

O-181-10

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2379969
BY
TOPPY TRADEMARKS LIMITED
TO REGISTER THE TRADE MARK**



IN CLASS 25

AND

**THE OPPOSITION THERETO
UNDER NO 93471
BY
COFRA HOLDING AG**

Trade Marks Act 1994

**In the matter of application 2379969
by Topy Trademarks Limited
to register the trade mark:**



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and the opposition thereto
under no 93471
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1. On 8 December 2004, Topy Trademarks Limited (which I will refer to as TTL) applied to register the above trade mark. Following examination, the application proceeded to publication in the *Trade Marks Journal* on 4 March 2005 for a goods specification of 'clothing, footwear and headgear' in class 25¹.

2. Aldemar AG filed notice of opposition to the trade mark application on 8 June 2005. The opponent was later substituted by the current opponent, Copra Holding AG (which I will refer to as CH) following assignment (on 20 December 2007) of the earlier rights relied upon for the single ground, section 5(2)(b) of the Trade Mark Act 1994 (the Act). CH claims that registration of the trade mark would be contrary to section 5(2)(b) of the Trade Marks Act 1994 (the Act) which states:

“(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.”

¹ Class 25 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

3. CH relies upon three earlier Community trade marks (CTMs), as follows:

789982 **YESSICA**

Application date: 3 April 1998
Registration date: 5 October 2000
Expiry date: 3 April 2008

Class 14: *Precious metals and their alloys and goods in these materials or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments.*

Class 18: *Leather and imitations of leather; goods made from these materials, not included in other classes; trunks and travelling bags; umbrellas, parasols and walking sticks.*

Class 25: *Clothing, footwear, headgear.*

789958 

Application date: 3 April 1998
Registration date: 5 October 2000
Expiry date: 3 April 2008

Class 14: *Precious metals and their alloys and goods in these materials or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments.*

Class 18: *Leather and imitations of leather; goods made from these materials, not included in other classes; trunks and travelling bags; umbrellas, parasols and walking sticks.*

Class 25: *Clothing, footwear, headgear.*

4096723 Yessica

Application date: 28 October 2004
Registration date: 29 February 2008

Class 24: *Textiles and textile goods, not included in other classes; bed and table covers.*

Class 35: *Retailing services.*

4. TTL filed a counterstatement, denying that any of the goods (of all three CTMs) are either similar or identical, and denying that the marks are sufficiently similar for there to be a likelihood of confusion. Neither side filed evidence and only CH filed written submissions. Neither side requested a hearing, both being content for a decision to be made from the papers on file.

5. At the time the opposition to the application was filed, earlier CTMs 789982 and 789958 were registered and earlier CTM 4096723 was pending. Since the opposition was filed, the status of all the CTMs has changed, according to the database of the Community Trade Mark register at the Office for Harmonization in the Internal Market (OHIM). CTMs 789982 and 789958 have now 'lapsed': a 'need to renew' was communicated on 9 September 2007, the 'expiry date' was 3 April 2008 (i.e. 10 years after the applications were made) and the 'expired' date was 8 February 2009². CTM 4096723 was registered on 29 February 2008.

² Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark provides for renewal of marks and also for re-instatement of marks in certain circumstances:

Article 46

Duration of registration

Community trade marks shall be registered for a period of 10 years from the date of filing of the application. Registration may be renewed in accordance with Article 47 for further periods of 10 years.

Article 47

Renewal

1. Registration of the Community trade mark shall be renewed at the request of the proprietor of the trade mark or any person expressly authorised by him, provided that the fees have been paid. 2. The Office shall inform the proprietor of the Community trade mark, and any person having a registered right in respect of the Community trade mark, of the expiry of the registration in good time before the said expiry. Failure to give such information shall not involve the responsibility of the Office. 3. The request for renewal shall be submitted within a period of six months ending on the last day of the month in which protection ends. The fees shall also be paid within this period. Failing this, the request may be submitted and the fees paid within a further period of six months following the day referred to in the first sentence, provided that an additional fee is paid within this further period. 4. Where the request is submitted or the fees paid in respect of only some of the goods or services for which the Community trade mark is registered, registration shall be renewed for those goods or services only. 5. Renewal shall take effect from the day following the date on which the existing registration expires. The renewal shall be registered.

