

**O-289-15**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NOS. 3071070 & 3071073 BY  
MANIAC SQUAT LIMITED**

**TO REGISTER:**

**HOLY  
HOLY**

**&**

**WOODY WOODMANSEY'S**

**HOLY  
HOLY**

**AS TRADE MARKS  
IN CLASSES 9, 16, 25 & 41**

**AND**

**IN THE MATTER OF CONSOLIDATED OPPOSITIONS THERETO  
UNDER NOS. 600000203 & 600000204 BY  
CBM CREATIVE BRANDS MARKEN GMBH**

## BACKGROUND

1. On 4 September 2014, Maniac Squat Limited (“the applicant”) applied to register the trade marks shown on the cover page of this decision. The applications were published for opposition purposes on 5 December 2014 (no. 3071073) and 19 December 2014 (no. 3071070) for the following goods and services:

**Class 9** - Sound storage media, image storage media and data storage media, all being pre-recorded; video and/or sound recordings; compact disks; audio tapes, cassettes and cartridges; video tapes, cassettes and cartridges; magnetic tapes, and discs all for bearing sound or video recordings; optical disks bearing sound or video recordings; video games.

**Class 16** - Printed matter, newsletters, books, brochures, posters, decals; all featuring or relating to a musical group; musical notes and scores.

**Class 25** - Clothing; T-shirts, sweatshirts, jackets; headgear, hats, caps; footwear.

**Class 41** - Entertainment services provided by a recording artist; musical entertainment services; sound recording and video entertainment services; concert, musical and video performances; television and radio entertainment services; entertainment services by stage production and cabaret; production of video and/or sound recordings; presentation, production and performance of shows, musical shows, concerts, videos and radio and television programmes; recording, film, video and television studio services; audio, film, video and television recording services; publishing; music publishing; sound recording, film and video production and distribution services.

2. The applications are opposed by CBM Creative Brands Marken GmbH (“the opponent”) under the fast track opposition procedure. The oppositions, which are directed against all of the goods and services in classes 9, 25 and 41 of the applications, are based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The trade marks and goods relied upon by the opponent are shown below:

Community Trade Mark (“CTM”) no. 11306545 for the trade mark: **HOLY**; applied for on 30 October 2012 and for which the registration procedure was completed on 13 March 2013:

**Class 25** - Clothing, footwear, headgear.

CTM no. 11946911 for the trade mark: **HOLY**; applied for on 1 July 2013 and for which the registration procedure was completed on 26 November 2013:

**Class 9** - Optical instruments, in particular spectacles, sunglasses, skiing goggles, correction spectacles, spectacle frames, spectacle lenses, spectacle cases.

3. In relation to the competing trade marks, the opponent states:

**No. 3071070**

“The trade mark against which the opposition is directed is visually, aurally and conceptually similar to the registered trade mark on which the opposition is based. The [application] simply reproduces twice, the earlier mark in its entirety.”

**No. 3071073**

The opponent repeats the comment above and adds:

“While the [application] also includes the words WOODY WOODMANSEY’S, these are in a far smaller, and hence less prominent font. HOLY HOLY is the dominant and distinctive element.”

4. In relation to the competing goods and services, the opponent states:

**Class 25**

“The goods against which the opposition is directed are all identical to the goods on which the opposition is based.”

**Classes 9 and 41**

“The goods and services against which the opposition is directed are all identical or similar to the goods on which the opposition is based. “Optical instruments” as covered by the earlier mark, includes as a subset “optical disks” as well as “compact disks”, “sound storage media, image storage media and data storage media”. All these goods are therefore identical to goods covered by the earlier mark. The remaining class 9 goods covered by the [applications] and all the class 41 services, are similar to the goods covered by the earlier mark.”

5. The applicant filed counterstatements in which the basis of the oppositions is denied; it does, however, admit that the competing goods in class 25 are identical.

6. In an official letter dated 24 April 2015, the Tribunal directed that the proceedings be consolidated.

7. Rule 6 of the Trade Marks (Fast Track Opposition)(Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

8. The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions. No leave was sought in respect of these proceedings.

9. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise written arguments will be taken. A hearing was neither requested nor considered necessary; the opponent filed written submissions which I will refer to, as necessary, below.

