

O/213/12

**TRADE MARKS ACT 1994**

**IN THE MATTER OF INTERNATIONAL REGISTRATION NO 982697  
IN THE NAME OF LES MONTRES BARTHELAY DISTRIBUTION SA IN  
RESPECT OF THE TRADEMARK**

**LadyBird My Princess**

**IN CLASS 14**

**AND IN THE MATTER OF OPPOSITION  
THERE TO UNDER NO 71986  
BY LITTLEWOODS LIMITED**

## BACKGROUND


1) Les Montres Barthelay Distribution SA (“the holder”) is the holder of International Registration (“IR”) no. 982697 “LadyBird My Princess”. Protection in the UK was requested on 17 October 2008 with a claimed International priority date of 13 June 2008. The request for protection was published, for opposition purposes, in The Trade Marks Journal on 20 March 2009. Protection is sought in respect of the following Class 14 goods:

*Precious metals and their alloys and goods made of these materials or plated therewith included in this class; jewellery, precious stones; timepieces and chronometric instruments.*

2) On 19 June 2009, Littlewoods Limited (“the opponent”) filed notice of opposition to the granting of protection in the UK. The grounds of opposition are in summary:

a) The designation offends under Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) because it is similar to two of the opponent’s earlier marks and in respect to identical or similar goods. The relevant details of the two earlier marks relied upon by the opponent are detailed below:

<b>Mark and relevant dates</b>	<b>Specification of goods</b>
CTM*5609466  LADYBIRD  Filing date: 12 January 2007  Registration date: 4 September 2008	<b>Class 14:</b> <i>Jewellery in the shape of circles, squares, crosses, triangles, rectangles, ellipses, stars, hearts; fine, precious, semi-precious, costume, decorative jewellery in the shape of circles, squares, crosses, triangles, rectangles, ellipses, stars, hearts; precious metals, unwrought or semi-wrought; alloys of precious metal; badges of precious metal in the shape of circles, squares, crosses, triangles, rectangles, ellipses, stars, hearts; boxes of precious metal; watches; clocks; horological instruments; cufflinks and key rings in the shape of circles, squares, crosses, triangles, rectangles, ellipses, stars, hearts; purses of precious metal; precious and semi-precious stones.</i>



<p>CTM*5609532</p>  <p>Filing date: 12 January 2007</p> <p>Registration date: 1 February 2008</p>	<p><b>Class 14:</b> <i>Jewellery; fine, precious, semi-precious, costume, decorative jewellery; precious metals, unwrought or semi-wrought; alloys of precious metal; badges of precious metal; boxes of precious metal; watches; clocks; horological instruments; cufflinks; key rings; purses of precious metal; precious and semi-precious stones.</i></p>
--	---

\*Community Trade Mark

b) The designation offends under Section 5(3) of the Act because the mark is similar to various earlier marks with a reputation in the name of the opponent. In addition to the two earlier marks shown above, the opponent also relies upon the following earlier marks:

Mark and relevant dates	Specification of goods
<p>CTM 1739168</p> <p>LADYBIRD</p> <p>Filing date: 28 June 2000</p> <p>Registration date: 25 September 2002</p>	<p><b>Class 35:</b> <i>Retail services in the field of children's clothing and accessories.</i></p>
<p>CTM 1925171</p> <p>LADYBIRD</p> <p>Filing date: 27 October 2000</p> <p>Registration date: 4 December 2001</p>	<p><b>Class 25:</b> <i>Articles of clothing, footwear and headgear.</i></p>

