

O-382-11

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2528396 IN THE NAME OF
THE PRETTY DRESS COMPANY LONDON LTD

AND

OPPOSITION THERETO UNDER NO 100246 BY
DEBONAIR TRADING INTERNACIONAL LDA

In the matter of application
No 2528396 in the name of
The Pretty Dress Company
London Ltd and
Opposition thereto under
No 100246 by Debonair
Trading Internacional Lda

Background

1. Application No 2528396 was made on 9 October 2009 and stands in the name of The Pretty Dress Company London Ltd (“PDCL”). It seeks registration of the following trade mark:



2. Following publication of the application in the *Trade Marks Journal*, a notice of opposition was filed, following which PDCL requested a limitation to the specification of goods. The limitation means that registration is now sought in respect of:

Ladies dresses, corset dresses and evening dresses

3. The notice of opposition was filed on behalf of Debonair Trading Internacional Lda (“Debonair”). Debonair claims that the mark applied for offends against the provisions of section 5(2)(b) of the Act as it is highly similar to each of its earlier marks with the respective goods being identical. In addition, it claims that the application is “especially likely to be seen as simply one more mark in a family of marks” as used by Debonair. In support of its grounds of opposition, Debonair relies upon a number of trade marks as listed in the following table:

No	Mark	Filing Date	Registration Date
2482729	SO...?	18.3.2008	1.8.2008
2492280	SO...? BRIT	9.7.2008	9.1.2009
CTM 8492217	SO...? SEXY	14.8.2009	29.3.2010
CTM 7237671	SO...?	17.9.2008	n/a
CTM 7055239	SO...? ETERNAL	10.7.2008	3.6.2009
CTM 5814942	SO...? LUXURIOUS	5.4.2007	13.3.2008
CTM 5530993	SO...? SENSUAL	7.12.2006	15.11.2007
CTM 5099635	SO...? SUPERSTAR	26.5.2006	27.4.2007
CTM 4630406	SO...? CHIC	5.9.2005	9.1.2008
CTM 4330221	SO...? SINFUL	3.3.2005	18.4.2006
CTM 4246311	SO...? WILD	19.1.2005	3.4.2006
CTM 2335511	SO...? KISS ME	31.7.2001	27.5.2005

4. Whilst many of the above marks are registered (or seek registration, where applicable) for a range of goods in a number of classes, Debonair seeks to rely only on them only insofar as they cover *Clothing; footwear; headgear; T-shirts; caps*.

5. PDCL filed a counterstatement in which, essentially, it denied all of the claims made.

6. Both parties filed evidence and the matter came before me for hearing on 16 August 2011. PDCL were represented by Ms Denise McFarland of counsel instructed by M R Hutchins & Co, its legal representatives in these proceedings. Debonair was similarly represented by Ms Deborah Selden of Beck Greener.

The evidence

7. Evidence on behalf of Debonair was filed in the form of a witness statement by Deborah Anne Selden, an employee of Beck Greener. Evidence on behalf of PDCL was filed in the form of witness statements by Johanna Fitzgerald, its founder and director and by Antony Levi of ACL Agencies, Elaine McCluskey, picture editor of the TV Times and Nicole Kerr, who describes herself as a fashion stylist.

Debonair's evidence

8. Ms Selden's witness statement primarily serves as a vehicle to introduce a number of exhibits:

DS-1: extracts from the Collins 2nd ed 1986 and Chambers 1972 dictionaries showing the meaning of the word 'couture'. In the former, the meaning is given as 'high fashion designing and dressmaking' in the latter, 'dressmaking and dress designing';

DS-2 : Internet printouts to show use of the word 'couture' by traders and the public as follows:

A printout downloaded on 16 November 2010 from the website of the Royal College of Art. It is in the form of an abstract from a student's thesis which refers to 'London's couture industry';

A BBC news article dated 20 September 2010 reporting on the funeral of the fashion designer Alexander McQueen wherein he is quoted as having designed the “most exquisite couture dresses”;

A printout from the Telegraph website which shows an article published on 30 September 2007. The article talks of Norman Hartnell and describes him as a couturier and having a couture house on Bruton Street in London;

A printout taken from the Independent website which shows an article published on 30 September 1995. The article talks of a designer employed in the UK by the women’s clothing store Wallis and mentions couture collections and couture styling ;

A number of printouts downloaded on 16 November 2010 from the Boudicca, lovecouture, swankybride and EnglishCoutureCompany websites. All refer to couture clothing or haberdashery;

An extract from the fashionforrealwomen.com website downloaded on 2 November 2010. The pages provide a definition for couture (“sewing”) and haute couture (“high sewing”) describing them as ‘available for custom fit’ and ‘made-to-measure’ respectively.

