

O-543-18

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3294123 BY
JACK LANE
TO REGISTER:

ENVY

AS A TRADE MARK IN CLASS 14

AND

OPPOSITION THERETO (UNDER NO. 60000830) BY
ENVY JEWELLERY LIMITED

Background and pleadings

1. Jack Lane (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK on 3 March 2018. It was accepted and published in the Trade Marks Journal on 23 March 2018. Registration is sought in relation to watches in class 14.

2. Envy Jewellery Limited (“the opponent”) have opposed the registration of the mark using the fast track opposition procedure. The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), with the opponent relying on two of its earlier UK Trade Mark registrations, namely:

i) Registration 3255601 for the mark **ENVY COLLECTIONS** which was filed on 8 September 2017 and registered on 9 March 2018. The mark is registered for: fashion jewellery in class 14.

ii) Registration 3044357 for the mark **Envy Jewellery** which was filed on 27 February 2014 and registered on 6 June 2014. The mark is registered for: Costume jewellery; Costume jewellery; Jewellery fashioned from non-precious metals; Jewellery fashioned of semi-precious stones; Jewellery in non-precious metals; Jewellery made of non-precious metal.

3. The opponent contends in its statement of case that the use by the applicant of its mark would be confusing/conflicting. It also states that it may sell watches in the future or that the applicant may sell jewellery; however, these points are not pertinent because the tribunal can only consider confusion on the basis of what is actually covered by the respective registrations/application which are the subject of this dispute.

4. The applicant filed a counterstatement denying the ground of opposition. I note the following from his counterstatement:

- The opponent is trading under the name ENVY COLLECTIONS not ENVY as per the subject application.

- The opponent's jewellery is for women only.
- The applicant intends to trade in respect of men's watches only.
- The applicant has no intention of selling jewellery or women's watches.
- The applicant will trade only online and his website will indicate that the business was established in 2018.

5. In these proceedings, both sides have represented themselves.

6. Rule 6 of the Trade Marks (Fast Track Opposition)(Amendment) Rules 2013, S.I. 2013/2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.

7. The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions. No leave was sought in respect of these proceedings.

8. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken. The applicant requested a hearing, but the only reason given for the request was that he wanted to provide an explanation as to why the opposition should not be upheld. The Tribunal wrote to the applicant refusing the request to be heard and advising him that he should explain why a hearing was necessary [to determine the case justly] and why it would be proportionate to the costs of the proceedings. The applicant did not respond, so these proceedings continued on the basis of the papers only. In terms of written arguments, only the opponent filed further written

arguments (which I take into account but will not separately summarise), although, I will, of course, take into consideration what both parties stated in their initial statements.

Decision

9. Section 5(2)(b) of the Act states that:

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

...

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

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

10. An “earlier trade mark” is defined in section 6 of the Act:

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.

11. The registrations upon which the opponent relies qualify as earlier trade marks under the above provisions. As both marks were registered within the five years before the date on which the applicant’s mark was published, they are not subject to proof of use. The opponent is therefore entitled to rely upon its marks for all the goods for which they are registered. This is pertinent in relation to the applicant’s point that the opponent sells only women’s jewellery; the registrations cover jewellery

at large which, therefore, includes both male and female jewellery; the opponent is entitled to rely on such goods without restriction.

Section 5(2)(b) case law

12. The following principles are gleaned from the decisions of the courts of the European Union 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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

13. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer*, the Court of Justice of the European Court of Justice (“CJEU”) stated:

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.¹

14. Guidance on this issue has also come from Jacob J in *British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”)² where the following factors were highlighted as being relevant when making the comparison:

- (a) the respective uses of the respective goods or services;
- (b) the respective users of the respective goods or services;
- (c) the physical nature of the goods or acts of service;
- (d) the respective trade channels through which the goods or services reach the market;
- (e) in the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) the extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

15. The comparison is between watches on the one hand, and jewellery on the other, as set out below:

Fashion jewellery for the **ENVY COLLECTION** mark

and

1 - C-397/97, para. 23
2 - [1996] RPC 281

“Costume jewellery; Costume jewellery; Jewellery fashioned from non-precious metals; Jewellery fashioned of semi-precious stones; Jewellery in non-precious metals; Jewellery made of non-precious metal” for the **Envy Jewellery** mark.

16. I accept that the term jewellery does not literally encompass watches. The goods are therefore not identical. However, confusion can arise on the basis of goods which are just similar.

17. In terms of similarity, the main purpose of a watch is to tell the time. The main purpose of jewellery is to adorn the body, with the aim of improving one’s overall and outward appearance. Whilst such main purposes are clearly different, it is also the case that watches are also used to adorn the body (normally on the wrist) and are also designed in way to improve one’s overall and outward appearance. There is therefore some similarity in purpose, particularly with items such as bracelets (both male and female). The nature of watches and jewellery (again, particularly bracelets) has some similarity, often being made from metal, leather or combinations thereof. The nature is not completely the same as the mechanical or electronic aspects of a watch will not be present in jewellery, even bracelets. The channels of trade are similar. It is a notorious fact that jewellers will very often sell watches through the same outlets. In terms of competition/complementary, I do not consider that either of these aspects is particularly prevalent in this assessment. I consider that watches and jewellery (particular bracelets) have a medium degree of similarity to each other. I should add that I come to this view whether the watches are male or female watches. Whilst I accept that there may be slightly more similarity between women’s watches and women’s jewellery, there is still a medium degree of similarity with regard to men’s watches and men’s jewellery (the latter, as observed earlier, being covered by both of the opponent’s registrations).

