

O-365-18

SUPPLEMENTARY DECISION

TRADE MARKS ACT 1994

**TRADE MARK APPLICATION NOS. 2537873 AND 2537872
FOR THE TRADE MARKS**

COYOTE UGLY

AND

COYOTE UGLY SALOON

**IN CLASSES 6, 9, 14, 16, 18, 21, 25, 28, 32, 33, 34, 41 AND 43
BY UGLY, INC**

AND

**THE OPPOSITIONS THERETO
UNDER NOS. 100661 AND 101025
BY GROUP LOTTUSS CORPORATION, S.L.**

Background and pleadings

1. These consolidated opposition proceedings have been ongoing for over five years. At various times they have been suspended owing to the ramifications of oppositions by the present applicant to the opponent's earlier European Union Trade Marks, consequential appeals to the European Union Intellectual Property Office's ("EUIPO") Boards of Appeal and then to the General Court of the European Union ("GC"); followed by cancellation applications and further appeals. The proceedings were also suspended for a period of time to allow the parties to pursue settlement, which was not successful. Mediation was not considered by the parties to be an option.

2. The opposed applications were filed by Ugly, Inc ("Ugly"). Application 2537873 is for the mark COYOTE UGLY. It was filed on 2 February 2010 and was published in the *Trade Marks Journal* on 26 March 2010. Application 2537872 is for the mark COYOTE UGLY SALOON, also filed on 2 February 2010. It was published on 6 August 2010. The specifications for both applications are identical and are as follows:

Class 6: Small items of metal hardware; goods of common metal not included in other classes; belt buckles and key rings.

Class 9: Apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; compact discs; digital music; mobile phone accessories and applications; computer software; software downloadable from the Internet; downloadable electronic publications; sunglasses; parts and fittings for all the aforesaid goods.

Class 14: Precious metals and their alloys; goods in precious metals or coated therewith, not included in other classes; jewellery, costume jewellery, precious stones; horological and chronometric instruments, clocks and watches.

Class 16: Paper, cardboard and goods made from these materials; printed matter; book binding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters packaging materials; printers' type; printing blocks; disposable nappies of paper for babies; printed publications; paint boxes for children; cheque book holders; calendars.

Class 18: Leather and imitations of leather; animal skins, hides; trunks and travelling bags; handbags, rucksacks, purses; umbrellas, parasols and walking sticks; whips, harness and saddlery; clothing for animals.

Class 21: Household or kitchen utensils and containers; combs and sponges; brushes; brush-making materials; articles for cleaning purposes; steel wool; articles made of ceramics, glass, porcelain or earthenware which are not included in other classes; electric and non-electric toothbrushes.

Class 25: Clothing, footwear, headgear.

Class 28: Games and playthings; playing cards; gymnastic and sporting articles; decorations for Christmas trees; childrens' toy bicycles.

Class 32: Beers; mineral and aerated waters; non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages; shandy; de-alcoholised drinks, non-alcoholic beers and wines.

Class 33: Alcoholic wines; spirits and liqueurs; alcopops; alcoholic cocktails.

Class 34: Tobacco; smokers' articles; matches; lighters for smokers.

Class 41: Education; providing of training; entertainment; sporting and cultural activities; nightclub services.

Class 43: Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking

and reservation services for restaurants and holiday accommodation; retirement home services; creche services.

3. Group Lottuss Corporation, S.L. (“Group”) opposes the applications under sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”)¹. Group relied upon three earlier EUTMs.

4. I issued a provisional decision² on 3 March 2016, pending the outcome of the various appeals. These have now all been resolved. This supplementary decision is, therefore, final and is subject to appeal.

5. The first of Group’s earlier EUTMs is 2428795, filed on 26 October 2001 and registered on 10 December 2009. This registration can no longer be relied upon for the purposes of this opposition because it has been cancelled in full.

6. The second earlier EUTM is 5883434, for COYOTE UGLY. This was filed on 8 May 2007 and registered on 2 August 2016. This mark is now registered for the following services:

Class 41: *entertainment services, services for discos, night clubs and cultural activities.*

Class 43: *cocktail lounge services, excluding any other services in this class.*

7. The third earlier EUTM is 7077671, also for COYOTE UGLY. This was filed on 18 July 2008 and was registered on 2 January 2014³ for the following goods and services:

Class 14: *Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and*

¹ Grounds originally claimed under sections 5(3) and 3(4) were withdrawn in a letter from Group dated 5 March 2013.

² BL O/118/16.

³ Following the decision of the Second Board of Appeal at the EUIPO, dated 30 September 2016, the mark remains registered for these goods and services.

chronometric instruments and all the items in the alphabetical list of Class 14 of the 9th edition of the Nice Classification.

