

O-310-18

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATION NO. 3212646
BY FAERING LTD
FOR THE TRADE MARK**

WELL BEGUN

**AND
OPPOSITION THERETO
UNDER NO. 409450 BY CSP PARIS FASHION GROUP**

BACKGROUND

1. On 14 February 2017 Faering Ltd (“the applicant”) applied to register the trade mark WELL BEGUN for goods and services in classes 25 and 35, of which only the following are opposed in these proceedings:

Class 25: Clothing; dresses; skirts; coats; jackets; suits; shirts; blouses; polo shirts; T-shirts; vests; sweaters; knitwear; cardigans; base layers; jumpers; cyclewear; outdoorwear; tops; parkas; ponchos; trousers; jeans; denims; shorts; tracksuits; belts; ties; bow ties; underwear; lingerie; hosiery; scarves; gloves; shawls; stoles; pyjamas; nightwear; dressing gowns and bath robes; swimwear; wedding dresses; kilts; footwear; shoes; heels; high-heeled shoes; stiletto heels; boots; wedge shoes; lace up shoes; loafers; moccasins; brogue shoes; sneakers; sandals; beach shoes; flip flops; ballet shoes; slippers; socks; headwear; hats; caps; visors; wraps.

Class 35: Retail services, retail store services, and online retail store services connected with the sale of clothing, footwear, headwear and fashion accessories.

2. The application was accepted and published for opposition purposes on 03 March 2017.

3. The application is opposed by CSP Paris Fashion Group (“the opponent”) under Section 5(2)(b) of Trade Marks Act 1994 (“the Act”), for the purpose of which it relies upon the following European Union Trade Mark (EUTM) registrations:

- (i) EUTM No. 527630
Mark: WELL
Filing date: 01 May 1997
Date of entry in register: 17 February 1999
Goods relied upon: Clothing; footwear; lingerie; hosiery (class 25).

(ii) EUTM No. 383646



Mark:

Filing date: 06 November 1996

Date of entry in register: 29 October 1998

Goods relied upon: Clothing; lingerie, underwear, hosiery; tights; stockings (class 25).

(iii) EUTM No. 13590633

Mark: WELL Magic Nights

Filing date: 19 December 2014

Date of entry in register: 22 April 2015

Goods relied upon: Clothing, underwear, stockings, tights, knee-high stockings, socks, underwear, hosiery, foot protectors (foot socks) and ankle-length socks (class 25).

4. The opponent claims that the applicant is seeking protection for goods and services which are identical or similar to those covered by the earlier marks. It also submits that WELL is, in the earlier mark, the sole component and, in the applied for mark, the distinctive and dominant component and that the marks are confusingly similar.

5. The applicant filed a counterstatement (completed by Nicholas Morley) denying the claims made. It puts the opponent to proof that the marks are conceptually, visually and aurally similar and that the word WELL is the dominant and distinctive component in WELL BEGUN.

6. The opponent's registrations are earlier marks in accordance with section 6 of the Act. As 527630 and 383646 were registered more than five years prior to the date the application was published, the requirements of Section 6A of the Act, i.e. proof of use, are relevant to each of them. However, the applicant indicated, in its counterstatement, that it did not require the opponent to provide proof of use. As for 13590633, since the mark had not been registered for more than five years at the date of the application,

there is no requirement on the opponent to prove that it has been genuinely used in relation to the registered goods. Consequently, the opponent is entitled to rely upon all of the marks listed at paragraph 3 above (in relation to the goods it has identified) without having to prove use.

7. The opponent is represented by Stevens Hewlett & Perkins; the applicant is not professionally represented. Both parties filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary. Both sides also filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. Neither side wished to be heard so I make this decision on the basis of the papers before me.

The opponent's evidence

8. This consists of a witness statement by Jonathan Sutton, the opponent's representative. His evidence is directed solely to establishing that clothing brands sell their own brand products through retail stores and websites bearing the same name.

