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In the matter of UK Trade Mark Application No.3150004 alaanyi in the name of Chiemeka Eijochi (the Applicant) in classes 24, 25, 27 & 42

and

Opposition No. 406759 thereto by dm-drogerie markt GmbH + Co. KG (the Opponent)

and

In the matter of an Appeal to the Appointed Person by the Opponent against the Decision of the Hearing Officer O-67-17 for the Registrar, The Comptroller General dated 15 February 2017

DECISION

Procedural history

1. On 16 February 2016, the Applicant applied to register the mark 'alaanyi' for a variety of goods in classes 24, 25, 27 and services in class 42.
2. The Opponent's opposition under s.5(2)(b) of the Trade Marks Act 1994 was and is based on the trade mark ALANA, the subject of an International Registration designating the EU No. 1123649 ("the Opponent's Mark"). There was no challenge to the Hearing Officer's finding that this was an earlier mark. It is registered in respect of a variety of goods in classes 21 & 25.
3. It is not necessary for me to set out the complete specifications of either the mark applied for or the Opponent's mark. It is sufficient to record that both specifications include identical goods in Class 25, namely, clothing and hats.
4. The Applicant filed a counterstatement in which he explained that the origins of his alaanyi mark are Igbo, a language which originates in Southeast Nigeria. He explained his view as to how his mark would be pronounced – as 'alan-yee' and as to how the Opponent's mark would be pronounced – as 'alan-ah'. His counterstatement also made various other submissions. Thereafter the Applicant did not file any evidence and, as it happened, played no active role thereafter in the Opposition or in this Appeal.
5. The Opponent filed evidence but it was directed only at showing examples of co-branding on clothing.

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6. Neither party requested a hearing but the Opponent filed written submissions.
7. In his decision dated 15th February 2017, the Hearing Officer rejected the Opposition in its entirety, finding that even in relation to the identical goods in class 25, there was no likelihood of confusion. He awarded no costs to the Applicant because the Applicant did not respond to the invitation to file information which detailed any costs he had incurred.

The Appeal in outline.

8. The Opponent appeals. At the hearing of the Appeal on 18 September 2017 the Opponent was represented by Mr Iain Stewart of Kilburn & Strode LLP, who provided me with a helpful and succinct skeleton argument. The Applicant was neither in attendance at the hearing nor represented and has made no response to the Appeal.
9. The Appeal has a narrow compass. There was no challenge to many of the parts of the Hearing Officer's decision in which:
 - 9.1. In §10, he directed himself as to the law concerning s.5(2)(b) by setting out the standard summary paragraphs (a) to (k) used by Hearing Officers (and as approved by the Court of Appeal).
 - 9.2. In §§11-23, he conducted a careful comparison of the goods and services. At the hearing before me, Mr Stewart helpfully concentrated on the identical goods – clothing - accepting that if he could not win on those goods, none of the other similar goods or services would help.
 - 9.3. In §§24-28, he considered the characteristics of the relevant average consumer(s) and the nature of the purchasing act(s).
 - 9.4. Mr Stewart made no criticism of these parts of the Decision. Having reviewed them myself, he was right to do so.
10. The Opponent's Appeal focusses on part of the comparison of the marks. The Opponent agrees with the Hearing Officer's assessment as regards the degree of visual and aural similarity, but it contends the Hearing Officer fell into error when

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he made his assessment of the degree of conceptual similarity between the mark applied for and the Opponent's Mark. Effectively the same point feeds through into the criticism of the Hearing Officer's global assessment of the likelihood of confusion. The Opponent criticizes the weight which the Hearing Officer gave to the conceptual aspects of the opposing signs in the global assessment of the likelihood of confusion. As I understood the point, the Opponent says that whatever the degree of conceptual similarity, it was not enough to outweigh the 'at least medium' visual and aural similarity, so the Hearing Officer should have found a likelihood of confusion.

