

O-534-14

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK REGISTRATION NO. 3006258
IN THE NAME OF RODRIGO OTAZU
IN RESPECT OF THE TRADE MARK:**

Rodrigo New York

AND

**AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO
UNDER NO 500220 BY OTAZU LICENSE LTD**

Background

1. Trade mark No. 3006258 shown on the cover page of this decision, stands registered in the name of Rodrigo Otazu (“the proprietor”). It was applied for on 16 May 2013 and completed its registration procedure on 25 August 2013. It is registered for the following goods in class 14:

Jade [jewellery]; Small jewellery boxes of precious metals; Costume jewellery; Enamelled jewellery; Fashion jewellery; Jewellery of precious metals; Crosses [jewellery]; Lapel pins [jewellery]; Rings being jewellery; Jewellery cases; Jewellery boxes; Jewellery boxes of precious metals; Jewellery, precious stones; Amulets being jewellery; Articles of imitation jewellery; Articles of jewellery; Articles of jewellery coated with precious metals; Articles of jewellery made from rope chain; Articles of jewellery made of precious metal alloys; Articles of jewellery made of precious metals; Articles of jewellery with ornamental stones; Articles of jewellery with precious stones; Artificial jewellery; Cases adapted to contain items of jewellery; Chain mesh of precious metals [jewellery]; Chains made of precious metals [jewellery]; Charms [jewellery] of common metals; Clips of silver [jewellery]; Cloisonne jewellery; Collets being parts of jewellery; Custom jewellery; Decorative articles [trinkets or jewellery] for personal use; Decorative brooches [jewellery]; Decorative pins [jewellery]; Dress ornaments in the nature of jewellery; Ear ornaments in the nature of jewellery; Fake jewellery; Gold jewellery; Gold plated brooches [jewellery]; Imitation jewellery ornaments; Items of jewellery; Jewellery articles; Jewellery being articles of precious metals; Jewellery being articles of precious stones; Jewellery chain; Jewellery chain of precious metal for anklets; Jewellery chain of precious metal for bracelets; Jewellery chain of precious metal for necklaces; Jewellery coated with precious metal alloys; Jewellery coated with precious metals; Jewellery containing gold; Jewellery fashioned from bronze; Jewellery fashioned from non-precious metals; Jewellery fashioned of cultured pearls; Jewellery fashioned of precious metals; Jewellery fashioned of semi-precious stones; Jewellery for personal adornment; Jewellery for personal wear; Jewellery in non-precious metals; Jewellery in precious metals; Jewellery in semi-precious metals; Jewellery in the form of beads; Jewellery incorporating diamonds; Jewellery incorporating pearls; Jewellery incorporating precious stones; Jewellery items; Jewellery made from gold; Jewellery made from silver; Jewellery made of bronze; Jewellery made of crystal; Jewellery made of crystal coated with precious metals; Jewellery made of glass; Jewellery made of non-precious metal; Jewellery made of plastics; Jewellery made of plated precious metals; Jewellery made of precious metals; Jewellery made of precious stones; Jewellery made of semi-precious materials; Jewellery ornaments; Jewellery products; Jewellery rope chain for anklets; Jewellery rope chain for bracelets; Jewellery rope chain for necklaces; Jewellery stones; Lapel pins of precious metals [jewellery]; Paste jewellery; Pendants

[jewellery]; Personal jewellery; Pewter jewellery; Pins being jewellery; Precious jewellery; Ring bands [jewellery]; Rings [jewellery]; Rings [jewellery] made of non-precious metal; Rings [jewellery] made of precious metal.

2. On 27 November 2013, Otazu License Ltd (“the applicant”) filed an application to have this trade mark declared invalid under the provisions of sections 47(2)(a) & (b) and sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). However, in a letter to the Tribunal dated 10 April 2014, the applicant withdrew the objections based upon sections 5(3) and 5(4)(a) of the Act. The relevant provisions which remain read as follows:

“47(2) The registration of a trade mark may be declared invalid on the ground-

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

(b)...

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

(2A) But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless—

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if—

(a) within the period of five years ending with the date of the application for the declaration the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes—

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered,

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(2D) In relation to a Community trade mark, any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Community.

2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

.....

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made.

Provided that this shall not affect transactions past and closed.”

And:

“5. - (2) A trade mark shall not be registered if because -

(a)....

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, or

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

An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) 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,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

3. The applicant directs its application against all of the goods for which the proprietor’s trade mark stands registered. It relies upon all of the goods (shown below) in Community Trade Mark (“CTM”) registration no. 10360444 for the trade

mark **RODRIGO OTAZU**, which was applied for on 21 October 2011, for which the registration process was completed on 18 August 2012 and which is registered for:

Class 14 - Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; Jewellery, precious stones; Jewellery, costume jewellery; Jewellery cases; Horological and chronometric instruments.

