

O/017/19

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION UK3264928

BY

RICHARD TURNHAM AND LINDA ANN TURNHAM

TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 14

Pinkies

AND OPPOSITION THERETO (NO. 411232)

BY

DIRAMODE

Background and Pleadings

1. RICHARD TURNHAM AND LINDA ANN TURNHAM (the Applicants) applied to register the word trade mark "Pinkies", on the 20 October 2017 for goods in Class14 listed below. It was accepted and published on the 3 November 2017.

Class 14: Alloys of precious metal; Alloys of precious metals; Amulets; Amulets being jewellery; Amulets [jewellery]; Amulets [jewellery, jewelry (Am.)]; Amulets [jewelry]; Ankle bracelets; Articles of jewellery; Articles of jewellery coated with precious metals; 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; Alloys of precious metal; Alloys of precious metals; Amulets; Amulets being jewellery; Amulets[jewellery]; Amulets[jewellery, jewelry (Am.)]; Amulets [jewelry];Ankle bracelets; Articles of jewellery; Articles of jewellery coated with precious metals; 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; Bangle bracelets; Bangles; Bead bracelets; Body costume jewellery; Body jewellery; Bracelet charms; Bracelets; Bracelets [jewellery]; Bracelets [jewellery, jewelry (Am.)]; Bracelets [jewelry]; Bracelets of precious metal; Charms; Charms for jewellery; Charms for jewelry; Charms for key chains; Charms for key rings; Charms [jewellery]; Charms [jewellery, jewelry (Am.)]; Charms [jewellery] of common metals; Charms [jewelry]; Children's jewelry; Custom jewelry; Cut diamonds; Decorative articles [trinkets or jewellery] for personal use; Diamonds; Ear ornaments in the nature of jewellery; Ear studs; Earrings; Earrings of precious metal; Emerald; Emeralds; Enamelled jewellery; Engagement rings; Eternity rings; Fashion jewellery; Finger rings; Friendship bracelets; Friendship rings; Gems; Gemstones; Gemstones, pearls and precious metals, and imitations thereof; Gold; Gold alloys; Gold and its alloys; Gold

base alloys; Gold bracelets; Gold chains; Gold earrings; Gold jewellery; Gold medals; Gold necklaces; Gold plated bracelets; Gold plated earrings; Gold plated rings; Gold rings; Gold-plated earrings; Gold-plated necklaces; Gold-plated rings; Hoop earrings; Identification bracelets [jewelry]; Identification bracelets of precious metal [jewelry]; Items of jewellery; Jewellery; Jewellery articles; Jewellery being articles of precious metals; Jewellery being articles of precious stones; Jewellery boxes; Jewellery charms; Jewellery coated with precious metal alloys; Jewellery coated with precious metals; Jewellery containing gold; Jewellery fashioned from non-precious metals; Jewellery fashioned of precious metals; Jewellery fashioned of semi-precious stones; Jewellery for personal adornment; Jewellery for personal wear; Jewellery in non-precious metals; Jewellery in precious metals; Jewellery in semi-precious metals; Jewellery in the form of beads; Jewellery incorporating diamonds; Jewellery incorporating pearls; Jewellery incorporating precious stones; Jewellery items; Jewellery made from gold; Jewellery made from silver; Jewellery made of non-precious metal; Jewellery made of plated precious metals; Jewellery made of precious metals; Jewellery made of precious stones; Jewellery made of semi-precious materials; Jewellery of precious metals; Jewellery plated with precious metals; Jewellery products; Jewellery stones; Jewellery; Jewelry; Jewelry boxes; Jewelry boxes not of metal; Jewelry boxes, not of metal; Jewelry boxes, not of precious metal; Jewelry charms; Jewelry charms in precious metals or coated therewith; Jewels; Key chains as jewellery [trinkets or fobs]; Key charms coated with precious metals; Key charms of precious metals; Key charms [trinkets or fobs]; Key fobs; Key fobs made of precious metal; Key fobs of precious metals; Key fobs [rings] coated with precious metal; Key rings and key chains; Key rings and key chains, and charms therefor; Key rings of precious metal; Key rings of precious metals; Key rings [split rings with trinket or decorative fob]; Key rings [trinkets or fobs]; Key rings [trinkets or fobs] of precious metal; Metal key fobs; Natural gem stones; Neck chains; Necklace charms; Necklaces; Necklaces [jewellery]; Necklaces [jewellery, jewelry (Am.)]; Necklaces [jewelry]; Necklaces of precious metal; Opal;

