

O/620/17

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3187135

BY ZIQI HUANG FOR THE TRADE MARK



(A SERIES OF TWO MARKS)

IN CLASS 14

AND

THE OPPOSITION THERETO UNDER NUMBER 408261

BY

NIKON CORPORATION

Background

1. On 22 September 2016, Ziqi Huang filed trade mark application number 3187135, for the series of two marks shown below, in respect of goods in class 14:



2. The application was accepted and published in the *Trade Marks Journal* for opposition purposes on 14 October 2016. Nikon Corporation ("the opponent") opposes the applications under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act"). For section 5(2)(b), the opponent relies upon the following earlier trade mark registrations:

(i) 2643967

Nikon

Relying on goods and services in classes 14 and 35. Date of filing: 28 November 2012; completion of registration procedure: 10 May 2013.

(ii) EUTM 10415214

Nikon

Relying on goods in class 14. Date of filing: 14 November 2011; completion of registration procedure: 2 June 2012.

(iii) International registration designating the EU 1185846

Nikon

Relying on services in Class 35. Date of designation of the EU: 12 December 2012; priority date 30 November 2012 (Japan); date of protection in the EU: 24 October 2014.

3. The opponent claims that the similarity of the parties' marks, goods and services leads to a likelihood of confusion under section 5(2)(b). For section 5(3) of the Act, the opponent relies upon marks (i) and (ii) in respect of goods in class 9. The opponent claims that use of the applicant's mark would take unfair advantage of the distinctive character and repute of its mark, and/or cause detriment to the distinctive character and/or repute of its mark. Under section 5(4)(a) of the Act, the opponent claims that use of the applicant's mark is liable to be prevented under the law of passing off, owing to its goodwill attached to the sign NIKON, which it claims to have used throughout the UK since 1 January 1988, in respect of "a wide range of photographic and other optical equipment."

4. Ms Huang filed a defence and counterstatement, in particular stating:

2. Fashionikon, in English, has no actual meaning but similar pronunciation as Fashionicon that means Fashionable person, which consist of the meaning what Fashionikon carry in respect of products and services. The present application mark has been formed of Fashion and ikon, rather than Fashion and Nikon as opposed by earlier application.

3. The reason behind this logo is for creating a more differentiated impression for our targeted customer to know us as a fashion accessories provider. The main products we are selling are costume jewelry, temporary tattoos, and fabric products, which should have no reasons for raising a conflict with what Nikon is selling.

4. On the other hand, Fashionikon was originally from the word Fashionicon and a letter of 'k' has been used to alternative with the letter 'c' for differentiation purpose. Fashionikon is a complete word and has been typefaced of 'Snell Roundhand Bold' on PHOTOSHOP, that should be completely different from type face of Nikon

5. The opponent is professionally represented by Maucher Jenkins, whilst Ms Huang represents herself.

6. The opponent filed evidence and submissions on 19 May 2017, and also filed written submissions in lieu of a hearing. In the latter, the opponent submits:

"We note that no submissions have been made by the Applicant in respect of the allegations made in our letter of 19 May 2017. Accordingly, in line with the principles of the case of Premier Luggage and Bags Ltd. v The Premier Company (UK) Ltd. & Anor, in that the Applicant has not disputed or challenged the comments made in our letter of 19 May 2017, then these should be considered to be accepted. On this basis, the opposition should succeed and the present Applicant should be refused in its entirety."

7. I note that the opponent has not given a reference for the Premier Luggage case. This is unfair to the applicant, who is self-represented and not *au fait* with trade mark caselaw. In any event, the opponent's point is not a good one. Firstly, the written submissions in lieu of a hearing expressly rely upon the arguments presented in the notice of opposition. Simply on this basis, there was no requirement for Ms Huang to address the same points in the written submissions. Secondly, and most importantly (particularly considering the applicant is self-represented), the place for the opponent's allegations and challenges is in the notice of opposition. These were

answered in the counterstatement. There was no need to repeat the denial, there being no obligation to reply to written submissions. Lack of response to the same points made in the notice of opposition, which had already been denied, in no way constitutes acceptance of those points. I reject the opponent's submission that the opposition should succeed on this basis.

