O/0555/25

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF INTERNATIONAL REGISTRATION NUMBER

WO0000001626485

BY ARTERNATIVE

TO REGISTER THE FOLLOWING TRADE MARK:

arte

IN CLASSES 14, 18, 25 AND 35

AND

IN THE MATTER OF INTERNATIONAL REGISTRATION NUMBER

WO0000001626483

BY ARTERNATIVE

TO REGISTER THE TRADE MARK:

ARTE

IN CLASSES 14, 18, 25 AND 35

AND OPPOSITION THERETO UNDER NUMBERS

OP000443001 AND OP000443002

BY SCHWEIZER KAPITAL HOLDING AG

BACKGROUND AND PLEADINGS

1. ARTERNATIVE ("the holder") is the holder of the international registrations ("the IRs") shown on the cover page of this decision ("the contested marks"), No. WO0000001626483 ("the '483 mark") and No. WO0000001626485 ("the '485 mark"). The IRs were registered on 25 September 2021. On 23 February 2023, the holder designated the UK as a territory in which it seeks to protect the IRs under the terms of the Protocol of the Madrid Agreement.

2. The holder seeks protection of the IRs in relation to the following goods and services:

Class 14	Chains [jewellery]; rings [jewellery]; earrings; bracelets; chronoscopes; cases [fitted] for jewels; key rings [split rings with trinket or decorative fob].
Class 18	Leather and imitations of leather; animal skins; travel cases; suitcases; umbrellas; handbags; trunks and suitcases; bags; pocket wallets; rucksacks; bags for sports; all-purpose athletic bags; bags for sports clothing.
Class 25	Clothing; footwear; headgear; sportswear.
Class 35	Retail services in relation to clothing; retail services in relation to headgear; retail services in relation to footwear; retail services in relation to jewellery.

3. The IRs were published for opposition purposes on 16 June 2023.

4. SCHWEIZER KAPITAL HOLDING AG ("the opponent") opposes all the goods and services contained within the IRs, on the basis of section 5(2)(b) of the Trade Marks Act 1994 ("the Act").

5. The opponent relies upon the three earlier rights detailed below:

(“the ‘169 mark”)

WO0000001450169

International registration date:

12 October 2018

Designation date:

12 October 2018

Date of protection of the international registration in the UK:

7 February 2020

Priority date:

8 June 2018

Priority country:

Switzerland

TM from which priority claimed:

74437/2018

ARTEL

(“the ‘524 mark”)

WO0000001543524

International registration date:

27 May 2020

Designation date:

27 May 2020

Date of protection of the international registration in the UK:

24 January 2022

Priority date:

6 December 2019

Priority country:

Switzerland

TM from which priority claimed:

740395

ARTEL

("the '371 mark")

WO0000001574371

International registration date:

26 November 2020

Designation date:

26 November 2020

Date of protection of the international registration in the UK:

24 January 2022

Priority date:

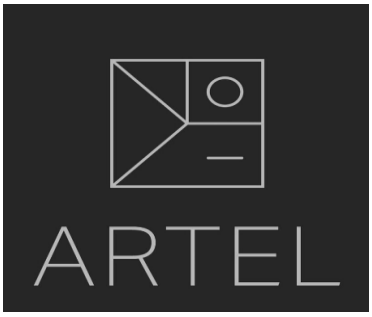
9 July 2020

Priority country:

Switzerland

TM from which priority claimed:

750077



6. For the purpose of these proceedings, the opponent is reliant upon all of the goods and services for which the earlier marks are registered:

("the '169 mark")

Class 6	Common metals and their alloys; statues and works of art of common metals; transportable buildings of metal; small items of metal hardware.