## **DECISION**

10. The opposition is based upon section 5(2)(b) of the Act, which reads as follows:

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

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

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

11. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.-(1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

12. In its counterstatement, the applicant states:

“5. It is denied that the earlier marks constitute earlier trade marks within s6(1)(a) of the Act, since both are subject to cancellation notifications made on 26 November 2014.”

13. The applicant has, however, provided no information in relation to the nature and scope of the cancellation actions nor has it requested a stay in these proceedings to await their conclusion. In those circumstances, and having confirmed at the time of writing this decision that the registrations upon which the opponent relies are extant, the proceedings must continue accordingly. The trade marks upon which the

opponent is relying qualify as earlier trade marks under the above provisions. As these earlier trade marks had not been registered for more than five years when the applications for registration were published, they are not subject to proof of use, as per section 6A of the Act. The opponent is, as a consequence, entitled to rely upon all of the goods it has identified.

### **Section 5(2)(b) – case law**

14. The following principles are gleaned from the decisions 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.

The principles:

- (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 and services

15. The competing goods and services are as follows:

Opponent's goods being relied upon	Applicant's goods and services being opposed
<p><b>Class 9</b> - Optical instruments, in particular spectacles, sunglasses, skiing goggles, correction spectacles, spectacle frames, spectacle lenses, spectacle cases.</p> <p><b>Class 25</b> - Clothing, footwear, headgear.</p>	<p><b>Class 9</b> - Sound storage media, image storage media and data storage media, all being pre-recorded; video and/or sound recordings; compact disks; audio tapes, cassettes and cartridges; video tapes, cassettes and cartridges; magnetic tapes, and discs all for bearing sound or video recordings; optical disks bearing sound or video recordings; video games.</p> <p><b>Class 25</b> - Clothing; T-shirts, sweatshirts, jackets; headgear, hats, caps; footwear.</p> <p><b>Class 41</b> - Entertainment services provided by a recording artist; musical entertainment services; sound recording and video entertainment services; concert, musical and video performances; television and radio entertainment services; entertainment services by stage production and cabaret; production of video and/or sound recordings; presentation, production and performance of shows, musical shows, concerts, videos and radio and television programmes; recording, film, video and television studio services; audio, film, video and television recording services; publishing; music publishing; sound recording, film and video production and distribution services.</p>

16. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“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”.

17. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) 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;
- e) 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.

18. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

19. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is

equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

20. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

21. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the General Court (“GC”) stated:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

22. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

“...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”.

In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”



Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

For the sake of convenience, I will consider the matter on a class-by-class basis.

### **Class 25**

23. In its counterstatement, the applicant admits that its goods in this class i.e. “Clothing; T-shirts, sweatshirts, jackets; headgear, hats, caps; footwear” are identical to those of the opponent i.e. “Clothing, footwear, headgear”; I agree.

### **Class 9**

24. In its counterstatement, the applicant states:

“20. It is admitted that Optical Instruments are covered by the Earlier Mark, but it is denied that the specified goods in Class 9 of [the applications] are the same or similar. Optical instruments are not the same or similar to optical disks or compact disks. An “Optical instrument” is defined as “an instrument designed to aid vision” (The Free Dictionary.com, vocabulary.com) whereas an optical disk is “a disk that can be read from and often written to by a laser” (Chambers) and a compact disk is defined as “a small disc from which digitally recorded sound, graphics or text can be read by a laser” (Chambers).

21. Furthermore, there are many ways that files can be stored on media (for example on records and digital tape) that have no “optical” element.

22. The Applicant requests proof that Optical Instruments include optical disks; compact disks; and pre-recorded sound storage media, image storage media and data storage media.

23. The Opponent states that the remaining Class 9 goods of [the applications] are similar to Optical Instruments. The Applicant denies similarity, and requires proof that video recordings, sound recordings, audio tapes, cassettes and cartridges, magnetic tapes, discs for bearing sound or video recordings and video games are similar to Optical Instruments”.

25. In its submissions, the opponent states:

“20. The Applicant offers a very narrow definition of an optical instrument. A more straightforward definition of Instrument (from the mainstream OED) is “a thing with or through which something is done or effected”.

