

O-230-19

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATIONS NOS. 3250944 AND 3250940
BY DHAMANI JEWELS FZC
TO REGISTER**

DHAMANI

AND

DHAMANI
1969

**AS TRADE MARKS IN CLASSES 14 AND 35
AND CONSOLIDATED OPPOSITIONS THERETO
(UNDER NOS. 410935 AND 410936)
BY DAMIANI INTERNATIONAL SA**

Background and pleadings

1. The details of the marks the subject of these proceedings are:

- i. Application 3250944 for the mark (hereafter “the 944 mark”):

DHAMANI

- ii. Application 3250940 for the mark (hereafter “the 940 mark”):

DHAMANI
1969

2. Both applications were filed on 17 August 2017 by Dhamani Jewels FZC (“the applicant”) in respect of the following identical list of goods and services:

Class 14: *Precious metals and their alloys; jewellery made from precious metals or coated therewith; jewellery; precious stones; jewellery made with precious metals and precious stones; horological and chronometric instruments.*

Class 35: *Advertising; business management; business administration; office functions; retail, online retail and mail order retail services relating to jewellery, precious stones, jewellery made with precious metals and precious stones, and horological and chronometric instruments.*

3. Both applications were accepted and published on 1 September 2017.

4. On 1 December 2017, Damiani International SA (“the opponent”) filed two notices of oppositions against the applications. The grounds of oppositions are under Section 5(2)(b) of the Trade Mark Act 1994 (“the Act”) with the opponent relying, amongst others¹, on the two earlier marks detailed below:

¹ In its notices of opposition, the opponent relied on five earlier marks. However, in its skeleton arguments it invited me to determine the oppositions based only upon the two marks set out below.

i. EUTM no. 5454103 (hereafter “the 103 earlier mark”) for the word mark DAMIANI, which was filed on 9 November 2006 and registered on 7 December 2015. The mark is registered in respect of, inter alia, *precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments* (in class 14)². The opponent relies on those goods for the purpose of opposing both applications in relation to the applicant’s goods in class 14 and the retail services specified in class 35.

ii. EUTM no. 8537821 (hereafter “the 821 earlier mark”) for the mark



, which has a priority date of 8 May 2009, was filed on 9 September 2009 and registered on 1 December 2015. The mark is registered in respect of, inter alia, *precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments* (in class 14) and *advertising; business management; business administration; office functions* (in class 35). The opponent relies on these goods and services for the purpose of opposing all of the goods of the class 14 and the *advertising; business management; business administration; office functions* services of the class 35 specification in relation to both applications.

5. Both oppositions were defended by the applicant who filed counterstatements denying the claims made. The oppositions were consolidated. The applicant is represented by D Young & Co LLP. The opponent is represented by Withers & Rogers LLP. Both parties filed evidence. A hearing took place before me on 6 February 2019 at which the applicant was represented by Chris Hall of Counsel, instructed by D Young & Co LLP and the opponent was represented by Marisa Broughton.

² In its notice of opposition Form TM7 the opponent incorrectly listed the goods relied upon and included the goods a different mark, namely trade mark registration number IR 842672 which was originally relied upon by the opponent and covers the following goods in class 14: *jewellery, namely belt buckles of precious metals, bracelets of precious metals, brooches, cuff-links, diamonds, earrings, necklaces, pearls, rings; precious metal and their alloys, bracelets, charms, earrings in precious metal or coated therewith, precious stones; horological (timepieces) and chronometric instruments including timepieces, wrist, watches, clocks and parts therefor*. However, at the hearing Mr Hall proceeded on the basis of the correct specification, so nothing turns on this point.

THE OPPONENT'S EVIDENCE

6. As neither of the two earlier rights relied upon by the opponent are subject to proof of use, the only evidence that is of relevance is that filed by the opponent for the purpose of demonstrating enhanced distinctive character of the word mark, i.e. the 103 mark. At the hearing Mr Hall accepted that the name DAMIANI has acquired enhanced distinctive character with a small but high-net-worth segment of the public, amongst whom it is known as an exclusive retailer of high-priced luxury jewellery. However, he also argued that the extent of the reputation and enhanced distinctiveness of DAMIANI is restricted to (and cannot go beyond) the luxury market.