DS-3

All downloaded on either 3 or 16 November 2010, these printouts are taken from the Wikihow, Telegraph, clothingattesco, Matalan, amandasofyork, sofeminine, loveburlesque and urban-couture websites. The WikiHow extract includes the following:

“Couture clothing is chosen by the very rich, the very vain and the very influential.....That said, by understanding and following fashion it is possible to cultivate a couture look without spending a great deal of money.”

The extract from the Telegraph, dated 14 March 2010 reports on Tesco’s launch of its Couture Range which is described by its Chief Executive as “a high fashion-led range.... [of] affordable yet high quality clothing.”

The extract from the Matalan online shop refers to its Candy Couture line and describes the goods sold under the range to be “the latest fashion must haves”.

9. Ms Selden states that the material she exhibits shows that the word ‘couture’ has a descriptive significance with respect to clothing but is also widely used by clothing

retailers as a laudatory term even when used in relation to clothing which has not been made to measure.

PDCL's evidence

10. Ms Fitzgerald states that she founded PDCL, launching its SO COUTURE! brand in early 2009 and that by the date of her witness statement (19 January 2011) the company had sold 'in excess of twelve thousand (12,000) dresses under this name'. She states that dresses are sold through the company's sales agent ACL Agencies as well as directly to individuals via the company's website. Sales have been made to customers throughout the UK. She exhibits the following:

- JF1: A photocopied letter headed ACL Agencies and addressed "To whom It May Concern". Signed by an Antony Levi, it indicates that the company has represented the So Couture! brand for approximately 2 years and sells to "a good proportion of" its 200 accounts in the UK. The letter is dated 14 January 2011.
- JF2: Pages taken from InStyle.co.uk magazine. The pages contain an advertisement for The Pretty Dress Company which refers to the "collection by UK designer So Couture!" The magazine is said to date from October 2010.
- JF3: Various internet printouts from a number of clothing retailers offering dresses from a number of sources. Some refer to So Couture and So Couture!. The printouts were downloaded in December 2010 and January 2011.
- JF4: Described as PDCL's online newsletter which was issued in November 2010. Ms Fitzgerald states there were 1447 subscribers to the newsletter as of 18 January 2010.
- JF5: An undated, unaddressed and unsigned letter on TV Times headed paper said to be from its picture editor Elaine McCluskey in which she confirms that the magazine has "personally dealt with So Couture for the last year" and has kept [a selection of the dresses in our fashion cupboard as we find the dresses are a lifesaver for a late/emergency shoot..."];

A printout of a twitter page downloaded on 8 December 2010;

A printout from itv.com relating to a tv programme. It indicates that the presenter of the show wore a So Couture! dress on a number of those shows broadcast in August and September. Whilst the text gives no indication of what year this was, the printout is dated 13 September 2010;

Article from the Express website reporting an interview with an actress who says she wears a "So Couture" dress. The article itself is dated 2 May 2010;

Article from the Daily Mirror reporting an interview with the same actress. There is no mention of So Couture! within the (incomplete) article but Ms Fitzgerald states the actress is wearing such a dress in the accompanying picture. The article is dated 28 April 2010;

A printout from PDCL's website downloaded 9 December 2010 referring to TV programmes shown on ITV1 in September, October and December 2010 and giving details of the clothing worn by the presenters which includes some So Couture! dresses;

Undated, unsigned letter from a Nicole Kerr addressed "To whom this may concern" which indicates that "So Couture! have been supplying me with dresses for fashion shoots for the past year";

Email dated 2 August 2010 which shows the sender and recipient both to be sales@theprettydresscompany.com. The email makes no reference to So Couture!;

An exchange of emails between a Nazaneen Gahaffar and sales@theprettydresscompany.com, all dated 29 November 2010. It appears Ms Gahaffar has sometimes appeared on TV and was seeking/being offered some new dresses. There is no mention of So Couture!.

