

O/1125/22

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3668847
BY CARLENE BARTHAM**

TO REGISTER:



AS A TRADE MARK IN CLASS 18

AND

**IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 428449 BY
LINHOPE INTERNATIONAL LIMITED**

BACKGROUND AND PLEADINGS

1. Carlene Barthram (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the United Kingdom on 14 July 2021. The application was accepted and published on 24 September 2021 in respect of the following goods:

Class 18

Sports bags; Sport bags; Sports [Bags for -]; Bags for sports; Bags for sports clothing; All-purpose sports bags; All purpose sports bags; All purpose sport bags; Bags; Kit bags; Casual bags; Waist bags; Music bags; Belt bags and hip bags; Sports packs; Work bags; Game bags; Athletics bags; Waterproof bags.

2. On 22 November 2021, the application was opposed by Linhope International Limited (“the opponent”). The opposition is based on sections 5(2)(a) and (b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”) and concerns all the goods in the application.

3. Under sections 5(2) and 5(3), it is relying on the following UK Trade Marks (“UKTMs”):

Mark	Goods relied on
UKTM No. 3068906 (a series of 3 marks) HOUSE OF CB houseofcb house of cb Filing date: 16 August 2014 Registration date: 2 January 2015	<u>Class 18</u> <i>Handbags, handbags made of leather, Ladies Handbags.</i>

Mark	Goods relied on
<p>UKTM No. 3068910 (a series of 3 marks)</p> <p>CB BODY</p> <p>cb body</p> <p>CBBODY</p> <p>Filing date: 16 August 2014</p> <p>Registration date: 21 November 2014</p>	<p><u>Class 3</u></p> <p><i>Body creams, shower gel, skin moisturiser.</i></p>
<p>UKTM No. 3068908 (a series of 3 marks)</p> <p>CB SWIM</p> <p>cbswim</p> <p>cb swim</p> <p>Filing date: 16 August 2014</p> <p>Registration date: 21 November 2014</p>	<p><u>Class 24</u></p> <p><i>Beach towels; Towels [textile] for the beach.</i></p> <p><u>Class 25</u></p> <p><i>Swimwear; Swimming trunks; Swimming caps; Swimming suits; Beachwear; Beach clothing; Beach clothes; Flip-flops.</i></p>

3. Under section 5(2) the opponent claims that the marks are similar and that some or all of the contested goods are similar to goods covered by the opponent's marks, which enjoy an enhanced degree of distinctive character. Consequently, it claims that there exists a likelihood of confusion on the part of the relevant public in the UK, which includes a likelihood of association.

4. Under section 5(3) the opponent claims that its earlier marks have acquired a reputation for the goods relied on and that use of the application in relation to the

contested goods would give rise to a link between the goods and the earlier marks in the mind of the average consumer. It claims that use of the contested marks would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character and/or reputation of the earlier mark.

5. Under section 5(4)(a) the opponent claims to have used the following signs throughout the UK for the following goods and services:

Sign	Use since	Goods and services relied on
HOUSE OF CB houseofcb house of cb	2014	<i>Women's clothing, footwear, hand bags, back packs, sports holdalls, accessories and the online sale and promotion of such goods.</i>
CB BODY cb body CBBODY	2015	<i>Body creams, shower gels, skin moisturiser, on line sales and promotion on line.</i>
CB SWIM cbswim cb swim	2015	<i>Towels for the beach, swimwear, swimming suits, beach clothing and flip flops, on line sale and promotion of such goods.</i>

6. The opponent claims to have acquired goodwill under the signs and that normal and fair use of the application in relation to the contested goods would give rise to a misrepresentation to the public to the effect that those goods were those of the opponent, or a licensee of the opponent, and that such misrepresentation would cause the opponent to suffer loss and damage.

