

O/018/19

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003224969 BY
THE MANTIQUE LTD
TO REGISTER:

The Mantique

AS A TRADE MARK IN CLASS 35

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 409955 BY
DK COMPANY A/S

BACKGROUND AND PLEADINGS

1. On 13 April 2017, The Mantique Ltd (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 5 May 2017. The applicant seeks to register the mark for the following services:

Class 35 Retail services in relation to clothing; Online retail store services in relation to clothing.

2. The application was opposed by DK Company A/S (“the opponent”). The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the earlier International Registration (no. 1298554) designating the EU for the mark **MATINIQUE**. The opponent relies on all goods and services for which the earlier mark is registered, namely:

Class 3 Bleaching preparations and other substances for laundry use; cleaning, polishing and stain removing preparations; soaps; perfumery, essential oils, cosmetics.

Class 9 Glasses; sunglasses; eyeglass cases; spectacle frames; cases for sunglasses; straps for sunglasses.

Class 14 Jewellery, precious stones; watches and chronometric instruments.

Class 18 Leather and imitations of leather; animal skins, hides; bags, handbags, suitcase, rucksacks, trunks and traveling bags, umbrellas, parasols, walking sticks, wallets, purses, shopping bags.

Class 25 Clothing, footwear, headgear.

Class 35 Retail and wholesale services relating to clothing, footwear, headgear, bleaching preparations and other substances for laundry use, cleaning, polishing and stain removing preparations, soaps, perfumery, essential

oils, cosmetics, glasses, sunglasses, cases for sunglasses and glasses, straps for sunglasses, jewellery, precious stones, watches, leather and imitations of leather, animal skins, hides, bags, handbags, suitcase, rucksacks, trunks and traveling bags, umbrellas, parasols, walking sticks, wallets, purses, shopping bags.

3. The opponent's mark was registered on 30 December 2015 and was granted protection in the EU on 4 November 2016.

4. In its Notice of Opposition, the opponent initially also sought to rely on EU Trade Mark registration no. 2723609. However, on 17 August 2018, the opponent withdrew its reliance on this earlier mark and confirmed that it wished to proceed with its opposition in reliance on its earlier International Registration as described above only.

5. The opponent argues that the respective goods are identical or similar and that the marks are similar.

6. The applicant filed a counterstatement denying the claims made.

7. The opponent is represented by Osborne Clarke LLP. The applicant is represented by Court and Tribunal Solutions. Neither party filed evidence. No hearing was requested and only the opponent filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

PRELIMINARY ISSUES

8. In a cover letter which accompanied its Counterstatement, the applicant made various submissions about why its mark should be considered different to the opponent's mark. The majority of these submissions relate to differences between the marks as they appear on the parties' websites, the colour schemes of the websites, the fonts used on the websites, the tag lines of the businesses, use on social media platforms, different website designers, different brand messaging and the different products offered by the parties.

9. In *O2 Holdings Limited, O2 (UK) Limited v Hutchinson 3G UK Limited* (Case C-533/06), the Court of Justice of the European Union (“CJEU”) stated at paragraph 66 of its judgment that when assessing likelihood of confusion in the context of registering a new trade mark, it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered. Any difference between the goods and services actually provided by the parties or their trading styles are irrelevant unless those differences are apparent from the applied-for and earlier marks, and their respective specifications. The differences in the way in which the parties use their marks in practice is not relevant to the decision I must make.

DECISION

10. Section 5(2)(b) of the Act reads as follows:

“5(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. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

(a) a registered trade mark, international trade mark (UK) or 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.”

12. The trade mark upon which the opponent relies qualifies as an earlier trade mark under the above provisions. As the earlier trade mark had not completed its registration process more than 5 years before the publication date of the application in issue in these proceedings, it is not subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely upon all of the goods and services it has identified.

Section 5(2)(b) – case law

13. 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

14. The highest degree of similarity with the applicant's services lies in the opponent's class 35 services. I have, therefore, reproduced only these services below:

Opponent's goods and services	Applicant's services
<p><u>Class 35</u> Retail and wholesale services relating to clothing, footwear, headgear, bleaching preparations and other substances for laundry use, cleaning, polishing and stain removing preparations, soaps, perfumery, essential oils, cosmetics, glasses, sunglasses, cases for sunglasses and glasses, straps for sunglasses, jewellery, precious stones, watches, leather and imitations of leather, animal skins, hides, bags, handbags, suitcase, rucksacks, trunks and traveling bags, umbrellas, parasols, walking sticks, wallets, purses, shopping bags.</p>	<p><u>Class 35</u> Retail services in relation to clothing; Online retail store services in relation to clothing.</p>

15. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, 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 for 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.”

16. “Retail services in relation to clothing” in the applicant’s specification is plainly identical to “Retail and wholesale services relating to clothing...” in the opponent’s specification. “Online retail store services in relation to clothing” in the applicant’s specification falls within the broader category of “retail and wholesale services relating to clothing...” in the opponent’s specification. Such services can, therefore, be considered identical on the principle outlined in *Meric*.

The average consumer and the nature of the purchasing act

17. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ services. I must then determine the manner in which the services are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

18. I have no submissions from either party on the average consumer or the purchasing process for the services in issue. The average consumer for the services will be a member of the general public. Purchases are likely to be fairly frequent and will vary in cost depending on the nature of the goods being purchased through the services. The level of attention paid by the average consumer is likely to be average.

19. The services are likely to be purchased from retail outlets or their online equivalent. The purchasing process for the services is likely to be dominated by visual considerations, as the average consumer is likely to select the services at issue following inspection of the premises' frontage on the high street, on websites and in advertisements (such as flyers, posters or online adverts). However, given that word-of-mouth recommendations may also play a part, I do not discount that there will be an aural component to the selection of the services.