Standard of Review

11. This appeal is by way of review such that the usual principles set out in *Reef Trade Mark* [2003] RPC 5 and other cases (including *BUD Trade Mark* [2003] RPC 25 and *Fage UK Ltd v Chobani UK Ltd* [2014] ETMR 26) apply. The same points are made at [5]-[6] of the judgment of Daniel Alexander Q.C. (sitting as a Deputy Judge of the High Court) in *Digipos Store Solutions Group Ltd v Digi International Inc.* [2008] RPC 24.
12. I have also kept in mind the more recent review of the case law on the appellate approach which Mr Alexander Q.C. carried out, this time as the Appointed Person, in *Talk for Writing Trade Marks O-017-17*. Having reviewed the case law from [14] to [50] he summarised the principles as follows:

'52. Drawing these threads together, so far as relevant for the present case, the principles can therefore be summarized as follows.

(i) Appeals to the Appointed Person are limited to a review of the decision of Registrar (CPR 52.11). The Appointed Person will overturn a decision of the Registrar if, but only if, it is wrong (Patents Act 1977, CPR 52.11).

(ii) The approach required depends on the nature of decision in question (REEF). There is spectrum of appropriate respect for the Registrar's determination depending on the nature of the decision. At one end of the spectrum are decisions of primary fact reached after an evaluation of oral evidence where credibility is in issue and purely discretionary decisions. Further along the spectrum are multi-factorial decisions often dependent on inferences and an analysis of documentary material (REEF, DuPont).

(iii) In the case of conclusions on primary facts it is only in a rare case, such as

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where that conclusion was one for which there was no evidence in support, which was based on a misunderstanding of the evidence, or which no reasonable judge could have reached, that the Appointed Person should interfere with it (Re: B and others).

(iv) In the case of a multifactorial assessment or evaluation, the Appointed Person should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions. In particular, where an Appointed Person has doubts as to whether the Registrar was right, he or she should consider with particular care whether the decision really was wrong or whether it is just not one which the appellate court would have made in a situation where reasonable people may differ as to the outcome of such a multifactorial evaluation (REEF, BUD, Fine & Country and others).

(v) Situations where the Registrar's decision will be treated as wrong encompass those in which a decision is (a) unsupportable, (b) simply wrong (c) where the view expressed by the Registrar is one about which the Appointed Person is doubtful but, on balance, concludes was wrong. It is not necessary for the degree of error to be "clearly" or "plainly" wrong to warrant appellate interference but mere doubt about the decision will not suffice. However, in the case of a doubtful decision, if and only if, after anxious consideration, the Appointed Person adheres to his or her view that the Registrar's decision was wrong, should the appeal be allowed (Re: B).

(vi) The Appointed Person should not treat a decision as containing an error of principle simply because of a belief that the decision could have been better expressed. Appellate courts should not rush to find misdirections warranting reversal simply because they might have reached a different conclusion on the facts or expressed themselves differently. Moreover, in evaluating the evidence the Appointed Person is entitled to assume, absent good reason to the contrary, that the Registrar has taken all of the evidence into account. (REEF, Henderson and others).

Bearing in mind the repeated reminders that different points are likely to be particularly relevant in other cases, this is not intended to be a summary of universal application for other cases where particular aspects of the approach may require different emphasis.'

The Relevant Parts of the Decision – conceptual comparison

13. Under the heading 'Comparison of trade marks', the Hearing Officer directed himself by reference to *Sabel BV v Puma* (particularly para 23) and *Bimbo v OHIM* (para 34). At §33 he stated he considered there to be 'at least a medium degree of visual similarity between the competing trade marks.' At §§34-35, the Hearing

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Officer considered aural similarity and for the reasons he set out he concluded there is ‘*at least a medium degree of aural similarity between the trade marks at issue.*’ The Opponent does not criticise those findings, indeed it relies on them and emphasises the ‘at least’ in each case.

14. In relation to the conceptual comparison, the Hearing Officer said this:

36. Finally, in relation to the conceptual comparison, the opponent states:

“25. Although the applicant has indicated that the origin of their trade mark is in the Nigerian language this would not be evident to many consumers in the UK. There is no conceptual similarity to speak of...”

37. The opponent’s trade mark will be understood as a feminine forename. While I note the derivation of the applicant’s trade mark, I agree with the opponent that this meaning will not be known to the average consumer in this country. The applicant’s trade mark may, for example, be construed as an invented word (with no meaning) or a word from an unspecified foreign language (the meaning of which will be unknown). In short, the opponent’s trade mark will convey a concrete conceptual message whereas the applicant’s will not.

