

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO 2620220 FOR THE TRADE MARK:



IN CLASSES 03, 09, 14, 18 AND 25 IN THE NAME OF MIO OTTIMO JEANS  
OFFICINO LIMITED

AN OPPOSITION THERETO UNDER NO 103806 BY ARS PARFUM CREATION &  
CONSULTING GMBH

## Background and Pleadings

1. Mio Ottimo Jeans Officino Limited (the applicant) applied to register the trade mark



on 5 May 2012. The application was accepted and published in the Trade Marks Journal on 8 June 2012 in respect of the following goods:

### **Class 3**

Soaps; perfumes.

### **Class 9**

Sunglasses.

### **Class 14**

Jewellery.

### **Class 18**

Leather and imitations of leather, and goods made of these materials and not included in other classes; briefcases; suitcases; handbags; wallets; purses; credit card holders; hat boxes; key cases; straps; luggage labels; sport bags; trunks and travelling bags; bags; belts; cases; satchels; pouches; rucksacks; beach bags; handbags; umbrellas; parasols; walking sticks; back packs; jewellery rolls; tote bags; shoulder bags; shopping bags; cosmetics bags; luggage; luggage straps; luggage tags; holdalls; cases for hand-held multimedia devices; cases and bags for portable computers.

### **Class 25**

Articles of clothing; lingerie; bras; pants; thongs; stockings; tights; suspender belts; camisoles; dressing gowns; negligees; corsets; night dresses; sleep shirts; sarongs; shoulder wraps; leggings; footwear; boots; shoes; slippers; headgear; belts; trousers; shorts; jeans; wristbands; headbands; hats; gloves; jackets; coats; jumpers; shirts; t-shirts; sweaters; vests; trousers; skirts; waistcoats; waterproof clothing; bathing costumes; pyjamas; undergarments; scarves; socks; suits; dresses; blouses; sun visors; anoraks; articles of clothing for leisurewear; articles of clothing for casualwear; articles of clothing for sportswear; articles of outer clothing; articles of weatherproof clothing; blazers; denims; jerseys; knitwear; parkas; sweatshirts; tops; windcheaters; swimwear; mittens; layettes; sashes and shawls; bathing caps; braces; suspenders; collars; cuffs; ear muffs; fittings for boots and shoes; gaiters; garters.

2. ars Parfum Creation & Consulting GmbH (the opponent) oppose the registration. The basis of this opposition is in respect of its earlier international trade mark registration (designating the EU) MOJO under No 912775, protected in the EU from 4 January 2007 in respect of the following goods:

**Class 3**

Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.

**Class 18**

Leather and imitations of leather, and goods made of these materials (included in this class); animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.

**Class 25**

Clothing, footwear, headgear.

3. The grounds of opposition are under Sections 5(1), 5(2)(a) and 5(2)(b) of the Act. Specifically, the opponent argues that the respective trade marks are either identical and/or similar and to be registered for identical and/or similar goods. As such, there is a likelihood of confusion.
4. In its counterstatement, the applicant denies the claims made and argues that the respective trade marks are totally different.
5. Both parties filed evidence. A Hearing took place on 4 July 2013. The applicant was represented by Mr Carl Steele for Ashfords LLP. The opponent did not attend but did file written submissions in lieu. All submissions from both parties have been taken into account in reaching this decision and will be referred to as and where appropriate during this decision.

**Opponent's evidence**

6. This is a witness statement, from Mr Lee Curtis, the Trade Mark Director of Harrison Goddard Foote, representatives of the opponent in these proceedings. The following information is contained therein:
7. Exhibit LC1 is a copy of an incorporation document, together with change of name documentation. This shows that the applicant's original name was Mojo Denim Limited. The name change occurred prior to the filing of the trade mark application, the subject of these proceedings. According to Mr Curtis, this means that the motives of the applicant were clear in the development and adoption of the trade mark applied for given the applicant's previous name.
8. Exhibit LC2 is a copy of an original trade mark watch notice, sent to the opponent's German representatives, which identify the trade mark applied for as a MOJO mark.

**The Applicant's evidence**

9. This is a witness statement from Mr Patrick Cahill, a trade marks paralegal of Ashfords LLP, representatives of the applicant in these proceedings. This witness statement contains five exhibits. Each exhibit contains examples of device trade marks in the marketplace for each of the five classes of goods applied for. These are filed in order to support the idea that consumers are commonly exposed to device only trade marks.

