

**O-420-16**

**TRADE MARKS ACT 1994  
IN THE MATTER OF  
APPLICATION NO 3117923  
BY ANTHONY OLIVIER LTD  
TO REGISTER THE TRADE MARK**



**IN CLASSES 18 & 25  
AND  
OPPOSITION THERETO (UNDER NO. 405346)  
BY  
S. OLIVER BERND FREIER GMBH & CO. KG**

## BACKGROUND

1) On 15 July 2015, Anthony Olivier Ltd ('the applicant') applied to register the trade mark shown on the cover page of this decision in respect of the following goods:

**Class 18:** Bags.

**Class 25:** Footwear, clothing, headgear.

2) The application was published on 31 July 2015 in the Trade Marks Journal and notice of opposition was subsequently filed by s. Oliver Bernd Freier GmbH & Co. KG ('the opponent').

3) The opponent claims that the application offends under section 5(2)(b) of the Trade Marks Act 1994 ('the Act'). It relies upon the following European Union Trade Mark ('EUTM'):

EUTM details	Goods relied upon
<p><b>EUTM No: 181875</b></p> <p><b>S. Oliver</b></p> <p><b>Filing date: 01 April 1996</b></p> <p><b>Date of entry in the register: 06 November 2000</b></p>	<p><b>Class 18:</b> Goods of leather, plastics and textile materials, namely bags, in particular sport and shopping bags and other goods of leather, namely containers not suitable for carrying objects such as small leather goods, in particular toilet bags, purses, key wallets.</p> <p><b>Class 25:</b> Clothing for men and women, including woven and knitted clothing and clothing of leather and imitation leather, in particular, blouses, shirts, T-shirts, sweat shirts, jackets, pullovers, tops,</p>

	bustiers, trousers, skirts, twinsets, suits, coats, underclothing, swimwear, headgear, scarves, head bands, jogging and fitness clothing, gloves, belts for clothing, shoes.
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4) The trade mark relied upon by the opponent is an earlier mark in accordance with section 6 of the Act and, as it completed its registration procedure more than five years prior to the publication date of the contested mark, it is subject to the proof of use conditions, as per section 6A of the Act. The opponent made a statement of use in respect of all of the goods it relies upon.

5) The applicant filed a counterstatement denying that there is any similarity between the respective marks or the respective goods. In answer to question 7 of Form TM8 which states “Do you want the opponent to provide “proof of use”?” the applicant ticked “No”. Consequently, the opponent is entitled to rely on the full breadth of goods for which it made a statement of use.

6) Only the opponent filed evidence. Neither party requested to be heard nor did they file written submissions in lieu of a hearing. I now make this decision on the basis of the papers before me.

## **EVIDENCE**

7) The opponent’s evidence comes from Mr Alastair Rawlence of Novagraaf UK, the opponent’s representative in these proceedings. There is no informative narrative in the witness statement aside from reference to Exhibit AJR1 which is stated to be “extracts taken from the internet”. The exhibit shows information about the names ‘Oliver’ and ‘Olivier’ taken from the website [www.behindthename.com](http://www.behindthename.com). Mr Rawlence’s accompanying submissions state that the evidence shows that “these surnames are known in the UK”.<sup>1</sup>

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<sup>1</sup> Page 5 of Mr Rawlence’s submissions dated 23 March 2016.

## **Preliminary point**

8) I note that in its counterstatement the applicant asserts that it provides high fashion shoes aimed at women with larger feet. It further states that this is a niche market in which the opponent does not operate and therefore there cannot be a likelihood of confusion. This is not something which I can take into account. This is because I am required to make the assessment of the likelihood of confusion under section 5(2)(b) notionally and objectively solely on the basis of the marks and goods and as they appear before me. The manner in which either party currently chooses to operate is irrelevant because marketing strategies are temporal and may change with the passage of time. See for instance, *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, where the Court of Justice of the European Union stated:

“59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

For these reasons, the applicant's arguments will have no bearing on the decision which follows.

## **DECISION**

9) Section 5(2)(b) of the Act states:

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

(a) .....

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

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

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

11) The goods to be compared are:

Opponent's goods	Applicant's goods
<b>Class 18:</b> Goods of leather, plastics and textile materials, namely <u>bags</u> , in	<b>Class 18:</b> Bags.

particular sport and shopping bags and other goods of leather, namely containers not suitable for carrying objects such as small leather goods, in particular toilet bags, purses, key wallets.

**Class 25:** Clothing for men and women, including woven and knitted clothing and clothing of leather and imitation leather, in particular, blouses, shirts, T-shirts, sweat shirts, jackets, pullovers, tops, bustiers, trousers, skirts, twinsets, suits, coats, underclothing, swimwear, headgear, scarves, head bands, jogging and fitness clothing, gloves, belts for clothing, shoes.

(my emphasis)

**Class 25:** Footwear, clothing, headgear.

12) Both parties' specifications include bags, clothing and headgear which are self-evidently identical. Further, as the opponent's 'shoes' fall within the applicant's 'footwear', these goods are also identical in accordance with the decision of the General Court ('GC') in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05 ('*Meric*'), where it stated:

"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 fur 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".

## **Average consumer and the purchasing process**

13) It is necessary to determine who the average consumer is for the respective goods and the manner in which they are likely to be selected. 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.”