The applicant's evidence

9. This consists of a witness statement by Nicholas John Morley, who identifies himself as the applicant's representative¹. His evidence relates to the meaning and use of the word WELL:

- Exhibit 1 consists of dictionary definitions; it shows that the meaning of the word WELL depends upon the context in which it is being used. I will return to this evidence later;
- Exhibit 2 is a long list of idioms including the word WELL. The list, taken from <http://idioms.thefreedictionary.com/well>, includes the idiom "well begun is half done";

¹ Various correspondence sent to the Tribunal by Nicholas Morley shows that he is the Managing Director of the applicant.

- Exhibits 3 and 4 are screen prints of a Google (UK) and a Google image (UK) search respectively for WELL BEGUN. Exhibit 3 shows the phrase “well begun is half done” as the three top ranked results; Exhibit 4 shows images incorporating the quote WELL BEGUN IS HALF DONE;
- Exhibit 5 is a screen print of a Google (UK) search for “Mary Poppins WELL BEGUN”. It shows images of Mary Poppins as well as images incorporating the quote WELL BEGUN IS HALF DONE. None of the pictures show the two elements, i.e. Mary Poppins and the quote, together;

10. The rest of the evidence refers to a website link for a document headed “Word frequency in written and spoken English: based on the British National Corpus” (a copy of which is not provided). According to Mr Morley, “the frequency of the combined spoken and written words per million occurrences were as follow: WELL 1175 (all use combined, but dominated by adverbial use), BEGUN 42.

11. Finally, Mr Morley stated that he conducted a search of the IPO database which revealed the following registrations in classes 25 and 35: i) WELL BEGINNINGS (EU11112422); ii) WELL GROOMED (UK2501386); iii) WELL ENDOWED (EU13469622) and WELL HUNG CLOTHING (UK2587574).

DECISION

12. Section 5(2)(b) of the Act reads:

“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.”

Section 5(2)(b) - case-law

13. 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:

- (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 greater 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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

The opponent's best case

14. Although the opponent has based its opposition on three marks, it is no. 527630 which, in my view, offers the best prospect of success and it is on the basis of this mark that I shall conduct the comparison.

Comparison of goods and services

15. In comparing the respective specifications, all the relevant factors should be taken into account. In the judgment of the Court of Justice of the European Union (CJEU) in *Canon*, Case C-39/97, the Court stated at paragraph 23:

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

16. The parties’ goods and services are as follows:

Applicant’s goods and services	Opponent’s goods
<p>Class 25: Clothing; dresses; skirts; coats; jackets; suits; shirts; blouses; polo shirts; T-shirts; vests; sweaters; knitwear; cardigans; base layers; jumpers; cyclewear; outdoorwear; tops; parkas; ponchos; trousers; jeans; denims; shorts; tracksuits; belts; ties; bow ties; underwear; lingerie; hosiery; scarves; gloves; shawls; stoles; pyjamas; nightwear; dressing gowns and bath robes; swimwear; wedding dresses; kilts; footwear; shoes; heels; high-heeled shoes; stiletto heels; boots; wedge shoes; lace up shoes; loafers; moccasins; brogue shoes; sneakers; sandals; beach shoes; flip flops; ballet shoes; slippers; socks; headwear; hats; caps; visors; wraps.</p> <p>Class 35: Retail services, retail store services, and online retail store services</p>	<p>Class 25: Clothing; footwear; lingerie; hosiery.</p>

connected with the sale of clothing, footwear, headwear, and fashion accessories.	
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17. 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 uses of the respective goods or services;
- b) The respective users of the respective goods or services;
- c) The physical nature of the goods or acts of services
- d) The respective trade channels through which the goods or services reach the market
- e) In the case of self serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- f) The extent to which the respective goods or services are competitive. 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.

18. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court (GC) stated that “complementary” means:

“...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”.

19. In *Gérard Meric v OHIM*, Case T- 133/05, the General Court (GC) 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”.

20. The applicant made no comment as to the similarity of the respective goods and services. As this cannot be taken as an admission that the goods and services are similar, I will proceed to my own assessment.

Class 25

21. Both specifications contain the identical terms *clothing*, *footwear*, *lingerie* and *hosiery*. These goods are self-evidently identical.