Evidence

8. The evidence comes from Kazuo Ushida, the opponent's President and Representative Director. For reasons which will become clear, it is unnecessary to set out a comprehensive summary of the opponent's evidence. I will refer to it as necessary later in the decision.

Decision

Section 5(2)(b) of the Act

9. 5(2)(b) of the Act states:

“(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.”

10. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-

425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public 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 and services

11. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where the 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.”

12. ‘Complementary’ was defined by the GC in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-325/06*:

“82 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...”.

13. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”) [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

14. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J said:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

15. As the opponent’s earlier marks had been registered for less than five years on the date on which the contested application was published, they are not subject to the proof of use provisions under section 6A of the Act. The consequence of this is that the opponent may rely upon all the goods and services specified in the notice of opposition in the registration without having to prove that it has made genuine use of them. I note that the class 35 specifications are very long and include all manner of business and office function services, in addition to retail services. I also note that the opponent’s statement of case appears to particularise the class 35 services of interest: retail and wholesale services for clocks and watches; unwrought and semi-

wrought precious stones and their imitations; badges of precious metal, tie pins, necklaces, bracelets, pendants, medals, rings, (trinkets); and brooches for clothing. These services represent the opponent’s best case in relation to its reliance on its class 35 services.

16. The law requires that goods and services be considered identical where one party’s description of its goods or services encompasses the specific goods or services covered by the other party’s descriptions (and vice versa): see *Gérard Meric v OHIM*, Case T-33/05, GC. The goods and services to be compared in class 14 are set out in the table below. I have highlighted goods which are identical either in the words used or because the description encompasses goods of the other party. I note that the applicant’s goods are repetitious; the goods beginning with the letters a, b and c appear twice (the goods are listed in alphabetical order).

Earlier marks	Application
<p>2643967: 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; unwrought precious stones; semi-wrought precious stones and their imitations; keyrings [trinkets or fobs]; jewellery cases; trophies [prize cups]; commemorative shields; personal ornaments [other than cuff links]; cuff links; shoe ornaments of precious metal; clocks and watches; pin badges; key rings of precious metals.</p> <p>EU 10415214: Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric</p>	<p>Alarm watches; Ankle bracelets; Articles of imitation jewellery; Articles of jewellery coated with precious metals; Artificial gem stones; Artificial jewellery; Artificial stones [precious or semi-precious]; Bangle bracelets; Bangles; Beads for making jewelry; Bib necklaces; Body-piercing rings; Body-piercing studs; Bracelets; Bracelets and watches combined; Bracelets for watches; Bracelets [jewellery, jewelry (Am.)]; Bracelets [jewelry]; Bracelets of precious metal; Brooches [jewellery, jewelry (Am.)]; Cases adapted to contain items of jewellery; Cases adapted to contain watches; Cases [fitted] for clocks; Cases [fitted] for horological articles; Cases [fitted] for jewels; Cases [fitted] for watches; Cases for jewels; Cat collar charms; Chains [jewellery, jewelry (Am.)]; Chalcedony;</p>