Class 14	Precious metals and their alloys; jewelry, precious and semi-precious stones; timepieces and chronometric instruments; statues, figures and works of art of precious metals or semi-precious metals or stones or imitations of precious metals; decorative boxes made of precious metal; decorative works of art of precious metals.
Class 16	Paper and cardboard; printing products (printed matter); figures and works of art of paper and cardboard; lithographic works of art; photographs [printed]; stationery and office requisites, excluding furniture; drawing material and material for artists; sheets, films and bags of plastic materials for wrapping and packaging; printing type, printing blocks.
Class 41	Education; training; entertainment services; sporting and cultural activities.
Class 43	Services for providing food and beverages; temporary accommodation.

("the '524 mark" and "the '371 mark)

7. The specifications for these marks are essentially the same, the only differences being that the '524 mark specification says "decorations for Christmas trees", whereas the '371 mark specification says "Christmas trees decorations" and the '524 mark says "security services for the protection of property and individuals", whereas the '371 mark says "security services for protection of property and individuals".

Class 3	Non-medicated toiletry preparations and cosmetic products; non-medicated dentifrices; perfumery products, essential oils.
Class 25	Clothing, footwear, headwear.

Class 28	Games, toys; video game apparatus; gymnastic and sporting articles; decorations for Christmas trees/Christmas trees decorations.
Class 29	Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs; milk, cheese, butter, yogurt and other dairy products; edible oils and fats.
Class 30	Coffee, tea, cocoa and coffee substitutes; rice, pasta and noodles; tapioca and sago; flour and preparations made from cereals; bread, pastry and confectionery products; chocolate; ice cream, sherbets and other edible ices; sugar, honey, golden syrup; yeast, baking powder; salt, seasonings, spices, preserved herbs; vinegar, sauces and other condiments; ice for refreshment.
Class 31	Unprocessed and non-transformed agricultural, aquacultural, horticultural and forestry products; unprocessed and raw grains and seeds; fresh fruits and vegetables, fresh aromatic herbs; natural plants and flowers; bulbs, seedlings and seeds; live animals; food products and beverages for animals; malt.
Class 32	Beers; non-alcoholic beverages; mineral and aerated waters; fruit beverages and fruit juices; syrups and other preparations without alcohol for making beverages.
Class 33	Alcoholic beverages except beers; alcoholic preparations for making beverages.
Class 45	Legal administration of licenses; management and licensing of industrial property rights and copyright (legal services); management and exploitation of copyright and industrial property rights by licensing for third parties (legal services);

licensing services relating to the manufacture of goods (legal services); intellectual property licensing; licensing of databases (legal services); granting licenses for franchising concepts (legal services); licensing of rights relating to the use of photographs (legal services); consultancy services relating to copyright licensing; services provided by consultants relating to trademark licensing; services provided by consultants relating to intellectual property licensing; legal services; security services for the protection of property and individuals/security services for protection of property and individuals; mediation; clothing rental.

8. Under section 5(2)(b), the opponent claims in its two separate Form TM7s and accompanying statements of grounds, that the applications are visually and aurally highly similar to the opponent's earlier marks and that the goods in classes 14, 18, 25 and 35 are identical and/or similar to the goods covered by the earlier marks. As a result, the opponent claims that there exists a likelihood of confusion on the part of the public, which includes a likelihood of association.

9. The holder filed two separate Form TM8s and counterstatements denying that the mark applied for was similar and that the marks have clear visual and phonetic differences and have no conceptual similarity. The holder puts the opponent to proof that any of the goods and services applied for in classes 14, 18, 25 and 35 are similar or identical to the goods and services in the earlier marks and denies that a likelihood of confusion or likelihood of association exists between the marks on the part of the public.

10. The two oppositions were consolidated on 12 January 2024.

11. The holder is represented by Locke Lord (UK) LLP and the opponent is represented by Lewis Silkin LLP. During the evidence rounds, the opponent filed written submissions, and the holder filed evidence. Neither party requested a hearing, nor did they file written submissions in lieu.

12. 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.

Evidence and submissions

13. The opponent filed written submission dated 8 March 2024.

14. The holder filed evidence in the form of a witness statement of Mathieu Mortelė, signed and dated 8 May 2024. Mathieu Mortelė of Locke Lord (UK) LLP, representative for the holder, is a member of the Bar of the Province of Antwerp. The witness statement was accompanied by 24 exhibits, MM1 – MM24.