Article 81

Restitutio in integrum

1. The applicant for or proprietor of a Community trade mark or any other party to proceedings before the Office who, in spite of all due care required by the circumstances having been taken, was unable to comply with a time limit vis-à-vis the Office shall, upon application, have his rights re-established if the obstacle to compliance has the direct consequence, by virtue of the

CTMs 789982 and 789958 have passed the period of grace for late renewal and *restitutio in integrum* as per Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark. Neither party had referred to the expiry of the earlier registrations and the consequences for these proceedings; I therefore sought written submissions from both parties prior to issuing this decision.

6. In response to my request, TL submitted that CTMs 789982 and 789958 be disregarded because they had expired, the grace period for renewal and the period for restoration of the registrations had passed, it being no longer possible to renew or restore them. Further, the lapsed registrations had ceased to be earlier trade marks within the meaning of section 6 of the Trade Marks Act 1994. TL also said:

“It has been the Registry’s practice for very many years to suspend oppositions where the earlier rights relied upon are pending applications or are themselves the subject of legal proceedings. There would be no need for this if the mere existence of those earlier rights at the date of filing of the oppositions was determinative of the applicability of those earlier rights.”

TL submitted that this practice is in accord with that of the Office for Harmonization of the Internal Market (OHIM) and that it knows of no judgments at European court level which would lead them to believe that the practice is incorrect.

7. CH submitted that CTMs 789982 and 789958 should still be taken into account:

“It is submitted that at the date the application the subject of the opposition was filed, the marks in issue were earlier trade marks within the meaning of the Trade Marks Act, and the date of application is the relevant date for the purposes of deciding whether there is a risk of confusion with any earlier trade marks.”

provisions of this Regulation, of causing the loss of any right or means of redress. 2. The application must be filed in writing within two months from the removal of the obstacle to compliance with the time limit. The omitted act must be completed within this period. The application shall only be admissible within the year immediately following the expiry of the unobserved time limit. In the case of non-submission of the request for renewal of registration or of non-payment of a renewal fee, the further period of six months provided in Article 47(3), third sentence, shall be deducted from the period of one year. 3. The application must state the grounds on which it is based and must set out the facts on which it relies. It shall not be deemed to be filed until the fee for re-establishment of rights has been paid.”

8. Section 6 of the Act states:

“6.— (1) In this Act an “earlier trade mark” means —
(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(b) a Community trade mark or international trade mark (EC) which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), (ba) a registered trade mark or international trade mark (UK) which—

(i) has been converted from a Community trade mark or international trade mark (EC) which itself had a valid claim to seniority within paragraph (b) from an earlier trade mark, and

(ii) accordingly has the same claim to seniority, or

(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark

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

(3) A trade mark within subsection (1)(a) or (b) whose registration expires shall continue to be taken into account in determining the registrability of a later mark for a period of one year after the expiry unless the registrar is satisfied that there was no bona fide use of the mark during the two years immediately preceding the expiry.”

9. TTL’s submission regarding the registrar’s practice of suspending cases pending registration of earlier rights stems from section 6(2). It is an earlier mark providing it becomes registered. Section 6(3) is pertinent to this case. The date on which CTMs 789982 and 789958 both expired was 3 April 2008, but section 6(3) provides for them to be taken into account in determining the registrability of a later mark for a period of one year after the expiry, i.e. until 3 April 2009. If the relevant date for determining registrability is the date of application, as CH submits, then the CTMs were registered at that date, as indeed they were when

the opposition was launched. It is now, at the decision stage, that they have been expired marks for over two years.

