

O-098-11

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION 2514606
BY CHRISTOPHER JAMES NASH TO REGISTER THE TRADE MARK**



IN CLASS 14

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 99722
BY SIGNET GROUP LTD**

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By Christopher James Nash to register the trade mark**



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BACKGROUND AND PLEADINGS

1. On 27th April 2009, Forever Wedding Rings of PO Box 1580, Southampton, SO15 5RH applied to register the above mark in Class 14. Subsequently, and no point was taken on this, an application was made on Form TM21 to change the name of the applicant from Forever Wedding Rings to Christopher James Nash. The attorney acting for Mr Nash explained that Mr Nash is a sole trader, trading as 'Forever Wedding Rings', and when he filed the application he did not realise it ought to have been filed in his own name rather than a trading name. This change of name was allowed by the registry and the application now stands in the name of Christopher James Nash.
2. The goods which are the subject of these proceedings are wedding rings and jewellery in Class 14.
3. The application was allocated the number 2514606 and was published in the Trade Marks Journal on 7th August 2009 and on 6th November 2009 Signet Group Ltd 15 Golden Square, London W1F 9JG (hereafter "Signet") lodged an opposition against the goods specified above.
4. Following an amendment to its pleadings, Signet has opposed on the basis of section 5(2)(b) and 5(3), citing the following earlier marks:

Mark. Filing and registration dates	Goods and services relied upon under section 5(2)(b)
UK 2378324 (“324”) FOREVER DIAMONDS Filed on: 18 th November 2004 Registered on: 15 th April 2005	Class 14: Horological and chronometric instruments; jewellery; precious stones; non-precious stones; watches; clocks; parts and fittings for all the aforesaid goods.
UK 2380962 (“962”) FOREVER DIAMONDS COLLECTION Filed on: 22 nd December 2004 Registered on: 24 th June 2005	Class 14: Horological and chronometric instruments; jewellery; precious stones; non-precious stones; watches; clocks; parts and fittings for all the aforesaid goods.
CTM 4225819 (“819”) NOW AND FOREVER Filed on: 22 nd December 2004 Registered on: 20 th February 2006	Class 14: Horological and chronometric instruments; jewellery; precious stones; non-precious stones; watches; clocks; parts and fittings for all the aforesaid goods.

5. I should mention that Signet rely on both section 5(2)(b) and 5(3) in connection with the ‘324 and ‘962 marks. As regards the 819 mark however, only section 5(2)(b) is relied upon.
6. In respect of all three earlier marks, Signet say Mr Nash’s mark is visually, phonetically and conceptually similar. The most distinctive and dominant element of the earlier marks is the word ‘Forever’, which is common to Mr Nash’s mark. The other elements in Mr Nash’s mark are all non-distinctive and/or descriptive. The goods are identical and taking all factors into account there is a likelihood of confusion under section 5(2)(b).
7. As regards section 5(3), Signet say they are a leading jeweller with retail outlets throughout the UK and have spent substantial sums on development, advertising and promotion over the years. Average consumers would

associate Mr Nash's mark with Signet and this will confer an unfair advantage on Mr Nash, as well as diminish the strength (ie distinctiveness) and attractiveness of the earlier marks. Moreover, Signet will have no control over the quality of goods provided by Mr Nash and this will be detrimental to the distinctive character and reputation of the earlier marks.

8. Mr Nash filed a counterstatement in which he denies the word 'forever' is, per se, distinctive in respect of the goods and that it designates a characteristic of those goods, namely their expected lifetime, as well as, in respect of wedding rings, the expected lifetime of the union symbolised by the rings. He says the word 'forever' has become customary in the bona fide and established practices of the trade. He then provides some examples of usage as part of a trading name, such as: 'Forever Jewellery', 'Forever Gold', and 'Forever amber'; etc. Further examples are given as usage as a part of a product name, such as: 'Forever necklace', 'Forever in my heart' pendant and 'Forever Friends' jewellery range. He also says the word 'forever' is commonly used by other jewellers in purely a descriptive sense, such as: "... this sterling silver pebble bead is to be treasured forever....", and "A gift of beauty is a joy forever she's guaranteed to love."
9. Mr Nash says the opponent *themselves*, or its subsidiary companies, are 'guilty' of use of the word 'forever' in a purely descriptive sense. Ernest Jones (a subsidiary) uses marketing materials including, eg, the following phrases, "Tell him you'd marry him all over again with a watch he'll treasure forever. Show her it's forever with a classic eternity ring....." and so forth.
10. He also notes that the word 'forever' forms part of many trade marks registered by others. He denies that the most distinctive, dominant element in the earlier marks is the word 'forever', as it is no more dominant than the remainder of the marks. It is not distinctive for the reasons given above and that, assuming there is any distinctiveness in the earlier marks at all, it can only reside in the marks as wholes and the precise combination of elements. It follows that he denies any visual, phonetic or conceptual similarity because none of the earlier marks contains a device, nor anything which looks or sounds like the words 'wedding rings' and, in turn, his mark has nothing which looks or sounds like the word 'diamonds', 'diamonds collection' or 'now and'.
11. He says he has been using his mark since September 2007 and has generated a substantial turnover, using advertising in bridal magazines. He is unaware of any instance of actual confusion during this time.
12. As regards the section 5(3) claim, he denies any similarity of marks, as discussed above. He admits that H Samuel, a subsidiary of the opponent, has used the relevant marks. But, because of the descriptiveness and non-distinctive nature of the word 'forever' he denies these earlier marks possess

