

O-0371-24

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION UK00003815402 BY
ALBIDAA SWORD & GIFTS LCC REGISTER:**



AS A TRADE MARK IN CLASSES 14, 25 AND 35

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 437128
BY GIORGIO ARMANI S.P.A.**

Background & Pleadings

1. On 1 August 2022, ALBIDAA SWORD & Gifts LCC (“the applicant”) applied to register the above trade mark in the United Kingdom for the following goods and services:

Class 14: Precious metals and their alloys; precious and semi-precious stones; horological and chronometric instruments.

Class 25: Clothing; footwear; headgear.

Class 35: Retail, wholesale and online retail and wholesale services in connection with watches, gifts, clothing, footwear and headgear.

The application was published for opposition purposes on 9 September 2022.

2. On 26 October 2022, GIORGIO ARMANI S.P.A. (“the opponent”) opposed the application, in its entirety, under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). For the purpose of the opposition, the opponent relies upon the following trade mark and all goods for which it is registered, as set out below:

International Registration (“IR”) 1566240



The registration holds a filing date of 30 September 2020 and protection was conferred from 20 April 2021.

Class 18: Handbags; traveling bags; briefcases; leather briefcases; leather credit card holders; wallets; leather document briefcases; key-cases of leather and skins;

purses; suit cases; cosmetic bags sold empty; gym bags; evening and shoulder bags for ladies; leather shopping bags; school bags; garment bags for travel; suit carriers for travel; shoe bags for travel; beach bags; diaper bags; backpacks; Boston bags; traveling trunks; duffel bags; overnight bags; carry-on bags; satchels; opera bags; vanity cases (not fitted); hides; cases and boxes made of leather; bags made of leather for packaging; leather straps; umbrellas; leather leashes; saddlery.

Class 25: Coats; jackets; trousers; skirts; tops; raincoats; overcoats; belts; braces for clothing; suits; stuff jackets; jumpers; jeans; dresses; cloaks; parkas; shirts; T-shirts; sweaters; underwear; baby-dolls being nightwear; bathrobes; bathing costumes; negligee; swim suits; dressing gowns; shawls; neckerchiefs; scarves; ties; neckties; sweat shirts; under shirts; polo shirts; body suits; shorts; combinations [clothing]; wedding dresses; stockings; socks; shoes; slippers; overshoes; galoshes; wooden clog; soles for footwear; footwear upper; boots; ski boots; snow boots; half boots; esparto shoes or sandals; sandals; bath sandals; gloves; mittens; hats and caps; visors (headwear).

3. In its Notice of Opposition, the opponent contends that the parties' trade marks are highly similar and that the respective goods and services are either identical, highly similar or complementary, such that there exists a likelihood of confusion, including a likelihood of association, on the part of the relevant public.

4. In its counterstatement, the applicant denies that the marks are similar and, though it makes a concession regarding the similarity of some of the parties' goods, it nonetheless denies that there is a likelihood of confusion, including a likelihood of association.

5. The opponent is represented by Haseltine Lake Kempner LLP and the applicant by Beck Greener LLP. Only the opponent filed evidence during the course of the proceedings. Neither party requested a hearing, though both elected to file written submissions in lieu. This decision is taken following a careful perusal of the papers.

6. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the

European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

The opponent's evidence

7. The opponent's evidence comprises a witness statement dated 26 May 2023 from Mr Antonio Croce, the opponent's intellectual property manager since 2014, and twelve supporting exhibits. I do not propose to summarise the evidence in any great detail, but instead provide a brief overview below:

The opponent's company was founded in 1975 and retails in haute couture, clothing, leather goods, shoes, watches, cosmetics and jewellery.

Screenshots of pages from the opponent's websites and those of third party retailers show items such as clothing, bags, shoes, jewellery and watches categorised as 'gifts' for retail purposes. Mr Croce admits that the screenshots were captured in 2023 but submits that they are "representative of the way in which gift options have been presented to the public for some time."

Gift guides featuring in publications such as Harpers Bazaar and The Guardian, with dates ranging from 2014 to 2023, feature goods including clothing, accessories, shoes and jewellery.

