

O-346-15

TRADE MARKS ACT 1994

IN THE MATTER OF UK APPLICATION NOS 3075079 & 3075666
IN THE NAME OF STACEYANNE MCINTOSH
IN RESPECT OF TRADE MARKS:



&

**holy
hearts**

AND

OPPOSITIONS THERETO
UNDER NOS 600000183 & 600000184
BY CBM CREATIVE BRANDS MARKEN GMBH

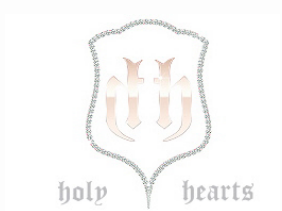
BACKGROUND

1. On 1 October 2014, Staceyanne Mcintosh (the applicant) applied to register holy hearts (and device), shown on the cover page of this decision. The application was made in respect of goods in classes 16 and 25 of the Nice Classification system.¹

2. On 6 October the applicant applied to register the words 'holy hearts' for a range of goods and services in classes 3, 16, 20, 25, 41 and 45.

3. The applications were published on 31 October 2014 and 7 November 2014, respectively. Following the publications, CBM Creative Brands Marken GmbH (the opponent) filed notices of opposition against the applications under the fast track opposition procedure.

4. Each of the oppositions was brought under section 5(2)(b) of the Trade Marks Act 1994 (the Act) and each is directed at some of the applicant's goods. The extent of each opposition is as follows:

OPPOSITION 60000183		
		

¹ *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).*

OPPOSITION 600000184		
Opposed mark:	Opposition directed at:	Opponent relies upon:
<p>holy hearts</p>	<p>Class 3 Aromatherapy preparations; Aromatic essential oils; Aromatic oils; Aromatic oils for the bath; Aromatics [essential oils]; Aromatics for fragrances; Balms (non-medicated-); Balms other than for medical purposes.</p> <p>Class 25 Caps, coats, bandannas, puffa jackets, tracksuits, polycotton velour tracksuits, t- shirts, blouses, hoodies, sheepskin boots.</p>	<p>CTM 11306545</p> <p>HOLY</p> <p>Applied for: 30 October 2012</p> <p>Date of entry in the register: 13 March 2013</p> <p>Class 25 Clothing, footwear, headgear</p> <p>AND</p> <p>CTM 4265971</p> <p>HOLY</p> <p>Applied for: 1 February 2005</p> <p>Date of entry in the register: 7 September 2011</p> <p>Class 3 Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions, dentifrices.</p>

5. On 17 January 2015, the applicant filed counterstatements, denying the grounds of opposition.

6. Rules 20(1)-(3) of the Trade Mark Rules 2008 (the provisions which provide for the filing of evidence) do not apply to fast track oppositions, but Rule 20(4) does. It reads:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

7. The net effect of the above is to require parties to seek leave in order to file evidence (other than the proof of use evidence which is filed with the notice of opposition) in fast track oppositions.

8. I note that in the period allowed for filing submissions the applicant filed an item of clothing under a covering letter. It was not filed in evidential form and, as no leave to file evidence was sought in respect of these proceedings, it was returned to the applicant. I will not refer to it in the remainder of the decision.

9. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if 1) the Office requests it or 2) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost. Otherwise written arguments will be taken.

10. A hearing was neither requested nor considered necessary. The opponent filed written submissions, which I will refer to as necessary, below.

DECISION

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

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

12. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

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

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

13. The opponent's marks are earlier marks but are not subject to proof of use because, at the date of publication of the application, they had not been registered for five years.²

Section 5(2)(b) case law

14. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the Court of Justice of the European Union (CJEU) cases mentioned) on the basis indicated below:

The CJEU cases

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; *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-6/01*; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04; *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P.*

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;

² See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004: SI 2004/946) which came into force on 5 May 2004

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a 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 causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

The average consumer and the nature of the purchasing act

15. In accordance with the above cited case law, I must determine who the average consumer is for the goods at issue and also identify the manner in which those goods will be selected in the course of trade.

16. 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.”

17. Specifically, in respect of the goods in class 25, in considering the level of attention that will be paid to such a purchase and the nature of the purchasing act, I am mindful of the decision of the General Court (GC) 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*, in which it commented:

"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 trademarks 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."

18. The average consumer of the goods at issue in classes 3 and 25 will be a member of the general public. The purchase is likely to be primarily visual as it is likely to be made from a store, website or directly from a shelf. The goods cover a range of products which are generally fairly low cost purchases. Consequently, the level of attention paid is likely to be no more than average.

