

O-431-10

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK REGISTRATION 2503898
IN THE NAME OF KIM WILLIAMSON
IN RESPECT OF THE TRADE MARK**



AND

**AN APPLICATION (NO 83534) FOR INVALIDATION BY
SHANTI HOSPITALITY GROUP LIMITED**

TRADE MARKS ACT 1994

In the matter of registration 2503898 in the name of Kim Williamson

and

An application (no 83534) for invalidation by Shanti Hospitality Group Limited

The background and the pleadings

1) The registered trade mark the subject of these proceedings stands in the name of Ms Kim Williamson. She applied for the trade mark on 2 December 2008 and it completed its registration procedure on 15 May 2009. The trade mark and the goods for which it is registered are shown below:



Class 03: soaps, perfumes, essential oils, cosmetics, hair lotions.

Class 04: candles

Class 25: clothing, footwear

2) On 10 July 2009 Shanti Hospitality Group Limited¹ (“SHG”) applied for a declaration of invalidity in respect of Ms Williamson’s registration. Invalidity is sought only in relation to the goods covered by class 25 of the registration. Although there was initially another ground of invalidation², by the time of the hearing that took place before me, the only ground to be determined was under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). Under this ground SHG rely on three trade marks³ of which it is the proprietor. None of the earlier marks

¹ This company was called C & C Hospitality Limited at the time of making its application – it changed its name to SHG on 27 May 2010.

² Section 5(3), but this was deemed withdrawn due to no evidence being filed in support of the ground (see rule 42(4) of the Trade Mark Rules 2008).

³ UK registration 2406234, UK registration 2406233 & Community trade mark (“CTM”) registration 473374.

are subject to the requirement to prove that they have been used as they were registered within (not before) the five year period prior to the publication of Ms Williamson's registration⁴. Given the nature of the earlier marks and the goods that they cover, I need only consider UK registration 2406234. The other earlier marks put SHG in no better position. Although the earlier mark is registered in a number of classes, the most relevant class is class 25, for which the earlier mark is registered in respect of:

Bathrobes; bath slippers; shower caps; clothing; head gear; tee-shirts.

3) As part of its statement of case SHG claims that:

"The most distinctive element of the registered proprietor's mark is "SHANTI" which is the applicant's registered trade mark. Therefore, there is a clear likelihood of confusion and association between the marks. The registered proprietor's goods in class 25 clearly overlap with those of the applicant."

4) Ms Williamson filed a counterstatement denying the grounds of invalidation. Ms Williamson claims that the word SHANTI is generic. She also highlights the differences in typeface and logos, and she says that SHANTI LIFE will not be used separately. Further information provided with the counterstatement highlights that Ms Williamson is targeting the ethical/environmental market. She explains that there are many companies using the word SHANTI. The word is said to be a Sanskrit word for "PEACE" and that she uses such a word in her practice as a yoga teacher. She says that she is also targeting the yoga market. She is not aware of SHG's reputation and could not find its products.

5) Only SHG filed evidence⁵, but as it consists, essentially, of submissions rather than evidence of fact, I will bear it in mind but will not summarise it here. The matter then came to be heard before me on 26 November 2010. At the hearing SHG were represented by Ms Denise McFarland, of Counsel, instructed by Penningtons Solicitors. Ms Williamson was represented by Mr James Setchell of Trade Mark Consultants Co.

⁴ See section 6A of the Act, which was added to the Act by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

⁵ The evidence was given by Ms Fink of Penningtons Solicitors.

Section 5(2)(b) of the Act

6) This section reads:

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

(a)

(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.”

7) In reaching my decision I have taken into account the guidance provided by the European Court of Justice (“ECJ”) in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 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* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).

8) The existence of a likelihood of confusion must be appreciated globally, taking into account all relevant factors (*Sabel BV v Puma AG*). As well as assessing whether the respective marks and the respective goods are similar, other factors are relevant including:

The nature of the average consumer of the goods in question and the nature of his or her purchasing act. This is relevant because it is through such a person’s eyes that matters must be judged (*Sabel BV v Puma AG*);

That the average consumer rarely has the chance to make direct comparisons between trade marks and must, instead, rely upon the imperfect picture of them he or she has kept in mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*) This is often referred to as the concept of “imperfect recollection”;

That the degree of distinctiveness of the earlier trade mark (due either to its inherent qualities or through the use made of it) is an important factor because confusion is more likely the more distinctive the earlier trade mark is (*Sabel BV v Puma AG*);

That there is interdependency between the various factors, for example, a lesser degree of similarity between the marks may be offset by a greater

degree of similarity between the respective goods, and vice versa (*Canon Kabushiki Kaisha v Metro- Goldwyn-Mayer Inc*).


9) In terms of the goods, I consider them to be identical. The earlier mark covers clothing at large and is therefore identical to the term clothing appearing in Ms Williamson's registration. Ms Williamson's registration also covers footwear. As clothing consists of anything to clothe the body, I consider footwear to be clothing and, so, the goods fall within the ambit of the term clothing appearing in SHG's earlier registration. Even if I am wrong on this, the earlier mark also covers bath slippers which are a type of footwear. This means that the term footwear in Ms Williamson's registration includes within its ambit identical goods (bath slippers are a type of footwear). Even though the term footwear covers more than bath slippers, no fall back specification has been provided so a finding of identity is all that can be made⁶.

10) Clothing is bought by the public at large. The average consumer is, therefore, a member of the general public. The case-law informs me that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting goods can, however, vary depending on the particular goods in question (see, for example, the judgment of the GC in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)). In my view, clothing will be purchased with a reasonable degree of care and attention. The average consumer may try the goods on and is likely to inspect them for colour, size, style etc. All of this increases the potential exposure to the trade mark. That being said, the purchase is unlikely to be a highly considered process as clothing is purchased relatively frequently and although cost can vary, it is, generally speaking, not a highly expensive purchase.

11) Although aural similarity will not be ignored completely from my analysis, I am conscious that the visual impression of the trade marks is likely to take on more significance as the purchase of clothing is normally a visual act⁷. In terms of the marks themselves, they are, for ease of reference, replicated in the table below:

⁶ See *Gérard Meric v OHIM* (Case T-133/05), a judgment of the General Court ("GC").

⁷ See *Société provençale d'achat and de gestion (SPAG) SA v (OHIM)* Case T-57/03 and *React Trade Mark* [2000] RPC 285.