THE APPLICANT'S EVIDENCE

7. The applicant's evidence comes from Mr Amit Dhamani, the applicant's CEO and Managing Director. I have read all the evidence, but for the purpose of this decision it is sufficient to record the key points of Mr Dhamani's witness statement which are:

- The name DHAMANI, which is now used as part of the applicant's corporate name and in relation to the applicant's goods and services, is a family name which has been used continuously by generations of the applicant's family members since as early as 1922;
- The applicant's family started business activities in India in 1969 and has since expanded operations internationally including Thailand (1990), UAE (1996), Hong Kong and Lebanon (2003), Bahrain (2008) and Oman (2014). The applicant headquarters are located in UAE where it operates 16 diamond jewellery stores and 4 wholesale offices;
- The applicant is a globally recognised leading manufacturer and retailer of jewellery. The applied for marks have been filed in order to continue the applicant's brand expansion globally. The applicant has registered various DHAMANI marks in UAE, Bahrain and Oman (Exhibit AD3);
- The applicant has a strong reputation in the name DHAMANI. The growth of the DHAMANI brand is the subject of various business studies amongst

esteemed educational institutes like Harvard Business School and is being taught to business students at the campus (AD12);

- The applicant has received numerous awards in relation to its jewellery business. Exhibit AD4 includes copies of awards received, all of which appear to be from authorities based in Dubai or Abu Dhabi;
- In 2017-2018 the applicant promoted the brand DHAMANI in the UK through sponsorship and advertisement at events attended and endorsed by royals, celebrities and prominent UK consumers. Only one event is mentioned, namely the Beaufort Festival of Polo Charity Event (Exhibit AD5);
- In 2016-2018 the applicant spent nearly £500,000 in the UK and over \$1.6 million outside the UK for branding, promotion and marketing;
- Exhibits AD13 and AD15 consists of copies of letters of endorsement from seven UK individuals and companies (AD13) and from 14 trade associations, jewellery manufacturers and vendors (of which only two are registered in the UK); each letter contains the same statement that the person signing it (or the company/association on behalf of which the letter is signed) has known (and worked with) the DHAMANI group of companies for a number of years and supports their expansion into the UK market and that the applicant is a reputed jewellery brand;
- In the ten-year period between 2007 and 2017, DHAMANI branded goods have been sold to more than 700 UK consumers and 2,000 EU consumer for a total value of over \$12 million. The applicant's turnover in the period 2015-2017 range from \$107 to \$124 million;
- The parties have peacefully coexisted in the market place globally for long time. They have operated in premises just 20 meters apart for over 10 years in the Dubai Mall, one of the world's largest shopping malls. Notwithstanding the Dubai Mall receive millions of visitors every year from across the world -over 92 million in 2015 - the applicant is not aware of any instance of confusion and has not received any complaint of infringement by the opponent;
- The applicant has received a number of favourable decisions in opposition proceedings brought by the opponent against applications for trade marks consisting of or containing the name DHAMANI filed in the Bahrain Office (Exhibit AD17).

DECISION

8. Section 5(2)(b) of the Act reads:

“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.”

Section 5(2)(b) - case-law

9. 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:

- (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 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

10. In the judgment of the Court of Justice of the European Union (CJEU) in *Canon*, Case C-39/97, the Court stated at paragraph 23:

“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”.

11. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- 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 services;
- 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.

12. I also bear in mind the decision in *Boston Scientific Ltd v OHIM*, Case T-325/06, where the General Court (GC) stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

13. In *Gérard Meric v OHIM*, Case T- 133/05, the GC stated:

“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”.

14. In *Oakley, Inc v OHIM*, Case T-116/06 at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

15. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b),

it is necessary to ascertain whether there is a likelihood of confusion with the opponent's earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are '*similar*' to goods are not clear cut."

16. However, on the basis of the European courts' judgments in *Sanco SA v OHIM*³, and *Assembled Investments (Proprietary) Ltd v. OHIM*⁴, upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd*⁵, Mr Hobbs concluded that:

i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

³ Case C-411/13P

⁴ Case T-105/05, at paragraphs [30] to [35] of the judgment

⁵ Case C-398/07P

17. Both applications cover the same specification. For ease of reference, the contested specification is set out below:

Class 14: *Precious metals and their alloys; jewellery made from precious metals or coated therewith; jewellery; precious stones; jewellery made with precious metals and precious stones; horological and chronometric instruments.*

Class 35: *Advertising; business management; business administration; office functions; retail, online retail and mail order retail services relating to jewellery, precious stones, jewellery made with precious metals and precious stones, and horological and chronometric instruments.*

18. I shall begin my comparison by comparing the contested specification with the goods of the earlier 103 mark, and then continue the comparison on the basis of the earlier 821 mark, where it provides the better case.

Comparison on the basis of the earlier the 103 mark

Applicant's goods and services	Opponent's goods
<p>Class 14: <i>Precious metals and their alloys; jewellery made from precious metals or coated therewith; jewellery; precious stones; jewellery made with precious metals and precious stones; horological and chronometric instruments.</i></p> <p>Class 35: <i>[...] retail, online retail and mail order retail services relating to jewellery, precious stones, jewellery made with precious metals and precious stones, and horological and chronometric instruments.</i></p>	<p>Class 14: <i>Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments.</i></p>

Class 14: Mr Hall accepted, on behalf of the applicant, that all the goods in class 14 covered by the contested mark are identical to the goods in class 14 covered by the 103 mark.