any 'reputation' which is a requirement for a section 5(3) action to succeed. Further, even if a reputation were to proven, he claims a defence, namely that use of the opposed mark would be with 'due cause', given the descriptive nature of the word 'forever'. Finally, he denies that any unfair advantage would accrue to him or that use of his mark would be detrimental to the distinctive character or repute of the earlier marks.

13. Mr Nash rounds off his pleaded case by saying that no single trader can claim exclusive trade mark rights in the word 'forever'.

14. Both parties filed evidence which, insofar as it is factually relevant, I shall summarise below, and final submissions were received which I shall also take into account. No hearing was requested by either party and so I give my decision based upon a careful reading of the papers.

Opponent's evidence

15. Mark Jenkins is Group Company Secretary of Signet and has filed a witness statement dated 14th May 2010. He says there has been extensive use of FOREVER DIAMONDS and FOREVER DIAMONDS COLLECTION since 1995. Net sales are as follows:

Year	£ 000s
2003/4	332.7
2004/5	1,289.1
2005/6	1,756.6
2006/7	1,934.7
2007/8	1,892.9
2008/9	1,421.3
2009/10	1,228.3

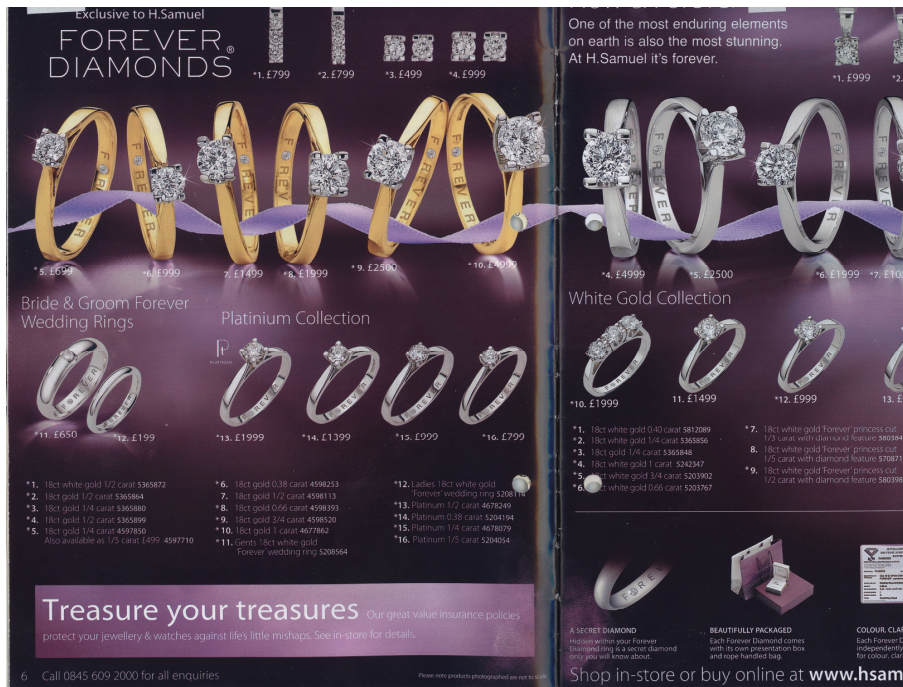
16. The goods sold under the marks are sold in the opponent's 354 retail outlets (as of 2009) throughout the UK and on its subsidiary, H Samuel Ltd's, website www.hsamuel.co.uk . The e-commerce capability has been present since 2005 and is the most visited UK speciality jewellery website (source: Hitwise). The opponent has 10.7% of the total market share and is the largest speciality retail jeweller in the UK, based on sales.