Ms Williamson's mark	SHG's mark
	<p data-bbox="810 376 1021 425">SHANTI</p>

12) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account any distinctive and dominant components. Mr Setchell was keen to stress the whole mark comparison that must be made, he felt that SHG were attempting to discount from the analysis the additional content of Ms Williamson's mark. Ms McFarland, on the other hand, highlighted what she considered to be the dominance of the word SHANTI in Ms Williamson's mark and that the other matter in it was subservient, with LIFE being a known descriptor unlikely to be given independent distinctive meaning.

13) In terms of distinctive and dominant components, SHG's trade mark does not separate into distinctive and dominant components. It will be seen as a single word and it is, therefore, its only constituent part. In terms of its concept, although I note Ms Williamson's explanation that SHANTI is the Sanskrit word for "peace", I consider it unlikely that the average consumer of clothing in the UK will know of this⁸. There is no evidence suggesting that the meaning put forward will be known. Furthermore, there is no evidence that even consumers who practice yoga (this is a group Ms Williamson intends to target) will know of the word. The same can be said for the alternative suggestion given by Mr Setchell at the hearing to the effect that the word may be seen as a reference to Shanty towns. Whilst I am aware of this word, it does not strike me as a common word, the knowledge and meaning of which I can accept as a notorious fact. Given all this, SHG's mark will be seen as an invented word.

14) Ms Williamson's mark consists of: i) the word SHANTI (in a particular form of script), ii) the word LIFE (in the same script), and iii) a swirled circular device. Whilst the words SHANTI and LIFE may appear to "hang together" to form a word combination, they do not do so in any real meaningful way given that SHANTI (as I have found with SGH's mark) will be seen as an invented word. I

⁸ In the *Chorkee case* (BL O-048-08), Anna Carboni, sitting as the Appointed Person, cautioned against accepting too readily the degree of knowledge that the average consumer may possess.

consider the word SHANTI to be the dominant and distinctive element on account of its position, that it is longer than the word LIFE, and that it is a much more distinctive and unusual word than LIFE. The word LIFE, and its construction into SHANTI LIFE, is not, though, to be ignored, neither is the device element which will play a part in the visual impression of the mark – it is only possible to make the comparison solely on the basis of the dominant and distinctive element if the other elements of the mark are negligible within its overall impression⁹ – they are certainly not that.

15) Any similarity resides in the presence of the word SHANTI in Ms Williamson's mark which is the entirety of SHG's mark. Considering the construction of the respective marks and the dominant and distinctive elements in them, there is a degree of similarity from both a visual and aural perspective. There is, though, a difference due to the addition of the word LIFE in Ms Williamson's mark (which impacts on both visual and aural similarity) and also the device element and stylisation (which impacts on visual similarity). Weighing all these considerations, I consider there to be a reasonable degree (neither high nor low) of visual similarity with a slightly higher degree of aural similarity.

16) In terms of concept, for a conceptual meaning to be relevant it must be one capable of immediate grasp¹⁰. I have already stated that SHANTI will be seen as an invented word and that SHANTI LIFE does not create a meaningful whole. On the basis of this there is neither conceptual similarity nor a conceptual difference.

17) The degree of distinctiveness of the earlier mark is another important factor to consider. This is because the more distinctive the earlier mark (based either on its inherent qualities or because of the use made of it), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). There is no evidence showing what use (if any) the earlier mark has been put to, so, I have only its inherent qualities to consider. From that perspective, I have already said that the earlier mark will be seen by the average consumer in the UK as an invented word. It has no suggestive or evocative qualities relating to clothing. I consider that the mark has a high degree of distinctive character. I note that in her counterstatement Ms Williamson said that lots of other traders use the word SHANTI. This, potentially, could mean that the average consumer may see the word as being less distinctive because it is a word commonly used. However, there is no evidence of any other SHANTI mark in use so the point is unsupported and academic.

⁹ See *Shaker di L. Laudato & Co. Sas*.

¹⁰ This is highlighted in numerous judgments of the GC and the ECJ including *Ruiz Picasso v OHIM* [2006] e.c.r. –I-643; [2006] E.T.M.R. 29.

Conclusions

18) It is clear that the factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17) and that a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

19) Ms Williamson highlighted in her counterstatement that her goods are marketed to the ethical/environmental market and for clothing for taking part in yoga. This, though, has no relevance because there is nothing to stop SHG from marketing its goods in exactly the same way. In any event, marketing strategies are temporal and could change with time. I must consider the respective marks used on a notional basis in relation to articles of clothing.

20) In terms of the relevant factors, the goods are identical and the marks reasonably similar. The earlier mark is also high in inherent distinctive character. However, an average consumer will pay a reasonable degree of care and attention to the goods that they are choosing and, so, they may be able to differentiate between the two marks given their differences. Whilst this is a possibility, the reasonable degree of similarity, a similarity based on what I regard as the dominant and distinctive element in Ms Williamson's mark, is, in my view, likely to result in confusion. This is particularly so when one bears in mind the concept of imperfect recollection (because consumers rarely see marks side by side), the most memorable aspect of Ms Williamson's mark, and the aspect most likely to be recalled, being the dominant and distinctive word SHANTI. I have not ignored Mr Setchell's call to consider the marks in their totalities. The case-law relating to comparisons involving composite or complex marks clearly calls for such an approach (see, for example, *Medion v Thomson Multimedia* [2006] ETMR 13 and Case C-3/03 P *Matratzen Concord v OHIM* [2004] ECR I-3657) as does the case-law in general (*Sabel BV v. Puma AG*), however, considering the marks in totalities, but bearing in mind their dominant and distinctive elements as assessed, together with all the other relevant factors, confusion is still likely.

21) Even if I am wrong on this and the average consumer notices and recalls that one mark is SHANTI LIFE (and that it has logo and stylization) and the other is just the word SHANTI, then I fully agree with Ms McFarland's view that this will be put down by the average consumer to there being an economic connection between the undertakings responsible for the marks, i.e. that the marks and the goods being sold under them come from the same or a linked company¹¹. The application for invalidation succeeds.

¹¹ This is a relevant form of confusion – see *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*.

22) I should add that even if I am found to be wrong on my assessment of the conceptual meanings underpinning the marks and that the word SHANTI (be it on its own or as part of the SHANTI LIFE mark) has meaning, then such meaning will still not relate to the word peace. Any meaning will, in my view, relate to a Shanty town or, even, to a sea shanty (a rhythmic song traditionally sung by sailors). If this were the case then it is my view that confusion is still likely. I say this because the earlier mark would still be high in distinctive character, if there is meaning then the same meaning (of the word SHANTI) is likely to be shared between the two marks so introducing an element of conceptual similarity, all of which will result in the marks still being assumed to be the responsibility of the same or a related undertaking.