Class 16: Address plates for addressing machines; address stamps; addressing machines; adhesive bands for stationery or household purposes; adhesive tape dispensers [office requisites]; adhesive tapes for stationery or household purposes; adhesives [glues] for stationery or household purposes; advertisement boards of paper or cardboard; albums; announcement cards [stationery]; aquarelles; architects' models; artists' watercolor [watercolour] saucers; babies' napkin—pants [diaper—pants] of paper and cellulose, disposable; babies' napkins of paper and cellulose, disposable; babies' diapers of paper and cellulose, disposable; bags (conical paper); bags (garbage -) of paper or of plastics; bags [envelopes, pouches] of paper or plastics, for packaging; bags for microwave cooking; balls for ball-point pens; bibs of paper; binders (loose-leaf -); binding strips [bookbinding]; biological samples for use in microscopy [teaching materials]; blackboards; blotters; blueprints; bookbinding apparatus and machines [office equipment]; bookbinding cloth; bookbinding cords; bookbinding material; bookbindings; bookends; booklets; bookmarkers; bottle envelopes of cardboard or paper; bottle wrappers of cardboard or paper; bows (paper -); boxes for pens; boxes of cardboard or paper; bubble packs (plastic -) for wrapping or packaging; cabinets for stationery [office requisites]; canvas for painting; carbon paper; cardboard; cardboard articles; cardboard tubes; cards; cases for stamps [seals]; chalk (marking -); chalk for lithography; chalk holders; chaplets; charcoal pencils; chart pointers, non-electronic; charts; checkbooks [cheque books] (holders for -); cigar bands; clipboards; clips (money -); clips for offices; cloth for bookbinding; coasters of paper; coffee filters (paper -); compasses for drawing; composing frames [printing]; composing sticks; computer printers (inking ribbons for); computer programmes (paper tapes and cards for the recordal of -); copying paper [stationery]; cords for bookbinding; correcting fluids [office requisites]; correcting ink [heliography]; covers [stationery]; covers of paper for flower pots; cream containers of paper; credit card imprinters, non-electric; cutters (paper -) [office requisites]; decalcomanias; diagrams; diaper—pants (babies' —) of paper and cellulose, disposable; diapers (babies' —) of paper and cellulose, disposable; dispensers (adhesive tape -) [office requisites]; document files [stationery]; document

laminators for office use; drawer liners of paper, perfumed or not; drawing boards; drawing instruments; drawing materials; drawing pads; drawing pens; drawing pins; drawing sets; drawing squares; drawing t-squares; duplicators; duplicators (inking sheets for -); easels (painters' -); elastic bands for offices; electrocardiograph paper; electrotypes; embroidery designs [patterns]; engraving plates; envelope sealing machines, for offices; envelopes [stationery]; erasers (writing board -); erasing products; erasing shields; etching needles; fabrics for bookbinding; face towels of paper; figurines [statuettes] of papier mâché; files [office requisites]; film (plastic cling-) extensible, for palletization; filter paper; filtering materials [paper]; filters (paper coffee -); finger-stalls [office requisites]; flags of paper; flower-pot covers of paper; folders [stationery]; folders for papers; fountain pens; franking machines [stamping machines]; french curves; galley racks [printing]; garbage bags of paper or of plastics; geographical maps; globes (terrestrial -); glue for stationery or household purposes; gluten [glue] for stationery or household purposes; graining combs; gummed cloth for stationery purposes; gummed tape [stationery]; gums [adhesives] for stationery or household purposes; hand labelling appliances; handkerchiefs of paper; hand-rests for painters; hat boxes of cardboard; hectographs; histological sections for teaching purposes; holders (passport -); holders for checkbooks [cheque books]; holders for stamps [seals]; house painters' rollers; hygienic paper; imprinters (credit card -), non-electric; index cards [stationery]; indexes; indian inks; ink; ink sticks; ink stones [ink reservoirs]; inking pads; inking ribbons; inking ribbons for computer printers; inking sheets for document reproducing machines; inking sheets for duplicators; inkstands; inkwells; isinglass for stationery or household purposes; jackets for papers; jacquard looms (perforated cards for -); knives (paper -) [office requisites]; labels, not of textile; laminators (document -) for office use; ledgers [books]; letter trays; letters [type]; lithographic stones; loose-leaf binders; luminous paper; manifolds [stationery]; marking chalk; mats for beer glasses; microwave cooking (bags for -); mimeograph apparatus and machines; modelling clay; modelling clays (molds for -) [artists' materials]; modelling clays (moulds for -) [artists' materials]; modelling materials; modelling paste; modelling wax, not for dental purposes; models (architects' -); moisteners [office requisites]; moisteners for gummed surfaces [office requisites]; molds for modelling clays [artists' materials]; money clips; moulds for modelling clays [artists' materials]; mounting photographs

