing for sportswear (other than footwear), articles of outer clothing (other than footwear), articles of weatherproof clothing (other than footwear), blazers, denims, jerseys, knitwear, parkas, sweatshirts, tops, and windcheaters, enabling customers to conveniently view and purchase those goods by mail order or by means of telecommunications.

The bringing together, for the benefit of others a variety of goods, namely soaps, cosmetics, perfumery, essential oils, eau de parfum, eau de toilette, cologne, fragrances and fragrance products for personal use, massage oils, hair lotions, dentifrices, cosmetic preparations for skin care, skin care cosmetics, skin care preparations, astringents for cosmetic purposes, preparations for the bath and shower, shower gel, bath gels, scented body lotions and creams, scented moisturizing skin cream, moisturisers, body lotions and creams, moisturising creams, scented skin soap, body oil, face, lip and cheek make-up, face powder, face glitter, lipstick, lip gloss, non-medicated lip balm, lip pencils, perfumed shimmer sticks, eye shadow, eye pencils, mascara, eye make-up, eyeliners, eye creams, eye gels, eye balms, highlighter, masks, cleansers, toners, clarifiers, exfoliators, foundation make-up, blusher, compacts, make-up remover, fragrance sachets, room fragrances, beauty care preparations, beauty care products, beauty creams, beauty tonics for application to the body, beauty tonics for application to the face, non-medicated beauty preparations, non-medicated skin care beauty products, skin care products for personal use, namely, face, eye and lip moisturisers, face and skin creams, lotions and serums, anti-aging treatments, foundation for the face, hair care

products, shampoo, hair conditioners, hair gel and hair spray, nail care preparations, nail polish, nail strengtheners and nail polish remover, shaving cream, shaving gel, after-shave preparations, after-shave lotion, depilatory preparations, personal deodorant, antiperspirants, potpourri, sun tanning preparations, cosmetic preparations for skin tanning, artificial tanning preparations, jewellery and imitation jewellery, precious stones, goods of precious metal or coated therewith, watches and clocks, wrist watch bands, tie clips, cuff links, key rings of precious metal, watch straps, tie pins, catalogues, calendars, printed matter, pages downloaded from the Internet, printed publications, magazines, pamphlets, stationery, posters, transfers, decalcomanias, diaries, pencil cases, pencils, pens, erasers, notebooks, paperweights, staplers, writing paper, envelopes, albums, binders, cardboard articles, packaging, files, fountain pens, hat boxes of cardboard, holders for cheque books, mats for beer glasses, coasters of paper, greeting cards, napkins of paper, newsletters, note books, packing paper, writing pads, passport holders, pictures, photographs, stands for pens and pencils, tissues of paper for removing make-up, artists materials, wrapping paper, bags of paper or plastic for packaging, boxes of paper or card or plastic for packaging, leather and imitation leather, cases, trunks, rucksacks, briefcases, umbrellas, parasols, walking sticks, back packs, hat boxes, animal skins, articles of clothing (other than footwear), lingerie, bras, pants, thongs, stockings, tights, suspender belts, camisoles, dressing gowns, negligees, corsets, night dresses, sleep shirts, sarongs, shoulder wraps, shorts, leggings, headgear, belts, trousers, shorts, jeans, wristbands, headbands, hats, gloves, jackets, coats, jumpers, shirts, t-shirts, sweaters, vests, trousers, skirts, waistcoats, waterproof clothing (other than footwear), bathing costumes, pyjamas, undergarments, scarves, suits, dresses, blouses, sun visors, anoraks, articles of clothing for leisurewear (other than footwear), articles of clothing for casualwear (other than footwear), articles of clothing for sportswear (other than footwear), articles of outer clothing (other than footwear), articles of weatherproof clothing (other than footwear), blazers, denims, jerseys, knitwear, parkas, sweatshirts, tops, and windcheaters, enabling customers to conveniently view and purchase those goods.

Retail services connected with soaps, cosmetics, perfumery, essential oils, eau de parfum, eau de toilette, cologne, fragrances and fragrance products for personal use, massage oils, hair lotions, dentifrices, cosmetic preparations for skin care, skin care cosmetics, skin care preparations, astringents for cosmetic purposes, preparations for the bath and shower, shower gel, bath gels, scented body lotions and creams, scented moisturizing skin cream, moisturisers, body lotions and creams, moisturising creams, scented skin soap, body oil, face, lip and cheek make-up, face powder, face glitter, lipstick, lip gloss, non-medicated lip balm, lip pencils, perfumed shimmer sticks, eye shadow, eye pencils, mascara, eye make-up, eyeliners, eye creams, eye gels, eye balms, highlighter, masks, cleansers, toners, clarifiers, exfoliators, foundation make-up, blusher, compacts, make-up remover, fragrance sachets, room fragrances, beauty care preparations, beauty care products, beauty creams, beauty tonics for application to the body, beauty tonics for application to the face, non-medicated beauty preparations, non-medicated skin care beauty products, skin care products for personal use, namely, face, eye and lip moisturisers, face and skin creams, lotions and serums, anti-aging treatments, foundation for the face, hair care products, shampoo, hair conditioners, hair gel and hair spray, nail care preparations, nail polish, nail strengtheners and nail polish remover, shaving cream, shaving gel, after-shave preparations, after-shave lotion, depilatory preparations, personal deodorant, antiperspirants, potpourri, sun tanning preparations, cosmetic preparations for skin tanning, artificial tanning preparations, jewellery, precious stones, goods of precious metal or coated therewith, watches and clocks, wrist watch bands, tie clips, cuff links, key rings of precious metal, watch straps, tie pins, catalogues, calendars, printed matter, pages downloaded from the internet, printed publications, magazines, pamphlets, stationery, posters, transfers, decalcomanias, diaries, pencil cases, pencils, pens, erasers, notebooks, paperweights, staplers, writing paper,

