

O-108-15

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION NO. 1186316
BY START TODAY CO., LTD.
IN RESPECT OF THE TRADE MARK:**



**AND
OPPOSITION THERETO (NO. 402120)
BY WE BRAND S.A.R.L.**

THE BACKGROUND AND THE PLEADINGS

1) Start Today Co., Ltd. (“Start”) is the holder of an international registration (“IR”) numbered 1186316. Start designated the UK for protection of its IR on 12 July 2013. The IR has an international priority date of 13 June 2013 and was published in the Trade Marks Journal on 7 February 2014. The trade mark is shown below:



Protection is sought for goods and services in classes 9, 14, 18, 25, 35 and 42. They are listed in the Annex to this decision

2) On grounds under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) WE Brand S.a.r.l. (“WE Brand”) opposes protection of the IR in the UK in respect of the following goods and services:

Class 9: Spectacles (eyeglasses and goggles); sunglasses.

Class 14: All goods

Class 18: All goods

Class 25: All goods

Class 35: All services

3) For the purposes of its claim the Opponent relies on the following Community trade marks (“CTMs”) and the following goods and services respectively covered by them:

CTM no. 11312667, filed on 1 November 2012 and registered on 1 April 2013:



Class 9: Spectacles including sunglasses; spectacle frames; cases and containers for spectacles.

Class 14: Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments including watches.

Class 35: Advertising; business management; business administration; office functions; retail business services and the bringing together of cosmetics,

perfumery, glasses, jewellery, leather products, clothing and clothing accessories and shoes, for the benefit of third parties in order to give consumers the possibility to examine and buy these products; sale promotion; business mediation in the purchase and sale of products; business mediation services in the trading of products to wholesalers; office functions in the field of drafting and closing of franchise agreements regarding the before mentioned services; the aforesaid services also offered via electronic channels, including the Internet.

CTM no. 7209571 filed on 3 September 2008 and registered on 22 June 2010 for the word mark:

WE

Class 3: Soaps, perfumery, essential oils, cosmetics, hair lotions.

Class 9: Spectacles including sunglasses; spectacle frames; cases and containers for spectacles.

Class 14: Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments including watches.

Class 18: Leather and imitations of leather, and goods made of these materials and not included in other classes; umbrellas and parasols; trunks and travelling bags; bags not included in other classes.

Class 25: Clothing, footwear, headgear.

Class 35: Business mediation in the purchase and sale, including within the framework of retailing, of soaps, perfumery, essential oils, cosmetics, hair lotion, eyewear, including sunglasses, optical frames, cases and containers for spectacles, precious metals and their alloys and products made from the aforesaid materials or coated therewith, jewellery, costume jewellery, precious stones, clocks and chronometrical instruments, including watches, leather and imitation leather and products made from the aforesaid materials, umbrellas and parasols, trunks and suitcases, bags, clothing, footwear, headgear; the aforesaid services also offered via electronic channels, including the internet.

4) Both marks relied on by the Opponent constitute “earlier trade marks” for the purposes of section 5(2)(b) of the Act. Since the registration procedure for both earlier marks was completed during the period of five years ending with the date of publication of the opposed mark, the proof of use provisions in section 6A of the Act do not apply in respect of either of the earlier marks.

5) Start filed a notice of defence and counterstatement, denying the grounds of opposition. Neither side filed evidence. Both filed written submissions. Neither requested a hearing. I therefore give this decision after a careful review of all the papers before me.

SECTION 5(2)(b)

6) Section 5(2)(b) of the Act reads as follows:

“5(2) A trade mark shall not be registered if because – [...]

(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”.

The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

(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 be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great 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 creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of the goods/services

7) In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“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”.

The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

a) The respective users of the respective goods or services;

b) The physical nature of the goods or acts of services

c) The respective trade channels through which the goods or services reach the market

d) 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;

e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

8) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05 (“*Meric*”), the General Court stated that:

“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 trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

9) In relation to understanding what terms used in specifications mean and cover, the guidance in the case-law is to the effect that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade”¹ and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning². I also note the judgment of Mr Justice Floyd in *YouView TV Limited v Total Limited* where he stated:

“..... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IPTRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of "dessert sauce" did not include jam, or because the ordinary and natural description of jam was not "a dessert sauce". Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

10) *Boston Scientific Ltd v Office for Harmonization in the Internal Market* (Trade Marks and Designs) (OHIM) Case T- 325/06 provides guidance on when goods are to be regarded as complementary:

“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).”

11) In *Oakley, Inc v OHIM*, Case T-116/06 (“*Oakley*”), at paragraphs 46-57, the General Court held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore

¹ See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

² See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

similar to a degree. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of *BOO!* for handbags in Class 18 and shoes for women in Class 25 and use of *MissBoo* for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘similar’ to goods are not clear cut.”

However, on the basis of the European courts’ judgments in *Sanco SA v OHIM*³, and *Assembled Investments (Proprietary) Ltd v. OHIM*⁴, upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd*⁵, Mr Hobbs concluded that:

- Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer’s point of view, they are unlikely to be offered by one and the same undertaking;
- In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent’s goods and then to compare the opponent’s goods with the retail services covered by the applicant’s trade mark;
- It is not permissible to treat a mark registered for ‘retail services for goods X’ as though the mark was registered for goods X;
- The General Court’s findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party’s trade mark was registered (or proposed to be registered).

In *Frag Comercio Internacional, SL, v OHIM*, Case T-162/08, the General Court held that a registration for ‘retail services’, which did not identify the kinds of goods covered by the services, was too vague to permit a proper comparison to be made

³ Case C-411/13P

⁴ Case T-105/05, at paragraphs [30] to [35] of the judgment

⁵ Case C-398/07P

between those services and the goods covered by the later mark. It was not therefore possible to determine that the respective services and goods were similar.

12) In its final submissions Start accepts in general terms that some of the competing goods and services are identical or similar. However, it is not fully explicit about precisely which goods are agreed to be identical and about the degrees of similarity of the other goods covered. It is therefore appropriate for me to provide a more explicit assessment on these points. I will now go through the classes applied for and the goods and services covered by them.

Class 9

13) The only goods opposed in class 9 are *spectacles (eyeglasses and goggles); sunglasses*. Start's specification includes *eyeglasses and goggles* under *spectacles*, which fall within the ambit of WE Brand's *spectacles including sunglasses* contained in both earlier marks, and are identical under the guidance in *Meric*. Goggles are in any case highly similar to spectacles owing to strong overlap in function, providers, users and channels of trade.