23) The ground under section 5(2)(b) having been successful and, in accordance with section 47(6) of the Act, I hereby declare Ms Williamson's registration in class 25 to be invalid and the registration deemed never to have been made to that extent.

Costs

24) SHG has been successful and is entitled to a contribution towards its costs¹². I hereby order Ms Kim Williamson to pay Shanti Hospitality Group Limited the sum of £1000. This sum is calculated as follows:

Preparing a statement and considering the other side's statement - £300

Expenses (opposition fee) - £200

Attending the hearing - £500

25) I have not awarded any costs in relation to SHG's "evidence" as it contained no real factual evidence.

26) The above sum should 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 14 day of December 2010

**Oliver Morris
For the Registrar,
The Comptroller-General**

¹² Costs are normally awarded on the basis of the registrar's published scale in Tribunal Practice Notice 4/2007.

O-431-10

TRADE MARKS ACT 1994

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IN THE NAME OF KIM WILLIAMSON
IN RESPECT OF THE TRADE MARK**



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The background and the pleadings

1) The registered trade mark the subject of these proceedings stands in the name of Ms Kim Williamson. She applied for the trade mark on 2 December 2008 and it completed its registration procedure on 15 May 2009. The trade mark and the goods for which it is registered are shown below:



Class 03: soaps, perfumes, essential oils, cosmetics, hair lotions.

Class 04: candles

Class 25: clothing, footwear

2) On 10 July 2009 Shanti Hospitality Group Limited¹ (“SHG”) applied for a declaration of invalidity in respect of Ms Williamson’s registration. Invalidity is sought only in relation to the goods covered by class 25 of the registration. Although there was initially another ground of invalidation², by the time of the hearing that took place before me, the only ground to be determined was under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). Under this ground SHG rely on three trade marks³ of which it is the proprietor. None of the earlier marks

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are subject to the requirement to prove that they have been used as they were registered within (not before) the five year period prior to the publication of Ms Williamson's registration⁴. Given the nature of the earlier marks and the goods that they cover, I need only consider UK registration 2406234. The other earlier marks put SHG in no better position. Although the earlier mark is registered in a number of classes, the most relevant class is class 25, for which the earlier mark is registered in respect of:

Bathrobes; bath slippers; shower caps; clothing; head gear; tee-shirts.

3) As part of its statement of case SHG claims that:

"The most distinctive element of the registered proprietor's mark is "SHANTI" which is the applicant's registered trade mark. Therefore, there is a clear likelihood of confusion and association between the marks. The registered proprietor's goods in class 25 clearly overlap with those of the applicant."

4) Ms Williamson filed a counterstatement denying the grounds of invalidation. Ms Williamson claims that the word SHANTI is generic. She also highlights the differences in typeface and logos, and she says that SHANTI LIFE will not be used separately. Further information provided with the counterstatement highlights that Ms Williamson is targeting the ethical/environmental market. She explains that there are many companies using the word SHANTI. The word is said to be a Sanskrit word for "PEACE" and that she uses such a word in her practice as a yoga teacher. She says that she is also targeting the yoga market. She is not aware of SHG's reputation and could not find its products.

5) Only SHG filed evidence⁵, but as it consists, essentially, of submissions rather than evidence of fact, I will bear it in mind but will not summarise it here. The matter then came to be heard before me on 26 November 2010. At the hearing SHG were represented by Ms Denise McFarland, of Counsel, instructed by Penningtons Solicitors. Ms Williamson was represented by Mr James Setchell of Trade Mark Consultants Co.

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Section 5(2)(b) of the Act

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

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(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.”

7) In reaching my decision I have taken into account the guidance provided by the European Court of Justice (“ECJ”) in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 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* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).

8) The existence of a likelihood of confusion must be appreciated globally, taking into account all relevant factors (*Sabel BV v Puma AG*). As well as assessing whether the respective marks and the respective goods are similar, other factors are relevant including:

The nature of the average consumer of the goods in question and the nature of his or her purchasing act. This is relevant because it is through such a person’s eyes that matters must be judged (*Sabel BV v Puma AG*);

That the average consumer rarely has the chance to make direct comparisons between trade marks and must, instead, rely upon the imperfect picture of them he or she has kept in mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*) This is often referred to as the concept of “imperfect recollection”;

That the degree of distinctiveness of the earlier trade mark (due either to its inherent qualities or through the use made of it) is an important factor because confusion is more likely the more distinctive the earlier trade mark is (*Sabel BV v Puma AG*);

That there is interdependency between the various factors, for example, a lesser degree of similarity between the marks may be offset by a greater

degree of similarity between the respective goods, and vice versa (*Canon Kabushiki Kaisha v Metro- Goldwyn-Mayer Inc*).


9) In terms of the goods, I consider them to be identical. The earlier mark covers clothing at large and is therefore identical to the term clothing appearing in Ms Williamson's registration. Ms Williamson's registration also covers footwear. As clothing consists of anything to clothe the body, I consider footwear to be clothing and, so, the goods fall within the ambit of the term clothing appearing in SHG's earlier registration. Even if I am wrong on this, the earlier mark also covers bath slippers which are a type of footwear. This means that the term footwear in Ms Williamson's registration includes within its ambit identical goods (bath slippers are a type of footwear). Even though the term footwear covers more than bath slippers, no fall back specification has been provided so a finding of identity is all that can be made⁶.

10) Clothing is bought by the public at large. The average consumer is, therefore, a member of the general public. The case-law informs me that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting goods can, however, vary depending on the particular goods in question (see, for example, the judgment of the GC in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)). In my view, clothing will be purchased with a reasonable degree of care and attention. The average consumer may try the goods on and is likely to inspect them for colour, size, style etc. All of this increases the potential exposure to the trade mark. That being said, the purchase is unlikely to be a highly considered process as clothing is purchased relatively frequently and although cost can vary, it is, generally speaking, not a highly expensive purchase.

11) Although aural similarity will not be ignored completely from my analysis, I am conscious that the visual impression of the trade marks is likely to take on more significance as the purchase of clothing is normally a visual act⁷. In terms of the marks themselves, they are, for ease of reference, replicated in the table below:

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Ms Williamson's mark	SHG's mark
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12) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account any distinctive and dominant components. Mr Setchell was keen to stress the whole mark comparison that must be made, he felt that SHG were attempting to discount from the analysis the additional content of Ms Williamson's mark. Ms McFarland, on the other hand, highlighted what she considered to be the dominance of the word SHANTI in Ms Williamson's mark and that the other matter in it was subservient, with LIFE being a known descriptor unlikely to be given independent distinctive meaning.