<p>instruments; pin badge; key rings of precious metals.</p>	<p>Charity bracelets; Charms for collar jewelry and bracelet; Charms in precious metals or coated therewith; Charms [jewellery, jewelry (Am.)]; Charms [jewellery] of common metals; Charms of precious metals; Charms of semi-precious metals; Chokers; Amulets being jewellery; Amulets [jewellery]; Amulets [jewellery, jewelry (Am.)]; Ankle bracelets; Articles of imitation jewellery; Articles of jewellery; Articles of jewellery coated with precious metals; Articles of jewellery made from rope chain; Articles of jewellery made of precious metal alloys; Articles of jewellery made of precious metals; Articles of jewellery with ornamental stones; Articles of jewellery with precious stones; Artificial gem stones; Artificial jewellery; Artificial stones [precious or semi-precious]; Badges of precious metal; Bands for watches; Bangle bracelets; Bangles; Barrels [clock and watch making]; Barrels [clock and watchmaking]; Beads for making jewelry; Bib necklaces; Body-piercing rings; Body-piercing studs; Bottle caps of precious metals; Boxes for timepieces; Boxes of precious metal; Bracelets; Bracelets and watches combined; Bracelets for watches; Bracelets [jewellery, jewelry (Am.)]; Bracelets [jewelry]; Bracelets of precious metal; Brooches [jewellery, jewelry (Am.)]; Buckles for watchstraps; Busts of precious metal; Busts of precious metals; Cabinets for clocks; Cases adapted to</p>
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	<p>contain horological articles; Cases adapted to contain items of jewellery; Cases adapted to contain watches; Cases [fitted] for jewels; Cases [fitted] for watches; Cases for chronometric instruments; Cases for clock and watch-making; Cases for jewels; Cases for watches; Cases for watches and clocks; Cases for watches [presentation]; Cases of precious metals for clocks; Cases of precious metals for horological articles; Cases of precious metals for jewels; Cases of precious metals for watches; Caskets for clocks and jewels; Chain mesh of precious metals [jewellery]; Chain mesh of semi-precious metals; Chains for watches; Chains [jewellery, jewelry (Am.)]; Chains made of precious metals [jewellery]; Chains of precious metals; Chains (Watch -); Chalcedony; Charity bracelets; Charms for collar jewelry and bracelet; Charms in precious metals or coated therewith; Charms [jewellery, jewelry (Am.)]; Charms [jewellery] of common metals; Charms of precious metals; Charms of semi-precious metals; Chokers; Clips (Tie -); Costume jewellery; Costume jewelry; Crosses [jewellery]; Cuff links and tie clips; Cuff links coated with precious metals; Custom jewelry; Drop earrings; Ear clips; Ear ornaments in the nature of jewellery; Ear studs; Earrings; Earrings of precious metal; Fitted covers for jewelry rings to protect against impact, abrasion, and damage to the ring's band and stones; Imitation jewellery; Imitation jewellery</p>
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	<p> ornaments; Imitation jewelry; Imitation pearls; Imitation precious stones; Jewellery cases; Jewellery chain of precious metal for anklets; Jewellery chain of precious metal for bracelets; Jewellery chain of precious metal for necklaces; Jewellery chains; Key chains as jewellery [trinkets or fobs]; Key charms coated with precious metals; Key charms of precious metals; Key charms [trinkets or fobs]; Key rings and key chains; Key rings of precious metals; Key rings [trinkets or fobs]; Key rings [trinkets or fobs] of precious metal; Lapel pins of precious metals [jewellery]; Leather jewelry boxes; Man-made pearls; Natural gem stones; Neck chains; Necklaces; Necklaces [jewellery]; Necklaces [jewellery, jewelry (Am.)]; Necklaces of precious metal; Non-leather watch straps; Non-monetary coins; Pearl; Pearls; Pearls [jewellery, jewelry (Am.)]; Pierced earrings; Ring bands [jewellery]; Ring holders of precious metal; Rings being jewellery; Rings coated with precious metals; Rings [jewellery]; Rings [jewellery, jewelry (Am.)]; Rings [jewellery] made of non-precious metal; Rings [jewellery] made of precious metal; Rings [jewelry]; Rings [trinket]; Rope chain [jewellery] made of common metal; Rope chain made of precious metal; Ruby; Ruthenium; Silver bracelets; Silver bullion; Silver earrings; Silver ingots; Silver necklaces; Silver rings; Silver thread; Silver-plated bracelets; Silver- </p>
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	<p>plated earrings; Silver-plated necklaces; Silver-plated rings; Small jewellery boxes of precious metals; Small jewelry boxes, not of precious metal; Sterling silver jewellery; Wedding bands (Jewellery); Wrist bands [charity]; Wrist straps for watches; Wrist watch bands; Wrist watches; Wristbands [charity]; Wristlet watches; Wristlets [jewellery]; Wristwatches; Wristwatches with GPS apparatus; Wristwatches with pedometers.</p>
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17. It can be seen from the table that the majority of the parties' class 14 goods are identical. The remaining goods in the application are:

Cases adapted to contain watches; Cases [fitted] for clocks; Cases [fitted] for horological articles; Cases [fitted] for watches; Cat collar charms; Barrels [clock and watch making]; Barrels [clock and watchmaking]; Boxes for timepieces; Cabinets for clocks; Cases adapted to contain horological articles; Cases adapted to contain watches; Cases [fitted] for watches; Cases for chronometric instruments; Cases for clock and watch-making; Cases for watches; Cases for watches and clocks; Cases for watches [presentation]; Wrist bands [charity]; Wristbands [charity];

18. As noted above, the applicant's specification includes *boxes of precious metal; cases of precious metals for clocks; cases of precious metals for horological articles; and cases of precious metals for watches*. These are identical to the opponent's goods made from precious metals or coated therewith. The applicant's boxes, cabinets, cases for clock and watch-making and various cases, listed in the paragraph above, could also be made from or covered with precious metals. The goods, therefore, are covered by the opponent's goods which are made from precious metals or coated therewith. Even if they are not identical, they are of a similar nature and purpose to the opponent's jewellery cases, will share users, method of use and channels of trade, so are similar to a good degree. Also similar to the opponent's jewellery cases are *fitted covers for jewelry rings to protect against*

impact, abrasion, and damage to the ring's band and stones; they serve the same purpose, users, methods of use and channels of trade.

19. *Cat collar charms* could be made from or coated with precious metals, in which case they are identical to the opponent's goods. *Wrist bands [charity]; Wristbands [charity]* are a type of personal ornament, which is a term in the opponent's specification for 2643967, and are, therefore, identical to personal ornaments. Given that they are worn to show support for a charity, they are highly similar to the opponent's pin badges, sharing purpose, users, channels of trade and being in competition, as an alternative to wearing a pin badge.

20. This leaves the barrels [clock and watch making] and barrels [clock and watchmaking], which are parts of clocks and watches. The opponent's specifications do not cover parts and fittings for clocks and watches. I do not know if such parts can be made from precious metals and their alloys. There is a low degree of similarity with the opponent's clocks and watches because they are complementary as 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.

21. The opponent's class 35 services do not put the opponent in any better a position than the comparison between the application and the opponent's class 14 goods.

The average consumer and the purchasing process

22. 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*.

23. The average consumer of the goods is a member of the general public. Visual considerations will be far and away the most important part of the selection process,


to ensure the product is of a pleasing design and fit for purpose, although I bear in mind that there may be an aural aspect to the purchasing process, e.g. if advice is sought prior to purchase. The degree of care the average consumer will display when selecting the goods is likely to vary depending on the price of the goods being purchased, but will be of at least a reasonable level (and may be very high).

Comparison of marks

24. 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 Court of Justice of the European Union 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.”

25. 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. I will compare the earlier marks which are relied upon in relation to class 14 goods (marks (i) and (ii)). The marks to be compared are:

Earlier registrations (i) and (ii)	Application
<p data-bbox="204 331 448 412">Nikon</p>	

26. Since the earlier registrations, which I will refer to as the earlier mark, consist of a single element, Nikon, this is the distinctive and dominant component of the earlier mark. Ms Huang's marks are comprised of more than one element. The word 'jewellery' is neither distinctive nor dominant and so will contribute very little, if anything, to the overall impression of the second mark in the series. The other two elements, the crown device and the word Fashionikon, have roughly equal impact and so neither dominates the overall impression.

27. Comparing the parties' marks visually, the earlier marks do not contain a device. The word element Fashionikon consists of eleven letters: the last five are identical to the earlier mark. The first six letters of Fashionikon are absent from the earlier mark. This is important because the average UK consumer reads from left to right. Balancing the various components, there is a very low degree of visual similarity between them.

28. The crown device will not be articulated in speech, which means that the aural comparison is between the word elements. The earlier mark will either be pronounced with a long or short 'i' (so, either N-eye-kon or N-ick-on). The first six letters and the first two syllables in the application are different to the earlier mark. Fashionikon has four syllables as opposed to the two in Nikon. The first 6 letters of Fashionikon will be recognised immediately as the word Fashion, and so will be

pronounced as this word. The last four letters of Fashionikon will either be pronounced with a long or short ‘i’: how this syllable will be pronounced will be informed to a large extent by conceptual considerations. On balance, there is a low degree of aural similarity between the parties’ marks.