Consumers can access articles, websites and various other platforms including Pinterest and Instagram to help them collate a complete outfit inclusive of clothing, shoes and accessories.

A number of retailers offer clothing and accessories (such as watches) simultaneously. An article dated 3 August 2022 refers to a survey conducted on the general public by Luxe Watches which revealed that fashion was the second most popular reason for wearing a watch and that 40% of women and 60% of men "valued the fashion aspect of watches".

Decision

8. Section 5(2)(b) of the Act reads 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,

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

9. Section 5A reads:

“Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

10. Under the provisions laid out in section 6 of the Act, the opponent’s trade mark clearly qualifies as an earlier mark. In accordance with section 6A of the Act, as it had not completed its registration procedure more than five years prior to the filing date of the applicant’s mark, it is not subject to the proof of use requirements. Consequently, the opponent can rely upon its mark and all goods for which it is registered without providing evidence of use.

Section 5(2)(b) - Case law

11. 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) (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 greater 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 and services

12. The goods and services to be compared are laid out at paragraphs 1 and 2 to this decision.

13. When considering the similarity or identity of the respective goods and services, I keep in mind the provision for identity set out in *Gérard Meric v OHIM*¹, which reads as follows:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

14. Applying this reasoning, I find the applicant’s *clothing* identical to a number of terms in the earlier specification; *trousers*, *dresses* or *sweaters*, for example. I further find the applicant’s *footwear* identical to the opponent’s *shoes* or *snow boots*, for example. Finally, I find the applicant’s *headgear* identical to the opponent’s *hats and caps* or *visors (headgear)*, for example. These goods are to be deemed identical.

¹ Case T-133/05

15. As for my comparison of the remaining terms in the applicant's specification, I keep in mind the factors for assessing similarity laid out by Jacob J. (as he then was) in the *Treat*² case, which were as follows:

- (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.

16. In *Kurt Hesse v OHIM*³, the Court of Justice of the European Union ("CJEU") stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*⁴, the General Court ("GC") 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".

² R.P.C. 281 [1996]

³ Case C-50/15 P

⁴ Case T-325/06

Class 14

Precious metals and their alloys; precious and semi-precious stones; horological and chronometric instruments

17. The above will encompass goods such as jewellery and watches, respectively. In its consideration of the aforementioned terms, the opponent submits as follows:

“The question of the similarity of jewellery items, precious stones and metals and horological and chronometric instruments, in particular watches, to clothing and fashion accessories generally has been the subject of a number of past decisions... However... it is clear the gap between the two sets of goods in the marketplace is becoming narrower...

...Consumers are used to and have become educated to consider these items are sold directly side by side with each other. They are aware that it is common, or at least not unusual, for the different categories of goods to derive from the same trade origin and be sold via the same distribution channels. Further, the evidence shows that they also clearly share the same relevant public.”⁵

18. In that regard, I find it useful to highlight the decision of the GC in two cases, as follows. Firstly, in *Oakley Inc. v OHIM*⁶, the GC stated that:

“86. The intervener’s argument that eyewear, jewellery and watches could be similar or complementary to items of clothing cannot succeed, since, as correctly pointed out by OHIM, the relationship between those goods is too indirect to be regarded as conclusive. It must be borne in mind that the search for a certain aesthetic harmony in clothing is a common feature in the entire fashion and clothing sector and is too general a factor to justify, by itself, a finding that all the goods concerned are complementary and, thus, similar.”

⁵ See the opponent’s written submissions filed in lieu of a hearing

⁶ Case T-116/06

19. Later, in *Compagnie des montres Longines, Francillon SA v OHIM*⁷, the GC rejected the argument that sunglasses, jewellery and watches were similar to clothing. The court stated that:

“46 In that regard, it must be stated at the outset that the goods which have to be compared in the present case, namely, on the one hand, the ‘optical sunglasses’ and ‘clothing and footwear’ in, respectively, Classes 9 and 25 of the Nice Agreement and, secondly, the various horological and jewellery goods, listed in paragraph 6 above, in Class 14 of that agreement, belong to adjacent market segments.