Comparison of goods

19. The goods to be compared are as follows:

Opposition 600000183	
The opponent's goods	The applicant's goods
Class 25 Clothing, footwear, headgear	Class 25: T-shirts, hoodies, tracksuits, sheepskin boots, caps, bandannas, shirts, trousers, pants, shawl, scarf, jackets, coats, body warmers, puffa jackets, blouses, polo shirts, jeans.

Opposition 600000184	
The opponent's goods	The applicant's goods
<p>Class 3 Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions, dentifrices.</p> <p>Class 25 Clothing, footwear, headgear</p>	<p>Class 3 Aromatherapy preparations; Aromatic essential oils; Aromatic oils; Aromatic oils for the bath; Aromatics [essential oils]; Aromatics for fragrances; Balms (non-medicated-); Balms other than for medical purposes.</p> <p>Class 25 Caps, coats, bandannas, puffa jackets, tracksuits, polycotton velour tracksuits, t-shirts, blouses, hoodies, sheepskin boots.</p>

20. In comparing the goods, I bear in mind the following guidance provided by the GC in *Gérard Meric v OHIM*, Case T-133/05:

“29. ...goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

21. Where appropriate I will, for the purposes of comparison, group related goods together in accordance with the decision in *Separode Trade Mark*³:

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

22. With regard to opposition 600000183, the applicant's specification contains a number of named items of clothing, footwear and headgear. The opponent's mark is registered for clothing, footwear and headgear at large. In accordance with *Merica*, these are identical goods.

23. Turning to opposition 600000184, the applicant's goods in class 25 are included within the broad term 'clothing, footwear, headgear' in the opponent's specification. As above, these are identical goods.

24. The applicant's specification in class 3 includes 'aromatherapy preparations; aromatic essential oils; aromatic oils; aromatic oils for the bath; aromatics [essential oils] and aromatics for fragrances' which are all included within perfumery and

³ *BL O-399-10*

essential oils in the opponent's specification. The remaining goods, 'balms (non-medicated-); balms other than for medical purposes', are included within cosmetics and possibly essential oils and/or perfumery depending on the nature of the particular balm.

25. In conclusion, all of the applicant's goods in classes 3 and 25 as opposed are identical to the opponent's goods as relied upon.


Comparison of the marks

26. It is clear from *Sabel BV v. Puma AG* (particularly at 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."

27. 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.

28. The competing marks are as follows:

The opponent's earlier mark	The applicant's marks
<p>HOLY</p>	
	<p>holy hearts</p>

29. The opponent's mark consists of a single element, the word HOLY, in block capitals with no form of stylisation. The overall impression of the mark is based solely on that word.

30. The applicant's first mark consists of the words 'holy hearts' in a gothic style font. Above the words is a shield device with a textured outline and a convex top. Contained within the shield are what the applicant describes as "both HHs together back to back". These are coloured pale pink/orange. Whilst the applicant has stated that the elements within the shield are in fact two letters h, the one is, in fact a mirror image and does not immediately strike me as two such letters. The overall impression is that of a symmetrical design of unknown derivation. The bottom point of the shield lies between the words 'holy hearts'. The words and the device play a role in the overall impression of the mark, but it is the device which plays the larger role given its size and position within the mark.

31. The applicant's second mark consists of the plain words 'holy hearts', which are presented in lower case with no additional stylisation. Neither part of the mark is emphasised. The two words hang together as the word 'holy' describes the following word 'hearts'. Consequently, the overall impression of the mark is based on its totality.

Visual similarity

The applicant's first mark, 'holy heart' and device

32. The only point of visual coincidence between this mark and the earlier mark relied on is the presence of the word 'holy'. The application also includes the additional word hearts and a large shield device which plays a significant role in the overall impression of the mark. Consequently, the visual similarity between the respective marks is low.

The applicant's second mark, 'holy hearts'

33. Visual similarities rest in the fact that both parties' marks contain the word 'holy'. It is the first word of the applicant's mark and the totality of the opponent's mark. The application also includes the word hearts. There is a moderate degree of visual similarity between these marks.

Aural similarity

34. Both of the applicant's marks will be articulated 'holy hearts'. These are two common words in the English language with which the average consumer will be familiar. 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, taking into account the additional word 'hearts' in the application, the degree of aural similarity overall is medium.

Conceptual similarity

35. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.⁴ The assessment must be made from the point of view of the average consumer.

36. The opponent submits:

“11 Conceptually, the word HOLY has only one meaning. It is a common word, readily understood, and the average consumer will undoubtedly associate it with the concept of something religious.