Class 35 (Retail services): In relation to the opposed retail services in class 35, Mr Hall submitted⁶ that they are similar to a low degree to the opponent's goods in class 14. However, in my view, there is sufficient complementarity between the applicant's *retail, online retail and mail order retail services relating to jewellery, precious stones, jewellery made with precious metals and precious stones, and horological and chronometric instruments* and the opponent's *jewellery, precious stones and horological and chronometric instruments* to give rise, on the principles outlined in *Oakley*, to a medium degree of similarity.

Comparison on the basis of the earlier the 821 mark

Applicant's services	Opponent's services
Class 35: <i>Advertising; business management; business administration; office functions; [...]</i>	Class 35: <i>Advertising; business management; business administration; office functions</i>

Class 35 (Advertising; business management; business administration; office functions): The competing services are self-evidently identical.

Average consumer

19. 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 and services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*. 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:

⁶ § 24 of skeleton arguments

“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.”

20. The average consumer of the parties’ goods in class 14 is the public at large and for goods such as *precious metals* and *precious stones*, a business user involved in the production of, for example, jewellery.

21. As regards the level of attention of the relevant public, Mr Hall’s submitted that the purchaser of the parties’ goods will deploy “an extremely high degree of attentiveness” because the goods sold by DAMIANI are intended for an exclusive consumer base and DHAMANI is used as a luxury brand. In this regard, it must be noted that the opponent’s earlier marks are entitled to protection against a likelihood of confusion with the applicant’s marks based on the ‘notional’ use of the earlier marks (for the goods on which the opponent relies for the purposes of this opposition) across all segments of the market⁷. This means that the quality, price or details of the parties’ goods and the particular circumstances in which they may currently be marketed, is not relevant for the purposes of the analysis I am required to conduct.

22. *Jewellery and horological and chronometric instruments*: such goods may include expensive items where the purchasing attention may be elevated, but they may equally include inexpensive goods made from (say) plastic or “non-precious” metal. The level of attention for *jewellery* and *horological and chronometric instruments* will consequently vary from low to high.

23. *Precious metals* and *precious stones*: there is a spectrum in these goods and they include articles marketed at the lower end of the range; nonetheless, given their

⁷ *Compass Publishing BV v Compass Logistics Ltd*

nature, I find that for *precious metals, precious stones and jewellery made with precious metals and precious stones*, the level of attention is likely to vary from above average to high (depending on the price).

24. In relation to the selection of the retail services at issue, the average consumer is likely to be mindful of a range of considerations such as the breadth of goods/brands stocked, delivery times/costs and, in relation to a bricks and mortar outlet, proximity to their home, opening times, etc. - all of which suggests an average degree of attention will be paid to the selection of such services. Further, the services could be sought to commission (say) the design of a bespoke piece of jewellery in which case the process is likely to involve a not insignificant financial expenditure, and the average consumer is likely to pay a high degree of attention.

25. Finally, in relation to the competing *advertising; business management; business administration; office functions* the average consumer of the services is the professional public, whose level of attention will be above average for such services, given their central importance to business success and the more considered approach to purchasing generally taken by businesses.

26. As regards the way the goods (in class 14) are likely to be selected, aesthetic considerations and size/fit are likely to be important to purchasers. Therefore, the goods are likely to be selected primarily by eye, and the marks will be encountered in that context through branding and labelling of the goods in shops, online and/or in printed promotional materials. However, I do not discount aural considerations, in the form, for example of word of mouth recommendations. Consumers are most likely to select the services at issue visually, having considered websites, advertisements and signage on the high street but may also, for example, be the subject of word-of-mouth recommendations.


Comparison of marks



27. 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.”

28. It would be wrong, therefore, artificially to dissect the 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. The respective marks are shown below:

Applied for 944 mark	Opponent's marks
	(103 earlier mark) DAMIANI
	(821 earlier mark) 

Applied for 940 mark	Opponent's marks
	(103 earlier mark) DAMIANI
	(821 earlier mark) 

29. I shall first compare the applicant's 944 mark to the opponent's mark 103 mark. The earlier 103 mark consists of the word DAMIANI in block capitals. It is self-evidently the dominant and distinctive element. As regards the applied for 944 mark, it consists of the word DHAMANI; although the word is presented in a slightly stylised upper-case script, it is the word itself that clearly plays the most important and distinctive role in the mark.

30. Visually, both marks are of the same length, have the letter 'D' at the start and the letters 'ANI' at the end and coincide in the sequence 'AM', which constitutes the third and fourth letter in the applied for mark and in the second and third letter in the opponent's mark. The only visual differences between the sign comes from the second letter 'H' in the applied for mark and the fourth letter 'I' in the opponent's mark. Whilst I observe the specific script of the applied for mark, notional and fair use of the earlier word mark in block capitals will embrace presentation of that mark in other scripts, including a script comparable to that used in the applied for mark⁸, so it does not constitute a distinguishing feature or, if it does, it is not particularly significant. In this connection, Mr Hall accepted on behalf of the applicant that there is a degree of similarity between the mark but contended that the similarity is no more than average⁹. In my view, since the signs coincided in six out of seven letters in total (and given what I have just said about the script), from a visual point of view they are similar to a high degree.

