

O-101-09

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2421925A  
BY HANSON PARTNERS LIMITED  
TO REGISTER THE TRADE MARK**



**IN CLASSES 18, 25, 37 and 40**

**AND**

**THE OPPOSITION THERETO  
UNDER NO 96369  
BY ANSON'S HERRENHAUS KG**

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### Introduction

1. On 16 May 2006, Hanson Partners Limited, which I will refer to as HP, applied to register the above trade mark. During the course of its examination, the application was divided. Divisional application 2421925A proceeded to publication for opposition purposes on 16<sup>th</sup> November 2007.
2. On 15<sup>th</sup> February 2008, Anson's Herrenhaus KG, which I will refer to as AH, filed a notice of opposition to the registration of the trade mark for part of the specification. The goods and services against which opposition is directed are:

#### *Class 18*

*Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.*

#### *Class 25*

*Clothing, footwear, headgear.*

#### *Class 40*

*Treatment of materials and fabrics; tailoring services; dressmaking services; cloth cutting; clothing alteration.*

AH claims that registration of the trade mark would be contrary to section 5(2)(b) of the Act since there would be a likelihood of confusion on the part of the public resulting from the above goods and services being associated with two of their own

earlier registered trade marks. The first is Community Trade Mark (CTM) No 3292117 ( hereafter “117”). This earlier mark is:

Anson’s

registered in class 35 for *retail trade services*.

It was filed on 29 July 2003 and was registered on 7 December 2004. Since its date of registration is less than five years before the application in suit was published in the *Trade Marks Journal*, there is no requirement for AH to prove use of its mark.

The second is Community Trade Mark (CTM) No 303511 (hereafter “511”). This earlier mark is:

Anson’s

registered in class 25 for *clothing*.

It was filed on 25<sup>th</sup> June 1996 and was registered on 14<sup>th</sup> May 1998. Since its date of registration is more than five years before the application in suit was published in the *Trade Marks Journal*, in contrast to the first registration relied upon, there is a requirement for AH to prove use of this mark.

AH claims that the dominant element in the application is the word HANSON, that it is visually and phonetically similar to ANSON’S and that it is susceptible to imperfect recollection by the average consumer, its goods and services being identical or similar (which includes being complementary) to the goods and services covered by AH’s registrations.

3. HP filed a counterstatement, denying the grounds of opposition save for one admission:

“The Applicant admits that the ‘clothing’ covered by the Opponent’s Registration No E303511 is identical to the “clothing” designated by the subject application and may cover similar goods to “footwear” and “headgear” ....”

4. AH filed evidence to substantiate proof of use of 511 and I will summarise this in due course.

5. HP did not file any evidence and the parties were advised they had a right to a hearing and that if neither side requested a hearing a decision would be made from the papers and from any written submissions. Neither side requested a hearing and only AH filed written submissions. I have borne in mind these written submissions in reaching my decision, referring to them directly when necessary.

6. Finally by way of introduction, I should mention an earlier decision reached by the registry between the same parties and involving identical marks which has not been appealed. This is BL O-276-08 dated 10<sup>th</sup> October 2008. I intend to substantially rely

upon the analysis and findings of this case. However, I cannot do so entirely as there are material differences between the two cases. The differences between the earlier case and this one are, (i) that the HP's specification of goods and service is different to the one considered in BL O-276-08, and (ii) whereas AH relied only upon 117 in the earlier case, it now relies also upon 511 and as a consequence it has the burden of proving use of that mark. Whilst there is not a complete overlap between the cases, the findings of the earlier case may to an extent be relevant to, even determinative of, this case. At the outset I will set out the extent to which I will rely simply upon the analysis and findings of the earlier case and that will then leave all other matters to be determined.

### **Findings in BL O-276-08 and their relevance to this case**

7. In this case, opposition was filed by AH against HP's application 2421925B, being the divided 'partner' of this application. Opposition, under the sole basis of section 5(2)(b), was lodged against the following:

*Class 24*

*Textile and textile goods, not included in other classes.*

*Class 35*

*Retail services connected with the sale of clothing, footwear and headgear, sunglasses, jewellery, clocks, watches, bags, umbrellas and rucksacks*

*Class 45*

*hire and rental of clothing, footwear, headgear; hire and rental of menswear; hire and rental of ladies wear; hire and rental of children's wear; hire and rental of accessories for all the foregoing.*

Opposition was based on AH's 117 mark only. HP's mark, the subject of application 2421925B, is identical to the mark in suit here. Division was requested in respect of the specification and the objections faced during examination in relation to section 5, rather than the marks, as may be the case as a result of an objection based, eg on series. In other words, the difference between 2421925B and 2421925A is in the respective specifications and not the marks.

