

O-061-16

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 3039404
BY SHAZADA BES
TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 9:**

Accesoreeze

AND

**OPPOSITION THERETO (NO. 402392) BY
MONSOON ACCESSORIZE LIMITED**

Background and pleadings

1. These opposition proceedings concern whether the trade mark **Accesoreeze** should be registered for the following goods in class 9:


Cases and accessories adapted for electronic equipment including mobile phones, tablet computers and e-book readers; Tablet computer; Cellular phone accessory charms; Tablet computers; Cases for mobile phones; Mobile phone straps; Mobile telephone batteries; Mobile telephones; Leather cases for mobile phones; Cases adapted for mobile phones; Cellular mobile telephones; Phone covers [specifically adapted]; Holders adapted for mobile phones; Mobile phones; Straps for mobile phones; Downloadable ring tones for mobile phones; Digital book readers; Electronic book readers.

2. The applicant is Ms Shazada Bes who filed the mark on 26 January 2014. The mark was subsequently published for opposition purposes on 28 March 2014.

3. The opponent is Monsoon Accessorize Limited. Its opposition is based on grounds under sections 5(2)(b), 5(3) & 5(4)(a) of the Trade Marks Act 1994 (the Act). The opponent relies on the following two earlier marks:

- i) Community trade mark (CTM) registration 1828250 for the mark ACCESSORIZE. The mark was filed on 28 August 2000 and was entered on the register on 2 September 2002. It is registered for the following services:

“[t]he bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a retail clothing and fashion accessory store; retail services relating to the sale of clothing, headwear, neckwear, footwear, lingerie, jewellery, imitation jewellery, bags, belts and fashion accessories.”

- ii) UK registration 2594255 for the mark . The mark was filed on 14 September 2011 and entered on the register on 27 January 2012. The opponent relies only on the class 9 goods of the registration which read:

“[h]air straightening irons; travel hair straightening irons; curling tongs; hair waving irons; heated rollers; hair care appliances operated by gas, catalytic combustion or electricity; crimping tongs, straightening tongs, curlers and hair-curlers; parts of the aforesaid appliances; electric flat irons; scales for household and persons; calculating machines, cases for pocket calculators; electric cables, electric plugs, electric switches; parts of the aforesaid goods; optical apparatus and instruments; optical glass and lenses; spectacles; sunglasses; frames, lenses, cases, cords and chains for spectacles; contact lenses; mobile phone cases and covers; photographic apparatus and instruments; apparatus and instruments all for receiving, transmitting and recording and reproduction of sound, visual images and video; computers; computer programs and computer games;

pre recorded or blank, videos, CDs, DVDs, cassettes and tapes, memory chips and usb drives.

4. Mark i) is relied on under sections 5(2)(b) & 5(3) of the Act, mark ii) is relied on under section 5(2)(b) only. Under section 5(4)(a), the opponent relies on the use of the sign ACCESSORIZE.

5. In opposition proceedings, earlier marks which were entered on the register five years or more before the date on which the opposed mark was published may only be relied on to the extent that they have been used. This is set out in section 6A of the Act, the so called "proof of use provisions". In terms of the earlier marks here, the provisions apply only to mark i), not mark ii). Mark ii) may be relied upon without the opponent having to prove use. In relation to mark i), the opponent made a statement of use claiming that it has used its mark for all of the services for which it is registered.

6. The applicant filed a counterstatement. It asked the opponent to prove use (of mark i). In relation to the opposition more generally, the applicant states:

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The opposition state the the mark we applied for is ACCESSOREEZE but we have actually applied for Accesoreeze.

Also they have stated that the differences between the 2 marks are the first 8 letters of our mark are the same as their mark which is false and that the only difference between the 2 marks is substitution of the two EE's for the opponents I towards the end of the mark, this however is also false as the mark we have applied for is Accesoreeze and the opponents mark is ACCESSORIZE.

As it can be seen the marks are totally different and both represent a different meaning as our mark represents accessories as opposed to the opponents mark which is accessorise. We do not believe that our mark can be classified as passing off, nor our mark could take unfair advantage of the opponents mark as the opponent is in a totally different line of business (low cost shoes, fashion jewellery etc) and the 2 marks look different and represent different meanings.

