

**O-300-15**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 3031086  
BY PIA HALLSTROM LIMITED TO REGISTER THE TRADE MARK**

**PIA HALLSTROM**

**IN CLASSES 14, 18 AND 25**

**AND IN THE MATTER OF OPPOSITION  
THERE TO UNDER NO 401741  
BY JOHN RICHARD BEALE**

## BACKGROUND

1) On 18 November 2013, Pia Hallstrom Limited (“the applicant”) applied under the Trade Marks Act 1994 (“the Act”) for registration of the mark PIA HALLSTROM in respect of the following list of goods:

**Class 14:** *Jewellery articles; Jewellery being articles of precious metals; Jewellery being articles of precious stones.*

**Class 18:** *Handbags, purses and wallets.*

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

2) On 13 December 2013 the application was published in the Trade Marks Journal and on 11 February 2014, John Richard Beale (“the opponent”) filed notice of opposition to the application. The grounds of opposition are in summary:

- a) the application offends under Section 5(2)(b) of the Act because it is similar to two earlier marks in the name of the opponent and in respect of identical or similar goods and that because of these similarities, a likelihood of confusion exists. The relevant details of the two earlier marks relied upon are:

Relevant details	Goods relied upon
<p>2311309</p> <p>PIA</p> <p>Filing date: 21 September 2002</p> <p>Date of entry in register: 7 March 2003</p>	<p><b>Class 14:</b> <i>Jewellery made from gold, silver, precious and semi-precious stones, costume jewellery, clocks and watches, silver plated trinket boxes and pill boxes.</i></p> <p><b>Class 18:</b> <i>Handbags, purses and travelling bags made of leather and of textile.</i></p>
<p>Community Trade Mark (CTM) 4077996</p> <p>PIA</p> <p>Filing date: 18 October 2004</p> <p>Date of entry in register: 17 January 2006</p>	<p><b>Class 14:</b> <i>Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments.</i></p> <p><b>Class 18:</b> <i>Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks</i></p>

	<p><i>and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.</i></p> <p><b>Class 25:</b> <i>Clothing, footwear, headgear.</i></p>
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b) the application offends under Section 5(4)(a) of the Act because the opponent has continuously and extensively used the mark PIA in Oxford since 2002 in respect of clothing. It therefore “has developed valuable goodwill in the brand”. It is claimed that use of the applicant’s mark in respect of clothing, footwear and headgear would result in misrepresentation and damage.

3) The applicant subsequently filed a counterstatement denying the opponent’s claims. The opponent’s two earlier marks are potentially subject to the proof of use provisions contained in Section 6A of the Act because they were registered more than five years before the publication of the contested mark. However, under Section 7 of the Form TM8, the applicant has indicated that it does not wish to put the opponent to such proof of use. The consequence of this is that the opponent does not need to provide evidence of use of its mark and it can rely on the full list of goods contained in its two earlier marks. The applicant claims that the mark consists of the full name of the person completing the form and that its products do not compete with the opponent’s goods because they are sold through only luxury stores in London, Paris and New York. It is also claimed that the respective goods are not similar or identical because the “opponents products are generic products are available from many high street or internet sellers” whereas the applicant’s “products are only available in very selected luxury stores in Central London and on my own stand alone web-site [www.piahallstrom.com](http://www.piahallstrom.com)”. It is suggested that, because of this, “it would be impossible for the ‘general public’ to mistake the two products”.

4) Only the opponent filed evidence and submissions. I will not summarise the submissions but refer to them as appropriate in my decision. Both sides ask for an award of costs. No hearing was requested and so this decision is taken following a careful perusal of the papers.

**Opponent’s Evidence**

5) This takes the form of a witness statement by Mr Beale. At Exhibits “Figure 3” to “Figure 20” Mr Beale provides sample pages of two of the opponent’s catalogues from each of the years 2005 to 2013. The mark PIA is not visible on the goods themselves, but a stylised form appears on the cover of the catalogue and the website address [www.piajewellery.com](http://www.piajewellery.com) appears at the bottom of every other page. A “welcome” text appears on page 3 of the first catalogue and begins

“At Pia we have been dreaming of Spring. ....” In all the catalogues, the goods illustrated are mostly jewellery, but handbags, ladies’ scarves, ladies’ ponchos, ladies’ jackets, ladies’ gilets, ladies’ coats, skirts, ladies’ cardigans, ladies’ gloves, jewellery boxes, watches, purses and “twin sets” consisting of a pearl necklace and a cardigan are also shown.

