

**O-224-15**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION 3064158  
BY YASMINE AL SAIRAFI  
TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 14:**

**Chameli**

**AND**

**OPPOSITION THERETO (NO. 403142) BY  
CHAMILIA LLC**

## **Background and pleadings**

1. This dispute concerns the registration of the trade mark **Chameli**. It was filed by Yasmine Al Sairafi (“the applicant”) on 14 July 2014 and was published for opposition purposes on 8 August 2014. Registration is sought for the following class 14 goods:

Fashion jewellery; Jewellery of precious metals; Jewellery, precious stones; Gold jewellery; Items of jewellery; Jewellery coated with precious metals; Jewellery containing gold; Jewellery fashioned of precious metals; Jewellery fashioned of semi-precious stones; Jewellery for personal wear; Jewellery in precious metals; Jewellery in semi-precious metals; Jewellery in the form of beads; Jewellery incorporating diamonds; Jewellery incorporating precious stones; Jewellery items; Jewellery made from gold; Jewellery made from silver; Jewellery made of crystal; Jewellery made of crystal coated with precious metals; Jewellery made of plated precious metals; Jewellery made of precious metals; Jewellery made of precious stones; Jewellery made of semi-precious materials; Jewellery products; Precious jewellery; Rings [jewellery]; Rings [jewellery] made of precious metal.

2. Registration is opposed by Chamilia LLC (“the opponent”) under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on its earlier community trade mark **CHAMILIA** which is registered for the following goods in class 14<sup>1</sup>:

Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewelry, necklaces, bracelets, bangles, anklets, beads, earrings; precious stones; horological and chronometric instrument

The opponent’s mark was filed on 2 December 2005 and registered on 1 June 2010.

3. The applicant filed a counterstatement accepting that the respective goods are identical or similar, but denying that the respective marks are similar and, consequently, denying that there is a likelihood of confusion.

4. Both sides have professional representation, the opponent being represented by Taylor Wessing LLP, the applicant by Kilburn & Strode LLP. Both sides filed evidence. Neither requested a hearing. The opponent filed written submissions in lieu of a hearing, the applicant did not. The applicant does, however, rely on submissions it made earlier in the proceedings.

5. The applicant’s evidence is given by Mr Ryan Pixton, a trade mark attorney with Kilburn & Strode. He gives evidence about the meaning of the word Chameli, the Hindi equivalent of the word Jasmine. The opponent’s evidence is given by Mr Jason Rawkins, a partner at Taylor Wessing. He gives evidence about the percentage of

---

<sup>1</sup> The mark is also registered for other goods and services but these are not relied on by the opponent.

UK residents that are Hindu and, also, evidence about the availability of cheap jewellery items in the UK. I will return to the evidence when it is necessary to do so.

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

6. Section 5(2)(b) of the Act states that:

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

(a) .....

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

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

7. The following principles are gleaned from the judgments of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

(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 be dominated by one or more of its components;

(f) however, it is also 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 creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of goods**

8. The applicant accepts the opponent's claim that the respective goods are identical or similar. However, given point (g) above, whether the goods are identical or just similar (and to what degree) is a factor that needs to be taken into account in the global assessment of the likelihood of confusion. I must, therefore, give my view on the matter. My view is that all of the goods sought to be registered by the applicant are identical to goods covered by the opponent's specification. All the applicant's goods are listed as jewellery of one form or another. As the opponent notes in its submissions, the earlier mark covers jewellery at large. As such, all the applied for goods fall within the ambit of that term and, consequently, they can be considered as identical<sup>2</sup>.

### **The average consumer**

9. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

"60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied

---

<sup>2</sup> See *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)(OHIM)* Case T-133/05.

objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

10. The average consumer is a member of the general public. The applicant submits that the average consumer will pay a high level of attention when selecting jewellery because they can be “extremely high value”. The opponent submits that this is not always the case because there are many items of inexpensive jewellery where little attention will be paid in the selection process. The opponent’s evidence contains some examples of inexpensive jewellery. I accept the evidence that some items of jewellery are inexpensive and I accept the submission that when selecting inexpensive items of jewellery no more than an average level of attention will be paid. I also observe that inexpensive items of jewellery will no doubt be purchased more frequently than the high cost items. However, all that being said, some jewellery is expensive. For example, if the average consumer is selecting diamond jewellery or solid gold items, a high degree of attention will be paid. Therefore, the level of attention will vary depending on what exactly is involved.

