

**O/108/21**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF  
TRADE MARK APPLICATION NO. 3429134  
IN THE NAME OF DAVID NUENS CUBA  
FOR THE TRADE MARK:**

**3AGATA**

**IN CLASS 14**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 000418557  
BY AGATHA DIFFUSION**

## Background and pleadings

1. On 17 September 2019, David Nuens Cuba (“the applicant”) applied to register the trade mark

**3AGATA**

for the following goods:

Class 14 *Agate as jewellery; Semi-precious articles of bijouterie; Semi-precious gemstones; Semi-precious stones; Gold plated bracelets; Gold plated brooches [jewellery]; Gold plated earrings; Gold plated rings; Bracelets [jewellery]; Bracelets [jewelry]; Brooches [jewellery]; Ear clips; Jewellery in non-precious metals; Jewellery in semi-precious metals; Jewellery stones; Semi-precious gemstones; Semi-precious stones; Silver-plated bracelets; Silver-plated earrings; Silver-plated necklaces; Silver-plated rings; Gemstones; Gold jewellery; Gold necklaces; Gold plated bracelets; Gold plated brooches [jewellery]; Gold plated chains; Gold plated earrings; Gold plated rings; Gold-plated earrings; Gold-plated necklaces; Gold-plated rings.*

2. The application was published for opposition purposes on 27 September 2019.

3. The application is opposed by Agatha Diffusion (“the opponent”). The opposition was filed on 26 November 2019 and is based upon Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all of the goods in the application. The opponent relies upon its UK trade mark registration number 1466800 (series of 2), shown below, which has a filing date of 06 June 1991 and for which the registration procedure was completed on 05 February 1993:

**AGATHA**

# AGATHA

4. The opponent relies upon all of the goods for which the earlier mark is registered, namely:

Class 14     *Precious metals and their alloys and articles in precious metals or coated therewith; jewellery, precious stones; horological and chronometric instruments; all included in Class 14.*

5. In its notice of opposition, the opponent submits that the applicant's mark is phonetically similar to the earlier mark, especially when taking into account the imperfect recollection of the consumer of the marks they encounter in the marketplace and for spoken telephone orders of the goods. It further submits that the goods applied for are identical and/or highly similar to the goods of the opponent, all of which is likely to cause confusion. In view of this, the opponent submits that the application should be refused in its entirety.

6. The applicant filed a counterstatement. As these are the only comments I have from the applicant, they are reproduced in full, and as written, below:

**“3agata brand has no connection with the French brand, agate in Portuguese means a stone name so the phoneme is totally different and the writing also, 3agata, our brand is basically the same name of the products we sell. therefore it has no link whatsoever and can neither be confused nor linked to the contested mark.”**

7. Although the opponent's earlier mark was more than five years old at the filing date of the application, no proof of use has been requested by the applicant.

8. The opponent filed evidence and I will summarise this to the extent that I consider necessary. The opponent also filed written submissions in support of its opposition on 22 July 2020. These will not be summarised further at this stage, but they will be referred to as and where it is considered appropriate throughout this decision.

9. No hearing was requested so this decision is taken following a careful perusal of the papers.

10. In these proceedings, the opponent is represented by Novagraaf UK and the applicant is a litigant in person.

## **Evidence**

11. The opponent filed a witness statement in the name of Alastair John Rawlence, a Trade Mark Attorney employed by Novagraaf UK. It is dated 21 July 2020. The purpose of Mr Rawlence's evidence was to adduce one exhibit (labelled *Exhibit AR1*). The content of this exhibit is a Wikipedia entry attained following a search of the internet carried out by Mr Rawlence for the term 'agata'. The result was located at [https://en.wikipedia.org/wiki/Agatha\\_%28given\\_name%29](https://en.wikipedia.org/wiki/Agatha_%28given_name%29) and is replicated below:

*Exhibit AR1*

Agatha (given name) - Wikipedia 21/07/2020, 09:11

WIKIPEDIA

## Agatha (given name)


**Agatha** also **Agata**, is a feminine given name derived from the Greek feminine name Ἀγάθη (*Agáthē*; alternative form: Ἀγαθή *Agathē*), which is a nominalized form of ἀγαθή (*agathē*), i.e. the feminine form of the adjective ἀγαθός (*agathós*) "good".<sup>[2][3][4]</sup>

It was the name of St. Agatha of Sicily, a third-century Christian martyr. The name has been rarely used in English-speaking countries in recent years.<sup>[5]</sup> It was last ranked among the top 1,000 names for girls born in the United States during the 1930s.<sup>[6]</sup>