21. When assessing the scope and meaning of a specification, the test to be applied is whether the applicant’s descriptions of his goods or services are such that permit an average person engaged in the relevant trade to clearly ascertain the nature of the goods or services for which the applicant seeks to register his trade mark, without the need for further explanation.

22. As the Applicant confirms, a CD is an optical disc and this falls comfortably within the broader definition of optical instrument (as defined above), without the need for further explanation.

23. Sound storage media, image storage media and data storage media, all being pre-recorded; video and/or sound recordings; compact disks; discs all for bearing sound or video recordings; optical disks bearing sound or video recordings would all include compact or optical discs and must, therefore, be regarded as identical to optical instruments.

24. The remaining class 9 goods all fulfil essentially the same function and are alternative media to compact discs. They are complementary and/or in competition with - and must, therefore, be regarded as closely similar to-optical instruments.”

### **Class 41**

26. In its counterstatement, the applicant states:

“24. The Opponent states that all the Class 41 services of [the applications] are similar to the goods specified in Classes 9 and 14 of the Earlier Mark [in fact, the opponent only relies upon its goods in class 9]. This is denied by the Applicant. The Applicant requires proof of such similarity for each of the services set out in Class 41 of [the applications].”

27. In its submissions, the opponent states:

“26. It is self-evident that the consumer would expect an artist providing services [in class 41] to also offer recordings of the same in class 9, and the corresponding goods and services must therefore, be regarded as complementary and, hence, similar.

27. The similarity asserted...is in accordance with UK Office practice (as set out, for example, in the Cross Search list), which confirms that that, when applications are filed covering “Films and video production and distribution; Record label services” the examiner must cross search against sound and video recordings in class 9.”

28. The phrase “optical instruments...” in the opponent’s specification in class 9 must be interpreted in light of the guidance provided by the courts in *Beautimatic* i.e. words in specifications should be given their natural meaning and *YouView* i.e. trade mark specifications should “not be allowed a liberal interpretation...” and “where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning...”. In my view, the ordinary and natural meaning the average consumer would attribute to the term “optical instruments” is, as the applicant suggests, an implement or tool for aiding vision. It would, in my view, include, for example, binoculars, telescopes, microscopes and instruments used by opticians for sight testing purposes. Approaching the term

“optical instruments...” on that basis, and comparing the type of goods that are likely to be encompassed by this term with the applicant’s goods in class 9 and services in class 41, and keeping in mind the factors identified above i.e. nature, users, intended purpose, method of use, trade channels and whether there exists a complementary or competitive relationship between them, I am unable to find any meaningful degree of similarity. As a consequence, I have concluded that there is no similarity between the opponent’s goods in class 9 and the applicant’s goods and services in classes 9 and 41. Where there is no similarity in the competing goods and services there can be no likelihood of confusion; I will return to this point later in this decision.

### **The average consumer and the nature of the purchasing process**

29. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods; I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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 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.”

30. Whilst the parties provided a number of submissions in relation to this aspect of the case, given my conclusions above in relation to the applicant’s goods in class 9 and services in class 41, it is only necessary for me to consider the position in relation to the goods in class 25. In its submissions, the opponent states:

“42. For class 25 items in particular, the purchasing act will be primarily visual on account of the goods being commonly purchased based on appearance. Aural considerations may also play a part.”

31. The average consumer for the goods in class 25 is a member of the general public. As to the manner in which such an average consumer will select these goods, in *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs)* Joined cases T-117/03 to T-119/03 and T-171/03, the GC considered the level of attention paid to and the manner in which clothing is selected. It stated:

“43 It should be noted in this regard that the average consumer’s level of attention may vary according to the category of goods or services in question (see, by analogy, Case C-342/97 Lloyd Schuhfabrik Meyer [1999] ECR I-3819, paragraph 26). As OHIM rightly pointed out, an applicant cannot simply assert that in a particular sector the consumer is particularly attentive to trade marks without supporting that claim with facts or evidence. As regards the clothing sector, the Court finds that it comprises goods which vary widely in

quality and price. Whilst it is possible that the consumer is more attentive to the choice of mark where he or she buys a particularly expensive item of clothing, such an approach on the part of the consumer cannot be presumed without evidence with regard to all goods in that sector. It follows that that argument must be rejected.