The trade mark shown above qualifies as an earlier trade mark under the above provisions. As the applicant's earlier trade mark had not been registered for more than five years when the application for invalidation was filed, it is not subject to proof of use, as per section 47(2)(2A) of the Act. As a consequence, the applicant is entitled to rely upon all of the goods for which its earlier trade mark is registered.

4. Although the ground has now been withdrawn, in its application, the applicant stated the following in relation to its objection based upon section 5(3) of the Act:

"It is understood that the Applicant for Cancellation legitimately acquired the rights in the RODRIGO OTAZU mark in October 2011 following a series of legal transactions that took place 2005-2011 (Annex 1). It is believed that the original business was established by the owner of the challenged mark in 1991 operating in the design and retail of jewellery sold under the mark RODRIGO OTAZU..."

I note that in a letter dated 19 June 2014, the Tribunal advised the parties that the applicant had not provided the documents referred to as Annex 1 to its application. For reasons which will shortly become apparent, this oversight (by both the applicant and the Tribunal), has no bearing on the issues before me.

5. The proprietor filed a counterstatement in which the basis of the invalidation is denied. He stated:

"1. The Proprietor is one of the most famous and prestigious jewellery designers in the world.

2. The Proprietor is the founder of the brand OTAZU, which is partially his own name. He has used the name since 1991 for the design and sale of jewellery.

3. The Proprietor uses the brand name RODRIGO NEW YORK, which includes his surname (sic), Rodrigo, for high end jewellery and is known as "Jeweler to the Stars", with Lady Gaga, Britney Spears, Madonna, Beyonce, Katy Perry, Jessica Parker Nicki Minaj and Jennifer Lopez amongst his celebrity clientele.

4. It is denied that the Applicant legitimately has acquired rights in the name RODRIGO OTAZU, and the alleged chain of title given by the Applicant is not admitted. The Applicant is put to strict proof of the claims made.

8. In respect of the Applicant's claims for invalidation under Sections 5(1) and 5(2), the Proprietor denies that his mark is similar to [the earlier trade mark]

and is to be registered for goods or services identical with or similar to those for which the Applicant's mark is protected, and he denies that there exists a likelihood of confusion on the part of the public, including a likelihood of association."

6. Whilst neither party filed evidence or asked to be heard, the proprietor filed written submissions in lieu of attendance at a hearing. The opening paragraph of the proprietor's submissions reads as follows:

"1. From the pleadings of the Parties, and the fact that the name of the Proprietor is the same as the trade mark on which the Cancellation Applicant relies, the Registrar will gather that there is a connection between the parties. However, as neither Party has filed evidence in these proceedings, none of this is relevant to the Proceedings, save that the Registrar is entitled in our submission to consider that the Cancellation Applicant's trade mark is a full name, comprising a personal name, RODRIGO and a family name OTAZU."

7. Although the factual circumstances of this case are, as the proprietor suggests somewhat unusual, as no evidence has been filed by either party, this is not a matter that I can take into account in reaching a decision. In those circumstances, what I must do is, inter alia, compare the competing trade marks/goods, and having done so, determine whether there is, or is not, a likelihood of confusion.

Section 5(2)(b) – case law

8. 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) 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 process

9. 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.”

10. The average consumer of the goods at issue is a member of the general public. As the goods are most likely to be the subject of self selection from retail outlets on the high street, or from the pages of a website or catalogue, visual considerations

are likely to loom large in the selection process. However, as, on occasion, it may be necessary for the average consumer to request the goods orally (for example in a traditional jewellers on the high street), aural considerations will also feature in the selection process. As to the degree of care the average consumer will take when selecting the goods, neither parties' specifications are limited in any way. As a consequence, the cost of the goods can vary widely, from a few pounds to many thousands of pounds. Whilst, for example, inexpensive costume jewellery may be selected on a whim with only a low degree of attention paid to its selection, bespoke jewellery made from, for example, precious metals and/or precious stones, is likely to be the subject of a much higher degree of care and attention.

Comparison of goods

11. In its application, the applicant states:

“The goods of the earlier mark are identical to the goods of the challenged mark.”

12. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the General Court (“GC”) stated:

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

13. As the competing specifications contain either identical terms, or as the applicant's specification includes broad terms which would include within their scope the proprietor's named goods, the competing goods are either literally identical, or identical on the principles outlined above in *Meric*.

Comparison of trade marks

14. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“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.”