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14) Ms Williamson's mark consists of: i) the word SHANTI (in a particular form of script), ii) the word LIFE (in the same script), and iii) a swirled circular device. Whilst the words SHANTI and LIFE may appear to "hang together" to form a word combination, they do not do so in any real meaningful way given that SHANTI (as I have found with SGH's mark) will be seen as an invented word. I

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15) Any similarity resides in the presence of the word SHANTI in Ms Williamson's mark which is the entirety of SHG's mark. Considering the construction of the respective marks and the dominant and distinctive elements in them, there is a degree of similarity from both a visual and aural perspective. There is, though, a difference due to the addition of the word LIFE in Ms Williamson's mark (which impacts on both visual and aural similarity) and also the device element and stylisation (which impacts on visual similarity). Weighing all these considerations, I consider there to be a reasonable degree (neither high nor low) of visual similarity with a slightly higher degree of aural similarity.

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17) The degree of distinctiveness of the earlier mark is another important factor to consider. This is because the more distinctive the earlier mark (based either on its inherent qualities or because of the use made of it), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). There is no evidence showing what use (if any) the earlier mark has been put to, so, I have only its inherent qualities to consider. From that perspective, I have already said that the earlier mark will be seen by the average consumer in the UK as an invented word. It has no suggestive or evocative qualities relating to clothing. I consider that the mark has a high degree of distinctive character. I note that in her counterstatement Ms Williamson said that lots of other traders use the word SHANTI. This, potentially, could mean that the average consumer may see the word as being less distinctive because it is a word commonly used. However, there is no evidence of any other SHANTI mark in use so the point is unsupported and academic.

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Conclusions

18) It is clear that the factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17) and that a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

19) Ms Williamson highlighted in her counterstatement that her goods are marketed to the ethical/environmental market and for clothing for taking part in yoga. This, though, has no relevance because there is nothing to stop SHG from marketing its goods in exactly the same way. In any event, marketing strategies are temporal and could change with time. I must consider the respective marks used on a notional basis in relation to articles of clothing.

20) In terms of the relevant factors, the goods are identical and the marks reasonably similar. The earlier mark is also high in inherent distinctive character. However, an average consumer will pay a reasonable degree of care and attention to the goods that they are choosing and, so, they may be able to differentiate between the two marks given their differences. Whilst this is a possibility, the reasonable degree of similarity, a similarity based on what I regard as the dominant and distinctive element in Ms Williamson's mark, is, in my view, likely to result in confusion. This is particularly so when one bears in mind the concept of imperfect recollection (because consumers rarely see marks side by side), the most memorable aspect of Ms Williamson's mark, and the aspect most likely to be recalled, being the dominant and distinctive word SHANTI. I have not ignored Mr Setchell's call to consider the marks in their totalities. The case-law relating to comparisons involving composite or complex marks clearly calls for such an approach (see, for example, *Medion v Thomson Multimedia* [2006] ETMR 13 and Case C-3/03 P *Matratzen Concord v OHIM* [2004] ECR I-3657) as does the case-law in general (*Sabel BV v. Puma AG*), however, considering the marks in totalities, but bearing in mind their dominant and distinctive elements as assessed, together with all the other relevant factors, confusion is still likely.

21) Even if I am wrong on this and the average consumer notices and recalls that one mark is SHANTI LIFE (and that it has logo and stylization) and the other is just the word SHANTI, then I fully agree with Ms McFarland's view that this will be put down by the average consumer to there being an economic connection between the undertakings responsible for the marks, i.e. that the marks and the goods being sold under them come from the same or a linked company¹¹. The application for invalidation succeeds.

¹¹ This is a relevant form of confusion – see *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*.

22) I should add that even if I am found to be wrong on my assessment of the conceptual meanings underpinning the marks and that the word SHANTI (be it on its own or as part of the SHANTI LIFE mark) has meaning, then such meaning will still not relate to the word peace. Any meaning will, in my view, relate to a Shanty town or, even, to a sea shanty (a rhythmic song traditionally sung by sailors). If this were the case then it is my view that confusion is still likely. I say this because the earlier mark would still be high in distinctive character, if there is meaning then the same meaning (of the word SHANTI) is likely to be shared between the two marks so introducing an element of conceptual similarity, all of which will result in the marks still being assumed to be the responsibility of the same or a related undertaking.

23) The ground under section 5(2)(b) having been successful and, in accordance with section 47(6) of the Act, I hereby declare Ms Williamson's registration in class 25 to be invalid and the registration deemed never to have been made to that extent.

Costs

24) SHG has been successful and is entitled to a contribution towards its costs¹². I hereby order Ms Kim Williamson to pay Shanti Hospitality Group Limited the sum of £1000. This sum is calculated as follows:

Preparing a statement and considering the other side's statement - £300

Expenses (opposition fee) - £200

Attending the hearing - £500

25) I have not awarded any costs in relation to SHG's "evidence" as it contained no real factual evidence.

26) The above sum should 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 14 day of December 2010

**Oliver Morris
For the Registrar,
The Comptroller-General**

¹² Costs are normally awarded on the basis of the registrar's published scale in Tribunal Practice Notice 4/2007.

O-431-10

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK REGISTRATION 2503898
IN THE NAME OF KIM WILLIAMSON
IN RESPECT OF THE TRADE MARK**



AND

**AN APPLICATION (NO 83534) FOR INVALIDATION BY
SHANTI HOSPITALITY GROUP LIMITED**

TRADE MARKS ACT 1994

In the matter of registration 2503898 in the name of Kim Williamson

and

An application (no 83534) for invalidation by Shanti Hospitality Group Limited

The background and the pleadings

1) The registered trade mark the subject of these proceedings stands in the name of Ms Kim Williamson. She applied for the trade mark on 2 December 2008 and it completed its registration procedure on 15 May 2009. The trade mark and the goods for which it is registered are shown below:



Class 03: soaps, perfumes, essential oils, cosmetics, hair lotions.

Class 04: candles

Class 25: clothing, footwear

2) On 10 July 2009 Shanti Hospitality Group Limited¹ (“SHG”) applied for a declaration of invalidity in respect of Ms Williamson’s registration. Invalidity is sought only in relation to the goods covered by class 25 of the registration. Although there was initially another ground of invalidation², by the time of the hearing that took place before me, the only ground to be determined was under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). Under this ground SHG rely on three trade marks³ of which it is the proprietor. None of the earlier marks

¹ This company was called C & C Hospitality Limited at the time of making its application – it changed its name to SHG on 27 May 2010.

² Section 5(3), but this was deemed withdrawn due to no evidence being filed in support of the ground (see rule 42(4) of the Trade Mark Rules 2008).