29. Nikon does not have a meaning or concept, and is not reminiscent of a dictionary word. Consequently, it will be seen as an invented word. The first six letters of Fashionikon form the common word ‘fashion’, the meaning of which does not need explanation. Following on from the immediate recognition of the meaning of ‘fashion’, it is natural to continue reading across to ‘ikon’. The most likely interpretation of this element will be that it is reminiscent of the word ‘icon’, because ‘fashion’ qualifies ‘icon’: someone who is a fashion icon. This is more likely than seeing Fashionikon as a conjoining of Fashion and nikon, which is what the opponent claims. There is no conceptual similarity between the marks.

30. Combining these various assessments, the marks have no overall similarity.

Distinctive character of the earlier marks

31. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*¹ 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 *WindsurfingChiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

¹ Case C-342/97

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).”

32. One of the principles which must be taken into account in deciding whether there is a likelihood of confusion is that 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. With this in mind, I need to assess whether the use made of the earlier marks has improved their distinctiveness levels to any meaningful degree. The relevant date for this assessment is the filing date of the contested application, 22 September 2016.

33. I consider it to be a notorious fact that Nikon is very well-known as a trade mark for camera equipment. The evidence shows that the opponent had a 45% share of the EU market for digital single reflex cameras in 2015. Included in the evidence are various reports of ‘brand rankings’, such as the UK Superbrands, Brand Directory and CoolBrands. Nikon was in the top 20 Cool Brands in 2012/13.

34. The evidence from the opponent’s website refers to the opponent also selling precision instruments (semiconductor lithography systems), optical apparatus and surveying apparatus and instruments (plus associated software). No figures are given for these, so it is not possible to say that the mark has an enhanced level of distinctive character for such goods. The evidence also shows that the opponent has sponsored various high profile sports events, such as the UK Open Golf Championships; the World Swimming Championships in Turkey, China and Dubai; the Asian Football Cup in Qatar, and car and motorbike championships in the USA and Australia. However, the most recent of any of these was in 2012 (swimming in

Turkey); most of the events at which the opponent was a sponsor took place in 2010 and 2011; and it is not clear what level of coverage the overseas events had in the UK. In any event, the rest of the evidence confirms that the opponent had, at the relevant date, a very strong reputation in camera equipment, without needing to rely upon ageing sponsorship of these events.

35. Nikon is not an English dictionary word. Generally, invented words have a high level of inherent distinctive character because they in no way describe or allude to any aspect of the goods or services. Nikon has a high level of distinctive character in relation to the goods relied upon under section 5(2)(b), Class 14 (and the services in Class 35). If it is possible to elevate that high level of distinctiveness through use, then the opponent has achieved this in relation to camera equipment. However, it has not relied upon camera equipment for this ground and, if it had, camera equipment would not have been similar to the applicant's goods. The enhanced level of distinctive character does not, therefore, take the opponent further than the already high level of inherent distinctive character in Nikon.

Likelihood of confusion

36. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. One of those principles states that a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*). The vast majority of the parties' goods are identical. However, despite this and despite the high level of inherent distinctive character for the earlier marks, there is no likelihood of confusion because there is no overall similarity between the marks. Even to bring to mind the earlier mark, Nikon, let alone to confuse Nikon with the application would mean considerable dissection of Fashionikon. If there is any natural break in Fashionikon, it is Fashion Ikon, not Fashion Nikon. Nor would Fashionikon be seen as an elision of Fashion and nikon. The average consumer would have to study the application hard to arrive at either scenario; a process which the average consumer would not undertake whatever the level of attention paid during the purchasing process. If I am

wrong that there is no overall similarity, there is only the lowest level of visual and aural similarity, which is offset by the lack of conceptual similarity, and the strong allusion to Fashion Icon in Ms Huang's mark, a concept which is missing from the earlier mark. There is no likelihood of confusion.

37. The section 5(2)(b) ground fails.

Section 5(3) of the Act

38. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC), in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

39. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Adidas-Salomon*, [2004] ETMR 10 and Case C-487/07, *L'Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact on the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure*).

40. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that its earlier mark relied upon has achieved a level of knowledge/reputation amongst a significant part of the public. Secondly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between the marks, in the sense of the earlier mark being brought to mind by the later mark. Thirdly, assuming that the first and second conditions have been met, section 5(3) requires that one or more of the three types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

41. The first condition is reputation. For its section 5(3) ground, the applicant relies upon marks (i) and (ii) for goods in class 9:

2643967: Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment, computers; computer software; fire-extinguishing apparatus; photographic equipment and parts and accessories therefor; cameras and parts and accessories therefor; digital cameras and

parts and accessories therefor; camera lenses; batteries and battery chargers for cameras and digital cameras; remote controls for cameras and digital cameras; cases for cameras and digital cameras; straps for cameras and digital cameras; binoculars; telescopes; range finders; computer software for editing and managing of photographs and movies; electronic publications; non-contact measuring machines and instruments; liquid crystal projectors; cameras with liquid crystal projectors; digital cameras with liquid crystal projectors; microscopes; electron microscopes; biological microscopes; x-ray electron microscopes; rifle scopes; telescopic sights; monoculars; spectacles; eyeglasses; glasses; eyewear; ophthalmic lenses; optical lenses; lenses for spectacles; lenses for eyeglasses; lenses for glasses; lenses for eyewear; eyeglass frames; solid state memory cards; flash memory cards; cell culture and observation systems; magnifying glasses; crossbow scopes; digital photo frames; telescopes for firearms; sighting telescopes for firearms; semiconductor manufacturing machines and systems; liquid crystal manufacturing machines and systems; semiconductor exposure apparatus; liquid crystal exposure apparatus; semiconductor testing apparatus; liquid crystal testing apparatus; polishing machines and apparatus for wafers; parts and accessories for semiconductor manufacturing machines and systems; parts and accessories for liquid crystal manufacturing machines and systems; parts and accessories for semiconductor exposure apparatus; parts and accessories for liquid crystal exposure apparatus; parts and accessories for semiconductor testing apparatus; parts and accessories for liquid crystal testing apparatus; parts and accessories for polishing machines and apparatus for wafers; cases especially made for photographic apparatus and instruments; filters for ultraviolet rays for cameras and digital cameras; filters for cameras and digital cameras; flash-bulbs for cameras and digital cameras; flashlights for cameras and digital cameras; shutter releases for cameras and digital cameras; shutters for cameras and digital cameras; slides [photography]; spools for cameras and digital cameras; stands for photographic apparatus; transparencies [photography]; viewfinders for cameras and digital cameras; tripods for cameras and digital cameras; epidiascopes; mobile phones; cellular phones; smartphones; hand-held terminal devices; scanners [data processing equipment]; CCD (charge-coupled device) cameras; decoration stickers for cameras; SD memory cards; flash memory cards; USB hubs; flash card readers; video game software; speakers; metronomes.

EUTM 10415214: Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus; photographic equipment and parts and accessories therefor; cameras and parts and accessories therefor; digital cameras and parts and accessories therefor; camera lenses; batteries and battery chargers for cameras and digital cameras; remote controls for cameras and digital cameras; cases for cameras and digital cameras; straps for cameras and digital cameras; binoculars; telescopes; range finders; computer software for editing and managing of

photographs and movies; electronic publications; non-contact measuring machines and instruments; computer software; liquid crystal projector; cameras with liquid crystal projector; digital cameras with liquid crystal projector; microscopes; electron microscopes; biological microscopes; x-ray electron microscopes; rifle scope; telescopic sights; monacles; spectacles; eyeglasses; glasses; eyewear; ophthalmic lenses; optical lenses; lenses for spectacles; lenses for eyeglasses; lenses for glasses; lenses for eyewear; eyeglass frames; solid state memory card; flash memory card; cell culture and observation system; magnifying glasses; crossbow scope; digital photo frame; telescope for firearm; sighting telescopes for firearms; semiconductor exposure apparatus; liquid crystal exposure apparatus; semiconductor testing apparatus; liquid crystal testing apparatus; parts and accessories for semiconductor exposure apparatus; parts and accessories for liquid crystal exposure apparatus; parts and accessories for semiconductor testing apparatus; parts and accessories for liquid crystal testing apparatus; cases especially made for photographic apparatus and instruments; filters for ultraviolet rays for cameras and digital cameras; filters for cameras and digital cameras; flash-bulbs for cameras and digital cameras; flashlights for cameras and digital cameras; shutter releases for cameras and digital cameras; shutters for cameras and digital cameras; slides [photography]; spools for cameras and digital cameras; stands for photographic apparatus; transparencies [photography]; viewfinders for cameras and digital cameras; tripods for cameras and digital cameras; epidiascopes; mobile phones; cellular phones; smartphones; handheld terminal devices; scanners [data processing equipment]; CCD (charge-coupled device) cameras; SD memory cards; flash memory cards; USB hubs; flash card readers; video game software.