**DECISION**

10. The grounds under Section 5(1) and 5(2)(a) of the Act shall be considered first. The relevant parts of the Act read as follows:

“5. - (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if because –  
 (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or  
 (b) .....

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

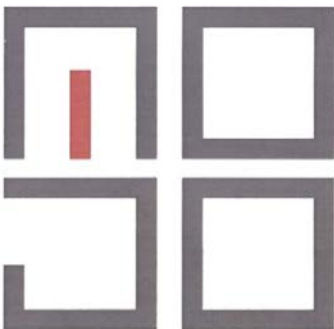
**Section 5(1) and 5(2)(a) – Identical Marks**

11. In deciding whether or not the respective trade marks are identical, the following guidance is borne in mind:

*S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA* [2003] FSR 34 (CJEU):

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

12. The respective trade marks are shown below:

<p>MOJO</p>	
<p>Earlier trade mark</p>	<p>Contested trade mark</p>

13. They are clearly not identical. As such, the grounds under Section 5(1) and 5(2)(a) must fail.

14. The remaining ground, under Section 5(2)(b) of the Act will now be considered.

**Section 5(2)(b) – Likelihood of confusion**

15. The relevant parts of section 5 of the Act read as follows:

(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.

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

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

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

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

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

e) 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*

f) 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*.

(g) 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*,

(h) 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*,

(i) 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*,

(j) 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*,

(k) 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*,

(l) 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*.

### **The average consumer**

17. The case-law informs me that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting goods or service providers can, however, vary depending on what is involved (see, for example, the judgment of the GC in *Inter- Ikea Systems BV v OHIM* (Case T-112/06)).
18. The goods in question are all those that will be purchased by the public at large. The level of attention likely to be displayed will vary from fairly low in the instance of, for example, an umbrella, to fairly high in respect of a piece of jewellery which can be expensive. The average degree of attention is at least likely to be reasonable.

### **Comparison of goods.**

19. When making the comparison, all relevant factors relating to the goods and services in the respective specifications should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU 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.”

20. Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

- “(a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

21. The definition of complementary is also borne in mind. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 325/06 GC* explained when goods are complementary:

“82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P *Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

22. The earlier goods are:

**Class 3**

Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.

**Class 18**

Leather and imitations of leather, and goods made of these materials (included in this class); animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.

**Class 25**

Clothing, footwear, headgear.

23. The contested goods are:

**Class 3**

Soaps; perfumes.

**Class 9**

Sunglasses.

**Class 14**

Jewellery.

**Class 18**

Leather and imitations of leather, and goods made of these materials and not included in other classes; briefcases; suitcases; handbags; wallets; purses; credit card holders; hat boxes; key cases; straps; luggage labels; sport bags; trunks and travelling bags; bags; belts; cases; satchels; pouches; rucksacks; beach bags; handbags; umbrellas; parasols; walking sticks; back packs; jewellery rolls; tote bags; shoulder bags; shopping bags; cosmetics bags; luggage; luggage straps; luggage tags; holdalls; cases for hand-held multimedia devices; cases and bags for portable computers.

**Class 25**

Articles of clothing; lingerie; bras; pants; thongs; stockings; tights; suspender belts; camisoles; dressing gowns; negligees; corsets; night dresses; sleep shirts; sarongs; shoulder wraps; leggings; footwear; boots; shoes; slippers; headgear; belts; trousers; shorts; jeans; wristbands; headbands; hats; gloves; jackets; coats; jumpers; shirts; t-shirts; sweaters; vests; trousers; skirts; waistcoats; waterproof clothing; bathing costumes; pyjamas; undergarments; scarves; socks; suits; dresses; blouses; sun visors; anoraks; articles of clothing for leisurewear; articles of clothing for casualwear; articles of clothing for sportswear; articles of outer clothing; articles of weatherproof clothing; blazers; denims; jerseys; knitwear; parkas; sweatshirts; tops; windcheaters; swimwear; mittens; layettes; sashes and shawls; bathing caps; braces; suspenders; collars; cuffs; ear muffs; fittings for boots and shoes; gaiters; garters.

