TRADE MARKS ACT 1994

IN THE MATTER OF:

OPPOSITION No. 411232

IN THE NAME OF DIRAMODE S.A.

TO TRADE MARK APPLICATION No. 3264928

IN THE NAMES OF RICHARD TURNHAM AND LINDA ANN TURNHAM

DECISION

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1. Diramode S.A. ("the Opponent") is the proprietor of the trade mark **PIMKIE** registered as an EU trade mark under number 3658028 on 26 May 2005 with a filing date of 27 January 2004 for the following goods in Class 14: *'Precious metals and their alloys and goods in precious metals or coated therewith not included in other classes; jewellery, costume jewellery, precious stones; horological and chronometric instruments'*.

2. On 20 October 2017, Richard Turnham and Linda Ann Turnham ("the Applicants") applied under number 3264928 to register the word **PINKIES** as a trade mark for use in relation to a long list of goods in Class 14. The list has for the purposes of this appeal been voluntarily reduced by an unconditional offer to restrict it to the following: *'Alloys of precious metal; diamonds; gold; platinum [metal]; precious metals; precious stones; presentation boxes for jewellery; presentation boxes for jewelry; rhodium; rings [jewellery]; rings [jewelry]; semi-precious stones; silver'*.

3. The Opponent objected and continues to object to the application under s.5(2)(b) of the Trade Marks Act 1994 on the ground that it would give rise to the existence of a likelihood of confusion if the marks **PIMKIE** and **PINKIES** were to be used

concurrently in the United Kingdom for Class 14 goods of the kind for which they were respectively registered and proposed to be registered.

4. The Opposition was rejected for the reasons given by Ms. Leisa Davies on behalf of the Registrar of Trade Marks in a decision issued under reference BL O/017/19 on 11 January 2019. She ordered the Opponent to pay £700 to the Applicants as a contribution towards their costs of the proceedings in the Registry.

5. The Applicants pleaded in defence of their application for registration that:

> Pinkies is not the same as Pimkie
>
> Pinkies is completely descriptive and says exactly what part of the body is being referred to
>
> Pinkies and Pimkie are 2 entirely different businesses at other ends of the scale. The Pimkie market is largely mainland Europe Not the UK aimed at the more affordable demographic with clothing. Pinkies is aimed at ABC1, this is an affordable luxury hand finished item and the prefect product as a gift, a ring made from precious metals and jewels.

They did not require the Opponent to provide proof of use of its earlier trade mark. The Opponent filed no evidence at all in support of its opposition to the application in suit.

6. The Applicants filed evidence in the form of a witness statement of Richard Turnham in which he stated:

> 1. Since the introduction of proper Hallmarking in 1478 each marker of precious metal articles is obliged by the assay office to have his or her own unique mark. Today that has not changed and now the applicant must have a trading name that is not only unique but a 2 or 3 letter punch mark that pertains to the trading name as well. Our unique trading name of PINKIES and the mark PNK are now registered under our Sponsor number 15219

> 1.2 Documentation attached from the Assay Office
>
> 1.3 Pimkie has no registration with the assay office, nor anything pending.
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> 2. Pinkies Logo is still under development, however an example of the style for packaging and branding is attached.
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> As you can see through the entire application process, the initial concept idea is to create a brand of ring to be placed on the little finger made from precious metals and Jewels accordingly and not to venture into clothing etc
>
> ...

7. The Hearing Officer rightly confirmed in paragraph [13] of her decision that the Assay Office registration had no bearing on the matters she had to decide under the Trade Marks Act 1994 and that the Applicants' evidence in that connection should play no part in her deliberation.

8. She decided in paragraph [25] (and I do not understand it to be disputed on appeal) that *'presentation boxes'* of the kind specified in the contested application for registration were *'similar'* to *'jewellery'* within the scope of the Opponent's trade mark registration *'as they are either presentation boxes or jewellery containers to hold items of jewellery. They are complementary in so far as items of jewellery are often displayed in presentation boxes or kept in ornamental boxes, they share the same producers, relevant public and distribution channels and therefore they are similar to a medium degree even though their nature and method of use are different'*.