17. Mr Jenkins says considerable costs on advertising and promoting the goods have been expended. Approximate figures are as follows:

Year	£ 000s
2003/4	0
2004/5	30

2005/6	60
2006/7	60
2007/8	75
2008/9	75
2009/10	50

18. Exhibit MJ1 is a selection of the opponent's brochures. These brochures date from 2005. I have selected just one typical example of use below, which appears in the H Samuel Wedding and Engagement Collection brochure, published in 2007. I say 'typical' as the colour purple is invariably used as background; 'FOREVER DIAMONDS' are also invariably described as "Exclusive to H Samuel" and finally, the use of 'FOREVER DIAMONDS' is invariably in connection with wedding or engagement rings.



Applicant's evidence

19. This takes the form of a witness statement dated 20th August 2010 by Christopher James Nash. As I have said, he is the sole proprietor of a business trading under the opposed mark. His business was started in 2007, with turnover in the final quarter of 2007 being £18,400. Thereafter, turnover in 2008 rose from £17,000 in the first quarter to £111,500 in the final quarter. In the first quarter of 2009, turnover was £165,500. The other figures provide relate to period either after the date of filing, or partially after that date.

20. He explains the primary marketing approach of his business is through attendance at wedding shows and fayres held throughout the country. Exhibit

CJN1 shows photographs of two typical stands at these shows. The stands show the application mark displayed prominently at the back of the stand with balloons and see-through cabinets showing the rings on offer. Mr Nash explains he has 16 representatives who attend the shows and fayres. The potential customer views the rings, and if interested arranges a mutually convenient date when either Mr Nash or one of his representatives visits the potential customer's home. At the customer's home a collection of wedding rings is taken for the customer to try, or to form the basis for a bespoke ring designed for the customer.

21. Exhibit CJN2 is a list of venues and dates of wedding shows and fayres attended by Mr Nash's company. This runs to some 548 venues, of which most appear to be in the South East of the country, but not exclusively so, as Yorkshire and Manchester also feature. Prior to the application filing date, some 180 'day venues' had been attended. Expenditure on the shows in the first quarter of 2008 was £5,520, rising to £6,050 in the final quarter.
22. Mr Nash also uses a telesales team to promote sales and this team contacts engaged couples with a view to booking appointments.
23. He also advertises in the printed press, ranging from regional wedding directories to national bridal publications such as: "BRIDES", "YOU AND YOUR WEDDING", "COSMOPOLITAN BRIDE" and "WEDDING IDEAS". Exhibit CJN3 comprises two samples of typical adverts in 'WEDDING IDEAS' and 'BRIDES' magazines. These adverts show the mark as filed, including in the colours as filed, and take the form of competitions to win rings. The adverts include contact details such as phone, website and e-mail addresses. The adverts also show discounts available to runners up in the competitions of between £100 - £150. The winners win the rings themselves. Expenditure on advertising has risen from £30 in the first quarter of 2008 to £3,530 in the first quarter of 2009.
24. Mr Nash explains he chose the word 'forever' to feature in his mark as it clearly alludes to the goods. A wedding ring is purchased in the expectation it will last and be worn forever and, of course, that the union symbolised by the ring will also last forever. He has however never regarded the word 'forever' as being capable, on its own, of setting apart and identifying his goods from those of any other trader's jewellery. He notes also it is common for wedding rings to be engraved on the inside of the rings, and this is part of the bespoke service he offers. The word 'forever' is commonly chosen by customers as such an engraving, either alone, or part of a phrase such as 'FOREVER YOURS'.
25. He concludes his witness statement by saying that, despite the period of co-existent use between his mark and the opponents, neither he nor his representatives are aware of even a single instance of confusion.