³ UK registration 2406234, UK registration 2406233 & Community trade mark (“CTM”) registration 473374.

are subject to the requirement to prove that they have been used as they were registered within (not before) the five year period prior to the publication of Ms Williamson's registration⁴. Given the nature of the earlier marks and the goods that they cover, I need only consider UK registration 2406234. The other earlier marks put SHG in no better position. Although the earlier mark is registered in a number of classes, the most relevant class is class 25, for which the earlier mark is registered in respect of:

Bathrobes; bath slippers; shower caps; clothing; head gear; tee-shirts.

3) As part of its statement of case SHG claims that:

"The most distinctive element of the registered proprietor's mark is "SHANTI" which is the applicant's registered trade mark. Therefore, there is a clear likelihood of confusion and association between the marks. The registered proprietor's goods in class 25 clearly overlap with those of the applicant."

4) Ms Williamson filed a counterstatement denying the grounds of invalidation. Ms Williamson claims that the word SHANTI is generic. She also highlights the differences in typeface and logos, and she says that SHANTI LIFE will not be used separately. Further information provided with the counterstatement highlights that Ms Williamson is targeting the ethical/environmental market. She explains that there are many companies using the word SHANTI. The word is said to be a Sanskrit word for "PEACE" and that she uses such a word in her practice as a yoga teacher. She says that she is also targeting the yoga market. She is not aware of SHG's reputation and could not find its products.

5) Only SHG filed evidence⁵, but as it consists, essentially, of submissions rather than evidence of fact, I will bear it in mind but will not summarise it here. The matter then came to be heard before me on 26 November 2010. At the hearing SHG were represented by Ms Denise McFarland, of Counsel, instructed by Penningtons Solicitors. Ms Williamson was represented by Mr James Setchell of Trade Mark Consultants Co.

⁴ See section 6A of the Act, which was added to the Act by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

⁵ The evidence was given by Ms Fink of Penningtons Solicitors.

Section 5(2)(b) of the Act

6) This section reads:

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

(a)

(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.”

7) In reaching my decision I have taken into account the guidance provided by the European Court of Justice (“ECJ”) in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 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* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).

8) The existence of a likelihood of confusion must be appreciated globally, taking into account all relevant factors (*Sabel BV v Puma AG*). As well as assessing whether the respective marks and the respective goods are similar, other factors are relevant including:

The nature of the average consumer of the goods in question and the nature of his or her purchasing act. This is relevant because it is through such a person’s eyes that matters must be judged (*Sabel BV v Puma AG*);

That the average consumer rarely has the chance to make direct comparisons between trade marks and must, instead, rely upon the imperfect picture of them he or she has kept in mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*) This is often referred to as the concept of “imperfect recollection”;

That the degree of distinctiveness of the earlier trade mark (due either to its inherent qualities or through the use made of it) is an important factor because confusion is more likely the more distinctive the earlier trade mark is (*Sabel BV v Puma AG*);

That there is interdependency between the various factors, for example, a lesser degree of similarity between the marks may be offset by a greater

degree of similarity between the respective goods, and vice versa (*Canon Kabushiki Kaisha v Metro- Goldwyn-Mayer Inc*).


9) In terms of the goods, I consider them to be identical. The earlier mark covers clothing at large and is therefore identical to the term clothing appearing in Ms Williamson's registration. Ms Williamson's registration also covers footwear. As clothing consists of anything to clothe the body, I consider footwear to be clothing and, so, the goods fall within the ambit of the term clothing appearing in SHG's earlier registration. Even if I am wrong on this, the earlier mark also covers bath slippers which are a type of footwear. This means that the term footwear in Ms Williamson's registration includes within its ambit identical goods (bath slippers are a type of footwear). Even though the term footwear covers more than bath slippers, no fall back specification has been provided so a finding of identity is all that can be made⁶.

10) Clothing is bought by the public at large. The average consumer is, therefore, a member of the general public. The case-law informs me that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting goods can, however, vary depending on the particular goods in question (see, for example, the judgment of the GC in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)). In my view, clothing will be purchased with a reasonable degree of care and attention. The average consumer may try the goods on and is likely to inspect them for colour, size, style etc. All of this increases the potential exposure to the trade mark. That being said, the purchase is unlikely to be a highly considered process as clothing is purchased relatively frequently and although cost can vary, it is, generally speaking, not a highly expensive purchase.

11) Although aural similarity will not be ignored completely from my analysis, I am conscious that the visual impression of the trade marks is likely to take on more significance as the purchase of clothing is normally a visual act⁷. In terms of the marks themselves, they are, for ease of reference, replicated in the table below:

⁶ See *Gérard Meric v OHIM* (Case T-133/05), a judgment of the General Court ("GC").

⁷ See *Société provençale d'achat and de gestion (SPAG) SA v (OHIM)* Case T-57/03 and *React Trade Mark* [2000] RPC 285.

Ms Williamson's mark	SHG's mark
	<p data-bbox="810 376 1021 425">SHANTI</p>

12) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account any distinctive and dominant components. Mr Setchell was keen to stress the whole mark comparison that must be made, he felt that SHG were attempting to discount from the analysis the additional content of Ms Williamson's mark. Ms McFarland, on the other hand, highlighted what she considered to be the dominance of the word SHANTI in Ms Williamson's mark and that the other matter in it was subservient, with LIFE being a known descriptor unlikely to be given independent distinctive meaning.

13) In terms of distinctive and dominant components, SHG's trade mark does not separate into distinctive and dominant components. It will be seen as a single word and it is, therefore, its only constituent part. In terms of its concept, although I note Ms Williamson's explanation that SHANTI is the Sanskrit word for "peace", I consider it unlikely that the average consumer of clothing in the UK will know of this⁸. There is no evidence suggesting that the meaning put forward will be known. Furthermore, there is no evidence that even consumers who practice yoga (this is a group Ms Williamson intends to target) will know of the word. The same can be said for the alternative suggestion given by Mr Setchell at the hearing to the effect that the word may be seen as a reference to Shanty towns. Whilst I am aware of this word, it does not strike me as a common word, the knowledge and meaning of which I can accept as a notorious fact. Given all this, SHG's mark will be seen as an invented word.