10. In *MIP METRO Group Intellectual Property GmbH & Co. KG v OHIM*, Case T-191/04, (“*Metro*” the General Court (GC) considered circumstances where an earlier (UK national) mark relied upon in opposition to a CTM had expired after the date the opposition was filed but before the decision was taken. The Court stated:

“30 According to well-established case-law, the essential function of a trade mark is to guarantee the identity of the origin of the marked goods to the consumer or end user by enabling him, without any possibility of confusion, to distinguish those goods from others which have another origin (Case 102/77 *Hoffmann-La Roche* [1978] ECR 1139, paragraph 7; Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 48; and Case C-329/02 P *SAT. 1 v OHIM* [2004] ECR I-8317, paragraph 23). There is no public interest in conferring the benefit of the full protection envisaged by Regulation No 40/94 on a trade mark which does not fulfil its essential function (*Henkel v OHIM*, paragraph 48).

31 The essential purpose of Articles 8 and 42 of Regulation No 40/94 and Rules 15, 16 and 20 of the implementing regulation, concerning relative grounds for refusal and opposition proceedings, is to ensure that, by making it possible to refuse registration of a new mark which may conflict with an earlier mark as there is a likelihood of confusion between them, the earlier mark may retain its function of identifying origin.

32 The possibility of such a conflict must be considered from two different angles. Firstly, with regard to the substantive scope of the abovementioned provisions, the earlier mark and the mark applied for must be identical or similar, as must the goods or services designated by those marks, so that confusion may arise between the two signs. Secondly, concerning the temporal scope of those provisions, both those marks must co-exist for a certain period. The function of an earlier mark as a means of identifying its origin cannot be undermined by another mark which is registered only after the term of protection of the earlier mark has expired. If there is no period during which both marks co-exist, no conflict can arise.

33 Accordingly, the Court of First Instance finds that the assertion in the contested decision that ‘[t]here is nothing that permits the Opposition Division to retroactively change an opponent’s status simply because in the course of opposition proceedings ... a national registration ... expires’ fails to take account of the fact that no conflict can arise between the mark applied for and an earlier mark which has expired during that period, given that the mark applied for may be registered only after the end of the

opposition proceedings. As a consequence, the protection which the Board of Appeal recognised the earlier mark as having is not justified by the need to protect the mark's essential function and is contrary to the spirit and the logic underlying the provisions governing the assessment of relative grounds for refusal and opposition proceedings."

11. *Metro* is analogous to the instant case; by applying its logic, I have reached the conclusion that CH can no longer rely upon CTMs 789982 and 789958. CH can only rely upon CTM 4096723, which was applied for on 28 October 2004 and for which the registration procedure was completed on 29 February 2008. TTL's application was published on 4 March 2005; CH's CTM 4096723 is therefore an earlier trade mark which is not subject to proof of use³ because at the date of publication of the application it had been registered for less than five years.

Decision

12. The leading authorities which guide me in this ground are from the European Court of Justice (ECJ): *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO)*. It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

³ See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*,

(g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(i) further, 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; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(j) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*.

Average consumer and the purchasing process

13. The retail services are not particularised so could cover consumer and specialist items, in which case the average consumer could be different, with differing levels of attention depending on what is being bought. The goods in issue are general consumer items and so the average consumer will be the general public. The level of attention will vary according to the particular nature of the item being purchased or hired. Bedding and e.g. oven gloves will be subjected to a reasonable level of attention, for example, since although of

relatively low cost, they are likely to have to function well and to fit in with a decorative scheme. Clothing will also be a considered purchase. The level of attention of a consumer of clothing may vary depending on cost and the occasion; in general, clothing is a reasonably considered purchase as items may be tried on, but not highly considered (as with specialist or technical goods). Buying clothes is a visual activity⁴; the public is increasingly brand conscious and the visual appearance of the trade mark and where it is placed on the clothing or footwear item is of some importance to many purchasers. The potential for imperfect recollection may be increased in relation to low cost goods, but if frequently purchased, that potential may be reduced. If items of high cost are infrequently bought, the higher level of attention may decrease the risk of imperfect recollection, but conversely the infrequency of purchase may lead to a greater potential for imperfect recollection.

