

**O-223-17**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3139335  
BY COCO'S LIBERTY LTD TO REGISTER THE TRADE MARK**

**Coco's Liberty**

**IN CLASS 14**

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. 406269  
BY CHANEL LIMITED**

## Background and pleadings

1) Coco's Liberty Ltd ("the applicant") applied to register under no 3139335 the mark "Coco's Liberty" in the UK on 5 December 2015. It was accepted and published in the Trade Marks Journal on 18 December 2015 in respect of the following list of goods:

**Class 14:** *Jewellery, precious stones; Jewellery being articles of precious metals; Jewellery being articles of precious stones; Jewellery chain of precious metal for anklets; Jewellery chain of precious metal for necklaces; Jewellery coated with precious metal alloys; Jewellery coated with precious metals; Jewellery containing gold; Jewellery fashioned from bronze; Jewellery fashioned from non-precious metals; Jewellery fashioned of precious metals; Jewellery fashioned of semi-precious stones; Jewellery for personal adornment; Jewellery for personal wear; Jewellery in non-precious metals; Jewellery in semi-precious metals; Jewellery incorporating diamonds; Jewellery incorporating precious stones; Jewellery made from gold; Jewellery made from silver; Jewellery made of bronze; Jewellery made of non-precious metal; Jewellery made of precious metals; Jewellery made of precious stones; Jewellery made of semi-precious materials; Jewellery products; Jewellery rope chain for anklets; Jewellery rope chain for bracelets; Jewellery rope chain for necklaces; Jewellery plated with precious metals; Jewellery; Jewellery in precious metals; Jewellery of precious metals; Jewellery boxes.*

2) Chanel Limited ("the opponent") opposes the mark on the basis of section 5(2)(b), of the Trade Marks Act 1994 ("the Act"). It is based upon a claim that the applicant's mark is in respect of a mark similar to those of the opponent, and in respect of identical or similar goods. It relies upon the following three earlier marks:

2584184	
Mark: COCO  Filing date: 9 June 2011 Date of entry in register: 9 September 2011	Goods relied upon:  <b>Class 14:</b> <i>Articles made of precious metals or coated therewith; jewellery; precious stones; charms; keyrings; horological and chronometric instruments, watches, clocks, watch bands, watch straps, watch bracelets; parts and fittings for all the aforesaid.</i>
3099353	
Mark: COCO CRUSH  Filing date: 16 March 2015 Date of entry in register: 5 June 2015	Goods relied upon:  <b>Class 14:</b> <i>Jewellery; cases for jewellery and jewels; precious stones; precious metals; charms; cufflinks; decorative pins; tie pins; brooches; badges; medallions; medals; ornaments and ornamental figures; trophies; keyrings; horological and chronometric instruments; watches, clocks, watch bands, watch straps, watch bracelets; cases for watches and clocks; parts and fittings for all the aforesaid goods.</i>
3109878	
Mark: I LOVE COCO  Filing date: 21 May 2015 Date of entry in register: 7 August 2015	Goods relied upon are identical to those listed above in respect of 3099353

3) The applicant filed a counterstatement denying the claims made and putting the opponent to proof of use of its earlier marks. However, the earlier marks all completed their registration procedures less than five years before the publication of the contested application. As a consequence of this, the opponent is not required to provide proof of use as set out in section 6A of the Act and is entitled to rely upon the full list of goods covered by these earlier marks (even though it has elected to rely only upon the Class 14 goods).

4) Both sides filed evidence. The opponent is represented by Withers & Rogers LLP and its Marisa Broughton represented the opponent at the hearing that took place on 6 April 2017. The applicant is unrepresented in these proceedings and its Elina Bergert attended the hearing.