Opals; Palladium; Palladium alloys; Palladium and its alloys; Pendants; Pendants [jewellery];Pendants [jewelry]; Peridot; Personal jewellery; Personal ornaments of precious metal; Pierced earrings; Platinum; Platinum alloys; Platinum and its alloys; Platinum jewelry; Platinum [metal];Platinum rings; Precious and semi-precious gems; Precious gemstones; Precious jewellery; Precious jewels; Precious metal alloys; Precious metal alloys [other than for use in dentistry];Precious metals; Precious stones; Presentation boxes for jewellery; Presentation boxes for jewelry; Processed or semi-processed precious metals; Rhodium; Rhodium alloys; Rhodium and its alloys; Ring bands [jewellery];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 of precious metal; Rings [trinket]; Rosaries; Ruby; Sapphire; Sapphires; Semi-precious articles of bijouterie; Semi-precious gemstones; Semi-precious stones; Semi-worked precious metals; Semi-wrought precious stones and their imitations; Signet rings; Silver; Silver alloys; Silver and its alloys; Silver bracelets; Silver earrings; Silver necklaces; Silver rings; Silver-plated bracelets; Silver-plated earrings; Silver-plated necklaces; Silver-plated rings; Sterling silver jewellery; Synthetic precious stones; Synthetic stones [jewellery]; Tiaras; Topaz; Trinkets coated with precious metal; Trinkets [jewellery];Trinkets [jewellery, jewelry (Am.)];Trinkets [jewelry];Wedding bands; Wedding rings; Women's jewelry; Wristlets [jewellery].

2. DIRAMODE (the Opponent) opposes the application under section 5(2)(b) of the Trade Marks Act 1994 (the Act). It relies on its earlier EU trade mark PIMKIE registration number EU003658028 which was filed on the 27 January 2004 and registered on the 26 May 2005. The goods and services relied upon in class 9, 14, and 35 are shown below:

Class 9: Optical goods, spectacles (optics), spectacle frames, sunglasses, sports glasses, glasses cases, lenses for spectacles.

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

Class 35: Advertising; Business management; Business administration; Office functions; Shop window dressing; Business investigation; Rental of advertising space; Office machines and equipment rental; Publicity material rental; Rental of advertising time on communication media; Economic forecasting; Business research; Public relations services; Procurement services for others [purchasing goods and services for other businesses]; News clipping services; Opinion polling; Organization of exhibitions for commercial or advertising purposes; Organisation of trade fairs for commercial or advertising purposes; Import-export agencies; Commercial information agencies; Modelling for advertising or sales promotion; Market studies.

3. For the purposes of this opposition the Opponent is relying on all its goods and services in classes 9, 14 and 35 for which the marks are registered claiming that there is a likelihood of confusion because under section 5(2)(b) the trade marks are similar and are to be registered for goods or services identical or similar to those for which the earlier mark is protected.

4. The Opponent submits that

“as a consequence of the high degree of similarity of the marks and the identity [sic] of the class 14 goods there is a likelihood of confusion on the part of the public”

5. The Applicant filed a defence and counterclaim denying the claims made, submitting that

“Pinkies is not the same as Pimkie”

“Pinkies is completely descriptive and says exactly what part of the body is being referred to”

“Pinkies and Pimkie are 2 entirely different businesses at other ends of the scale. The Pimkie market is largely mainland Europe Not the UK aimed at the more affordable demographic with clothing. Pinkies is aimed at ABC1, this is an affordable luxury hand finished item and the perfect product as a gift, a ring made from precious metals and jewels.”

6. The Applicant is represented by Dean Moore. The Opponent is represented by Wilson Gunn. Only Mr Turnham filed evidence, by way of a witness statement and exhibits dated 15 August 2018. This will be summarised to the extent that it is considered appropriate. Neither party requested a hearing and neither submitted submissions in lieu of a hearing. This decision is therefore taken upon the careful perusal of the papers.

Mr Turnham's Evidence

7. Mr Turnham is the part owner of the trade mark Pinkies with Mrs Linda Turnham. His statement sets out the process of registering their “unique mark PINKIES” with the Assay Office and that they have been awarded a punch mark PNK which they can use as their unique hallmark on their jewellery.