Comparison of goods

14. Following the established tests in *Canon* and in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281, I must consider all relevant factors including the nature of the goods and services, their intended purpose, their method of use, whether the goods or services are in competition with or complementary to each other and also the nature of the users and the channels of trade⁵.

15. CH's class 35 specification is registered for 'retailing services' but does not specify what goods are retailed⁶. The GC in *Oakley, Inc v OHIM*, Case T-116/06,

⁴ See *Société provençale d'achat and de gestion (SPAG) SA v OHIM* Case T-57/03, paragraph 66, and *React Trade Mark* [2000] RPC 285.

⁵ Paragraph 23 of *Canon* where the ECJ 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." The earlier incorrect translation of 'Verwendungszweck' in the English version of the judgment has now been corrected as 'intended purpose'. The criteria identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281 for assessing similarity between goods and services 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, taking into account how goods/services are classified in trade.

⁶ Contrary to the judgment of the CJ in *Praktiker Bau- und Heimwerkermärkte AG*, Case C-418/02 [2005] E.T.M.R. 88.

dealt with the issue of similarity between goods and a retail services specification which was both unrestricted and restricted in scope. The conflict was between an earlier mark which was registered for goods in classes 18 and 25 and a later mark which had been registered for “Retail and wholesale services, including on-line retail store services; retail and wholesale of eyewear, sunglasses, optical goods and accessories, clothing, headwear, footwear, watches, timepieces, jewellery, decals, posters, athletic bags, backpacks and knapsacks, and wallets’. The GC upheld OHIM’s decision that the goods in classes 18 and 25 were similar to “retail and wholesale of eyewear, sunglasses, optical goods and accessories, clothing, headwear, footwear, watches, timepieces, jewellery, decals, posters, athletic bags, backpacks and knapsacks, and wallets” since there is a complementary relationship between retail of the goods and the goods themselves:

“54 Clearly, in the present case, the relationship between the retail services and the goods covered by the earlier trade mark is close in the sense that the goods are indispensable to or at the very least, important for the provision of those services, which are specifically provided when those goods are sold. As the Court held in paragraph 34 of *Praktiker Bau- und Heimwerkermärkte*, paragraph 17 above, the objective of retail trade is the sale of goods to consumers, the Court having also pointed out that that trade includes, in addition to the legal sales transaction, all activity carried out by the trader for the purpose of encouraging the conclusion of such a transaction. Such services, which are provided with the aim of selling certain specific goods, would make no sense without the goods.”

Having established the similarity between goods and the sale of those specified goods, the GC went on to consider the unrestricted retail services part of the later registration: “Retail and wholesale services, including on-line retail store services”. It said:

“59 In the second place, with regard to the comparison of ‘retail and wholesale services, including on-line retail store services’ with the goods in question, it must be recalled that the Court held, in paragraph 50 of *Praktiker Bau- und Heimwerkermärkte*, paragraph 17 above, that the applicant for the Community trade mark must be required to specify the goods or types of goods to which those services relate.

60 In that regard, it must be pointed out that the applicant has, as correctly stated by the Board of Appeal in paragraph 32 of the contested decision, failed to provide any specification whatsoever of the goods or types of goods to which the ‘retail and wholesale services, including on-line retail store services’ relate.

61 Thus, it must be held that ‘retail and wholesale services, including on-line retail store services’, on account of the very general wording, can

include all goods, including those covered by the earlier trade mark. Therefore, it must be held that 'retail and wholesale services, including on-line retail store services', display similarities to the goods concerned.