<p>CTM 3475183</p> <p>LADYBIRD</p> <p>Filing date: 14 November 2003</p> <p>Registration date: 28 April 2006</p>	<p><b>Class 3:</b> <i>Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery; essential oils, cosmetics, hair lotions; dentifrices; wipes incorporating toilet preparations; wet wipes; baby bath; baby wash; baby shampoo; baby oil; baby lotion; talcum powder; soap; baby eau de toilette; cotton wool; cotton wool pads; cotton wool balls; cotton wool buds.</i></p> <p><b>Class 5:</b> <i>Pharmaceutical, veterinary and sanitary preparations; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides; medicated shampoo; medicatd soap; medicated wash; medicated bath preparations; food for babies; impregnated wipes for cosmetic and medical use; paper wipes impregnated with toilet preparations.</i></p> <p><b>Class 10:</b> <i>Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopedic articles; suture materials; babies bottles; dummies; teething rings; soothers; teats.</i></p> <p><b>Class 16:</b> <i>Disposable napkins; diapers of cellulose or paper; disposable liners for napkins; bibs of paper or cellulose; wipes of paper, cellulose or tissue for cosmetic use; wipes of paper, cellulose or tissue for toilet use; paper make-up removal wipes; toilet paper; toilet tissues; pads for removing make-up disposable training pants; disposable underpants for babies.</i></p> <p><b>Class 21:</b> <i>Household or kitchen utensils and containers (not of precious metal or coated therewith); combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes; baby bowls; baby feeding apparatus.</i></p>
---	---

<p>CTM 5792015</p> <p>LADYBIRD</p> <p>Filing date: 28 March 2007</p> <p>Registration date: 7 April 2008</p>	<p><b>Class 12:</b> <i>Safety seats and safety belts, all adapted for vehicles and for use by children; perambulators; push chairs (baby carriages); all in class 12.</i></p>
<p>CTM 3475217</p>  <p>Filing date: 14 November 2003</p> <p>Registration date: 22 March 2005</p>	<p><b>Class 25:</b> <i>Clothing, footwear and headgear; baby clothing.</i></p> <p><b>Class 28:</b> <i>[...]; babies toys; [...].</i></p>
<p>CTM 5792098</p>  <p>Filing date: 28 March 2007</p> <p>Registration date: 8 April 2008</p>	<p><b>Class 12:</b> <i>Safety seats and safety belts, all adapted for vehicles and for use by children; perambulators; push chairs (baby carriages); all included in class 12</i></p>

c) The designation offends under Section 5(4)(a) of the Act because the opponents, or its predecessors in title, have used the mark LADYBIRD since at least 1984 in respect of retail services in the field of children's clothing and accessories and has, therefore, built up a substantial reputation and goodwill identified by the mark.

3) The holder subsequently filed a counterstatement denying the opponent's claims and putting it to proof of use in respect of all goods and services for which a reputation has been claimed.

4) Only the opponent filed evidence in these proceedings. Both sides ask for an award of costs. Neither side requested to be heard and I make my decision after careful consideration of all the papers on file.

### **Opponent's Evidence**

5) This takes the form of two witness statements. The first of these is by Richard May, Registered Trade Mark Attorney with Rouse & Co., the opponent's representatives in these proceedings. His statement consists exclusively of submissions that I will not detail here, but I will keep in mind during my deliberations.

6) The second witness statement is by Annemarie McNally of Shop Direct Home Shopping Limited and Head of Licensing and Wholesale for the LADYBIRD brand owned by the opponent. She explains that the opponent is part of the Shop Direct Limited group of companies and it acquired, in January 2009, the LADYBIRD brand that includes the word marks and device marks relied upon in these proceedings. When it acquired the marks it did not obtain a comprehensive body of historical evidence and, as such, Ms McNally explains that the exhibited evidence is limited by what is available to the opponent.

7) Ms McNally states that, because of the fame of the LADYBIRD marks, the opponent's acquisition of the brand generated extensive press coverage. Examples are provided at Exhibits AMM1, AMM3 and AMM4 showing articles that appeared in the *Sunday Times* and *The Telegraph* newspapers and on the *BBC* website. It is noted, variously, in these articles that LADYBIRD is one of the best-selling children's brands in the UK, that other bidders included *Tesco* and *Boots*.