9. In paragraph [24] she decided (and again I do not understand it to be disputed on appeal) that the remainder of the goods listed in the contested application for registration were goods of a kind listed in the earlier registration and for that reason fell to be regarded as *'identical'* thereto.

10. Her assessment of the purchasing process for the goods concerned was as follows:

> [28] In the present case the goods found to be identical or similar are directed at the general public at large who is likely to choose the goods from a shop or online through self-selection or from recommendations. Consumers purchasing jewellery such as engagement rings are likely to exercise a greater degree of thought in the purchasing process as they will be considered luxury, high end often bespoke pieces of some value. These purchases are not spontaneous or impulsive but are careful infrequent purchases. For this class of jewellery therefore the average consumer will be highly observant and aware. This is in complete contrast to costume jewellery which are of low value, and where the purchasing process is more casual. Despite this however even jewellery at the lower end of the market would attract a reasonable level of care as a number of factors would prevail in the purchasing process namely the style of the piece and whether it complements an outfit or is given as a gift. On this basis therefore, I would consider that the average consumer would take a reasonable to high level of care in the purchasing process which would be primarily visual although I do not discount aural considerations.

11. In paragraph [41] she confirmed that the trade mark **PIMKIE** was possessed of a high degree of inherent distinctiveness:

> The earlier mark consists of one word "PIMKIE" with no apparent allusive association with the goods or services covered by the registration. Registered marks possess varying degrees of inherent distinctiveness on a scale of low to high. Some are descriptive or allusive of a characteristic of the goods or services whilst others have no such qualities if they are made up or invented. Since the word will be considered to be invented it has a high degree of inherent distinctiveness.

12. Her overall assessment with regard to the likelihood of confusion was as follows:

> [44] I have identified the average consumer to be a member of the general public who would primarily select the goods via visual means but with aural means not being discounted. I have found that a reasonable to high degree of attention will be paid in the purchasing process. I have found that the earlier mark has a high degree of inherent distinctive character. I am

> also mindful of the decision in *The Picasso Estate v. OHIM*, Case C-361/04 P, where the Court of Justice of the European Union found that:
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> > "20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law."
>
> [45] Despite the good visual and aural similarities between the marks I cannot ignore the conceptual differences, which are too great to be missed by the average consumer paying at least a reasonable degree of attention. Weighing up all the relevant factors I find that the conceptual meaning of 'Pinkies' will counteract the aural and visual similarities between them. I have considered the possibility of confusion through consumers misreading or mishearing one mark for the other however I consider this to be unlikely. I do not consider therefore that consumers will mistake one mark for the other and therefore conclude that there is no likelihood of confusion.

13. The Opponent contends on appeal that there was no sufficient or proper basis for the Hearing Officer's determination to the effect that **PIMKIE** and **PINKIES** could be used concurrently as trade marks for Class 14 goods of the kind for which they were respectively registered and proposed to be registered without giving rise to the existence of a likelihood of confusion because *'the conceptual meaning of PINKIES will counteract the aural and visual similarities between them'*.

14. The Applicants support the Hearing Officer's decision on the basis that *'PINKIES is spelt in such a way that the consumer would understand the intended use of "PINKIES" to actually be an abbreviation of Pinky Rings, this would be apparent in all of our products, as this is and will always be a ring made of precious metals incorporating jewels at times intended to be worn on the little finger. ... In this*

instance we have looked at Pimkie, and they have no stores in the UK, they are a fashion outlet, NOT a jewellery brand spread throughout Europe. There is no similarity in product, business or name as we see it'.