62 It follows from all of the foregoing that the Board of Appeal was right to consider that services consisting of 'retail and wholesale of clothing, headwear, footwear, athletic bags, backpacks and knapsacks and wallets', and 'retail and wholesale services, including on-line retail store services', are similar to the goods covered by the earlier trade mark."

16. CH has not specified the goods or types of goods to which its retailing services relate. Following the GC judgment above, CH's specification "on account of the very general wording, can include all goods" including those opposed in class 25 of the application. I am therefore bound to find that retailing services covers retail of clothing, footwear and headgear and that the retail services display similarities to clothing, footwear and headgear. Bearing in mind what the court said about the complementary relationship between goods and the retail of them, I find that there is a high level of similarity between "retailing services" of CH's earlier mark and "clothing, footwear and headgear" of TTL's application.


17. CH's registration also includes textiles and textile goods and bed and table covers in class 24. CH submits these are similar because the goods in class 25 are made of textile. Being a component of a finished good does not of itself give rise to a similarity; the issue will turn upon the particular goods. Textiles and clothing do not share the same nature or purpose, but the two may be complementary in the case of tailoring, where the choice of textile would be an element of buying a bespoke item⁷. There could also be competition between buying a finished piece of clothing or choosing instead to buy fabric for home dressmaking. There is consequently a low level of similarity between textiles and clothing and headgear, but no similarity with footwear. CH also submits that the average consumer is used to seeing brands extend into areas which may be viewed as an extension of the clothing market such as bedding. There is no evidence to support this. The respective purposes and methods of use of textile goods (as opposed to textiles) compared to clothing, footwear and headgear are different, they are not found in proximity on shop shelves and they are not competitive or complementary. There is no similarity between textile goods and clothing, footwear and headgear.

⁷ In *Boston Scientific Ltd v OHIM* Case T- 325/06 the General Court (GC) explained when goods were to be considered complementary: "82 It is true that goods are complementary if 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 (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P *Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48)."

Comparison of trade marks

18. The authorities direct that, in making a comparison between the marks, I must have regard to each mark's visual, aural and conceptual characteristics. I have to decide which, if any, of their components I consider to be distinctive and dominant, without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

19. The marks to be compared are:

Earlier mark	Application
Yessica	

20. As CH's mark is for a word only, the only possible point of convergence between the marks is the word element. Both words consist of seven letters, of which the first letter is different and the remaining letters ('essica') are identical. The first letters, Y and J, look very different. Proportionally, the JESSICA element in TTL's mark is as prominent as the device element, it plays an equally dominant and distinctive rôle to the device. YESSICA does not readily divide into separate elements; there is no separate dominant and distinctive element. The device and word are separate elements in TTL's mark so that the device forms no part of JESSICA which may have put a visual difference between the marks. Owing to the similarity in both structure and composition of the -ESSICA elements of both marks, there is a good deal of visual similarity between the marks, notwithstanding the different first letters. Factoring in the distinctive, prominent device, which is separate to and positioned above the word element, there is a reasonable degree of similarity between the marks.

21. CH submits that the marks are clearly similar aurally because it claims the syllabic structure is identical (-ESSICA). CH further submits:

“Furthermore, in many countries in Europe, the letter “J” is pronounced similarly to the letter “Y”, for example, JESSICA would be pronounced YESSICA. This makes the marks identical from an aural comparison.”

The aural assessment must be from the standpoint of the average consumer in the UK. In the UK, the letter J is pronounced as a J, not a Y. J has a harder sound than Y; it is different aurally (it is not comparable to c/k/x/q, for example).

22. CH goes on to say:

“For many consumers in the UK it is submitted that the element JESSICA could be pronounced as “YESSICA”, given that consumers are used to the pronunciation of fashion brands being different to the English pronunciation. This is especially so in relation to clothing and fashion brands generally. For example, GUCCI is pronounced in the Italian style. Accepted English pronunciation of this name would be as GUCKI or GUSI.”