31. As regards the comparison of the marks from a phonetic point of view, Mr Hall submitted, on behalf of the applicant that DHAMANI and DAMIANI will be pronounced by the average consumer very differently. He stated:

“DHAMANI, a name of Indian origin, would be pronounced 'Dar-mar-nee', whereas DAMIANI, an Italian name, would most likely be pronounced 'Dam-ee-a-nee' (with the 'a' as in 'cat' or as in 'ah'). The differences in syllables and aural emphasis is apparent.”

⁸ BL-O-420-18, *YANGO TRADE MARK and Case T-364/04 Sadas SA v. OHIM*.

⁹ § 23 (d) of skeleton arguments

32. Ms Broughton, on behalf of the opponent, stated that the 103 mark will be pronounced as ‘dam-e-an-i’ whereas the 944 mark will be pronounced as ‘dam-an-i’. According to Ms Broughton *“the marks are phonetically identical save for the additional second syllable in the 103 mark which is a short vowel sound that is lost in the middle of the opponent’s mark”*. Whilst DHAMANI and DAMIANI are names of Indian and Italian origin respectively, the UK relevant consumer is likely to pronounce them in accordance with the pronunciation rules of the English language. Given the characteristics of the marks at issue, in particular the common characteristic of the initial ‘D’ and the sequences ‘AM’ and ‘ANI’, their pronunciations coincide as regards the sound of the letters D-AM-ANI. Whilst the presence of the letter H between the letters D and A in the applied for mark is likely to result in a broader initial DAAA - sound in the applied for mark, compared with a shorter DA -sound in the opponent’s mark, this do not create a significant difference in the pronunciation of the beginning of the marks. Further, whilst the second syllable in the opponent’s mark has the vowel ‘I’ between the letters ‘M’ and ‘A’, this is likely to be pronounced as a short vowel. I find that the marks may well both be pronounced as three similar syllables – for example as DAM–YAR– NEE as against DARM-AR-NEE, though I acknowledge that the applied for mark could also be pronounced as DA – MEE – AR – NEE (in which case it would be four syllables). Either way, the marks are aurally highly similar.

33. Conceptually, both parties agree that the competing marks are likely to be perceived as family names however, the applicant claims that they are conceptually identical, whereas the opponent argues that they are likely to be recognised as different names from different continents. I agree with the parties that DHAMANI and DAMIANI are both likely to give the impression of being family names of foreign origin. In a recent decision¹⁰, Ms Emma Himsworth QC, sitting as the Appointed Person, allowed an appeal against a decision of the Hearing Officer that the names SANDRA and SANDRO were conceptually different. She stated:

“27. The EU courts have accepted that names may have a concept. Therefore to the extent that the Hearing Officer proceeded with an analysis of conceptual

¹⁰ BL-O-276-18 SANDRA TRADE MARK

similarity on the basis that the marks in issue were names he was in my view correct to do so.

28. It is also clear that the mere fact that the marks the subject of the comparison can be grouped under a common generic term of 'names' does not automatically lead to a finding of conceptual similarity. This is well illustrated by the examples given in Part C, Section 2, Chapter 4 Comparison of Signs of the Guidelines for Examination of European Trade Marks issued by the EUIPO on 1 October 2017 where the names FRANK and MIKE are identified as being names which would not lead to a finding of conceptual similarity because the public is not likely to make a conceptual link between the two words; whereas the contrary is the case where the names in issue are FRANK and FRANKIE one being a different version of the other such that the public is likely to make a conceptual link.

29. Moreover, the fact that a mark is a name does automatically mean that the mark has a clear and specific semantic content for the relevant public (see for example C-361/04 P *Claude Ruiz-Picasso and Others v EUIPO* EU:C:2006:25).

30. It is therefore necessary to make an assessment of conceptual similarity between names on the basis of each individual case.

31. In making his assessment of conceptual similarity in the present case the Hearing Officer found that the marks were conceptually different. He did so upon the basis that one was to be regarded as 'a common British name' and the other 'a foreign sounding name' (paragraph [35] of his Decision).

32. For the reasons set out above, in so far as the appeal against the Hearing Officer's finding that the marks were conceptually dissimilar was pursued on the basis that because all the marks in issue were names it automatically followed that the marks must be found to be conceptually similar I reject it.

33. However, for the reasons set out below, I do not consider that the reasoning of the Hearing Officer provided a proper basis for the finding that the marks were conceptually different i.e. that each of the marks has a clear concept that could be immediately grasped by the average consumer and that the concepts are different.