15. I must at this point emphasise the requirement for the objection to registration under s. 5(2)(b) to be assessed with due regard for all the circumstances in which the mark **PIMKIE** might be used for Class 14 goods of the kind for which it is registered (as listed in paragraph 1 above) and all the circumstances in which the mark **PINKIES** might be used for Class 14 goods of the kind for which it is sought to registered (as listed in paragraph 2 above): Case C-533/06 O2 Holdings Ltd v. Hutchison 3G UK Ltd EU : C : 2008 : 339 at para. [66].

16. The objection to registration must therefore be examined across the full width of the list of goods for which registration of **PINKIES** is requested and cannot be confined to an examination of the objection in relation only to *'rings made of precious metals incorporating jewels at times intended to be worn on the middle finger'* in the absence of any steps being taken to restrict the coverage of the contested application for registration to rings of that kind.

17. It follows that the envisaged *'conceptual meaning of PINKIES'* would, in the absence of any such steps being taken, need to be operative in the context of commerce across the full width of the list of goods before it could be taken to '*counteract the aural and visual similarities*' between **PIMKIE** and **PINKIES** to the extent necessary to justify rejection of the opposition in its entirety.

18. The Hearing Officer assessed the position with regard to '*conceptual meaning*' in paragraph [38] of her decision:

> The Applicant submits that conceptually "Pinkies is a plural noun meaning little fingers, and is commonly recognised throughout the UK when dealing with jewellery in this case as the term Pinkie ring meaning ring on the little finger". In contrast it submits that the Opponent's mark has no reference

> within any online dictionary and does not exist as a well-known word. For a conceptual message to be relevant it must be immediately grasped by the average consumer. The average UK consumer is likely to understand the meaning of the word Pinkies as the plural form of little finger but there may be a proportion who merely associate it with the colour pink. For rings specifically, the link may be made with pinkie rings however for other types of jewellery I do not consider that the average consumer would necessarily or immediately recognise this meaning. The Opponent is silent on the conceptual meaning of Pimkie and therefore I would consider it to be an invented word. Therefore, I do not consider there to be any conceptual similarity between the marks whether the Applicant's mark is perceived as little fingers or by reference to the colour pink.

19. She thus determined that **PINKIES** would be '*perceived as little fingers or by reference to the colour pink*' and would not '*necessarily or immediately*' be linked to pinkie rings in the context of jewellery other than '*rings*' as listed in the contested application for registration. In doing so, she recognised that the nature of the goods in relation to which the mark **PINKIES** was used within the coverage of the contested application for registration was liable to affect the way in which it would be perceived and remembered by consumers exposed to the use of it.

20. In paragraph [45] the Hearing Officer spoke of the existence of '*good visual and aural similarities between the marks*' **PIMKIE** and **PINKIES**. This echoed what she had said in paragraphs [36] and [37] of her decision.

21. In paragraph [36] she addressed the question of visual similarity:

> Both marks are word only marks of similar length. They coincide in five of their letters namely the sequence P-I-*- K-I-E-* which present identically in both marks. The marks only differ in their third letter and ending namely on "M" in the earlier mark and "N" in the Opponent's mark and the Applicant's mark ending in an "S". Both N and M are visually similar. The obvious visual difference between the letters in the marks are reduced by the remaining common elements. I take note that as a general rule, beginnings of words tend to

> have more visual and aural impact than the ends and although this does not apply in all cases the relevant public is likely to consider marks as wholes and not dissect each element. I therefore consider the marks to share a good degree of visual similarity.

22. In paragraph [37] she addressed the question of aural similarity:

> The Applicant's mark is likely to be pronounced PINK-EYS because it is unlikely that the UK average consumer would pronounce the N separately. Whereas the Opponent's mark is likely to be pronounced PIM-KEY. In both case the beginning of the words will be pronounced in an identical way despite the difference in the third letter and phonetically there will be little difference between the pronunciation of the letter "M" and "N". I note that the end of the Applicant's word will be pronounced with the addition of the "S" however overall there is sufficient similarity in the articulation of the words when taken as a whole, for me to determine that the marks share a good degree of aural similarity.