(apparatus for -); musical greeting cards; napkin—pants (babies' —) of paper and cellulose, disposable; napkins of paper (table -); napkins of paper and cellulose (babies' —), disposable; napkins of paper for removing make-up; nibs; nibs of gold; note books; numbering apparatus; numbers [type]; obliterating stamps; office perforators; office requisites, except furniture; packaging material made of starches; packing paper; pads (writing -); pads [stationery]; paint boxes [articles for use in school]; paintbrushes; painters' brushes; painters' easels; palettes for painters; pantographs [drawing instruments]; paper (electro-cardiograph -); paper (waxed -); paper; paper bows; paper clasps; paper for recording machines; paper knives [cutters] [office requisites]; paper ribbons; paper sheets [stationery]; paper shredders for office use; paper tapes and cards for the recordal of computer programmes; paper-clips; paperweights; papier mâché; parchment paper; passport holders; pastels [crayons]; pastes for stationery or household purposes; patterns for dressmaking; patterns for making clothes; pen cases; pen clips; pen wipers; pencil holders; pencil lead holders; pencil leads; pencil sharpeners, electric or non-electric; pencil sharpening machines, electric or non-electric; pencils; penholders; pens [office requisites]; perforated cards for jacquard looms; photo-engravings; photograph stands; photographs; photographs (apparatus for mounting -); pictures; placards of paper or cardboard; place mats of paper; plastic cling film, extensible, for palletization; plastic film for wrapping; plastics for modelling; plates for addressing machines (address -); pointers (chart -), non-electronic; portraits; postcards; printers' blankets, not of textile; printers' reglets; printing blocks; printing sets, portable [office requisites]; printing type; punches [office requisites]; radiograms (paper for -); ribbons (paper -); rollers (house painters' -); rollers for typewriters; rosaries; rubber erasers; rulers (drawing -); rulers (square -); saucers (watercolor [watercolour] -) for artists; school supplies [stationery]; scrapbooks; scrapers [erasers] for offices; sealing compounds for stationery purposes; sealing machines for offices; sealing stamps; sealing wafers; sealing wax; seals [stamps]; self-adhesive tapes for stationery or household purposes; sheets of reclaimed cellulose for wrapping; shields (erasing -); shields [paper seals]; signboards of paper or cardboard; silver paper; slate pencils; spools for inking ribbons; square rulers; squares (drawing -); stamp pads; stamp stands; stamps (address -); stamps [seals]; stamps [seals] (cases for -); stands for pens and pencils; staples for offices; stapling presses [office

requisites]; starch paste [adhesive] for stationery or household purposes; starches (packaging material made of -); stationery; stationery (cabinets for -) [office requisites]; steatite [tailor's chalk]; steel letters; steel pens; stencil cases; stencil plates; stencils; stencils [stationery]; stickers [stationery]; stones (lithographic -); table linen of paper; table napkins of paper; tablecloths of paper; tablemats of paper; tags for index cards; tailors' chalk; teaching materials [except apparatus]; terrestrial globes; thumbtacks; tissues of paper for removing make-up; toilet paper; towels of paper; tracing cloth; tracing needles for drawing purposes; tracing paper; tracing patterns; transfers [decalcomanias]; transparencies [stationery]; trays for sorting and counting money; t-squares (drawing -); tubes (cardboard -); type [numerals and letters]; typewriter keys; typewriter ribbons; typewriters, electric or non-electric; vignetting apparatus; viscose sheets for wrapping; watercolor saucers (artists' -); watercolors [paintings]; watercolour saucers (artists' -); watercolours [paintings]; wax (sealing -); waxed paper; wood pulp board [stationery]; wood pulp paper; wrappers [stationery]; wrapping paper; wristbands for the retention of writing instruments; writing board erasers; writing brushes; writing cases [sets]; writing cases [stationery]; writing chalk; writing instruments; writing materials; writing or drawing books; writing pads; writing paper; writing slates; writing tablets; xuan paper for chinese painting and calligraphy; babies' napkins of paper and cellulose [disposable]; diapers (babies'-) of paper and cellulose [disposable]; napkins of paper and cellulose (babies'-) [disposable].

Class 21: Household or kitchen utensils and containers (not of precious metal or coated therewith); combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes.

Class 25: Clothing, footwear, headgear.

Class 34: Tobacco; smokers' articles; matches.

Class 43: *Hotel reservations; accommodation reservations (temporary —); rental of meeting rooms; rental of tents; rental of transportable buildings; reservations (temporary accommodation —); rental of lighting apparatus other than for theatrical sets or television studios.*

8. Ugly filed counterstatements, denying that Group’s earlier EUTMs were valid and referring to the actions it had filed either to oppose or to cancel them.

9. The applicant filed evidence in support of a request in 2014 that the proceedings be suspended. Neither side filed evidence in respect of the grounds of opposition. Neither side asked to be heard. Only the applicant filed written submissions in lieu of a hearing.