7. The applicant is self-represented. The opponent is represented by an in-house legal advisor. Only the opponent filed evidence. Neither side asked for a hearing or filed written submissions in lieu of attending a hearing.

The evidence

8. The opponent's evidence comes from Ms Jessica Coz, a legal assistant in the opponent company. She explains that the opponent owns numerous registrations in the UK and worldwide in respect of the mark ACCESSORIZE. The mark appears to be the brainchild of Peter Simon, the founder of Monsoon, who saw a gap in the market as a one stop destination providing "finishing touches and accessories to complete every fashion look". The first Accessorize store was launched in 1984 in Covent Garden. There are now 1000 stores across 70 countries. In the UK there are 121 Accessorize stores and a further 124 dual stores which feature both Monsoon and Accessorize goods.

9. Ms Coz states that it is difficult to separate out advertising costs between Monsoon and Accessorize as promotion is often undertaken in conjunction with Monsoon. For the financial year 2013-2014 just under £6.5 million was spent on

promotion. Ms Cox states that if only half of this were attributed to Accessorize then this is still a significant investment.

10. Turnover for the financial year 2013-2014 for Accessorize alone in the UK was over £180 million. Ms Cox states that this is in line with previous years.

11. Ms Cox states her understanding that the applicant is based in Glasgow. She highlights a number of Accessorize stores in the immediate vicinity. She expects the applicant to have seen them or even purchased goods from them.

12. It is explained that the focus for Accessorize has moved over time. She states that there has been a rise in the market for covers, holders etc for mobile phones and tablets. She states that there is a desire to have products which reflect the users' personality and to co-ordinate their clothing. She states that the opponent sells covers for mobile phones and tables, not just in its own stores, but also as a licensed product in other retail outlets such as Argos, Very and PC World. No evidence is given as to when such sales began nor the volume of such sales. Ms Cox notes that the applicant's specification is focused on this area. Exhibit JC1 contains some examples of the products sold, including:

- i) A leather phone case on the Accessorize website.
- ii) A picture of a Accessorize cover for a Samsung Galaxy S3 and a universal iPad Folio.
- iii) A Google search page showing various Accessorize phone/tablet covers.
- iv) A print from the Accessorize website showing two iPhone covers.

13. The rest of Ms Cox's evidence is in the nature of submission as opposed to evidence of fact. I will not summarise it here, but will bear it in mind.

Section 5(2)(b)

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

“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.”

15. 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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods/services

16. When making a comparison, all relevant factors relating to the goods/services in issue should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

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

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

18. In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v OHIM* Case T- 325/06, the General Court (“GC”) stated:

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

19. In relation to complementarity, I also bear in mind the guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case BL O/255/13 *LOVE* where he warned against applying too rigid a test:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in Boston is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, 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. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to Boston.”

20. In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade”¹ and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning². I also note the judgment of Mr Justice Floyd in *YouView TV Limited v Total Limited* where he stated:

“..... 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) (IPTRANSLATOR)* [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.”

Comparison with the goods of earlier mark 2594255

21. The goods of the earlier mark are:

“[h]air straightening irons; travel hair straightening irons; curling tongs; hair waving irons; heated rollers; hair care appliances operated by gas, catalytic combustion or electricity; crimping tongs, straightening tongs, curlers and hair-curlers; parts of the aforesaid appliances; electric flat irons; scales for household and persons; calculating machines, cases for pocket calculators; electric cables, electric plugs, electric switches; parts of the aforesaid goods; optical apparatus and instruments; optical glass and lenses; spectacles; sunglasses; frames, lenses, cases, cords and chains for spectacles; contact lenses; mobile phone cases and covers; photographic apparatus and instruments; apparatus and instruments all for receiving, transmitting and

¹ See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

² See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

recording and reproduction of sound, visual images and video; computers; computer programs and computer games; pre recorded or blank, videos, CDs, DVDs, cassettes and tapes, memory chips and usb drives.