8. Following an exhaustive analysis of case law in relation to section 5(2)(b) the Hearing Officer found no likelihood of confusion in relation to any of the opposed goods. Certain of her findings are worth highlighting.

- Following the Court of First Instance (CFI) authority in *Oakley, Inc v Office for Harmonisation in the Internal Market (OHIM)* (case T-116/06), the Hearing Officer found (para 15) that retail services at large covers the retail of textiles and textile goods, which in turn are similar to the textiles and textile goods themselves.
- That likewise, the class 35 services in HP's mark, covering the retail of specific goods are also similar to retail services at large.

- That, absent evidence from AH, she accepted a modicum of similarity between retail services at large and hire and rental of clothing in class 45 (para 17).
- The average consumer for the relevant goods will be the general public (para 18), whose attention may vary.
- As regards the comparison of marks, visually there is a low level of similarity (para 21). Aurally, there is a higher level of similarity than visually (para 22), having regard to the fact that many English speakers, some dialects even, habitually involve dropped 'aitches'. Conceptually, both marks share surnominal identity (para 23), in other words, both would be treated as indicating a surname to the average consumer, but the surnames suggested are different – 'Hanson' and 'Anson'.
- In weighing the factors together and applying relevant case law (paras 24 – 30), the Hearing Officer found no likelihood of confusion, highlighting the low level of similarity between the marks. The Hearing Officer was also referred to decision R 85/2007-4 by the Fourth Board of Appeal at OHIM, being a successful opposition by AH to the (word only) mark 'Hanson' (by an applicant in the Czech Republic). That case involved identical goods in classes 18 and 25. The Hearing Officer gave due weight to that decision without being bound by it. The conclusion of low level of similarity between the marks was plainly arrived at having regard, in particular, to the consideration that the selection of goods by the consumer was visual (para 28), and the fact that both marks comprise or contain what, to the consumer, would indicate different surnames. This is unlikely to go unnoticed, together also with the additional matter on the HP's mark.

9. I see no reason to depart from either the findings of this decision or the analysis which underlies the findings. Indeed, to do so would, in such circumstances as these, put in jeopardy an expectation on this tribunal that it will strive towards a level of consistency which allows parties (and others), with some certainty, to be able to predict the outcome.

10. In saying this, I am of course aware that the specification of the case in suit is different from that considered in the earlier case. Specifically, I cannot agree with AH's submission that this case may be distinguished from BL O-276-08 on the basis that there is identity and/or close similarity between the respective services in classes 18, 25 and 40 (HP's goods and services) on the one hand and 25 (covered by AH's 117 mark) and 35 (covered by AH's 511 mark) on the other. I would accept that in BL O-276-08, none of HP's goods or services were expressly found to be identical with AH's (including the class 35 retail services), but it does not follow that the earlier case can, in its entirety, be distinguished or ignored. On the contrary, the marks engaged in the earlier case are identical and, if anything, the specification in this case is even further removed from the specification in the 117 mark. Specifically, this application contains no retail services at all in class 35.

11. The goods and services in this case can, at most, be considered similar or complementary to the retail services at large of 117. I have no material before me whereby I would be able to conclude that retail services at large are more similar to leather goods in class 18 or clothing in class 25, than they are to textile goods in class 24. Moreover, whereas the Hearing Officer could have been said to be

generous in finding that hire and rental services in class 45 had, absent evidence, a modicum of similarity to retail services in class 35, it would be at least, if not more, generous to conclude that the class 40 services of this application, being

*Treatment of materials and fabrics; tailoring services; dressmaking services; cloth cutting; clothing alteration.*

are equally similar to retail services at large in class 35. AH submits that department stores routinely provide such complementary services alongside the sale of, eg clothing and textiles. I think it likely that department stores, notably at the higher end, such as JOHN LEWIS or HARRODS, may well offer tailoring and alteration services alongside the sale of clothing and, for that reason I would accept that there is complementarity here. I do not accept however that the evidence (of which there is none on this point), or submissions in this case render retail services any closer to the treatment and tailoring of class 40 in this case, than they were to hire and rental of clothing in class 45 in the earlier case.