Decision

10. Group has grounds under 5(1), 5(2)(a) and 5(2)(b), but for economy of process, it will suffice to consider the oppositions under the section 5(2)(b) ground. Section 5(2)(b) of the Act states that:

“(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.”

11. The following principles are gleaned from the decisions of the Court of Justice of the European Union (“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.

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

12. In carrying out the comparison, I bear in mind that the list of goods and services covered by EUTM 7077671 is unchanged from my provisional decision, whilst the wording of the services covered by EUTM 5883434 is different, but not substantially so.

13. 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.”

14. ‘Complementary’ was defined by the General Court (“GC”) in *Boston Scientific Ltd v 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...”.

15. 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 includes an assessment of the channels of trade of the respective goods or services.

16. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

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

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (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."

18. In *Gérard Meric v OHIM*, Case T-33/05, the GC stated that:

"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".

19. The earlier marks are not subject to proof of use, which means that they must be considered across the notional breadth of the goods and services relied upon⁴.

20. As before, I will consider Ugly's goods and services class by class.

Class 6: Small items of metal hardware; goods of common metal not included in other classes; belt buckles and key rings.

21. There do not appear to be any goods or services in classes 14, 21, 25, 34, 41 or 43 which can be considered similar to Ugly's class 6 goods. The list of goods in class 16 (earlier EUTM 7077671) is very lengthy. The opponent has not filed any submissions; there are therefore no submissions about where it perceives similarity to lie. I have been through the class 16 list and there is nothing that strikes me as sharing similarity with the class 6 goods on any meaningful level. Therefore, in the absence of submissions from the opponent to the contrary, I find that none of the goods or services of the earlier marks are similar to Ugly's class 6 goods.

⁴ *Roger Maier and Another v ASOS* [2015] EWCA Civ 220, paragraphs 78 and 84.

Class 9: *Apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; compact discs; digital music; mobile phone accessories and applications; computer software; software downloadable from the Internet; downloadable electronic publications; sunglasses; parts and fittings for all the aforesaid goods.*

22. In relation to sunglasses in Ugly's class 9 specification, there is no similarity with Group's goods in classes 14 and 25, as per the judgment of the GC in *Oakley Inc. v OHIM*, Case T-116/06:

“86 The intervener's argument that eyewear, jewellery and watches could be similar or complementary to items of clothing cannot succeed, since, as correctly pointed out by OHIM, the relationship between those goods is too indirect to be regarded as conclusive. It must be borne in mind that the search for a certain aesthetic harmony in clothing is a common feature in the entire fashion and clothing sector and is too general a factor to justify, by itself, a finding that all the goods concerned are complementary and, thus, similar.”

23. In relation to the remainder of Ugly's class 9 goods and the other goods and services of the earlier marks, there does not appear to be any similarity with the goods or services in classes 14, 21, 25, 34, 41 or 43. This leaves the comparison between Ugly's class 9 goods and Group's lengthy list of class 16 goods. The only goods in Group's class 16 list which are similar to any of Ugly's class 9 goods are “computer programmes (paper tapes and cards for the recordal of -); paper tapes and cards for the recordal of computer programmes”. These are blank media for the purpose of recording computer programmes. This is the same as the nature and purpose of Ugly's magnetic data carriers. Users will be shared. The goods are in competition, there being a choice of media on which to record the computer programmes. There is a high degree of similarity between these goods. There is no similarity between Ugly's *computer software and software downloadable from the internet* and Group's *paper tapes and cards for the recordal of computer programmes* because Group's goods are blank media.

Class 14: *Precious metals and their alloys; goods in precious metals or coated therewith, not included in other classes; jewellery, costume jewellery, precious stones; horological and chronometric instruments, clocks and watches.*

24. In its written submissions in lieu of a hearing, Ugly accepts that there is identity with Group's class 14 goods.

Class 16: *Paper, cardboard and goods made from these materials; printed matter; book binding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters packaging materials; printers' type; printing blocks; disposable nappies of paper for babies; printed publications; paint boxes for children; cheque book holders; calendars.*

25. *Paper* is identical to Group's paper and many other of the listed types of papers (for example, waxed paper). *Cardboard* is identical to Group's cardboard. *Goods made from paper* is identical, on the *Meric* principle to (for example) Group's paper coffee filters, boxes of paper, paper bows and paper bags. *Goods made from cardboard* is identical to Group's cardboard articles. *Book binding material* is identical to Group's bookbinding material. *Adhesives for stationery or household purposes* is identical to Group's adhesives [glues] for stationery or household purposes. *Photographs* is identical to Group's photographs. *Stationery* is identical to Group's stationery. On the *Meric* principle, *artists' materials* is identical to, for example, Group's canvas for painting, easels, paint boxes, paintbrushes and palettes. *Paint brushes* are identical to Group's paintbrushes. *Typewriters packaging materials* appears to be a typographical error; there should be a semi-colon after typewriters. *Typewriters* are identical to Group's typewriters, electric or non-electric. *Packaging materials*, on the *Meric* principle, is identical to bags [envelopes, pouches] of paper or plastics, for packaging, and bubble packs (plastic -) for wrapping or packaging. *Printers' type* is identical to Group's printing [type]. *Printing blocks* are identical to Group's printing blocks. *Disposable nappies of paper for babies* are identical to Group's diapers (babies' -) of paper and cellulose [disposable]. *Paint boxes for children* are identical to Group's *paint boxes [articles for use in school]*.