34. Firstly, as noted above the Applicant had admitted with no qualification that the Opponent's marks would be 'understood as the male first name SANDRO' i.e. the marks in issue were names. There was no suggestion that there was any distinction to be drawn on the basis that the Applicant's mark was a 'British name' and the Opponent's a 'foreign sounding name'; secondly the Hearing Officer's statement that he was 'happy to accept' the Opponent's contention 'that its mark will be seen by the average UK consumer as a name' (paragraph [37] of the Decision); and thirdly the absence of any suggestion that either name is the name of a well-known person such as to have an established meaning of the type envisaged in Case C-361/04 P Picasso (above) . In fact, it seems to me that members of the public could regard SANDRA and SANDRO as different versions of the same name or names derived from the same root such that it would have been open to the Hearing Officer to find that the marks were conceptually similar.

35. In the circumstances, I consider that the Hearing Officer was wrong to find that the marks were conceptually dissimilar; in my view at its lowest the marks are conceptually neutral."

34. In my view, similar considerations would equally apply in principle in relation to family names. In the case at issue, the overall impression of the marks will be of foreign-sounding family names, but, I do not accept the submission that was made to me on behalf of the applicant that the average consumer will immediately and necessarily grasp the geographical origin of the names as Indian and Italian respectively. In my view the marks may be considered conceptually neutral.

35. I shall now compare the applicant's 944 mark to the opponent's 821 mark. Visually there are more differences. Notwithstanding the overall impression of the marks will

still be dominated by the words DHAMANI and DAMIANI respectively, there are additional elements that must be considered, namely, (a) the presentation of the applied for mark in a slight stylised script (b) the fact that the mark is in white letters against a black rectangular, neither of which I believe creates a significant visual difference and (c) the presence of the small words 'VIA MONTE NAPOLEONE 10' in the opponent's mark. In relation to the latter, the opponent submits that the words 'VIA MONTE NAPOLEONE 10' are likely to be perceived as a street address and such are non-distinctive; conversely, the applicant states that they are distinctive. In my view, the opponent's argument that the UK average consumer will associate the words 'VIA MONTE NAPOLEONE 10' with a street address cannot be accepted. That said, I do not think that the UK consumer is likely to attach any specific meaning (or concept) to the words; more likely than not, he/she will simply perceive them as words of foreign origin and, given that they occupy a secondary position in relation to the other word element, i.e. DAMIANI, will attach to them less weight in the overall impression of the mark. Visually, the marks are similar to a medium degree. Aurally, it is unlikely that a significant part of the relevant public, who cannot be assumed to be familiar with the Italian language, will pronounce the words 'VIA MONTE NAPOLEONE 10' having regard to their secondary position and to the fact that due to their length they are the more difficult to pronounce. The marks are aurally similar to a high degree. Conceptually, the words 'VIA MONTE NAPOLEONE 10' are devoid of any conceptual meaning for a significant part of the UK public, and for similar reasons to those outlined above the conceptual position is neutral. However, even for those who perceive the words as an address, given their descriptive nature and the dominant and distinctive role of the word DAMIANI, then for similar reasons to those outlined above the conceptual position is neutral.

36. Moving onto the applicant's mark 940 mark, I shall compare this to the opponent's 103 and 821 marks. Much of what I have already said in paragraphs 29-34 above, applies to this mark also. As regards the element '1969', it has a secondary position in the applied-for mark and, I agree with the opponent, it is likely to be perceived as being a year by the relevant public and have limited impact of the overall impression of the mark. For that reason, it is also unlikely to be pronounced by the relevant

public¹¹. Accordingly, comparing the applied for 940 mark with the opponent's 103 mark, the marks are visually and aurally similar to a high degree; conceptually the position regarding the names is neutral; although the element '1969' introduces the concept of a year, it is a non-distinctive concept in this mark which does not make the marks conceptually different. Lastly, comparing the applicant's 940 mark with the opponent's 821 mark, similarly to what I found in relation to the 944 mark, at paragraph 35, the marks are also visually similar to a medium degree, aurally similar to a high degree and conceptually neutral.

Distinctive character of the earlier mark

37. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated at paragraphs 22 and 23 that:

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

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

¹¹ *OHIM v Osra SA* [2012] EUECJ T-133/09 (28 June 2012)

commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

38. As I have mentioned, Mr Hall accepted that the word 103 mark has acquired enhanced distinctive character with a small but high-net-worth segment of the public, amongst whom it is known as an exclusive retailer of high-priced luxury jewellery.

39. As regards the other mark, i.e. 821 mark, to the extent that it is relied upon by the opponent in relation to the registered *advertising; business management; business administration; office functions* services in class 35, there is no evidence of use in relation to these services and the opponent has not claimed that the mark has acquired enhanced distinctiveness through reputation in the context of these services. The mark is inherently distinctive since it does not describe the services in any way. Through it does not have the highest degree of distinctive character because it is not a wholly invented word, it is not a common English word and has, in my view, an above average degree of distinctive character.