**12. I conclude that AH is no better off in relation to its 117 mark than it was in BL O-276-08, and therefore, as regards that mark, there is no likelihood of confusion with this mark.** That leaves me to deal with the 511 mark, covering clothing in class 25. In contrast to the 117 mark, I do not believe I can simply rely on the earlier case as, (a) the specification is different from 117 and, in particular, identical goods are involved, (b) proof of use requirements are engaged, and (c) AH may in theory plead enhanced distinctive character of the 511 mark as a result of use. It is necessary then to undertake a full analysis of AH's case as it relates only to the 511 mark, commencing with a summary of the evidence of use, being the only evidential material filed by either side. Lest I am found to be wrong to rule the 117 mark out at this point and, in consequence, I should have conducted a full analysis of likelihood of confusion in respect of both AH's marks I stress that my overall finding would be no different to that which I shall reach in respect of the 511 mark only.

### **AH's evidence of proof of use**

13. John Cloppenburg, Managing Director of Anson's Herrenhaus AG of Dusseldorf Germany has provided an affidavit dated 27<sup>th</sup> August 2008. He says that AH has used the mark ANSON'S in relation to clothing and retailing of clothing in Germany during the relevant period 16<sup>th</sup> November 2002 – 16<sup>th</sup> November 2007.

14. Exhibit AH1 comprises samples of promotional material showing the ANSON's brand used in relation to clothing. There are sales brochures inserted into daily newspapers between May 2003 and April 2004 (circulation 1.3 million). A sales brochure dated September 2006 sent by post to 1.3 million homes. Copies of two Insider Journal Magazines dated February 2005 and Fall/Winter 2007 sent to 450,000 specific customers. These sales brochures and magazines were sent to readers of daily newspapers, undetermined addresses or specific customers on a regular basis, all in Germany on a regular basis. All textual matter in the sales brochures is in German. The brochures show menswear of a formal and casual nature. One of the brands used is PAUL ROSEN with the word 'London' beneath it. There are several items also showing a UNION JACK label.

15. Mr Cloppenburg says that the ANSON's brand (exhibit AH2) is used for labelling for some of the clothing items sold in ANSON's retail shops, of which we learn later from exhibit AH7, are all based in Germany. Such products are 'dual labelled' he says. Exhibit AH3 shows such dual labelling with a photographs of the inside of a several mens' jackets showing a variety of labels: ANSON's; ABRAMS; HEMLOCK, MONTEBELLO and, again, PAUL ROSEN (together with a Union Jack flag), all affixed separately to the linings

16. Exhibit AH4 comprises a list of clothing manufacturers who have ordered such labels to be sewn inside garments sold in ANSON's retail outlets, covering the period 2002 -2007. The list is provided by Avery Dennison Paxar Central Europe GmbH ("Avery"), who is responsible for the labels.

17. Exhibit AH5 is a table showing retail unit sales and retail sales values for goods sold in ANSON's retail outlets and featuring the ANSON's brand alongside other brands. The years covered are 2003-2004. Specifically, 695 units of clothing featuring the PAUL ROSEN (which, in some illustrations, feature the Union Jack Flag) brand were sold in 2003 at a value of 52,036.85 euros. This rose to 2259 units in 2004 at a value of 187634.47 euros. Exhibit AH6 comprises sales figures and values during the years 2005 -2007. BY way of example, in 2005 AH sold a total of 29, 529 units bearing the HEMLOCK and ANSON's brands with a retail value of 2,986,053 euros.

18. Exhibit AH7 is an undated list of retail stores trading as ANSON's. There are 20 listed, all based in Germany.

19. Finally, Exhibit AH8 is a print out dated 27<sup>th</sup> August 2008 showing a photograph from the ANSON's website showing the exteriors of several of the retail outlets.

20. Annette Roode has provided an affidavit dated 28<sup>th</sup> August 2008. She is Team Leader of Customer Service of Avery, the firm responsible for producing the ANSON's labels. Exhibit 1 is a table showing Avery's customers and the quantities of labels ordered between 2002 – 2007. The table shows that 885,620 labels were ordered by AH during that period. Exhibit 2 shows an example of one of the labels supplied.

## **Decision**

### **Proof of use**

21. The Trade Marks (Proof of Use, etc) Regulations 2004 apply in relation to the 511 mark. The provision reads as follows:

#### **"6A Raising of relative grounds in opposition proceedings in case of non-use**

(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within Section 6(1) (a), (b) or (ba) in relation to which the conditions set out in section 5(1),(2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, ...