22. The applied for *dresses; skirts; coats; jackets; suits; shirts; blouses; polo shirts; T-shirts; vests; sweaters; knitwear; cardigans; base layers; jumpers; cyclewear; outdoorwear; tops; parkas; ponchos; trousers; jeans; denims; shorts; tracksuits; underwear; pyjamas; nightwear; dressing gowns and bath robes; swimwear; wedding dresses and kilts* are all covered by the opponent's broad term *clothing*. These goods are identical on the principle outlined in *Meric*.

23. The applied for *belts; ties; bow ties; scarves; gloves; shawls; stoles; and wraps* are accessories to, or sometimes may even form part of, items of *clothing* and are therefore complementary goods. These goods are all highly similar to the opponent's *clothing*.

24. The applied for *shoes; heels; high-heeled shoes; stiletto heels; boots; wedge shoes; lace up shoes; loafers; moccasins; brogue shoes; sneakers; sandals; beach*

shoes; flip flops; ballet shoes; slippers and socks all fall within the opponent's broad term *footwear*. Again, these goods are identical on the principle outlined in *Meric*.

25. The contested *headwear; hats; caps and visors*, which I shall refer collectively as *headwear*, serve the same purpose as the opponent's *clothing* and *footwear*, namely covering and protecting parts of the human body and for fashion. They are often found in the same retail outlets and target the same public. Consumers looking for *headwear* will expect to find *footwear* and *clothing* in the same department or shop and vice versa. Moreover, many manufacturers and designers will design and produce both *clothing* (and *footwear*) and *headgear*. In my view, these goods are also similar to a high degree.

Class 35

26. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC 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 similar to a degree.

27. 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.”

28. However, on the basis of the European courts’ judgments in *Sanco SA v OHIM*², and *Assembled Investments (Proprietary) Ltd v. OHIM*³, upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd*⁴, Mr Hobbs concluded that:

i) 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;

ii) 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;

iii) It is not permissible to treat a mark registered for ‘retail services for goods X’ as though the mark was registered for goods X;

iv) 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).

29. Accordingly, there is a degree of similarity between goods X and services for the retailing of goods X. On that basis, I find that there is a medium degree of similarity between the opponent’s *clothing* and *footwear* and the applicant’s *retail services, retail store services, and online retail store services connected with the sale of clothing and*

² Case C-411/13P

³ Case T-105/05, at paragraphs [30] to [35] of the judgment

⁴ Case C-398/07P

footwear. As for the remaining goods listed in relation to the contested services in class 35, i.e. *headwear* and *fashion accessories*, I found that *headwear* is highly similar to *clothing*. I also found that certain articles of clothing accessories, e.g. *belts*, which would fall within the term *fashion accessories*, are highly similar to the opponent's *clothing*. I therefore find that there is also a medium degree of similarity between the opponent's *clothing* and the contested *retail services, retail store services, and online retail store services connected with the sale of headwear and fashion accessories*.

The average consumer and the nature of the purchasing act

30. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods and services at issue; I must then determine the manner in which these goods and services will be selected in the course of trade. 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.”

31. The average consumer of all the applicant's goods in class 25, and of its retail services in class 35, will consist of the general public. The same is true of all the opponent's goods in Class 25. The purchasing of all these goods, and the selection of retail outlets or online retail channels through which they are purchased, is a predominantly visual process, so the visual aspects of the marks take on more importance, but aural aspects will not be ignored. As to the level of attention paid, while the average consumer's level of attention may vary depending on the cost and nature of the item at issue, I think that when selecting even routine items of clothing,

footwear and headwear, as well as an appropriate retail channel for purchase of the goods, the average consumer will pay a normal degree of attention.

Distinctive character of earlier mark

32. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*²⁶, 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).”

33. As no evidence of use has been filed by the opponent, I have only the inherent distinctive character of the mark to consider. The applicant argues that “WELL is not a distinctive mark” because WELL is a common word. Whilst I accept that WELL is a commonly used word in everyday speech, this is not of itself a reason to attribute it a very low degree of distinctive character. The distinctiveness of the opponent’s mark must be assessed in relation to the goods for which it is registered. The word WELL is not descriptive of the goods at issue, i.e. *clothing, footwear, lingerie and hosiery* and

the evidence relating to the presence of the element WELL in other marks, in the field concerned, is not sufficient to establish that this element has become weakly distinctive⁵. I consider that the earlier mark has an average degree of distinctiveness in respect of all the goods.