15. The opponent filed written submissions in reply dated 8 July 2024.

16. The opponent commented as follows: "The Opponent … submits that the Applicant has not provided any link as to why the Applicant's Submissions and accompanying Exhibits are relevant to the current proceedings or form any viable defence to the oppositions."

17. I have also had difficulty in identifying the purpose of the holders' evidence.

18. There is no explanation from the holder as to what it is seeking to show in filing this evidence. The witness statement is simply a list of what the exhibits are. The exhibits show references to "arte" and "Arte Antwerp" as a Belgian clothing brand on social media, in articles, in catalogues, as an award nominee, and offered for sale websites, together with sales figures from Shopify. Most of the evidence relates to activity in Belgium, the Netherlands, France, Germany, and Austria, but there is some UK social media activity and there are some sales recorded. There is also an untranslated German language article about the

opponent, Schweizer Kapital, as well as evidence of social media pages showing the opponent's figurative mark in relation to apartments and travel.

19. Perhaps the holder is trying to run an argument of prior use or concurrent use without confusion, but it has not said so. Or it could be arguing that the actual goods and services that the parties sell are not in conflict. Proof of use does not apply in this case, and even if it did, it would be a requirement of the opponent and not the holder. To sum up, absent any context from the holder, I do not find this evidence to be of assistance to me in my goal of deciding whether there is a likelihood of confusion based on a notional assessment of the goods and services and the marks.

DECISION

Sections 5(2)(b), 5A, and 6

20. Sections 5(2)(b) and 5A of the Act state:

> "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.
>
> 5A 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."

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

> "(6)(1) In this Act an "earlier trade mark" means –
>
> (a) a registered trade mark or international trade mark (UK) 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."

22. The opponent's marks qualify as earlier trade marks under the above provisions. As the opponent's marks had not completed their registration process more than five years before the designation date of the IRs, they are not subject to the proof of use requirements. Consequently, the opponent may rely on all of the goods and services highlighted in its notices of opposition.

Relevant law

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

The principles

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well

informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

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

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

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

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might 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

24. In comparing the respective specifications, all relevant factors should be considered, as per *Canon*, where the CJEU stated at paragraph 23 of its judgment:

> "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."

25. The relevant factors identified by Jacob J. (as he then was) in the Treat case, [1996] R.P.C. 281, for assessing similarity were:

(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.

26. In *Gérard Meric v OHIM*, Case T- 133/05, the General Court ("GC") stated that:

"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."

27. Further, in *Kurt Hesse v OHIM*,[1] the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods

28. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM),* Case T-325/06, the General Court stated that "complementary" means:

"[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking."

29. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

[1] Case C-50/15 P

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

30. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term 'computer software'. In the course of his judgment he set out the following summary of the correct approach to interpreting broad and/or vague terms:

"…the applicable principles of interpretation are as follows: (1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services. (2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms. (3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers. (4) A term which cannot be interpreted is to be disregarded."

31. In *Avnet Incorporated v Isoact Limited* [1998] FSR 16, Jacob J (as he then was) said at [19]:

"[…] definitions of services … are inherently less precise than specifications of goods. […] In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast

range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase."

32. I bear in mind that it is permissible to group goods together for the purposes of assessment: *Separode Trade Mark*:[2]

"The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision."