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

Applicant’s trade mark	Proprietor’s trade mark
RODRIGO OTAZU	Rodrigo New York

15. In its application, the applicant states:

“The marks are confusingly similar on account of the challenged mark containing RODRIGO which is visually, aurally and conceptually identical to the distinctive component RODRIGO of the earlier mark, thereby rendering the challenged mark visually, aurally and conceptually similar to the earlier mark.”

16. In his submissions, the proprietor states:

“In the case of a trade mark that comprises a name, consumers generally attribute greater distinctiveness to the surname than the forename when a mark comprises of first and family name: Case T-185/03 Vincenzo Fusco v OHIM - (43 to 54)

Visually, the marks share the common element RODRIGO at the start but differ from then on. The Cancellation Applicant’s mark consists of one more word element, namely the distinctive and unusual surname OTAZU, and the contested sign of two, namely the place name NEW YORK. Hence, the marks are visually different overall.

Aurally, the marks are also different. The Cancellation Applicant’s mark consists of six syllables (RO-DRI-GO-O-TA-ZU), whereas the contested sign consists of only five (RO-DRI-GO-NEW-YORK). Although the first three syllables of each mark are the same, reasonably well informed, observant and circumspect consumers are unlikely to overlook the element OTAZU in the Cancellation Applicant’s mark, nor are they likely to confuse it with NEW YORK in the contested sign, which is aurally completely different.

Conceptually, the applicant’s mark will be perceived by the relevant consumer as a full name with RODRIGO being the first name and OTAZU being the family name. RODRIGO NEW YORK on the other hand will be understood as ‘Rodrigo from New York’; a basic description of a person called Rodrigo living in, or coming from, New York.

This distinction is enhanced by the facts that the sign RODRIGO OTAZU has a Spanish ring to it whereas RODRIGO NEW YORK has no such connotation, with NEW YORK being of American English origin and, in such a context, RODRIGO having either a Latin American or Spanish feel, the whole being a distinctive mixture of different cultures and lineages.

The over-riding dominant and distinctive element within the trade mark of the Cancellation Applicant is the word OTAZU. This is because there are far fewer family names than personal names, and so family names are the key factor when people consider the distinguishing features of names. Hence, when a full name is used as a trade mark, the average consumer will place more stock by the family name than by the personal name.

To put this another way, in the trade mark of the Cancellation Applicant, the element RODRIGO does not fulfil an independent function, but rather it qualifies the family name and serves to distinguish the notional person called Rodrigo Otazu from other Otazus. This leads to the normal rules of distinction (whereby the beginning of a mark is often considered the most important) being displaced where a trade mark comprises a name. One may illustrate this by considering the personal name David. This name can have numerous connotations, dependent upon, and therefore not independent of, the family name with which it is associated (consider, for example, David Beckham, David Cameron, David Yurman and David Hasselhoff).

On the other hand, the contested sign RODRIGO NEW YORK is a different kind of trade mark, which will be perceived by consumers in a different way.

The conceptual differences between the marks will impinge on the way consumers perceive the marks visually and aurally, enhancing the differences between them. One would never confuse David Cameron with David Beckham.”

17. In his submissions, the proprietor draws my attention to the decision of the GC mentioned above (in which it was concluded there was a likelihood of confusion between ENZO FUSCO and ANTONIO FUSCO) and to two decisions of the Opposition Division of the Office for Harmonisation in the Internal Market (“OHIM”) who considered the similarity between DANIEL ROTH and DANIEL DODD and CHRISTIAN DIOR and CHRISTIAN DAN respectively, concluding that there was no likelihood of confusion. In *Harman International Industries, Inc v OHIM*, Case C-51/09P, the CJEU 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”.

In *El Corte Inglés, SA v OHIM*, Case T-39/10, the GC 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.”

18. The applicant’s trade mark consists of the words RODRIGO and OTAZU presented as separate words in upper case; although the words RODRIGO and OTAZU are likely to be fairly unusual (RODRIGO) and highly unusual (OTAZU) to the average consumer in the United Kingdom, as both words are of roughly equal length and as the word RODRIGO appears as the first word in the trade mark, both words are, in my view, likely to make a roughly equal contribution to the overall impression the trade mark makes on the average consumer. The proprietor’s trade mark consists of the word Rodrigo presented in title case together with the words New York also in title case. As the words New York will be well known to the average consumer as a geographical location in the United States of America, these words have no distinctive character; the consequence of which, is that the overall impression created by the proprietor’s trade mark will be dominated by the word Rodrigo. However, as the words New York still contribute to the overall impression the proprietor’s trade mark conveys, I will bear them in mind when I compare the competing trade marks.