Comparison of marks

34. 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 them, 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.”

35. It would be wrong therefore artificially to 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 them. The marks to be compared are:

Application	Earlier mark
WELL BEGUN	WELL

⁵ *Hipp & Co v OHIM-Laboratorios Ordesa (Bebimil)*, T-221/06

Overall impression

36. Before coming onto a comparison of the similarities and differences between the marks, I need to address the applicant's request regarding the provision of evidence in relation to the dominance of WELL in WELL BEGUN and the similarities of the marks. This is not, strictly speaking, something that an opponent bringing a claim under Section 5(2)(b) must address in its evidence. Consequently, I have not given any weight to the applicant's request or to the opponent's failure to meet it.

37. In terms of overall impression, the earlier mark consists of the single word WELL presented in upper case, being self-evidently the only and therefore the dominant and distinctive part of the mark.

38. The applied for mark consists of two separated words, WELL and BEGUN, presented in capital letters. Whilst there is some discussion between the parties as to the dominance of the word WELL in WELL BEGUN, neither word materially dominates the other. This means that both words make a roughly equal contribution to the overall impression the mark conveys.

Visual and aural similarity

39. Visually, the respective marks share the element WELL, being the only component of the opponents' mark and the first component of the applicant's mark. They differ in that the applicant's mark contains the additional element BEGUN. This results in a medium level of visual similarity. Aurally, the considerations are similar with the opponents' mark consisting of the single syllable U-ELL and the applicant's mark consisting of the two syllables U-ELL B-GAN. They also share a medium level of aural similarity.

Conceptual similarity

40. Conceptually, there is a submission/evidence from the applicant that the word WELL will be understood as a generic word associated in the mind of consumers most

commonly with an adverb, but also an adjective, exclamation, noun or verb. This is supported by the evidence, which shows that the word WELL has, inter alia, the following meaning:

- Adverb:
 1. In a good or satisfactory way
"The whole team played well"
 2. In a thorough manner
"Add the mustard and lemon juice and mix well"
 3. [With modal] Very probably; in all likelihood.
"Being short of breath may well be the first sign of asthma"
- Adjective
 1. In good health; free or recovered from illness,
"I don't feel very well"
- Exclamation
 1. Used to express a range of emotions including surprise, anger, resignation, or relief,
"Well, really! The manners of some people!"
- Noun
A shaft sunk into the ground to obtain water, oil, or gas.
- Verb (often well up)
[No object, with adverbial] (Of a liquid) rise up to the surface and spill or be about to spill.
"Tears were beginning to well up in her eyes"

41. The opponent accepts that the word WELL has a number of meanings and that it is not clear what meaning the average consumer would attribute to it in the context of the goods at issue. As to the conceptual similarity, it does not really explain why it considers that the mark are conceptually similar. It states:

"The word WELL has a number of meanings including good health and a location from where water may be drawn. In view of the nature of the goods for which protection is sought it cannot be assessed as to what meaning

consumers of the goods would place on the goods of the Opponent's earlier right.

The contested mark consists of the words WELL BEGUN presented in no particular stylisation. The word "BEGUN" is the past participle of "BEGIN" and in its totality the trade mark WELL BEGUN would be seen as a new development of the opponent's goods marketed under the trade mark WELL.

The respective marks WELL and WELL BEGUN are visually, aurally and conceptually similar [...]"

42. Turning to the evidence in relation to WELL BEGUN being part of the phrase "well begun is half done", I do not accept the applicant's evidence and submission to the effect that it is a well-known expression. I am far from convinced that the average consumer will, on seeing the applicant's mark, associate it to with that expression, let alone with Mary Poppins. Though there is some evidence of a small number of uses of the phrase "well begun is half done" on UK websites, there is no evidence that it is well known to the general public⁶. That said, I accept that the meaning of WELL BEGUN is likely to be understood by the average consumer, as meaning something that begun in a positive manner/is well underway. In this connection, I note that the online Oxford English dictionary contains the following definition:

Well-begun

Adjective

Begun in a positive or promising manner; properly or correctly started.