26. There is also a witness statement dated 23rd August 2010 by Kenneth Stanley Targett, who is a trade mark attorney acting for Mr Nash. His witness statement takes the form of a number of GOOGLE searches, seeking to demonstrate the non-distinctive nature of the word 'forever' in the context of the relevant goods. The first search (Exhibit KST1) relates to the word 'forever' when used as an engraving (on its own, or part of a larger phrase) on wedding rings. So, for example, the webpage www.love2have.co.uk (which is exhibited) contains some suggestions for engravings such as, "I will love you forever"; the webpage www.serendipitydiamonds.co.uk suggests the words "Together forever" and "Now and forever", or just the word "Forever" as engravings.
27. The second GOOGLE search (Exhibit KST2) is aimed at jewellery traders in the UK using 'forever' as part of their trading name. There is a company called 'Forever Jewellery' based in Cardiff and they have a website www.foreverjewellerywholesale.com. There is a company called 'Joy Forever Jewellery'; a company called 'Forever-Amber' based in Tunbridge Wells and 'Forever Gold' from Ware, Hertfordshire, and also a company by the same name from Swansea.
28. There is a GOOGLE search (Exhibit KST3) on jewellery traders using the word 'forever' as part of a product name for their goods. A website www.bridaldesignsweddingjewellery.co.uk offers a 'Forever necklace' for sale. The company Bridal Designs Wedding Jewellery of Barnstaple are behind the website. A company called Poisoned Apple Jewellery offer a 'Forever Autumn' necklace on their website. A 'Forever and ever' necklace is also offered at www.prezzybox.com. At www.my-wardrobe.com Laura Lee Jewellery offer a 'To treasure forever and ever' silver band. At www.cavendishfrench.com can be found 'Forever glamour party pieces', and at www.argos.co.uk a range of 'Forever friends' items can be found. At www.clogau.co.uk a 'Silver & Rose Gold Together Forever Heart Bangle' can be bought and at www.bradford.co.uk there is a 'Forever in my heart' pendant.
29. There is a GOOGLE search (Exhibit KST4) for the opponent's and its subsidiary's own use of the word 'forever' in a descriptive sense. So, for example, Ernest Jones, in its marketing material uses such phrases as "Show her its forever with this 18ct gold ring.....", "Remember, diamonds are forever with the wedding ring of your dreams", and so forth. There are similar phrases used by H Samuel and C P Jewellery.
30. At Exhibit KST5, Mr Targett shows a print out of registered trade marks using the word 'forever' as part of the mark and in connection with goods of Class 14.

31. Finally, at Exhibit KST6 Mr Targett exhibits a dictionary definition of 'forever', being defined in the Cambridge Advanced Learner's Dictionary as an adverb, meaning "for all time".

Opponent's evidence in reply

32. Tania Clark, who is a partner at Withers and Rogers LLP, attorneys acting for the opponent, has filed a witness statement dated 22nd October 2010. At Exhibit TC1 is an extract from an Internet Forum available on the wedding website, www.hitched.co.uk. The extract is taken from a discussion forum and the particular thread is entitled 'Forever wedding rings'. The first post is by a person called 'Moya50' who says,

"..... has anyone used them ? They called yesterday to say I had won £100.00 off the price of w [word/s lost] they also make rings to your design or to shape round your engagement rings [word/s lost].

33. Following that post, there is a post dated 2nd December 2009 from 'Lauraks' in West Bromwich who says,

" I have a forever engagement ring but bought this from H Samuels so not sure whether they [word/s lost] most jewellery stores have a look on the H Samuels website honey ! I love my ring and the [word/s lost]".

34. Ms Clark says this is evidence of actual confusion in the marketplace, as H Samuels is, as I have said, a subsidiary of the opponent.

DECISION

Section 5(2)(b)

35. The opposition is founded upon Section 5(2) (b) and 5(3) of the Act. Section 5(2)(b) of the Act reads:

"(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."

36. The earlier trade marks in this case have filing dates of 18th November 2004 and 22nd December 2004. Plainly they all qualify as earlier trade marks. Moreover their dates of registration are all under five years prior to the date of publication of the application in suit, and accordingly none are subject to proof of use requirements under section 6A of the Act.

37. In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the Court of Justice of the European Union (“CJEU”) in *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 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P* (LIMONCELLO). It is clear from these cases that:

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

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

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

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

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

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

(g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood

of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,

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

(i) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

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

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

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

The average consumer and nature of the purchase

38. The average consumer for both parties' products will be drawn from the general public, in particular those with an interest in purchasing jewellery. As the goods are identical, the identity of the average consumer will likewise be common.

39. As far as the purchasing process is concerned, both parties' products will I believe be carefully considered purchases. These are not everyday purchases. Although jewellery can range from the relatively inexpensive to high value purchases it is very much a personal selection, often therefore undertaken with the help of a shop assistant and with the help and approval of the person who will wear the jewellery. This must the case especially for

wedding rings, which are intended to be worn on a permanent basis and have huge personal and sentimental significance.