33. The goods/services to be compared are shown in the table below:

The opponent's goods and services	**The holder's goods and services**
The '524 mark and the '371 mark Class 3 Non-medicated toiletry preparations and cosmetic products; non-medicated dentifrices; perfumery products, essential oils.	
The '169 mark Class 6 Common metals and their alloys; statues and works of art of common metals; transportable buildings of metal; small items of metal hardware.	
The '169 mark Class 14 Precious metals and their alloys; jewelry, precious and semi-precious	Class 14 Chains [jewellery]; rings [jewellery]; earrings; bracelets; chronoscopes;

[2] BL O/399/10

stones; timepieces and chronometric instruments; statues, figures and works of art of precious metals or semi-precious metals or stones or imitations of precious metals; decorative boxes made of precious metal; decorative works of art of precious metals.	cases [fitted] for jewels; key rings [split rings with trinket or decorative fob].
<u>The ‘169 mark</u> <u>Class 16</u> Paper and cardboard; printing products (printed matter); figures and works of art of paper and cardboard; lithographic works of art; photographs [printed]; stationery and office requisites, excluding furniture; drawing material and material for artists; sheets, films and bags of plastic materials for wrapping and packaging; printing type, printing blocks.	
	<u>Class 18</u> Leather and imitations of leather; animal skins; travel cases; suitcases; umbrellas; handbags; trunks and suitcases; bags; pocket wallets; rucksacks; bags for sports; all-purpose athletic bags; bags for sports clothing.
<u>The ‘524 mark and the ‘371 mark</u> <u>Class 25</u> Clothing, footwear, headwear.	<u>Class 25</u> Clothing; footwear; headgear; sportswear.
<u>The ‘524 mark and the ‘371 mark</u> <u>Class 28</u>	

Games, toys; video game apparatus; gymnastic and sporting articles; decorations for Christmas trees/ Christmas trees decorations.[3]	
The ‘524 mark and the ‘371 mark Class 29 Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs; milk, cheese, butter, yogurt and other dairy products; edible oils and fats.	
The ‘524 mark and the ‘371 mark Class 30 Coffee, tea, cocoa and coffee substitutes; rice, pasta and noodles; tapioca and sago; flour and preparations made from cereals; bread, pastry and confectionery products; chocolate; ice cream, sherbets and other edible ices; sugar, honey, golden syrup; yeast, baking powder; salt, seasonings, spices, preserved herbs; vinegar, sauces and other condiments; ice for refreshment.	
The ‘524 mark and the ‘371 mark Class 31 Unprocessed and non-transformed agricultural, aquacultural, horticultural and forestry products; unprocessed and raw grains and seeds; fresh fruits	

[3] The ‘524 mark specification says “decorations for Christmas trees”, whereas the ‘371 mark specification says “Christmas trees decorations”.

and vegetables, fresh aromatic herbs; natural plants and flowers; bulbs, seedlings and seeds; live animals; food products and beverages for animals; malt.	
The ‘524 mark and the ‘371 mark Class 32 Beers; non-alcoholic beverages; mineral and aerated waters; fruit beverages and fruit juices; syrups and other preparations without alcohol for making beverages.	
The ‘524 mark and the ‘371 mark Class 33 Alcoholic beverages except beers; alcoholic preparations for making beverages.	
	Class 35 Retail services in relation to clothing; retail services in relation to headgear; retail services in relation to footwear; retail services in relation to jewellery.
The ‘169 mark Class 41 Education; training; entertainment services; sporting and cultural activities.	
The ‘169 mark Class 43 Services for providing food and beverages; temporary accommodation.	

<u>The '524 mark and the '371 mark</u> <u>Class 45</u> Legal administration of licenses; management and licensing of industrial property rights and copyright (legal services); management and exploitation of copyright and industrial property rights by licensing for third parties (legal services); licensing services relating to the manufacture of goods (legal services); intellectual property licensing; licensing of databases (legal services); granting licenses for franchising concepts (legal services); licensing of rights relating to the use of photographs (legal services); consultancy services relating to copyright licensing; services provided by consultants relating to trademark licensing; services provided by consultants relating to intellectual property licensing; legal services; security services for the protection of property and individuals/security services for protection of property and individuals;[4] mediation; clothing rental.	

<u>Class 14</u>

34. "Chains [jewellery]", "rings [jewellery]", "earrings" and "bracelets" are *Meric* identical to the opponent's "jewelry …".