### **Opponent's evidence**

5) This takes the form of a witness statement by Lucy Kathryn Aboulian, Senior Intellectual Property Counsel of the opponent. Ms Aboulian provides a history of the opponent and what she describes as "its iconic COCO trade mark". She states that the opponent was founded in the UK in 1925, originally as an haute couture fashion house but that it has become "extremely well known for its fragrance, beauty, watches and jewellery products". It is claimed that, today (the witness statement is dated 24 August 2016), the opponent is "one of the leading fashion houses in the world".

6) Ms Aboulian states that the opponent's marks are a homage to its founder Gabrielle "Coco" Chanel. Ms Aboulian refers to numerous books, films and a musical documenting Coco Chanel's life with the Broadway musical starring Katherine Hepburn being entitled "Coco".

7) At Exhibit LKA1, Ms Aboulian provides examples of use of the opponent's mark in relation to a fine jewellery collection and also costume jewellery and other goods between 2011 and 2015. The mark CHANEL appears prominently on each page and the mark COCO also appears separately on the pages. Bracelets, rings, pendants, necklaces and charms are shown. The origin of the illustrations is unknown, but at least one is marked as "internal use only" (page 19).

8) Ms Aboulian states that, as a result of significant sums being invested in advertising and promoting the mark COCO, the mark is instantly recognisable by the trade and by consumers in the UK as indicating the origin of luxury goods.

9) Ms Aboulian states that the COCO mark was first used in the UK in relation to costume jewellery "at least as early as 2005" and in relation to fine jewellery "since at

least as early as 1997”. Exhibit LKA3 includes a copy of an article from *Marie Claire* magazine in 1997 about the opponent and its founder and makes reference to the opponent’s “new fine jewellery collection”; it refers to the use of the opponent’s “double C” mark but makes no mention of the COCO mark. A further fine jewellery collection was launched in 2012 and, at Exhibit LKA4, Ms Aboulian provides a copy of an article from *Harper’s Bazaar* magazine, dated January 2012, that refers to the collection. It makes reference to the opponent’s founder as “Coco” but does not mention the COCO mark. Copies of advertisements for the opponent’s COCO fine jewellery collection are shown at Exhibit LKA5. These are from 2009 and 2010 and appeared in *Harper’s Bazaar*, *Condé Nast Traveller* and *Apollo* magazines.

10) The following annual UK wholesale figures for the COCO fine jewellery collection (these figures do not include sales of costume jewellery) are:

<b>Year</b>	<b>GBP significantly in excess of</b>
2010	150,000
2011	300,000
2012	40,000
2013	70,000

11) The opponent’s fine jewellery are sold only from its own boutiques numbering six in London and one in Manchester. These include concessions within *Harrods* and *Selfridges*.

12) Ms Aboulian states that on 14 April 2015, the opponent launched a six piece jewellery collection under the mark COCO CRUSH. Both COCO and COCO CRUSH marks appear on the screenshot of the *Net-a-Porter* website, dated 23 April 2015, promoting the collection and provided at Exhibit LKA6. Ms Aboulian states that £130,000 has been invested in advertising the launch of the collection. Print advertisements were placed in *Elle*, *Dazed & Confused*, *I-D Magazine*, *In-Style*, *Harper’s Bazaar*, *Marie Claire*, *Red*, *Tatler*, *Traveller* and *Vogue* in issues that were published in October and November 2015.

13) Ms Aboulian states that the launch of the collection attracted significant media interest and was covered by many leading publications including the *Telegraph*, *Vogue*, the *Independent* and the *Observer*. Examples of this coverage are provided at Exhibit LKA10.

### **Applicants' evidence**

14) This takes the form of a witness statement by Elina Bergert, founder Director and Designer of the applicant. Ms Bergert explains that the applicant's mark was inspired from her childhood nickname "Coco" and how she set up a retail outlet in London in January 2014 to sell the applicant's goods.

15) Ms Bergert provides information regarding the nature of the applicant's use in the field of affordable design jewellery and has received publicity by being referred to in *Condé Nast Traveller*, *The City Magazine* and *Elle*, copies of which are provided at Exhibit A3. Annual wholesale figures are provided, rising from £25,000 in both 2014 and 2015 to approximately £80,000 in 2016.