40. I will of course factor these observations into my overall assessment of likelihood of confusion.

Comparison of marks

41. The case law makes it clear I must undertake a full comparison, from the perspective of the average consumer, of both marks in their totalities and overall impression (see authority (k) above in para 37), taking account of all differences and similarities, and also having regard to the distinctive and dominant elements of the respective marks.

42. In this case there are three earlier marks and whilst each needs to be considered separately, in terms of their respective (or potential) distinctive and dominant elements, it will be '324 and '962 which will present Signet with their best case. This is because, in both these marks, the key question, as recognised by the parties, will be whether the word 'forever' has any distinctive character at all. '819 possesses something of a different 'identity', where the word 'forever' is subsumed within a recognisable phrase, 'now and forever'. Signet's best case therefore resides with its earlier marks '324 and '962 and I will restrict my considerations to the similarity between these marks and Mr Nash's mark.

Visual comparison.

43. Signet's '324 mark just comprises two recognisable, dictionary words, 'Forever Diamonds', in that (linear) order and in plain script using capital letters. Mr Nash's mark comprises three recognisable, dictionary words, 'Forever Wedding Rings', the word 'Forever' appears above the words 'Wedding Rings'. The lettering is a standard font, upper and lower case being used. The lettering is in colour, being a light blue. In addition, there is a non stylised depiction of three wedding rings on top of each other and adjacent to the word 'Forever'. Both marks share the word 'forever', being the first word in each. This is the extent of the similarity as the other elements of the respective marks are different. Taking the similarities and dissimilarities into account, I find that '324 and Mr Nash's mark share a moderately high level of visual similarity.

44. Signet's '962 mark contains an additional word (in addition to 'Forever diamonds') and that word is 'collection' There are no other features however, the mark comprising just three dictionary words. Mr Nash's mark is as described above in para 43. The respective marks share the word 'forever', being the first word in each. This is the extent of the similarity as the other elements of the respective marks are different. Taking the similarities and

dissimilarities into account, I find that the respective marks also share a moderately high level of visual similarity.

Phonetic comparison

45. Signet's '324 mark will be pronounced "FOR –EVER DYE – MONDS". Mr Nash's mark will be pronounced "FOR-EVER WEDD – ING RINGS". Of course, the depiction of the wedding rings will not be enunciated. Both marks share the word 'forever' at the beginning of each. Taking the similarities and dissimilarities into account, I find the respective marks to share a moderate level of phonetic similarity.
46. Signet's '962 mark will be pronounced "FOR-EVER DYE-MONDS COLLECT-SHUN". Mr Nash's mark will be pronounced as above. Both marks share the word 'forever' at the beginning of each. Taking the similarities and dissimilarities into account, I find the respective marks to share a moderate level of phonetic similarity.

Conceptual comparison

47. By conceptual similarity, it is meant 'semantic' conceptual similarity. Signet's '324 mark comprises two known dictionary words, 'Forever diamonds'. The status and meaning of 'forever' is given at paragraph 31 above, namely, it is an adverb, meaning 'for all time'. Diamonds are, of course, precious stones used in many types of jewellery. They are used in jewellery, amongst other things, because of their physical properties such as colour and hardness. Diamond is the hardest naturally formed substance.
48. Nothing in the evidence however, demonstrates there is such a thing as a 'forever diamond'. That is to say, the word 'forever' does not '*designate*', or *describe*, a particular, objective and commonly understood, quality or characteristic of a type of diamond. Diamonds may be blue, brown, green, cut or uncut, but they are not 'forever'. In purely linguistic terms, if there were such a thing as a 'forever diamond', then presumably there may be something less than a 'forever' diamond. This is nonsense of course. A diamond has inherent, objective characteristics (certain terms may be used by experts and some by the consumer, some by both), but the adverb, 'forever', is in effect linguistically vague, and not a word which would be used in describing, in the course of trade, a particular type of diamond.
49. Likewise, there is no such thing as a 'forever wedding ring'. The word 'forever' simply does not describe an objective and commonly understood quality or characteristic about, or relating to, a wedding ring. The fact that rings can and often are engraved with, eg the word 'forever' on the inside or elsewhere, does not thereby mean they would be described in trade as a 'forever wedding ring'. Some terms, such as 'eternity ring', have assumed generic

significance amongst traders and the public, however there is no evidence before me to suggest that the term 'forever' has assumed generic and/or descriptive significance in relation to diamonds or wedding rings.