[4] The '524 mark says "security services for the protection of property and individuals", whereas the '371 mark says "security services for protection of property and individuals".

35. “Chronoscopes” are *Meric* identical to the opponent’s “… chronometric instruments”.

36. I compare “cases [fitted] for jewels” with the opponent’s “jewelry …”. While the goods differ in nature, method of use and purpose, I consider that they overlap in user and trade channels. This is on the basis that a purchaser of jewellery goods will likely also buy cases for those goods. Further, I consider it likely that these goods are produced by the same undertakings and are purchased through the same retailers. Lastly, I consider that the goods are complementary on the basis that jewellery is important to the holder’s goods and it is likely that the average consumer will believe that the same undertaking is responsible for both types of goods. Overall, I consider that these goods are similar to a medium degree.

37. I compare “key rings [split rings with trinket or decorative fob]” to the opponent’s “jewelry …”. The trade channels and the users will overlap to some extent. While both sets of goods are decorative, the primary purpose of the holder’s goods is to hold keys, whereas the purpose of the opponent’s goods is to adorn the body. The nature of the goods will overlap in that they may well be made from the same materials. The goods are neither in competition, nor complementary. I consider them to be similar to a low degree.

Class 18

38. I compare “bags for sports”, “all-purpose athletic bags” and “bags for sports clothing” with the opponent’s Class 28 “gymnastic and sporting articles”. The holder’s goods are for carrying sports equipment and sports clothing, whereas the opponent’s goods are the sporting goods themselves. All relate to sport, and all would be sold through the same trade channels, albeit they may not be shelved next to each other. They are not in competition, but they are complementary in that sporting goods are important for the use of sports bags in such a way that customers may think that the responsibility for those goods lies with the same undertaking. I find these goods to be of medium similarity.

39. I compare “handbags” and “bags” with the opponent’s “clothing …”. The term “bags” is a broad term that includes “handbags”. In my view, these goods could be conceived by some consumers as aesthetically complementary accessories to articles of clothing. Fashion accessories such as handbags have consistently been found to be similar to clothing based on the fact that they share a common aesthetic function, since these goods jointly contribute to the “look” of the consumers.[5] It is, in fact, a common customer behaviour to aesthetically combine those goods when purchasing them and their aesthetic coordination may also be considered at the design stage. They are likely to be sold in the same outlets as clothing and the average consumer may expect them to be produced by the same undertaking. Consequently, I find that there is a low degree of similarity between the respective goods.

40. In comparing “travel cases”, “suitcases”, “umbrellas”, “trunks and suitcases”, “pocket wallets” and “rucksacks” with the opponent’s “clothing …”, the purpose of these goods is practical, that of transporting items, protecting one from the rain, or storing money. I do not consider that they would be intended to be coordinated with items of clothing to present a particular image or sold as such. These goods are dissimilar.

41. I compare “leather and imitations of leather” and “animal skins” with the opponent’s Class 25 “clothing, footwear, headwear”. While the opponent’s finished products may be made from the holder’s goods, that does not in itself make them similar in nature: see *Les Éditions Albert René v OHIM*, Case T-336/03, paragraph 61. I consider this to be the case in respect of the goods at issue here. Furthermore, I do not find them to be in competition or to be complementary. I find that they are dissimilar.

Class 25

42. “Clothing”, “footwear”, “headgear” are identical to the opponent’s “clothing …”, “… footwear …” and “… headwear”.

[5] See for example *Gitana SA v OHIM*, Case T-569/11, para 45

43. “Sportswear” is *Meric* identical to the opponent’s “clothing …”

Class 35

44. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

45. In *Tony Van Gulck v Wasabi Frog Ltd,* Case BL O/391/14, 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.”

46. However, on the basis of the European courts’ judgments in *Sanco SA v OHIM*, Case C-411/13P and *Assembled Investments (Proprietary) Ltd v. OHIM,* Case T-105/05*,* at paragraphs [30] to [35] of the judgment, upheld on appeal in *Waterford*

Wedgewood Plc v. Assembled Investments (Proprietary) Ltd Case C-398/07P, 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 GC'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).