8) Ms McNally states that the LADYBIRD brand was first used in approximately 1938 and at Exhibit AMM5 provides photographs of a book cover, sleeve and selected extracts from a book published in 1977 and entitled "Ladybird, Ladybird. A Story of Private Enterprise". The sleeve note begins "As one of the world's largest children's wear manufacturers Pasolds Ltd has made its Ladybird trade mark a household name." Ms McNally confirms that Pasolds Ltd were the original proprietor of the LADYBIRD brand. Exhibit AMM6 is an extract from the user-authored online encyclopedia, *Wikipedia* illustrating the content relating to "Ladybird (Clothing)". It reflects the facts presented above by Ms McNally.

9) Ms McNally also states that since launch, continuous sales, advertising and promotion have resulted in the LADYBIRD brand becoming one of the UK's best known brands of children's clothing and accessories. In "recent years"

LADYBIRD branded jewellery has been introduced to the UK market following the then proprietor of the marks, *Woolworths*, entering a licence agreement, on 29 January 2007, in respect of Class 14 goods. Extracts of this licence are provided at Exhibit AMM8.

10) A copy of a “Brand Guidelines” booklet from 2006/7, relating to the mark LADYBIRD, is produced at Exhibit AMM9. It refers to the LADYBIRD brand in respect of “kids clothing” and the retailing of the same and indicates trade in children’s clothing over many decades.

11) Ms McNally states that the UK is the biggest market for the LADYBIRD brand. To illustrate the historic desirability of the brand, Ms McNally states that its reported acquisition by *Woolworth* in 2001 was reported to cost £11 million. An article that appeared in *The Independent* newspaper, on 17 January 2001, reporting the acquisition is provided at Exhibit AMM10 and refers to the LADYBIRD brand as “one of Europe’s oldest brands of children’s clothing”.

12) Copies of various LADYBIRD catalogues are provided at Exhibits AMM11, AMM12 and AMM13 covering the period Spring/Summer 2004, Autumn/Winter 2004, Autumn/Winter 2006 and Autumn/Winter 2008. These show a wide variety of children’s wear and the word LADYBIRD followed by the device of a ladybird (and as reflected in the earlier device marks relied upon) appears on the front cover of the catalogues and a number of other pages. The marks relied upon are not visible on any goods in the first two of these catalogues. In the third, children’s slippers and wellington boots decorated as a ladybird are shown, but the marks relied upon are not visible on any of the goods themselves. The final catalogue illustrates numerous items, such as a scarf, boys’ tops and coats featuring the word LADYBIRD alone or with the device of a ladybird.

13) Examples of marketing material and details of marketing campaigns are provided and at Exhibit AMM14 is a copy of an article published on 25 July 2006 by *Brand Republic* reporting a £1 million campaign to promote the LADYBIRD value school uniform range. Exhibit AMM15 is a copy of an article published on 31 July 2006 by *Retail Week* reporting *Woolworth’s* (the previous proprietor of the brand) major expansion of the LADYBIRD branded retail outlets and identifying that the LADYBIRD brand enjoyed a 3.9% market share of the £6.3 billion children’s wear market.

14) Ms McNally states that the opponent has been successful in taking action against the holder’s LADYBIRD MY PRINCESS IR designations in other territories such as Spain and Turkey. The decisions relating to these two proceedings are provided at Exhibits AMM17 and AMM18, respectively, along with certified translations.

15) At Exhibits AMM19 and AMM20, Ms McNally provides extracts from [www.woolworthsmuseum.co.uk](http://www.woolworthsmuseum.co.uk) and [www.pasold.co.uk](http://www.pasold.co.uk), both relating to previous

proprietors of the LADYBIRD brand and marks. These websites both provide further historical information regarding the large size and longstanding nature of the reputation attached to the LADYBIRD children's wear brand.

16) Ms McNally states that the LADYBIRD marks were used on exterior signage, display material in retail outlets and are often seen as point of sale in outlets worldwide. Photographs illustrating examples of these are provided at Exhibit AMM21. All appear to relate to retail outlets outside the UK and are dated between 1996 and 2006.

