

O-440-10

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2503180
BY
FABRIKANT-TARA INTERNATIONAL, LLC
TO REGISTER THE TRADE MARK**

FACETS OF LOVE

IN CLASS 14

AND

**THE OPPOSITION THERETO
UNDER NO 99244
BY
DIAMINTANGIBLES INTERNATIONAL LIMITED**

**Trade Marks Act 1994
In the matter of application 2503180
by Fabricant-Tara International, LLC
to register the trade mark: FACETS OF LOVE
in class 14
and the opposition thereto
under no 99244
by Diamintangibles International Limited**

BACKGROUND

1. On 24 November 2008, Fabricant-Tara International, LLC (FTIL) applied to register the above trade mark in class 14 of the Nice Classification system¹. Following publication of the application in the *Trade Marks Journal* on 27 March 2009, Diamintangibles International Limited (DIL) filed notice of opposition against the application which is for *diamonds, jewellery, ormolu wear, watches and clocks*.

2. The sole ground of opposition is brought under 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.”

3. To support this ground, the opponent relies upon all of the goods in class 14 of its earlier registered trade marks:

i) 2391342 (UK)

FACETS OF FIRE

Registered: 11 November 2005

Class 14 - Diamonds, precious and semi-precious stones, and goods made from such goods; jewellery and imitation jewellery; necklaces, earrings, brooches and rings; goods made from precious metals or their alloys not included in other classes; ormolu wear; watches and clocks.

¹ International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).

ii) Community Trade Mark (CTM) 4436796

FACETS OF FIRE

Registered: 8 March 2007

Class 14 - Diamonds and jewellery.

iii) CTM 4879128

FACETS OF DESIRE

Registered: 6 February 2007

Class 14 - Diamonds and fine jewellery.

The earlier marks completed their registration less than five years before the publication date of the application. There is therefore no requirement for the opponent to prove use of its marks.²

4. DIL states that the mark applied for is similar to its earlier marks and should be refused as there exists a likelihood of confusion on the part of the public.

5. FTIL filed a counterstatement stating that 'FACETS OF' plays '*a severely restricted role in providing distinctiveness*', suggesting that when seeking global appreciation of the marks, '*it is proper to concentrate on the respective suffixes of each mark*'. On this basis it states that the marks should in no way be considered similar, as the suffixes '*share no visual, phonetic nor indeed conceptual, similarity whatsoever*'.

6. Only FTIL filed evidence in the proceedings (in a letter dated 5 January 2010 the opponent's representative declined to file evidence) and only DIL filed written submissions in lieu of a hearing. I will refer to these written submissions as necessary below. Neither side requested a hearing, both being content for a decision to be made from the papers on file.

Evidence

7. The applicant's evidence consists of a witness statement in the name of David Gill, the attorney acting on behalf of the applicant. For the most part this takes the form of submissions, which I will not summarise here but will refer to where appropriate. Attached exhibits consist of dictionary definitions of 'facet' (Exhibit 1), 'fire', 'desire' and 'love' (Exhibit 8) and paper copies of internet searches containing the word 'facet' (Exhibits 2 and 3). Exhibit 7 consists of an article from The Independent, dated 17 April 2004, in order to demonstrate uses of the word 'facet'. Also included are several prints from the Community Trade Mark database of 'facet'

² 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.

trade marks protected in the UK, in an attempt to demonstrate that the term is commonly used within class 14. The UK and European courts have made clear that state of the register evidence is rarely relevant (see, in particular, *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281). No evidence has been provided to illustrate which of the marks, if any, is actually in use in the UK and what the relevant public's perception of these marks may be in relation to the goods in question (Exhibits 4-6 refer).

THE DECISION

Section 5(2)(b) case law

8. The leading authorities pertinent to this ground are from the European Court of Justice (ECJ), namely: *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 the relevant factors: (*Sabel BV v. Puma AG*, paragraph 22);

(b) the matter must be judged through the eyes of the average consumer of the good/services in question; *Sabel BV v. Puma AG*, paragraph 23, who is deemed to be reasonably well informed and 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* paragraph 27);

(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*, paragraph 23);

(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*, paragraph 23);

(e) an element of a mark may play an independent distinctive role within it without necessarily constituting the dominant element; (*Medion AG V Thomson multimedia Sales Germany & Austria GmbH*, paragraph 30);

(f) 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*, paragraph 17);

(g) 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*, paragraph 24);

(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*, paragraph 26);

(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 + Adidas Benelux BV*, paragraph 41);

(j) however, if the association between the marks causes the public to believe wrongly 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*, paragraph 29).