14) Ms Williamson's mark consists of: i) the word SHANTI (in a particular form of script), ii) the word LIFE (in the same script), and iii) a swirled circular device. Whilst the words SHANTI and LIFE may appear to "hang together" to form a word combination, they do not do so in any real meaningful way given that SHANTI (as I have found with SGH's mark) will be seen as an invented word. I

⁸ In the *Chorkee case* (BL O-048-08), Anna Carboni, sitting as the Appointed Person, cautioned against accepting too readily the degree of knowledge that the average consumer may possess.

consider the word SHANTI to be the dominant and distinctive element on account of its position, that it is longer than the word LIFE, and that it is a much more distinctive and unusual word than LIFE. The word LIFE, and its construction into SHANTI LIFE, is not, though, to be ignored, neither is the device element which will play a part in the visual impression of the mark – it is only possible to make the comparison solely on the basis of the dominant and distinctive element if the other elements of the mark are negligible within its overall impression⁹ – they are certainly not that.

15) Any similarity resides in the presence of the word SHANTI in Ms Williamson's mark which is the entirety of SHG's mark. Considering the construction of the respective marks and the dominant and distinctive elements in them, there is a degree of similarity from both a visual and aural perspective. There is, though, a difference due to the addition of the word LIFE in Ms Williamson's mark (which impacts on both visual and aural similarity) and also the device element and stylisation (which impacts on visual similarity). Weighing all these considerations, I consider there to be a reasonable degree (neither high nor low) of visual similarity with a slightly higher degree of aural similarity.

16) In terms of concept, for a conceptual meaning to be relevant it must be one capable of immediate grasp¹⁰. I have already stated that SHANTI will be seen as an invented word and that SHANTI LIFE does not create a meaningful whole. On the basis of this there is neither conceptual similarity nor a conceptual difference.

17) The degree of distinctiveness of the earlier mark is another important factor to consider. This is because the more distinctive the earlier mark (based either on its inherent qualities or because of the use made of it), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). There is no evidence showing what use (if any) the earlier mark has been put to, so, I have only its inherent qualities to consider. From that perspective, I have already said that the earlier mark will be seen by the average consumer in the UK as an invented word. It has no suggestive or evocative qualities relating to clothing. I consider that the mark has a high degree of distinctive character. I note that in her counterstatement Ms Williamson said that lots of other traders use the word SHANTI. This, potentially, could mean that the average consumer may see the word as being less distinctive because it is a word commonly used. However, there is no evidence of any other SHANTI mark in use so the point is unsupported and academic.

⁹ See *Shaker di L. Laudato & Co. Sas.*

¹⁰ This is highlighted in numerous judgments of the GC and the ECJ including *Ruiz Picasso v OHIM* [2006] e.c.r. –I-643; [2006] E.T.M.R. 29.

Conclusions

18) It is clear that the factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17) and that a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

19) Ms Williamson highlighted in her counterstatement that her goods are marketed to the ethical/environmental market and for clothing for taking part in yoga. This, though, has no relevance because there is nothing to stop SHG from marketing its goods in exactly the same way. In any event, marketing strategies are temporal and could change with time. I must consider the respective marks used on a notional basis in relation to articles of clothing.

20) In terms of the relevant factors, the goods are identical and the marks reasonably similar. The earlier mark is also high in inherent distinctive character. However, an average consumer will pay a reasonable degree of care and attention to the goods that they are choosing and, so, they may be able to differentiate between the two marks given their differences. Whilst this is a possibility, the reasonable degree of similarity, a similarity based on what I regard as the dominant and distinctive element in Ms Williamson's mark, is, in my view, likely to result in confusion. This is particularly so when one bears in mind the concept of imperfect recollection (because consumers rarely see marks side by side), the most memorable aspect of Ms Williamson's mark, and the aspect most likely to be recalled, being the dominant and distinctive word SHANTI. I have not ignored Mr Setchell's call to consider the marks in their totalities. The case-law relating to comparisons involving composite or complex marks clearly calls for such an approach (see, for example, *Medion v Thomson Multimedia* [2006] ETMR 13 and Case C-3/03 P *Matratzen Concord v OHIM* [2004] ECR I-3657) as does the case-law in general (*Sabel BV v. Puma AG*), however, considering the marks in totalities, but bearing in mind their dominant and distinctive elements as assessed, together with all the other relevant factors, confusion is still likely.

21) Even if I am wrong on this and the average consumer notices and recalls that one mark is SHANTI LIFE (and that it has logo and stylization) and the other is just the word SHANTI, then I fully agree with Ms McFarland's view that this will be put down by the average consumer to there being an economic connection between the undertakings responsible for the marks, i.e. that the marks and the goods being sold under them come from the same or a linked company¹¹. The application for invalidation succeeds.

¹¹ This is a relevant form of confusion – see *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*.

22) I should add that even if I am found to be wrong on my assessment of the conceptual meanings underpinning the marks and that the word SHANTI (be it on its own or as part of the SHANTI LIFE mark) has meaning, then such meaning will still not relate to the word peace. Any meaning will, in my view, relate to a Shanty town or, even, to a sea shanty (a rhythmic song traditionally sung by sailors). If this were the case then it is my view that confusion is still likely. I say this because the earlier mark would still be high in distinctive character, if there is meaning then the same meaning (of the word SHANTI) is likely to be shared between the two marks so introducing an element of conceptual similarity, all of which will result in the marks still being assumed to be the responsibility of the same or a related undertaking.

23) The ground under section 5(2)(b) having been successful and, in accordance with section 47(6) of the Act, I hereby declare Ms Williamson's registration in class 25 to be invalid and the registration deemed never to have been made to that extent.

Costs

24) SHG has been successful and is entitled to a contribution towards its costs¹². I hereby order Ms Kim Williamson to pay Shanti Hospitality Group Limited the sum of £1000. This sum is calculated as follows:

Preparing a statement and considering the other side's statement - £300

Expenses (opposition fee) - £200

Attending the hearing - £500

25) I have not awarded any costs in relation to SHG's "evidence" as it contained no real factual evidence.

26) The above sum should 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 14 day of December 2010

**Oliver Morris
For the Registrar,
The Comptroller-General**

¹² Costs are normally awarded on the basis of the registrar's published scale in Tribunal Practice Notice 4/2007.

O-431-10

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK REGISTRATION 2503898
IN THE NAME OF KIM WILLIAMSON
IN RESPECT OF THE TRADE MARK**



AND

**AN APPLICATION (NO 83534) FOR INVALIDATION BY
SHANTI HOSPITALITY GROUP LIMITED**

TRADE MARKS ACT 1994

In the matter of registration 2503898 in the name of Kim Williamson

and

An application (no 83534) for invalidation by Shanti Hospitality Group Limited

The background and the pleadings

1) The registered trade mark the subject of these proceedings stands in the name of Ms Kim Williamson. She applied for the trade mark on 2 December 2008 and it completed its registration procedure on 15 May 2009. The trade mark and the goods for which it is registered are shown below:



Class 03: soaps, perfumes, essential oils, cosmetics, hair lotions.