6) Mr Beale provides figures for the number of these catalogues it sent each year. These figures range from just under 3 million in 2006 rising to over 4.7 million in 2011 before dropping slightly to just over 4.3 million in 2013.

7) Mr Beale states that the opponent has also operated from the website [www.piajewellery.com](http://www.piajewellery.com), the domain name of which has been owned since August 2002. Since January 2011, the opponent has been using *Google Analytics* software to analyse the usage of its website and produces graphs of this data at Exhibit “Figure 21”. Mr Beale summarises these as showing that over 625,000 different people visited the website in the year 2011, 94% of which were in the UK. In the same year, revenue from UK customers was nearly £3.6 million. In 2012, revenue from UK customers was over £3.1 million. Later in his witness statement, Mr Beale provides significantly higher turnover figures, but he does not state that these are exclusively as a result of trade in the UK.

8) At Exhibits “Figure 25” to “Figure 28”, Mr Beale provides examples of advertisements placed in *The Lady* magazine and the *Telegraph Weekend* newspaper supplement in September 2012, November 2012, February 2013 and November 2013 respectively. These all carry the website address [www.piajewellery.com](http://www.piajewellery.com) and include the name “Pia” in the postal address.

9) Mr Beale states that, currently, the opponent has 15 stores in the UK including York in the North of England, Cardiff and numerous locations in southern England and the Midlands. The last of these shops to open was Kingston-upon-Thames in 2011.

10) At Exhibits “Figure 31” and “Figure 32”, Mr Beale provides undated photographs of packaging bearing a stylised form of the word mark PIA.

## **DECISION**

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

11) Section 5(2)(b) 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) 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:

(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***

13) In assessing the similarity of goods, it is necessary to apply the approach advocated by case law and all relevant factors relating to the respective goods should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the Court of Justice of the European Union (“the CJEU”) stated at paragraph 23:

‘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.’

14) Other factors may also be taken into account such as, for example, the distribution channels of the goods concerned (see, for example, *British Sugar Plc v James Robertson & Sons Limited (TREAT)* [1996] RPC 281).

15) I also bear in mind the following guidance of the General Court (“the GC”) in *G rard Meric v OHIM, T-133/05 (“MERIC”)*:

“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 f r 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 Vedral 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).”

16) For procedural economy, I will restrict my analysis to the consideration of similarity of goods to the list of goods contained in the opponent’s CTM 4077996. Its UK mark does not appear to offer any stronger case.

17) The respective goods are:

Opponent’s goods	Applicant’s goods
<p><b>Class 14:</b> <i>Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments.</i></p> <p><b>Class 18:</b> <i>Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.</i></p> <p><b>Class 25:</b> <i>Clothing, footwear, headgear.</i></p>	<p><b>Class 14:</b> <i>Jewellery articles; Jewellery being articles of precious metals; Jewellery being articles of precious stones.</i></p> <p><b>Class 18:</b> <i>Handbags, purses and wallets.</i></p> <p><b>Class 25:</b> <i>Clothing, footwear, headgear.</i></p>

18) The applicant submits that the goods are not similar because the opponent’s goods are generic products whereas the applicant’s goods are only available in very selected luxury stores in Central London and on its own stand alone web-site [www.piahallstrom.com](http://www.piahallstrom.com). I dismiss this argument. The consideration necessary under Section 5(2)(b) of the Act is one of a notional analysis based upon the respective list of goods included in the earlier mark(s) and the contested application. Marketing strategies may differ over time, for example, the applicant may sell its mark and then it may be used in respect of goods that are in direct competition with the goods of the opponent. With this in mind and applying the guidance provided in *MERIC*, it is self evident that all of the applicant’s goods are identical to those of the opponent. In Class 14, the applicant’s goods are all jewellery and are identical to the goods covered by the opponent’s *goods in precious metals or coated therewith* and *jewellery*. The applicant’s Class 18

goods are included in the opponent's broad term *goods made of these materials* (being leather and imitation leather). Insofar as the applicant's Class 18 goods are not made of leather or imitation leather, they will share a high level of similarity with the same goods that are made of leather and imitation leather and covered by the broad term in the opponent's specification. Finally, the same terms appear in both the applicant's and the opponent's Class 25 specifications and it is, therefore, self evident that the terms cover identical goods.