47 It may also be stated, by analogy with what the Court held in the context of an assessment relating to Article 8(5) of Regulation No 207/2009 in the case which gave rise to the judgment of 27 September 2012 in *El Corte Inglés v OHIM — Pucci International (Emidio Tucci)*, T-373/09, EU:T:2012:500, paragraph 66, that, even though those categories of goods are different, each of them includes goods which are often sold as luxury goods under the famous trade marks of renowned designers and manufacturers. That fact shows that there is a certain proximity between the goods at issue, in particular in the luxury goods sector.

48 Likewise, the Court held, still in the context of an assessment relating to the provision referred to in paragraph 47 above, in paragraph 79 of its judgment of 27 September 2012 in *Pucci International v OHIM — El Corte Inglés (Emidio Tucci)*, T-357/09, EU:T:2012:499, that, in the luxury items sector, goods like glasses, jewellery and watches are also sold under the famous trade marks of renowned designers and manufacturers and that clothing manufacturers are therefore turning towards the market for those goods. The Court deduced from that there was a certain proximity between the goods at issue.

49 However, notwithstanding the fact that the goods covered by the trade mark application and those protected by the earlier mark, which are referred to in paragraph 46 above, belong to adjacent market segments, it must, in the first

⁷ Case T-505/12

place, be held that the Board of Appeal did not err in stating that they differed in their nature, their intended purpose and their method of use.

50 First, the raw materials from which they are manufactured are different, except for some similarities between certain materials which may be used both in the manufacture of optical sunglasses and for certain horological goods or jewellery, such as glass.

51 Secondly, clothing and footwear in Class 25 are manufactured to cover, conceal, protect and adorn the human body. Optical sunglasses are above all produced to make it easier to see, to provide users with a feeling of comfort in certain meteorological conditions and, in particular, to protect their eyes from rays of sunlight. Watches and other horological goods are designed, inter alia, to measure and indicate the time. Lastly, jewellery has a purely ornamental function (see, to that effect, judgment in *nollie*, cited in paragraph 41 above, EU:T:2010:114, paragraph 33 and the case-law cited).

52 In the second place, it must be pointed out that as the nature, intended purpose and method of use of the goods at issue are different, they are neither in competition with each other nor interchangeable.

53 The applicant has not shown that it is typical, notwithstanding the abovementioned differences, for a consumer who, for example, intends to buy himself a new watch or some jewellery, to decide, suddenly, to buy himself, on the contrary, clothing, footwear or optical sunglasses, and vice versa.

54 In that regard, in particular, it must also be stated that the applicant has not proved its claim that, in the luxury and fashion sector, it is generally the trade mark and its prestige among consumers that motivate the consumer's decision to purchase a specific item and not the actual necessity to purchase that item, inter alia for its functionalities and to fulfil a very specific need. Likewise, it is necessary to reject as not proved the applicant's claim that, as the appearance and value of the goods prevail over other factors relating to their nature, consumers in the sector concerned are principally in search not of specific goods,

but of satisfaction for their 'hedonistic needs' or that they seek the instant gratification generated by an impulse purchase.

55 Moreover, it must be stated that to accept that such claims are well-founded would be tantamount, in essence, to rendering irrelevant any differentiation between goods which belong to the luxury sector and are protected by the respective marks, since the applicant's theory relating to the impulse purchase aimed at the instant gratification of consumers leads to the conclusion that a likelihood of confusion may actually exist irrespective of the goods concerned, on the sole condition that they all fall within that sector. Such an approach, by which the applicant in actual fact alleges that all the goods at issue are interchangeable, is manifestly contrary to the principle of speciality of marks which the Court must take into account in its analysis in accordance with Article 8(1)(b) of Regulation No 207/2009 and would improperly extend the area of protection of trade marks. For the same reasons, it is necessary to reject as irrelevant the applicant's claim that the goods are interchangeable inasmuch as each of them may be given as a gift and the consumer impulsively chooses one or other of them. To accept such a vague connection would lead to holding that goods which are manifestly different in their nature and intended purpose are similar.