## **DECISION**

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

17) I find it convenient to consider first the grounds based upon Section 5(2)(b) of the Act. This reads:

“(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.”

18) An “earlier trade mark” is defined in section 6 of the Act, the relevant parts of which state:

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

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

19) The date of designation of the UK of the holder's IR was 17 October 2008. However, by virtue of an International Convention priority date of 13 June 2008 it is this latter date that is the relevant date for these proceedings. Both of the opponent's earlier CTMs, relied upon for these grounds, are registered and therefore, are both earlier marks as defined by Section 6(1), above. Further, as both CTMs have a filing date of 12 January 2007 and this is less than five years before the publication date of the holder's UK designation of its IR, then the



opponent is not required to provide proof of use of its marks (Section 6A(1) refers). As a consequence of all of this, the opponent is entitled to rely upon the full range of goods listed in both its earlier CTMs.

20) The opponent's best case in respect of this ground of opposition resides with its word mark LADYBIRD. Accordingly, I will limit my considerations to the likelihood of confusion between the contested IR and this mark.

21) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the Court of Justice of the European Union (CJEU) in *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] FSR. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] ETMR 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 (LIMONCELLO)*

### **Comparison of goods**

22) In assessing the similarity of goods, it is necessary to apply the approach advocated by case law and all relevant factors relating to the respective goods and services should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23:

'In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.'

23) Other factors may also be taken into account such as, for example, the distribution channels of the goods concerned (see, for example, *British Sugar Plc v James Robertson & Sons Limited (TREAT)* [1996] RPC 281).

24) For ease of reference, the respective lists of goods are as follows:

<b>Opponent's list of goods</b>	<b>Holder's list of goods</b>
<p><b>Class 14:</b> <i>Jewellery in the shape of circles, squares, crosses, triangles, rectangles, ellipses, stars, hearts; fine, precious, semi-precious, costume, decorative jewellery in the shape of circles, squares, crosses, triangles, rectangles, ellipses, stars, hearts; precious metals, unwrought or semi-wrought; alloys of precious metal; badges of precious metal in the shape of circles, squares, crosses, triangles, rectangles, ellipses, stars, hearts; boxes of precious metal; watches; clocks; horological instruments; cufflinks and key rings in the shape of circles, squares, crosses, triangles, rectangles, ellipses, stars, hearts; purses of precious metal; precious and semi-precious stones.</i></p>	<p><b>Class 14:</b> <i>Precious metals and their alloys and goods made of these materials or plated therewith included in this class; jewellery, precious stones; timepieces and chronometric instruments.</i></p>

25) The identical term *precious stones* is present in both specifications and self-evidently relates to identical goods.

26) In respect of the opponent's terms *precious metals, unwrought or semi-wrought; alloys of precious metal* and the holder's term *precious metals and their alloys*, whilst they are constructed slightly differently, it is, once again, self-evident that they are describing the identical goods.

27) In *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-133/05*, at paragraph 29, the General Court ("the GC") stated that goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the mark application or when the goods designated by the mark application are included in a more general category designated by the earlier mark. Bearing this in mind, it is evident that:

- The holder's *goods made of these materials [precious metals and their alloys or plated therewith included in this class]* are identical to the opponent's *precious [...] jewellery in the shape of circles, squares,*

*crosses, triangles, rectangles, ellipses, stars, hearts [...] badges of precious metal in the shape of circles, squares, crosses, triangles, rectangles, ellipses, stars, hearts; boxes of precious metal;*

- The holder's *jewellery* is identical to the opponent's *jewellery in the shape of circles, squares, crosses, triangles, rectangles, ellipses, stars, hearts; fine, precious, semi-precious, costume, decorative jewellery in the shape of circles, squares, crosses, triangles, rectangles, ellipses, stars, hearts;*
- The holder's *timepieces and chronometric instruments* are identical to the opponent's *watches; clocks; horological instruments.*

28) In summary, all of the holder's goods are identical to goods listed in the opponent's specification.