7. The applicant filed a defence and counterstatement denying the claims made. She did not put the opponent to proof of use of its earlier marks. In particular, she denied that the marks were similar and claimed that the two parties were operating in different markets. According to her counterstatement, her goods are focused on the running and cycling markets while the opponent sells “*glamorous women’s dresses, skirts and swimwear, plus shoes and accessories*”. She also submits that there are other brands on the market with “CB” in their logos.

8. In these proceedings, the opponent has been represented by Mono Law Solicitors and then Richard Southall, who was the attorney who filed the notice of opposition and statement of grounds. The applicant is unrepresented.

EVIDENCE AND SUBMISSIONS

9. Only the opponent filed evidence. This is in the form of a witness statement from Joanna Richards, director and shareholder of Linhope International Limited, dated 27 June 2022. The evidence goes to the use made of the earlier marks. The opponent also filed submissions on the same day. I shall refer to both the evidence and submissions where appropriate in my decision.

PRELIMINARY ISSUES

10. I consider it helpful at this point to address some issues raised by the applicant. The first of these is the claim that the two parties operate in different markets. While this is a relevant factor in the section 5(3) and 5(4)(a) grounds, when I deal with the claim under section 5(2)(b) I must make my assessment on the basis of fair use of the marks as registered. The opponent’s marks qualify as earlier marks under section 6(1)(a) of the Act. Although they completed their registration procedures more than five years before the date of application for the contested mark, and so are subject to the use provisions in section 6A of the Act, the applicant chose not to require the opponent to provide such proof. The TM8 form says that if use is not requested the opponent may rely on all the goods and services for which it has claimed to have used the earlier marks.

11. The second point concerns the existence of other “CB” brands on the market. The mere fact that there are other marks or signs using these letters is not enough to establish that the distinctive character of “CB” has been weakened through frequent use: see *Zero Industry Srl v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-400/06, paragraph 73. In particular, there is no indication of how many of those signs are effectively used.

12. Finally, the applicant describes the contested mark as “*the Challenge Beyond logo*”. These words do not appear in the mark that has been applied for, and it is that mark that I must consider.

DECISION

Section 5(2)

13. Section 5(2) of the Act is as follows:

“A trade mark shall not be registered if because –

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

(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.”

14. In considering the opposition under this section, I am guided by the following principles, gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) in *SABEL BV v Puma AG* (Case C-251/95), *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (Case C-39/97), *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* (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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):¹

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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their 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;

¹ Section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts, although the UK has left the EU.

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; and

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

15. It is settled case law that I must make my comparison of the goods on the basis of all relevant factors. These may include the nature of the goods, their purpose, their users and method of use, the trade channels through which they reach the market, and whether they are in competition with each other or are complementary: see *Canon*, paragraph 23, and *British Sugar Plc v James Robertson & Sons Limited (TREAT Trade Mark)* [1996] RPC 281 at [296]. Goods are complementary when

“... 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.”²

16. The goods to be compared are shown in the table below:

Earlier goods	Contested goods
<u>Class 3 (CB BODY)</u> <i>Body creams, shower gel, skin moisturiser.</i>	
<u>Class 18 (HOUSE OF CB)</u> <i>Handbags, handbags made of leather, Ladies Handbags.</i>	<u>Class 18</u> <i>Sports bags; Sport bags; Sports [Bags for -]; Bags for sports; Bags for sports clothing; All-purpose sports bags; All purpose sports bags; All purpose sport bags; Bags; Kit bags; Casual bags; Waist bags; Music bags; Belt bags and hip bags; Sports packs; Work bags; Game bags; Athletics bags; Waterproof bags.</i>
<u>Class 24 (CB SWIM)</u> <i>Beach towels; Towels [textile] for the beach.</i>	
<u>Class 25 (CB SWIM)</u> <i>Swimwear; Swimming trunks; Swimming caps; Swimming suits; Beachwear; Beach clothing; Beach clothes; Flip-flops.</i>	

17. Neither party has made specific submissions on the comparison of the goods.

18. Section 60A of the Act states that goods should not be regarded as dissimilar simply because they appear in different classes of the Nice Classification.