47. As highlighted in *Oakley* above, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

48. In this case, I compare the holder's "retail services in relation to clothing", "retail services in relation to headgear", "retail services in relation to footwear" and "retail services in relation to jewellery" with the opponent's "clothing …", "… headwear", "… footwear …" and "jewelry …". The opponent's goods will be sold through the holder's matching trade channels, to the same users, who may perceive the goods and services as emanating from one and the same

undertaking, and as such they are complementary. I therefore consider the respective goods and services to be similar to a medium degree.

49. As some degree of similarity between the goods and services is required for there to be a likelihood of confusion[6], the opposition must fail in respect of the following goods in the applicants' specification:

Class 18	leather and imitations of leather; animal skins; travel cases; suitcases; umbrellas; trunks and suitcases; pocket wallets; rucksacks.

The average consumer and the purchasing act

50. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited,* [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

> "60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

[6] *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

51. The average consumer for the goods and services at issue is a member of the public buying jewellery, chronometric instruments, bags, clothing, footwear and headgear.

52. In respect of jewellery and chronometric instruments, some of the purchases will be at the very expensive end of the spectrum and a great deal of thought will be given to the aesthetic properties of the goods. Overall, the level of attention paid will be that of a medium to high degree.

53. For the remaining goods and services, the purchaser will be faced with a wide price range and will consider practical and aesthetic matters. The level of attention paid will be that of a medium degree.

54. In all cases, visual considerations will predominate, although there will be occasions when verbal factors also play a significant part when the purchaser seeks the advice of a shop assistant.

Comparison of the trade marks

55. It is clear form *Sabel* that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU states at paragraph 34 of its judgment in *Bimbo*, 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 relevant 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."

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

57. The opponent's word marks represent the opponent's strongest case, being closest to the holder's marks, and so it will not be necessary for me to carry out an analysis of the opponent's '371 figurative mark by comparison with the holder's marks. The respective specifications of the '524 word mark and the '371 figurative mark are essentially the same and so my comparative analysis of the goods and services remains valid.

58. The marks to be compared are as follows:

The opponent's marks	**The holder's marks**
(The '619 mark) ARTEL	(The '485 mark) arte
(The '524 mark) ARTEL	(The '483 mark) ARTE

59. The opponent's marks are the same word mark – "ARTEL" – and the overall impression of the marks resides in that word alone.

60. The holder's '485 mark is a figurative mark, being the word "arte" that is rendered in slightly stylised all lower-case form with the letters "r" and "t" being angular. However, the word "arte" alone is the dominant element in forming the overall impression, the stylisation making a minor contribution.

61. The holder's '483 mark is the word mark – "ARTE" – and the overall impression of the mark resides in that word alone.

62. Visually, the opponent's word marks could be rendered in either block capitals or all lower case according to the principles of normal and fair use. As such, the marks only meaningfully differ in the opponent's marks having the additional letter "L" at the end and consequently the opponent's marks entirely encapsulate the holders' marks. I consider these marks to be highly similar visually.

63. At paragraph 3.a., of its counterstatements, the holder submits that the marks have clear phonetic differences.

64. In paragraph 9 of its written submissions, the opponent says the following: "The average English-speaking consumer following standard speech patterns would pronounce the Application Marks as 'AR-TEE' with the Earlier Marks being pronounced as 'AR-TEE-EL'. Alternatively, the Application Marks will be pronounced as 'AHT' with the Earlier Marks being pronounced as 'AHT-EL'. There is therefore high aural similarity between the Application Marks and the Earlier Marks."

65. I do not think it likely that the opponent's marks would be pronounced "AR-TEE-EL". In my view, the opponent's marks would be pronounced "AH-TELL". The holder's marks would be pronounced "AH-TAY", "AHT" or "AH-TEE". Whichever of the pronunciations of the holder's marks was used, would, result in the marks being of a medium level of aural similarity.