50. So, on the basis there are no such things as 'forever diamonds' or 'forever wedding rings', just what conceptual allusions are invoked by these terms, and can they said to be similar? In the context of jewellery, I believe the use of 'forever' will be seen to be having allusion to the union or devotion, ostensibly between giver and recipient, and either symbolised or commemorated by the jewellery itself. As such, the '324 and '962 marks are conceptually very similar to Mr Nash's since all evoke the same allusion, albeit that that allusion is applied to and qualifies different items – diamonds and wedding rings. I should add that the word 'collection' in the '962 mark is an entirely descriptive word which does not undermine the concept behind the words preceding it.

Overall similarity

51. These findings need to be brought together in an overall assessment of similarity of the marks, having regard to any distinctive, dominant characteristics. My discussion below in the likelihood of confusion section will address, in particular the question whether the word 'forever' can, in light of the evidence before me, be said to possess distinctive capacity in relation to the respective goods.

52. I should nevertheless factor into my assessment of overall similarity of marks, my answer to the question I have posed above. As will be clear from my analysis below at paras 56- 63 I find that the word 'forever' in the overall marks *does* have a distinctive role, in contrast to the other elements, and of course that word is common to Mr Nash's mark. Not only is it 'common to' but it appears also as the first word in all the respective marks and, purely linguistically speaking, it qualifies the descriptive words or images that follow or attend it. As such there is a dominance, as well as a distinctiveness, about the word. So, taking into account my overall assessment of visual, phonetic and conceptual similarity, as well as an analysis of distinctive elements, I find, overall, marks '324 and '962 are highly similar to Mr Nash's application.

Comparison of the goods

53. It is not disputed that the respective goods are identical.

Likelihood of confusion

54. Before proceeding to bring all my findings together in an overall global assessment, I need to make an assessment of the distinctive character of the earlier marks. An invented word having no derivation from known words is, in

its inherent characteristics, very high on the scale of distinctiveness, KODAK of course being the prime example.

55. The earlier marks, '324 and '962, comprise dictionary words. These words allude to the products in question in the way I have described above in para 50.
56. Mr Nash's line of attack as far as the word 'forever' is concerned is fairly clear. He says it appears in trading names, the names of products and in a descriptive (ie marketing) capacity – all in the context of the trade in jewellery. Moreover, there are many registered trade marks which also contain the word, thus indicating its absence of distinctiveness, in and of itself, to designate the goods of a single undertaking. State of the register evidence, as it is sometimes called, has repeatedly been rejected (see, eg *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281) on the basis that it does not necessarily reflect the actual market place, and I make the same comment as regards the evidence drawn from the register and used by Mr Nash.
57. The same dismissal cannot however be made of evidence drawn from contemporary internet searches.
58. Dealing firstly with descriptive use of the word 'forever' in the context of marketing phraseology. Plainly, such use is in a particular context of a wider phrase or sentence. Such usage does not thereby deprive the word 'forever', on its own or with other descriptive words, of distinctive capacity, either inherently or on the basis of use. Consumers can distinguish between this kind of 'marketing phrase' usage and the kind of usage illustrated above in para 18, which, in my view, would be seen as trade mark use, even without the 'RTM' symbol and the words 'Exclusive to H Samuel'.
59. As regards the usage of 'forever' in the context of trading names or the names of products, the problem with such evidence is that, far from demonstrating that the word 'forever' is 'devoid' of distinctive character, it actually tends to show the opposite, and that the word (alone or in combination with descriptive words) is fully capable of designating origin. So, for example 'Forever Jewellery' is clearly a *trading name*, likewise 'Forever Amber' and 'Forever Gold'. Use by traders of the word 'forever' to 'describe' products, eg a 'Forever' bangle or 'Forever' pendant or something similar, does not show that there is a *uniform and consistent* understanding in the trade and amongst consumers that any such things exist. On the contrary, it can be argued that such usage, by the smallish number of individual traders for which evidence is supplied, is potentially as a *secondary* trade mark. In other words, no two (let alone more) suppliers sell what would be understood to be 'forever' bangles or 'forever' pendants, by which I mean bangles or pendants which have the same characteristics or are intended to have the

same significance. Consequently, the word 'forever' actually individualises the bangles or pendants on *offer by the supplier*. The supplier could be saying in effect, these bangles or pendants are what I have chosen to call 'Forever bangles' or 'Forever pendants'. I appreciate however that, with such evidence, it is perhaps dangerous to be definitive about how exactly the average consumer will view a particular word in its specific context. That said, I do not believe that, either in terms of its quantity (number of traders involved) or more importantly, its quality, Mr Nash has plainly shown that the word 'forever' has *no* distinctiveness at all in relation to these products. At best, he can be said to have shown that a number of traders use the word in the context of names given to specific products and as such, the word may not be possessed of a particularly high level of distinctiveness.

