

O-327-14

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS IN THE MATTER OF

APPLICATION NOS 2643055 & 2643056

BY HOWARD SCOTT EGGLESTONE AND DAVID STEPHEN LISTER

TO REGISTER THE FOLLOWING TRADE MARKS:

Holy Ghost

&



AND

**OPPOSITION THERETO (UNDER NOS 400670 & 400671)
BY CBM CREATIVE BRANDS MARKEN GMBH**

BACKGROUND

1) On 20 November 2012 Howard Scott Egglestone and David Stephen Lister ('the applicants') applied to register the following two trade marks:

Application No 2643055:

Holy Ghost

Application No 2643056:



2) Both trade marks have been applied for in respect of the following goods and services:

Class 14: Jewellery, costume jewellery, precious stones, goods made of precious metals and their alloys, goods coated with precious metals and their alloys, horological and chronometric instruments, clocks and watches, earrings, rings, badges, buckles, chains, parts and fittings for all the aforesaid goods.

Class 25: Clothing, footwear, headgear.

Class 35: Retail and wholesale services connected with the sale of clothing, footwear, headgear, jewellery and costume jewellery, precious stones, goods made of precious metals and their alloys, goods coated with precious metals and their alloys, horological and chronometric instruments, clocks and watches, earrings, rings, badges, buckles, chains, parts and fittings for all the aforesaid goods.

3) The applications were published on 07 June 2013 in the Trade Marks Journal and notice of opposition was subsequently filed by CBM Creative Brands Marken GmbH ('the opponent'). The opponent claims that both applications offend under section 5(2)(b) of the Trade Marks Act 1994 ('the Act').

4) The opponent relies on the community trade mark registration ('CTM') shown in the table below:

CTM details	Goods and services relied upon
CTM No: 11306545 HOLY Filing date: 30 October 2012 Date of entry in the register: 13 March 2013	Class 25: <i>Clothing, footwear, headgear.</i> Class 35: <i>Retail services, including via websites and teleshopping, in relation to clothing, footwear, headgear, sunglasses, precious metals and their alloys and goods in precious metals or coated therewith, jewellery, precious stones, horological and chronometric instruments, leather and imitations of leather, and goods made of these materials.</i>

5) The trade mark relied upon by the opponent has a filing date of 30 October 2012 and completed its registration procedure on 13 March 2013. The consequences of these dates, in relation to the applicants' marks, are that i) the opponent's mark is an earlier mark in accordance with section 6 of the Act; and ii) it is not subject to the proof of use conditions contained in section 6A of the Act.

6) The applicants filed a counterstatement for each opposition denying that the respective marks are similar. They assert that the opponent's mark is devoid of distinctive character. They make no submission as regards the similarity or identity between the respective goods and services.

7) Further to receipt of the counterstatements the two oppositions were consolidated¹ in light of the identity of the parties and the similar issues to be determined. Both parties filed written submissions only during the evidential rounds. Neither party requested to be heard. I therefore make this decision based on the papers before me giving full consideration to all submissions. I will refer to certain of the parties' submissions as, and when, I consider it appropriate.

DECISION

Section 5(2)(b)

8) This section of the Act provides:

"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,

¹ Under the provision of rule 62(1)(g) of The Trade Marks Rules 2008.

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

9) The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *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 for 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) 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*,

f) 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*,

(g) 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*,

(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; *Sabel BV v Puma AG*,

(i) 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*,

(j) 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*,

(k) 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*,

(l) 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*.