Likelihood of confusion

40. In determining whether there is a likelihood of confusion, 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 marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has retained in his mind.

41. There are two types of relevant confusion to consider: direct confusion (where one mark is mistaken for the other) and indirect confusion (where the respective similarities lead the consumer to believe that the respective goods and services come from the same or a related trade source). In *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 Mr Iain Purvis Q.C. sitting as the Appointed Person noted that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

42. Before going on to consider the likelihood of confusion, I should mention that during the course of the hearing Mr Hall referred to an authority (although was unable to recall from memory what the authority was) for the proposition that where an earlier mark has been put to use by the owner, the Tribunal cannot ignore the use made when considering the likelihood of confusion. Following the hearing, on 13 February 2019, I received written submissions from Mr Hall. He referred to Section 11-080 of the 16th edition of Kerly and to the decision in *Premier Brands UK Ltd. v Typhoon Europe Ltd & Anor* [2000] ETMR 1071 for the proposition that “*where the earlier mark has been used, the way in which the proprietor actually uses the mark can be said, prima facie, to be the paradigm case of its use in a normal and fair manner*”. He also argued that use of the earlier mark can reduce the likelihood of confusion (rather than increasing it) and referred to the following paragraph in *Kurt Geiger, O-075-13*, where Ian Purvis, QC sitting as the Appointed Person stated:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that the more distinctive it is, either by inherent nature or by use, the greater the likelihood on confusion. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

43. Finally, he reiterated the submission made at the hearing that (a) the reputation of DAMIANI as a luxury brand reduces the likelihood of confusion in the hypothetical case that DHAMANI were to be used in the context of high street or costume jewellery, and that (b) there is no risk of confusion if DHAMANI is used in the context of luxury jewellery because the average consumer of luxury jewellery is extremely discerning.

44. Ms Broughton responded in written submissions dated 28 February 2019, observing that (a) there is no basis for permitting the filing of Mr Hall’s submissions after the hearing, in the absence of directions issued to this effect (which I did not give at the hearing); (b) the opponent’s earlier marks are not subject to proof of use and the Tribunal is required to consider notional and fair use of those marks across the breadth of the specification of goods and services; (c) the Tribunal cannot interpret notional and fair use of the earlier mark strictly as use in the manner demonstrated by the evidence; to do so is contrary to the concept of notional and fair use and fails to take into account the possible future uses of the mark - for example, the opponent could introduce a premium or mid-market range of products (d) the words “paradigm case of notional and fair use” mean “a typical example” not the sole example; (e) the passage in *Kurt Geiger* O-075-13 is not pertinent, the point being made was that the likelihood of confusion will be reduced if the distinctive component of the earlier mark is not found in the later mark; (f) there is no basis for the applicant’s claim that there is no likelihood of confusion where the earlier mark has enhanced distinctive character and sells luxury goods.

45. Mr Hall responded in further submissions, which, I have read but I do not intend to summarise here.

46. Whilst, ideally, parties should be prepared to support all of their legal arguments at the hearing, Ms Broughton had the opportunity to respond to the matters raised by

Mr Hall and I am satisfied that having the benefit of both parties' arguments on the point will assist the case. Hence, I am minded to allow the further material into the proceedings.

47. Having regards to the legal arguments advanced by Mr Hall, Ms Broughton is clearly right in saying that the authorities referred to by Mr Hall do not provide support for his contention that I should assess the likelihood of confusion between the marks taking into account the use made of the earlier marks. *Premier Brands UK Ltd. v Typhoon Europe Ltd & Anor* was an infringement case and the passage to which Mr Hall referred to must be seen in the specific context of that case, where an issue arose as to whether the registered proprietor of the infringed sign could rely upon the way in which it used the mark. The judge observed that under Section 10(2) of the Act “*the allegedly infringing sign has to be compared with [the mark of the proprietor] used in a normal and fair manner in relation to goods for which it is registered*”. It is in that setting that the comments about the relevance of the use of the mark “in a normal and fair manner” must be read. The concept of use of the mark “in a normal and fair manner” for the purpose of assessing the likelihood of confusion in infringement proceedings (Section 10 of the Act) and the concept of “notional and fair use” of the mark for the purpose of assessing the likelihood of confusion in opposition proceedings (Section 5(2)(b) of the Act) are different concepts, both serving the purpose of broadening the protection of a registered mark, not restricting it. In particular, the case law on “notional and fair use” in opposition cases tells me that the prospective analysis of the likelihood of confusion between two marks must take into account the objective circumstances in which the marks may be present on the market and cannot be dependent on the commercial intentions of proprietors of the opposing marks which may vary from time to time¹². Hence, I must consider notional and fair use of the competing marks across all segments of the markets for the goods/services for which they are registered or sought to be registered. Further, there is no authority which support Mr Hall's claim that confusion is less likely because the earlier mark has a reputation as a luxury brand. Whilst it is true that “*that any increase in the likelihood of confusion as a result of enhanced distinctiveness through reputation inevitably*

¹² Case C-533/06, *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*. See also the judgment of the CJEU in *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C- C-171/06P at paragraph 59

*diminishes as one moves away from the core products in relation to which the mark has been used*¹³, this is only relevant to the extent that “*confusion [is] less likely in relation to goods/services for which the mark has not been used*”¹⁴ and does not involve considerations relating to the segment of the markets in which the proprietor has traded, i.e. luxury market.

