

O-292-11

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION 2552393  
BY ANN COHERTON TO REGISTER THE TRADE MARK**



**IN CLASSES 25 AND 35,**

**AND IN THE MATTER OF OPPOSITION  
THERE TO UNDER NO 101130  
BY BARBA S.R.L**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF Application No 2552393  
By Ann Coherton to register the trade mark**



**and**

**IN THE MATTER OF opposition thereto under No 101130 by Barba S.R.L.**

**BACKGROUND AND PLEADINGS**

1. On 8<sup>th</sup> July 2010, Ann Coherton of 46 Marlborough Road, Shipley, West Yorkshire BD18 3NX applied to register the above mark in classes 25 and 35 in respect of the following goods and services:

**Class 25:**

Children's clothing, footwear and headgear

**Class 35:**

Retail of children's clothing, footwear and headgear. Online retail of children's clothing, footwear and headgear.

2. The application was allocated number 2552393 and was published in the Trade Marks Journal on 30<sup>th</sup> July 2010 and on 29<sup>th</sup> October 2010 Barba S.R.L. of Via S. Pasquale a Chiaia 83, 1-80122 Napoli, Italy (hereafter, "Barba") lodged an opposition against the goods and services specified above.
3. Barba has opposed on the sole basis of section 5(2)(b), citing the following earlier mark:

Mark. Filing and registration dates	Goods and services relied upon under section 5(2)(b)
CTM 2293504  BARBA  9 <sup>th</sup> July 2001 2 <sup>nd</sup> August 2006	<p><b>Class 18:</b> Leather and imitations of leather, and goods made of these materials and not included in other classes, animal skins; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.</p> <p><b>Class 25:</b> Clothing, footwear, headgear.</p>

4. Barba say the bird device in Ms Coherton's mark will not be sufficient to overcome the similarities in the word elements which comprises the dominant element in her mark. The word element only differs in respect of the middle letter, the beginning and end of the respective words being identical. The word elements are also the same length, and the middle letter will only have soft pronunciation; the lack of phonetic emphasis amplifying the overall similarities. As far as Ms Coherton's goods are concerned these are identical to Barba's class 25 specification and similar to its class 18 specification. As far as her services are concerned these are similar to the Barba's goods. Taking all factors into account, there is a likelihood of confusion.
5. Ms Coherton filed a counterstatement denying likelihood of confusion. She says the bird device is both noticeable and as the word BALBA or BARBA have no meaning, it is the bird device which is a more distinctive element. As far as the words are concerned even a difference of just a single consonant can be telling in small words. Further dissimilarities arise with the particular lettering and circular device present in her mark. She also notes that Barba markets itself as "BARBA Napoli".
6. As far as the goods and services are concerned she says she sells organic baby clothing not leather goods in class 18. She also denies the goods in class 25 are similar, on the basis she sells baby clothing via the internet whereas Barba sell adult clothing such as shirts, neckties and pants, according to its FACEBOOK page.
7. She says further distance is created between the respective marks on the basis the letters 'l' and 'r' are nowhere near each other on the QWERTY keyboard and so could not lead to confusion when using a search engine.

Also, by typing BARBA or BALBA into a search engine, the opponent's website [www.barbanapoli.it](http://www.barbanapoli.it) does not appear.

8. Ms Coherton concludes that Barba does not appear to have a large market share in classes 18 and 25 and cannot lay claim to enhanced distinctive character. The word 'BARBA' means 'beard' in Italian, Portuguese and Spanish which will not be associated with baby clothing. All factors considered there is no likelihood of confusion.
9. Formal evidence has been filed only by Ms Coherton, which insofar as it is factual I shall summarise below. Submissions have been filed by Barba which I shall take into account. No hearing was requested by either party and so I give my decision based upon a careful reading of the papers.

### **Applicant's evidence**

10. This takes the form of a witness statement dated 19<sup>th</sup> May 2011 by Susan Clark, solicitor for the applicant. At exhibit SEC2 she shows images of her client's mark and that used by the opponent, incorporating the word 'Napoli' and a device. Exhibit SEC3 is a copy of a page from the opponent's website saying that, "Currently shirts make up 90% of Barba's production with the rest equally divided between neckties and pants". Exhibit SEC4 is a copy of the results of a GOOGLE search done on 17<sup>th</sup> May 2011 on the word 'BARBA', showing that neither the applicant's nor the opponent's marks are retrieved.