56 What is more, it must be stated that the relevant market within which the abovementioned goods fall cannot be limited to the 'luxury' or 'haute couture' market segment alone and that specific significance cannot, in addition, be attributed to that market segment in the present case, since the categories of goods protected by the marks at issue are defined in a manner which is sufficiently broad to include both 'consumer' goods falling within a generally affordable price range and certain 'inexpensive' goods. The applicant has not claimed, in relation to the 'basic' goods falling within those market segments, that they are also purchased by consumers acting in an impulsive and hedonistic manner, with the result that those consumers may indiscriminately replace some goods with others.

57 In the third place, it must be pointed out that, by its other arguments, the applicant attempts, in essence, to establish a complementary connection between the goods at issue.

58 It must be borne in mind that, in accordance with the case-law, complementary goods or services are those which are closely connected in the sense that one is indispensable or important for the use of the other in such a way that consumers may think that the same undertaking is responsible for manufacturing those goods or for providing those services. By definition, goods intended for different publics cannot be complementary (see, to that effect, judgment in *Emidio Tucci*, cited in paragraph 48 above, EU:T:2012:499, paragraph 50 and the case-law cited).

59 Furthermore, according to the case-law, aesthetic complementarity between goods may give rise to a degree of similarity for the purposes of Article 8(1)(b) of Regulation No 207/2009. Such aesthetic complementarity must involve a genuine aesthetic necessity, in the sense that one product is indispensable or important for the use of the other and consumers consider it ordinary and natural to use those products together. That aesthetic complementarity is subjective and is determined by the habits and preferences of consumers, to which producers' marketing strategies or even simple fashion trends may give rise (see judgment in *Emidio Tucci*, cited in paragraph 48 above, EU:T:2012:499, paragraph 51 and the case-law cited).

60 However, it is important to point out that the mere existence of aesthetic complementarity between the goods is not sufficient to conclude that there is a similarity between them. For that, the consumers must consider it usual that the goods are sold under the same trade mark, which normally implies that a large number of the producers or distributors of the goods are the same (see judgment in *Emidio Tucci*, cited in paragraph 48 above, EU:T:2012:499, paragraph 52 and the case-law cited)."

20. Of course I acknowledge that these cases are not precisely on all fours with the present proceedings but I find much of the reasoning relevant to the assessment

before me. Whilst I accept that, similarly to the opponent's class 25 goods, the applicant's goods in class 14 can be worn on the body and sometimes selected for aesthetic purposes, there is nonetheless a distinction in their respective uses. The users are likely to be shared but the physical nature of the goods is likely to differ significantly. As for the goods' trade channels, as shown in the opponent's evidence, there may be some crossover in the way the goods reach the market and the retail establishments they are sold in, though they are, in my experience, unlikely to be positioned in any real degree of vicinity. The goods are not competitive; the consumer will require one or the other and, whilst I acknowledge that the parties' goods can be worn alongside each other to create a complete outfit comprising both clothing and accessories, I do not consider the goods complementary to the extent that they are indispensable, or even important, for one another. In other words, notwithstanding the examples the opponent has exhibited, I do not find the goods complementary in a trade mark sense. Weighing the cited case law with my own view on the matter, I find the goods dissimilar. For completeness, I do not consider that any of the opponent's other goods (namely, those in Class 18) improve its position.

Class 35

21. Before making an assessment of similarity in relation to the applicant's class 35 services, I take note of the proposed limitation made out in its written submissions filed in lieu of a hearing. At paragraph 7, it submits as follows:

"If against the Applicant's expectation, the Tribunal were to find that the marks at issue are similar for the purposes of s.5(2)(b), the Applicant proposes an alternative class 35 specification for the Tribunal's consideration as shown below, limiting the term "retail, wholesale and online retail and wholesale services in connection with gifts."

Class 35

*Retail, wholesale and online retail and wholesale services in connection with watches; retail, **wholesale and online retail and wholesale services in connection with gifts, namely fragrances, watches & jewellery, watch***

boxes & jewellery boxes, eyewear, tableware, cookware and containers, swords & knives; retail, wholesale and online retail and wholesale services in connection with clothing, footwear and headgear." (applicant's emphasis)

I intend to consider the above submission only if it appears necessary.

Retail, wholesale and online retail and wholesale services in connection with clothing, footwear and headgear.