### ***The average consumer***

29) As matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, paragraph 23) it is important that I assess who the average consumer is for the goods and services at issue. I have already identified that all the respective goods are identical and it follows that the respective average consumer of the respective goods will also be identical. Such consumers will generally be drawn from the general public, however, I recognise that in respect of goods such as *precious stones, precious metals, unwrought or semi-wrought and alloys of precious metal*, the average consumer may have more knowledge of the trade because such goods may be purchased by jewellery makers and other trade buyers and may make significant bulk purchases of high value.

30) The goods in question can be generally described as jewellery, clocks, watches and other small goods made from precious or semi-precious materials. Such goods are bought either predominantly on aesthetic appeal (as with jewellery) or where aesthetic appeal plays some subordinate, but still significant role, to functional requirements (as with watches and clocks). Such goods range significantly in price and this is likely to result in the level of attention varying greatly during the purchasing process. It is likely that, where goods are particularly high in value, the average consumer will play much closer attention during the purchasing act. At the other end of the spectrum, affordable costume jewellery may be bought on impulse and the degree of attention paid by the consumer will be commensurately lower.

### ***Comparison of marks***

31) For ease of reference, the respective marks are:

<b>Opponent's mark</b>	<b>Holder's mark</b>
LADYBIRD	LadyBird My Princess

32) When assessing the extent of similarity between the respective marks, I must do so with reference to their visual, aural and conceptual similarities bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*, para 23). The opponent's mark consists of the single word LADYBIRD and this is, therefore, the dominant and distinctive element. The Holder's mark is likely to be perceived by the consumer as the word "LadyBird" and the phrase "My Princess". This latter phrase is of low distinctive character as it alludes to the wearer of the holder's goods (I will expand my reasoning regarding this point later) and the former element "LadyBird" will be distinctive. Whilst such distinctiveness may be reduced in cases where it is used in respect of goods in the form of, or decorated with ladybirds, this is somewhat offset by it appearing with the additional words, that have the effect of focusing the consumers attention on the "LadyBird" element as the identifier of origin rather than a potential descriptor of the goods. Consequently, I conclude that the word "LadyBird" is the dominant and distinctive part of the holder's mark.

33) Having identified the dominant and distinctive elements of the mark, I now proceed to consider the level of visual, aural and conceptual similarity between the marks.

34) From a visual perspective, both marks contain the common element "ladybird". Whilst, in the holder's mark, the word is shown with a capital "L" and "B", the opponent's mark is shown in capitals. Nevertheless, this element of the respective marks consists of the same word and, even accounting for the differences in presentation, are virtually identical. The holder's mark also contains the additional elements "My Princess" and this is an obvious point of dissimilarity between the marks. Taking all of this into account, I conclude that the respective marks share a moderate to moderately high level of visual similarity.

35) From an aural perspective, the first element of the respective marks is identical and will be pronounced as the three syllables LAY-DEE-BURD. The additional elements of the holder's mark will result in an additional three syllables MY-PRIN-SESS being pronounced. Therefore, the holder's mark consists of six syllables, the first three of which are identical to the three syllables present in the opponent's mark but with the last three syllables being absent in the opponent's mark. Taking all of this into account, I conclude that the respective marks share a moderate to moderately high degree of aural similarity.

36) From a conceptual perspective, both marks include the word "ladybird" being "a small beetle with a domed back which is typically red or yellow with black spots"<sup>1</sup>. The additional words "My Princess", present in the holders mark means a daughter of a monarch belonging to someone. In practical terms, the term is

---

<sup>1</sup> "ladybird". Oxford Dictionaries. April 2010. Oxford Dictionaries. April 2010. Oxford University Press. 21 May 2012 <<http://oxforddictionaries.com/definition/ladybird>>.

likely to be understood by the consumer as a term of endearment, especially to describe a girl of special affection. It is not obvious to me that the word “ladybird” and the phrase “my princess” are linked and they appear to exist, in the mark, as distinct, unrelated elements. Taking all of this into account, I conclude that the respective marks share a moderate to moderately high level of conceptual similarity.