² *Boston Scientific Ltd v OHIM*, Case T-325/06, paragraph 82.

Nevertheless, I do not see that the opponent's Class 3 goods are similar to the opponent's goods. They may share users, but this is not enough for me to find similarity. I shall therefore consider the CB BODY mark no further under this ground.

Comparison with the Opponent's Class 18 goods

19. Goods may be considered to be identical where one party's goods are included in a more general category in the other party's specification: see *Gérard Meric v OHIM*, Case T-133/05, paragraph 29. The applicant's *Bags* includes the opponent's Class 18 goods and I therefore find them to be identical.

20. I also consider that the applicant's *Casual bags* will include some goods covered by the opponent's *Handbags*. In *Sky Plc & Ors v Skykick UK Ltd & Anor* [2020] EWHC 990 (Ch), Arnold LJ stated that "*General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.*"³ The literal meaning of the applicant's term includes casual handbags and so I find that the terms are identical per *Meric*.

21. The next goods I shall compare with the opponent's goods are *Waist bags* and *Belt bags and hip bags*. Goods may be considered together where "*they are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons*": see *SEPARODE Trade Mark*, BL O-399-10, paragraph 5. These share a purpose with the opponent's goods, as they are all used to carry items. They may also be made from the same materials. There may be some shared trade channels. In my view, there is some competition between the goods as a user may choose a waist or hip bag rather than a handbag to carry their valuables if they need to leave their hands free. I find that there is a medium degree of similarity between the goods.

22. The remaining Class 18 goods in the applicant's specification are *Sports bags*; *Sport bags*; *Sports [Bags for -]*; *Bags for sports*; *Bags for sports clothing*; *All-purpose sports bags*; *All purpose sports bags*; *All purpose sport bags*; *Kit bags*; *Music bags*;

³ Paragraph 56.

Sports packs; Work bags; Game bags; Athletics bags; Waterproof bags. Like the goods I considered in the previous paragraph, these share a purpose with the opponent's goods, as they are all used to carry items. They may also be made from the same materials. In my experience, though, they would not tend to be sold in the same outlets, or in the same areas of department stores. They are unlikely to be in competition with the applicant's Class 18 goods and I have nothing to suggest there would be any complementarity. Taking all these factors into account, I consider that there is a low degree of similarity between these goods and those of the opponent.

Comparison with the Opponent's Class 24 and 25 goods

23. I consider that these goods are dissimilar to the contested goods. They do not share a purpose or method of use and their physical nature will also be different. They goods are not in competition and I do not believe that there is any complementarity. While some of the contested goods (such as *Sports bags*) may be sold in the same outlets as *Swimwear* and *Swimming caps* to the same users, I take the view that this is not sufficient for me to find similarity. I shall therefore consider the CB SWIM mark no further under this ground.

Average consumer and the purchasing process

24. In *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors* [2014] EWHC 439 (Ch), Birss J (as he then was) described the average consumer in these terms:

"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 word 'average' denotes that the person is typical. The term 'average' does not denote some form of numerical mean, mode or median."⁴

⁴ Paragraph 60.

25. The average consumer is a member of the general public who will buy the goods either on visiting a physical store or by using a website. They may also browse printed catalogues and order the goods by telephone. They are likely to see the mark and so the visual aspects of it will be important. The aural element of the mark cannot be ignored, as the consumer may discuss the purchases with sales staff or, as I have already noted, order them on the telephone.

26. The price of the Class 18 goods will vary and they will not tend to be bought on a frequent basis. The consumer is likely to examine the goods to ensure that they meet their needs, in terms of size, appearance, mode of carrying, materials, and other particular features. Overall, therefore, I consider that the average consumer will pay a medium degree of attention during the purchasing process.