12 HOLY HEARTS will likewise be immediately and unambiguously perceived by the average consumer as pertaining to holiness and religious people.

13 The respective signs share an overarching, somewhat ephemeral, concept of holiness.”

37. All three marks contain the word ‘Holy’ which will be understood by the average consumer to mean, inter alia, religious, sacred or awe inspiring in a broad sense. The additional word ‘hearts’ when combined with the word ‘holy’ may be perceived to refer to religious people or religious care, or may be considered a reference to the sacred heart often seen in religious iconography.

38. All three marks evoke a sense of ‘holiness’, though the applicant’s marks are more specific (whichever way they are interpreted by the average consumer) and not as nebulous as the mark relied on by the opponent. Accordingly, I find the conceptual similarity between the opponent’s mark and the applicant’s two marks to be at a medium level.

Distinctive character of the earlier mark

39. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been used as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger Joined Cases C-108/97 and C-109/97* [1999] ETMR 585.

40. The opponent states, in its submissions:

“24...HOLY has no inherent link to any of the goods for which the Earlier Trade Mark is registered. It is neither descriptive nor non-distinctive and

⁴ This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.

should, therefore, be considered a trade mark with at least a normal level of distinctiveness.”

41. I agree, the opponent’s earlier mark possesses a medium degree of inherent distinctive character.

Likelihood of confusion

42. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind.⁵ I must also keep in mind the average consumer for the goods, the nature of the purchasing process and have regard to the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa.

43. I have made the following findings:

- The applicant’s ‘holy hearts’ mark is visually similar to the opponent’s mark to a medium degree.
- The applicant’s ‘holy hearts’ and device mark is visually similar to the opponent’s mark to a low degree.
- The applicant’s marks and the opponent’s mark are aurally and conceptually similar to a medium degree.
- The parties’ goods are identical.
- The average consumer is a member of the general public. The purchase is primarily visual and the level of attention paid is no more than average.

44. In making a finding, I bear in mind the comments of the GC with regard to identical goods when considering the likelihood of confusion. In *Aldi GmbH & Co KG v Office for Harmonization in the Internal Market*⁶ the GC stated:

“91 In addition, the Opposition Division considered that the goods at issue were identical, as was recalled in the contested decision, without the Board of Appeal’s taking a final decision in that regard (see paragraph 40 et seq. above). That implies, in accordance with the case-law cited at paragraph 23 of the present judgment, that, if there is to be no likelihood of confusion, the degree of difference between the marks at issue must be high (see, to that effect, judgment of 29 January 2013 in Case T-283/11 *Fon Wireless v OHIM – nfon (nfon)*, not published in the ECR, paragraph 69).”

Opposition 600000183 – ‘holy hearts’ and device

⁵ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

⁶ *(Trade Marks and Designs) (OHIM) Case T-505/11*

45. This opposition is directed against goods in class 25. The purchase of such goods will be, for the most part, visual, with a reasonable level of attention being paid to the purchase. Differences I have already identified mean that there is no likelihood of the marks being mistaken for one another giving rise to direct confusion, which leaves the consideration of indirect confusion. This concept is explained in *L.A. Sugar Limited v By Back Beat Inc*⁷, where Mr Iain Purvis Q.C. sitting as the Appointed Person noted:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.’

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (‘26 RED TESCO’ would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as ‘LITE’, ‘EXPRESS’, ‘WORLDWIDE’, ‘MINI’ etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (‘FAT FACE’ to ‘BRAT FACE’ for example).”

46. In this case, there is no indirect confusion. The similarity between the marks, i.e. the inclusion of the word ‘HOLY’, does not give rise to a situation where the common element is so strikingly distinctive that it could only be seen as originating from the opponent. In fact, it is an element which plays less of a role in the overall impression of the mark as a whole than the device. The applied for mark does not simply add a non-distinctive element to the common element. Rather, it adds the shield which is large and a visually significant device element.

⁷ Case BL-O/375/10

47. The look and feel created by the mark applied for is visually striking in elements which are not common with the earlier mark. Accordingly, the average consumer will not consider the common element to indicate goods being provided by the same or an economically linked undertaking.

CONCLUSION – Opposition 600000183

48. The opposition fails under section 5(2)(b) of the Act

Opposition 600000184 – ‘holy hearts’

49. In reaching a decision on the likelihood of confusion I am mindful of the guidance on how to approach issues of similarity involving composite signs which can be found in the CJEU’s judgment in *Medion AG v Thomson multimedia Sales Germany & Austria GmbH*, Case C-120/04 where it was held that:

“29. In the context of consideration of the likelihood of confusion, 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. On the contrary, 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 (see *Matratzen Concord*, paragraph 32).