19) In summary all of the applicant's goods are identical to those covered by the opponent's earlier mark except *handbags, purses and wallets*, but these share a high level of similarity with the same goods made of leather and imitation leather covered by the opponent's *goods made of these materials*.

### ***The average consumer***

20) 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 or services 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 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.”

21) As I explained in paragraph 18, above, I must undertake a notional analysis of the respective goods. This notional analysis will require me to also consider who the average consumer is for such notional goods. Such an analysis will preclude me finding that, because the applicant's activity is actually in high-end, expensive jewellery, then the average consumer is highly sophisticated and the purchasing process is carefully considered. Both parties' specifications cover goods from across the cost spectrum. Therefore, whilst I keep in mind that some of these goods may be high-end and expensive, the majority of such goods are not and the average consumer pays a reasonable, but not the highest level of attention during the purchasing process for such goods. For goods in all three classes, it is essentially a visual purchase with all the goods being either fashion items or personal decorative items where aesthetic qualities are important. That



said, I do not ignore that in some circumstances, aural considerations may be a factor.

### **Comparison of marks**

22) 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.”

23) It would be wrong, therefore, to artificially dissect the 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.

24) The respective marks are:

<b>Opponent's mark</b>	<b>Applicant's mark</b>
PIA	PIA HALLSTROM

25) The opponent's mark consists of the single word PIA and this is obviously the dominant and distinctive element of the mark. The applicant's mark consists of the two words PIA HALLSTROM. This is likely to be perceived by the average consumer as a full name of an individual. Neither of these words appear to be common names in the UK and certainly there is no evidence to suggest that they are. Surnames have generally been accepted to have greater distinctive character than forenames (see, for example, *El Corte Inglés, SA v OHIM*, Case T-39/10, paragraph 54). However, recent decisions from the GC and High Court in *Giovanni Cosmetics Inc. v OHIM, Vasconcelos & Gonçalves SA*, T-559/13 (“GIOVANNI”) and in *Whyte and Mackay Limited v Origin Wine UK Limited & Dolce Co Invest Inc*, [2015] EWHC 1271 (Ch) (“WHYTE AND MACKAY”) respectively suggest that this should not be a general rule.

26) In the *MEDION* case (paragraph 30) the CJEU stated that “it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant part”. The court went on to comment that a finding of likelihood of confusion should not be subject upon the condition that the part of the mark that is represented by the earlier mark should be the dominant part of the mark. However, Arnold J in his recent judgment in, when discussing this principle, stated:

“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)”.

27) In light of the very recent nature of the *WHITE AND MACKAY* and *GIOVANNI* cases, the parties were given the opportunity of commenting on their relevance to the current proceedings. The applicant submitted that both cases appeared to support the understanding that surnames are more distinctive than first names and that, when there are two components in a mark, one component is qualified by the second component.

28) The opponent submitted that in paragraph 20 of his decision, Arnold J was merely stating the legal arguments of the Appellant in respect of the first ground for appeal in that case. That is not the case. His reference to “this principle” related to the principle established in *MEDION* and his reference to “The second point” is a reference to what he perceives as the second of three points that the CJEU confirmed in its *BIMBO* judgment. In other words, Arnold J was discussing the relevant case law and not the legal arguments of the Appellant.

29) In respect of the *GIOVANNI* case, the opponent submits that difficulty exists because of a conflicting line of decisions following *MEDION*. As the opponent points out, the principle set out in *MEDION* is that there may be likelihood of confusion where the contested mark is composed of an element that constitutes a company name with a registered mark and where that company name “does not determine the overall impression conveyed by the composite mark, but still has an independent distinctive role. The key point in the current proceedings is that, as per Arnold J’s comment in paragraph 20 in *WHYTE AND MACKAY*, the word PIA does not have an independent distinctive role in the mark PIA HALSTROM because it merely functions as part of a unit to identify the name of a particular person. This is different to all the marks discussed in the case law cited by the opponent, namely *GLAXO WELLCOME*, *BULLOVER ACCUTRON*,

DEBUR UVEDA and THOMSON LIFE. In all these examples, each word was considered to have independent distinctive character, unlike in the current case. My finding in this case is reinforced by the comments of Mr Geoffrey Hobbs QC in *Novartis Seeds BV's Application* [2006] ETMR 82 (and mentioned with approval by Arnold J in *Avida Corp v Debur India Ltd* [2013] EWHC 589 (Ch) where he concluded that in the mark ERIC CANTONA CANTO that ERIC CANTONA had independent significance. The implication being that the word ERIC alone did not.