23. There is plainly a high degree of visual and aural similarity between the marks **PIMKIE** and **PINKIES**. I do not think the Hearing Officer could reasonably or realistically be taken to have decided otherwise simply because she described them somewhat loosely as visually and aurally similar to '*a good degree*'. And I think it is clear that she recognised in paragraphs [36] and [37] of her decision that the letters **M** and **N** contribute to the degree of similarity between the marks by being visually very similar and aurally very close.

24. For the purpose of determining whether **PIMKIE** and **PINKIES** could be used concurrently as trade marks for the identical and similar goods in Class 14 for which they were respectively registered and proposed to be registered without giving rise to the existence of a likelihood of confusion, the Hearing Officer had to make a realistic appraisal of the net effect of the similarities and differences between the marks and the goods in issue, giving the similarities and differences as much or as little significance as the relevant average consumer, who is taken to be reasonably

well-informed and reasonably observant and circumspect, would have attached to them at the relevant point in time.

25. It was necessary to consider, as part of that process, how the interplay between the visual, aural and conceptual aspects of the marks in issue would affect the way in which they were liable to be perceived and remembered. This was important. The outcome of the opposition ultimately depended upon whether the marks were or were not sufficiently different from a conceptual point of view to be regarded as insufficiently similar from a visual or aural point of view to give rise to the existence of a likelihood of confusion.

26. In Case C-437/16P Wolf Oil Corp. v. EUIPO EU:C:2017:737 the CJEU was '*called upon to determine whether the General Court, for the purpose of establishing the neutralisation of similarities of two signs, can simply point out that the earlier sign refers to a clear and immediately apparent concept and that the contested sign does not have a clear meaning which can be immediately perceived by the relevant public'* (paragraph [42].

27. The Court observed as follows:

> 43. In that regard, it should be recalled that, according to settled case-law, the conceptual differences between two signs at issue may counteract their visual and phonetic similarities, provided that at least one of those signs has a clear and specific meaning for the relevant public, with the result that that public is capable of grasping it immediately (see, inter alia, judgments of 12 January 2006, *Ruiz-Picasso and Others v. OHIM*, C-361/04 P, EU:C:2006:25, paragraph 20, and of 23 March 2006, *Mülhens v OHIM,* C-206/04 P, EU:C:2006:194, paragraph 35).
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> 44. According to the case-law of the Court of Justice, the neutralisation of the visual and phonetic similarities of the signs at issue by their conceptual differences is examined when making the overall assessment of the similarity of those signs, which is based on the overall impression given by those signs (see, to that effect, judgments of 12 January 2006, *Ruiz-*

> *Picasso and Others v OHIM,* C-361/04 P, EU:C:2006:25, paragraphs 19 to 21; of 23 March 2006, *Mülhens v OHIM,* C-206/04 P, EU:C:2006:194, paragraphs 34 and 35; and of 15 March 2007, *T.I.M.E. ART v OHIM*, C-171/06 P, not published, EU:C:2007:171, paragraphs 48 and 49). That case-law deals more specifically with the assessment of the degree of conceptual differences which may lead to the neutralisation of visual and phonetic similarities. That analysis must be preceded by a finding of the conceptual differences between the signs at issue (see, to that effect, judgments of 12 January 2006, *Ruiz-Picasso and Others v OHIM,* C-361/04 P, EU:C:2006:25, paragraphs 22 and 23, and of 18 December 2008, *Les Éditions Albert René v OHIM,* C-16/06 P, EU:C:2008:739, paragraphs 96 to 98.
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> 45. … A distinction should be made between the assessment of the conceptual differences between the signs at issue and the overall assessment of their similarities, which form two distinct stages in the analysis of the overall likelihood of confusion, the first being a prerequisite for the second.

and went on to observe:

> 53. On the merits, contrary to the appellant's assertion, the General Court correctly applied Article 8(1)(b) of Regulation No 207/2009, as interpreted by the case-law of the Court of Justice cited in paragraph 43 of the present judgment, and did not consider that the visual and phonetic similarities were automatically neutralised by the conceptual differences.