(5) In relation to a Community trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

22. In this case the application was published on 16<sup>th</sup> November 2007 and the registration procedure for the 511 mark completed on 14<sup>th</sup> May 1998. This earlier trade mark is therefore registered more than five years before the publication date of the HP’s trade mark and AH is therefore required to demonstrate that this trade mark has been put to genuine use in the five year period ending with the date of publication of the application, ie between 17<sup>th</sup> November 2002 and 16<sup>th</sup> November 2007.

23. The requirements for “genuine use” have been set out by the European Court of Justice (ECJ) in its judgment in *Ansul BV v Ajax Brandbeveiliging BV*, Case C-40/01 [2003] RPC 40. The ECJ held as follows:



“35. ... ‘Genuine use’ therefore means actual use of the mark....

36. ‘Genuine use’ must therefore be understood to denote use that is not merely token, serving solely to preserve the rights conferred by the mark. Such use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user...

37. It follows that ‘genuine use’ of the mark entails use of the mark on the market for the goods or services protected by that mark and not just internal use by the undertaking concerned. The protection the mark confers and the consequences of registering it in terms of its enforceability *vis-à-vis* third parties cannot continue to operate if the mark loses its commercial *raison d’être*, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings. Use of the mark must therefore relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns...

38. Finally, when assessing whether there has been genuine use of the trade mark, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, in particular whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark.

39. Assessing the circumstances of the case may thus include giving consideration, *inter alia*, to the nature of the goods or service at issue, the characteristics of the market concerned and the scale and frequency of use of the mark. Use of the mark need not, therefore, always be quantitatively significant for it to be deemed genuine, as that depends on the characteristics of the goods or service concerned on the corresponding market.”

24. In accordance with Section 6A (5) of the Act, as the earlier trade mark relied upon by AH is a Community trade mark, it must demonstrate that it has been put to genuine use within the European Community. AH submits that it has used the mark ANSON’s in Germany during the relevant period and I accept that the evidence establishes that. I would add that although the evidence shows some of the branding used by ANSON’s (a Union Jack flag, and the mark “PAUL ROSEN London”) as having reference to the UK, this does not equate to genuine use in the UK. **Genuine use has been shown only in respect of Germany.**

25. The next question is, precisely on what goods has the mark been used and what would be a ‘fair specification’ as a result. The legal propositions behind the question of arriving at a fair specification have been expounded in *NIRVANA* (BL O/262/06, paras 58 and 59). I do not propose to set all of these out here, but it is relevant that a fair specification would be one that the average consumer would use to describe the goods, and thus it would be relevant and recognisable in relation to the trade

concerned. The goods concerned here are not specialist but available on the high street. The evidence points entirely in one direction – use in respect of mens' clothing, both formal and casual. The models used to show the clothing in the catalogues of Exhibit AH1 are exclusively adult male. A wide mix of clothing is shown: suits, casual jackets, accessories such as belts, ties and scarves. Although some of the items are depicted with other brands such as ABRAMS, BOSS, JOOP!, PAUL ROSEN, Mr Cloppenburg explains that his company has a policy that the clothing is 'dual labelled' that is to say, the ANSON's label is inserted or affixed to the item, alongside other brands such as ABRAMS. This is shown in the photograph comprising Exhibit AH3 and in the tables at Exhibits AH5 and AH6. **I am uncertain as to the precise extent of the 'dual labelling', that is to say that Mr Cloppenburg states that dual labelling is only used on some of the clothing sold by ANSON's retail outlets (para 6 of his witness statement). Despite this, I nevertheless accept that the ANSON's label has been genuinely used on "mens' clothing" during the relevant period and that this would reflect a fair specification for the 511 mark. I feel justified in doing this, given the extensive list of manufacturers (over 50) for whom Avery have produced labels. This is narrower than the broad term 'clothing' originally claimed, but it is what the evidence shows.** I would just add that even if I am found to be wrong in so limiting AH's specification, and that AH were entitled to maintain 'clothing' at large, this would not affect my overall assessment of likelihood of confusion.

### **Section 5(2) (b)**

26. The opposition is based on section 5(2)(b). The relevant part of section 5(2)(b) of the Act is as follows:

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

(a) –

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade marks 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 6(1)(a) of the Act defines an earlier mark as:

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

AH's trade mark upon which it relies is an earlier mark as per section 6(1)(a).

27. The leading authorities which guide me in this ground are from the European Court of Justice (ECJ): *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co*

*GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO)*. It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it; *Sabel BV v Puma AG*,

(g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(i) further, 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; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(j) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*

### **Comparison of goods and services**

28. Following the established tests in *Canon* and in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281, I must consider the nature of the goods and services, their intended purpose, their method of use, whether the goods or services are in competition with or complementary to each other and also the nature of the users and the channels of trade. The comparison will be made between AH's "mens' clothing" (as determined in para 25 above) in class 25 and HP's goods in classes 18, 25 and 40.