14) In classes 14, 18 and 25 I shall make my comparison on the basis of the goods covered by CTM 7209571, since CTM 11312667 offers WE Brand no advantage over CTM 7209571 in these classes. I will, of course, revisit the position on the basis of CTM 7209571 if it becomes necessary to do so.

Class 14

15) The closest goods covered by the earlier mark are its goods in class 14 which are:

Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments including watches.

16) The earlier mark's *Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes* covers the following applied for goods, which are therefore identical: *insignias of precious metal; badges of precious metal; shoe ornaments of precious metal. Keyrings (trinkets or fobs); trophies (prize cups); commemorative shields; tie clips; tie pins; medals; cuff links* may all be made of, or coated with, precious metals or their alloys and thus, falling within the ambit of *goods in precious metals or coated therewith, not included in other classes*, be identical. Even when they are not made of, or coated with, precious metals or their alloys, they have the same basic nature, are offered through the same channels of trade, to the same consumers, for the same purpose, and are highly similar to *goods in precious metals or coated therewith, not included in other classes* because this includes the precious metal equivalents of the applied for goods.

17) The earlier mark's *Jewellery* covers the following applied for goods, which are therefore identical: *threads of precious metal (jewellery, jewelry (Am.)); jewellery made of coral; pearls (jewellery, jewelry (Am.)); artificial gemstones; diamonds; opal;*

jade (jewellery); jasper; agates; ruby; ornaments (jewellery, jewelry (Am.)); bonnet pins of precious metal (jewellery); jewellery cases; earrings; necklaces (jewellery, jewelry (Am.)); bracelets (jewellery, jewelry (Am.)); pendants; gem brooches; rings (jewellery, jewelry (Am.)); lockets (jewellery, jewelry (Am.)); crystal jewellery.

18) The earlier mark's *precious stones* covers the following applied for goods, which are therefore identical: *unwrought and semi-wrought precious stones; emerald; topaz; olivine (peridot); chalcedony; sapphire.* The applied for *imitations of unwrought and semi-wrought precious stones* have the same basic purpose and use as *precious stones* and are sold largely to the same consumers, through the same channels of trade; they are highly similar.

19) The earlier mark's *Horological and chronometric instruments including watches* covers the following applied for goods, which are therefore identical: *wristwatches; table clocks; pocket watches; automobile clocks; stopwatches; wall clocks; alarm clocks.* The applied for *Watch and clock springs; cases for clock and watchmaking; watch chains; watch glasses; straps for wristwatches; clock hands (clock and watch making); pendulums (clock and watch making); dials (clock and watch making)* are all used not only in the manufacture of, but are also provided for the repair and maintenance of, watches and clocks; they are complementary to, and offered through the same channels of trade, and to the same consumers as, *horological and chronometric instruments including watches*, to which they are highly similar.

Class 18

20) The closest goods covered by the earlier mark are for the most part its goods in class 18 which are:

Leather and imitations of leather, and goods made of these materials and not included in other classes; umbrellas and parasols; trunks and travelling bags; bags not included in other classes.

21) The earlier mark's *leather and imitations of leather, and goods made of these materials and not included in other classes* covers the following applied for goods, which are therefore identical: *industrial packaging containers of leather; commutation card cases [leatherware]; leather (unworked or semi-worked).* The applied for *card cases (notecases); purses; key cases; money pouches; business card cases; vanity cases, not fitted* may all be made of leather or imitation leather, and thus fall within the ambit of *leather and imitations of leather, and goods made of these materials and not included in other classes*; they are thus identical. Even where these goods are not made of real or imitation leather, they have the same basic nature, are offered through the same channels of trade, to the same consumers, for the same purpose, and are highly similar to *goods made of these materials and not included in other classes* because this includes the leather or imitation leather equivalents of the applied for goods. This high similarity is shared by *fur (unworked or semi-worked)* which is also offered through the same channels of trade, to the same consumers, for the same purpose.

22) The earlier mark's *trunks and travelling bags* covers the following applied for goods, which are therefore identical: *Gladstone bags; Japanese wicker trunks (Kori); suitcases; carry-on bags; trunks; handbags; Boston bags*. The earlier mark's *Bags not included in other classes*, covers the following applied for goods, which are therefore identical: *Bags; folding briefcases; shoulder bags; Gladstone bags; briefcases; carry-on bags; handbags; Boston bags; schoolchildren's backpacks; rucksacks; pouches; charm bags (Omamori-ire); shopping bags (including "wheeled shopping bags")*.

23) The earlier mark's *umbrellas and parasols* covers the following applied for goods, which are thus identical: *umbrellas; telescopic umbrellas; Japanese paper umbrellas (Karakasa); Japanese oiled-paper umbrellas (Janome-gasa); rainproof parasols; beach umbrellas (beach parasols); parasols (sun umbrellas)*. The applied for mark's *umbrella covers; umbrella handles; metal parts of umbrellas; frames for umbrellas; bags for umbrellas* are complementary to, and may be offered through the same channels of trade to the same consumers as *umbrellas and parasols*; they are highly similar. That leaves the applied for *walking sticks; canes; metal parts of canes and walking-sticks; walking cane handles* which are not of the same nature, do not serve the same purpose, and are not in competition with, or complementary to, *umbrellas and parasols*. There may be some overlap in consumers, but I have no information as to trade channels. There is only a low degree of similarity between these goods and *umbrellas and parasols*.

24) The closest match to the applied for *clothing for domestic pets* is the earlier mark's *clothing* in class 25. Apart from the obvious difference in end users, *clothing* in class 25 and *clothing for domestic pets* share the same function, purpose and purchasers, and channels of trade may overlap, pet owners often liking to assimilate their pets' needs to their own. There is high similarity between the earlier mark's *clothing* and clothing for pets.

Class 25

25) The closest goods covered by the earlier mark are its goods in class 25 which are:

Clothing, footwear, headgear.

Since all the goods applied for fall into one or other of the categories *clothing, footwear* or *headgear*, they are identical with the earlier goods.

Class 35

Comparison on the basis of earlier mark CTM 7209571

26) I shall begin my comparison of the class 35 services by comparing the goods and services of the earlier mark CTM 7209571 with the applied for services, and then continue the comparison on the basis of the earlier CTM 11312667, where it provides the better case. The closest services covered by CTM 7209571 are its services in class 35 which are:

Business mediation in the purchase and sale, including within the framework of retailing, of soaps, perfumery, essential oils, cosmetics, hair lotion, eyewear, including sunglasses, optical frames, cases and containers for spectacles, precious metals and their alloys and products made from the aforesaid materials or coated therewith, jewellery, costume jewellery, precious stones, clocks and chronometrical instruments, including watches, leather and imitation leather and products made from the aforesaid materials, umbrellas and parasols, trunks and suitcases, bags, clothing, footwear, headgear; the aforesaid services also offered via electronic channels, including the internet.