Comparison of goods and services

10) The goods and services to be compared are shown in the table below:

Opponent's goods and services	Applicants' goods and services
<p>Class 25: <i>Clothing, footwear, headgear.</i></p> <p>Class 35: <i>Retail services, including via websites and teleshopping, in relation to clothing, footwear, headgear, sunglasses, precious metals and their alloys and goods in precious metals or coated therewith, jewellery, precious stones, horological and chronometric instruments, leather and imitations of leather, and goods made of these materials.</i></p>	<p>Class 14: <i>Jewellery, costume jewellery, precious stones, goods made of precious metals and their alloys, goods coated with precious metals and their alloys, horological and chronometric instruments, clocks and watches, earrings, rings, badges, buckles, chains, parts and fittings for all the aforesaid goods.</i></p> <p>Class 25: <i>Clothing, footwear, headgear.</i></p> <p>Class 35: <i>Retail and wholesale services connected with the sale of clothing, footwear, headgear, jewellery and costume jewellery, precious stones, goods made of precious metals and their alloys, goods coated with precious metals and their alloys, horological and chronometric instruments, clocks and watches, earrings, rings, badges, buckles, chains, parts and fittings for all the aforesaid goods.</i></p>

11) The leading authorities as regards determining similarity between goods and services are considered to be *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281 ('*Treat*') and *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*

[1999] R.P.C. 117. In the latter case, the CJEU accepted that all relevant factors should be taken into account including the nature of the goods/services, their intended purpose, their method of use and whether they are in competition with each other or are complementary. The criteria identified in the *Treat* case 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.

12) When comparing the respective goods and services, if a term clearly falls within the ambit of a term in the competing specification then identical services must be considered to be in play (see *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM Case T-133/05) ('*Meric*').

13) Whether goods/services are complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), will depend on whether there exists a close connection or relationship such that one is important or indispensable for the use of the other. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T- 325/06 it was stated:

"It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057; Case T-364/05 Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-757, paragraph 94; and Case T-443/05 El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños) [2007] ECR I-0000, paragraph 48)."

14) Further, the General Court ('GC') in *Oakley, Inc v OHIM* T-116/06 ('*Oakley*') stated:

"54. Clearly, in the present case, the relationship between the retail services and the goods covered by the earlier trade mark is close in the sense that the goods are indispensable to or at the very least, important for the provision of those services, which are specifically provided when those goods are sold. As the Court held in paragraph 34 of *Praktiker*

Bauund Heimwerkermärkte, paragraph 17 above, the objective of retail trade is the sale of goods to consumers, the Court having also pointed out that that trade includes, in addition to the legal sales transaction, all activity carried out by the trader for the purpose of encouraging the conclusion of such a transaction. Such services, which are provided with the aim of selling certain specific goods, would make no sense without the goods”

15) The respective goods in class 25, and respective retail services in class 35, are all either self-evidently identical or are identical on the *Meric* principle (bearing in mind, for instance, that the applicant’s ‘retail services connected with the sale of clocks and watches, earrings, rings, badges, buckles, chains...’ falls within the wider ambit of the opponent’s ‘retail services in relation to...goods in precious metals or coated therewith, jewellery...horological and chronometric instruments...’).

16) The applicants’ wholesale services and the opponent’s retail services connected with the sale of the same goods are both essentially concerned with bringing together goods for sale to end consumers. The respective nature, purpose and trade channels are highly similar. There is a high degree of similarity between these services.

17) As to the applicants’ goods in class 14, these are identical to the goods to which the opponent’s retail services relate. The applicants’ goods are therefore indispensable to the opponent’s services; they are complementary as per *Oakley*. However, as the respective goods and retail services do not have the same nature, purpose or method of use,² I conclude that the overall level of similarity is moderate.

Average consumer and the purchasing process

18) It is necessary to consider these matters from the perspective of the average consumer of the goods and services at issue (*Sabel BV v. Puma AG*). The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect, but his/her level of attention is likely to vary according to the category of goods and services.

19) The average consumer for the goods and services at issue in this case is the general public. The specifications before me include clothing. In this connection, I

² In this connection I have borne in mind the following comments in *Oakley*, as regards assessing the similarity between goods and the retail services connected with the sale of said goods:

“47 Indeed – as also pointed out by the Cancellation Division in paragraphs 21 and 22 of the decision of 18 June 2004 – the nature of the goods and services in question is different, because the former are fungible and the latter are not. Their purpose is also different, since the retail service precedes the purpose served by the product and concerns the activity carried out by the trader for the purpose of encouraging the conclusion of the sales transaction for the product in question. So, for example, an item of clothing is intended in particular to clothe the person who purchases it, whereas a service linked to the sale of clothes is intended, inter alia, to offer assistance to the person interested in the purchase of that clothing. The same applies to their method of use, which for clothes means the fact of wearing them, whereas the use of a service linked to the sale of the clothes consists, inter alia, in obtaining information about the clothes before proceeding to buy them.”

note that 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 GC stated:

“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.