Cheque book holders are identical to Group's holders for checkbooks [cheque books].

26. This leaves *printed matter; printed publications and calendars*. I can see no goods in Group's list of goods in class 16 which are similar, and there are no goods or services in Group's other classes which are similar.

Class 18: *Leather and imitations of leather; animal skins, hides; trunks and travelling bags; handbags, rucksacks, purses; umbrellas, parasols and walking sticks; whips, harness and saddlery; clothing for animals*.

27. In *El Corte Inglés SA v OHIM*, Case T- 443/05, the GC stated:

“42 First, the goods in class 25 and those in class 18 are often made of the same raw material, namely leather or imitation leather. That fact may be taken into account when assessing the similarity between the goods. However, given the wide variety of goods which can be made of leather or imitation leather, that factor alone is not sufficient to establish that the goods are similar (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 55).

43 Second, it is apparent that the distribution channels of some of the goods at issue are identical. However, a distinction must be made according to whether the goods in class 25 are compared to one or other of the groups of goods in class 18 identified by OHIM.

44 On the one hand, as regards the second group of goods in class 18 (leather and imitations of leather, animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery), the Board of Appeal rightly held that the distribution channels were different from those used for the distribution of goods in class 25. The fact that those two categories of goods may be sold in the same commercial establishments, such as department stores or supermarkets, is not particularly significant

since very different kinds of goods may be found in such shops, without consumers automatically believing that they have the same origin (see, to that effect, Case T-8/03 *El Corte Inglés v OHIM – Pucci (EMILIO PUCCI)* [2004] ECR II-4297, paragraph 43).

45 On the other hand, as regards the first group of goods in class 18, namely leather and imitation leather goods not included in other classes such as handbags, purses or wallets, it should be noted that those goods are often sold with goods in class 25 at points of sale in both major retail establishments and more specialised shops. That is a factor which must be taken into account in assessing the similarity of those goods.

46 It must be recalled that the Court has also confirmed the existence of a slight similarity between 'ladies' bags' and 'ladies' shoes' (*SISSI ROSSI*, paragraph 42 above, paragraph 68). That finding must be extended to the relationships between all the goods in class 25 designated by the mark applied for and the leather and imitation leather goods not included in other classes, in class 18, designated by the earlier mark.

47 In light of the foregoing, it must be held that there is a slight similarity between the goods in class 25 and the first group of goods in class 18. Consequently, the Board of Appeal could not conclude that there was no likelihood of confusion on the part of the relevant public solely on the basis of a comparison of the goods concerned.

48 As to whether clothing, footwear and headgear in class 25 are complementary to 'leather and imitations of leather, and goods made of these materials and not included in other classes' in class 18, it must be recalled that, according to the case-law, 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 the production of those goods lies with the same undertaking (*SISSI ROSSI*, paragraph 42 above paragraph 60).

49 Goods such as shoes, clothing, hats or handbags may, in addition to their basic function, have a common aesthetic function by jointly contributing to the external image ('look') of the consumer concerned.

50 The perception of the connections between them must therefore be assessed by taking account of any attempt at coordinating presentation of that look, that is to say coordination of its various components at the design stage or when they are purchased. That coordination may exist in particular between clothing, footwear and headgear in class 25 and the various clothing accessories which complement them such as handbags in class 18. Any such coordination depends on the consumer concerned, the type of activity for which that look is put together (work, sport or leisure in particular), or the marketing strategies of the businesses in the sector. Furthermore, the fact that the goods are often sold in the same specialist sales outlets is likely to facilitate the perception by the relevant consumer of the close connections between them and strengthen the perception that the same undertaking is responsible for the production of those goods.

51 It is clear that some consumers may perceive a close connection between clothing, footwear and headgear in class 25 and certain 'leather and imitations of leather, and goods made of these materials and not included in other classes' in class 18 which are clothing accessories, and that they may therefore be led to believe that the same undertaking is responsible for the production of those goods. Therefore, the goods designated by the mark applied for in class 25 show a degree of similarity with the clothing accessories included in 'leather and imitations of leather, and goods made of these materials and not included in other classes' in class 18 which cannot be classified as slight."