15. It is necessary also to take account of the Hearing Officer’s assessment of the degree of distinctive character of the earlier mark. I did not detect any criticism of this assessment by the Opponent on this Appeal, but as part of this assessment the Hearing Officer indicated (in the passage I have underlined) that he was proceeding on the basis that although ALANA would be seen as a feminine forename, it was one that is not terribly common:

39. Although the opponent has filed evidence in these proceedings, as none of this evidence was directed to the use it may have made of its earlier trade mark, I have only its inherent credentials to consider. As I mentioned above, ALANA will be known as a feminine forename albeit, in my experience, one that is not terribly common. Although feminine forenames are fairly commonplace as designations of origin in the fashion and clothing sectors, as a relatively uncommon forename, the opponent’s earlier trade mark is, in my view, possessed of an average degree of inherent distinctive character.

16. The Opponent points to §§37 and 39 of the Decision and says they are inconsistent in this sense: if the name is ‘not terribly common’, how can it convey a ‘concrete conceptual message’? Before me, the Opponent sought to bolster its argument with

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the statistic that ALANA did not feature in the top 100 list of given feminine names in the UK between 1904-2015. Mr Stewart informed me in oral submissions that in fact it ranked at 227 in England and Wales in 2015, representing 223 children.

17. These data (even if admissible) miss the point and do not give rise to any reviewable error in the Hearing Officer's reasoning. In my view, there is no inconsistency between §§37 and 39. A finding that a feminine forename is 'not terribly common' means that some people and perhaps the majority will not have come across that name before but that does not prevent those people (and in particular, the average consumer) from recognizing and therefore understanding it as a feminine forename.
18. The Opponent also contended that *'There is an absence of a concrete message conveyed by the earlier mark.'* For this contention to be upheld I would have to find that the earlier mark ALANA would be seen and understood by the average consumer as a meaningless, invented word. I am unable to make such a finding for two reasons: first, because I cannot detect any error in the Hearing Officer's reasoning, let alone an error of principle which would entitle me to intervene and second, because, in any event, I do not agree that ALANA would be understood as a meaningless invented word – I agree with what the Hearing Officer said.

Relevant parts of the Decision – Likelihood of confusion

19. When it came to his consideration of whether there was a likelihood of either direct or indirect confusion, the Hearing Officer directed himself entirely appropriately on the general approach in §§40 and 41. He also summarised the findings he had made earlier in his decision which feed into the global assessment. He then cited passages from *Picasso* and *Nokia*:

42. In *The Picasso Estate v OHIM, Case C-361/04 P*, the CJEU found that:

"20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law."

However, in Nokia Oyj v OHIM, Case T-460/07, the GC stated that:

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“Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established (see, to that effect, Case C-16/06 P Éditions Albert René [2008] ECR I-0000, paragraph 98).”

20. The Hearing Officer then stated his conclusions:

43. In reaching a conclusion, I begin by reminding myself that the competing goods and services are either identical or similar to at least a medium degree and that the trade marks at issue are visually and aurally similar also to at least a medium degree. However, I have also concluded that the opponent’s trade mark will create a concrete conceptual image in the mind of the average consumer (of a feminine forename) whereas the applicant’s trade mark will not convey any conceptual message. Although I am conscious of the guidance in Nokia, each case turns on its own facts and I am satisfied that the very clear conceptual message conveyed by the opponent’s trade mark, a message which will, in turn, act as a hook in the mind of the average consumer (paying a normal degree of attention during the selection process) and thus aid their recall, is sufficient to avoid a likelihood of either direct or indirect confusion.

Discussion

21. As the Opponent submitted, *Picasso*, *Nokia* and *Editions Albert René* were all cases concerned with the influence of conceptual differences vis-a-vis visual and aural similarities – the so-called ‘counteraction theory’.