### **DECISION**

16) Section 5(2)(b) of the Act is 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, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark".

### **Comparison of goods**

17) In the judgment of the Court of Justice of the European Union ("the 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”.

18) 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.

19) I also keep in mind the following guidance of the General Court (“the GC”) in *Gérard Meric v Office for Harmonisation in the Internal Market (MERIC)*, Case T-133/05:

“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 trade mark application (Case T-388/00 Institut für Lernsysteme

v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

20) All of the of the applicant's goods, except the two discussed in the following paragraphs are each types of jewellery and, as such, when applying the guidance from *MERIC*, are identical to the term *jewellery* present in each of the earlier mark's specifications.

21) The term *precious stones* is present in all three of the earlier marks' specifications and therefore, is self-evidently identical.

22) The application also includes *Jewellery boxes*. Ms Broughton submitted that these are identical to *cases for jewellery* in the specification of its COCO RUSH registration. I agree. “Jewellery cases” and “jewellery boxes” cases are both terms to describe a container in which jewellery is stored or transported. I find that they are identical.

23) The earlier COCO registration does not include the term *cases for jewellery* but Ms Broughton submitted that the applicant's *jewellery boxes* are similar to *jewellery* that is listed. These goods are different in nature, intended purpose and method of use, the first being a receptacle for storing jewellery, the second worn as a fashion adornment. However, they may share trade channels with both jewellery and boxes for storing jewellery being available from the same outlets.

24) In terms of complementarity, in *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court 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”.

25) In *Sanco SA v OHIM*, Case T-249/11, the General Court 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.

26) With this guidance in mind, I find that there is complementarity between *jewellery* and *jewellery boxes* with the average consumer likely to believe that the responsibility for these goods lies with the same or linked undertaking. Jewellery boxes are capable of being fashion statements themselves and even compliment the style of the jewellery for which the box is designed to hold. As a result, I conclude that these respective goods share a medium degree of similarity.

### **Comparison of marks**

27) The opponent relies upon three earlier marks, however, for the purposes of procedural economy, I will focus my considerations based upon its COCO mark that, on the face of it, appears to represent the opponent’s best case. If the opposition

does not succeed based upon this mark, it is unlikely to succeed based upon its other marks. Therefore, the respective marks are:

<b>Opponent's marks</b>	<b>Applicants' mark</b>
COCO	Coco's Liberty

28) It is clear from the judgment of CJEU in *Sabel BV v Puma AG*, Case C-251/95 (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.”

29) 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.

30) The opponent's mark consists of the single word COCO and it is self-evident that this is its dominant and distinctive element. It is not disputed between the parties that it will be perceived as a women's forename in both marks. I would add that it is not a particularly common name. The applicant's mark consists of the possessive form of the word COCO and the word LIBERTY. Ms Bergert submitted that these two elements have equal dominance within the mark, whereas Ms Broughton submitted

that Liberty serves as a secondary qualifying word. The presence of the apostrophe "s" this creates a message that the second element, LIBERTY, is something that is possessed by the person called COCO. With this in mind, I conclude that the mark "hangs together" as a phrase describing something ("liberty") being possessed by a person (called "Coco"). As a consequence, the distinctive character of the applicant's mark resides in its totality.

31) Visually, as I explained to Ms Bergert at the hearing, both the applied for mark and the earlier marks are all "word marks" and the consequence of this is that they provide for use of the marks in any normal typeface and in both upper and lower case (see, to this effect, Case T-346/04 *Sadas v OHIM – LTJ Diffusion (ARTHUR ET FELICIE)* [2005], paragraph 47). Therefore, the fact that the opponent's Mark is presented in uppercase and the applicant's Mark is represented in title case does not create a visual difference. The word COCO appears in both marks and this creates visual similarity. The applicant's mark contains the addition of an apostrophe "s" after COCO and also the word LIBERTY and these are points of difference. Taking all of this into account, I conclude that the respective marks share a medium level of visual similarity.