22. As already established, the opponent relies on a number of goods falling within the remit of *clothing, footwear and headgear*. In *Tony Van Gulck v Wasabi Frog Ltd*⁸, Mr Geoffrey Hobbs Q.C., as the Appointed Person, reviewed the law concerning retail services v goods. 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 **MissBoo** for the Listed Services is considerably more complex. 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."

23. However, on the basis of the European courts' judgments in *Sanco SA v OHIM*⁹, and *Assembled Investments (Proprietary) Ltd v. OHIM*¹⁰, at paragraphs [30] to [35] of

⁸ Case BL O/391/14

⁹ Case C-411/13P

¹⁰ Case T-105/05

the judgment, upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd*¹¹, 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 (or vice versa), 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;

iv) The General Court's findings in *Oakley* did not mean 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).

24. In *Tulliallan Burlington Ltd v EUIPO*¹², the CJEU considered the correct approach to determining the appropriate scope of protection afforded to trade marks that were registered for retail services prior to the court's judgment in *Praktiker*¹³. This judgment required applicant's to register trade marks for such services to specify the goods to which the services relate. The GC had decided that, absent such a list of goods, it was not possible to compare retail services-type registrations with later applications to register trade marks in relation to particular goods. The applicant appealed. The CJEU upheld the appeal ruling that:

¹¹ Case C-398/07P

¹² Cases C-155/18P to C-158/18P

¹³ Case C-418/02

“132. In that regard, admittedly, the Court of Justice has held that, for the purposes of registration of a trade mark covering services provided in connection with retail trade, it is not necessary to specify in detail the service or services for which that registration is sought, but that, on the other hand, the applicant must be required to specify the goods or types of goods to which those services relate (judgment in *Praktiker*, paragraphs 49 and 50).

133. However, first, the Court has made clear that the line of authority derived from the judgment in *Praktiker* concerns only applications for registration as trade marks and does not concern the protection of trade marks registered at the date of that judgment’s delivery (judgment of 11 October 2017, *EUIPO v Cactus*, C-501/15 P, EU:C:2017:750, paragraph 45). Since in the present case Tulliallan Burlington’s three earlier United Kingdom trade marks, which Tulliallan Burlington relied on in support of its opposition, were registered before the date on which the judgment in *Praktiker* was delivered, they were not, in any event, concerned by the obligation arising from that judgment.

134. Secondly, it cannot be inferred from the considerations in the judgment in *Praktiker* mentioned in paragraph 132 of the present judgment that, when a trade mark covering retail services, registered after that judgment’s delivery, is relied on in support of the ground of opposition referred to in Article 8(1)(b) of Regulation No 207/2009, that ground of opposition may be rejected from the outset, simply by invoking the absence of any precise statement of the goods to which the retail services covered by the earlier trade mark may relate.

135. To act in such a manner would mean that the earlier trade mark is precluded from being relied upon in opposition in order to prevent the registration of an identical or similar mark in respect of similar goods or services and, consequently, refuse to recognise it as having any distinctive character, even though that mark is still registered and it has not been declared invalid on one of the grounds laid down in Regulation No 207/2009.

136. In addition, as EUIPO in essence notes, it is possible, by means of a request seeking proof of genuine use of the earlier trade mark, within the

meaning of Article 42(2) of Regulation No 207/2009, to determine the precise goods covered by the services for which the earlier trade mark was used and, therefore, pursuant to the last sentence of that paragraph, to take into account, for the purposes of the examination of the opposition, only those goods.

137. Accordingly, it is apparent from all the foregoing considerations that, in finding, in paragraph 71 of the judgments under appeal, that the absence of any precise statement of the goods which may be sold in the various shops comprising a shopping arcade, such as the shopping arcade referred to by the earlier trade marks, precluded any association between those shops and the goods of the mark applied for, the General Court erred in law.”

25. The above services concern the retail or wholesale of goods which are deemed identical to those relied upon by the opponent. There is likely to be some similarity in the use and users of the respective goods and services, although the nature is different. The goods and services are not necessarily competitive, though the end goods are the same and there could be an element of complementarity. I find a medium degree of similarity.