42. The CJEU gave guidance in relation to assessing reputation in *General Motors*:

“24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector.

25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.”

43. Claiming a reputation in relation to all the class 9 goods reputation is not justified on the evidence filed. I have already given my findings as to where the opponent’s reputation lies: camera equipment.

44. Although similarity of goods is not a requirement of section 5(3) of the Act, the relative distance between the goods is still a factor in determining whether the earlier mark will be brought to mind by the later mark. Goods in class 14 and camera equipment are far apart.

45. Whilst similarity of goods is not a prerequisite, the marks do have to be similar. I refer to my findings above in this regard. When the lack of similarity between the marks is combined with the gulf between the parties’ goods, there will be no link made between them.

46. Consequently, the section 5(3) ground fails.

Section 5(4)(a) of the Act

47. 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.”

48. The requirements to succeed in a passing off action are well established and are summarised in *Halsbury’s Laws of England* 4th Ed. as being that:

i) the claimant’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

ii) there is a misrepresentation by the defendant (whether or not intentional) which is likely to deceive the public into believing that the defendant’s goods or services are those of the claimant;

and iii) the claimant has suffered or is likely to suffer damage as a result of the erroneous belief created by the defendant’s misrepresentation.

49. There is one possible difference between the position under trade mark law and the position under passing off law. In *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, Lewinson L.J. cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that “a substantial number” of the relevant public are deceived, which might not mean that the average consumer is confused. As both tests are intended to be normative measures intended to exclude those who are unusually careful or careless (per Jacob L.J. in *Reed Executive Plc v Reed Business Information Ltd* [2004] RPC 40), it is doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes.

50. The opponent has substantial goodwill in Nikon for camera equipment. This ground suffers from the same shortcomings in relation to lack of similarity between the marks/signs and lack of similarity of fields of trade. Whilst the latter does not, automatically, lead to a failure for the opponent, in *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA), Millet L.J. made the following findings about

the lack of a requirement for the parties to operate in a common field of activity, and about the additional burden of establishing misrepresentation and damage when they do not:

“There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff's business. The expression “common field of activity” was coined by *Wynn-Parry J. in McCulloch v. May* (1948) 65 R.P.C. 58, when he dismissed the plaintiff's claim for want of this factor. This was contrary to numerous previous authorities (see, for example, *Eastman Photographic Materials Co. Ltd. v. John Griffiths Cycle Corporation Ltd.* (1898) 15 R.P.C. 105 (cameras and bicycles); *Walter v. Ashton* [1902] 2 Ch. 282 (The Times newspaper and bicycles) and is now discredited. In the *Advocaat* case Lord Diplock expressly recognised that an action for passing off would lie although “the plaintiff and the defendant were not competing traders in the same line of business”. In the *Lego case Falconer J.* acted on evidence that the public had been deceived into thinking that the plaintiffs, who were manufacturers of plastic toy construction kits, had diversified into the manufacture of plastic irrigation equipment for the domestic garden. What the plaintiff in an action for passing off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties.

The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration

‘...whether there is any kind of association, or could be in the minds of the public any kind of association, between the field of activities of the plaintiff and the field of activities of the defendant’:

Annabel's (Berkeley Square) Ltd. v. G. Schock (trading as Annabel's Escort Agency) [1972] R.P.C. 838 at page 844 per Russell L.J.

In the *Lego* case *Falconer J.* likewise held that the proximity of the defendant's field of activity to that of the plaintiff was a factor to be taken into account when deciding whether the defendant's conduct would cause the necessary confusion.