Comparison of trade marks

20. 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 the trade 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.”

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

22. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
MATINIQUE	The Mantique

23. With the exception of the points referred to at paragraph 8 above, I have no substantive submissions from the applicant on the similarity of the marks. In its written submissions in lieu, the opponent stated:

“11. Visually, the Application and the Opponent's Trade Mark are extremely similar. The dominant element of the Applicant's mark referred to at paragraph 10 above differs only one character to the Opponent's Trade Mark. Further, the first two letters, and last three letters of the marks are identical. Applying the principles set out at paragraph 8(b) above. the matter must be judged through the eyes of the average consumer of retail services in relation to clothing; 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. Based on the high degree of visual similarity between the marks, the average consumer is unlikely to recall the minor differences between the marks. In particular, as the difference in the order of characters falls in the middle of the marks, the average consumer is even less likely to recall the differences between the Application and the Opponent's Trade Mark. It follows that there is a high likelihood of confusion between the marks.

12. Phonetically, the Applicant's Trade Mark and the Opponent's Trade Marks are also extremely similar. A further consequence of the similarity of the comparison of the marks set out in paragraph 12 is high degree of phonetic similarity between the marks. In particular, the marks correspond aurally in their beginnings and the final syllable of the Applicant's Trade Marks and the Opponent's Trade Mark is shared, i.e. 'IQUE'. It is submitted that the effect of the beginning of the end of the marks sharing phonetic similarities is that the overall degree of phonetic similarity is enhanced.

13. Conceptually, neither the dominant element of the Application nor the Opponent's Trade Mark have any particular meaning, and as such are not conceptually distinctive. Nonetheless, it is submitted that any conceptual meaning that the average consumer would attribute to the Application would be similar to that of the Opponent's Trade Mark as an inevitable consequence of their high degree of visual and phonetic similarity."

24. The opponent's mark consists of the 9-letter invented word MATINIQUE, presented in upper case. There are no other elements to contribute to the overall impression, which is contained in the word itself. The applicant's mark consists of the ordinary dictionary word THE and the 8-letter invented word MANTIQUE, presented in lower case with the first letter of each word capitalised. I consider that the overall impression of the mark is as a unit (as opposed to two separate and unrelated words). As the word THE is commonly used to refer to a particular thing or person, it will be seen as referring to the word MANTIQUE. The word MANTIQUE is therefore likely to play a greater role in the overall impression, with the word THE playing a lesser role.

25. Visually, the parties' marks differ in that the applicant's mark consists of two words and the opponent's mark consists of only one word. However, as noted above, the word THE in the applicant's mark will play a lesser role in the overall impression. The second word in the applicant's mark and the sole word in the opponent's mark both start with the letters MA and end with the letters IQUE. The point of difference lies in the middle letters – TIN in the opponent's mark and NT in the applicant's mark. However, two of the middle letters – T and N – are common to both marks (albeit in a different order), which reduces the visual difference. As notional and fair use covers use in any standard typeface, differences created by the use of upper and lower case in the marks will not be relevant. I consider the marks to be visually highly similar.

26. Aurally, the opponent's mark will be pronounced MAT-IN-EEK. The word THE in the applicant's mark will be given its ordinary English pronunciation. The word MANTIQUE in the applicant's mark will be pronounced MAN-TEEK. I consider the marks to be aurally similar to at least a medium degree.

27. In the applicant's cover letter which accompanied its Counterstatement, the applicant's representative stated that "the word Mantique is a deliberate use of the inherent meaning describing the goods and services offered by our client – a play on 'man' and 'boutique'. In my view, it is unlikely that this meaning will be recognised by the average consumer. Conceptually, the average consumer is likely to view both marks as made-up words with no recognisable meaning. The marks are, therefore, conceptually neutral.

Distinctive character of the earlier trade mark

28. 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-2779, 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)."

29. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

30. As the opponent has not filed any evidence to show that its mark has enhanced its distinctiveness through use, I have only the inherent position to consider. I have no submissions from the parties about the distinctiveness of the earlier mark.

31. I must make an assessment of the inherent distinctiveness of the earlier mark as a whole. The earlier mark is an invented word with no recognisable meaning. It is neither descriptive nor allusive of the goods and services for which it is registered. In my view, the earlier mark has a high degree of inherent distinctive character.

Likelihood of confusion

32. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather it is a global assessment where a number of factors need to be borne 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 and 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 services and the nature of the purchasing process. In doing so, I must be alive to the fact 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.

33. I have found the marks to be visually highly similar and aurally similar to at least a medium degree. Neither mark has a recognisable meaning and they are, therefore,

conceptually neutral. I have found the earlier mark to have a high degree of inherent distinctive character. I have identified the average consumer to be a member of the general public who will select the services primarily by visual means (although I do not discount an aural component). I have concluded that an average degree of attention will be paid during the purchasing process.

34. Bearing all of the factors in mind, as well as the principle of imperfect recollection, I am satisfied that the visual similarities between the marks will lead to the consumer mistaking one for the other. As neither mark has a recognisable meaning, there is no conceptual hook to assist the consumer in differentiating between them. This is particularly the case given that the applicant's services are identical to those of the opponent. I consider that there is a likelihood of direct confusion.

CONCLUSION

35. The opposition is successful.

COSTS

36. The opponent has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of £600 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the applicant's statement	£200
Official Fee	£100
Preparing written submissions in lieu of a hearing	£300
TOTAL	£600

37. I therefore order The Mantique Ltd to pay DK Company A/S the sum of £600. This sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

Dated this 11th day of January 2019

S WILSON

For the Registrar