28. On this basis, there is a low to moderate degree of similarity between Ugly's *leather and imitations of leather; handbags and purses* and Group's class 25 goods. There is no similarity between the remainder of Ugly's class 18 goods (*animal skins,*

hides; trunks and travelling bags; rucksacks; umbrellas, parasols and walking sticks; whips, harness and saddlery; clothing for animals). There are no goods or services in Group's other classes which are similar to Ugly's 18 goods which I have listed between the brackets.

Class 21: *Household or kitchen utensils and containers; combs and sponges; brushes; brush-making materials; articles for cleaning purposes; steel wool; articles made of ceramics, glass, porcelain or earthenware which are not included in other classes; electric and non-electric toothbrushes.*

29. Ugly submits that its *electric and non-electric toothbrushes* are not similar to Group's goods. The parties' class 21 specifications are identical in wording apart from Ugly's ceramics and toothbrushes and Groups' unworked or semi-worked glass. Group's specification includes "brushes". However, the average consumer would not consider a toothbrush to fall under the description of a brush. A brush for the teeth is only ever referred to as a toothbrush. The natural meaning of 'brush' is a brush for general household or industrial purposes, not for teeth cleaning. There are no other goods in Group's specifications which are similar to toothbrushes. Articles made of ceramics are covered by household and kitchen containers. With the exception of *electric and non-electric toothbrushes*, which are not similar to Group's goods, all of Ugly's class 21 goods are identical to Group's class 21 goods.

Class 25: *Clothing, footwear, headgear.*

30. Ugly accepts the parties' class 25 goods are identical.

Class 28: *Games and playthings; playing cards; gymnastic and sporting articles; decorations for Christmas trees; children's' toy bicycles.*

31. Group has made no submissions as to where it considers similarity between the parties' goods and services to exist. It is not obvious to me that there is any similarity between the parties' goods and services. I therefore find that there is no similarity.

Class 32: *Beers; mineral and aerated waters; non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages; shandy; de-alcoholised drinks, non-alcoholic beers and wines.*

32. In *Group Lottuss Corp., SL v OHIM*, Case T-161/07, the GC held there to be a low degree of similarity between beer, cocktail bars, entertainment and discotheques on account of the complementarity, target audience and overlapping points of sale. I see no reason why this logic should not extend to the other goods in Ugly's class 32 specification. The goods are similar to a low degree with Group's entertainment and disco services in Class 41, and with Group's cocktail lounge services in class 43.

Class 33: *Alcoholic wines; spirits and liqueurs; alcopops; alcoholic cocktails.*

33. The findings in the preceding paragraph in relation to Ugly's class 32 goods apply equally to its class 33 goods. In addition, it is common to find house wines and house branded cocktails in cocktail lounges. The goods are similar to a low degree with Group's entertainment and disco services in Class 41, and with Group's cocktail lounges in class 43.

Class 34: *Tobacco; smokers' articles; matches; lighters for smokers.*

34. Ugly accepts that the parties' class 34 goods are identical.

Class 41: *Education; providing of training; entertainment; sporting and cultural activities; nightclub services.*

35. *Entertainment, cultural activities and nightclub services* are identical to Group's entertainment services, services for night clubs and cultural activities. There does not appear to be any meaningful similarity within the parameters of the authorities set out above between Ugly's *education; providing of training; and sporting activities*. In the absence of any submissions from the opponent, I find no similarity.

Class 43: *Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation; retirement home services; creche services.*

36. Ugly's *bar services* are identical to Group's cocktail lounge services. Ugly's *booking and reservation services for restaurants and holiday accommodation* is identical to Group's hotel reservations and accommodation reservations (temporary—). Ugly's *temporary accommodation* and *provision of holiday accommodation* are complementary to Group's hotel reservations and accommodation reservations (temporary—). Although the nature differs, the purpose of the reservation service is to facilitate staying in the temporary accommodation or hotel. They are highly complementary and the trade channels will, at least, overlap. The users of the services will be the same. These are highly similar services.

Services for providing food and drink; restaurant and catering services

37. *Services for providing drink*, on the *Meric* principle, covers Group's cocktail lounge services. As well as the purchase of drink, the purchase of food is often a feature of visiting a cocktail lounge (or bar). The channels of trade may coincide and, as above, the food and drink are served contemporaneously so that customers might think the responsibility for those services lies with the same undertaking. However, I bear in mind that the nature and purpose of the services differ; one provides a product in glasses to drink, the other provides a product from a kitchen to eat. Group's *cocktail lounge services* in class 43 and Ugly's *services for providing food and drink; restaurant and catering services* are similar to a low degree.