48. Having clarified the approach, I shall now move on to consider the likelihood of confusion.

49. With regard to both the 944 and the 940 marks, it is accepted that the goods in Class 14 are identical to the goods in Class 14 for which the opponent’s mark 103 is registered. The relevant public is the general public, or a business user. The purchase is mainly visual. The goods will be selected with a degree of attention varying from low (in case of cheap *jewellery* and *horological and chronometric instruments* made of non-precious material) to above average to high (in the case of *precious metals, precious stones and items of jewellery made with precious metals and precious stones*). In this connection, the correct approach is to assess the likelihood of confusion based on the perception of the part of the public displaying the lowest degree of attentiveness for those goods. The earlier mark has acquired enhanced distinctiveness through use and it is distinctive to a high degree. The marks are likely to be perceived as foreign-sounding family names; however, the average consumer is unlikely to immediately and necessarily grasp the geographical origin of the names. The marks have a high degree of visual and aural similarity; the conceptual position is neutral. In those circumstances, I find that even where an above average degree of attention is displayed, the similarity between the marks combined with the absence of a conceptual hook, will result in the average consumer imperfectly recollecting the earlier mark and directly confusing it with the later marks, where identical goods are involved. The position is even worse for the applicant where the degree of attention is lower, i.e. average and low. Consequently, I find that there is a likelihood of direct confusion in relation to all of the applied-for goods in class 14.

¹³ BL-O-016-10, *ROJA DOVE TRADE MARK*, paragraph 18

¹⁴ BL-O-016-10, *ROJA DOVE TRADE MARK*, paragraph 20

50. As regards the applied-for retail services in class 35, I found that the services are similar to a medium degree to the goods in class 14 for which I have concluded that there is a likelihood of confusion. Here the closeness between the goods for which DAMIANI has a reputation and the contested retail services, is such that the reputation is still significant in terms of likelihood of confusion. In relation to these services, my conclusion is that the similarity of the marks and the closeness of the services is likely to result in the consumer being indirectly confused into thinking that the applied-for retail services are a brand extension of the opponent's jewellery-related goods. That could in particular be the case if the contested goods covered by the trade mark DHAMANI were sold by means of DHAMANI retail services thereby creating a likelihood of confusion in consumers' minds.

51. In relation to the contested *advertising; business management; business administration; office functions* services in class 35, there is no evidence (and it was not argued) that the opponent has a reputation for those services. However, it has a registered mark, i.e. 821, upon which it relies, which covers identical services. Even if the opponent cannot rely on the mark having acquired a high degree of distinctiveness through use, the earlier mark is inherently distinctive to an above average degree. The contested marks, i.e. both the 944 and the 940 marks, and the earlier 821 mark are visually similar to medium degree, aurally similar to a high degree and conceptually neutral. The services will be selected visually by a business user with an above average degree of attention. In those circumstances, I find that, taking into account all of the relevant factors, including the identity of the services and the similarity of the marks, there is a likelihood of direct confusion, arising from the average consumer misremembering the name DAMIANI and confusing it with the DHAMANI marks. There is a likelihood of indirect confusion.

Claim to coexistence outside the UK, marketing targeting the UK and decision of the Bahrain IPO

52. In reaching a conclusion I have not overlooked the applicant's evidence about the coexistence of the competing marks in the Dubai Mall and the marketing targeting the UK.

53. In *Aceites del Sur-Coosur SA v OHIM*, Case C-498/07 P, the CJEU found that:

“82. First, although the possibility cannot be ruled out that the coexistence of two marks on a particular market might, together with other elements, contribute to diminishing the likelihood of confusion between those marks on the part of the relevant public, certain conditions must be met. Thus, as the Advocate General suggests at points 28 and 29 of his Opinion, the absence of a likelihood of confusion may, in particular, be inferred from the ‘peaceful’ nature of the coexistence of the marks at issue on the market concerned.

83. It is apparent from the file, however, that in this case the coexistence of the La Española and Carbonell marks has by no means been ‘peaceful’ and the matter of the similarity of those marks has been at issue between the two undertakings concerned before the national courts for a number of years.”