22. In making the comparison, it is useful to break the applied for goods down, albeit grouping them when it is reasonable to do so:

Cases for mobile phones; Leather cases for mobile phones; Cases adapted for mobile phones; Phone covers [specifically adapted]

23. The earlier mark covers “mobile phone cases and covers” which, self-evidently, are identical to the applied for goods.

Cases adapted for electronic equipment including mobile phones, tablet computers and e-book readers

24. As stated above, the earlier mark covers cases for mobile phones and, also, cases for pocket calculators. To the extent that the applied for goods cover cases for mobile phones, the goods are identical. In relation to cases adapted for electronic equipment, identity can be found because electronic equipment covers both mobile phones and pocket calculators. In relation to cases for tablet computers and e-book readers, the nature (compared to mobile phone cases) is the same as is the method of use. The trade channels will likely overlap. The purpose of both is to protect the respective devices, but the exact purpose is different because of the item that is being protected. I consider there to be a reasonably high degree of similarity between these goods.

Cellular phone accessory charms

25. It seems to me that the closest product(s) of the earlier mark are its mobile phone cases and covers. Cases and covers are a form of accessory for a phone as are charms which I assume is something which hangs off the phone to make it more attractive. However, the main purpose of a case/cover is aimed at protection, although such items will also have a secondary function of making the phone more attractive. The nature is different as is the method of use. The goods do not really compete, neither are they complementary in the sense described by the case law. The trade channels are, though likely to be the same. I consider there to be a medium degree of goods similarity.

..... accessories adapted for electronic equipment including mobile phones, tablet computers and e-book readers; Holders adapted for mobile phones; Mobile phone straps; Straps for mobile phones

26. Given what I have said in the preceding paragraph, such goods fall in the exact same category. There is a medium level of similarity.

Tablet computer; Tablet computers

27. The earlier mark covers computers per se, which consequently covers tablet computers. The goods must, therefore, be considered identical.

Mobile telephones; Cellular mobile telephones; Mobile phones

28. The earlier mark covers “apparatus and instruments all for receiving, transmitting and recording and reproduction of sound, visual images and video”. A mobile phone performs all the various functions of the earlier term. A mobile phone would, consequently, fall within the ambit of the earlier term and must, therefore, be considered identical.

Mobile telephone batteries

29. Given that the earlier mark covers mobile phones within the ambit of one of its terms (see above), I consider that I must find some similarity with mobile phone batteries. The overall nature may be different as is the method of use, but there is a key complementary relationship given the indispensable link between them - the consumer is likely to believe that the responsibility for the latter will fall with the former, and vice versa. There is a medium degree of similarity,

Downloadable ring tones for mobile phones

30. Compared to mobile phones (or cases for them), the purpose of the goods is not really similar and there is no similarity in nature or method of use. I see no competition or any strong degree of complementarity. There may, though, be some overlap in trade channels. There is a low, at best, degree of similarity with the earlier mark’s goods.

Digital book readers; Electronic book readers.

31. The specification of the earlier mark covers “apparatus and instruments all for receiving, transmitting and recording and reproduction of sound, visual images and video” which is a broad term covering various items. I think the term is broad enough to include within its ambit digital and electronic book readers, after all, such things are devices which reproduce visual media. From that perspective the goods are identical. Even if I am wrong on this, such readers must be regarded as very similar to tablet computers (which are covered by the earlier mark’s “computers”). The nature and method of use will be similar. The purpose differs on account of the varying functions of a tablet computer, but is similar on account of one of the main functions of a tablet computer is to act as an e-book reader. Some users may make a competitive choice between a single function e-book reader or multi-purpose tablet computer which has the ability to function as an e-book reader. I consider there to be a medium degree of similarity.

Comparison with the services of earlier mark 1828250

32. The services of the earlier mark are:

“[t]he bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a retail clothing and fashion accessory store; retail services relating to the sale of clothing, headwear, neckwear, footwear, lingerie, jewellery, imitation jewellery, bags, belts and fashion accessories.”

33. The essence of the above specification is that of a retail service, the goods the subject of that retailer's offering being set out at the end of the specification. None of the applied for goods are identified as being the subject of the retail service. The closest one gets is in relation to the term "fashion accessories", but I consider it would be a strain of language to regard any of the applied goods (including items such as mobile phone covers) to be regarded as a fashion accessory. Whilst items such as mobile phone covers may have more by way of design characteristics than in years gone by, they would not naturally be described as fashion accessories. This applies even to mobile phone charms, they would not be described as fashion accessories.

34. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree. However, as I have held above, the opponent's retail services do not cover the goods of the applicant. That may not, though, be the end of the matter. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, reviewed the law concerning retail services v goods; he stated:

"9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent's earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are 'similar' to goods are not clear cut."

35. However, on the basis of the European courts' judgments in *Sanco SA v OHIM*³, and *Assembled Investments (Proprietary) Ltd v. OHIM*⁴, upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd*⁵, Mr Hobbs concluded that:

i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for retail services and a mark proposed to be registered for goods (or vice versa), it is necessary to

³ Case C-411/13P

⁴ Case T-105/05, at paragraphs [30] to [35] of the judgment

⁵ Case C-398/07P

envisage the retail services normally associated with the applicant's goods and then to compare the applicant's goods with the retail services covered by the opponents' trade mark;

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

36. In *Frag Comercio Internacional, SL, v OHIM*, Case T-162/08, the General Court held that a registration for 'retail services', which did not identify the kinds of goods covered by the services, was too vague to permit a proper comparison to be made between those services and the goods covered by the later mark. It was not therefore possible to determine that the respective services and goods were similar.

37. It is therefore clear that a retail service can only be properly compared to goods if the goods to which the retail service is connected is specified, otherwise it is too vague. In the present case such connected (to the retail service) goods do not correspond to the applied for goods. This, of course, does not rule out a finding of similarity, but, in the present case, the retail services through which the applicant's goods are normally associated do not correspond with the opponent's retail service. Items such as mobile phone cases are normally sold through mobile phone shops or larger stores such as supermarkets where they will be located within the electrical area not the fashion area. There may be some exceptions to this (the opponent may represent an exception), but one is looking at the norm, not the exceptions to the norm. I do not consider there to be a complementary relationship in play, but even if there was, it is not sufficiently pronounced for the goods and services to be taken as similar.

38. In view of my finding that the applied for goods are not similar to the services of earlier mark, the opposition based on earlier mark 1828250 is dismissed as with no similarity between the goods/services, there can be no likelihood of confusion⁶. Given this, it is unnecessary to consider whether this mark meets the proof of use provisions.

Average consumer and the purchasing act

39. 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:

⁶ See, for example, *Waterford Wedgwood plc v OHIM* – C-398/07 P (CJEU)

“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.”

40. Where the goods conflict, they conflict with regard to items purchased by the general public. For items such as cases/covers, the degree of care and attention used in their selection is likely to be of no more than an average level. They are relatively low cost, although they are not purchased that often. Whilst the cost may be low, some attention will be paid to ensure that the correct version is chosen for the device in question, and considerations will be applied to how they look and feel. In relation to tablet computers, mobile phones etc, a higher than average level of care will be adopted. This is a more considered purchase that will not only be infrequent, but will involve more costly items. Care will also be applied due to the technical nature of the products with the consumer considering the various specifications and functionality. Although the degree of care and attention will be higher than the norm, I do not pitch it at the highest level.

41. The various goods will be perused through media such as brochures, pamphlets, websites, at point of sale etc. This suggests a selection process that is more visual than aural. I do not, however, ignore the aural impact of the marks as sales advisors could be involved, although this is likely to be more relevant for the technical products such as computers and mobile phones.

Comparison of marks

42. 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.”

43. 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:

Accessoreeze and Accessorize

44. In terms of overall impression, the applicant's mark comprises just one word, so that constitutes its overall impression. The opponent's mark also comprises one word, but it also has a figurative element (possibly a crown) representing the dot above the letter I, and it is also presented in a stylised script. However, the figurative element is very small and has little visual impact and the stylisation is not overly significant and fairly unremarkable – given this, these additional components, whilst not wholly negligible, play only a minor role in the overall impression, an overall impression which is dominated more by the word of which the mark is comprised.

45. Conceptually, the applied for mark is a misspelling of the word accessories. The concept of the opponent's mark will be based upon the word accessorise (the mark is the US rather than the UK spelling). There is clearly a very high degree of conceptual similarity between the marks.