8. He states that the Opponent has no such registration with the Assay Office under the mark PIMKIE.

9. He states that the Pinkies logo is under development and has exhibited at “2.” an example of the style of words they are intending to use for packaging and branding purposes. He states that the initial concept/idea is to create a brand of ring to be placed on the little finger made from precious metals and jewels.

10. Mr Turnham concludes by stating that he/they have invested their finances into “Moulding in the UK and sampling along with Assay registration.”

11. Mr Turnham describes Exhibit 1.2 as Assay Office documentation. The extract is a copy letter from The Assay Office dated April 2018 confirming the hallmark registration of the “Sponsor mark PNK in shape 31”.

12. Mr Turnham confirms that he has attempted to resolve the matter with the Opponent and ordinarily these conversations would be subject to the without privilege rule and not matters that I would be privy to. However, although I am aware that conversations have taken place in the background no specific details have been disclosed to me and neither has the Opponent made any application to exclude this evidence. As it is, this information does not add anything which may be of assistance to me in my deliberations. I will therefore disregard any reference to negotiations between the Applicant and the Opponent.

Preliminary Issues

13. The main thread of the Applicant’s argument is that a hallmarking registration with the Assay office provides its trademark with protection. An Assay registration however has no bearing on trademarks because the purpose of a hallmarking classification is to certify the authenticity and purity of the gems or precious metals used. A trademark is governed by the Act and its main function is to distinguish goods and services of one undertaking from another and acts as a source of goods origin. The references

to hallmarking therefore will play no part in my decision as I must simply consider the opposition based on the criteria under the Act in relation to trademarks.

Decision

14. The opposition is based on section 5(2)(b) of the Act, which states:

“5(2) A trade mark shall not be registered if because-

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

15. An earlier trade mark is defined in section 6 of the Act, which states:

“6. (1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

16. The Applicant makes reference to the Opponent's website which "does not recognise the UK as a customer with no options to choose the UK". It submits that the paid advert on google for Pimkie.com makes no mention of the UK. It displays the advert as follows:

"(Pimkie: Select your country and language and shop online! Discover our Pimkie collection for women. France, Germany, Spain, Italy, Belgium, Poland, Austria)"

In these proceedings, the Opponent is relying upon its EU trade mark registration shown above, which qualifies as an earlier trade mark under section 6 of the Act. The earlier mark was registered in 2005 over five years as at the date the application was published and would ordinarily be subject to proof of use provisions contained in section 6A of the Act. However, the Applicant has not required the Opponent to demonstrate proof of use and therefore it is entitled to rely upon all the goods and services of its registration without having to establish genuine use.

17. 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 greater 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 to mind the earlier mark, 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 will wrongly 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

18. When conducting a goods and services comparison, all relevant factors should be considered as per the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon Kabushiki Kaisha v Metro Goldwyn Mayer inc* Case C-39/97, where the court stated at paragraph 23 of its judgment that:

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

19. I am also guided by the relevant factors for assessing similarity identified by Jacob J in *Treat*, [1996] R.P.C. 281 namely:

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

20. In addition, in *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (*Ch*), Floyd J stated that:

"... 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."

21. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court ("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 fur 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".

22. The Opponent submits that "the goods in class 14 are identical or in the alternative highly similar". The Applicant makes no submissions regarding the identity or otherwise of the goods and services.

23. In my view there is an overlap between the parties' specifications within Class14 where the identical wording is used as per the table below and on the *Merice* principle.

Applicant's Goods	Opponent's Goods
Class 14	Class14
Alloys of precious metal; Alloys of precious metals; Amulets; Amulets being jewellery; Amulets [jewellery]; Amulets [jewellery, jewelry (Am.)]; Amulets [jewelry]; Ankle bracelets; Articles of jewellery; Articles of jewellery	Precious metals and their alloys and goods in precious metals or coated therewith not included in other classes; jewellery, costume jewellery, precious stones;