11. The goods will be selected from counters, display shelves, viewed in shop windows, selected from the Internet or from catalogues. This suggests a visual process. However, the selection of jewellery will often involve a salesperson who will show the items and/or give advice, so the aural impact of the marks is not to be ignored in the assessment.

### **Comparison of marks**

12. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

13. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are:

**Chameli v CHAMILIA**

14. Both marks are single words and, thus, do not break down into distinctive/dominant components beyond the words of which they are comprised. I should also add that the difference in casing between the marks is not significant because either mark could notionally be used in upper case and/or sentence case.

15. Visually, the opponent highlights that the marks share certain letters and, also, the order of some of those letters. It states that the exceptions to this are the different 5<sup>th</sup> letters in the marks (the “e” for the “i”) and the additional final letter A in CHAMILIA. It submits that it is striking that the first four letters are shared CHAM- and that the first 6 letters are “virtually identical” Chamel-/CHAMIL-. The opponent submits that the beginnings of marks are generally more important and is normally the part more likely to catch the attention of the average consumer. The applicant highlights that one mark consists of 8 letters, the other 7 and it highlights the difference created by the “e” for the “i” and, also, the different final letter.

16. There are clearly some visual similarities and differences as highlighted by the parties. However, I come to the view that there is a reasonable degree of visual similarity given the similar length of the marks, the shared first 4 letters and the shared 6<sup>th</sup> & 7<sup>th</sup> letters. In a comparison involving the marks at issue here, and notwithstanding the differences that do exist, the similarities strike me as reasonably significant.

17. Aurally, the opponent submits that the beginnings of the marks sound the same, and that any difference between the sounds created by the middle parts of the marks is very small because the average consumer will pronounce them in a very similar way. The applicant submits that the differences result in the marks being “impossible to confuse”. It submits that one is made up of two syllables, the other three, that there are different middle vowels and a different ending.

18. With marks such as this there will be variations in the way in which they will be articulated, however, the most likely pronunciations will be:

Chameli: CAM-EL-E or CHAM-EL-E

CHAMILIA: CAM-IL-EAR or CHAM-IL-EAR

19. Again, there are similarities and differences. The beginning sounds are the same. The middle sounds are very similar. The end sound has some similarity. Overall, there is a reasonable degree of aural similarity.

20. In terms of informing the conceptual comparison, the applicant filed evidence showing that Chameli is the Hindu word meaning Jasmine. The applicant’s forename is Yasmine so this may have been the origin of the mark. Although the opponent does not challenge any of this as a matter of fact, it has provided evidence of the low percentage of the UK population who are Hindus and, therefore, that any conceptual difference the meaning of Chameli may create is not relevant to the vast majority of the UK population. I agree. That a small percentage of the population may see a conceptual difference is of little importance. For the vast majority of UK average consumers both marks will be seen as invented word, neither party identifying a meaning for either mark beyond that already mentioned. As the applicant submits,

this means that there is no conceptual similarity, the position being, effectively, neutral.

### **Distinctiveness character of the earlier mark**

21. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

22. The earlier mark is the word CHAMILIA. As an invented word, it is inherently distinctive to a high degree. No use has been presented to enhance its distinctiveness.

### **Likelihood of confusion**

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

24. The goods are identical. However, depending on what is involved, the goods may be selected with either a normal or higher degree of perspicacity. The applicant is in its best position when considered from the perspective of jewellery such as diamond jewellery because the average consumer will pay a higher degree of attention than the norm when selecting them. Whilst it is true that this may reduce the effects of imperfect recollection (because more care is being applied), this factor

should not be cast aside completely. This is particularly so in a case such as this where neither mark has a clear meaning, resulting in no conceptual hook to aid the average consumer's recollection. Taking all factors into account, including the high degree of distinctive character of the earlier mark, I consider that there is a likelihood of confusion. The degree of visual and aural similarity means that, despite the higher level of care and attention being deployed, the marks may still be imperfectly recalled. The finding extends to all the goods sought to be registered. The opposition succeeds.

### **Costs**

25. The opponent has succeeded and is entitled to a contribution towards its costs. My assessment is as follows:

*Official Fee - £100*

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

*Filing and considering evidence - £300<sup>3</sup>*

*Written submissions - £300*

26. I therefore order Yasmine Al Sairafi to pay Chamilia LLC the sum of £1000. This should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 20th day of May 2015**

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

---

<sup>3</sup> This is below the scale minimum in view of the brevity of the evidence filed in the proceedings.