The average consumer

9. In accordance with the above cited case law, I must determine who the average consumer is and consider the nature of the purchasing process. The average consumer for jewellery, watches, ormolu wear and clocks is the general public, while diamonds and precious/semi-precious stones are likely to be purchased by jewellery makers/designers. The average consumer is reasonably well informed and reasonably circumspect and observant, but his level of attention is likely to vary according to the category of goods or services. The attention paid is likely to vary depending on price and, to some extent, the nature of the goods and the frequency of the purchase. A diamond engagement ring is likely to afford a higher level of attention than would be evident during the purchase of costume jewellery, which could be a fairly frequent and inexpensive occurrence. For the most part the consumer will pay a reasonable, but not exceptional, level of attention, though in the case of those buying gemstones for the creation of jewellery, I would expect the level of attention to be high. The full range of goods is purchased visually, as their primary purpose is their appearance.

Comparison of goods

10. In comparing the respective specifications, all relevant factors should be considered, as per *Canon* in which 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 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 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.

11. In its submissions DIL states:

“The goods sought to be registered by the Application in Suit are identical to those covered by the Opponent’s prior rights relied upon.”

In respect of the UK registered mark ‘FACETS OF FIRE’, the goods are clearly identical: the specification is identically worded to that of the application.

12. The CTM registration for ‘FACETS OF DESIRE’ is registered for ‘diamonds and fine jewellery’. For ease of reference the goods are show below:

| The opponent’s mark | The applicant’s mark |
|--|--|
| Class 14 Diamonds and fine jewellery | Class 14 Diamonds, precious and semi-precious stones, and goods made from such goods; jewellery and imitation jewellery; necklaces, earrings, brooches and rings; goods made from precious metals or their alloys not included in other classes; ormolu wear; watches and clocks |

13. Diamonds are included in both the application and the opponent's earlier mark and are identical terms. In *Gérard Meric v OHIM*, Case T-133/05, the ECJ held that goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application³ or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark.⁴ Precious stones which are included in the application can be considered a wider term which encompasses diamonds, while 'jewellery' is a wider term which includes fine jewellery. Goods made from diamonds, precious and semi-precious stones and goods made from precious metals or their alloys not included in other classes, can be considered 'fine jewellery'. Applying the test laid down by the General Court in *Merica*, these can be considered identical goods.

14. The remaining goods which require further assessment are semi-precious stones, imitation jewellery, watches, ormlu wear and clocks. First, I will consider the semi-precious stones in the application. Both diamonds and semi-precious stones are component parts used in the creation of jewellery, although they differ greatly in terms of exclusivity. In both cases they are likely to be bought by manufacturers/designers to be used as part of an end product. Taking this into account, their respective trade channels are likely to be close (if not identical, as I am aware that there are merchants who specialise in trading diamonds). I find that diamonds and semi-precious stones have a reasonable level of similarity.

15. Imitation jewellery in the application will, like fine jewellery in the opponent's earlier mark, be purchased for its appearance. Both will be used for personal decoration and are likely to be made available through the same trade channels. It is also important to note that price is not necessarily an indicator of whether jewellery is 'fine' or 'imitation', as many designers produce high end jewellery in a premium price bracket which consists of paste or glass stones or silver rather than platinum. I consider these goods to have a reasonably high degree of similarity.

16. Necklaces, earrings, brooches, and rings fall within the more general category, fine jewellery, in the opponent's earlier mark and that being the case are identical goods according to the principles laid down in *Merica*.

17. Turning to the watches specified in the application, they will primarily be used to tell the time, whereas jewellery will be selected entirely for its appearance. However, it would be artificial to conclude that a watch is a purely functional item. Watches can be selected as much for their appearance as, for example, a bracelet. Watches are frequently designed with the timepiece almost hidden within an ornate bracelet resulting in an end product which is as much about appearance as it is about function. Watches and jewellery are often sold through the same outlets both on the high street and through online retailers and it is common for a consumer to own several watches in the same way as they would a selection of jewellery. Both can be

³ T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53

⁴ T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42

considered items for personal adornment. Taking these factors into account, I find the respective goods have a reasonably high degree of similarity.

18. Next, I will consider ormolu wear in the application against jewellery in the opponent's earlier mark. Ormolu is defined as 'a gold-coloured alloy of copper, zinc and tin used in decoration and making ornaments.'⁵ Ormolu wear is a term applied to items decorated using the aforementioned alloy. Ormolu wear is generally purchased for interior decoration rather than for personal adornment. Pieces tend to be large and often free standing, normally taking the form of mantle clocks or furniture. Ormolu wear is not generally sold through the same retail outlet as jewellery. I am mindful of the fact that some antique dealers will no doubt trade in ormolu wear and jewellery, but the point to be taken here is that purchasers would expect to buy ormolu wear from a specialist dealer rather than a jewellers. After considering the guidance in *Canon* and *Treat* I am bound to conclude that there is no similarity between these goods.