32) From an aural perspective, the position is similar with the first syllable CO being identical and the second syllables of CO and COES respectively being highly similar. The applicant's Mark also has the additional three syllables LIB-ER-TEE. Once again, I conclude that taking this into account, the marks share a medium level of aural similarity.

33) As I have already noted, it is common ground between the parties that the COCO element of both marks is a reference to a person and will be perceived as such by the average consumer. This is the only concept present in the opponent's mark. In the applicant's mark the COCO element presents in the possessive form with an apostrophe "s" and is followed by the word LIBERTY. Ms Bergert explained how this word is intended to communicate her personal journey but the average consumer is likely only to understand it in terms of its ordinary meaning of a state of being free. Nevertheless, these are concepts absent in the opponent's mark and I conclude there is also a medium degree of conceptual similarity.

## **Average consumer and the purchasing act**

34) 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.

35) 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.”

36) All of the parties' goods are normally purchased from high street or Internet retailers. These goods are usually selected for their aesthetic qualities and, as a result, the purchasing act is usually visual. There is nothing before me to lead me to conclude differently. However, I do not ignore the aural considerations that may be involved. The purchase of jewellery and similar goods is, if not quite an everyday purchase, certainly not unusual, especially in respect of inexpensive costume jewellery. Taking this into account, I conclude that the level of attention paid by the consumer during the purchasing process is reasonable rather than high.

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

37) 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).”

38) The earlier mark consists of the word COCO and creates the impression of a women’s first name. Women’s forenames are commonly adopted as marks for fashion and jewellery goods and, as such, are not normally particularly distinctive. However, this is offset to a degree because the name COCO is not particularly common. I conclude that it is endowed with a moderate degree of inherent distinctive character.

39) The opponent provides evidence of use of the mark and its links to the opponent’s founder submitting that the mark has acquired an enhanced level of distinctive character in respect of jewellery. From the guidance above, it is clear that I must consider the issue by taking account of such matters as:

- market share held by the mark: no information is provided regarding this, but taking account of the self-evidently huge size of the jewellery market in the

UK, the wholesale figures provided must only equate to an extremely small proportion of that market. Whilst I accept that retail sales will be significantly higher than wholesale, in the context of the huge UK jewellery market, the turnover would still be very modest;

- how intensive, geographically widespread and long-standing use of the mark has been: It is claimed that COCO fine jewellery has been sold in the UK since at least 1997 and in respect of costume jewellery since 2005. However, the earliest dated corroboratory evidence is from 2009/2010 (references to the opponent's COCO fine jewellery appearing in a number of magazines - Exhibit LKA5). The unchallenged evidence is that this fine jewellery is sold from the opponent's own boutiques, six being in London and one in Manchester. Whilst I note that the moderate wholesale figures shown at paragraph 10 do not include costume jewellery, no turnover or sales figures relating to such is provided. Taking all of this into account, I conclude that use is not particularly intense and neither are such sales particularly widespread;
- the amount invested by the undertaking in promoting the mark: Ms Aboulian states that significant sums have been invested in advertising and promoting the mark. There is no precise information supporting this statement but it is clear from the evidence illustrating advertisements in national magazines such as *Marie Claire* and *Harper's Bazaar* that reasonable efforts have been made to promote goods under the COCO mark in the UK;
- 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: It is not possible to ascertain this but, keeping in mind the reasonably limited geographical scope of use and the scale of use, despite promotion in national magazines, I conclude that the proportion of the relevant section of the public (being the jewellery buying public) is not large when considered in the context of the size of the UK consumer base in respect of jewellery;

- statements from chambers of commerce and industry or other trade and professional associations: there are no statements provided.