coated with precious metals; 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; Alloys of precious metal; Alloys of precious metals; Amulets; Amulets being jewellery; Amulets[jewellery]; Amulets[jewellery, jewelry (Am.)]; Amulets [jewelry]; Ankle bracelets; Articles of jewellery; Articles of jewellery coated with precious metals; 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; Bangle bracelets; Bangles; Bead bracelets; Body costume jewellery; Body jewellery; Bracelet charms; Bracelets; Bracelets [jewellery]; Bracelets [jewellery, jewelry (Am.)]; Bracelets [jewelry]; Bracelets of precious metal; Charms; Charms for jewellery; Charms for jewelry; Charms for key chains; Charms for key rings; Charms [jewellery]; Charms [jewellery, jewelry (Am.)]; Charms [jewellery] of common metals; Charms [jewelry]; Children's jewelry; Custom jewelry; Cut diamonds; Decorative articles [trinkets or jewellery] for personal use; Diamonds; Ear ornaments in the nature of jewellery; Ear studs; Earrings; Earrings of precious metal; Emerald; Emeralds; Enamelled jewellery; Engagement rings; Eternity rings; Fashion jewellery; Finger rings; Friendship bracelets; Friendship rings; Gems; Gemstones; Gemstones, pearls and precious metals, and imitations thereof; Gold; Gold alloys; Gold and its alloys; Gold base alloys; Gold bracelets; Gold chains; Gold earrings; Gold jewellery; Gold medals; Gold necklaces; Gold plated bracelets; Gold plated earrings; Gold plated rings; Gold rings; Gold-plated earrings; Gold-plated necklaces; Gold-plated rings; Hoop earrings; Identification bracelets

[jewelry]; Identification bracelets of precious metal [jewelry]; Items of jewellery; Jewellery; Jewellery articles; Jewellery being articles of precious metals; Jewellery being articles of precious stones; Jewellery charms; Jewellery coated with precious metal alloys; Jewellery coated with precious metals; Jewellery containing gold; Jewellery fashioned from non-precious metals; Jewellery fashioned of precious metals; Jewellery fashioned of semi-precious stones; Jewellery for personal adornment; Jewellery for personal wear; Jewellery in non-precious metals; Jewellery in precious metals; Jewellery in semi-precious metals; Jewellery in the form of beads; Jewellery incorporating diamonds; Jewellery incorporating pearls; Jewellery incorporating precious stones; Jewellery items; Jewellery made from gold; Jewellery made from silver; Jewellery made of non-precious metal; Jewellery made of plated precious metals; Jewellery made of precious metals; Jewellery made of precious stones; Jewellery made of semi-precious materials; Jewellery of precious metals; Jewellery plated with precious metals; Jewellery products; Jewellery stones; Jewellery; Jewelry; Jewelry charms; Jewelry charms in precious metals or coated therewith; Jewels; Key chains as jewellery [trinkets or fobs]; Key charms coated with precious metals; Key charms of precious metals; Key charms [trinkets or fobs]; Key fobs; Key fobs made of precious metal; Key fobs of precious metals; Key fobs [rings] coated with precious metal; Key rings and key chains; Key rings and key chains, and charms therefor; Key rings of precious metal; Key rings of precious metals; Key rings [split rings with trinket or decorative fob]; Key rings [trinkets or fobs]; Key rings [trinkets or fobs] of precious metal; Metal key fobs; Natural gem stones; Neck chains; Necklace charms; Necklaces; Necklaces

<p>[jewellery]; Necklaces [jewellery, jewelry (Am.)]; Necklaces [jewelry]; Necklaces of precious metal; Opal; Opals; Palladium; Palladium alloys; Palladium and its alloys; Pendants; Pendants [jewellery]; Pendants [jewelry]; Peridot; Personal jewellery; Personal ornaments of precious metal; Pierced earrings; Platinum; Platinum alloys; Platinum and its alloys; Platinum jewelry; Platinum [metal]; Platinum rings; Precious and semi-precious gems; Precious gemstones; Precious jewellery; Precious jewels; Precious metal alloys; Precious metal alloys [other than for use in dentistry]; Precious metals; Precious stones; Processed or semi-processed precious metals; Rhodium; Rhodium alloys; Rhodium and its alloys; Ring bands [jewellery]; 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 of precious metal; Rings [trinket]; Rosaries; Ruby; Sapphire; Sapphires; Semi-precious articles of bijouterie; Semi-precious gemstones; Semi-precious stones; Semi-worked precious metals; Semi-wrought precious stones and their imitations; Signet rings; Silver; Silver alloys; Silver and its alloys; Silver bracelets; Silver earrings; Silver necklaces; Silver rings; Silver-plated bracelets; Silver-plated earrings; Silver-plated necklaces; Silver-plated rings; Sterling silver jewellery; Synthetic precious stones; Synthetic stones [jewellery]; Tiaras; Topaz; Trinkets coated with precious metal; Trinkets [jewellery]; Trinkets [jewellery, jewelry (Am.)]; Trinkets [jewelry]; Wedding bands; Wedding rings; Women's jewelry; Wristlets [jewellery].</p>	
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24. All the Applicant's goods above are jewellery, precious metals and their alloys thereof and precious stones and therefore are covered by the Opponent's specification