37) I have found that the marks share a moderate to moderately high level of visual, aural and conceptual similarity. Such findings combine so that the respective marks, when considered as a whole, share a moderate to moderately high level of similarity overall.

### ***Distinctive character of the earlier trade mark***

38) I must consider the distinctive character of the earlier mark because the more distinctive it is, either by inherent nature or by use the greater the likelihood of confusion (*Sabel BV v Puma AG* [1998] RPC 199). The distinctive character of the earlier mark must be assessed by reference to the goods for which it is registered and by reference to the way it is perceived by the relevant public (*Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91).

39) The mark consists of the word LADYBIRD, being the word used to describe a small beetle. Except where it is used in respect of goods decorated with, or in the shape of such beetles, it is endowed with a moderately high level of inherent distinctive character. It is not of the highest level of distinctive character, as an invented word can be, but nevertheless it will not describe (except in the specific examples identified above) the majority of the goods covered by the specification of goods.

40) Whilst the evidence illustrates a long history associated with the LADYBIRD brand in respect of children’s wear, there is insufficient evidence before me to conclude that such a reputation has extended into the Class 14 goods relied upon by the opponent in respect of these grounds. Such evidence is limited to extracts from a licence agreement in respect of such goods that the opponent’s predecessor in title, *Woolworth*, entered into in January 2007. However, there is no further evidence and, in particular, nothing in respect of the scale, geographical scope, market share or level of promotion of such goods. Consequently, I must conclude that the moderately high level of inherent distinctive character is not enhanced through use.

### ***Likelihood of confusion***

41) I must adopt the global approach advocated by case law and take into account that marks are rarely recalled perfectly with the consumer relying instead on the imperfect picture of them he has in kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27).

42) Mr May submits that the “My Princess” element of the holder’s mark will convey the message that the goods are directed at young/infant girls and is likely to perceive the mark as a brand extension of the opponent’s own LADYBIRD brand. He also submits that the risk of confusion is heightened because of the renown and distinctive character of the opponent’s mark. I am not persuaded by the final element of this argument. For the purposes of this ground of objection, it is reputation in respect of Class 14 goods that is relevant and I have already found that the evidence has failed to demonstrate that the opponent’s mark benefits from an enhanced level of distinctive character in respect to these goods. However, Mr May’s submission regarding how the phrase “My Princess” will be perceived has more force. As I identified earlier, it is likely to be perceived as a term of endearment and, accordingly, is likely to be perceived as indicating goods aimed at young girls. In such a case, the word “LadyBird” in the holder’s mark will be perceived by the consumer as indicating trade origin.

43) In summary, therefore, I concur with Mr May that the word “ladybird” is the dominant and distinctive element of both marks, I have found that all of the holder’s goods are identical to the opponent’s goods and that the respective average consumer is the same. Further, the marks share a moderate to moderately high level of similarity. Taking all of this into account, I find that the consumer is likely to be confused in believing that the goods sold under the holder’s mark will originate from the same or linked undertaking to those goods sold under the opponent’s mark.

44) In light of my conclusion above, the opposition based upon Section 5(2)(b) of the Act is successful in its entirety.

### **Section 5(3) and Section 5(4)(a)**

45) In light of my findings above, it is not necessary for me to also consider the grounds based upon these sections of the Act.

### **COSTS**

46) The opposition having been successful, Littlewoods Limited is entitled to a contribution towards its costs. I take account of the fact that no hearing has taken place but that it did file evidence and written submissions in lieu of attendance. I award costs on the following basis:

Preparing Notice of Opposition (and including official fee) and considering other side’s statement	£500
Preparing evidence and submissions	£1100
<b>TOTAL</b>	<b>£1600</b>

47) I order Les Montres Barthelay Distribution SA to pay Littlewoods Limited the sum of £1600. 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 28<sup>th</sup> day of May 2012**

**Mark Bryant  
For the Registrar,  
the Comptroller-General**