### **DECISION**

#### **Section 5(2)(b)**

11. The opposition is founded upon Section 5(2) (b) of The Trade Marks Act 1994 ("the Act"). This 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.”

12. Barba's mark was filed on 9<sup>th</sup> July 2001 and registered on 2<sup>nd</sup> August 2006. It is therefore an earlier mark in accordance with Section 6 of the Act.

Moreover, given its date of registration is within 5 years of the publication of the application, it is not subject to proof of use requirements.

13. 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;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;
- (f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

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

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

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

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Preliminary comment**

14. It is important to explain that, in an opposition, I am required to consider notional circumstances pertaining to normal and fair use of the respective marks. That is to say, what matters to me are the marks in the forms applied<sup>1</sup> for and registered and the goods and services for which they are either already protected or in respect of which they seek protection<sup>2</sup>. Thus, insofar as Ms Coherton has sought to adduce evidence as to Barba's use of its mark, in combination with the word 'NAPOLI', with or without other matter, this is not relevant in my analysis. Moreover, evidence as to Barba's sale, predominantly of shirts, neckties and pants, expressly does not have the effect that its specification is 'limited', in any assessment of likelihood of confusion, to those items. There is provision whereby applicants can request proof of use of earlier marks to the extent they are relied upon in opposition proceedings but they do not apply in this case as there is less than five years between the date of registration of the earlier mark and the date of publication of the later one.

### **The average consumer and the nature of the purchase**

15. The average consumer for both parties' goods and services will be the clothes buying public; in Ms Coherton's case, the childrens' clothes buying public. Such goods are everyday items but nonetheless purchased with some degree of circumspection, being personal items.

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<sup>1</sup> See, eg Case C-254/09P, *Calvin Klein Trademark Trust v OHIM* (para 46)).

<sup>2</sup> See eg *Origins Natural Resources Inc v Origin Clothing Ltd* [1995] FSR 280.

16. Case law acknowledges that the nature of the purchase places some emphasis on visual selection<sup>3</sup> but it is necessary also to consider in any comparison all aspects, including phonetic and conceptual.
17. I will need to bear these comments in mind when I come to my overall assessment of likelihood of confusion.

### **Comparison of marks**

18. Case law makes it clear I must undertake a full comparison, taking account of visual, phonetic and conceptual similarities and dissimilarities, from the perspective of the average consumer. Marks need to be considered in their totalities and taking account of overall impression (see authorities (c), (e) and (f) above in para 13), giving recognition to distinctive and dominant elements.

### **Visual comparison**

19. Ms Coherton's mark comprises the word 'balba' in lower case text and although the letters are stylised, it is nonetheless recognisable as the word 'balba'. The stylisation includes the letters being in the colour dark brown, with the central parts of each letter infilled with different coloured circles being: blue, brown, red and turquoise, in that order from left to right. Above the first 'a' of 'balba' there is the recognisable device of a chirping bird. The bird is relatively small as compared to the letters forming the word.
20. Barba's mark simply comprises the word 'BARBA' in plain, upper case text.
21. In terms of the letters used, both marks comprise five letter words, beginning with 'ba' and ending with 'ba'. There is just one letter difference between the respective marks, that letter occurring in the middle of each word; the 'r' in Barba's mark becomes the letter 'l' in Ms Coherton's mark.
22. Taking the respective similarities and dissimilarities into account I find that, visually, the marks are similar to a high degree.

### **Phonetic comparison**

23. Ms Coherton's mark will be pronounced 'bal-ba'. The bird device and other stylisation will not be enunciated. Barba's mark will be enunciated 'bar-ba'. I agree with Barba that the different letter in the middle of each mark has a soft pronunciation in normal speech, such that it could be misheard against the harder sounds, preceding and following it.

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<sup>3</sup> See, eg *New Look Ltd v OHIM* - T-117/03 to T-119/03 and T-171/03 (GC):

24. Taking the similarities and dissimilarities into account I find that the respective marks are phonetically similar to a high degree.