I will come onto conceptual identity, but JESSICA is a very common forename in the UK which would be pronounced with a J, not with a Y instead of the J. Because it is so well known, it would not be perceived as a foreign name and so there appears to be no reason why the UK average consumer would give it a foreign pronunciation. Average consumers in the UK do not assume that all fashion brands are foreign and deserve a foreign pronunciation, especially when the brand consists of a well-known English word. I am not persuaded that the average UK consumer would turn the J into a Y. The marks are not aurally identical but the rhythmic pattern of the remaining syllables and letters does make for a good deal of similarity.

23. CH submits that conceptually, “the marks are identical consisting of a first or christian name”. I find this submission difficult to understand because YESSICA is not a name in the UK, at least not to my knowledge and there is no evidence otherwise. I agree that JESSICA is a forename. Its conceptual significance is solely that it is a forename; i.e. it is not a word which could be a surname or a word with another meaning. YESSICA is an invented word; the respective marks are, therefore, conceptually dissimilar, although as the application is for an invented word, there is not conceptual dissonance.

Likelihood of confusion

24. It is necessary to consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade mark (either by nature or nurture) the greater the likelihood of confusion⁸. The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which

⁸ *Sabel BV v Puma AG* [1998] RPC 199.

registration is sought and, secondly, by reference to the way it is perceived by the relevant public⁹. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the goods for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings¹⁰. CH has not filed any evidence of use of its mark so I have only its inherent character to consider. Invented words have high inherent distinctive character; YESSICA is an invented word and therefore has a high degree of inherent distinctive character. There is a high level of similarity between TTL's clothing, footwear and headgear and CH's retailing services, and a low level of similarity between CH's textiles and TTL's clothing and headgear. There is no similarity between the application and CH's textile goods, bed and table covers. I have found the marks to be dissimilar conceptually but that there is a good deal of similarity visually and more so aurally.

25. In *Quelle AG v OHIM* Case T-88/05, the GC said:

“68 Therefore, in the global assessment of the likelihood of confusion, the visual, phonetic 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 (Case T-129/01 *Alejandro v OHIM – Anheuser Busch (BUDMEN)* [2003] ECR II-2251, paragraph 57, and *NLSPORT, NLJEANS, NLACTIVE and NLCollection*, paragraph 53 supra, paragraph 49). 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 marks are marketed. If the goods covered by the marks in question are usually sold in self-service stores where consumers 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 phonetic similarity between the signs (*NLSPORT, NLJEANS, NLACTIVE and NLCollection*, paragraph 53 supra, paragraph 49).

69 Likewise, the degree of phonetic similarity between two marks is of less importance in the case of goods which are marketed in such a way that, when making a purchase, the relevant public usually perceives visually the mark designating those goods (*BASS*, paragraph 56 supra, paragraph 55,

⁹ *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

¹⁰ *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

and Case T-301/03 *Canali Ireland v OHIM – Canal Jean (CANAL JEAN CO. NEW YORK)* [2005] ECR II-2479, paragraph 55). That is the case with respect to the goods at issue here. Although the applicant states that it is a mail order company, it does not submit that its goods are sold outside normal distribution channels for clothing and shoes (shops) or without a visual assessment of them by the relevant consumer. Moreover, while oral communication in respect of the product and the trade mark is not excluded, the choice of an item of clothing or a pair of shoes is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly, the visual aspect plays a greater role in the global assessment of the likelihood of confusion (*NLSPORT, NLJEANS, NLACTIVE and NLCollection*, paragraph 53 supra, paragraph 50). The same is true of catalogue selling, which involves as much as does shop selling a visual assessment of the item purchased by the consumer, whether clothing or shoes, and does not generally allow him to obtain the help of a sales assistant. Where a sales discussion by telephone is possible, it takes place usually only after the consumer has consulted the catalogue and seen the goods. The fact that those products may, in some circumstances, be the subject of discussion between consumers is therefore irrelevant, since, at the time of purchase, the goods in question and, therefore, the marks which are affixed to them are visually perceived by consumers.”