40) The opponent provides evidence that the name COCO is associated with its founder Gabrielle “Coco” Chanel. I do not dispute, given the way the evidence shows its COCO goods being marketed (namely in close association with its CHANEL marks), the consumer is likely to make such an association. However, the mark relied upon consists of COCO alone and contains no reference to CHANEL. As a consequence, it is not obvious to me that the link to the opponent’s founder will be detected by the average consumer in circumstances where there is an absence of a link to CHANEL, This is particularly so because it may equally refer to any person named COCO.

41) Considering all of this, I conclude that the opponent’s mark has not attained any material enhanced distinctive character resulting from the use made of it such as would influence the outcome of these proceedings.

#### **GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.**

42) The following principles are gleaned from the decisions of the CJEU 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.

43) 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 and 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*).

44) I have found that:

- With the exception of the applicant's cases for jewellery (where I found a medium degree of similarity to the opponent's goods), the respective goods are identical;
- The distinctive character of the applicant's mark resides in its totality;
- The respective marks share a medium degree of visual, aural and conceptual similarity and noted that it is common ground between the parties that COCO element of both marks will be understood as a reference to a person;
- The purchasing process is predominantly visual in nature with the level of attention paid by the consumer during the purchasing process being reasonable rather than high;
- The opponent's mark is endowed with a moderate degree of distinctive character and this is not enhanced by a material extent as a result of the use made of it.

45) Ms Bergert claimed that she is not aware of any instances of confusion. I note this, but I keep in mind the guidance in *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, where Kitchen L.J. stated that:

“80. ....the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in *Specsavers* at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a likelihood of confusion. But conversely, the absence of actual confusion despite side by side use may be powerful evidence that they are not sufficiently similar to give rise to a likelihood of confusion. This may not always be so, however. The reason for the absence of confusion may be that the mark has only been used to a limited extent or in relation to only some of the goods or services for which it is registered, or in such a way that there has been no possibility of the one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur.”

46) Taking this guidance into account together with an absence of evidence illustrating that the parties' customers may have been exposed to both marks, this may explain the reason why Ms Bergert is not aware of any actual confusion. Therefore, I dismiss this submission.

47) At the hearing, Ms Bergert claimed that there are third parties also using COCO. In the absence of any evidence of this, I dismiss this submission. Even if such evidence had been provided, whether or not it would have had any persuasive value would have depended on numerous factors.

48) When taking all of the above into account, I conclude that there is a likelihood of confusion in respect of all of the applicant's goods. Consumers familiar with either mark (I say this because it does not matter which way round the confusion occurs - see *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, paragraphs 42 – 67), upon encountering the other mark, are likely to assume the reference to COCO, present in both, is a reference to the same person and

consequently they are likely to believe that the goods provided under both marks originate from the same or a linked undertaking. I believe this to be so, even when taking into account that women's forenames are not uncommon as marks in the fashion and jewellery industries.

49) The opponent also relies upon an argument that its COCO and COCO CRUSH marks constitute a family of marks and that the applicant's mark will be perceived by the average consumer as another member of this family. I am not convinced by this submission, but it is a point I do not need to decide in light of my finding that the opponent is wholly successful.

50) In summary, the opposition is successful in its entirety and the application is refused.

## **COSTS**

51) The opponent has been successful and is entitled to a contribution towards its costs, according to the published scale in Tribunal Practice Notice 4/2007. I take account that both sides filed evidence and that a hearing was held. With this in mind, I award costs as follows:

Preparing statement and considering counterstatement (including fee)	£500
Preparing evidence and considering other side's evidence	£800
Preparing for & attending hearing	£750
<b>Total:</b>	<b>£2050</b>

52) I order Coco's Liberty Ltd to pay Chanel Limited the sum of £2050 which, in the absence of an appeal, should be paid within 14 days of the expiry of the appeal period.

**Dated this 11<sup>TH</sup> day of May 2017**

**Mark Bryant**

**For the Registrar**

**The Comptroller-General**