50. The applicant has not mentioned any particular conditions under which the goods are marketed. Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”



32. As items of clothing are, most likely to be the subject of self selection from traditional retail outlets on the high street, catalogues and websites, visual considerations are likely to dominate the selection process, though, as the opponent suggests, not to the extent that aural considerations can be ignored. The cost of the goods at issue can vary considerably. Nevertheless, as factors such as material, size, colour, cost and compatibility with other items may all come into play, the average consumer will, in my experience, pay an average degree of attention when making their selection. This level of attention will, in my experience, increase as the cost and importance of the item increases.

### **Comparison of trade marks**

33. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade 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.”

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

Opponent's trade mark	Applicant's trade marks
<p>HOLY</p>	<p><u>No. 3071070</u></p>  <p><u>No. 3071073</u></p> <p>WOODY WOODMANSEY'S</p> 

### The opponent's earlier trade mark

35. The opponent's trade mark consists of the English language word HOLY presented in upper case; it has no distinctive or dominant components. The overall impression it conveys will be of a single word, the meaning of which will be well known i.e. "of, relating to, or associated with God or a deity; sacred" (collinsdictionary.com refers).

### No. 3071070

36. The first of the applicant's trade marks consists of two elements (the second element being identical to the first and placed below it). The first element consists of the capital letters "H", "L" and "Y". Between the letters "H" and "L" there appears a lower case letter "o" (presented in a smaller font than and positioned towards the top of the letters which accompany it); the letter "o" is underlined. In its submissions, the opponent argues that:

"7. The opposed marks, while adopting a degree of stylisation are fundamentally, word marks with no other visual matter added."

37. In its counterstatement, the applicant argues that the distinctive and dominant element of its trade mark is either the repetition of the word "HOLY" or:

"9...its stylised form, with one word above the other, with a distinctive graphic device associated with each letter "o".

38. I accept that the combination of letters in different sizes and cases and the underlining which appears below the letter "o" will contribute to the overall impression the applicant's trade mark conveys. Despite the stylisation, it will still be seen clearly by the average consumer as the word "HOLY", a word which is so well

known, that, in my view, the overall impression conveyed by the trade mark will be based upon a simple repetition of this word.

39. The manner in which the applicant's trade mark is presented obviously creates a degree of visual difference between the competing trade marks. However, the fact that the competing trade marks consist of either the word HOLY alone or a repetition of what will, in my view, be construed as the word HOLY, still results in at least a reasonable degree of visual similarity between them.

40. Insofar as aural similarity is concerned, the pronunciation of the opponent's trade mark as a two syllable word i.e. HO-LY is entirely predictable. Notwithstanding its presentation, given my conclusions above, the applicant's trade mark will be pronounced as the four syllable combination HO-LY HO-LY. The simple repetition of a word identical to the opponent's trade mark results, in my view, in a high degree of aural similarity between the competing trade marks.

41. Although in its counterstatements the applicant takes issue with the manner in which the opponent pleaded this aspect of its case, what concepts, if any, the competing trade marks convey is a matter for me. As I mentioned earlier, the word HOLY will be well known as meaning "of, relating to, or associated with God or a deity; sacred". In its counterstatement the applicant argues:

"15. Furthermore, if there is any concept associated with the subject mark, it is the association with the applicant's band, the name of which is taken from a famous song by David Bowie (and the recording of it, on which the band members played)."

42. Although the applicant's counterstatement incorporates what it describes as the results of "an internet search for "holy holy", the extract included is of such poor quality the details are impossible to discern. However, even if I could, it would not assist the applicant. If the applicant wished to file evidence to support its assertions, it should have sought leave to do so at the appropriate time. As it did not, and as its assertions are not a matter of which I am entitled to judicial notice, they do not assist it. Having concluded that the opponent's trade mark has the conceptual meaning I have attributed to it above, I agree with the position adopted in the opponent's submissions i.e.

"13. The repetition of the word in the opposed marks serves only to emphasise the concept; it does not alter it or introduce any alternative or different concept..."

43. In my view, the concrete conceptual message that will be conveyed by both trade mark focuses on, as the opponent puts it "something religious". In my view, this results in the competing trade marks being (if not conceptually identical) conceptually similar to the highest degree.