Clothing is a visual purchase so the visual aspect of the similarity carries more weight in my comparison than the aural similarity. Visual perception of the mark includes TTL’s device element which forms part of the overall perception of the application, as per *Shaker*¹¹. The visual perception also includes differing first letters of the respective word elements; consumers normally attach more importance to the first part of words¹². However, what is more significant than the differing first letters per se is the effect of them on the meaning or concept of

¹¹ “41 It is important to note that, according to the case-law of the Court, in the context of consideration of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see order in *Matratzen Concord v OHIM*, paragraph 32; *Medion*, paragraph 29).

As the Advocate General pointed out in point 21 of her Opinion, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element.”

¹² Joined Cases T-183/02 and T-184/02 *El Corte Inglés, SA v OHIM*. This is not a hard and fast rule; if the beginning of both marks is a descriptive or common combining form, the importance may be reduced, as per *Castellani SpA v OHIM*, T-149/06 and *Spa Monopole, compagnie fermière de Spa SA/NV v OHIM*, Case T-438/07

the words: the differing first letters mean that one is an invented word with no concept and the other is a very well-known female forename. Visual and aural similarity can be offset by a lack of conceptual similarity, as found by the GC in *Phillips-Van Heusen Corp v OHIM* [2004] ETMR 60:

“54 Next, it must be held that the conceptual differences which distinguish the marks at issue are such as to counteract to a large extent the visual and aural similarities pointed out in paragraphs 49 and 51 above. For there to be such a counteraction, at least one of the marks at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately. In this case that is the position in relation to the word BASS, as has just been pointed out in the previous paragraph. Contrary to the findings of the Board of Appeal in paragraph 25 of the contested decision, that view is not invalidated by the fact that that word mark does not refer to any characteristic of the goods in respect of which the registration of the marks in question has been made. That fact does not prevent the relevant public from immediately grasping the meaning of that word mark. It is also irrelevant that, since the dice game Pasch is not generally known, it is not certain that the word mark PASH has, from the point of view of the relevant public, a clear and specific meaning in the sense referred to above. The fact that one of the marks at issue has such a meaning is sufficient – where the other mark does not have such a meaning or only a totally different meaning – to counteract to a large extent the visual and aural similarities between the two marks.”

26. Although I bear in mind that the average consumer perceives trade marks as wholes and rarely has the opportunity to compare marks side by side, relying instead upon the imperfect picture he has of them in his mind, the conceptual dissimilarity of the marks is an important factor reducing the likelihood of imperfect recollection. In considering the interdependency principle (*Canon*), whereby a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods and services, and vice versa, the position here is of a substantial degree of similarity between goods and services and between the marks aurally and visually, but that the latter is offset to a very great extent by the conceptual dissimilarity. Taking all the factors into account, I consider that there is no likelihood of confusion.

27. I have based this decision solely upon a comparison between CTM 4096723 and the application owing to the expiry circumstances of the other two CTMs, as explained at the beginning of this decision. If I had been able to consider the expired CTMs, for which there would have been identical goods in class 25, but additional elements in the marks, my conclusion would have been no different. Despite the identical goods, the marks would be dissimilar, on the same conceptual comparison basis as for CTM 4096723.

28. The opposition fails.

Costs

29. TTL has been successful and is entitled to an award of costs on the following basis, taking into account that, except for when I asked for them, TTL did not file written submissions, informing the registry of this prior to the filing of CH's written submissions, and that neither side filed any evidence:

Considering the other side's statement
and preparing a counterstatement: £200

30. I order Cofra Holding AG to pay Topy Trademarks Limited the sum of £200. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 03 day of June 2010

**Judi Pike
For the Registrar,
the Comptroller-General**