29. The criteria identified in the *Treat* case for assessing similarity between goods and services 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 service;
- (d) the respective trade channels through which the goods or services reach the market;
- (e) in the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) the extent to which the respective goods or services are competitive, taking into account how goods/services are classified in trade.

30. Plainly, the goods in class 25 are identical or similar. HP's specification is broader and would encompass all types of clothing, footwear and headgear. But to the extent that it is broader I regard the extra matter as similar to mens' clothing. Specifically, footwear and headgear is also intended to be worn and can be sold through the same or similar distribution channels. The evidence filed in this case shows, for example, that mens' shoes, scarves and caps are also sold through ANSON's retail outlets. The reason that these specific items were not included in my

finding on genuine use was because the specification as originally filed would be expanded.

31. In relation to class 18, according to the description and guidance in relation to this class published in relation to the Nice classification, the goods of this class are specifically not clothing, but this of itself is not determinative of the question of similarity. Such goods may be made from the same raw material but their function may well be different. Clothing is to be worn but some at least of the goods covered in class 18 are intended to perform a specific function, be it as bags, harnesses, umbrellas or whatever. AH informs me, by way of submission, that the brand LOUIS VUITTON and HERMES are examples of brands which are used both in relation to clothing and bags (in the case of LOUIS VUITTON), and whips harness and saddlery and clothing in the case of HERMES. I am also conscious that the Court of First Instance in the cases of *SERGIO ROSSI (Case T-169/03) [2005] ECR II 685*, and *EL CORTE INGLES SA (Case T-443/05)* has grappled with the similarity between goods in classes 25 and 18. The CFI's approach in the latter of these cases was to treat the class 18 goods as falling into two broad categories, (i) leather and imitations of leather, animal skins, hides: trunks and travelling bags; umbrellas, parasols and walking sticks; whips harness and saddlery, and (ii) leather and imitation leather goods not included in other classes such as, for example, handbags, purses and wallets. In relation to the first group, the CFI found a *slight* degree of similarity (following the *SERGIO ROSSI* case) (para 47), and in particular noted that these were often sold with class 25 goods at points of sale in major retail establishments and more specialised shops. In relation to the second group, the CFI discussed the notion of complementarity between goods in class 25 and 18. They said that goods may be considered complementary if they were indispensable or important for the use of the other in such a way that customers may think that the responsibility for the production of those goods lies with the same undertaking. Goods such as clothing, hats or handbags may, in addition to their basic function, have a common aesthetic function by contribution to the external image (look) of the consumer. Specifically, goods in class 18 which contribute to an overall co-ordinated 'look' should, according to the CFI, be treated as *having a similarity with clothing in class 25, which is classified as more than slight* (para 51). Without naming those goods in class 18 exhaustively, the CFI terms them "clothing accessories". I can see no reason to depart from these findings on similarity as between class 25 and class 18 reached by the CFI in *EL CORTES INGLES* and thus conclude that the goods of class 18 are to be treated as either slightly similar, or more than slightly similar in the case of clothing accessories.

32. As regards the services of class 40, in para 11 above I accepted complementarity as regards retailing of clothing and treatment of fabrics and alterations etc. In the same way, I accept complementarity as between clothing itself and treatment of fabrics and alterations etc in class 40. The one is indispensable or at least important to the other. As I have said, I think it highly probable that a higher end department store especially, such as JOHN LEWIS or HARRODS, will, as well as selling clothing offer, eg an alteration service, such that a consumer may assume that a mark used in relation to the service of alteration of clothing denotes the same undertaking responsible for the clothing itself. In saying this I am also aware from my own experience as a consumer that clothing alteration services are offered in other outlets as well, such as dry cleaners and specialist outlets. The department

store scenario can undoubtedly be over played (see, eg para 44 of *EL CORTES INGLÉS*), since such a wide variety of goods and services may be on offer without any real risk of confusion, but I think in this case, and given the very close relationship between the goods and service in the probable setting of a department store, I consider it fair to treat the goods of class 25 and the services in class 40 as complementary, and thus more than slightly similar.