- JF6: Letter from Nuala Dempster of The Dressing Room, a boutique located at Gorey in Co Wexford (outside of the jurisdiction). It confirms the boutique "has stocked the "So Couture 'brand for the past six months" The letter is dated 4 January 2011.
- JF7: Pages downloaded on 15 December 2010 from the Marshall Ward.co.uk website. The pages show a variety of clothing and bear the words So Fabulous!

11. The remaining witness statements are from Mr Levi, Ms McCluskey and Ms Kerr and put into formal evidence the comments they made in their letters exhibited at JF1 and JF5. The witness statements are dated 17th, 19th and 18th January 2011 respectively.

12. That concludes my summary of the evidence.

Decision

13. Section 5(2)(b) of the Act states:

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

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

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

14. An “earlier trade mark” is defined in section 6 of the Act. It states:

“6.-(1) In this Act an "earlier trade mark" means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark 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,
- (b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), or
- (c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark.

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

(3) A trade mark within subsection (1)(a) or (b) whose registration expires shall continue to be taken into account in determining the registrability of a later mark for a period of one year after the expiry unless the registrar is satisfied that there was no *bona fide* use of the mark during the two years immediately preceding the expiry.”

15. Debonair relies on twelve trade marks as set out above at paragraph 3 above. Each qualifies as an earlier trade mark under the above provisions. As none of the earlier marks completed its registration process more than five years before the publication date of the mark for which registration has been applied, the provisions of

section 6A of The Trade Marks (Proof of Use, etc) Regulations 2004 are not relevant.

Preliminary Issues

16. As set out at paragraph 3 above, Debonair seeks to rely on a family of marks argument. As I indicated at the hearing, Debonair is in some difficulties in pursuing such a claim. In *Miguel Torres SA v OHIM* -T-287/06 the General Court stated:

“81 However, according to the above case-law, the likelihood of confusion attaching to the existence of a family of earlier marks can be pleaded only if both of two conditions are satisfied. First, the earlier marks forming part of the ‘family’ or ‘series’ must be present on the market. Secondly, the trade mark applied for must not only be similar to the marks belonging to the series, but also display characteristics capable of associating it with the series.”

17. Debonair has filed no evidence to show what use it has made of all or indeed any of the marks on which it seeks to rely. Absent evidence of use, I reject any claim to a family of SO...? branded marks.

18. At the hearing, Ms Seldon accepted that if Debonair could not succeed by relying on its earlier marks 2482729 and CTM 4630406 it would be in no stronger position as regards its other earlier marks. I proceed on that basis.

19. In its skeleton argument, PDCL refers to the fact that it is the registered proprietor of two other earlier registrations containing the words So Couture which did not attract objection from Debonair. An objection founded on section 5(2)(b) of the Act turns upon whether an opponent has an earlier trade mark compared to the mark under attack. Whether an applicant for registration itself has (an) other registered trade mark(s) which predate(s) any earlier mark upon which an opponent relies cannot affect the outcome of the case in relation to this ground (see *PepsiCo, Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) T-269/02*).

The objection based on section 5(2)(b) of the Act

20. In determining the question under Section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel v Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R 77, *Marca Mode CV v Adidas AG* [2000] E.T.M.R.723, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di Laudato & C. Sas v OHIM* C-334/05 (Limoncello), as cited with approval in *Och-Ziff Management Europe Ltd and Oz Management LP v Och Capital LLP, Union Investment Management Ltd and Ochoki* [2010] EWCH 2599 (Ch). It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;
- (f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks causes the public to 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

21. The goods to be compared are as follows:

Debonair's earlier marks	PDCL's application
Clothing; footwear; headgear; T-Shirts; caps	Ladies dresses, corset dresses and evening dresses

22. In her skeleton argument, Ms McFarlane refers to the fact that the specification of goods of the application has been subject to limitation and submits that as it now stands "the entire basis of [Debonair's] challenge based on "identity" of goods has now fallen away." Ms McFarlane submits that the goods for which registration is sought is:

"a very particular sub-set of specialist ladies clothing and would not be confused with the general broad ambit of unspecified goods such as headgear, outerwear etc. that fall within class 25. Moreover and more particularly it is *very different from and wholly distinguishable from the class of goods relied on by the Opp for their earlier marks ie; "Clothing; footwear; headgear; T-shirts; caps"* (her emphasis).