19. The final consideration to be made is the assessment of similarity between clocks and jewellery. Clocks, like watches, have a principal purpose as a timepiece. In the case of a clock this will be the main reason for purchase. Clocks may be bought to be displayed in a room. They are not items of personal decoration. Trade channels for clocks and jewellery may converge: I am aware that some jewellers also sell a range of clocks, both in high street stores and online. Taking the trade channels into account, there is a low degree of similarity between the clocks and jewellery.

Comparison of the marks

20. For ease of reference the marks are shown below:

| Opponent's earlier marks | Applicant's mark |
|--------------------------|------------------|
| FACETS OF DESIRE | FACETS OF LOVE |
| FACETS OF FIRE | |

21. In making a comparison between the marks, I must consider each mark's visual, aural and conceptual similarities with reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components,⁶ 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.

⁵ Oxford English Dictionary

⁶ *Sabel v Puma AG*, para. 23

22. As the opponent is relying on two different earlier marks I will begin by assessing 'FACETS OF DESIRE' against the application. Both marks begin with 'FACETS OF' and both are word only marks.

23. In his witness statement Mr Gill states:

"On the basis of clear and common use, and descriptiveness, of the element 'FACETS OF...' in relation to Class 14 products and in particular jewellery and items forming part of jewellery, the sole distinctive element of Earlier Marks arises from the suffix '...FIRE' and '...DESIRE' respectively."

Although 'facets of...' qualifies the 'desire' and 'love' elements and has a certain allusive quality in relation to cut gemstones, in my view, neither mark has a single dominant and distinctive element: the marks hang together as complete phrases, and that is how I must compare them, in accordance with the judgement in *Sabel v Puma* which makes it clear that the average consumer perceives a mark as a whole and does not proceed to analyse its various details.

24. Visually, both marks begin with the words 'FACETS OF'. The applicant's mark is followed by the word 'LOVE'. The opponent's mark, by contrast, has the third word 'DESIRE'. These words are visually distinct, but when viewed as a whole with the fact that the first two words (in each three-word mark) are identical, I conclude that these marks share a reasonable level of visual similarity.

25. From an aural perspective the first two words of both marks are identical. The point of difference is the third word of the applicant's mark which will be pronounced with one short syllable, 'LOVE', whereas the opponent's mark will be pronounced with three syllables, 'DE-ZI-ER'. Taking all of this into account, I conclude that the respective marks share a reasonable level of aural similarity.

26. Conceptually the marks both have the words 'FACETS OF' in common. FTIL submits that the word facet has two clear meanings, the first of which is, 'one side of a many-sided body, especially a cut gem'. It suggests that the 'common descriptive understanding' of the word facet means that it should not be considered and indicates that the comparison should be restricted to the last word in each case. I have already stated above that I must consider the marks as a whole. In this case neither 'LOVE' nor 'DESIRE' are tangible objects so when prefixed with the term 'FACETS OF...' both are ethereal concepts in the context of the first definition.

27. The second meaning of the word 'facet' is the focus of DIL's submissions. The second meaning provided is 'a particular aspect of a thing'.

'In relation to jewellery, therefore, the mark, 'FACETS OF LOVE', could be seen as meaning 'an aspect of love'. In the opponent's view the marks are conceptually very similar, both meaning 'an outward sign or token of love or passion.'

28. The point of difference between the marks is the third word in each case. 'LOVE' in the applicant's mark and 'DESIRE' in the opponent's mark. Conceptually there is little difference between the impressions that both of these words will create in the

mind of the consumer. In fact a dictionary definition of 'Love' is '*a deep feeling of sexual attraction and desire*'.⁷ In both cases the mark as a whole gives the impression of an aspect of feeling for another person. I conclude that the respective marks have a high degree of conceptual similarity.

29. I have therefore found that the respective marks share a reasonable level of visual and aural similarity and a high degree of conceptual similarity. This combines to give the marks a reasonably high level of similarity overall.

Distinctive character

30. As the case law dictates, I must also assess the distinctive character of DIL's trade mark. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which it has been registered and, secondly, by reference to the way it is perceived by the relevant public.⁸ In determining the distinctive character of a trade 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 trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings.⁹ No evidence of use has been filed by DIL, so I have only to consider the inherent level of distinctiveness.