The earlier mark's *business mediation in the purchase and sale, including within the framework of retailing, of [the specified goods], the aforesaid services also offered via electronic channels, including the internet* involves services offered by an intermediary for bringing businesses together for the purchase and sale of goods. Sometimes, for example, the intermediary may act as a purchasing agent or broker for a business customer; more usually, the intermediary may act as a selling agent or broker for a business principal. These are not services provided by retail or wholesale operators. The difference is that in the case of business mediation the mediator is acting as an agent or broker, whereas in wholesale and retail dealings the parties deal direct. Moreover, retail transactions involve end customers rather than agreements between businesses in the chain of supply. None of the applied for *retail and wholesale services*, therefore, fall within the ambit of the class 35 services of the earlier mark, and so are not identical.

27) Both *business mediation in the purchase and sale* of specified goods and *wholesale services* in respect of those goods involve the negotiation of contracts for the purchase and sale of goods between businesses. In either case the ultimate commercial object of the service is that the business customer acquires the relevant goods. However the user of wholesale services is the business customer. The user of the services of a selling agent is the seller. A business might seek to source its goods by buying them from a wholesaler or by commissioning a purchasing agent or broker to purchase them for it, so there is some potential for overlap in users. In this case, however, the nature of the service and the method of use would be different. Buying from a wholesaler involves the buyer in comparing information on the products and deals available from that wholesaler and then acquiring the goods direct from the wholesaler. Buying through a purchasing agent or broker involves briefing that intermediary on the purchaser's requirements and commissioning the intermediary to source products from a third party. Although there is potential for some overlap of users in some cases, users of business mediation services and wholesaling services will routinely be different, and channels of trade, purpose and method of use are all different. There is not more than a low degree of similarity between the earlier mark's business mediation services and the applied for wholesale services and even less with the applied for retail services, which do not involve transactions with end consumers rather than businesses.

28) Nor can there be more than low similarity at best between *business mediation in the purchase and sale* of specified goods and the goods themselves, insofar as these are reflected in the specification of the applied for mark in classes 14, 18 and 25. They differ in nature, purpose and method of use, market sector, the consumers they are directed at and the kind of operators providing them. They are not in

competition with each other. Unlike wholesalers and retailers, business intermediaries in the purchase and sale of specified goods are not directly involved in the supply of those goods; they simply provide access to those who do supply them. Any arguable complementarity between these services and the goods ultimately supplied is therefore far weaker than in the case of wholesale or retail services.

29) With regard to the following services, both wholesale and retail, of the applied for mark, the closest comparison is offered by the class 18 and class 3 goods of CTM 7209571. On the principles in *Oakley* there is a medium degree of similarity between the applied for mark's *retail and wholesale services connected with the sale of umbrellas* and the earlier mark's class 18 goods *umbrellas*: retailing and wholesaling of the goods does not share nature, intended purpose or method of use with the goods themselves; however, they are indispensable for the respective retail and wholesale services; they are complementary to the services and share channels of trade. I have already found only a low degree of similarity between *walking sticks; canes; metal parts of canes and walking-sticks; walking cane handles* and *umbrellas*. There cannot be sufficient complementarity between the earlier mark's class 18 goods *umbrellas* and the applied for *retail and wholesale services connected with the sale of ferrules of metal for walking sticks, canes, metal parts of canes and walking-sticks, walking stick handles* to give rise to anything more than a very low level of similarity.

30) On the principles in *Oakley* there is a medium degree of similarity between the applied for mark's *retail and wholesale services connected with the sale of toiletries* and the earlier mark's class 3 goods *soaps, perfumery, essential oils, hair lotion*. Other *retail services connected with the sale of toiletries* covered by the applied for mark, including the explicitly mentioned *dentifrices, soaps*, being supplied to the same consumers for the same basic purpose through the same channels of trade, are of average similarity to the goods of the earlier mark's class 3 specification. Although soaps are used predominantly for personal cleansing, there is a considerable overlap in function, purpose, consumers and channels of trade with detergents. There is therefore also a medium degree of similarity between the applied for *retail and wholesale services connected with the sale of detergents* and the earlier mark's *soap*. The earlier mark's *essential oils* are oils containing essences used, for example, in toiletries and cosmetics. The baby oils the subject of the applied for *retail and wholesale services connected with the sale of baby oils* are specially formulated as an emollient to prevent chafing and irritation of the highly sensitive skin of babies. Nature, purpose, method of use, and user thus differ, though purchasers may overlap (parents may purchase toiletry and cosmetic products with essential oils for their own personal use, and baby oils for use on their babies). The products are not complementary or in competition, so there is even greater difference with the applied for retail and wholesale services. There is therefore not more than low similarity between the earlier mark's essential oils and the applied for *retail and wholesale services connected with the sale of baby oils*.

Comparison on the basis of earlier mark CTM 11312667

31) The earlier mark's *advertising, the aforesaid services also offered via electronic channels, including the Internet* covers, and is therefore identical with, the applied for

internet advertising; advertising by electronic mail; providing information about advertising inserted in the paper and magazines for commercial purposes; providing of advertising spaces on the Internet included in this class; advertising services; organization of exhibitions for advertising purposes on the Internet. The applied for *publicity services; publicity material rental* can be included in advertising services; they are in any case closely related to, and complementary to, the earlier mark's *advertising*. They are identical or highly similar.

32) The earlier mark's *business management, the aforesaid services also offered via electronic channels, including the Internet* covers, and is therefore identical with, the applied for *business management of a shopping centre or a shopping mall*. The earlier mark's *business administration, the aforesaid services also offered via electronic channels, including the Internet* covers, and is therefore identical with, the applied for *business administration of a shopping centre or a shopping mall*. The earlier mark's *office functions, the aforesaid services also offered via electronic channels, including the Internet* covers, and is therefore identical with, the applied for *data search in computer files for others*. The applied for *business management analysis or business consultancy and business consultancy for providers of on-line retail store services on the Internet* are highly similar to the earlier mark's *business management*; the purpose, users and providers of these services will strongly coincide.

33) The earlier mark's *retail business services and the bringing together of cosmetics for the benefit of third parties in order to give consumers the possibility to examine and buy these products* covers, and is therefore identical with the applied for *retail services connected with the sale of cosmetics*.