Retail, wholesale and online retail and wholesale services in connection with watches

26. The above services are similar in nature to those considered in my previous paragraph, but the end goods in the above term are not identical to goods relied upon by the opponent. In fact, I have found the applied for *horological instruments* dissimilar to the goods relied upon by the opponent which creates some distinction between the respective comparisons. There may be some coincidence in the respective users but this seems to be the extent of any opportunity for meaningful similarity. The uses are distinct and I do not consider there to be any competition or complementarity. Applying due weight to the relevant factors, I find these services dissimilar to the goods relied upon by the opponent.

Retail, wholesale and online retail and wholesale services in connection with gifts

27. I agree with the opponent's submission regarding the term 'gifts', insofar as it submits that "the term 'gifts' is not limited to certain classes or categories of goods. The definition of 'gifts' can therefore cover a broad range of goods in this context." It directs me to its exhibits which show goods such as shirts, scarves, shoes etc falling under the heading of 'gifts' on various websites and included in several published 'gift guides'. This approach marries with my own experience and I agree that it would not be unusual for goods such as those relied upon by the opponent in class 25 to be considered suitable gifting items. With that in mind, in light of my findings at paragraph 14, I find there to be a degree of similarity.

28. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

"49. ...I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity."

As some similarity is essential to engage a likelihood of confusion, the opposition fails at this juncture in respect of the goods and services where I have found no similarity.

The average consumer and the nature of the purchasing act

29. 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*, Case C-342/97. 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. (as he then was) 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.”

30. In *New Look Limited v OHIM*¹⁴, the GC stated that:

“49. However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

And

“50. ...Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase.

¹⁴ Joined cases T-117/03 to T-119/03 and T-171/03

Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

31. The average consumer of the goods and services which remain at issue is likely to be a member of the general public. The goods are typically purchased by process of self selection from the aisles of the relevant retail outlet or online equivalent, with the services engaged with on a similar basis. The goods and services are both generally advertised or promoted through visual means such as entries in catalogues or online posts, for example. That said, I do not overlook the relevance of the marks’ aural impression as advice could be offered by salespeople, for example. When approaching its selection of the relevant goods, the consumer is likely to be alive to a number of considerations such as quality, compatibility and sustainability. As for the services, the consumer is also likely to keep in mind the reputation or reliability of the provider. To my knowledge, the goods and services are engaged with fairly frequently and, though the price of the goods (or end goods) can vary fairly widely, the cost is not generally of a high degree. Weighing all factors, I find the average consumer will typically apply a medium degree of attention to its selection of the goods and/or services.



Comparison of trade marks

32. 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 them, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*, Case C-591/12P, that:

“34. ...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.”

33. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create.

34. The trade marks to be compared are displayed in the table below:

Opponent's mark	Applicant's mark
	

35. The opponent's earlier mark comprises a figurative depiction of a single digit. Its overall impression therefore lies solely in that digit.

36. The overall impression of the applicant's mark resides solely in the single digit it is comprised of.

37. Visually, the marks are both, in my view, evocative of an upper case letter A, though in both parties' marks there is some obscurity. In the opponent's mark, the line at the left of the letter, where it begins, is the thickest. The adjoining line on the right hand side is notably narrower and roughly half of it has been omitted. The horizontal line which typically sits in between is also missing. In the applicant's mark it is the line on the right hand side which is the thickest. The line on the left hand side is partially omitted and, though there is some small indication of the adjoining horizontal line, it is mostly absent. The opponent's mark is presented in black and the applicant's in a pale grey, though I attribute little weight to that difference. The typeface adopted in each

mark appears very similar, though fairly unremarkable. Weighing all considerations, I find the marks visually similar to a fairly high degree.

38. As indicated above, I find it likely that both marks will be identified as a depiction of the letter 'A'. It seems reasonable, therefore, to expect that the average consumer will attempt to articulate each mark as such. The marks will be articulated identically in one syllable; AY.

39. Given that both marks are likely to be identified as a partially obstructed portrayal of the single English letter 'A', in upper case, the marks' conceptual position is identical. Each mark will be interpreted conceptually as a depiction of an ordinary alphabetical letter.