54. In *Budejovicky Budvar NP v Anheuser-Busch Inc*, Case C-482/09, the CJEU held that:

“74. In that context, it follows from the foregoing that Article 4(1)(a) of Directive 89/104 must be interpreted as meaning that a later registered trade mark is liable to be declared invalid where it is identical with an earlier trade mark, where the goods for which the trade mark was registered are identical with those for which the earlier trade mark is protected and where the use of the later trade mark has or is liable to have an adverse effect on the essential function of the trade mark which is to guarantee to consumers the origin of the goods.

75. In the present case, it is to be noted that the use by Budvar of the Budweiser trade mark in the United Kingdom neither has nor is liable to have an adverse effect on the essential function of the Budweiser trade mark owned by Anheuser-Busch.

76. In that regard, it should be stressed that the circumstances which gave rise to the dispute in the main proceedings are exceptional.

77. First, the referring court states that Anheuser-Busch and Budvar have each been marketing their beers in the United Kingdom under the word sign 'Budweiser' or under a trade mark including that sign for almost 30 years prior to the registration of the marks concerned.

78. Second, Anheuser-Busch and Budvar were authorised to register jointly and concurrently their Budweiser trade marks following a judgment delivered by the Court of Appeal (England & Wales) (Civil Division) in February 2000.

79. Third, the order for reference also states that, while Anheuser-Busch submitted an application for registration of the word 'Budweiser' as a trade mark in the United Kingdom earlier than Budvar, both of those companies have from the beginning used their Budweiser trade marks in good faith.

80. Fourth, as was stated in paragraph 10 of this judgment, the referring court found that, although the names are identical, United Kingdom consumers are well aware of the difference between the beers of Budvar and those of Anheuser-Busch, since their tastes, prices and get-ups have always been different.

81. Fifth, it follows from the coexistence of those two trade marks on the United Kingdom market that, even though the trade marks were identical, the beers of Anheuser-Busch and Budvar were clearly identifiable as being produced by different companies.

82. Consequently, as correctly stated by the Commission in its written observations, Article 4(1)(a) of Directive 89/104 must be interpreted as meaning that, in circumstances such as those of the main proceedings, a long period of honest concurrent use of two identical trade marks designating identical products neither has nor is liable to have an adverse effect on the essential function of the trade mark which is to guarantee to consumers the origin of the goods or services."

55. The applicant cannot satisfy the onus of establishing honest concurrent use for the following reasons: (i) the evidence relates to use outside the UK and does not establish

that the UK relevant public has been educated to distinguish between the opposing marks¹⁵; (ii) the evidence relating to the marketing targeting the UK and that concerning the sale figures falls short of showing a long history of peaceful coexistence in the UK market; (iii) the matter of the similarity of the opposing marks has been at issue between the parties in other jurisdictions and imply that coexistence is unlikely to be peaceful. Finally, to the extent that the evidence concerning the alleged coexistence of the marks in the Dubai Hall (and globally) is relied upon for its persuasive value, it is not sufficient, in my view, to argue convincingly that the UK relevant public is unlikely to be confused.

56. As regards Mr Hall's argument that in the luxury jewellery market there are other companies using similar brands, i.e. Tiffany and Taffin, Carolina Bucci, Gucci and Buccellati, nothing is said about the alleged coexistence (peaceful or otherwise) of those brands in the UK market¹⁶. In any event, the point is not pertinent, as it relates to different names and each case must be considered on its own.

57. Finally, the applicant relies on copies of notifications of two decisions from the Bahrain IPO (AD17). These show that, on 28 March 2018, the Bahrain IPO rejected two oppositions brought by the opponent against the registration of two DHAMANI marks due to "*non-similarity between the marks*". The point can be dealt with very briefly. It is not clear from this evidence what test the Bahrain IPO applied to determine the matter, but, in any event these decisions are not binding upon me.

CONCLUSION

58. The oppositions succeed in their entirety and subject to appeal the applications will be refused.

¹⁵ See Case T-460/07 Nokia v OHIM – Medion, paragraph 68 and T-31/03 Grupo Sada v OHIM – Sadia, paragraph 86

¹⁶ In this connection Mr Hall refers to pages from the opponent's evidence showing, amongst others, some of those brands

COSTS

59. As the opponent has been successful it is entitled to a contribution towards its costs. Awards of costs are governed by Tribunal Practice Notice (TPN) 2/2016. Using that TPN as a guide, I award costs to the opponent on the following basis:

Official fees (x2):	£200
Preparing a statement and considering the other side's statement (X2):	£400
Filing evidence and considering the other side evidence:	£800
Attending a hearing:	£800
Considering submissions filed after the hearing and preparing a response:	£400
Total:	£2,600

60. I order Dhamani Jewels FZC to pay Damiani International SA the sum of £ 2,600 as a contribution towards its costs. This 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 02nd day of May 2019

Teresa Perks
For the Registrar
The Comptroller General