66. Conceptually, at paragraph 3.a. of its counterstatements, the holder submits that the marks have no conceptual similarity.

67. In paragraph 27 of its written submissions, the opponent says that "Regardless of there being no conceptual comparison, this does not detract from the visual and aural similarities between the Application Marks and the Opponent's Earlier Marks".

68. I find that the marks do not give rise to a particular concept in respect of the goods and services at issue and so they are conceptually neutral.

Distinctive character of the earlier mark

69. In *Lloyd Schuhfabrik Meyer* the CJEU stated that:

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

70. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

71. The earlier marks consist of the word “ARTEL”. This is an invented word that is not suggestive of the opponent’s goods and services and so I find the earlier marks to be of high inherent distinctiveness.

Likelihood of confusion

72. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent’s trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

73. I have found that the marks are visually similar to a high degree and of medium similarity aurally. The marks are conceptually neutral. The earlier marks are inherently distinctive to a high degree.

74. Except where I have found the holder’s goods to be dissimilar, the goods and services range from being of low similarity to being identical by comparison with the opponent’s goods and services.

75. The average consumer for the goods and services at issue will be a member of the public, paying a medium to high level of attention during the purchasing process for jewellery and chronometric instruments and a medium level for the

rest of the goods and services. Visual considerations will predominate, although there will be occasions when verbal factors also play a significant part.

76. The opponent's word marks could be rendered in either block capitals or all lower case according to the principles of normal and fair use. As such, the marks only meaningfully differ in the opponent's marks having the additional letter "L" at the end and consequently the opponent's marks entirely encapsulate the holders' marks. Also, the beginnings of words tend to have more visual and aural impact than the ends.[7]

77. In this case it is highly likely that the marks at issue will be mis-recalled for each other, even where the goods are of low similarity. The absence of a concept for the average consumer to grasp makes it particularly likely that they will mis-recall these marks.

78. There is therefore a likelihood of direct confusion.

CONCLUSION

79. The oppositions have been partially successful such that the IRs, WO0000001626485 and WO0000001626483, may not be protected in the UK for the following goods and services:

Class 14	Chains [jewellery]; rings [jewellery]; earrings; bracelets; chronoscopes; cases [fitted] for jewels; key rings [split rings with trinket or decorative fob].
Class 18	handbags; bags; bags for sports; all-purpose athletic bags; bags for sports clothing.
Class 25	Clothing; footwear; headgear; sportswear.

[7] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

Class 35 Retail services in relation to clothing; retail services in relation to headgear; retail services in relation to footwear; retail services in relation to jewellery.

80. The IRs may be protected in the UK for the following goods:

Class 18	Leather and imitations of leather; animal skins; travel cases; suitcases; umbrellas; trunks and suitcases; pocket wallets; rucksacks.

COSTS

81. The opponent has been significantly more successful than the holder in this case and is entitled to a contribution towards its costs.

82. At paragraph 31 of its written submissions in reply to the evidence, the opponent has said that it "requests an enhanced costs award in their favour, given that the Applicant's Submissions and accompanying evidence exceeds the 300-page total allowed and that the Opponent has incurred unnecessary time and expense in reviewing the evidence, the majority of which falls outside the jurisdiction of these proceedings." I have taken this request, and my own findings as to the relevance of the holder's evidence, into account when making my costs award which is based on the scale published in Tribunal Practice Notice 1/2023.

83. I award the opponent the sum of £2250, calculated as follows:

Official fees:	£100 x 2 = £200
Preparing statements and considering the other side's statements:	£250 x 2 = £500
Considering and commenting on the other side's evidence:	£1200
Preparation of written submissions:	£350
Total:	**£2250**

84. I therefore order ARTERNATIVE to pay SCHWEIZER KAPITAL HOLDING AG the sum of £2250. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the final determination of the appeal proceedings.

Dated this 20th day of June 2025

John Williams
For the Registrar