in Class14 in its entirety. “*Personal ornaments*” and “*tiaras*” are covered by the earlier “*jewellery*”. “*Key chains, key rings, key charms and key fobs, trinkets, and gold medals*” are also all covered by the Opponent’s goods in “*precious metals*” or coated therewith and are therefore also identical.

25. The contested “*Jewellery boxes; Jewelry boxes; Jewelry boxes not of metal; Jewelry boxes, not of metal; Jewelry boxes, not of precious metal; Presentation boxes for jewellery; Presentation boxes for jewelry;*” are similar to the Opponent’s “*jewellery*” as they are either presentation boxes or jewellery containers to hold items of jewellery. They are complementary in so far as items of jewellery are often displayed in presentation boxes or kept in ornamental boxes they share the same producers, relevant public and distribution channels and therefore they are similar to a medium degree even though their nature and method of use are different.

Average Consumer

26. When considering the opposing marks, I must consider first of all who the average consumer is for the goods and the purchasing process. The average consumer is deemed reasonably informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion the average consumer’s level of attention is likely to vary according to the category of goods in question.¹

27. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited, [2014] EWHC 439 (Ch)*, Birss J described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively

¹ Lloyd Schuhfabrik Meyer, case c- 342/97.

by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

28. In the present case the goods found to be identical or similar are directed at the general public at large who is likely to choose the goods from a shop or online through self-selection or from recommendations. Consumers purchasing jewellery such as engagements rings are likely to exercise a greater degree of thought in the purchasing process as they will be considered luxury, high end often bespoke pieces of some value. These purchases are not spontaneous or impulsive but are careful infrequent purchases. For this class of jewellery therefore the average consumer will be highly observant and aware. This is in complete contrast to costume jewellery which are of low value, and where the purchasing process is more casual. Despite this however even jewellery at the lower end of the market would attract a reasonable level of care, as a number of factors would prevail in the purchasing process namely the style of the piece and whether it complements an outfit or is given as a gift. On this basis therefore, I would consider that the average consumer would take a reasonable to high level of care in the purchasing process which would be primarily visual although I do not discount aural considerations.

Comparison of the Trade Marks

29. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by them, 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.”

30. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create.

31. The respective trade marks are as follows

Applicant's mark	Opponent's Existing mark
Pinkies	PIMKIE

32. In comparing the marks there is no difference between the variation in the casing because a word trade mark registration protects the word itself irrespective of the font capitalisation or otherwise. Therefore, a trade mark in capital letters covers notional use in lower case and vice versa.²

33. Lengthy submissions were submitted from the Applicant on the comparison of the marks with the Opponent merely stating that the marks were visually and aurally highly similar. Whilst I do not propose to reproduce these submissions in their entirety here, I have taken them into consideration in reaching my decision.

² *Bentley Motors Limited v Bentley 1962 Limited* BL O/159/17

34. The Applicant's mark consists of a seven letter plural word "Pinkies". There are no other elements to contribute to the overall impression which is contained in the word itself.

35. The Opponent's mark consists of a six letter word in conventional font. Again, there are no other elements to contribute to the overall impression, which is contained in the word itself.

Visual Comparison

36. Both marks are word only marks of similar length. They coincide in five of their letters namely the sequence "P-I-* K-I-E-*" which present identically in both marks. The marks only differ in their third letter and ending namely an "M" in the earlier mark and "N" in the Opponent's mark and the Applicant's mark ending in an "S". Both N and M are visually similar. The obvious visual difference between the letters in the marks are reduced by the remaining common elements. I take note that as a general rule, beginnings of words tend to have more visual and aural impact than the ends³ and although this does not apply in all cases the relevant public is likely to consider marks as wholes and not dissect each element. I therefore consider the marks to share a good degree of visual similarity.