23. At the hearing Ms McFarlane accepted that there is similarity between the now limited specification and *clothing* as appears in Debonair's earlier marks but maintained that the respective goods were distinguishable from each other.

24. I am mindful of the findings of the Court of First Instance (now General Court) in *Saint-Gobain SA v OHIM* Case T-364/05 where it said:

"67... it is important to reiterate that the comparison between the goods in question is to be made on the basis of the description of the goods set out in the registration of the earlier mark. That description in no way limits the methods by which the goods covered by the earlier mark are likely to be marketed."

25. I am also mindful of the findings of the Court of First Instance (now General Court) in the case of *NHL Enterprises BV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-414/05:

"71 The Court considers, first, that that assessment by the Board of Appeal is not called in question by the particular conditions in which the applicant's goods are marketed, since only the objective marketing conditions of the goods in question are to be taken into account when determining the respective importance to be given to visual, phonetic or conceptual aspects of the marks at issue. Since the particular circumstances in which the goods covered by the marks at issue are marketed may vary in time and depending on the wishes of the proprietors of those marks, the prospective analysis of the likelihood of confusion between two marks, which pursues an aim in the general interest, namely that the relevant public may not be exposed to the risk of being misled as to the commercial origin of the goods in question, cannot be dependent on the commercial intentions of the trade mark

proprietors-whether carried out or not- which are naturally subjective (see, to that effect, *NLSPORT*, *NLJEANS*, *NLACTIVE* and *NLCollection*, cited at paragraph 61 above, paragraph 49, and Case T-147/03 *Devinlec v OHIM – TIME ART (QUANTUM)* [2006] ECR II-11, paragraphs 103 to 105, upheld on appeal by the Court by judgment of 15 March 2007 in Case C-171/06 P *TIME ART v OHIM*, not published in the ECR, paragraph 59).”

26. The specification of goods for which PDCL seeks registration consists of *ladies dresses, corset dresses and evening dresses*. Whilst one might expect e.g. an evening dress to have something more about it than a dress one might wear when carrying out one’s everyday activities, the fact remains that the specification as now limited simply covers a wide range of dresses. Dresses are items of clothing. In *Gérard Meric v OHIM*, Case T-133/05, the General Court said:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

27. ‘Clothing’ is a term of art which includes any number of types of garment. As ‘dresses’ are included within the term ‘clothing’ I consider that the goods for which PDCL seek registration are identical to clothing as appears in the earlier registrations.

Average consumer and the nature of the purchasing process

28. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods. I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade.

29. Clothing are goods which will be bought by the public at large and these then are the average consumer for these goods. Ladies dresses (of whatever style) are bought by women: they then are the average consumer for these goods.

30. As to the manner in which the goods are likely to be selected by the average consumer, this is most likely to consist of a visual act made on the basis of self selection in either a retail environment, from a catalogue or on-line (see for example the comments of the Appointed Person in *React Trade Mark* [2000] RPC 285).

31. In *New Look Ltd v Office for the Harmonization in the Internal Market* (Trade Marks and Designs) Joined cases T-117/03 to T-119/03 and T-171/03 the General


Court considered the level of attention taken when purchasing goods in the clothing sector:

“43 It should be noted in this regard that the average consumer’s level of attention may vary according to the category of goods or services in question (see, by analogy, Case C-342/97 Lloyd Schuhfabrik Meyer [1999] ECR I-3819, paragraph 26). As OHIM rightly pointed out, an applicant cannot simply assert that in a particular sector the consumer is particularly attentive to trade marks without supporting that claim with facts or evidence. As regards the clothing sector, the Court finds that it comprises goods which vary widely in quality and price. Whilst it is possible that the consumer is more attentive to the choice of mark where he or she buys a particularly expensive item of clothing, such an approach on the part of the consumer cannot be presumed without evidence with regard to all goods in that sector. It follows that that argument must be rejected.”