22. For completeness, the passage from *C-16/06 Editions Albert René* cited in *Nokia* reads as follows:

98 Case-law shows that the global assessment of the likelihood of confusion implies that conceptual differences between two signs may counteract aural and visual similarities between them, provided that at least one of those signs has, from the point of view of the relevant public, a clear and specific meaning, so that the public is capable of grasping it immediately (see, to that effect, Case C-361/04 P Ruiz-Picasso and Others v OHIM [2006] ECR I-643, paragraph 20, and Case C-206/04 P Mühlens v OHIM [2006] ECR I-2717, paragraph 35 et seq.).

23. As the Opponent also submitted:

23.1. *Picasso* and *Editions Albert René* are examples where the earlier mark was well-known (PICASSO and OBELIX respectively), and they therefore

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conveyed a clear conceptual meaning to the average consumer which was different to the marks under opposition (PICARO and MOBILIX). On the facts of each of those two cases, the conceptual difference was sufficient to outweigh the visual and aural similarities, giving rise to findings of no likelihood of confusion.

23.2. By contrast, in *Nokia*, the conceptual differences were deemed insufficient to neutralize the visual and aural similarities which had been established. Indeed, the Court considered *'in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established.'* That was an assessment on the facts of that case, where the earlier mark was LIFE and the opposed mark was LIFE BLOG.

24. The Opponent also drew attention to the Decision of Miss Himsworth QC as the Appointed Person in *Peek & Cloppenburg AG v JAXKS Ltd* (O-424-16), submitting the present case was distinct. In that case (where the earlier mark was Jake*s and the opposed mark was JAXKS), the Hearing Officer found that *'The clear conceptual message sent by the opponent's trade mark is, in my view, more than sufficient to neutralise the medium degree of visual and aural similarity between the competing trade marks.'* The appeal, which involved an attack on that finding, was dismissed.

25. Finally, the Opponent referred to a passage in the UK IPO's practice manual at p152 where, having referenced *Sabel* and given the example where there is a very distinctive common idea behind the marks (such as a monkey playing a piano) it is stated that *'Other than in exceptional circumstances such as this, mere conceptual similarity will be insufficient to give rise to a likelihood of confusion.'* The Opponent seeks to invoke this principle in reverse and submitted that: *'Only in exceptional cases should conceptual dissimilarity be sufficient to avoid a likelihood of confusion where visual and aural similarity is found.'* However, it is clear there is no such principle of law – it all depends on the facts of the particular case.

26. In one very real sense, all these cases and examples are distinct since each instance turns on its own facts. Whether, in any particular case, a conceptual difference

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between the marks is or is not sufficient to outweigh visual and aural similarities, giving rise to either a likelihood of confusion or not, depends on the facts of the particular case.

27. In the end, the Opponent's submissions on this Appeal seemed to me to amount to nothing more than simple disagreement with the assessment which the Hearing Officer had made. In spite of all the submissions made by the Opponent, both in writing and orally, I have been unable to detect any error, let alone any error of principle, in the reasoning of the Hearing Officer. Furthermore, I consider the Hearing Officer's reasoning to have been entirely correct.
28. In these circumstances, I dismiss this Appeal and the application to register alaanyi will proceed to registration.

Costs

29. As I mentioned above, before the Hearing Officer made his decision, the Applicant was invited to file information with the UK IPO detailing any costs he had incurred in the Opposition. No information was filed, so the Hearing Officer made no award of costs in favour of the successful Applicant.
30. Since the Appeal has failed, there is no question of the Appellant being awarded any costs. Ordinarily, if the Respondent to this Appeal (i.e. the Applicant) had played an active role in the Appeal, I might have had some information on which to gauge the level of his costs and to make an award of costs in his favour. So far as I am aware, no communication in writing has been received from the Applicant since he filed his counterstatement on 16 July 2016, but without any detriment to his position in the Opposition or on this Appeal. Having said that, I cannot exclude the possibility that the Applicant might have incurred some costs in at least considering the Appeal filed by the Opponent. Accordingly, I will give the Applicant a period of 14 days from the date of this decision to make a reasoned request for an award of costs of this Appeal. Such a request should be directed to the sort of information mentioned at the end of the letter which the UK IPO sent to the Applicant dated 4 January 2017, and is likely to be restricted to time spent considering the few documents filed in this Appeal. In the absence of such a request, I will make no order as to the costs of this Appeal.

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JAMES MELLOR QC

The Appointed Person

23rd January 2018