Comparison of marks

27. It is clear from *SABEL* (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 in *Bimbo* that:

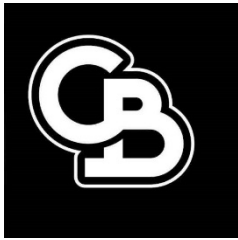
“... it is necessary to ascertain in each individual case, the overall impression made on the target public by the sign for which the registration is sought, by means of, *inter alia*, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”⁵

28. It would be wrong, therefore, artificially to dissect the marks, although it is necessary to take into account their distinctive and dominant components and to give

⁵ Paragraph 34.

due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

29. The respective marks are shown below:

Earlier series of marks	Contested mark
HOUSE OF CB houseofcb house of cb	

30. The contested mark consists of a black square in the centre of which is a device consisting of the capital letter B with a capital C placed to the upper left of the B, with the bottom of the C joined to the middle bar of the B. These do not create a word and so will, in my view, be seen as either initials or simply the letters themselves. The letters are shown in white with a thin white outline a short distance from the letter device. The letters CB make the larger contribution to the overall impression of the mark, although the stylisation and colour also play a role.

31. The earlier marks are a series consisting of the words “HOUSE OF CB”. Even in the second mark in the series, these words are clearly identifiable and so I shall from now on refer to the earlier marks in the singular. I have been given no evidence or submissions on the use of the phrase “House of...” but I consider that it would bring to mind an institution, such as a fashion house. In my view, CB is the more distinctive element of the mark, but the whole mark does hang together as a unit.

Visual comparison

32. The visual similarities between the marks arise from the presence of the letters “CB”. The contested mark contains additional words at the beginning of the mark. I recall that, while the average consumer tends to pay greater attention to the beginning of the marks, this is not a hard-and-fast rule: see *Bristol Global Co Ltd v European*

Union Intellectual Property Office, Case T-194/14. The average consumer will also notice the stylisation of the contested mark. Overall, I find that the marks are visually similar to a medium degree.

Aural comparison

33. The contested mark will be pronounced as the letters (“SEE-BEE”) while the earlier mark will be pronounced as “HOWSS-OF-SEE-BEE”). I take into account my finding that “CB” is the distinctive element of the earlier mark, the second half of which is aurally identical to the contested mark. I find that the marks are aurally similar to a medium degree.

Conceptual comparison

34. I have no evidence that the average consumer will attach any meaning to the letters “CB” and so I find the contested mark to be conceptually neutral. The earlier mark brings to mind a house of some sort, whether this is a physical building or a dynastic house (such as “the House of Windsor”), belonging to or concerning “CB”. While I found “CB” to have no conceptual content, the earlier mark as a whole has some meaning and so I find there to be conceptual dissimilarity.

Distinctive character of the earlier mark

35. In *Lloyd Schuhfabrik Meyer*, 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 Alternberger* [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).”

36. Registered trade marks possess varying degrees of inherent distinctive character, perhaps lower where a mark may be suggestive of, or allude to, a characteristic of the goods or services, ranging up to high for invented words which have no allusive qualities. The earlier mark does not allude to any characteristic of the goods for which it is registered and comprises two dictionary words and a combination of two letters. “HOUSE OF” may be of limited distinctive character in the fashion world and two letters on their own may be inherently fairly weakly distinctive, but taking the mark as a whole I find that it has a medium level of inherent distinctive character.

37. The opponent has also claimed that the distinctive character of the mark has been enhanced through the use made of it. I shall now summarise what the evidence tells me about that use.