32. As the *New Look* case acknowledges, the cost of clothing can vary considerably, however, as neither of the competing specifications in class 25 is limited in this respect, I must keep in mind goods across the whole price spectrum. Whilst I agree the average consumer’s level of attention is likely to be heightened when selecting, for example, a bespoke evening dress, it is also likely that the same average consumer’s level of attention will diminish when selecting, for example, an inexpensive dress for wearing as a cover-up on the beach. While these examples demonstrate that the average consumer’s level of attention is likely to vary considerably given the cost and nature of the particular item being bought, I consider that even when selecting routine items the average consumer is likely to be conscious of factors such as the size, colour, material and price of the article concerned and its suitability for purpose and ease of being laundered. Overall, I think the average consumer is likely to pay at least a reasonable degree of attention to the selection of the goods at issue.

Comparison of marks

33. The trade marks to be compared are as follows:

Debonair’s earlier trade marks	PDCL’s trade mark
2482729 SO...? CTM 4630406 SO...? CHIC	

34. The average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as wholes and does not pause to analyse their various details. In addition, the average consumer rarely has the chance to make a direct comparison between trade marks and must instead rely upon the imperfect picture of them which has been kept in mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant components of the respective trade marks and, with that in mind, I must then go on to compare the respective trade marks from the visual, aural and conceptual perspectives.

35. Earlier mark 2482729 contains a number of elements. There is the word SO, followed by an ellipsis itself followed by a question mark. The word SO has no meaning in relation to the goods and is distinctive of them. Given that it appears at the beginning of the mark, I consider the word SO to be the dominant element of the mark. That is not to say the punctuation is negligible or does not add to the mark or would be ignored but it is the word SO that forms the memorable part of the mark and is the most important in it.

36. Earlier mark CTM 4630406 consists of the same elements followed by the additional word CHIC. The word CHIC is a well-known word used to describe clothing that is fashionable or elegant and thus is not distinctive in relation to the goods at issue. But the word SO is used as an intensifier and it therefore has a direct relationship with the word which follows it despite the two words being separated by the punctuation such that neither word really dominates the other.

37. The mark applied for consists of the words SO COUTURE (with the initial letters of each word capitalised) followed by an exclamation mark, the whole presented on a rectangular, pink, background. The words are written in a cursive script though there is nothing remarkable about that script. Given the way the mark is presented there is less emphasis on the word SO per se however the word is positioned at the beginning of the mark and the word COUTURE is descriptive of high fashion items mark. But the word SO is used as an intensifier and therefore has a direct relationship with the word that follows it. In my view neither word dominates the other. As far as the colour of the application is concerned, I take note of the comments made by Mr Geoffrey Hobbs QC, sitting as the appointed person in *Mary Quant Cosmetics Japan Ltd v Able C & C Ltd* BL O/246/08:

“10. The present oppositions under Section 5(2)(b) are based on the rights conferred by registration of a device mark recorded in the register in black-and-white. It follows that colouring is immaterial to the distinctiveness of the Opponent’s device mark as registered and therefore irrelevant for the purposes of the assessment of similarity in both oppositions.”

In *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2010] EWHC 2035 (Ch), Mann J stated:

“119. It is not clear to me that this is a debate which advances the case very much, but the position seems to me to be as follows. As a matter of principle the exercise involves comparing the offending sign with the registered mark and assessing the likelihood of confusion or association. The two things have

to be compared. Since we live in a visual world, and signs are visual, some form of appearance has to be considered. If the registered mark is unlimited to colour then it is registered for all colours. This means that the colour of the offending sign becomes irrelevant. It will not be possible to say that its colour prevents there being an infringement. At this point one can take one of two courses, each of which ought to have the same result. The first is to imagine the registered mark in the same colour as the offending sign. The second is to drain the colour from the offending sign,. Either way one then has the material for comparison. One could even imagine them both in a third colour. It does not matter. So in a sense both Mr Purvis and Mr Bloch are right. As a matter of visual convenience it seems to me to be easier to imagine the registered mark in a colour than to imagine the offending sign drained of colour, and I propose to adopt that course.”