...


53. Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing 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.”

20) As stated by the GC, clothing (and, by extension, footwear and headgear) will vary greatly in price. The same can also be said of the applicants’ goods in class 14; an item of costume jewellery, for example, is likely to be far more inexpensive than a platinum diamond ring or a designer watch. Accordingly, the purchase may not always be particularly considered. Nevertheless, bearing in mind that the consumer may wish try on the goods, or to ensure that they are of a preferred colour, size or material (for example), it is likely that at least a reasonable degree of attention is still likely to be afforded, even for those goods which sit at the lower end of the cost scale. The purchasing act will be primarily visual on account of the goods being commonly purchased based on their appearance; they are likely to be selected after perusal of racks/shelves in retail establishments, or from photographs on Internet websites or in catalogues. However, I do not discount aural considerations which may also play a part.

21) Turning to the respective services in class 35, these are also likely to be sought out primarily by the eye whether on the high street or via the internet, for example (although again, I bear in mind the potential for aural use). As for the level of attention that is likely to be paid during the purchase of these services, factors such as the variety or kind of goods stocked, their price and perhaps delivery costs and refund/exchange policies are all likely to lead the consumer to pay, in my view, a reasonable level of attention when selecting such service providers.

Comparison of marks

22) The average consumer normally perceives a mark as a whole and does not proceed to analyse its details. The visual, aural and conceptual similarities 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*). Accordingly, there cannot be an artificial dissection of the marks, although it is necessary to take into account any distinctive and dominant components.

Opponent's mark	Applicants' marks
<p>HOLY</p>	<p>Holy Ghost</p> 

23) The opponent's mark consists of the single word HOLY presented in plain block capitals. There are no dominant elements; the distinctiveness of the mark lies in its totality.

24) The first of the applicants' marks (as shown in the table above) consists of the two words 'Holy Ghost' presented in title case. The words hang together with neither being more dominant than the other; the distinctiveness lies in the mark as whole. On account of the shared word HOLY, there is a moderate degree of visual similarity between the marks. Aurally, as the opponent submits, the first two syllables in the applicants' mark are clearly identical to the only two syllables in the opponent's mark. However, having regard for the vocalisation of the word 'GHOST' in the applicants' mark which is absent from the opponent's mark, this results in no more than a moderate degree of aural similarity. As for the conceptual aspect, the opponent's mark is likely to evoke in the average consumer's mind the general abstract idea of something religious or sacred. Turning to the concept of the applicants' mark, I think

it likely, as submitted by the opponent, and bearing in mind that the UK is well-known to be a predominantly Christian country, that the average consumer in the UK will be aware that the words 'HOLY GHOST' describe the third divine person of the Christian Trinity (the whole trinity being the Father, Son and Holy Ghost). If, however, I am wrong in attributing such knowledge to the average consumer, the applicants' mark will nevertheless conjure the idea of a religious ghost/spirit. Accordingly, I cannot agree with the opponent's contention that the respective marks both convey the broad message and "overarching" concept of "holiness/religion" per se; whilst this is true for the opponent's mark, the applicants' mark evokes the narrower and more specific idea of a certain religious entity. On account of this, I find the level of conceptual similarity to be, on the whole, fairly low.