envelopes, albums, binders, cardboard articles, packaging, files, fountain pens, hat boxes of cardboard, holders for cheque books, mats for beer glasses, coasters of paper, greeting cards, napkins of paper, newsletters, note books, packing paper, writing pads, passport holders, pictures, photographs, stands for pens and pencils, tissues of paper for removing make-up, artists materials, wrapping paper, bags of paper or plastic for packaging, boxes of paper or card or plastic for packaging, leather and imitation leather, cases, trunks, rucksacks, briefcases, umbrellas, parasols, walking sticks, back packs, hat boxes, animal skins, articles of clothing (other than footwear), lingerie, bras, pants, thongs, stockings, tights, suspender belts, camisoles, dressing gowns, negligees, corsets, night dresses, sleep shirts, sarongs, shoulder wraps, shorts, leggings, headgear, belts, trousers, shorts, jeans, wristbands, headbands, hats, gloves, jackets, coats, jumpers, shirts, t-shirts, sweaters, vests, trousers, skirts, waistcoats, waterproof clothing (other than footwear), bathing costumes, pyjamas, undergarments, scarves, suits, dresses, blouses, sun visors, anoraks, articles of clothing for leisurewear (other than footwear), articles of clothing for casualwear (other than footwear), articles of clothing for sportswear (other than footwear), articles of outer clothing (other than footwear), articles of weatherproof clothing (other than footwear), blazers, denims, jerseys, knitwear, parkas, sweatshirts, tops, and windcheaters.

Mail order retail services connected soaps, cosmetics, perfumery, essential oils, eau de parfum, eau de toilette, cologne, fragrances and fragrance products for personal use, massage oils, hair lotions, dentifrices, cosmetic preparations for skin care, skin care cosmetics, skin care preparations, astringents for cosmetic purposes, preparations for the bath and shower, shower gel, bath gels, scented body lotions and creams, scented moisturizing skin cream, moisturisers, body lotions and creams, moisturising creams, scented skin soap, body oil, face, lip and cheek make-up, face powder, face glitter, lipstick, lip gloss, non-medicated lip balm, lip pencils, perfumed shimmer sticks, eye shadow, eye pencils, mascara, eye make-up, eyeliners, eye creams, eye gels, eye balms, highlighter, masks, cleansers, toners, clarifiers, exfoliators, foundation make-up, blusher, compacts, make-up remover, fragrance sachets, room fragrances, beauty care preparations, beauty care products, beauty creams, beauty tonics for application to the body, beauty tonics for application to the face, non-medicated beauty preparations, non-medicated skin care beauty products, skin care products for personal use, namely, face, eye and lip moisturisers, face and skin creams, lotions and serums, anti-aging treatments, foundation for the face, hair care products, shampoo, hair conditioners, hair gel and hair spray, nail care preparations, nail polish, nail strengtheners and nail polish remover, shaving cream, shaving gel, after-shave preparations, after-shave lotion, depilatory preparations, personal deodorant, antiperspirants, potpourri, sun tanning preparations, cosmetic preparations for skin tanning, artificial tanning preparations, with jewellery, precious stones, goods of precious metal or coated therewith, watches and clocks, wrist watch bands, tie clips, cuff links, key rings of precious metal, watch straps, tie pins, catalogues, calendars, printed matter, pages downloaded from the internet, printed publications, magazines, pamphlets, stationery, posters, transfers, decalcomanias, diaries, pencil cases, pencils, pens, erasers, notebooks, paperweights, staplers, writing paper, envelopes, albums, binders, cardboard articles, packaging, files, fountain pens, hat boxes of cardboard, holders for cheque books, mats for beer glasses, coasters of paper, greeting cards, napkins of paper, newsletters, note books, packing paper, writing pads, passport holders, pictures, photographs, stands for pens and pencils, tissues of paper for removing make-up, artists materials, wrapping paper, bags of paper or plastic for packaging, boxes of paper or card or plastic for packaging, leather and imitation leather, cases, trunks, rucksacks, briefcases, umbrellas, parasols, walking sticks, back packs, hat boxes, animal skins, articles of clothing (other than footwear), lingerie, bras, pants, thongs, stockings, tights, suspender belts, camisoles, dressing gowns, negligees, corsets, night dresses, sleep shirts, sarongs, shoulder wraps, shorts, leggings, headgear, belts, trousers, shorts, jeans,

wristbands, headbands, hats, gloves, jackets, coats, jumpers, shirts, t-shirts, sweaters, vests, trousers, skirts, waistcoats, waterproof clothing, bathing costumes, pyjamas, undergarments, scarves, socks, suits, dresses, blouses, sun visors, anoraks, articles of clothing for leisurewear (other than footwear), articles of clothing for casualwear (other than footwear), articles of clothing for sportswear (other than footwear), articles of outer clothing (other than footwear), articles of weatherproof clothing (other than footwear), blazers, denims, jerseys, knitwear, parkas, sweatshirts, tops, and windcheaters.