28. The Court thus emphasised that there is no rule to the effect that visual and aural similarities are automatically neutralised by conceptual differences. It insisted upon the need for two distinct stages in the analysis of the overall likelihood of confusion, with the first being directed to '*a finding of the conceptual differences between the signs at issue*' and the second being directed to '*assessment of the degree of conceptual differences'* with a view to determining whether they '*may lead to the neutralisation of visual and phonetic similarities'*.

29. Even though one of the marks in issue refers to a clear and immediately apparent concept and the other does not have a clear meaning which can be immediately perceived by the relevant public, the degree of visual and aural similarity between them may still be sufficient to give rise to the existence of a likelihood of confusion. An example of this is provided by Case T-112/09 Icebreaker Ltd v OHIM EU:T:2010 361, where the General Court decided as follows:

> 41. ….the signs at issue are two English words. Although the word 'icebreaker' will be understood only by the part of the Italian public mastering the English language, that is not the case of the word 'iceberg', which is a common word with an immediately obvious meaning to the relevant public. It follows that the latter would perceive the earlier mark ICEBERG as having a clear meaning, whereas the mark applied for ICEBREAKER would be devoid of any clear meaning for that public.
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> 42. However, the marks at issue have the prefix 'ice' in common, which can be considered a basic English word, understandable for most of the relevant public. Since the prefix 'ice' has a certain evocative force, it must be regarded as limiting, in the present case, the conceptual difference between the marks at issue. Nor is it disputed by the applicant that the prefix 'ice' acts as a semantic bridge between the marks at issue.
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> 43. Consequently, the Board of Appeal was right to find that that the conceptual comparison was not decisive and did not affect the visual and phonetic similarities or differences between the conflicting signs.

More generally, the proposition that use of a meaningful word cannot conflict with the protection conferred by registration of an invented word only has to be stated in order to be rejected.

30. I have set out the Hearing Officer's assessment of '*conceptual meaning*' in paragraph 18 above. This was the first of the two stages identified in Wolf Oil. As I have noted in paragraph 19 above, she envisaged that even by consumers to whom

the mark **PINKIES** seemed to be alluding to the concept of fingers rather than colour, it would not necessarily or immediately be taken to be referring to pinkie rings if it was not being used with reference to rings specifically. Conversely she did not find that the mark **PINKIES** would be taken to be referring to pinkie rings either by consumers to whom it seemed to be alluding to the concept of colour rather than fingers or when it was being used in relation to goods of the kind listed in the contested application for registration other than rings.

31. At the second of the two stages identified in Wolf Oil, the Hearing Officer had to grapple with the question whether the *'meaning of PINKIES'* would serve to prevent the high degree of visual and aural similarity between the marks from giving rise to the existence of a likelihood of confusion across the full range of goods covered by the contested application for registration. Both as a consequence of there being no rule to the effect that visual and aural similarities are automatically neutralised by conceptual differences and as a consequence of there being no rule to the effect that use of a meaningful word cannot conflict with the protection conferred by registration of an invented word, a reasoned assessment was required as to why or how that would or would not be the case.

32. I have set out the Hearing Officer's overall assessment with regard to the likelihood of confusion in paragraph 12 above. On the basis that the *'conceptual differences'* between the marks **PIMKIE** and **PINKIES** *'are too great to be missed by the average consumer paying at least a reasonable degree of attention'*, she decided that the *'meaning of PINKIES will counteract the visual and aural similarities between them'*. However, I do not accept that her assessment to that effect went as far as it needed to go into the matters I have referred to in paragraph 31 above and I consider that the conclusion she arrived at was wrong for the reasons I will now explain.