Class 04: candles

Class 25: clothing, footwear

2) On 10 July 2009 Shanti Hospitality Group Limited¹ (“SHG”) applied for a declaration of invalidity in respect of Ms Williamson’s registration. Invalidity is sought only in relation to the goods covered by class 25 of the registration. Although there was initially another ground of invalidation², by the time of the hearing that took place before me, the only ground to be determined was under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). Under this ground SHG rely on three trade marks³ of which it is the proprietor. None of the earlier marks

¹ This company was called C & C Hospitality Limited at the time of making its application – it changed its name to SHG on 27 May 2010.

² Section 5(3), but this was deemed withdrawn due to no evidence being filed in support of the ground (see rule 42(4) of the Trade Mark Rules 2008).

³ UK registration 2406234, UK registration 2406233 & Community trade mark (“CTM”) registration 473374.

are subject to the requirement to prove that they have been used as they were registered within (not before) the five year period prior to the publication of Ms Williamson's registration⁴. Given the nature of the earlier marks and the goods that they cover, I need only consider UK registration 2406234. The other earlier marks put SHG in no better position. Although the earlier mark is registered in a number of classes, the most relevant class is class 25, for which the earlier mark is registered in respect of:

Bathrobes; bath slippers; shower caps; clothing; head gear; tee-shirts.

3) As part of its statement of case SHG claims that:

"The most distinctive element of the registered proprietor's mark is "SHANTI" which is the applicant's registered trade mark. Therefore, there is a clear likelihood of confusion and association between the marks. The registered proprietor's goods in class 25 clearly overlap with those of the applicant."

4) Ms Williamson filed a counterstatement denying the grounds of invalidation. Ms Williamson claims that the word SHANTI is generic. She also highlights the differences in typeface and logos, and she says that SHANTI LIFE will not be used separately. Further information provided with the counterstatement highlights that Ms Williamson is targeting the ethical/environmental market. She explains that there are many companies using the word SHANTI. The word is said to be a Sanskrit word for "PEACE" and that she uses such a word in her practice as a yoga teacher. She says that she is also targeting the yoga market. She is not aware of SHG's reputation and could not find its products.

5) Only SHG filed evidence⁵, but as it consists, essentially, of submissions rather than evidence of fact, I will bear it in mind but will not summarise it here. The matter then came to be heard before me on 26 November 2010. At the hearing SHG were represented by Ms Denise McFarland, of Counsel, instructed by Penningtons Solicitors. Ms Williamson was represented by Mr James Setchell of Trade Mark Consultants Co.

⁴ See section 6A of the Act, which was added to the Act by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

⁵ The evidence was given by Ms Fink of Penningtons Solicitors.

Section 5(2)(b) of the Act

6) This section reads:

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

(a)

(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.”

7) In reaching my decision I have taken into account the guidance provided by the European Court of Justice (“ECJ”) in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 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* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).

8) The existence of a likelihood of confusion must be appreciated globally, taking into account all relevant factors (*Sabel BV v Puma AG*). As well as assessing whether the respective marks and the respective goods are similar, other factors are relevant including:

The nature of the average consumer of the goods in question and the nature of his or her purchasing act. This is relevant because it is through such a person’s eyes that matters must be judged (*Sabel BV v Puma AG*);

That the average consumer rarely has the chance to make direct comparisons between trade marks and must, instead, rely upon the imperfect picture of them he or she has kept in mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*) This is often referred to as the concept of “imperfect recollection”;

That the degree of distinctiveness of the earlier trade mark (due either to its inherent qualities or through the use made of it) is an important factor because confusion is more likely the more distinctive the earlier trade mark is (*Sabel BV v Puma AG*);

That there is interdependency between the various factors, for example, a lesser degree of similarity between the marks may be offset by a greater

degree of similarity between the respective goods, and vice versa (*Canon Kabushiki Kaisha v Metro- Goldwyn-Mayer Inc*).


9) In terms of the goods, I consider them to be identical. The earlier mark covers clothing at large and is therefore identical to the term clothing appearing in Ms Williamson's registration. Ms Williamson's registration also covers footwear. As clothing consists of anything to clothe the body, I consider footwear to be clothing and, so, the goods fall within the ambit of the term clothing appearing in SHG's earlier registration. Even if I am wrong on this, the earlier mark also covers bath slippers which are a type of footwear. This means that the term footwear in Ms Williamson's registration includes within its ambit identical goods (bath slippers are a type of footwear). Even though the term footwear covers more than bath slippers, no fall back specification has been provided so a finding of identity is all that can be made⁶.

10) Clothing is bought by the public at large. The average consumer is, therefore, a member of the general public. The case-law informs me that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting goods can, however, vary depending on the particular goods in question (see, for example, the judgment of the GC in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)). In my view, clothing will be purchased with a reasonable degree of care and attention. The average consumer may try the goods on and is likely to inspect them for colour, size, style etc. All of this increases the potential exposure to the trade mark. That being said, the purchase is unlikely to be a highly considered process as clothing is purchased relatively frequently and although cost can vary, it is, generally speaking, not a highly expensive purchase.

11) Although aural similarity will not be ignored completely from my analysis, I am conscious that the visual impression of the trade marks is likely to take on more significance as the purchase of clothing is normally a visual act⁷. In terms of the marks themselves, they are, for ease of reference, replicated in the table below:

⁶ See *Gérard Meric v OHIM* (Case T-133/05), a judgment of the General Court ("GC").

⁷ See *Société provençale d'achat and de gestion (SPAG) SA v (OHIM)* Case T-57/03 and *React Trade Mark* [2000] RPC 285.

Ms Williamson's mark	SHG's mark
	<p data-bbox="810 376 1018 430">SHANTI</p>

12) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account any distinctive and dominant components. Mr Setchell was keen to stress the whole mark comparison that must be made, he felt that SHG were attempting to discount from the analysis the additional content of Ms Williamson's mark. Ms McFarland, on the other hand, highlighted what she considered to be the dominance of the word SHANTI in Ms Williamson's mark and that the other matter in it was subservient, with LIFE being a known descriptor unlikely to be given independent distinctive meaning.

13) In terms of distinctive and dominant components, SHG's trade mark does not separate into distinctive and dominant components. It will be seen as a single word and it is, therefore, its only constituent part. In terms of its concept, although I note Ms Williamson's explanation that SHANTI is the Sanskrit word for "peace", I consider it unlikely that the average consumer of clothing in the UK will know of this⁸. There is no evidence suggesting that the meaning put forward will be known. Furthermore, there is no evidence that even consumers who practice yoga (this is a group Ms Williamson intends to target) will know of the word. The same can be said for the alternative suggestion given by Mr Setchell at the hearing to the effect that the word may be seen as a reference to Shanty towns. Whilst I am aware of this word, it does not strike me as a common word, the knowledge and meaning of which I can accept as a notorious fact. Given all this, SHG's mark will be seen as an invented word.