### **Conceptual comparison**

25. The conceptual comparison is based upon semantic similarity. Neither word has any particular meaning in English and thus will not convey any semantic concept. Although Ms Coherton says the word 'barba' means 'beard' in Spanish, Italian and Portuguese, the average UK consumer is unlikely to be aware of this and it would be wrong to impute such linguistic knowledge to that consumer.<sup>4</sup> In consequence, the verbal elements of both marks will be seen as invented words by the average consumer.

26. As both word elements will be seen as invented words by the average consumer, they cannot be said to be conceptually similar or dissimilar. I would just add that, of course, I have considered if any other element in Ms Coherton's mark (notably the bird device or overall stylisation) will serve as a clue to any conceptual meaning behind her mark. I do not believe this to be the case; the bird device is only apt to be viewed in a decorative light (particularly in relation to children's clothing), and given its size relative to the letters, it is most unlikely the average consumer may see the word 'balba' as meaning 'bird' in a foreign language, or that the particular bird may go by the name, 'balba'.

27. On that basis I find the respective marks to be conceptually neither similar nor dissimilar.

### **Overall similarity of marks**

28. At this point I need to bring my individual findings above, together in an overall finding of similarity of marks, bearing in mind their distinctive and dominant elements and also the fact, as recognised in case law, that clothing tends to be selected on a visual basis..

29. I do not accept the submission that, as 'balba' has no recognisable meaning in English, the bird device in Ms Coherton's mark will be viewed as the distinctive, dominant element. In terms of its visual significance, the bird device is, as I have said, relatively small, perched on top of one single letter. As I have already said, my view would be that the bird serves no more than a pleasantly decorative function in relation, especially, to children's clothing, and would not thereby contribute to any particular concept behind Ms Coherton's mark. Similarly, the stylisation and colours in the lettering cannot be said to take 'precedence', in terms of their dominance or distinctiveness, over the word 'balba'.

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<sup>4</sup> See, eg *Chorkee Trade Mark* BL – O/048/08 (AP)



30. Taking all factors into account, and recognising the importance of visual selection in the purchasing process (not forgetting other elements), I find the respective marks to be similar to a high degree.

**Comparison of the goods and services**

31. In assessing the similarity of the goods and services, it is necessary to apply the approach advocated by case law and to take account of all the relevant factors relating to the services in the respective specifications. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at para 23 of the 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 and their method of use and whether they are in competition with each other or are complementary.’

32. Other factors have been identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281, such as the nature of the users and the channels of trade.

33. It is important to recognise that even though the factual evidence on similarity may be non-existent, I nevertheless have the statements of case, submissions and am able to draw upon commonly known facts. Mr Geoffrey Hobbs QC sitting as the Appointed Person, said in *Raleigh International trade mark* [2001] R.P.C. 11, at para 20, that such evidence will be required if the goods or services specified in the opposed application for registration are not identical or self-evidently similar to those for which the earlier trade mark is registered. But where there is self-evident similarity, and especially in relation to everyday items, evidence may not be necessary.

34. The relevant goods and services to be compared are:

<b>Barba’s goods</b>	<b>Ms Coherton’s goods and services</b>
<p><b>Class 18:</b> Leather and imitations of leather, and goods made of these materials and not included in other classes, animal skins; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.</p>	<p><b>Class 25:</b> Children's clothing, footwear and headgear</p> <p><b>Class 35:</b> Retail of children's clothing, footwear</p>

<p><b>Class 25:</b> Clothing, footwear, headgear.</p>	<p>and headgear. Online retail of children's clothing, footwear and headgear.</p>
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**Class 25**

35. The respective goods are identical. As I have said in my preliminary comment, the issue is not the goods in respect of which the parties' actually use their marks but what the specifications cover. Barba has 'clothing, footwear and headgear', which encompasses, 'childrens' clothing footwear and headgear'.