### **Average consumer**


33. The average consumer for mens' clothing and HP's goods and services will be the general public since the items offered for sale and services on offer are aimed at the general consumer. The level of attention will vary according to the particular nature of the item being purchased or required to be altered. Some items of clothing, such as socks for example may well involve little consideration in the purchasing act, being inexpensive and functional, whilst others, such as suits will involve a much more considered purchasing act. By and large, the more expensive the item and the more decorative and aesthetically pleasing it is (which includes the need to match other items), the more considered will be the purchase. Likewise, alterations will also be a considered purchase as, although, of themselves small in value, the consumer will invariably be entrusting a much more valuable item to the hands of someone else.

### **Similarity of marks**

34. At this point I feel I can borrow and quote with approval the hearing officer's assessment of the respective marks, which as I have said, are identical, in BL O-276-08. She states:

"19. The authorities direct that, in making a comparison between the marks, I must have regard to each mark's visual, aural and conceptual characteristics. I have to decide which, if any, of their components I consider to be distinctive and dominant. The likelihood of confusion must be appreciated globally by evaluating the importance to be attached to those different elements, taking into account the degree of similarity in the goods and services, the category of goods and services in question and how they are marketed. However, I should guard against dissecting the marks so as to distort the average consumer's perception of them; the average consumer perceives trade marks as wholes and rarely has the opportunity to compare marks side by side, relying instead upon the imperfect picture he has of them in his mind.

20. The marks to be compared are:

AH's	HP's
Anson's	

AH's mark is clearly a word mark in plain type whilst HP's mark is comprised of words in plain type and the device of a heraldic lion. In HP's mark, the word HANSON is presented in larger type than partners and is also emboldened, appearing darker than all the other elements of the mark. I agree with AH's submission that HANSON is the dominant element of the application. 'Partners' plays a subordinate role; the lion is a distinctive element, but the mark overall is dominated by the word HANSON.

21. AH also submits that the application contains the entirety of its mark. This cannot literally be true, since AH's mark contains an apostrophe and a genitive 's'. What AH presumably means is that ANSON is contained within HANSON. I agree that there is a slight degree of visual similarity between ANSON'S and HANSON, the only point of convergence between the marks. However, the average consumer does not generally dissect marks and I bear in mind that my visual comparison must be made by comparing AH's mark with the whole of the application, which is a complex mark with more than one distinctive element. I find that there is a low level of visual similarity.

22. AH contends that many English speakers drop their 'aitches' so that an accurate oral comparison would be between ANSON'S and ANSON. I agree that is a relevant consideration; there are several UK areas where a dropped H is a natural dialect feature. In addition, 'h' is a soft consonant, more easily missed aurally than harder consonants. Its position in HP's mark means that, spoken or heard, it creates less of a distance between the marks in the way that harder consonants would do. I find that there is a higher level of aural similarity between the marks than is the case visually, notwithstanding PARTNERS, which plays a subordinate role. Since there are word elements in the mark, it is unlikely that the average consumer would choose to refer to HP's mark by reference to the heraldic lion, since the word elements provide a much more natural and accessible way to articulate the mark.

23. I agree with AH that both marks suggest surnames. I consider that especially to be so for HP's mark because HANSON qualifies PARTNERS and it is common practice for trade marks which identify partnerships to do so by the partners' surnames. My view is that the marks share a similar surnominal identity. However, the surnames themselves are not similar. At a high level of conceptual generality, the marks both contain a surname; however, a conclusion on this basis that the marks are conceptually similar would, I think, lead to a skewed result, since the surnames are different and

surnames possess intrinsic qualities of identification. I will say more about this below.”

35. The last point regarding conceptual identity will be developed below in my overall assessment.

### **The distinctive character of the earlier mark**

36. AH's mark is inherently distinctive for mens' clothing. In the UK it is highly probable that it will be seen as a surname and thus it will not be at the highest level of distinctiveness, which is a level occupied by invented words having no meaning or relationship to the goods or services on which they are used. The distinctive character is not enhanced through use in the UK as I have already found, there is no use in the UK, only Germany.