38. There is a low degree of similarity between Ugly's *services for providing food and drink; restaurant services* and Group's services for night clubs, as per *Tao Asian Bistro*, case BL O/004/11, in which Professor Ruth Annand, sitting as the Appointed Person, considered an appeal against a finding before the registrar that nightclub services in class 41 were dissimilar to Chinese restaurant services in class 43. Professor Annand stated:

“I accept Mr. Edenborough’s contention that the supply of food and drink (albeit non-alcoholic) is important to the provision of the entertainment aspects of nightclub services, for example, dancing, in such a way that customers might think the responsibility for those services lies with the same undertaking. The services might not unusually be provided contemporaneously and through the same supply channels. In my judgment, the type of food or drink served is irrelevant.

39. Since catering services are a feature of private parties and functions which can be held in nightclubs, there is also similarity, albeit low, between services for nightclubs and *catering services*.

40. There are no submissions from the opponent about which of its goods or services it considers to be similar to Ugly’s *retirement home services* and *creche services*. There does not appear to be any meaningful similarity within the parameters of the authorities set out above. These services are not similar to any of Group’s goods or services.

Average consumer

41. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, Kitchin LJ considered the characteristics of the average consumer. Although this was an infringement case, the principles apply equally under section 5(2):

“34 This court considered the characteristics of the average consumer at some length in *Interflora Inc v Marks and Spencer plc* [2015] EWCA Civ 1403,

[2014] FSR 10 from [107] to [130]. The following general points emerge further to those set out above:

i) the average consumer is a hypothetical person or, as he has been called, a legal construct; he is a person who has been created to strike the right balance between the various competing interests including, on the one hand, the need to protect consumers and, on the other hand, the promotion of free trade in an openly competitive market, and also to provide a standard, defined in EU law, which national courts may then apply;

ii) the average consumer is not a statistical test; the national court must exercise its own judgment in accordance with the principle of proportionality and the principles explained by the Court of Justice to determine the perceptions of the average consumer in any given case in the light of all the circumstances; the test provides the court with a perspective from which to assess the particular question it has to decide;

iii) in a case involving ordinary goods and services, the court may be able to put itself in the position of the average consumer without requiring evidence from consumers, still less expert evidence or a consumer survey. In such a case, the judge can make up his or her own mind about the particular issue he or she has to decide in the absence of evidence and using his or her own common sense and experience of the world. A judge may nevertheless decide that it is necessary to have recourse to an expert's opinion or a survey for the purpose of assisting the court to come to a conclusion as to whether there is a likelihood of deception;

iv) the issue of a trade mark's distinctiveness is intimately tied to the scope of the protection to which it is entitled. So, in assessing an allegation of infringement under Article 5(1)(b) of the Directive arising from the use of a similar sign, the court must take into account the distinctiveness of the trade mark, and there will be a greater likelihood

of confusion where the trade mark has a highly distinctive character either per se or as a result of the use which has been made of it. It follows that the court must necessarily have regard to the impact of the accused sign on the proportion of consumers to whom the trade mark is particularly distinctive;

v) if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement.”

42. The goods and services of both parties are, for the most part, consumer goods and services which will be purchased primarily visually, although the potential for an aural purchasing perspective is not ignored. Apart from certain expensive goods in class 14, I consider that no more than a normal degree of attention will be paid to the purchase of the goods and services and, in some cases, less than normal (such as household sponges, matches and paper face towels).

Comparison of marks

43. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of

that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

44. 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.

45. The respective marks are:

Earlier mark	Applications
COYOTE UGLY	COYOTE UGLY COYOTE UGLY SALOON

46. The parties’ respective COYOTE UGLY word-only marks are identical.

47. Although there is some degree of visual, aural and conceptual difference between the earlier mark and Ugly’s COYOTE UGLY SALOON mark because of the additional word SALOON, the marks are visually and aurally highly similar. A saloon is, in the UK, the more expensive and comfortable bar area in a pub (in contrast to the public bar). The concept of Ugly’s mark is therefore a bar called COYOTE UGLY; however, there is still the shared meaning of an ugly coyote. Overall, the marks are similar to a high degree.

Distinctive character of the earlier marks

48. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*⁵ the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

49. There is no evidence of use so I have only inherent distinctiveness to consider. The earlier marks do not describe or allude to any characteristics of the registered goods or services. The marks consist of two words in unusual grammatical juxtaposition (COYOTE UGLY rather than UGLY COYOTE). They have an above average level of distinctive character.

⁵ Case C-342/97.

Likelihood of confusion

50. 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 CJEU said in *Waterford Wedgwood plc v OHIM* Case C-398/07:

“35 It must be noted that the Court of First Instance, in paragraphs 30 to 35 of the judgment under appeal, carried out a detailed assessment of the similarity of the goods in question on the basis of the factors mentioned in paragraph 23 of the judgment in *Canon*. However, it cannot be alleged that the Court of First Instance did not take into account the distinctiveness of the earlier trade mark when carrying out that assessment, since the strong reputation of that trade mark relied on by Waterford Wedgwood can only offset a low degree of similarity of goods for the purpose of assessing the likelihood of confusion, and cannot make up for the total absence of similarity. Since the Court of First Instance found, in paragraph 35 of the judgment under appeal, that the goods in question were not similar, one of the conditions necessary in order to establish a likelihood of confusion was lacking (see, to that effect, *Canon*, paragraph 22) and therefore, the Court of First Instance was right to hold that there was no such likelihood.”