30) In summary, having regard for the comments in both the *GIOVANNI* and *WHITE AND MACKAY* judgments and also the parties' submissions in respect of these together with the historical case law on the point, I conclude that the two words PIA HALLSTROM make up a full name, functioning as a unit to identify a particular individual to the average consumer and neither element has a greater relative weight than the other.

31) Visually and aurally, both marks contain the word PIA and this creates an element of visual and aural similarity. In addition the applicant's mark also includes the word HALLSTROM. This is absent in the opponent's mark and is, therefore, a point of dissimilarity. The word PIA is relatively short in length, whereas the word HALLSTROM is of longer length. Taking these factors into account, I conclude that the respective marks share a reasonable low level of visual and aural similarity.

32) Conceptually, it is not clear to me that, when the word PIA is used alone, that it will be perceived as a forename at all, however, even if it is, it will be perceived as a reference to any individual whose forename is PIA. On the other hand, the applicant's mark relates to a specific individual named PIA HALLSTROM, where the word PIA appears before a family name, reinforcing the impression that it is a first name. It is not clear to me that such an impression attaches to the word PIA when it is not juxtaposed with a family name (and such a view appears to be consistent with the submissions of the opponent). It is my view that these similarities and differences combine to create only a low degree of conceptual similarity.

### ***Distinctive character of the earlier trade mark***

33) I must consider the distinctive character of the earlier mark because the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG* [1998] RPC 199). The distinctive character of the earlier trade mark must be assessed by reference to the goods for which it is registered and 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.

34) When considering the mark's level of inherent distinctive character, I keep in mind that because forenames serve to indicate any number of individuals, they are not necessarily imbued with a particularly high level of distinctive character. However, in this case, whilst I have no evidence before me on the point, the name PIA strikes me as being somewhat unusual and consequently its level of distinctive character will be higher than for a more common forename.

35) The opponent has also provided evidence that the mark has an enhanced level of distinctive character because of the use made of it. It has been used since 2002 and the turnover in respect of the goods sold under the mark was over £3 million in 2011 and 2012, with over 600,000 UK customers. There is also evidence that the opponent advertises in national publications such as the *Telegraph Weekend* supplement and *The Lady* magazine. This indicates that it has a presence in the UK sufficient to result in an enhanced level of distinctive character, but taking account of the size of the fashion/jewellery/clothing sector, such use still indicates a very small proportion of the market sector. Therefore, any enhancement to distinctive character will not be significant.

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

36) I must adopt the global approach advocated by case law and take into account that marks are rarely recalled perfectly with the consumer relying instead on the imperfect picture of them he has in kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). I must take into account all factors relevant to the circumstances of the case, in particular the interdependence between the similarity of the marks and that of the goods or services designated (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*)

37) The applicant has relied on the argument that the respective marketing strategies are different, with the applicant marketing high-end, expensive goods through luxury retail outlets whereas the opponent produces generic goods. I have already commented earlier (paragraph 18) that this is not the correct approach and I am mindful of the following comments of the CJEU in *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P:

“59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

38) Consequently, I dismiss the applicant's arguments that there can be no likelihood of confusion because the parties employ different marketing strategies.

39) The opponent submits that it is not uncommon for companies to have premium brands alongside a more affordable brand and where the same partial branding is used. The argument has some support from the GC, for example, in *Zero Industry Srl v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-400/06*, where it commented:

78 Second, the Board of Appeal also pointed out in paragraph 25 of the contested decision that, as regards the conditions in which the goods in question are marketed, it is not unusual in the clothing business for the same mark to be configured in various ways according to the product it designates. It is also common, in its view, for the same clothing manufacturer to use sub-brands in order to distinguish its various lines from those of others. It therefore concluded that it is conceivable that consumers may associate zero<sup>rh+</sup> and zero and regard the marks at issue as designating different ranges of products coming from the same manufacturer.