34) The earlier mark's *retail business services and the bringing together of glasses for the benefit of third parties in order to give consumers the possibility to examine and buy these products* covers and is identical with the applied for *retail services connected with the sale of spectacles, eyeglasses*. The applied for specification also covers *goggles*. These are worn to protect the eyes during potentially hazardous activities or sports such as skiing or swimming. Although spectacles and glasses are for the most part not in competition with goggles, there is an overlap in this protective function. Both may be offered by specialist retailers and the average consumer will be used to finding them provided by the same retailer. Users, purpose and channels of trade in the respective retail services overlap. There is a high degree of similarity between the earlier mark's *retail business services and the bringing together of glasses for the benefit of third parties in order to give consumers the possibility to examine and buy these products* and the applied for *retail services connected with the sale of goggles*.

35) The earlier mark's *retail business services and the bringing together of jewellery for the benefit of third parties in order to give consumers the possibility to examine and buy these products* covers, and is therefore identical with the applied for *retail services connected with the sale of jewellery ornaments, earrings, necklaces, rings (jewellery), bracelets (jewellery), jewellery chains, jewellery charms, key rings, jewellery trinkets*. *Retail services connected with the sale of unwrought and semi-wrought precious stones and their imitations* have the same basic purpose and use as the earlier mark's *retail business services and the bringing together of jewellery*

and are sold to the same consumers, through the same channels of trade; they are highly similar.

36) In addition to their time-keeping function, clocks and watches serve an ornamental purpose which they share with jewellery, and are therefore traditionally sold through the same retail outlets. Use and purpose overlap, users and channels of trade are the same. The earlier mark's *retail business services and the bringing together of jewellery for the benefit of third parties in order to give consumers the possibility to examine and buy these products* is therefore highly similar to the applied for *retail services connected with the sale of clocks, watches*.

37) Bags and pouches are routinely made of leather. The earlier mark's *retail business services and the bringing together of leather products* covers, and is therefore identical with the applied for *retail and wholesale services connected with the sale of bags and pouches, trunks*. Even where bags and pouches are not made of leather the retail services connected with them have the same basic nature, and are offered through the same channels of trade, to the same consumers, for the same purpose; thus there is high similarity between *retail business services and the bringing together of leather products* and the applied for *retail and wholesale services connected with the sale of bags and pouches, trunks*.

38) The earlier mark's *retail business services and the bringing together of clothing and clothing accessories and shoes for the benefit of third parties in order to give consumers the possibility to examine and buy these products* covers, and is therefore identical with, the applied for *retail services connected with the sale of clothing, footwear, stocking suspenders, sock suspenders, suspenders for clothing, expanding bands for holding sleeves, belts for clothing, badges for wear, buckles for clothing, brooches for clothing, Japanese buckles to bind a broad belt of kimonos (Obidomes), bonnet pins, ornamental emblems attachable on clothing (Wappens), brassards, hoods for clothing*. The earlier mark's *retail business services and the bringing together of clothing* covers, and is therefore identical with, the applied for *retail services connected with the sale of clothing for pets*. The earlier mark's *retail business services and the bringing together of clothing and clothing accessories and shoes* and the applied for *retail services connected with the sale of headgear* are both aimed at the retail of highly similar goods which may be purchased because they contribute to a "look". They may be offered by specialist retailers, such as clothes retailers as well as major retail establishments. The average consumer will be well used to finding the retailing of these goods provided by the same retailer, in fairly close proximity (in the case of online retailing, in associated categories). There is a high degree of similarity between the earlier mark's *retail business services and the bringing together of clothing and clothing accessories and shoes* and the applied for *retail services connected with the sale of headgear*.

39) In paragraphs 33 to 38 above I have found identity or high similarity between the earlier mark's *retail business services* in respect of various specific goods and the applied for *retail services connected with the sale of goods* which I have found to correspond to them. Wholesale services as such differ in the level of distribution, and users are businesses. However in the modern market environment for such consumer goods (including online) there is scope for considerable overlap of users and channels of trade. Consumers will not be surprised to find wholesaling and

retailing of these goods provided by the same or associated undertakings. In both cases the nature and purpose of the service is to supply the specific goods in question. Accordingly, where in paragraphs 33 to 38 above I have found identity or high similarity between the earlier marks *retail business services* in respect of specific goods and the applied for *retail services connected with the sale of goods* which I have found to correspond to those goods, I also make a parallel finding of high similarity between the earlier marks *retail business services* in respect of the same specific goods and the applied for *wholesale services connected with the sale of the relevant corresponding goods*.

40) The earlier mark's *sale promotion, the aforesaid services also offered via electronic channels, including the Internet* covers, and is therefore identical with, the applied for *sales promotion for others on the Internet; organization of fashion shows for promotional purposes; organization of exhibitions for commercial purposes on the Internet; promoting the goods and services of others through the operation of customer loyalty and incentive schemes by means of trading stamps*. Research of the relevant market is normally an important component of sales promotion; in any case, purpose and users are the same, and it will often be offered by the same providers. The earlier mark's *sale promotion, the aforesaid services also offered via electronic channels, including the Internet* is therefore identical, or at least highly similar, to the following applied for services: *marketing research on public estimation of retail stores; marketing research; information relating to rankings on sales; information relating to retail stores via the global computer network; providing information on sales relating to clothing, bags and jewellery; providing information relating questionnaire surveys and providing information concerning commercial sales*.

41) The earlier mark's *business mediation in the purchase and sale of products, the aforesaid services also offered via electronic channels, including the Internet* covers, and is therefore identical with, the applied for *arranging of buying and selling contracts for third parties on an on-line shopping mall; arranging and providing information of buying and selling contracts in digital commerce; mediation and conclusion of commercial transactions for others; mediation and conclusion of commercial transactions by telecommunication or the electronic way for others*.

42) There is some overlap in users between the earlier mark's *business mediation in the purchase and sale of products, the aforesaid services also offered via electronic channels, including the Internet* and the applied for *auctioneering provided on the Internet; providing information on sales relating to auction* and their purpose is to facilitate the purchase and sale of goods by third parties, but this is at a very general level of similarity. Providers and method of use are different, and the nature of the auctioneering process, including on the internet, is a very distinct and singular one. Bearing in mind that specifications for services should be scrutinised carefully, and confined to the substance rather than given a wide construction covering a vast range of activities⁶, there is only a low degree of similarity between the earlier mark's *business mediation in the purchase and sale of products, the aforesaid services also*

⁶ See the observations of Jacob J. (as he then was) in *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16.

offered via electronic channels, including the Internet and the applied for auctioneering provided on the Internet; providing information on sales relating to auction.

43) The applied for *providing employment information* is a service one would normally expect to find in the context of recruitment, personnel or career advisory services. It is not similar to any of the services of the earlier mark.