**Comparison of goods in class 03:**

24. It is noted that soaps and perfumes are included within each specification. They are identical.

**Comparison of goods in class 18:**

25. Each specification includes *leather and imitations of leather, and goods made of these materials*. The terms are identical. Likewise each includes *umbrellas, parasols and walking sticks*. They are also identical. The contested *hat box* can be made from leather and so is identical to the earlier broader term which includes goods made from leather. The remaining contested terms are types of bags or other items used



for storage or transportation which are either covered by the earlier *trunks and travelling bags* or goods made from leather. They are, in either case, identical.

**Comparison of goods in class 25:**

26. The earlier terms are *clothing, footwear, headgear*. The contested terms are specific examples of clothing, footwear or headgear items. They are identical to the class 25 goods of the application

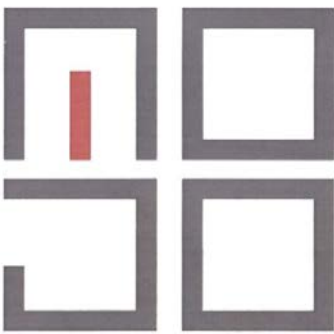
**Comparison of goods in classes 09 and 14:**

27. The opponent argues that these are accessories to clothing and so are similar. Jewellery is worn for personal adornment. This may also be the case for clothing, but its main function is to dress the human body. As above, their nature and that of clothing is different. They do not have the same distribution channels and again are neither in competition, nor complementary.

28. Of course it is true that couturiers that make fashion clothes nowadays also sell items such as sunglasses and jewellery under their marks. However, this is not the rule, and rather applies to (economically) successful designers. Bearing in mind all of the foregoing, it is considered that these goods are not similar to any of the earlier goods.

**Comparison of the marks**

29. The respective trade marks are for convenience, again shown below:

MOJO	
Earlier trade mark	Contested trade mark

**Preliminary remarks**

30. The opponent, in its evidence, has made much of two points. Firstly, that the applicant's company was once called Mojo Denim which, according to the opponent, provides clues as to the applicant's motivation in developing the trade mark applied for. Secondly, that the contested trade mark was caught as a MOJO trade mark by a computerised watching service. It is considered that the relevant consideration for the Tribunal in these proceedings is to compare the trade marks in question objectively bearing in mind the perspective of the average consumer, who in this case will be the public at large. It is this perspective which is the key to the comparison to be undertaken.

31. Visually, the earlier trade mark is clearly a word only trade mark comprised of the element MOJO. The contested trade mark is comprised of two complete squares on

the right hand side and two incomplete squares on the left hand side. The top left square contains a red line in its centre and the bottom left square contains a missing section. Together, the four square like elements appear to form a single larger square. The opponent argues that a consumer would read the contested trade mark as being MOJO. It is considered that this is beyond the realm of reasonable possibilities as the contested trade mark has all the hallmarks of being viewed purely as a device. It is considered that there is clearly no visual similarity between the signs.

32. Likewise, when comparing aurally, it is considered that the earlier trade mark will be clearly articulated as the word MOJO. The same cannot reasonably be said of the contested trade mark which is unlikely to be articulated at all. They are not similar.
33. Finally, conceptually the earlier trade mark will be understood as meaning a charm, a spell or as someone who has influence. As this will not reasonably be read in the contested trade mark, the marks are considered to not be similar conceptually.
34. Consequently, the respective trade marks are not similar, indeed they are clearly dissimilar.
35. Owing to the absence of similarity of the trade marks, neither the identity of goods nor the distinctiveness of the earlier trade mark can have an effect upon the outcome. There is not a likelihood of confusion and the ground of opposition under section 5(2)(b) is dismissed.

## **COSTS**

36. The applicant has been successful and so is entitled to a contribution towards its costs. The applicant is therefore awarded the sum of £1700. This sum is calculated as follows:

Considering opposition - £200

Statement of Case in Reply - £300

Considering Evidence - £350

Preparing and Filing Evidence - £350

Preparation for and attendance at Hearing - £500

37. I order ars Parfum Creation & Consulting GmbH to pay Mio Ottimo Jeans Officino Limited the sum of £1700. 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.
38. The above sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 27<sup>th</sup> day of August 2013**

**Louise White**

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