Where the plaintiff's business name is a household name the degree of overlap between the fields of activity of the parties' respective businesses may often be a less important consideration in assessing whether there is likely to be confusion, but in my opinion it is always a relevant factor to be taken into account.

Where there is no or only a tenuous degree of overlap between the parties' respective fields of activity the burden of proving the likelihood of confusion and resulting damage is a heavy one. In *Stringfellow v. McCain Foods (G.B.) Ltd.* [1984] R.P.C. 501 Slade L.J. said (at page 535) that the further removed from one another the respective fields of activities, the less likely was it that any member of the public could reasonably be confused into thinking that the one business was connected with the other; and he added (at page 545) that

‘even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.’

In the same case Stephenson L.J. said at page 547:

‘...in a case such as the present the burden of satisfying Lord Diplock's requirements in the *Advocaat* case, in particular the fourth and fifth requirements, is a heavy burden; how heavy I am not sure the judge fully appreciated. If he had, he might not have granted the respondents relief. When the alleged “passer off” seeks and gets no benefit from

using another trader's name and trades in a field far removed from competing with him, there must, in my judgment, be clear and cogent proof of actual or possible confusion or connection, and of actual damage or real likelihood of damage to the respondents' property in their goodwill, which must, as Lord Fraser said in the *Advocaat* case, be substantial.' ”

51. In *Phones 4u Ltd v Phone4u.co.uk. Internet Ltd* [2007] RPC 5, in the Court of Appeal, Jacob LJ said:

“16 The next point of passing off law to consider is misrepresentation. Sometimes a distinction is drawn between "mere confusion" which is not enough, and "deception," which is. I described the difference as "elusive" in *Reed Executive Plc v Reed Business Information Ltd* [2004] R.P.C. 40. I said this, [111]:

"Once the position strays into misleading a substantial number of people (going from 'I wonder if there is a connection' to 'I assume there is a connection') there will be passing off, whether the use is as a business name or a trade mark on goods."

17 This of course is a question of degree—there will be some mere wonderers and some assumers—there will normally (see below) be passing off if there is a substantial number of the latter even if there is also a substantial number of the former.

18 The current (2005) edition of *Kerly* contains a discussion of the distinction at paras 15–043 to 15–045. It is suggested that:

"The real distinction between mere confusion and deception lies in their causative effects. Mere confusion has no causative effect (other than to confuse lawyers and their clients) whereas, if in answer to the question: 'what moves the public to buy?', the insignia complained of is identified, then it is a case of deception."

19 Although correct as far as it goes, I do not endorse that as a complete statement of the position. Clearly if the public are induced to buy by mistaking the insignia of B for that which they know to be that of A, there is deception. But there are other cases too—for instance those in the Buttercup case. A more complete test would be whether what is said to be deception rather than mere confusion is really likely to be damaging to the claimant's goodwill or divert trade from him. I emphasise the word "really."

52. The opponent's customers would not get as far as wondering if there is a connection between the parties' marks, let alone that the use of the application would cause a substantial number of the opponent's customers to be misled into purchasing the Ms Huang's goods, believing that they are provided by the opponent. **The section 5(4)(a) ground fails.**

Outcome

53. The opposition fails under all grounds. The application may proceed to registration.

Costs

67. Ms Huang has been successful and is entitled to a contribution towards her costs. Awards of costs in proceedings commenced after 1 July 2016 are governed by Annex A of Tribunal Practice Notice ("TPN") 2 of 2016. As Ms Huang is unrepresented, at the conclusion of the evidence rounds the tribunal invited her to indicate whether she intended to make a request for an award of costs and, if so, to complete a pro-forma indicating a breakdown of her actual costs, including providing accurate estimates of the number of hours spent on a range of given activities relating to the prosecution of the opposition. It was made clear to Ms Huang that if the pro-forma was not completed "no costs, other than official fees arising from the action and paid by the successful party...will be awarded". Since Ms Huang did not respond to that invitation within the timescale allowed (nor has any response been received from her prior to the date of the issuing of this decision), and as Ms Huang

has not incurred any official fees in defending its application, I make no order as to costs.

Dated this 5th day of December 2017

**Judi Pike
For the Registrar,
the Comptroller-General**