60. I have also already commented on the fact that if rings are engraved with the word 'forever' but this does not thereby make them 'Forever Rings'.
61. I must also bear in mind that the actual earlier marks are 'Forever Diamonds', and 'Forever Diamonds Collection'. They are registered for items, including diamonds themselves, but also a broader range of goods, some of which may well contain diamonds but would be normally otherwise described.
62. I have already found that there are no such things as 'forever diamonds'. I have said that the fact that others may use the word 'forever' as part of a trading name or the name for a product seems to me to be evidence, not that the word 'forever' is, according to Mr Nash, inherently 'devoid' of distinctive character, but the opposite, that it is capable of operating either on its own or part of a larger mark to designate the goods of a particular undertaking.
63. On that basis, these earlier marks can be said to be inherently distinctive, but only on a low to moderate level, given the allusion to which I have referred above in para 50 .
64. I need to consider whether the distinctiveness of Signet's marks has been enhanced through use. Given the share of the retail market owned by Signet, it is not surprising they believe the distinctiveness of their marks has been enhanced through use. So far as I can make out from the evidence however, the earlier marks are only used by the opponent's one subsidiary, H Samuel Ltd, and it is unclear exactly what market share they may have. They are the UK's number 1 speciality jewellery brand, based on sales, according to Mr Jenkins. That said, there is little or nothing which puts sales of jewellery *bearing the respective marks* into context, ie as compared to other brands or the market as a whole. Moreover, the earlier marks are undoubtedly used as secondary marks, the primary mark being 'H Samuel'. Furthermore, as Mr Nash has pointed out in his submissions (largely in connection with section 5(3)), the purchase of goods bearing these marks is inevitably a special event and accordingly does not equate to everyday exposure of the respective

marks. There is no evidence of wide scale television or magazine advertising either. Taking into account all the factors, I find that the distinctiveness of the earlier marks is not enhanced to any significant extent through use.

65. I also need to deal with Mr Nash's argument that likelihood of confusion is unlikely as the marks have co-existed since 2007 and no confusion has yet occurred - with the exception of the instance recounted in Signet's evidence, and with which I shall deal below. Confusion, says Mr Nash, is all the more unlikely in this case, given the way he markets his goods at trade fayres and wedding shows.

66. It is entirely feasible to envisage a scenario where, for example, demonstrating likelihood of confusion (or absence of) is underpinned by factual circumstances, such as a period of close trading proximity and parallel usage. Alan Steinfield QC, sitting as a deputy judge of the High Court, in *Fiorelli Trade Mark* [2007] RPC 18 ("*Fiorelli*"), gave weight to an *absence* of confusion in the marketplace. However, this should be tempered by a number of decisions which express caution about the circumstances in which it is appropriate to give these factors weight (see the Court of Appeal in *The European Ltd v. The Economist Newspaper Ltd* [1998] FSR 283 at page 291, Laddie J in *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at 809 and the Court of Appeal in *Phones 4U Ltd v Phone 4u. co. uk Internet Ltd* [2007] RPC 5 at paragraphs 42 to 45.) In the first of the above cases, Millet LJ stated:

"Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark."

67. In this case, the respective marks have not existed in such close proximity that 'parallel usage' can be said to be a factor in my assessment. As Mr Nash says, he markets his goods at wedding shows and fayres and then in the customers' homes. Signet's are available in their retail outlets and via the web. This cannot be said to be *parallel* usage in the *Fiorelli* sense.

68. As for the (implicit) argument that Mr Nash's marketing activities may also undermine any case for likelihood of confusion, the European Courts have developed a line of authority resistant to such arguments. In the case of *C-171/06P T.I.M.E Art v OHIM and Devinlec Developpement Innovation Leclerc*, the CJEU says:

"59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing

marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

69. On that basis, this argument is also dismissed and the specific marketing activities adopted by Mr Nash are also not a factor in my assessment.
70. At this point, I need to consider the evidence of ‘actual’ confusion submitted by Tania Clark. Mr Nash says this evidence is worthless for a number of reasons. Firstly, the identity of ‘Lauraks’ is unknown and I simply cannot say whether she/he is representative of the average consumer. Secondly, the instance happened after the date of opposition. Thirdly, the posting by Lauraks does not refer explicitly to the marks of the respective parties; Lauraks refers to Forever Engagement Rings (rather than ‘diamonds’/‘diamonds collection’). Finally, Mr Nash says that in any event it only shows a possible ‘association’ (‘bringing to mind’) at best, between the respective marks and that is not enough to make out a section 5(2)(b) likelihood of confusion.
71. There is some force in Mr Nash’s criticisms. Having said that, I do not believe the evidence can, on closer inspection, be *entirely* dismissed. Firstly, although it is not conceded by Mr Nash, there must be a strong suspicion, based on other evidence, that the ‘thread’, of which ‘Lauraks’ post is just one post, originated in respect of Mr Nash’s products under the mark, ‘Forever Wedding Rings’. ‘Moya50’s’ previous post refers to a telephone call offering ‘Forever Wedding Rings’ at £100 discount. The evidence (see paras 22 and 23 above) says that that is how Mr Nash’s products are marketed, inter alia, by telesales. Also, there is evidence that Mr Nash offers discounts or around £100 - £150 (Exhibit CJN3 referred to in para 23 above).
72. In response to ‘Moya50’s’ post, ‘Lauraks’ says she bought a ‘forever engagement ring’ from H Samuels. At this point, although the earlier marks concerned are ‘forever diamonds’/ ‘collection’, it should be noted from the copy of the advert shown in para 18 above, that H Samuels were *also* using the word ‘forever’, not just in the context of ‘forever diamonds’, but by *extension*, to their own ‘Forever Wedding Rings’. It is not surprising then, that ‘Lauraks’ knew she had bought a ‘forever engagement ring’, which she associated with H Samuels.
73. Although Mr Nash makes legitimate criticisms of this evidence, I think it does nevertheless show that both the applicant (assuming Moya50’s post is about Mr Nash’s goods) and the opponent’s goods are possessed of the common word, ‘forever’, which operates as an ‘*identifier*’, or ‘*common reference*’ for both ‘Lauraks’ and ‘Moya50’.
74. As to the further, legal question of whether this is evidence of ‘confusion’ in accordance with section 5(2)(b), or mere association in terms of ‘bringing to

mind', I believe the criticisms by Mr Nash of the evidence are valid. I may add however that I would have arrived at the same overall conclusion, with or without the evidence of 'actual' confusion.

75. At this point I need to remind myself of my various findings and bring them together in a global assessment taking, of course, into account, the doctrine of imperfect recollection. I have found that the respective goods are identical. I have found the earlier marks to be inherently distinctive to a low to moderate degree. I have made observations on the respective average consumers, namely that they have identity and commonality and I have found the purchasing process to involve a carefully considered approach. Finally, I have found the respective marks, '324 and '962, to be highly similar. Needless to say that in making a global assessment, it is not a 'tick box' exercise, whereby if I find more factors in Signet's favour, it wins. All factors must be weighed in the evaluation of likelihood of confusion.
76. In all the circumstances, I find there is likelihood of confusion in this case in connection with marks '324 and '962. The opposition is therefore entirely successful under section 5(2)(b).

Section 5(3)

77. In view of my finding under section 5(2)(b), strictly speaking there is no need for me to consider the case under section 5(3). For the sake of completeness it may just help however, if I make a few observations as to how I may have found under section 5(3).
78. For a section 5(3) case to get off the ground, the earlier mark must have a reputation. 'Reputation' for the purposes of Section 5(3) means that the earlier mark is known by a significant part of the public concerned with the products or services covered by that mark (paragraph 26 of the CJEU's judgment in *General Motors Corp v Yplon SA (CHEVY)* [2000] RPC 572).
79. In my analysis under section 5(2) above, I was unable to find that the distinctiveness of Signet's earlier marks had been enhanced through use. Consistent with that finding, and for the reasons given in para 64 above, I am unable to conclude either that Signet's marks have the required reputation amongst a significant part of the relevant public.
80. For this reason, shortly stated, I would have rejected the opposition based on section 5(3).

Costs

81. Signet Group Ltd has been totally successful in its opposition. Accordingly, it is entitled to a contribution towards its costs and neither party sought costs off the normal scale. In the circumstances Signet Group Ltd the sum of £1400 as

a contribution towards the costs of the proceedings. The sum is calculated as follows:

1. Official fee for opposition and preparing statement - £400
2. Preparing and considering evidence - £600
3. Preparing submissions - £400

Total £1400

82. I order Christopher James Nash to pay Signet Group Ltd the sum of £1400. The 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 09 day of March 2011

**Edward Smith
For the Registrar,
the Comptroller-General**