44) None of the services listed under Class 35 for CTM 7209571 or CTM 11312667 provide anything more than a low degree of similarity with any of the following services of Start's specification, and in many cases there is no similarity at all; nor do any of the other goods or services of CTM 7209571 or of CTM 11312667 offer a better case: *retail and wholesale services connected with the sale of woven fabrics and beddings, personal articles, combs, face towels of textile, handkerchiefs of textile, towels of textile, hand-held flat fans, hair bands, buttons, false nails, false eyelashes, shaving utensils cases, pedicure sets, eyelash curlers, manicure sets, ear picks, toilet cases, cosmetic utensils, false beards, ornamental beards, ornamental moustaches, hand implements for hair curlers, ferrules of metal for walking sticks, canes, metal parts of canes and walking-sticks, walking stick handles, foods and beverages, liquor, meat, sea food, vegetables and fruits, confectionery, bread and buns, rice and cereals, milk, carbonated drinks, refreshing beverages, non-alcoholic fruit juice beverages, tea, coffee, cocoa, processed food, two wheeled motor vehicles, bicycles, furniture, joinery fittings, tatami mats, electrical machinery and apparatuses, lighting apparatus, household electrothermic appliances, bladed or pointed hand tools, hand tools, hardware of metal, kitchen equipment, cleaning tools and washing utensils, pharmaceutical, veterinary and sanitary preparations and medical supplies, agricultural machines, agricultural implements and supplies, natural flowers and trees, printed matter, paper and stationery, sports goods, toys, dolls, game machines and apparatus, musical instruments and records, pre-recorded DVDs, tobaccos, smokers' articles, chains for dogs, clothing for pets, beds for household pets, dog kennels, nesting boxes for small birds, feeding vessels for pets, brushes for pets, chewing goods for pet dogs, indoor aquaria and their fittings, bird cages, bird baths, toys for domestic pets, foods for pets, teething rings, babies' bottles, baby carriages, babies' diapers of paper.*

The average consumer and the purchasing process

45) The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97. In Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:*

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the

relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

46) The average consumer for all of the goods of both WE Brand’s and Start’s specifications will be the general public, though for some goods the average consumer will include both the general public and businesses. The average consumer of some of the parties’ class 35 services, for example retail services, consists of the general public. Other services, such as business management and sales promotion, are aimed exclusively at businesses.

47) Clothing, footwear, cosmetics and the like are bought regularly. Items such as spectacles, clocks and suitcases will also be fairly routine (although not frequent) purchases for any household. The goods concerned are not specialist ones and, although their cost can vary, they are not, generally speaking, highly expensive purchases. Overall, consumers will normally pay a reasonable degree of attention, neither higher nor lower than the norm, when selecting the goods or an appropriate retail service provider for them. Jewellery can range from ordinary, relatively inexpensive items of everyday wear to very expensive and infrequent purchases. Whilst the average consumer of expensive jewellery will likely pay higher attention to the selection of an appropriate retailer, the position must also be considered from the perspective of more ordinary jewellery for which there will be just a reasonable degree of care and attention in the selection of an appropriate retailer. For goods such as unwrought and semi-wrought precious stones and their imitations there is an obvious business market, but there will be some private consumers too, and the spectrum of business customers for all the goods and services will include small businesses.

48) The purchasing of all these goods, and the selection of the wholesale or retail outlet through which they are purchased, and of the other class 35 services, including in an online context, is a predominantly visual process, so visual aspects of the marks take on more importance; but there may be some scope for aural use of the mark, so aural aspects will not be overlooked in my comparison of the marks.

The distinctiveness of the earlier marks

49) The degree of distinctiveness of the earlier marks must be assessed. This is because the more distinctive the earlier mark (on the basis either of inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in *Joined*

Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

50) Since no evidence has been filed, there is only the question of inherent distinctiveness to be considered. The word WE is an ordinary word with a well-known meaning, but not one which is descriptive or allusive of any of the goods of the earlier marks. As such it has a normal degree of inherent distinctive character in the word mark, CTM 7209571. The stylisation of the word in CTM 11312667, while not completely negligible, does not add greatly to its inherent distinctiveness. It too has a normal degree of inherent distinctive character.




Comparison of the marks

51) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

It would be wrong, therefore, to dissect the trade marks artificially, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

52) The marks to be compared are shown below:

Start's IR 1186316	WE Brand's CTM 11312667	WE Brand's CTM 7209571
		

Start's mark consists of the letters WE appearing above the letters AR, so as to form a square configuration, all shown in heavy block capitals, and surrounded by a thin line forming a square border with rounded corners. The border plays only a minor (but not negligible) role in the overall impression of the mark. In its submissions Start suggests that the four letters of its mark may be "viewed in the order of W,E, A and R, or W,A,R and E, or W,E,R and A". I cannot agree. The average consumer will not "unpack" the mark to the extent suggested by Start, but will read the text in the way in which it is normally read in English, left to right, top line first. The configuration of the mark sharply divides it into two lines and, though neither dominates the other, this militates against their being read continuously as one word. In terms of the mark's meaning and significance, the average consumer will normally look to attach a meaning to something he/she sees, so will likely regard WE as the word WE rather than simply letters. AR is not a known word, so some consumers may see AR simply as those two letters; however, some may see AR as an approximation of the word ARE (for example, as a quirky spelling of that word) creating the phrase WE ARE.

53) WE Brand's CTM 7209571 consists of the plain word mark WE. That is the only thing that contributes to its overall impression. We Brand's CTM 11312667 consists of the letters WE stylised as heavy, rectangular capital letters with rounded corners at the bottom left-hand corner of the W and top left-hand corner of the E. Whilst the stylisation is not completely negligible, the word WE takes on much more significance in the overall impression. In both cases, the average consumer will not analyse WE in the marks into its constituent letters, but will perceive it as consisting of the first person plural personal pronoun.

54) For the sake of simplicity I shall begin by comparing Start's mark with CTM 7209571. I bear in mind that since the earlier mark is a word mark, notional and fair use of it would include use in a script comparable to that of Start's mark. The prominent positioning of WE as the first line of the Start mark, occupying its upper half, constitutes an obvious point of visual similarity. There is, though, an obvious point of difference owing to the addition of AR. The border also creates a visual difference, but one which has less significance given the minor role it plays in the overall impression. This all results in a medium degree of visual similarity with WE Brand's mark overall.

55) WE will be pronounced identically in both marks as the first person plural personal pronoun. The average consumer may pronounce the second line in Start's

mark as the two individual letters A and R, thus adding two further syllables, or phonetically to sound like the word “are”, thus adding one further syllable. In either case, this introduces an element of aural dissimilarity with WE Brand’s mark. In either case, however, I consider that the initial identically pronounced WE of Start’s mark produces a medium degree of aural similarity with WE Brand’s mark overall.