19. In my experience, the word RODRIGO/Rodrigo can operate as either a forename or surname. As a consequence, the conceptual message conveyed by the applicant’s trade mark, may be of either an individual with the forename RODRIGO and the surname OTAZU (as is the case in these proceedings) or of two surnames,

whereas the conceptual message sent by the proprietor's trade mark will be of a person who has either the forename or surname Rodrigo, who is, or perhaps who has a business which is, based in New York City. Insofar as the word RODRIGO/Rodrigo may operate as a forename and OTAZU as a surname, the competing trade marks are conceptually similar to the extent that they both refer to an individual with the forename RODRIGO/Rodrigo, but differ to the extent that the applicant's trade mark refers to a specific individual, whereas the proprietor's trade mark simply relates to an individual with that forename who is, for example, based in New York City. Considered overall, I think, the competing trade marks are conceptually similar to a reasonable degree. Insofar as the visual and aural comparison is concerned, the fact that both trade marks share the word RODRIGO/Rodrigo but have differing suffixes i.e. OTAZU and New York, results, in my view, in at least a reasonable degree of visual and aural similarity between them. However, given the descriptive nature of the words New York, it is, in my view, highly likely that these words will not be articulated by the average consumer when referring to the proprietor's trade mark and will be largely disregarded when it is considered from a visual perspective; conclusions which would, of course, lead to a heightening of the degree of aural and visual similarity between the competing trade marks.

Distinctive character of the applicant's earlier trade mark

20. I must now assess the distinctive character of the applicant's trade mark. The distinctive character of a trade mark can be appraised only, first, by reference to the goods for which it is registered and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. As no evidence has been filed in these proceedings, I have only the inherent characteristics of its trade mark to consider. As I mentioned earlier, the elements which comprise the applicant's trade mark (whether alone or in combination) would, in my view, be either fairly unusual (the word RODRIGO) or highly unusual (the word OTAZU) to the average consumer in the United Kingdom. Considered as a totality, the applicant's trade mark is, in my view, possessed of a fairly high degree of inherent distinctive character.

Likelihood of confusion

21. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to factor in the distinctive character of the applicant's trade mark as the more distinctive this trade mark is the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and 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, inter alia, that:

- the competing goods are identical;
- the average consumer is a member of the general public who will select the goods both visually and orally (although the visual element is likely to be more important) and whose level of attention is likely to vary markedly;
- the presence in the competing trade marks of the word RODRIGO/Rodrigo results in at least a reasonable degree of visual, aural and conceptual similarity between them;
- the applicant's earlier trade mark is possessed of a fairly high degree of inherent distinctive character.

22. Whilst I accept that in the United Kingdom (as in many other countries) surnames are likely to have more distinctive character than forenames, as the court points out, the specific features of each case must be taken into account, including, inter alia, the distinctive character of the forename. Although in his counterstatement, the proprietor claims he "is one of the most famous and prestigious jewellery designers in the world", as no evidence has been filed in support of such a claim, that is not a factor that I can take into account.

23. The differences between the competing trade marks are, in my view, sufficient to avoid direct confusion i.e. where one trade mark is mistaken for the other. That leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc* (BL-O/375/10), the Appointed Person, Mr Iain Purvis Q.C, commented on the difference between direct and indirect confusion in the following terms:

"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.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even

where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

24. Having concluded there will be no direct confusion, will there be indirect confusion? In my view, there will. I reach that conclusion because, in my view, the word RODRIGO/Rodrigo is sufficiently unusual/distinctive in the United Kingdom that its presence in the competing trade marks will fix itself in the average consumer’s mind and lead them to assume that the identical goods at issue in these proceedings originate from undertakings which are economically linked. In reaching that conclusion, I have not lost sight of the fact that, on occasions, it is possible that the average consumer will be extremely attentive when selecting the goods at issue. However, as the specifications are not limited in any way, that it not a point that assists the proprietor. However, even when considered in relation to goods at the higher end of the price range, the unusual/distinctive nature of the word RODRIGO/Rodrigo in the competing trade marks will, in my view, still lead the average consumer to the same conclusion.

Conclusion

25. The application has been successful and, subject to any successful appeal, the registration will, under the provisions of section 47(6) of the Act, be deemed never to have been made.

Costs

26. The applicant has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, I award costs to the applicant on the following basis:

Preparing a statement and considering the other side’s statement:	£200
Application fee	£200
Total:	£400

27. I order Rodrigo Otazu to pay to Otazu License Ltd the sum of **£400**. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 15th day of December 2014

C J BOWEN
For the Registrar
The Comptroller-General