Aural comparison

37. The Applicant's mark is likely to be pronounced PINK-EYS because it is unlikely that the UK average consumer would pronounce the N separately. Whereas the Opponent's mark is likely to be pronounced PIM-KEY. In both cases the beginning of the words will be pronounced in an identical way despite the difference in the third letter and phonetically there will be little difference between the pronunciation of the

³ *El Corte Inglés, SA v OHIM, Cases T-183/02*

letter “M” and “N”. I note that the end of the Applicant’s word will be pronounced with the addition of the “S” however overall there is sufficient similarity in the articulation of the words when taken as a whole, for me to determine that that marks share a good degree of aural similarity.

Conceptual Comparison

38. The Applicant submits that conceptually *“Pinkies’ is a plural noun meaning little fingers, and is commonly recognised throughout the UK when dealing with jewellery in this case as the term Pinkie ring” meaning ring on the little finger*”. In contrast it submits that the Opponent’s mark has no reference within any online dictionary and does not exist as a well-known word. For a conceptual message to be relevant it must be immediately grasped by the average consumer⁴. The average UK consumer is likely to understand the meaning of the word Pinkies as the plural form of little finger but there may be a proportion who merely associate it with the colour pink. For rings specifically, the link may be made with pinkie rings however for other types of jewellery I do not consider that the average consumer would necessarily or immediately recognise this meaning. The Opponent is silent on the conceptual meaning of Pimkie and therefore I would consider it to be an invented word. Therefore, I do not consider there to be any conceptual similarity between the marks whether the Applicant’s mark is perceived as little fingers or by reference to the colour pink.

Distinctiveness of the earlier mark

39. The degree of distinctiveness of the earlier mark is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark the greater the likelihood of confusion. The Opponent has not filed any evidence regarding use of its mark. I must therefore consider the matter on inherent characteristics.

⁴ *Ruiz Picasso v OHIM* [2006] e.c.r.I-643; [2006] E.T.M.R.29

40. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

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

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

41. The earlier mark consists of one word “PIMKIE” with no apparent allusive association with the goods or services covered by the registration. Registered marks possess varying degrees of inherent distinctiveness on a scale of low to high. Some are descriptive or allusive of a characteristic of the goods or services whilst others have no such qualities if they are made up or invented. Since the word will be considered to be invented it has a high degree of inherent distinctiveness.

Likelihood of Confusion

42. When considering whether there is a likelihood of confusion between the two marks I must consider whether there is direct confusion, where one mark is mistaken for the other or whether there is indirect confusion where the similarities between the marks lead the consumer to believe that the respective goods or services originate from the same or related source.

43. In determining whether there is a likelihood of confusion there are a number of factors to bear in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods or services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the Opponent's trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must consider that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

44. I have identified the average consumer to be a member of the general public who would primarily select the goods via visual means but with aural means not being discounted. I have found that a reasonable to high degree of attention will be paid in the purchasing process. I have found that the earlier mark has a high degree of inherent distinctive character. I am also mindful of the decision in *The Picasso Estate v OHIM*, Case C-361/04 P, where the Court of Justice of the European Union 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.”

45. Despite the good visual and aural similarities between the marks I cannot ignore the conceptual differences, which are too great to be missed by the average consumer paying at least a reasonable degree of attention. Weighing up all the relevant factors I find that the conceptual meaning of ‘Pinkies’ will counteract the aural and visual similarities between them. I have considered the possibility of confusion through consumers misreading or mishearing one mark for the other however I consider this to be unlikely. I do not consider therefore that consumers will mistake one mark for the other and therefore conclude that there is no likelihood of confusion.

Outcome

46. The opposition under section 5(2)(b) fails accordingly; subject to any successful appeal the application may proceed to registration.

Costs

47. As the Applicants have been successful they are entitled to a contribution toward their costs. Awards of costs in proceedings are based upon the scale as set out in Tribunal Practice Notice 2 of 2016 below:

Preparing a statement and	£200
considering the other side’s statement	

Preparing evidence £500

Total £700

48. I order DIRAMODE to pay RICHARD TURNHAM AND LINDA ANN TURNHAM the sum of £700 as a contribution towards their costs. The sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 11th day of January 2019

Leisa Davies

For the Registrar