30. However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.

31. In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.

32. The finding that there is a likelihood of confusion should not be subject to the condition that the overall impression produced by the composite sign be dominated by the part of it which is represented by the earlier mark.

33. If such a condition were imposed, the owner of the earlier mark would be deprived of the exclusive right conferred by Article 5(1) of the directive even where the mark retained an independent distinctive role in the composite sign but that role was not dominant.”

50. In *Aveda Corporation v Dabur India Limited*⁸ Arnold J held:

“47. In my view the principle which I have attempted to articulate in paragraph 45 above is capable of applying where the consumer perceives one of the constituent parts to have significance independently of the whole, but is mistaken as to that significance. Thus in *BULOVA ACCUTRON* the earlier trade mark was ACCURIST and the composite sign was BULOVA ACCUTRON. Stamp J held that consumers familiar with the trade mark would be likely to be confused by the composite sign because they would perceive ACCUTRON to have significance independently of the whole and would confuse it with ACCURIST.

48. On that basis, I consider that the hearing officer failed correctly to apply *Medion v Thomson*. He failed to ask himself whether the average consumer would perceive UVEDA to have significance independently of DABUR UVEDA as a whole and whether that would lead to a likelihood of confusion.”

51. I am also mindful of the recent decision of the CJEU in *Bimbo S.A. v OHIM*⁹ in which it was held that:

“25...a component of a composite sign does not retain such an independent distinctive role if, together with the other component or components of the sign, that component forms a unit having a different meaning as compared with the meaning of those components taken separately.

...

33. Next, ...it should be pointed out that the purpose of examining whether any of the components of a composite sign has an independent distinctive role is to determine which of those components will be perceived by the target public.

34. Indeed, ...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.

35...Such an assessment must be based on the overall impression produced by the trade marks at issue, since the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details... Therefore, this does not involve an exception, that must be duly substantiated, to that general rule.

⁸[2013] EWHC 589 (Ch)

⁹Case C-591/12P

36. Moreover, the individual assessment of each sign...must be made in the light of the particular circumstances of the case and cannot therefore be regarded as being subject to general presumptions...it is clear, in particular, from the case-law subsequent to *Medion* (EU:C:2005:594), that the Court of Justice did not introduce, in that judgment, a derogation from the principles governing the assessment of the likelihood of confusion.”

52. The word HOLY is the totality of the opponent’s mark and the first word of the applicant’s mark. There is a general rule, clear from decisions such as joined cases T-183/02 and T-184/027¹⁰, that the first parts of words (and consequently, first words of marks) catch the attention of consumers. However, it is also clear that each case must be decided on its merits considering the marks as wholes. In this case the word HOLY has significance independently of ‘holy hearts’ as a whole. It is a clearly understood word at the start of the mark which is used adjectivally to define the following word, hearts. None of the possible, and I’m sure, non-exhaustive, interpretations I have outlined in respect of ‘holy hearts’ detract from the core message which is that of something which is holy.

53. I am mindful of the decision in *Medion* which makes clear that a finding of a likelihood of confusion should not depend upon the overall impression of the composite mark being dominated by the part which is identical to the earlier mark. *Medion* recognises that the overall impression in a case such as this may lead the public to believe that the goods derive, at the very least, from companies which are economically linked. In my view that is the case here, the nature of the common element HOLY gives rise to indirect confusion where the average consumer will believe the respective goods originate from the same or a linked undertaking.¹¹

CONCLUSION – Opposition 600000184

54. The opposition succeeds under section 5(2)(b) of the Act in respect of classes 3 and 25, which represent the full extent of the opposition.

55. The application may proceed to registration in respect of the following goods and services, which were not opposed:

Class 16 - Polycotton velour bible covers.

Class 20 - Wooden plaques, biblical writing on plaques.

Class 41 - Education and training based on the bible, personal development workshops, conference, prayer sport run.

Class 45 - Mentoring, musical biblical worship, personal development, prayer group, prayer workshop, prayer gathering.

¹⁰ *El Corte Inglés v OHIM – González Cabello and Iberia Líneas Aéreas de España (MUNDICOR)* [2004] ECR II – 965, paragraph 81

¹¹ *I have also considered the decision of Mr Iain Purvis Q.C. in L.A. Sugar Limited v By Back Beat Inc. Case BL-O/375/10*

Costs

56. Since both parties have achieved a measure of success, I decline to make an award of costs in this case.

Dated this 28th day of July 2015

**Ms AI Skilton
For the Registrar,
The Comptroller General**