38. Ms Richards, director of the opponent, says that the mark has been used between July 2014 and 3 April 2022 in the UK by the exclusive licensee, Original Beauty Technology Company Limited (“OTBC”), on goods, including bags, sold through the website houseofcb.com and physical stores and concessions. In the statement of grounds, it is said that there have been House of CB-branded stores in Westfield Stratford City (London), the Arndale (Manchester) and The Metquarter (Liverpool), the first two of which were “currently” operating along with a concession in Selfridges in

The Trafford Centre in Manchester. Eight concessions in Topshop are also listed, but no dates are given for any of these outlets.⁶

39. Ms Richards claims that OTBC has been “*extremely successful*” in selling goods bearing the earlier mark. However, no sales figures have been provided. Instead, Ms Richards adduces as evidence 4 million visitors to the website in its first year and over 14 million by 2019 and more than 3.5 million Instagram followers. There is nothing to say where any of these users or followers are located. Ms Richards also says that OTBC has spent “*hundreds of thousands of pounds in advertising and promoting the HOUSE OF CB Branded Goods*” but does not say where or how this was spent, apart from on the Instagram account.⁷

40. Exhibit 3 shows handbags for sale on houseofcb.com. Prices are in US dollars and the URL shows that the website is aimed at customers in the US. The goods in Exhibit 4 are priced in sterling, but the bags shown are holdalls, gym bags and a backpack, which are not covered by the earlier mark. Furthermore, the screenshots are undated.

41. Ms Richards states that photographs of celebrities such as Rihanna, Jennifer Lopez, the Kardashians and Mariah Carey wearing HOUSE OF CB branded goods regularly appear on social media and in the press. No examples are provided so I cannot tell whether these would have been seen by UK consumers, whether it would have been clear that the goods came from the opponent, and whether any of those goods included handbags. The evidence as a whole falls short of what would be required to show that the inherent distinctiveness of the mark had been enhanced through use. The level of distinctive character therefore remains at medium.

Conclusions on likelihood of confusion

42. There is no scientific formula to apply in determining whether there is a likelihood of confusion. It is a global assessment where a number of factors need to be borne in

⁶ Paragraph 6.

⁷ Paragraph 7.

mind. I must also take account of the interdependency principle, i.e. that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods or vice versa. I keep in mind 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 they have in their mind.

43. In *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, Mr Iain Purvis QC, sitting as the Appointed Person, explained the ways in which confusion could occur:

“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 recognised 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.’

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (‘26 RED TESCO’ would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)."

44. In *Liverpool Gin Distillery Limited & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ commented that:

"This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition."⁸

45. He also said:

"As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/291/16) at [16] 'a finding of likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion'. Mr Mellor went on to say that, if there is no likelihood of direct confusion, 'one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion'. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."⁹

46. Earlier in my decision, I found that:

⁸ Paragraph 12.

⁹ Paragraph 13.

- the contested goods were either identical or similar to a medium or low degree to the Class 18 goods relied upon by the opponent;
- the average consumer would pay a medium degree of attention during the purchasing process;
- the marks were visually and aurally similar to a medium degree and conceptually dissimilar;
- “CB” was the most distinctive element of the earlier mark; and
- the earlier mark had a medium level of inherent distinctive character which the evidence did not show had been enhanced through use.

47. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis QC, sitting as the Appointed Person, pointed out that the level of “distinctive character” is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“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 of 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.”

48. It is the letters “CB” that make the greatest contribution to the distinctiveness of each of the marks. In my view, it is likely that even where there is only a low degree of similarity between the goods the average consumer will mistake one mark for the other. In coming to this finding, I have taken account of the imperfect recollection of the average consumer. They are unlikely to see the marks side by side. I find that there is a likelihood of direct confusion between the marks for all the contested goods.

49. The opposition succeeds under section 5(2)(b). For completeness, I will briefly consider the remaining grounds.

Section 5(3)

50. Section 5(3) of the Act is as follows:

“A trade mark which –

(a) is identical with or similar to an earlier trade mark,

[...]