14) Ms Williamson's mark consists of: i) the word SHANTI (in a particular form of script), ii) the word LIFE (in the same script), and iii) a swirled circular device. Whilst the words SHANTI and LIFE may appear to "hang together" to form a word combination, they do not do so in any real meaningful way given that SHANTI (as I have found with SGH's mark) will be seen as an invented word. I

⁸ In the *Chorkee case* (BL O-048-08), Anna Carboni, sitting as the Appointed Person, cautioned against accepting too readily the degree of knowledge that the average consumer may possess.

consider the word SHANTI to be the dominant and distinctive element on account of its position, that it is longer than the word LIFE, and that it is a much more distinctive and unusual word than LIFE. The word LIFE, and its construction into SHANTI LIFE, is not, though, to be ignored, neither is the device element which will play a part in the visual impression of the mark – it is only possible to make the comparison solely on the basis of the dominant and distinctive element if the other elements of the mark are negligible within its overall impression⁹ – they are certainly not that.

15) Any similarity resides in the presence of the word SHANTI in Ms Williamson's mark which is the entirety of SHG's mark. Considering the construction of the respective marks and the dominant and distinctive elements in them, there is a degree of similarity from both a visual and aural perspective. There is, though, a difference due to the addition of the word LIFE in Ms Williamson's mark (which impacts on both visual and aural similarity) and also the device element and stylisation (which impacts on visual similarity). Weighing all these considerations, I consider there to be a reasonable degree (neither high nor low) of visual similarity with a slightly higher degree of aural similarity.

16) In terms of concept, for a conceptual meaning to be relevant it must be one capable of immediate grasp¹⁰. I have already stated that SHANTI will be seen as an invented word and that SHANTI LIFE does not create a meaningful whole. On the basis of this there is neither conceptual similarity nor a conceptual difference.

17) The degree of distinctiveness of the earlier mark is another important factor to consider. This is because the more distinctive the earlier mark (based either on its inherent qualities or because of the use made of it), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). There is no evidence showing what use (if any) the earlier mark has been put to, so, I have only its inherent qualities to consider. From that perspective, I have already said that the earlier mark will be seen by the average consumer in the UK as an invented word. It has no suggestive or evocative qualities relating to clothing. I consider that the mark has a high degree of distinctive character. I note that in her counterstatement Ms Williamson said that lots of other traders use the word SHANTI. This, potentially, could mean that the average consumer may see the word as being less distinctive because it is a word commonly used. However, there is no evidence of any other SHANTI mark in use so the point is unsupported and academic.

⁹ See *Shaker di L. Laudato & Co. Sas.*

¹⁰ This is highlighted in numerous judgments of the GC and the ECJ including *Ruiz Picasso v OHIM* [2006] e.c.r. –I-643; [2006] E.T.M.R. 29.

Conclusions

18) It is clear that the factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17) and that a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

19) Ms Williamson highlighted in her counterstatement that her goods are marketed to the ethical/environmental market and for clothing for taking part in yoga. This, though, has no relevance because there is nothing to stop SHG from marketing its goods in exactly the same way. In any event, marketing strategies are temporal and could change with time. I must consider the respective marks used on a notional basis in relation to articles of clothing.

20) In terms of the relevant factors, the goods are identical and the marks reasonably similar. The earlier mark is also high in inherent distinctive character. However, an average consumer will pay a reasonable degree of care and attention to the goods that they are choosing and, so, they may be able to differentiate between the two marks given their differences. Whilst this is a possibility, the reasonable degree of similarity, a similarity based on what I regard as the dominant and distinctive element in Ms Williamson's mark, is, in my view, likely to result in confusion. This is particularly so when one bears in mind the concept of imperfect recollection (because consumers rarely see marks side by side), the most memorable aspect of Ms Williamson's mark, and the aspect most likely to be recalled, being the dominant and distinctive word SHANTI. I have not ignored Mr Setchell's call to consider the marks in their totalities. The case-law relating to comparisons involving composite or complex marks clearly calls for such an approach (see, for example, *Medion v Thomson Multimedia* [2006] ETMR 13 and Case C-3/03 P *Matratzen Concord v OHIM* [2004] ECR I-3657) as does the case-law in general (*Sabel BV v. Puma AG*), however, considering the marks in totalities, but bearing in mind their dominant and distinctive elements as assessed, together with all the other relevant factors, confusion is still likely.

21) Even if I am wrong on this and the average consumer notices and recalls that one mark is SHANTI LIFE (and that it has logo and stylization) and the other is just the word SHANTI, then I fully agree with Ms McFarland's view that this will be put down by the average consumer to there being an economic connection between the undertakings responsible for the marks, i.e. that the marks and the goods being sold under them come from the same or a linked company¹¹. The application for invalidation succeeds.

¹¹ This is a relevant form of confusion – see *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*.

22) I should add that even if I am found to be wrong on my assessment of the conceptual meanings underpinning the marks and that the word SHANTI (be it on its own or as part of the SHANTI LIFE mark) has meaning, then such meaning will still not relate to the word peace. Any meaning will, in my view, relate to a Shanty town or, even, to a sea shanty (a rhythmic song traditionally sung by sailors). If this were the case then it is my view that confusion is still likely. I say this because the earlier mark would still be high in distinctive character, if there is meaning then the same meaning (of the word SHANTI) is likely to be shared between the two marks so introducing an element of conceptual similarity, all of which will result in the marks still being assumed to be the responsibility of the same or a related undertaking.

23) The ground under section 5(2)(b) having been successful and, in accordance with section 47(6) of the Act, I hereby declare Ms Williamson's registration in class 25 to be invalid and the registration deemed never to have been made to that extent.

Costs

24) SHG has been successful and is entitled to a contribution towards its costs¹². I hereby order Ms Kim Williamson to pay Shanti Hospitality Group Limited the sum of £1000. This sum is calculated as follows:

Preparing a statement and considering the other side's statement - £300

Expenses (opposition fee) - £200

Attending the hearing - £500

25) I have not awarded any costs in relation to SHG's "evidence" as it contained no real factual evidence.

26) The above sum should 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 14 day of December 2010

**Oliver Morris
For the Registrar,
The Comptroller-General**

¹² Costs are normally awarded on the basis of the registrar's published scale in Tribunal Practice Notice 4/2007.