56) The square configuration of Start’s mark has no obvious conceptual significance. The first line of text, WE, exactly coincides conceptually with the sole element comprising WE Brand’s mark, and, as already observed, will be perceived as the first person plural personal pronoun. Where the average consumer pronounces the AR line in Start’s mark as the two individual letters A and R, it will have no conceptual content capable of being immediately grasped beyond that of being individual letters. Overall, there will be a medium degree of conceptual similarity between the competing marks. Where the AR is pronounced phonetically, it could be perceived as a quirky spelling of the word “are”, thus adding a further conceptual element, and thus some conceptual difference in relation to WE Brand’s mark. However, there remains a moderate to medium degree of conceptual similarity between the competing marks overall.

57) The comparison I have made above also basically applies to CTM 11312667, but with the following qualification regarding the visual comparison. I have already noted the stylisation of the letters WE in the CTM This stylisation does add a further difference from Start’s mark in the visual comparison. However, in view of the presentation of the letters of Start’s mark in heavy block capitals, the difference is not a very striking one. Even bearing in mind the element of stylisation, I think there remains a medium degree of visual similarity between Start’s mark and CTM 11312667.

Likelihood of confusion

58) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

59) I have found identity or a high degree of similarity between some of the competing goods/services. I focus on these to begin with. I have found a medium degree of visual and aural similarity and a moderate to medium degree of conceptual similarity between the competing marks. I have found that the earlier mark has a normal degree of distinctive character, and that Start’s mark is dominated by its two lines of text. Taking into account my findings on the average consumer and the purchasing process, I consider that the overall difference between the marks is too great for them to be confused directly with one another, even in respect of identical goods. Turning to the question of indirect confusion, I have found that WE will be seen in both marks as the first person singular pronoun, and that AR may be perceived as a variant of “are” or as consisting simply of its letters. When considering indirect confusion I must bear in mind that if AR is perceived as a quirky

spelling of the word “are”, the text of Start’s mark can be seen as forming the complete phrase “we are”. However, a strong and marked feature of Start’s mark is, as I have already remarked, its sharp visual division of its textual components into WE and AR. In view of this stark division I consider that, whether AR is perceived as a variant of “are” or simply as the letters AR, where the goods and services concerned are identical or highly similar, the prominence of the distinctive WE in Start’s mark gives rise to a likelihood that the public will believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings. There is therefore a likelihood of indirect confusion. Where the relevant goods and services are less than identical or highly similar (as assessed by me earlier), the overall difference between the marks, together with the distance between the goods/services, will be sufficient for the inclusion of WE to be seen as no more than a coincidence.

OUTCOME

60) The opposition has succeeded in respect of the following goods/services of the application which were opposed, in respect of which I have found a likelihood of confusion:

Class 9: spectacles (eyeglasses and goggles); sunglasses;

Class 14

Unwrought and semi-wrought precious stones and their imitations; emerald; topaz; olivine (peridot); threads of precious metal (jewellery, jewelry (Am.)); chalcedony; sapphire; jewellery made of coral; pearls (jewellery, jewelry (Am.)); artificial gemstones; diamonds; opal; jade (jewellery); jasper; agates; ruby; keyrings (trinkets or fobs); jewellery cases; trophies (prize cups); commemorative shields; ornaments (jewellery, jewelry (Am.)); earrings; insignias of precious metal; badges of precious metal; bonnet pins of precious metal (jewellery); tie clips; tie pins; necklaces (jewellery, jewelry (Am.)); bracelets (jewellery, jewelry (Am.)); pendants; gem brooches; medals; rings (jewellery, jewelry (Am.)); lockets (jewellery, jewelry (Am.)); cuff links; shoe ornaments of precious metal; wristwatches; table clocks; pocket watches; automobile clocks; stopwatches; wall clocks; alarm clocks; watch and clock springs; cases for clock and watchmaking; watch chains; watch glasses; straps for wristwatches; clock hands (clock and watch making); pendulums (clock and watch making); dials (clock and watch making); crystal jewellery.

Class 18

Industrial packaging containers of leather; clothing for domestic pets; bags; folding briefcases; shoulder bags; Gladstone bags; Japanese wicker trunks (Kori); briefcases; suitcases; carry-on bags; trunks; handbags; Boston bags; schoolchildren's backpacks; rucksacks; pouches; charm bags (Omamori-ire); card cases (notecases); shopping bags (including "wheeled shopping bags"); purses; key cases; money pouches; purses; commutation card cases [leatherware]; business card cases; vanity cases, not fitted; umbrellas; telescopic umbrellas; Japanese paper umbrellas (Karakasa); Japanese oiled-paper umbrellas (Janome-gasa); rainproof parasols; beach umbrellas (beach parasols); parasols (sun umbrellas); umbrella covers; umbrella handles; metal

parts of umbrellas; frames for umbrellas; bags for umbrellas; leather and fur (unworked or semi-worked).

Class 25

Clothing; non-Japanese style outerclothing; coats; jackets; pants; trousers; vests; sweaters; shirts; nightwear; underwear (underclothing); swimwear (bathing suits); swimming caps (bathing caps); camisoles; jerseys; knitwear; skirts; T-shirts; parkas; Japanese traditional clothing; sleep masks; aprons (clothing); collar protectors (for wear); socks and stockings; shawls; scarves (scarfs); gloves and mittens (clothing); neckties; bandanas (neckerchiefs); mufflers; ear muffs (clothing); hoods (clothing); nightcaps; headgear for wear; hats; caps; garters; sock suspenders; suspenders (braces); waistbands; belts for clothing; footwear; shoes and boots; slippers; sandals; Japanese style wooden clogs (geta); Japanese style sandals (zori); masquerade costumes; clothes for sports; anoraks; wristbands; boots for sports; gymnastic shoes; golf shoes; soccer shoes; ski boots; snowboarding shoes; climbing boots (mountaineering boots); baseball shoes; footwear for track and field athletics