38. Comparing the mark applied for with earlier mark No 2482729, each begins with the word SO and ends in a punctuation mark so there is a degree of visual similarity between them. These marks also have some visual differences given the inclusion of the word COUTURE in the mark applied for and the fact that the actual punctuation marks are not the same. I consider these marks have a moderate degree of visual similarity. The differing punctuation will not be apparent from an aural standpoint as they are highly unlikely to be pronounced by the average consumer. The word COUTURE is non distinctive for the goods at issue and I consider the marks are aurally similar to a reasonably high degree.

39. From a conceptual perspective, the word SO is used as an intensifier and, whilst the average consumer is unlikely to analyse the mark to any significant degree, the inclusion of the ellipsis is highly suggestive that something has been omitted though what that omission might be is, in effect, a matter of speculation. This is supported to some degree by the inclusion of the question mark. I do not consider the average consumer will impart any particular conceptual meaning to the mark other than that it begs a question. The word SO is also used as an intensifier in the mark applied for but the inclusion of the word COUTURE identifies the subject of that intensification.

40. Whilst much of the evidence dates from after the relevant date in these proceedings, I do not consider that the position will have altered appreciably. The evidence shows that COUTURE is used to refer to clothing which is fashionable. The mark brings to mind something that is highly fashionable. In my view the respective marks are not similar from a conceptual perspective.

41. Comparing the mark applied for with earlier mark CTM 4630406, each begins with word SO, both contain another word each of which begins with the letter C and both contain punctuation so there is again a degree of visual similarity between them. There are also some visual differences given the differences in the word CHIC and COUTURE and the respective positioning of the punctuation. I consider the marks have a reasonably high degree of visual similarity. Again, the differing punctuation will not be apparent from an aural standpoint as they are highly unlikely to be pronounced by the average consumer. Both words CHIC and COUTURE are non distinctive for the goods at issue. I consider the marks are aurally similar to a reasonably high degree.

42. As I indicated above, the word SO is an intensifier and therefore has a direct relationship with the word which follows it which, in the case of the earlier mark, is the word CHIC. The mark brings to mind something that is highly fashionable and thus, in my view the earlier mark is conceptually highly similar if not identical to the mark for which registration is applied.

Distinctive character of the earlier marks

43. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which it has been acquired and, secondly, by reference to the way it is perceived by the relevant public (see *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings (see *Windsurfing Chiemsee v Huber and Attenburger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585).

44. No evidence of any use of the earlier marks has been put before me and therefore I have only the inherent distinctive character to consider. Earlier mark No 2482729 consists of a combination of the distinctive word SO which, when coupled with an ellipsis and question mark is a somewhat unusual presentation such that I consider it is a mark with a high level of inherent distinctive character. Earlier CTM 4630406 consists of the same elements along with the word CHIC which is non-distinctive for the goods at issue. I consider this mark to have a reasonably high level of inherent distinctive character.

Likelihood of confusion

45. In determining whether there is a likelihood of confusion, a number of factors have to be borne in mind. The first is the interdependency principle whereby a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. I also have to factor in the distinctive character of the earlier marks as the more distinctive they are the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely on the imperfect picture of them he or she has retained in mind.

46. As far as earlier mark No 2482729 is concerned, I have found it has a high level of inherent distinctive character, that identical goods are involved, that the respective marks have a moderate degree of visual similarity and a reasonably high degree of aural similarity but are conceptually dissimilar. On a global appreciation, I find that there is a likelihood of direct confusion between the respective marks and the opposition based on this earlier mark succeeds.

47. As for CTM 4630406, I have found it has a reasonably high level of inherent distinctive character, that identical goods are involved, that the respective marks

have a reasonably high degree of similarity from both a visual and aural perspective and are conceptually highly similar if not identical. Again on a global appreciation, I find that there is a likelihood of direct confusion between the respective marks and the opposition based on this earlier mark also succeeds.

Costs

48. As Debonair has been successful it is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice 4 of 2007. Using that as a guide, I award costs to Debonair on the following basis:

Preparation of a statement and considering the other side's statement:	£400 plus fee £200
Preparing evidence and considering and commenting on the other side's evidence:	£400
Preparation for and attendance at the hearing:	£400
Total:	£1400

49. I order The Pretty Dress Company London Ltd to pay Debonair Trading Internacional LDA the sum of £1400. 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 04 day of November 2011

**Ann Corbett
For the Registrar
The Comptroller General**