51. There is no likelihood of confusion where there is no similarity of goods and services. Consequently, this opposition fails against:

Class 6: Small items of metal hardware; goods of common metal not included in other classes; belt buckles and key rings.

Class 9: Apparatus for recording, transmission or reproduction of sound or images; recording discs; compact discs; digital music; mobile phone accessories and

applications; computer software; software downloadable from the Internet; downloadable electronic publications; sunglasses; parts and fittings for all the aforesaid goods.

Class 16: Printed matter; printed publications; calendars.

Class 18: Animal skins, hides; trunks and travelling bags; rucksacks; umbrellas, parasols and walking sticks; whips, harness and saddlery; clothing for animals.

Class 21: Electric and non-electric toothbrushes.

Class 28: Games and playthings; playing cards; gymnastic and sporting articles; decorations for Christmas trees; childrens' toy bicycles.

Class 41: Education; providing of training; sporting activities.

Class 43: Retirement home services; creche services.

52. The earlier mark is either identical or highly similar, overall, to both of the applications, which also feature the unusual grammatical inversion of COYOTE UGLY. The earlier mark has an above average degree of distinctive character and covers mostly consumer goods and services. Although the class 14 goods may entail a higher level of purchasing attention, these goods are identical. There is either nothing or little between the marks in terms of difference which would offset both the identity of the class 14 goods and the identity or high similarity of the marks, even with a higher level of attention. Applying the interdependency principle, there is a likelihood of confusion in respect of all of the remaining goods and services, including those of low similarity.

Outcome

53. The opposition fails for the following goods and services:

Class 6: *Small items of metal hardware; goods of common metal not included in other classes; belt buckles and key rings.*

Class 9: *Apparatus for recording, transmission or reproduction of sound or images; recording discs; compact discs; digital music; mobile phone accessories and applications; computer software; software downloadable from the Internet; downloadable electronic publications; sunglasses; parts and fittings for all the aforesaid goods.*

Class 16: *Printed matter; printed publications; calendars.*

Class 18: *Animal skins, hides; trunks and travelling bags; rucksacks; umbrellas, parasols and walking sticks; whips, harness and saddlery; clothing for animals.*

Class 21: *Electric and non-electric toothbrushes.*

Class 28: *Games and playthings; playing cards; gymnastic and sporting articles; decorations for Christmas trees; childrens' toy bicycles.*

Class 41: *Education; providing of training; sporting activities.*

Class 43: *Retirement home services; creche services.*

54. The opposition succeeds against the following goods and services:

Class 9: magnetic data carriers.

Class 14: Precious metals and their alloys; goods in precious metals or coated therewith, not included in other classes; jewellery, costume jewellery, precious stones; horological and chronometric instruments, clocks and watches.

Class 16: Paper, cardboard and goods made from these materials; book binding material; adhesives for stationery or household purposes; photographs; stationery; artists' materials; paint brushes; typewriters; packaging materials; printers' type; printing blocks; disposable nappies of paper for babies; paint boxes for children; cheque book holders.

Class 18: Leather and imitations of leather; handbags, purses.

Class 21: Household or kitchen utensils and containers; combs and sponges; brushes; brush-making materials; articles for cleaning purposes; steel wool; articles made of ceramics, glass, porcelain or earthenware which are not included in other classes.

Class 25: Clothing, footwear, headgear.

Class 32: Beers; mineral and aerated waters; non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages; shandy; de-alcoholised drinks, non-alcoholic beers and wines.

Class 33: Alcoholic wines; spirits and liqueurs; alcopops; alcoholic cocktails.

Class 34: Tobacco; smokers' articles; matches; lighters for smokers.

Class 41: Entertainment; cultural activities; nightclub services.

Class 43: Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation.

Costs

55. Both parties have achieved a roughly equal measure of success, with Group being slightly more successful in terms of the proportion of goods and services which

have been refused. Group did not file evidence or submissions and the only evidence filed by the applicant related to a suspension request. In the circumstances, I award Group the statutory fee for filing one opposition (£200), since the marks were so similar and the specifications of the two applications the same, as a contribution towards its costs.

56. I order Ugly, Inc to pay to Group Lottuss Corporation, S.L. the sum of **£200**. This sum is to be paid within 14 days of the expiry of the appeal period or within 14 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 18th day of June 2018

Judi Pike
For the Registrar,
the Comptroller-General