Class 35

Sales promotion for others on the Internet; organization of fashion shows for promotional purposes; Internet advertising; advertising by electronic mail; providing information about advertising inserted in the paper and magazines for commercial purposes; providing of advertising spaces on the Internet included in this class; advertising and publicity services; publicity material rental; organization of exhibitions for commercial or advertising purposes on the Internet; promoting the goods and services of others through the operation of customer loyalty and incentive schemes by means of trading stamps; business administration and management of a shopping centre or a shopping mall; arranging of buying and selling contracts for third parties on an on-line shopping mall; arranging and providing information of buying and selling contracts in digital commerce; business consultancy for providers of on-line retail store services on the Internet; business management analysis or business consultancy; providing information relating questionnaire surveys; marketing research on public estimation of retail stores; marketing research; information relating to rankings on sales; information relating to retail stores via the global computer network; providing information on sales relating to clothing, bags and jewellery; providing information concerning commercial sales; mediation and conclusion of commercial transactions for others; mediation and conclusion of commercial transactions by telecommunication or the electronic way for others; data search in computer files for others; retail and wholesale services connected with the sale of clothing, headgear, footwear, bags and pouches, trunks, stocking suspenders, sock suspenders, suspenders for clothing, expanding bands for holding sleeves, belts for clothing, jewellery ornaments, earrings, necklaces, rings (jewellery), bracelets (jewellery), jewellery chains, jewellery charms, key rings, jewellery trinkets, badges for wear, buckles for clothing, brooches for clothing, Japanese buckles to bind a broad belt of kimonos (Obidomes), bonnet pins, ornamental emblems attachable on clothing (Wappens), brassards, hoods for clothing, cosmetics, clocks, watches and spectacles, eyeglasses and goggles, clothing for pets, unwrought and semi-wrought precious stones and their imitations.

The Applicant's mark can therefore proceed to registration only in respect of the following goods/services, which were either not opposed, or in respect of which I found no likelihood of confusion:

Class 9: Photographic machines and apparatus; cinematographic machines and apparatus; optical machines and apparatus; measuring or testing machines and instruments; telecommunication machines and apparatus; recorded computer software for computer networks; electronic machines, apparatus and their parts; computers and their peripherals; computer programs (downloadable software); downloadable game programs; downloadable image, video and music files via telecommunication networks; phonograph records; downloadable music files; downloadable image files; recorded video discs and video tapes; electronic publications.

Class 18: Walking sticks; canes; metal parts of canes and walking-sticks; walking cane handles;

Class 35: Auctioneering provided on the Internet; providing information on sales relating to auction; providing employment information; retail and wholesale services connected with the sale of woven fabrics and beddings, personal articles, combs, face towels of textile, handkerchiefs of textile, towels of textile, hand-held flat fans, hair bands, buttons, false nails, false eyelashes, shaving utensils cases, pedicure sets, eyelash curlers, umbrellas, manicure sets, ear picks, toilet cases, cosmetic utensils, false beards, ornamental beards, ornamental moustaches, hand implements for hair curlers, ferrules of metal for walking sticks, canes, metal parts of canes and walking-sticks, walking stick handles, foods and beverages, liquor, meat, sea food, vegetables and fruits, confectionery, bread and buns, rice and cereals, milk, carbonated drinks, refreshing beverages, non-alcoholic fruit juice beverages, tea, coffee, cocoa, processed food, two wheeled motor vehicles, bicycles, furniture, joinery fittings, tatami mats, electrical machinery and apparatuses, lighting apparatus, household electrothermic appliances, bladed or pointed hand tools, hand tools, hardware of metal, kitchen equipment, cleaning tools and washing utensils, pharmaceutical, veterinary and sanitary preparations and medical supplies, toiletries, dentifrices, soaps and detergents, agricultural machines, agricultural implements and supplies, natural flowers and trees, printed matter, paper and stationery, sports goods, toys, dolls, game machines and apparatus, musical instruments and records, pre-recorded DVDs, tobaccos, smokers' articles, chains for dogs, beds for household pets, dog kennels, nesting boxes for small birds, feeding vessels for pets, brushes for pets, chewing goods for pet dogs, indoor aquaria and their fittings, bird cages, bird baths, toys for domestic pets, foods for pets, baby oils, teething rings, babies' bottles, baby carriages, babies' diapers of paper.

Class 42: Meteorological information; designing of machines, apparatus, instruments (including their parts) or systems composed of such machines, apparatus and instruments; designing on the Internet; designing Web sites on the Internet; designing of clothing, footwear and bags; designing of jewelry; designing of advertising matter; designing; hosting of weblogs; providing

search engines for obtaining data via communications networks; providing search engines for weblogs; identification verification services; computer software design, computer programming, or maintenance of computer software for business management; computer software design, computer programming, or maintenance of computer software; technical advice relating to computers; providing temporary use of on-line non-downloadable software; rental of storage areas on servers for social networking via the Internet; providing computer programs for customer management; providing computer programs for electronic authentication; rental of computers; providing computer programs.

COSTS

61) On filing form TM7 WE Brand paid the sum of £200 as its opposition fee. By reason of rule 2 of the Trade Marks (Fees) (Amendment) Rules 2013, which amended the Table in the Schedule to the Trade Marks (Fees) Rules 2008, an opposition fee of only £100 was due, since the grounds of opposition were based solely on section 5(2) of the Act. The Registry will therefore arrange to refund to WE Brand the sum overpaid in the amount of £100. Accordingly, only the due opposition fee of £100 is taken into account in my costs order below.

62) WE Brand S.a.r.l. has been largely successful and is entitled to a contribution towards its costs. I hereby order Start Today Co., Ltd. to pay WE Brand S.a.r.l. the sum of £750. This sum is calculated as follows:

<i>Opposition fee</i>	£100
<i>Preparing a statement and considering the other side's statement</i>	£300
<i>Written submissions</i>	£350

The above sum should 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 11th day of March 2015

Martin Boyle
For the Registrar,
The Comptroller-General

ANNEX

International Registration (UK) Number: WO0000001186316 Goods and services for which protection is sought

Class 9

Photographic machines and apparatus; cinematographic machines and apparatus; optical machines and apparatus; measuring or testing machines and instruments; telecommunication machines and apparatus; recorded computer software for computer networks; electronic machines, apparatus and their parts; computers and their peripherals; computer programs (downloadable software); spectacles (eyeglasses and goggles); sunglasses; downloadable game programs; downloadable image, video and music files via telecommunication networks; phonograph records; downloadable music files; downloadable image files; recorded video discs and video tapes; electronic publications.

Class 14

Unwrought and semi-wrought precious stones and their imitations; emerald; topaz; olivine (peridot); threads of precious metal (jewellery, jewelry (Am.)); chalcedony; sapphire; jewellery made of coral; pearls (jewellery, jewelry (Am.)); artificial gemstones; diamonds; opal; jade (jewellery); jasper; agates; ruby; keyrings (trinkets or fobs); jewellery cases; trophies (prize cups); commemorative shields; ornaments (jewellery, jewelry (Am.)); earrings; insignias of precious metal; badges of precious metal; bonnet pins of precious metal (jewellery); tie clips; tie pins; necklaces (jewellery, jewelry (Am.)); bracelets (jewellery, jewelry (Am.)); pendants; gem brooches; medals; rings (jewellery, jewelry (Am.)); lockets (jewellery, jewelry (Am.)); cuff links; shoe ornaments of precious metal; wristwatches; table clocks; pocket watches; automobile clocks; stopwatches; wall clocks; alarm clocks; watch and clock springs; cases for clock and watchmaking; watch chains; watch glasses; straps for wristwatches; clock hands (clock and watch making); pendulums (clock and watch making); dials (clock and watch making); crystal jewellery.