25) The second of the applicants' marks consists of two distinctive elements; the first is the words HOLY GHOST, which again hang together; the second is the device of a winged cross. Both elements have significant visual impact; to my mind, they share roughly equal dominance. The level of aural similarity between this mark and the opponent's mark is again moderate (the device will not be vocalised). The prominent device element in the applicants' mark is absent from the opponent's mark; this is a clear point of visual contrast. There is also the word 'GHOST' in the applicants' mark which is absent from the opponent's mark. The only point of visual coincidence between the marks is the word HOLY. All things considered, the level of visual similarity is low. In terms of concept, the words 'HOLY GHOST' in the applicants' mark will be perceived in the same manner as in the applicants' other mark but this time that concept is accompanied by the concept of a winged cross. Bearing in mind my earlier conclusions as to the concept portrayed by the opponent's mark, the conceptual similarity between the respective marks is low.

Distinctive character of the earlier mark

26) The distinctive character of the earlier mark must be considered. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). The distinctive character of a trade mark must be assessed by reference to the goods or services for which it is registered and by reference to the way it is perceived by the relevant public (*Rewe Zentral AG v OHIM (LITE)* Case T-79/00 [2002] ETMR 91).

27) As there is no evidence before me, I have only the inherent level of distinctiveness of the opponent's mark to consider.

28) The applicants contend that the opponent's mark is devoid of distinctive character. This submission does not assist the applicants. It is not open to me to conclude that the earlier mark is non-distinctive.³

29) The opponent states:

³ See the decision of the General Court in *Formula One Licensing BV –v- OHIM* (Case T-10/09, paragraph 47), which was later upheld by the CJEU in Case C-196/11 P at paragraphs 39 to 47.

“...HOLY has no inherent link to any of the goods or services for which the Earlier Trade mark is registered. It is neither descriptive nor non-distinctive and should, therefore, be considered a trade mark with at least a normal level of distinctiveness”

I agree. I will approach the global assessment of the likelihood of confusion on the basis that the earlier mark is possessed of a normal (i.e. average) level of distinctiveness.

Likelihood of confusion

30) In deciding whether there is a likelihood of confusion I must take account of all of my earlier findings. I must also keep in mind the following:

- i) the interdependency principle, whereby a lesser degree of similarity between the goods and services may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*);
- ii) the principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and;
- iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

31) I have found certain of the respective goods and services to be similar to a high degree, others to be similar to a moderate degree and the remainder to be identical. As regards application 2643055, the respective marks share a moderate degree of visual and aural similarity and a fairly low degree of conceptual similarity. Application 2643056 shares a moderate degree of aural similarity and a low degree of visual and conceptual similarity with the earlier mark. The average consumer will be the general public who are likely to pay, at least, a reasonable degree of attention during the, mainly visual, purchasing act. The degree of visual similarity is therefore of particular importance in the global assessment of the likelihood of confusion. I must also bear in mind that the earlier mark is possessed of a normal (average) degree of inherent distinctive character.

32) Having weighed all of the above factors against each other, and whilst I keep in mind that certain of the respective goods and services are identical, given that at least a reasonable degree of attention will likely be paid during the mainly visual purchase (militating against imperfect recollection) and that there is only a moderate/low degree of visual similarity between the marks, I consider it unlikely that the consumer will mistake either of the applicants' marks for the opponent's mark or vice versa; there is no likelihood of direct confusion. Furthermore, having regard, in particular, for the fairly low/low degree of conceptual similarity between the respective marks, the average consumer is also unlikely to believe that the respective goods and services emanate from the same or linked undertaking(s) i.e. there is no likelihood of indirect confusion.

The opposition fails.

COSTS

33) The applicants have been successful and, as such, are entitled to a contribution towards their costs. In approaching the award I bear in mind that, although two counterstatements were filed, they were extremely brief and largely identical and further to their receipt, the two cases were consolidated. I award costs to the applicants on the following basis:

Considering the notice of opposition and preparing Form TM8 and counterstatement (x2)	£200
Written submissions:	£300
Total:	£500

34) I order CBM Creative Brands Marken GmbH to pay Howard Scott Egglestone and David Stephen Lister the sum of **£500**. 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 25th day of July 2014

**Beverley Hedley
For the Registrar,
the Comptroller-General**