**Class 35**

36. On the question of the similarity between goods and retail services of those goods, the General Court (GC) has issued an important decision in Case T-116/06 *Oakley Inc v OHIM* ("Oakley"). In this case the Court held that the respective goods and services do not have the same nature, purpose and method of use, for example, because goods are fungible when services are not (see para 47). Despite this, the Court found that the OHIM Board of Appeal was correct to find that there were similarities, given the complementary nature of the goods and the respective retail services. That is to say that the goods are indispensable to, or at the very least important for the provision of the retail services, which are specifically provided when the goods are sold (paras 54 and 55). This must be true, regardless of how those services are provided, whether by means of a catalogue or traditional brick and mortar environment . As a consequence, the Court found that retail services are not merely auxiliary or ancillary to the goods in question (para 56). The one rider I should note to this is that the finding of overall similarity is only endorsed by the GC in respect of retail services which are in respect of *identical, or closely connected to* the goods of the earlier mark (para 56). I have already said that the goods of the respective specifications are identical.

37. I appreciate there is always a danger in regarding cases like *Oakley* as being authority for broad and inflexible legal propositions, eg to the effect that in all cases retail services for the sale of goods identical to or closely connected to those specified in an opponent's specification *must, a priori*, be regarded as similar to the goods themselves. This is far too rule-based and prescriptive an approach; it potentially obviates the need for any evidence on the point and absolves the decision maker from any responsibility for weighing such evidence, even in technical cases which involve specialist goods and retailing. In the *particular* circumstances of the *Oakley* case, it was accepted,

eg by the GC (para 50) that, “the manufacturers of the goods in question (clothing) often have their own sales outlets for their goods or resort to distribution agreements which authorise the provider of the retail services to use the same mark as that affixed to the goods sold”. I accept that to be the case here, noting that both *Oakley* and this case involve ‘clothing’, and I have no evidence or even submissions to the contrary.

38. On that basis I find that Ms Coherton’s retail services, including both online and traditional environments, are similar to the goods covered by Barba’s specification.

### ***Likelihood of confusion***

39. 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 mark. An invented word having no derivation from known words is, in its inherent characteristics, very high on the scale of distinctiveness, KODAK being the prime example.

40. The earlier mark comprises the word, ‘BARBA’. To the average consumer in the UK this will be an invented word and which will have, as a consequence, a high degree of inherent distinctiveness. There is no evidence of use of ‘BARBA’ in the UK and so I cannot conclude that the, already high level of distinctiveness, is enhanced through use.

41. 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 (and especially in this case) the doctrine of ‘imperfect recollection’, namely that consumers rarely have the opportunity to compare marks side by side and I must have regard to the circumstances in which the average consumer comes across trade marks in the real world and that such a consumer is unlikely to have perfect recall.

42. I have found that the respective goods in class 25 to be identical and the services in class 35 to be similar. I have made observations on the respective average consumers, namely that they will be the clothes buying public and that the nature of the purchase will be considered and engage visual selection especially. I have found the respective marks to be similar to a high degree. Finally I have found the earlier mark to be inherently distinctive to a high degree. Needless to say that in making a global assessment, it is not a ‘tick box’ exercise, whereby if I find more factors in one party’s favour, it inevitably wins. All factors must be weighed in the evaluation of likelihood of confusion.

43. Nonetheless, in all the circumstances I find there is likelihood of confusion in relation to all the goods and services of Ms Coherton’s specification.

44. Having arrived at that conclusion, based on notional comparison and the case law principles, I would just like to deal with one piece of evidence submitted by Ms Coherton. The evidence of absence of confusion in relation to GOOGLE (or any other) searches is not a factor in my analysis and neither is the position of the letters 'l' and 'r' on the QWERTY keyboard. The case law makes clear the nature of the assessment which admits, or rather compels, account to be taken of 'imperfect recollection' on the part of the average consumer. The average consumer will not always, and inevitably, access the parties' goods and services through GOOGLE or any other search engine for that matter. What is required is a rounded view, to include the various means in which the respective marks will be seen in the context of their usage. Such a rounded view is not arrived at by skewing the circumstances towards internet usage via a search engine and a keyboard.
45. So, to conclude, the opposition is totally successful as against all the goods and services specified.

### **Costs**

46. Barba has been successful in its opposition and is accordingly entitled to a contribution towards its costs. Neither party has sought an award off the normal scale of costs. I take account of the fact that the decision has been reached without a hearing. In the circumstances I award Barba S.R.L. the sum of £700 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

1. Filing fee for opposition - £200
2. Preparing a statement £200
3. Considering evidence and filing submissions - £300

Total £700

47. I order Ms Ann Coherton to pay Barba S.R.L. the sum of £700. 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 18 day of August 2011**

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