31. The mark consists of the words 'FACETS OF DESIRE'. All three words have a clear meaning in English, as already identified above. The word 'facet' has a loose connection with the goods but in the context of the mark as whole, is not descriptive of the goods in question. As such, the mark enjoys a reasonably high degree of inherent distinctive character.

Likelihood of confusion

32. I must adopt the global approach advocated by case law and take into account that marks are rarely recalled perfectly with the consumer relying instead on the imperfect picture of them he has in kept in his mind.¹⁰

33. I also take into account the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa. I have found that the respective marks share a reasonably high level of similarity. I have identified the goods which are identical or share a reasonable or high level of similarity to DIL's *diamonds and fine jewellery*. The exception to this is ormolu wear (no similarity) and clocks (low similarity).

34. The similarities in the marks, in particular, the conceptual similarities, are such that I believe that there is a likelihood of consumers being confused into believing

⁷ Collins English Dictionary

⁸ Rewe Zentral AG v OHIM (LITE) [2002] ETMR 91

⁹ Windsurfing Chiemsee v Huber and Attenberger Joined Cases C-108/97 and C-109/97 [1999] ETMR 585

¹⁰ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

that the goods provided by the applicant are those of the opponent or provided by some undertaking linked to them; for example, a range of 'Facets of...' goods. The opposition under Section 5(2) (b) therefore succeeds in relation to the 'FACETS OF DESIRE' mark for all of the goods apart from ormolu wear and clocks.

35. I will consider the balance of the specification in class 14, namely 'ormolu wear and clocks', in respect of the opponent's 'FACETS OF FIRE' mark.

Facets of Fire - Comparison of goods

36. As I have stated at paragraph 11 above, the goods for the opponent's 'FACETS OF FIRE' mark and the applicant's 'FACETS OF LOVE' mark are identical.

Facets of Fire - Comparison of marks

37. Both are word only marks and are not presented with any emphasis added. As above, both are marks which hang together and do not possess any dominant characteristics.

38. Both marks begin with the words 'FACETS OF'. The applicant's mark is followed by the word 'LOVE'. The opponent's mark, by contrast, has the third word 'FIRE'. Both are short, four letter words making the overall marks equal in length. Considering both marks as a whole, there is a reasonable degree of similarity.

39. From an aural perspective the first two words of both marks are identical. The point of difference is the third word of the applicant's mark which will be pronounced with one short syllable, 'LOVE', whereas the opponent's mark will be pronounced with two syllables, 'FI-ER'. Taking all of this into account, I conclude that the respective marks share a reasonable level of aural similarity.

40. Conceptually, the point of difference between the marks is the third word in each case. 'LOVE' in the applicant's mark and 'FIRE' in the opponent's mark.

41. The applicant submits that the conceptually the words '*can be quite clearly differentiated*' and suggests that these words should be considered in isolation. The opponent suggests that the marks 'FACETS OF FIRE' and 'FACETS OF LOVE' are conceptually similar '*...the word 'fire' in relation to jewellery is clearly metaphorical, rather than literal, the word 'fire' symbolising passion.*'

42. In both cases the mark as a whole gives the impression of an aspect of something intangible which gives rise to a reasonable degree of similarity between the marks.

43. The distinctive character of the earlier mark is as above, the mark consists of the words 'FACETS OF FIRE'. All three words have a clear meaning in English. The word 'facet' has a loose connection with the goods but in the context of the mark as whole, is not descriptive of the goods in question. As such, the mark enjoys a reasonably high degree of inherent distinctive character.

Likelihood of confusion

44. In comparing these marks, taking into account the interdependency principle and the fact that marks are rarely recalled perfectly with the consumer relying instead on the imperfect picture of them he has in kept in his mind, the similarities between the marks are such that if used on goods which are identical, I believe that there is a likelihood of consumers being confused into believing that the goods provided by the applicant are those of the opponent or provided by some undertaking linked to them; for example, a range of 'Facets of...' goods. The opposition under Section 5(2) (b) therefore succeeds in relation to the 'FACETS OF FIRE' mark in respect of ormolu wear and clocks.

Conclusion

45. The opposition under Section 5(2)(b) succeeds in its entirety.

Costs

46. Diamintangibles International Limited has been successful and is entitled to an award of costs on the following basis:

| | |
|---|------|
| Preparing a statement and considering the other side's statement: | £200 |
| Official fee: | £200 |
| Considering the other side's evidence and filing written submissions: | £500 |

Total: £900

47. I order Fabrikant-Tara International, LLC to pay Diamintangibles International Limited the sum of £900. 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 23 day of December 2010

**Ms AI Skilton
For the Registrar,
the Comptroller-General**