Electronic shopping retail services connected with soaps, cosmetics, perfumery, essential oils, eau de parfum, eau de toilette, cologne, fragrances and fragrance products for personal use, massage oils, hair lotions, dentifrices, cosmetic preparations for skin care, skin care cosmetics, skin care preparations, astringents for cosmetic purposes, preparations for the bath and shower, shower gel, bath gels, scented body lotions and creams, scented moisturizing skin cream, moisturisers, body lotions and creams, moisturising creams, scented skin soap, body oil, face, lip and cheek make-up, face powder, face glitter, lipstick, lip gloss, non-medicated lip balm, lip pencils, perfumed shimmer sticks, eye shadow, eye pencils, mascara, eye make-up, eyeliners, eye creams, eye gels, eye balms, highlighter, masks, cleansers, toners, clarifiers, exfoliators, foundation make-up, blusher, compacts, make-up remover, fragrance sachets, room fragrances, beauty care preparations, beauty care products, beauty creams, beauty tonics for application to the body, beauty tonics for application to the face, non-medicated beauty preparations, non-medicated skin care beauty products, skin care products for personal use, namely, face, eye and lip moisturisers, face and skin creams, lotions and serums, anti-aging treatments, foundation for the face, hair care products, shampoo, hair conditioners, hair gel and hair spray, nail care preparations, nail polish, nail strengtheners and nail polish remover, shaving cream, shaving gel, after-shave preparations, after-shave lotion, depilatory preparations, personal deodorant, antiperspirants, potpourri, sun tanning preparations, cosmetic preparations for skin tanning, artificial tanning preparations, jewellery, precious stones, goods of precious metal or coated therewith, watches and clocks, wrist watch bands, tie clips, cuff links, key rings of precious metal, watch straps, tie pins, catalogues, calendars, printed matters, pages downloaded from the internet, printed publications, magazines, pamphlets, stationery, posters, transfers, decalcomanias, diaries, pencil cases, pencils, pens, erasers, notebooks, paperweights, staplers, writing paper, envelopes, albums, binders, cardboard articles, packaging, files, fountain pens, hat boxes of cardboard, holders for cheque books, mats for beer glasses, coasters of paper, greeting cards, napkins of paper, newsletters, note books, packing paper, writing pads, passport holders, pictures, photographs, stands for pens and pencils, tissues of paper for removing make-up, artists materials, wrapping paper, bags of paper or plastic for packaging, boxes of paper or card or plastic for packaging, leather and imitation leather, cases, trunks, rucksacks, briefcases, umbrellas, parasols, walking sticks, back packs, hat boxes, animal skins, articles of clothing (other than footwear), lingerie, bras, pants, thongs, stockings, tights, suspender belts, camisoles, dressing gowns, negligees, corsets, night dresses, sleep shirts, sarongs, shoulder wraps, shorts, leggings, headgear, belts, trousers, shorts, jeans, wristbands, headbands, hats, gloves, jackets, coats, jumpers, shirts, t-shirts, sweaters, vests, trousers, skirts, waistcoats, waterproof clothing (other than footwear), bathing costumes, pyjamas, undergarments, scarves, socks, suits, dresses, blouses, sun visors, anoraks, articles of clothing for leisurewear (other than footwear), articles of clothing for casualwear (other than footwear), articles of clothing for sportswear (other than footwear), articles of outer clothing (other than footwear), articles of weatherproof clothing (other than footwear), blazers, denims, jerseys, knitwear, parkas, sweatshirts, tops, and windcheaters.

39. On the same basis, the application may proceed to registration in class 18 for:

**Class 18**

Leather and imitation leather; cases; trunks; rucksacks; briefcases; umbrellas; parasols; walking sticks; back packs; hat boxes; animal skins.

**Costs**

40. The original hearing officer decided that the parties had been roughly equally successful and therefore ordered that the parties should bear their own costs.

41. The Appointed Person directed that the costs of the appeal should be dealt with as part of the costs in the opposition proceedings.

42. The appeal failed in class 18, but required reconsideration in class 35. The result of the appeal was therefore a 'score draw'. The result of my decision is that the application will proceed for a wider range of services in class 35 than originally allowed. Overall, the applicant has been more successful than the opponent. I find that the opponent should therefore make a contribution towards the applicant's costs. Taking account of their relative success, I order Tony Van Gluck to pay Boohoo.Com UK Ltd the sum of £500.

43. The above sum should be paid within seven days of the expiry of the appeal period or, if there is a further appeal, within seven days of the conclusion of that appeal.

**Dated this 22nd day of October 2014**

**Allan James  
For the Registrar**