Distinctive character of the earlier trade mark

40. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested

by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

41. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the goods or services for which they are registered, to those with high inherent distinctive character, such as invented words. Dictionary words which do not allude to the goods or services will typically fall somewhere in the middle. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; generally, the more distinctive the earlier mark, the greater the likelihood of confusion. The distinctive character of a mark may be enhanced as a result of it having been used in the market.

42. The opponent has not made a pleading of enhanced distinctiveness, nor does its evidence support such a finding. Consequently, I have only the mark’s inherent position to consider. The opponent’s mark comprises a somewhat distorted depiction of the letter A. To my knowledge, the letter has no descriptive or allusive qualities when considered in respect of the relied upon goods. Whilst the mark’s distortion certainly contributes to its distinctiveness, it nonetheless comprises an ordinary dictionary letter and the presentation is not particularly elaborate. On balance, I find the mark inherently distinctive to a medium degree.

Likelihood of confusion

43. 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 services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent’s trade mark, as the more distinctive it is, the greater the likelihood of confusion.

44. To make the assessment, I must adopt the global approach advocated by the case law whilst taking account of my earlier conclusions. I also bear in mind that the average consumer rarely has the chance to make direct comparisons between trade marks and, instead, must rely upon the imperfect picture of them retained in its mind.

45. In *Kurt Geiger v A-List Corporate Limited*¹⁵, 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.”

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.

46. Confusion can be direct or indirect. I take note of the comments made by Mr Iain Purvis Q.C., as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*¹⁶, where he explained that:

¹⁵ BL O-075-13

¹⁶ BL O/375/10

“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.””

47. I have found the parties’ marks visually similar to a fairly high degree and aurally and conceptually identical. I have further found the inherent distinctiveness of the earlier mark to be of a medium degree. The respective goods and services are either identical or similar to a medium degree. The average consumer is likely to apply a medium degree of attention when making its selection of the relevant goods and services. To my mind, particularly as the consumer is not applying a high degree of attention, and notwithstanding the differences between the parties’ marks, they are sufficiently similar and their likeness is as such that the average consumer would erroneously mistake one for the other. Both marks would leave an identical impression on the average consumer; that of an upper-case letter A with part of it having been omitted. Consequently, it seems likely that the average consumer would mistake the marks wherever there is a similarity, even of a low degree, between the respective specifications, engaging the effects of the interdependency principle. In other words, wherever the goods and services are similar, I find it likely that direct confusion would occur.

48. At paragraph 21, I noted the applicant’s proposed limitation to the term *retail, wholesale and online retail and wholesale services in connection with gifts* in class 35, which I have found similar (to a degree) to the relied upon goods on the basis of the broad nature of the term ‘gifts’. Consequently, I move now to consider the proposed term.

Wholesale and online retail and wholesale services in connection with gifts, namely fragrances, watches & jewellery, watch boxes & jewellery boxes, eyewear, tableware, cookware and containers, swords & knives

49. In my view, the services captured by the above term, in which the opponent highlights specifically what the 'gifts' it refers to are, concerns end goods which I consider dissimilar to the opponent's. There is a distinction in use, nature and I do not find the applied-for service competitive nor complementary when considered against the opponent's goods. Other than a broad opportunity for crossover in respective users, to which I attribute little weight, I see no tangible similarity.

Conclusion

50. The opposition has succeeded, in part. Subject to any successful appeal, the application will be refused registration for:

Class 25: Clothing; footwear; headgear.

Class 35: Retail, wholesale and online retail and wholesale services in connection with clothing, footwear and headgear; retail, wholesale and online retail and wholesale services in connection with gifts.

51. In respect of the goods and services where I have found no similarity, the opposition has failed. Subject to any successful appeal, the application will proceed to registration for:

Class 14: Precious metals and their alloys; precious and semi-precious stones; horological and chronometric instruments.

Class 35: Retail, wholesale, and online retail and wholesale services in connection with watches; retail, wholesale and online retail and wholesale services in connection with gifts, namely fragrances, watches & jewellery, watch boxes & jewellery boxes, eyewear, tableware, cookware and containers, swords & knives.

Costs

52. Both parties have achieved a measure of success. In the circumstances, I direct that each party bears its own costs.

Dated this 26th day of April 2024

**Laura Stephens
For the Registrar**