### **Likelihood of confusion**

37. To assist in deciding whether there is a likelihood of confusion, AH has included with its submissions a translation (into English from German) of a decision taken by the OHIM Fourth Board of Appeal, 20 July 2007, R 85/2007-4, which involved AH's opposition against a CTM application for the trade mark HANSON (by an applicant in the Czech Republic). Although the translation has not been attested or otherwise verified by the translator, its accuracy has not been challenged and I will therefore treat it as a faithful translation. The opposition was decided in AH's favour. AH relied upon its earlier trade mark ANSON'S (CTM 1001999). I bear in mind what was said by Geoffrey Hobbs Q.C., sitting as the Appointed Person in *Zurich Private Banking* (BL 0/201/04), on the matter of decisions in different jurisdictions:

“However, the position as between different national registries and the Community Trade Marks Office is that they are not competent to adjudicate on the correctness of each other's determinations and, as a corollary of that, not required to treat each other's determinations as binding upon them in the independent exercise of their own powers. That is not to say that each of them should or will simply ignore the determinations of the others. The general principle is that each of them should give determinations of the others such weight (if any) as they might fairly and properly be said to bear in the decision-taking processes they are required to undertake independently of one another.”

I find the decision of the Board of Appeal is, potentially, of limited assistance here. Firstly, it must be said that the goods and services cannot be said to be absolutely identical as they were in the Board of Appeal's case. Secondly, HP's mark contains additional matter which has to be factored into the overall assessment. Thirdly, it must be remembered that the Board of Appeal's decision will seek to view matters through the eyes of the average Czech consumer, not the average English speaking UK consumer. I have nevertheless read the translation carefully and would like, respectfully, to make observations on one aspect in particular. This is doubly important as it forms a specific submission by AH, namely that the fact that both marks may be regarded as surnames, and each is different, does not of itself suffice to make them incapable of confusion.



38. At para 14 of the Board of Appeal's decision, it is said that the addition of the initial letter 'H' does not result in a different overall impression from that of a similar mark. The Board of Appeal say this is a minor change in spelling which can easily be overlooked or forgotten. At para 18, the Board of Appeal states that the conceptual comparison is 'neutral', given that neither mark has any conceptual meaning in any of the languages of the Community. Both would be understood as proper names or made-up words. In response to this, I think it highly probable that in the UK both marks would be seen as surnames rather than made up words. Starting with that premise, I would be far less dismissive of the 'H' element in "Hanson" than the Board of Appeal. Moreover, where the perception is likely to be that of surnames, and those surnames are evidently different, a finding of conceptual "neutrality" betrays, in my opinion, an overly formulaic, almost contrived, approach. Where names are concerned, people are especially alert to differences; SMITH is very different from SMYTH. The names people have, and are given, are invariably precious to them, and one might expect in any setting or circumstance to be instantly corrected if the wrong name is used in error. I see no real difference in a trading context; names function as trade marks – some would say they represent the most natural trade marks, and as such it is impossible to ignore differences. I emphasise that this is not to say that any difference in surname must inevitably render the marks incapable of confusion. What I am saying however is that, in my opinion, the Board of Appeal's analysis, by treating the respective marks as conceptually 'neutral', and paying little heed to the 'H' element sought to view matters through the eyes of the average, non-English speaking, Czech consumer. Such an analysis cannot simply be transposed onto the average UK consumer.

39. The CFI found (endorsed by the ECJ), for example, that the marks PICASSO and PICARRO are conceptually different, based on the fact that PICASSO would convey a clear and specific meaning as being the name of the famous painter (see para 20 of Case *C-361/04P PICASSO v OHIM*). I see no reason, in principle, why a similar finding of conceptual difference may be found where, what are likely to be regarded as names, do not necessarily have the degree of fame that PICASSO enjoys. I have dwelt at some length on this point because I regard it as very important in my overall assessment of likelihood of confusion.

40. Likelihood of confusion is a global assessment, I have to bear in mind the nature of the goods and services, the purchasing acts and the relevant consumer, which have been dealt with above. I have to weigh the proximity of the goods and services against the relative distance between the marks - the interdependency principle – whereby a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon*). The interdependency principle is particularly important in this case given the earlier decision reached and the different nature of the goods and services in this case. I must also consider what is the relative importance that the phonetic and visual similarities have in relation to the goods and services during the purchasing process. I must also appraise the distinctive character of the earlier mark, because the more distinctive it is (either *per se* or by reputation), the greater will be the likelihood of confusion (*Sabel*). The distinctive character of a mark must be assessed by reference to the particular goods or services to which it is attached and by reference

to the relevant consumer's perception of the mark. Finally of course I should take into account imperfect recollection.

41. I have found that the goods and services are those bought by the general public who will have varying degrees of attentiveness to the purchasing act.