33. It is firmly established (as noted in paragraph 17(h) of the Hearing Officer's decision) that in cases within the scope of s. 5(2)(b) of the Act there is a greater

likelihood of confusion where the earlier mark has a highly distinctive character, either *per se* or because of the use which has been made of it. That applies here. The trade mark **PIMKIE** is (and the Hearing Officer rightly affirmed that it was) possessed of a high degree of inherent distinctiveness. Moreover, the marks **PIMKIE** and **PINKIES** are visually and aurally similar to a degree which would easily enable them to become tangled up with one another in the perceptions and recollections of consumers exposed to concurrent use of them for Class 14 goods of the kind listed in the earlier registration and the contested application for registration.

34. To envisage that there would nevertheless be no mingling of identities in the overall impression conveyed by the marks is to suppose that the visual and aural similarities between them would be subject to the neutralising effect of a contradistinction based on the absence of meaning in the case of **PIMKIE** and the presence of meaning in the case of **PINKIES**. However, an assessment of overall impression should (as noted in paragraphs 17(b) to (d) of the Hearing Officer's decision) proceed on the basis that consumers normally perceive a mark as a whole without engaging in analysis of its details and must, in situations where they do not have the opportunity to make direct comparisons, rely on the imperfect recollection of it which they have kept in mind. Those considerations apply here.

35. It can be expected in the context of the Hearing Officer's assessment of the purchasing process for the goods concerned (set out in paragraph 10 above) that the relevant consumers would do as consumers ordinarily do: take the marks **PIMKIE** and **PINKIES** as they find them, without pausing to analyse or compare them generally or with reference to the presence or absence of meaning in either case. I see no reason to expect them to think their way through the high degree of visual and aural similarity between the marks by a process of contradistinguishing between the former as a word which has no conceptual connotations of its own and the latter as a word linked to the concept of fingers or colour. That, in my view, is a thought process which involves examination by way of trade mark analysis and comparison

of a kind they would not naturally undertake on exposure to marks with this degree of similarity. I consider that the Hearing Officer's observation to the effect that the *'conceptual differences'* between **PIMKIE** and **PINKIES** are *'too great to be missed'* is the product of just such an examination.

36. The Applicants have repeatedly emphasised that **PINKIES** can be regarded as descriptive when used in relation to 'pinky' / 'pinkie' rings within the coverage of their application for registration. I can see that the non-distinctiveness of **PINKIES** may, in relation to such rings, provide them with a defence to a claim for infringement of the rights conferred by registration of the trade mark **PIMKIE** in accordance with s.11(2)(b) of the 1994 Act (as amended) (and see, to the same effect, Articles 14(1)(b) and (2) of the Recast Trade Marks Directive (Directive (EU) 2015/2436) and Articles 14(1)(b) and (2) of the EU Trade Mark Regulation (Regulation (EU) 2017/1001)) on the basis that: *'A registered trade mark is not infringed by - ... (b) the use of signs or indications which are not distinctive ... provided that the use is in accordance with honest practices in industrial or commercial matters'*. However, their circumscribed ability to defend the use of **PINKIES** from attack in such circumstances cannot be elevated to the status of a reason for regarding it as eligible for registration as a trade mark, either generally or notwithstanding the Opponent's objection to the contested application for registration.

37. For the reasons I have given, the Appeal succeeds and the Hearing Officer's decision (including as to costs) is set aside. Opposition No. 411232 to Trade Mark Application No. 3264928 is remitted to the Registry for further processing in accordance with this decision and the provisions of the Trade Marks Act 1994 and the Trade Marks Rules 2008.

38. I approach the question of costs in the manner indicated in paragraphs [12] to [14] of my decision in AMARO GAYO Trade Mark BL O/257/18 (25 April 2018). Having regard to what I consider to be the amount of effort and expenditure that is

likely to have been reasonably and productively incurred in pursuit of the Opposition, I think it would be reasonable to order the Applicants to pay £750. to the Opponent in respect of its costs of the proceedings in the Registry and on appeal. That sum is to be paid within 21 days of the date of this decision.

Geoffrey Hobbs QC

25 September 2019

Mr Andrew Marsden of Wilson Gunn appeared on behalf of the Opponent.

Mr Dean Moore provided written submissions for the assistance of the Applicants.