43. Though the spelling convention employed by the dictionary definition uses a hyphen, it does not seem to me that the absence of a hyphen in the applied for mark affects its meaning. As the element WELL will be seen as an adjective qualifying the word BEGUN, the conceptual weight of the component WELL will be less than that of the component BEGUN. Accordingly, I find that in the applied mark the words WELL and BEGUN will be read and clearly understood as a unit conveying the specific and

⁶ See *Chorkee Ltd v Cherokee Inc.*, Case BL O/048/08

distinct meaning envisaged above. This puts a clear conceptual distance between WELL BEGUN and WELL *solus*.

Likelihood of confusion

44. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has retained in his mind.

45. There are two types of relevant confusion to consider: direct confusion (where one mark is mistaken for the other) and indirect confusion (where the respective similarities lead the consumer to believe that the respective goods and services come from the same or a related trade source). This distinction was summed up by Mr Iain Purvis Q.C. sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“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.”

46. Earlier in my decision I found that the respective specifications are similar to various degree and that they include identical goods. The goods will be selected by predominantly visual means, although I do not discount aural considerations. The average consumer is the general public paying a normal degree of attention. The earlier mark is distinctive to a normal degree. The marks are visually and aurally similar to a medium degree. Conceptually, I find that the conceptual impact of the applied for mark is such that it is sufficient to counteract the visual and phonetic similarities between the marks⁷. **There is no likelihood of confusion, either direct or indirect.**

Conclusion

47. The partial opposition fails and subject to appeal, the application can proceed to registration in its entirety.

COSTS

48. The applicant has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. As the applicant is not professionally represented, at the conclusion of the proceedings the Tribunal invited it to indicate whether it intended to make a request for an award of cost and, if so, to complete a pro-forma indicating a breakdown of its actual costs, including providing accurate estimates of the number of hours spent on a range of given activities relating to the prosecution of the opposition; it was made clear to the applicant that if the pro-forma was not completed “no costs, will be awarded”. The applicant responded to the invitation indicating that it spent a total of 46 hours dealing with the matter. This was split as follows: “Consideration of opposition submissions” 14 hours, “Evidence, including research on cited cases, preparation of witness statement, including gathering of witness statement” 21 hours, “Preparation and submission of written statements/submissions” 7 hours and “Commenting on opposition submissions” 4 hours. The pro-form was sent by Nicholas Morley. The email signature identifies Mr Morley as Managing Director of the applicant. He stated:

⁷ Case T-185/02, *Ruiz-Picasso and Others v OHIM – DaimlerChrysler* [2004] ECR II-1739

“My consultancy rate is £100 per hour which should be applied to this estimated time. I attach a purchase order from one of my clients which evidences this.”

49. The document attached is a purchase order for activities which seem unrelated to the current proceedings.

50. Given that Mr Morley is the applicant’s Managing Director, I consider that the applicant must be considered as having acted in its own behalf, i.e. as a litigant in person without a legal representative. The minimum level of compensation for litigants in person is of £19 per hour⁸. I will proceed on that basis.

51. As an unrepresented party, I accept that it was necessary for the applicant to familiarise itself with the Notice of Opposition and having done so, to research the position and to formulate an appropriate response; the applicant’s activities includes the filing of a counterstatement as well as the submission of evidence and written submissions. The applicant has provided no explanation of how it arrived at the figure of 46 hours and, absent such an explanation, I do not consider it can be justified. Having regard to the fact that the opposition was based only on one ground, i.e. Section 5(2)(b and that the evidence filed by both parties was very light, I consider that it would be reasonable to order the opponent to pay £600. This is within the published scale and also would not breach the rule that the costs allowed to a litigant in person should not exceed two-third of the amount that would have been allowed had the litigant in person been legally represented⁹.

52. I order CSP Paris Fashion Group to pay Faering Ltd to the sum of £600. 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.

⁸ CPR 46.5 and Practice Direction 46

⁹ See BL 077/13 and CPR 46.5. On the basis of the figures suggested in TPN 2/2016 I would have likely awarded to a professionally represented applicant £900 broken down as follow: £200 for preparing a statement and considering the other side’s statement, £500 for preparing evidence and considering and commenting on the other side’s evidence and £200 for written submissions.

Dated this day 17th May 2018

Teresa Perks

For the Registrar

The Comptroller – General