Class 18

Industrial packaging containers of leather; clothing for domestic pets; bags; folding briefcases; shoulder bags; Gladstone bags; Japanese wicker trunks (Kori); briefcases; suitcases; carry-on bags; trunks; handbags; Boston bags; schoolchildren's backpacks; rucksacks; pouches; charm bags (Omamori-ire); card cases (notecases); shopping bags (including "wheeled shopping bags"); purses; key cases; money pouches; purses; commutation card cases [leatherware]; business card cases; vanity cases, not fitted; umbrellas; telescopic umbrellas; Japanese paper umbrellas (Karakasa); Japanese oiled-paper umbrellas (Janome-gasa); rainproof parasols; beach umbrellas (beach parasols); parasols (sun umbrellas); umbrella covers; umbrella handles; metal parts of umbrellas; frames for umbrellas; bags for umbrellas; walking sticks; canes; metal parts of canes and walking-sticks; walking cane handles; leather and fur (unworked or semi-worked).

Class 25

Clothing; non-Japanese style outerclothing; coats; jackets; pants; trousers; vests; sweaters; shirts; nightwear; underwear (underclothing); swimwear (bathing suits);

swimming caps (bathing caps); camisoles; jerseys; knitwear; skirts; T-shirts; parkas; Japanese traditional clothing; sleep masks; aprons (clothing); collar protectors (for wear); socks and stockings; shawls; scarves (scarfs); gloves and mittens (clothing); neckties; bandanas (neckerchiefs); mufflers; ear muffs (clothing); hoods (clothing); nightcaps; headgear for wear; hats; caps; garters; sock suspenders; suspenders (braces); waistbands; belts for clothing; footwear; shoes and boots; slippers; sandals; Japanese style wooden clogs (geta); Japanese style sandals (zori); masquerade costumes; clothes for sports; anoraks; wristbands; boots for sports; gymnastic shoes; golf shoes; soccer shoes; ski boots; snowboarding shoes; climbing boots (mountaineering boots); baseball shoes; footwear for track and field athletics.

Class 35

Sales promotion for others on the Internet; organization of fashion shows for promotional purposes; Internet advertising; advertising by electronic mail; providing information about advertising inserted in the paper and magazines for commercial purposes; providing of advertising spaces on the Internet included in this class; advertising and publicity services; publicity material rental; organization of exhibitions for commercial or advertising purposes on the Internet; promoting the goods and services of others through the operation of customer loyalty and incentive schemes by means of trading stamps; business administration and management of a shopping centre or a shopping mall; arranging of buying and selling contracts for third parties on an on-line shopping mall; arranging and providing information of buying and selling contracts in digital commerce; business consultancy for providers of on-line retail store services on the Internet; business management analysis or business consultancy; providing information relating questionnaire surveys; marketing research on public estimation of retail stores; marketing research; information relating to rankings on sales; information relating to retail stores via the global computer network; providing information on sales relating to clothing, bags and jewellery; providing information concerning commercial sales; auctioneering provided on the Internet; providing information on sales relating to auction; mediation and conclusion of commercial transactions for others; mediation and conclusion of commercial transactions by telecommunication or the electronic way for others; data search in computer files for others; providing employment information; retail and wholesale services connected with the sale of woven fabrics and beddings, clothing, headgear, footwear, bags and pouches, trunks, personal articles, combs, face towels of textile, handkerchiefs of textile, towels of textile, hand-held flat fans, stocking suspenders, sock suspenders, suspenders for clothing, expanding bands for holding sleeves, belts for clothing, jewellery ornaments, earrings, necklaces, rings (jewellery), bracelets (jewellery), jewellery chains, jewellery charms, key rings, jewellery trinkets, badges for wear, buckles for clothing, brooches for clothing, Japanese buckles to bind a broad belt of kimonos (Obidomes), bonnet pins, ornamental emblems attachable on clothing (Wappens), brassards, hoods for clothing, hair bands, buttons, false nails, false eyelashes, shaving utensils cases, pedicure sets, eyelash curlers, manicure sets, ear picks, toilet cases, cosmetic utensils, false beards, ornamental beards, ornamental moustaches, hand implements for hair curlers, umbrellas, ferrules of metal for walking sticks, canes, metal parts of canes and walking-sticks, walking stick handles, foods and beverages, liquor, meat, sea food, vegetables and fruits, confectionery, bread and buns, rice and cereals, milk, carbonated drinks, refreshing beverages, non-alcoholic fruit juice beverages, tea, coffee, cocoa, processed food, two wheeled motor vehicles,

bicycles, furniture, joinery fittings, tatami mats, electrical machinery and apparatuses, lighting apparatus, household electrothermic appliances, bladed or pointed hand tools, hand tools, hardware of metal, kitchen equipment, cleaning tools and washing utensils, pharmaceutical, veterinary and sanitary preparations and medical supplies, cosmetics, toiletries, dentifrices, soaps and detergents, agricultural machines, agricultural implements and supplies, natural flowers and trees, printed matter, paper and stationery, sports goods, toys, dolls, game machines and apparatus, musical instruments and records, pre-recorded DVDs, clocks, watches and spectacles, eyeglasses and goggles, tobaccos, smokers' articles, chains for dogs, clothing for pets, beds for household pets, dog kennels, nesting boxes for small birds, feeding vessels for pets, brushes for pets, chewing goods for pet dogs, indoor aquaria and their fittings, bird cages, bird baths, toys for domestic pets, foods for pets, baby oils, teething rings, babies' bottles, baby carriages, babies' diapers of paper, unwrought and semi-wrought precious stones and their imitations.

Class 42

Meteorological information; designing of machines, apparatus, instruments (including their parts) or systems composed of such machines, apparatus and instruments; designing on the Internet; designing Web sites on the Internet; designing of clothing, footwear and bags; designing of jewelry; designing of advertising matter; designing; hosting of weblogs; providing search engines for obtaining data via communications networks; providing search engines for weblogs; identification verification services; computer software design, computer programming, or maintenance of computer software for business management; computer software design, computer programming, or maintenance of computer software; technical advice relating to computers; providing temporary use of on-line non-downloadable software; rental of storage areas on servers for social networking via the Internet; providing computer programs for customer management; providing computer programs for electronic authentication; rental of computers; providing computer programs.