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EU) in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

51. The conditions of section 5(3) are cumulative. First, the opponent must show that the earlier mark is similar to the application. Secondly, it must satisfy me that the earlier mark has achieved a level of knowledge/reputation amongst a significant part of the relevant public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the application. Fourthly, assuming that the first three conditions have been met, section 5(3) requires that one or more of the three types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

52. Under section 5(2)(b), I found that the contested mark was similar to the HOUSE OF CB mark. There are two other marks that I must consider: CB BODY and CB SWIM.

These also share the letters “CB” with the contested mark and I find that they are similar. I will make a more detailed assessment later if that proves necessary.

Reputation

53. In *General Motors Corp v Yplon SA*, Case C-375/97, the CJEU held that:

“24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or services marketed, either the public at large or a more specialised public, for example traders in a specific sector.

25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

54. There is nothing in the evidence to show that any use has been made of the CB BODY or CB SWIM marks and so I am unable to find that these marks have a reputation.

55. Turning now to the HOUSE OF CB series of marks, I recall that I found the evidence insufficient to establish that the distinctive character of the marks had been enhanced. The factors that were relevant in that assessment are also the ones that I must consider when deciding whether the mark has a reputation. In particular, there are no figures for sales and marketing expenditure in the UK or examples of advertising. I note that the opponent uses social media channels and lists the locations of physical stores and concessions. However, the evidence is insufficient for me to find that the mark is known by a significant part of the handbag-buying public, which would be a significant proportion of the general public.

56. The section 5(3) ground fails.

Section 5(4)(a)

57. Section 5(4)(a) of the Act states that:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule or law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection 4(A) is met

...”

58. Subsection 4(A) is as follows:

“The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of

application for registration of the trade mark or date of the priority claimed for that application.”

59. In *Reckitt & Colman Products Limited v Borden Inc. & Ors* [1990] RPC 341, HL, Lord Oliver of Aylmerton described the ‘classical trinity’ that must be proved in order to reach a finding of passing off:

“First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying ‘get-up’ (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff’s goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by him are the goods or services of the plaintiff. Thirdly, he must demonstrate that he suffers or, in a quia timet action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant’s misrepresentation that the source of the defendant’s goods or services is the same as the source of those offered by the plaintiff.”¹⁰

Relevant Date

60. In *Advanced Perimeter Systems v Keycorp Limited (MULTISYS)*, BL O-410-11, Mr Daniel Alexander QC, sitting as the Appointed Person, quoted with approval the summary made by Mr Allan James, acting for the Registrar, in *SWORDERS Trade Mark*, BL O/212/06:

“Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has

¹⁰ Page 406.

used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.”¹¹

61. The applicant has not provided any evidence that it has used the contested mark before the date of application and so this is the relevant date.

Goodwill

62. The opponent must show that it had goodwill in a business at the relevant date of 14 July 2021 and that the signs relied upon are associated with, or distinctive of, that business. The signs are identical to the earlier registered marks.

63. The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantages of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has the power of attraction sufficient to bring customers home to the source from which it emanates.”

64. As I have already found in paragraph 54 above, there is no evidence to show use of the CB BODY and CB SWIM signs. Therefore, I cannot find that the business has any goodwill associated with those signs. Turning to the HOUSE OF CB signs, I again note that no sales figures have been adduced in evidence, which is insufficient for me to find goodwill associated with those signs.

¹¹ Quoted in paragraph 43 of BL O-410-11.

65. The section 5(4)(a) ground has failed.

OUTCOME

66. The opposition has succeeded under section 5(2)(b) and registration is refused.

COSTS

67. The opponent has been successful and is entitled to a contribution towards its costs in line with the scale set out in Tribunal Practice Notice 2/2016. My calculation of the award is shown below. I have allowed £100 to cover official fees for the successful ground.

Preparing a statement and considering the other side's statement: £400

Preparing evidence: £500

Official fees: £100

TOTAL: £1000

68. I therefore order Carlene Barthram to pay Linhope International Limited the sum of £1000, which should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 20th day of December 2022

**Clare Boucher,
For the Registrar,
Comptroller-General**