14) The average consumer for the goods at issue is the general public. The goods will be purchased mainly by the eye from retail premises or websites. That is not to say though that the aural aspect should be ignored since the goods may sometimes be the subject of discussions with retail staff, for example. The cost of the goods is likely to vary. However, factors such as size, colour, pattern or suitability for purpose and functionality are likely to be taken into account by the consumer in relation to all of the goods; even those at the lower end of the cost scale. I agree with the opponent that, generally speaking, an average (normal) degree of attention is likely to be paid during the purchase.

## **Comparison of marks**

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

16) For ease of reference, the marks to be compared are:

Opponent's mark	Applicant's mark
<b>S. Oliver</b>	 The image shows a dark, textured background with a gold-colored logo. At the top is a laurel wreath. Below it, the name 'Anthony Oliver' is written in a cursive script. Underneath the name, the words 'LUXURIOUS FOOTWEAR' and 'FOR THE DISTINCTIVE WOMAN' are written in a smaller, sans-serif font.

17) The opponent's mark, consisting of the letter 'S' followed by a dot and the word 'Oliver', has the appearance of a personal name (i.e. initial and surname). 'Oliver' is not an unusual surname in the UK. Nevertheless, it has the greatest weight in the overall impression owing, in particular, to the proportion of the mark which it occupies. That said, the initial 'S.', present in a prominent position at the beginning of the mark, also makes an important contribution to the overall impression.

18) The applicant's mark consists of the distinctive name 'Anthony Olivier' presented in a font which has the appearance of being hand written. Above that name is, as the opponent puts it, "the intertwined leaf/stem device" ('the leaves') which is also a distinctive element. Below the name are the words 'LUXURIOUS FOOTWEAR FOR THE DISTINCTIVE WOMAN' ('the strapline') which, owing to its descriptive nature, is a non-distinctive element. The black background merely serves as a backdrop for all of the aforementioned elements (which are presented in gold). Viewing the mark as a whole, I agree with the opponent that the name 'Anthony Olivier' is 'the most prominent element' in the mark; it has the greatest weight in the overall impression. I also agree with the opponent that, of those two names, 'Olivier' is the more distinctive (given that Anthony is the relatively more common name).<sup>2</sup> Accordingly, 'Olivier' is likely to have more impact than 'Anthony' but, given the relative size and positioning of the forename, only slightly so. The leaves also make a significant contribution to the overall impression but to a lesser extent than 'Anthony Olivier'. The descriptive strapline will have far less impact than the name and the leaves.

19) Visually, the single point of similarity between the marks lies in the surnames 'Oliver' and 'Olivier'. There is obviously a high degree of similarity between those names. However, given that all other aspects of the marks are visually very different, there is only a low degree of visual similarity between the marks as a whole.

20) From an aural perspective, the leaves in the applicant's mark will not be articulated and it is unlikely that the strapline will be vocalised. The mark is likely to be referred to solely by the personal name. The most likely pronunciation, in my view, would be AN-TON-EE OL-IV-EE-AY. However, it is possible that the mark will be pronounced as AN-TON-EE OL-IV-EE-ER. The opponent's mark will be vocalised as S OL-IV-ER. I do not agree with the opponent that there is a 'reasonably high degree' of aural similarity; and this is so regardless of which of the two possible pronunciations of the applicant's mark occurs. Considering the marks as a whole, they are aurally similar to, at best, a medium degree.

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<sup>2</sup> Opponent's submissions in Form TM7.

21) Whilst both marks will be perceived as personal names, the consumer will recognise that they refer to different individuals (albeit with similar surnames). To my mind, there is no conceptual similarity.

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

22) The distinctive character of the earlier mark must be considered. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). 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).”

As there is no evidence of use before me, I can only take into account the inherent qualities of the opponent’s mark. As I have already indicated, the mark will be perceived as the initial S followed by the surname Oliver (i.e. a personal name).

Bearing in mind that i) the average consumer will be accustomed to the use of names as badges of origin, ii) Oliver is not an unusual surname in the UK and iii) the combination with the initial S does little to elevate the mark's distinctiveness, I find the mark, as a whole, to be possessed of a normal degree of distinctive character.

### **Likelihood of confusion**

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

24) I have found that the marks are aurally similar to, at best, a medium degree and visually similar to a low degree. The low degree of visual similarity is particularly important (more so than the degree of aural similarity) since the purchase will be mainly visual.<sup>3</sup> I have also found there to be no conceptual similarity between the marks, the earlier mark has a normal degree of distinctive character and an average degree of attention will be paid by the general public during the purchase. Bearing all of these factors in mind, I find that there is no likelihood of confusion, either directly or indirectly, despite the identity of the goods and the possibility of the marks being imperfectly recalled.

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<sup>3</sup> In *New Look Ltd v OHIM* Joined cases T-117/03 to T-119/03 and T-171/03, the GC stated: "49 However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs."

25) **The opposition fails.**

## **COSTS**

26) As the applicant has been successful, it is entitled to a contribution towards its costs. Using the guidance in Tribunal Practice Notice 4/2007, but keeping in mind that the applicant has not incurred the expense of legal representation, I award the applicant £100 for considering the notice of opposition and preparing a counterstatement.

27) I order s. Oliver Bernd Freier GmbH & Co. KG to pay Anthony Olivier Ltd the sum of **£100**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**.Dated this 1st day of September 2016**

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