44. In summary, the opponent's earlier trade mark and the first of the applicant's trade marks are visually similar to a reasonable degree, aurally similar to a high degree and if not conceptually identical, are conceptually similar to the highest degree.

**No. 3071073**

45. As to the applicant's second trade mark, many of the same considerations apply. However, in its counterstatement, the applicant makes various references to the fact that Woody Woodmansey is:

“8...the name of the famous band member who played on the recording of David Bowie's song Holy Holy”.

46. Based on the above assertion, the applicant argues, in the alternative, that it is the name Woody Woodmansey which is the dominant element of the applicant's second trade mark. For the reasons I have already described, in the absence of evidence, this submission does not assist the applicant. Approaching the applicant's second trade mark on a notional basis, in its submissions the opponent states:

“9. [This trade mark] includes a person's name which will, the opponent admits be perceived by the consumer. However, HOLY HOLY is presented in a markedly larger font, rendering it the dominant and distinctive component to which the eye is readily and inevitably drawn.”

47. The applicant's second trade mark includes the words WOODY WOODMANSEY'S which the opponent admits will be recognised as the name of a person; I agree. Although this name is presented in a much smaller and lighter font than the words which accompany, it will not go unnoticed and will, given its positioning as the first element in the trade mark, make a distinctive contribution to the overall impression the trade mark conveys. Although its presence will inevitably reduce the degree of visual and, as it will be verbalised, the degree of aural similarity I have identified above, it is the repetition of what will be construed as the word HOLY which, in my view, remains the dominant element of the applicant's second trade mark. Because, as the opponent suggests, the inclusion of a personal name will not alter the conceptual meaning conveyed by the words HOLY HOLY, the conceptual message conveyed by the applicant's second trade mark will still be, at least in part, a religious one and the competing trade marks are still, in my view, conceptually similar to a high degree.

**Distinctive character of the opponent's trade mark**

48. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

49. These are fast track opposition proceedings in which it was not necessary for the opponent to provide evidence of the use it may have made of its earlier trade mark; as a consequence, I have only the inherent characteristics of the opponent's trade mark to consider. In its counterstatement, the applicant states:

"11. If the opponent is correct, then it will have a monopoly over the common English word "holy", which means that the opponent's earlier marks are not capable of acting as a source of origin."

And:

"12...Holy is a common English word, which can be found in 120 trade mark registrations shown in the UK IP Office's database..."

And:

"16. The earlier marks are not capable of acting as a source of origin, since they are no more than an adjective, which could be applied to the goods in question."

50. In its submissions, the opponent states:

"29. ...HOLY has no inherent link to any of the goods or services for which the Earlier Trade mark is registered. It is neither descriptive nor non-distinctive and should, therefore, be considered a trade mark with at least a normal level of distinctiveness.

30. It is noted that the applicant claims in its counterstatements that the word HOLY "is not capable of acting as a source of origin, since [it] is no more than an adjective, which could be applied to the goods in question".

31. Clearly, the Opponent disagrees with this assertion and we note that no supporting evidence, or indeed submissions, to support this bald claim were offered. We merely point out that the mark is registered and it is not open to the office to conclude the Earlier Trade Marks are non-distinctive (Case T-10/09 Formula One Licensing B. V. upheld by the CJEU in C-196/11)."

The comments of the CJEU in the case mentioned by the opponent are as follows:

"41. ....it is not possible to find, with regard to a sign identical to a trade mark protected in a Member State, an absolute ground for refusal, such as the lack of distinctive character, provided by Article 7(1)(b) of Regulation No 40/94 and Article 3(1)(b) of Directives 89/104 and 2008/95. In this respect, it should be noted that the characterisation of a sign as descriptive or generic is equivalent to denying its distinctive character.

42. It is true that, as is clear from paragraph 48 of the judgment under appeal, where an opposition, based on the existence of an earlier national trade mark, is filed against the registration of a Community trade mark, OHIM and, consequently, the General Court, must verify the way in which the relevant



public perceives the sign which is identical to the national trade mark in the mark applied for and evaluate, if necessary, the degree of distinctiveness of that sign.