42. In my assessment of the marks, I said that there was an appreciably greater degree of aural similarity than visual similarity but this alone cannot result in likelihood of confusion. It is but one factor in the mix. I also have to decide the relative weight which should be accorded to visual or aural perception of the marks. I am guided by the CFI in *Quelle AG v OHIM* Case T-88/05:

“57 Furthermore, it is settled case-law that a complex mark and another mark which is identical or similar to one of the components of the complex mark may be regarded as being similar where that component forms the dominant element within the overall impression given by the complex mark. That is the case where that component is likely to dominate, by itself, the image of that mark which the relevant public keeps in mind, with the result that all the other components of the mark are negligible within the overall impression given by it. That approach does not amount, however, to taking into consideration only one component of a complex trade mark and comparing it with another mark. On the contrary, such a comparison must be made by examining the marks in question, each considered as a whole (*MATRATZEN*, paragraph 55 supra, paragraphs 33 and 34, and *Representation of a cowhide*, paragraph 52 supra, paragraph 27).

58 However, that does not mean that the overall impression created in the mind of the relevant public by a complex trade mark may not, in certain circumstances, be dominated by one or more of its components. Furthermore, with regard to the assessment of the dominant character of one or more given components of a complex trade mark, account must be taken, in particular, of the intrinsic qualities of each of those components by comparing them with those of other components. In addition and accessorially, account may be taken of the relative position of the various components within the arrangement of the complex mark (*MATRATZEN*, paragraph 55 supra, paragraphs 34 and 35, and Case T-31/03 *Grupo Sada v OHIM – Sadia (GRUPO SADA)* [2005] ECR II-1667, paragraph 49).

....

68 Therefore, in the global assessment of the likelihood of confusion, the visual, phonetic or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (Case T-129/01 *Alejandro v OHIM – Anheuser Busch (BUDMEN)* [2003] ECR II-2251, paragraph 57, and *NLSPOORT, NLJEANS, NLACTIVE and NLCollection*, paragraph 53 supra, paragraph 49). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing marks are marketed. If the goods covered by the marks in question

are usually sold in self-service stores where consumers choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any phonetic similarity between the signs (*NLSPORT*, *NLJEANS*, *NLACTIVE* and *NLCollection*, paragraph 53 supra, paragraph 49).

69 Likewise, the degree of phonetic similarity between two marks is of less importance in the case of goods which are marketed in such a way that, when making a purchase, the relevant public usually perceives visually the mark designating those goods (*BASS*, paragraph 56 supra, paragraph 55, and Case T-301/03 *Canali Ireland v OHIM – Canal Jean (CANAL JEAN CO. NEW YORK)* [2005] ECR II-2479, paragraph 55). That is the case with respect to the goods at issue here. Although the applicant states that it is a mail order company, it does not submit that its goods are sold outside normal distribution channels for clothing and shoes (shops) or without a visual assessment of them by the relevant consumer. Moreover, while oral communication in respect of the product and the trade mark is not excluded, the choice of an item of clothing or a pair of shoes is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly, the visual aspect plays a greater role in the global assessment of the likelihood of confusion (*NLSPORT*, *NLJEANS*, *NLACTIVE* and *NLCollection*, paragraph 53 supra, paragraph 50). The same is true of catalogue selling, which involves as much as does shop selling a visual assessment of the item purchased by the consumer, whether clothing or shoes, and does not generally allow him to obtain the help of a sales assistant. Where a sales discussion by telephone is possible, it takes place usually only after the consumer has consulted the catalogue and seen the goods. The fact that those products may, in some circumstances, be the subject of discussion between consumers is therefore irrelevant, since, at the time of purchase, the goods in question and, therefore, the marks which are affixed to them are visually perceived by consumers.”

43. The marks are used to market decorative items, personal items, such as bags and clothing. These are the categories of goods at which the opposition is directed and the purchase of such goods will be largely visual. The visual similarity between the marks in this case is therefore of greater importance than it is aurally since the average consumer’s perception of the marks will be formed on the basis of visual inspection of the goods and a visual encounter with the marks under which they are marketed.

**44. Balancing all the factors mentioned above, and in particular the fact that both marks will, to the UK consumer, designate different surnames, my overall conclusion is that there is not a likelihood of confusion. Once again, I stress that I have factored in both imperfect recollection and the interdependency principle in my overall assessment. The opposition therefore fails.**

## **Costs**

45. The opposition having failed, HP is entitled to a contribution towards its costs.

Considering notice of opposition	£200
Statement of case in reply	£300
Considering evidence	£500
Total	£1,000

Accordingly, I order Anson's Herrenhaus KG to pay to Hanson Partners Limited the sum of £1,000. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 21<sup>st</sup> day of April 2009**

**Edward Smith  
For the Registrar,  
the Comptroller-General**