40) I must give full regard for all the factors in the global appreciation test, I am of the view that the differences between the marks are sufficient for the consumer to not confuse one mark with the other, so called "direct confusion". Neither do I find that there is any indirect confusion whereby the consumer is likely to believe that goods provided under the respective marks originate from the same or linked undertaking. It is not clear to me that when the word PIA is used alone that it will be seen as a forename and therefore any connection with the mark PIA HALLSTROM is lost. The mark PIA HALLSTROM however, will be perceived as a unit that is a full name. I note the submission that use of sub brands is reasonably common in the field of interest to the parties. However, this does not automatically lead to a finding of confusion. It is but one factor to take into account in the global appreciation of the facts of the case. Even if use of the word PIA alone would be seen as use of a forename, because it can be a reference to any one individual bearing the name, it will do no more than prompt the average consumer to wonder about a connection to the mark PIA HALLSTROM. Such a weak connection falls short of resulting in a likelihood of confusion. Therefore, having regard for this and taking account the recent guidance from the courts in *Giovanni Cosmetics Inc. v OHIM, Vasconcelos & Gonçalves SA, Whyte and Mackay Limited v Origin Wine UK Limited & Dolce Co Invest Inc* and, of course *MEDION*, I conclude that there is no likelihood of confusion.

41) In reaching this conclusion I have kept in mind that the respective goods are identical goods, that the marks will both be perceived as names, that the opponent's mark consists of a word that is present in the applicant's mark and that, as a forename, it does not appear to be particularly common.

42) In summary, there is no likelihood of confusion in respect of all of the goods listed in the applicant's mark. The opposition fails insofar as it relies upon Section 5(2)(b) of the Act.

### **Section 5(4)(a)**

43) Section 5(4)(a) states:

"A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of "an earlier right" in relation to the trade mark."

44) Halsbury's Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

"The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal

definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.”

45) Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have

acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

46) The first part of the enquiry is whether the opponent owns goodwill attached to the word mark PIA. In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), it was stated:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

47) Details of the scale of the opponent's use of the mark are provided by Mr Beale in his evidence. This illustrates that the opponent has used its PIA mark in the UK since at least 2005 (there is a claim to use from 2002) in respect of various items of ladies clothing (as well as jewellery). There is also evidence of promotional activities in the UK in national publications and that the opponent has 15 stores in the UK where its own brand goods are sold. Whilst the UK turnover figures are not broken down to reflect the various categories of goods the opponent provides, when taking all the evidence into account, I have little hesitation in concluding that it has demonstrated the requisite goodwill.

48) Having concluded that the opponent owns this requisite goodwill, I must consider whether use of the applied for mark would result in misrepresentation and damage. The test for misrepresentation was set out in *Neutrogena Corporation and Another v Golden Limited and Another*, [1996] RPC 473, where Morritt L.J. stated:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”



49) Therefore, I must now consider if the applicant's mark is sufficiently similar to the opponent's mark to amount to misrepresentation to the public. As stated by *Lord Oliver of Aylmerton in Reckitt & Colman Products Ltd. v. Borden Inc.*[1990] RPC 341 at page 407, the question on the issue of deception or confusion is:

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [services] in the belief that [they are] the respondents'[services]”.

50) For the reasons I set out in paragraph 40, above, it is my view that a substantial number of the public will not be misled into purchasing that the goods under the PIA HALLSTROM mark in the belief that they are, in fact, the goods of the opponent. Despite sharing the same word PIA, the presence of the distinctive family name HALLSTROM in the applicant's mark is sufficient to prevent the public from being misled.

### **Summary**

51) The grounds based upon both Section 5(2)(b) and Section 5(4)(a) fail and the opposition fails in its entirety.

### **COSTS**

52) The applicant has been successful and it is entitled to a contribution towards its costs. I keep in mind that only the opponent filed evidence and written submissions and that no hearing took place. I also keep in mind that the applicant was not legally represented and consequently did not incur legal costs. I award costs as follows:

Preparing counterstatement and considering other side's statement	£150
Considering evidence	£200
Considering other side's written submissions	£100

**Total: £450**

53) I order John Richard Beale to pay Pia Hallstrom Limited the sum of £450 which, in the absence of an appeal, should be paid within 14 days of the expiry of the appeal period.

**Dated this 29th day of June 2015**

**Mark Bryant  
For the Registrar,  
the Comptroller-General**