46. Aurally, the applicant's mark will be articulated as AC-SES-O-REEZ, the opponent's mark as AC-SES-O-RIZE. Each mark is of a virtually identical length, both comprising four syllables, the first three of which are the same. The fourth syllable is different, but the fourth syllable articulations are still quite similar both beginning with an R sound and ending in an Z sound. As a whole, the marks are aurally similar to a very high degree.

47. Visually, the marks are of a virtually identical length. The first five letters are the same, as are the last two. Both also have the letters SOR in the middle. There are some differences in the letters, although one of those, the double S for a single S is something which could easily be overlooked. As the applicant points out, there is also a difference towards the end, the EE for an I. There is also a visual difference created by the figurative element representing the dot above the I in the opponent's mark. Although, in deciding what weight to attribute to this difference, I must bear in mind what I have said in my assessment of the earlier mark's overall impression. There is also the stylised script, but such a differences should be given very little weight because, notionally speaking, it is possible for the applied for mark to be used in a similar script. Overall, I consider there to be a high degree of visual similarity.

Distinctive character of the earlier marks

48. 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).”

49. Inherently, the earlier mark’s main component is the word ACCESSORIZE which is clearly weak in inherent distinctive character, particularly for goods which have the capacity to be sold as an accessory for other goods. However, there is not much else to the mark. As I have said, the stylisation is fairly unremarkable and the figurative element above the I has little impact; if it adds to the earlier mark’s distinctiveness, it is fig leaf like in its impact. The earlier mark, therefore, has only a low level of inherent distinctive character. However, in relation to items such as mobile phones per se, and computers, the distinctiveness is stronger, at least of a moderate level.

50. In terms of the use made, the question must be focused on the goods of the earlier mark. The absence of any specific detail of the length and level of sales for goods such as mobile phone covers leads me to conclude that the earlier mark’s distinctiveness has not been enhanced to any material extent for the goods covered by the earlier mark in question.

Likelihood of confusion

51. 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.

52. Some of the goods applied for are identical to goods of the earlier mark, others just similar, albeit to varying degrees. The level of care adopted in the selection process may also vary. All of this may impact on the outcome, so my analysis needs to be broken down. I will start with the various cases that have been applied for, namely:

Cases adapted for electronic equipment including mobile phones, tablet computers and e-book readers; cases for mobile phones; Leather cases for mobile phones; Cases adapted for mobile phones; Phone covers [specifically adapted]

53. I have found the goods to be identical in so far as phone cases are concerned, but still reasonably high in similarity for the other types of cases. I have found the marks to be visually, aurally and conceptual similar to a high (visual) or very high (aural and conceptual) degree. Such findings would often lead the decision taker to automatically find that there is a likelihood of confusion. However, it is not as simple as that because various other factors need to be taken into account. One factor that is important in this case is the degree of distinctiveness of the earlier mark. As I have already stated, the earlier mark is low in inherent distinctive character. Whilst this is noted, such a matter cannot be regarded as a silver bullet to kill off a finding of a likelihood of confusion. In *L'Oréal SA v OHIM*, Case C-235/05 P, the CJEU found that:

“45. The applicant’s approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

54. I must also take into account the principle of imperfect recollection, it is not as though, for example, that the goods are highly considered purchases. Weighing the various factors I come to the conclusion that there is a likelihood of confusion and, indeed, this could be on the basis of the average consumer directly confusing one mark for the other. The figurative element is so lacking in impact that this could be overlooked, particularly bearing in mind imperfect recollection. The difference in stylisation, as already observed, has little significance. The difference in letters (and the impact of this on the eye and the ear) could also be lost through imperfect recollection. I appreciate that both parties have chosen trade marks which are adaptations of the words *accessorise/accessories*. But when considered as trade marks (which of course I must do) it is, in my view, asking too much of the average consumer to analyse the marks to the level of detail that he or she then decides that the respective undertakings are different due to them both adopting words which are weak in distinctiveness. This is not how the average consumer would ordinarily operate and, further, the overall level of similarity is too high, which, when factored with the concept of imperfect recollection, will lead to confusion. **The opposition succeeds in relation to these goods.**