43. However, as the appellant rightly points out, their verification has limits.

44. Their verification may not culminate in a finding of the lack of distinctive character of a sign identical to a registered and protected national trade mark, since such a finding would not be compatible with the coexistence of Community trade marks and national trade marks or with Article 8(1)(b) of Regulation No 40/94, read in conjunction with Article 8(2)(a)(ii).”

51. In my view, the opponent’s position is to be preferred. The applicant’s reference to the state-of-the-register is (as per the comments in this regard in, inter alia, *British Sugar* mentioned above) irrelevant. Not only are the opponent’s earlier trade marks validly registered, in relation to (at least) clothing, footwear and headgear in class 25, I agree its earlier trade mark is neither descriptive nor non-distinctive. I also agree with the opponent that, absent use, its earlier trade mark is possessed of a normal/average degree of inherent distinctive character.

### **Likelihood of confusion**

52. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent’s trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

53. As per the comments of the CJEU in *Waterford Wedgwood plc v OHIM* Case C-398/07, there must be some similarity in the competing goods and services to engage the test for the likelihood of confusion. Earlier in this decision, I concluded that there was no meaningful similarity between the opponent’s goods in class 9 and the goods and services in classes 9 and 41 of the applications. Where there is no similarity in the competing goods and services there can be no likelihood of confusion and the opposition against the goods and services in classes 9 and 41 fails accordingly.

### **No. 3071070**

54. In relation to its goods in class 25, the applicant admits that these are identical to the opponent’s goods in the same class. Insofar as the first of the applicant’s trade marks is concerned, I have found the opponent’s earlier trade mark to be visually similar to it to a reasonable degree, aurally similar to a high degree and if not conceptually identical, conceptually similar to the highest degree. Notwithstanding

the graphical aspect of the applicant's trade mark, the degree of visual and aural similarity I have identified, combined with the identical or very high degree of conceptual similarity arising from what I have concluded will be construed by the average consumer as the repetition of the word HOLY (which will, in my view, fix itself in the average consumer's mind and prompt their recollection), is sufficient to result in a likelihood of indirect confusion (the visual differences being sufficient to avoid the competing trade marks being directly confused).

**No. 3071073**

55. In relation to the applicant's second trade mark, I have concluded that while the inclusion of the words WOODY WOODMANSEY'S inevitably reduces the degree of visual and aural similarity with the opponent's earlier trade mark, the degree of conceptual similarity remains largely unaffected. In *Whyte and Mackay Limited v Origin Wine UK Limited and Dolce C Invest Inc* ("JURA ORIGIN") [2015] EWHC 1271 (Ch) (6.5.15), Arnold J stated:

"18. The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19. The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20. The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21. The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors."

56. In view of the above guidance and my own conclusions reached earlier, the average consumer will, in my view, perceive the applicant's second trade mark as consisting of two elements i.e. WOODY WOODMANSEY'S and HOLY HOLY, both of which have a distinctive significance which is independent of the significance of the trade mark as a whole. In those circumstances, the reduced degree of visual and aural similarity resulting from the inclusion of the words WOODY WOODMANSEY'S in the applicant's second trade mark, is offset by (at least) the high degree of conceptual similarity resulting from the presence of the words HOLY HOLY as the dominant element, which will, for the reasons indicated above, still, in my view, result in a likelihood of indirect confusion.

### **Overall conclusion**

57. The class 16 elements of the applications were not opposed and may in due course proceed to registration. The oppositions have failed in relation to classes 9 and 41 and succeeded in relation to class 25. Subject to any successful appeal, the applications may also proceed to registration in classes 9 and 41 but will be refused in respect of class 25.

CBM

### **Costs**

58. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. I begin by reminding myself that the oppositions were directed at three classes in the applications and the opponent has only been successful in relation to one class. As the applicant has been more successful than the opponent, it is entitled to a contribution towards its costs. The award must, however, take into account the consolidated nature of the proceedings and reflect the partial nature of the opponent's success. Using the TPN as a guide and bearing all of the above in mind, I award costs to the applicant on the following basis:

Preparing statements and considering the opponent's statements:	£300
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<b>Total:</b>	<b>£300</b>
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59. I order CBM Creative Brands Marken GmbH to pay to Maniac Squat Limited the sum of **£300**. This sum is to 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 22nd day of June 2015**

**C J BOWEN**  
**For the Registrar**