Average consumer and the nature of the purchasing act

18. In accordance with the case law cited in paragraph 12, I must determine who is the average consumer and the nature of the purchasing act. 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 in question³.

19. The average consumer of both watches and jewellery is a member of the general public. The items are not everyday purchases, but they are still likely to be purchased reasonably frequently. Although I accept that some watches and some items of jewellery can be expensive (and therefore carefully considered), this is not the case with all such goods - some can be much cheaper. Therefore, it is also necessary to consider the likelihood of confusion in respect of such lower cost items where, in my view, just a normal degree of attention will be paid during the selection process.

20. The selection process will be very much a visual one because the consumer will be looking carefully at the aesthetic characteristics the goods possess. They will be perused in shop windows, in display counters, in brochures and on the web. However, oral considerations still have a role to play, particularly bearing in mind that the consumer may need to ask a sales assistant to view the goods more closely.

Comparison of marks

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

³ *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*, C-342/97, para. 26

that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.⁴

22. It would be wrong, therefore, to artificially dissect the 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 the marks.

23. The respective marks are shown below:

ENVY

v

ENVY COLLECTION

and

Envy Jewellery

24. The applicant's mark consists of the word ENVY. Whilst presented in a particular font, it is an unremarkable one. The overall impression will be strongly dominated by the word itself.

25. Both earlier marks consist of the word ENVY/Envy, together with words which, in my view, will clearly be seen as descriptive words (COLLECTION/Jewellery). For this reason, the average consumer will focus their attention strongly on the initial words that make up the mark and, therefore, the words ENVY/Envy strongly dominate the overall impression of both marks. I will, though, continue to take into account the whole of the marks in the comparison.

⁴ C-591/12P, para. 34

26. Visually and aurally, the marks have a strong aspect of similarity due to the common presence of the word ENVY. That this word is in sentence case in one of the earlier marks does not matter because, notionally, that mark can be used in upper case, lower case or sentence case. The stylisation of the applied for mark creates little difference because it is so unremarkable. The additional words COLLECTIONS/Jewellery is a further difference, however, as such words have less weight in the overall impression, the difference they contribute is lessened. I consider the marks to be visually and aurally similar to a high degree.

27. There is also a high degree of conceptual similarity as all of the marks will be conceptualised on the basis of the conventional meaning of the word envy.

Distinctive character of the earlier trade mark

28. Having compared the marks, it is necessary to determine the distinctive character of the earlier mark, in order to make an assessment of the likelihood of confusion. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, the ECJ stated that:

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 *WindsurfingChiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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).⁵

29. No use having been filed, I have only the inherent characteristics of the marks to consider. The distinctiveness of the mark(s) is based predominantly upon the word ENVY. Whilst it could be argued that such a word has some suggestive/allusive qualities (that they will make other people envious), such allusion is extremely mild. I consider the marks to be possessed of a normal (medium) degree of distinctiveness. Whilst the marks are not highly distinctive, they certainly cannot be said to be low in distinctive character either.

Conclusions on likelihood of confusion

30. I have so far considered the factors that need to be taken into account when assessing the likelihood of confusion and now come to a global assessment. As the CJEU stated:

A global assessment of the likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between these goods or services. Accordingly, a lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the marks, and vice versa. The interdependence of these factors is expressly mentioned in the tenth recital of the preamble to the Directive, which states that it is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion, the appreciation of which depends, in particular, on the recognition of the trade mark on the market and the degree of similarity between the mark and the sign and between the goods or services identified.⁶

⁵ C-342/97, paras. 22-23

⁶ *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, C-39/97, para. 17

31. There are two types of confusion that must be considered:

- direct confusion, where one mark is mistaken for another; and
- indirect confusion, where the similarities lead the consumer to believe that the goods or services come from the same, or a related, undertaking.

32. Whilst bearing in mind the global assessment that must be made, this case hinges, in my view, on what impact the difference between the goods makes. If the goods had been identical (be they watches or jewellery) I would have had little hesitation in upholding the opposition. Having added the goods similarity to the mix, and bearing in mind the similarity between the marks and the level of distinctiveness, I still conclude that there is a likelihood of confusion. The average consumer will assume that the same undertaking is offering both jewellery and watches under a similar ENVY brand. This would be no stretch for the average consumer to reach given the common trade channels that are in play and the relationship in nature and purpose between watches and jewellery. Some consumers will not recall the differences between the marks because the words COLLECTION/Jewellery are so descriptive. Even if the difference was noticed, it makes no material difference because the descriptive nature of the words does nothing to inform the consumer that the undertakings are different and does nothing to dispel that the goods come from the same trade source. I should say for sake of completeness that this finding would have been the same even if the applicant had formally requested the application be restricted to men's watches only. As observed already, there is still a medium degree of similarity with jewellery and the factors would still have combined to create a likelihood of confusion. The opposition succeeds.

COSTS

33. The opponent has been successful and is entitled to a contribution towards its costs. Awards of costs in proceedings commenced on or after 1 July 2016 are

governed by Tribunal Practice Notice (TPN) 2/2016. For fast track opposition proceedings, costs are capped at £500, excluding the official fee.⁷

Official fee - £100

Preparing a statement and considering the other side's statement - £100

Written submissions - £50

Total: £250

34. I therefore order Jack Lane to pay Envy Jewellery Limited the sum of £250. The above sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

Dated this 30th day of August 2018

Oliver Morris
For the Registrar,
The Comptroller-General

⁷ TPN 2/2015.