Cellular phone accessory charms; accessories adapted for electronic equipment including mobile phones, tablet computers and e-book readers; Holders adapted for mobile phones; Mobile phone straps; Straps for mobile phones

55. I have found a medium degree of similarity between the above goods and the opponent's mobile phone cases. Although the degree of similarity is less, the type of relationship between these items (in comparison to phone cases) leads me to conclude that there is still a likelihood of confusion for largely similar reasons to that set out above. **The opposition succeeds in relation to these goods.**

Tablet computer; Tablet computers; Mobile telephones; Cellular mobile telephones; Mobile phones; Digital book readers; Electronic book readers

56. I have found the goods to be identical. In terms of the digital/electronic book readers, even if they are not identical, they are still highly similar to goods of the earlier mark. A difference here is that the goods are likely to be chosen with a greater degree of care. However, the impact of this in terms of avoiding confusion is lessened by the fact that the earlier mark is more distinctive with regard to such items. Overall, I consider that there is a likelihood of confusion. **The opposition succeeds in relation to these goods.**

Mobile telephone batteries

57. I have found a medium degree of similarity with the goods (mobile phones) of the opponent's mark. Although the degree of goods similarity is less, the type of relationship between these items leads me to conclude that there is still a likelihood of confusion for largely similar reasons to that set out in relation to mobile phones per se. **The opposition succeeds in relation to these goods.**

Downloadable ring tones for mobile phones

58. Here, I found there to be a low, at best, degree of similarity with the earlier mark's cases and covers and mobile phones. I consider this to be a significant factor in this assessment and is sufficient, when all other factors are added to the mix, to avoid a likelihood of confusion. **The opposition fails for these goods.**

Section 5(3) & 5(4)(a)

59. I do not consider it proportionate or necessary to consider these grounds of opposition in detail. I say this for the following reasons:

- i) The opposition has already succeeded for the most part.
- ii) If there is any reputation, it is in relation to the class 35 services only. The same applies to goodwill, there is insufficient evidence to show that the goodwill of the opponent is connected with the class 9 goods such as mobile phone covers.
- iii) Even if one were to consider the matter in relation to the unsuccessfully opposed goods (ring tones) on the basis of the section 5(3) reputed goods,

whilst the opponent will have met the hurdle of reputation⁷ (and the proof of use assessment) for its fashion related retail services in class 35, it would have failed, in my view, to establish the necessary link⁸; a person encountering the applied for mark in relation to ring tones would not, in my view, bring the earlier mark to mind. For similar reasons, the claim would have failed under section 5(4)(a) as there will not be a misrepresentation.

Conclusion

60. The opposition succeeds and the mark is to be refused registration in respect of:

Class 9: Cases and accessories adapted for electronic equipment including mobile phones, tablet computers and e-book readers; Tablet computer; Cellular phone accessory charms; Tablet computers; Cases for mobile phones; Mobile phone straps; Mobile telephone batteries; Mobile telephones; Leather cases for mobile phones; Cases adapted for mobile phones; Cellular mobile telephones; Phone covers [specifically adapted]; Holders adapted for mobile phones; Mobile phones; Straps for mobile phones; Digital book readers; Electronic book readers.

61. The opposition fails and the mark may be registered for:

Class 9: Downloadable ring tones for mobile phones.

Costs

62. The opponent has largely succeeded and is entitled to an award of costs. My assessment is as follows:

Official fee - £200

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

Filing and considering evidence - £600

Total - £1100

63. I therefore order Ms Shazada Bes to pay Monsoon Accessorize Limited the sum of £1100. 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.

⁷ The test, as per *General Motors Corp v Yplon SA (Chevy)* [1999] ETMR 122 and [2000] RPC 572, relates to a degree of knowledge by a significant part of the relevant public.

⁸ *Intel Corporation Inc v CPM (UK) Ltd (C-252-07)* the factors (which must be assessed globally, the degree of mark similarity, the nature and closeness (or otherwise) of the goods, the strength of reputation, the degree of distinctiveness and whether there exists a likelihood of confusion (although this is not a prerequisite).

Dated this 4th day of February 2016

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