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**Agatha**



An Orthodox icon of St. Agatha of Sicily, the saint responsible for the wide usage of the name Agatha

<b>Pronunciation</b>	<span><span>/<span><span>ˈ</span><span>æ</span><span>ɡ</span><span>ə</span><span>θ</span><span>ə</span></span>/</span><sup>(1)</sup></span>
<b>Gender</b>	Female
<b>Language(s)</b>	Ancient Greek
<b>Origin</b>	
<b>Meaning</b>	"good"
<b>Other names</b>	
<b>See also</b>	Ag, Aggy, Aggi, Aggie

### Russian name

In Russian, the name "Arára" (*Agata*) was borrowed from the Western European languages, and derives from the same Ancient Greek root from which older names *Agafya*<sup>[7]</sup> and *Agafa*<sup>[8]</sup> also come. Its masculine version is *Agat*.<sup>[9]</sup> In 1924–1930, the name was included into various Soviet calendars,<sup>[10]</sup> which included the new and often artificially created names promoting the new Soviet realities and encouraging the break with the tradition of using the names in the Synodal Menologia.<sup>[11]</sup>

Its diminutives include **Agatka** (Ага́тка), **Aga** (А́га), and **Gata** (Га́та).<sup>[8]</sup>

[https://en.wikipedia.org/wiki/Agatha\\_\(given\\_name\)](https://en.wikipedia.org/wiki/Agatha_(given_name)) Page 1 of 6

## DECISION

12. The opposition is based upon section 5(2)(b) of the Act, which reads as follows:

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

...

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

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

13. 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) a European Union 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.”

14. Given its filing date, the trade mark upon which the opponent relies qualifies as an earlier trade mark under the above provisions. The earlier mark was registered more than 5 years before the date of application for the contested mark and so the applicant could have required the opponent to provide proof of use of the mark under section 6A of the Act. As it did not do so, the opponent is able to rely on all the goods for which the earlier mark is registered.

15. Although the UK has left the European Union, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. Therefore, this decision contains references to the trade mark case-law of the European courts.

## **Section 5(2)(b) –**

16. 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 Office for Harmonisation in the Internal Market (Trade Marks and Designs) (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 to mind the earlier mark, 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 and services**

17. When making the comparison, all relevant factors relating to the goods and services in the specification should be taken into account. In *Canon*, Case C-39/97, the Court of Justice of the European Union (CJEU) stated at paragraph 23 of its judgment that:

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



18. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

“(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. 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.”

19. In *Gérard Meric v OHIM*, Case T-133/05, the General Court stated that:

“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”.<sup>1</sup>

20. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to

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<sup>1</sup> Paragraph 29

be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

21. The goods to be compared are:

Opponent's goods	Applicant's goods
<p><u>Class 14</u>  <i>Precious metals and their alloys and articles in precious metals or coated therewith; jewellery, precious stones; horological and chronometric instruments; all included in Class 14.</i></p>	<p><u>Class 14</u>  <i>Agate as jewellery; Semi-precious articles of bijouterie; Semi-precious gemstones; Semi-precious stones; Gold plated bracelets; Gold plated brooches [jewellery]; Gold plated earrings; Gold plated rings; Bracelets [jewellery]; Bracelets [jewelry]; Brooches [jewellery]; Ear clips; Jewellery in non-precious metals; Jewellery in semi-precious metals; Jewellery stones; Semi-precious gemstones; Semi-precious stones; Silver-plated bracelets; Silver-plated earrings; Silver-plated necklaces; Silver-plated rings; Gemstones; Gold jewellery; Gold necklaces; Gold plated bracelets; Gold plated brooches [jewellery]; Gold plated chains; Gold plated earrings; Gold plated rings; Gold-plated earrings; Gold-plated necklaces; Gold-plated rings.</i></p>

22. The opponent submits that both sets of goods fall in class 14 and that taking into account the relevant factors for assessing similarity as outlined in *Treat*, the respective parties' goods are identical and/or highly similar to one another.

23. While making my comparison. I bear in mind the comments of Floyd J. (as he then was) in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch):

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."<sup>2</sup>

24. In *Sky Plc & Ors v Skykick UK Ltd & Anor* [2020] EWHC 990 (Ch), Arnold LJ set out the following summary of the correct approach to interpreting broad and/or vague terms:

"...the applicable principles of interpretation are as follows:

- (1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.
- (2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.
- (3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.
- (4) A term which cannot be interpreted is to be disregarded."<sup>3</sup>

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<sup>2</sup> Paragraph 12

<sup>3</sup> Paragraph 56

25. “*Agate as jewellery*”. Agate is a gemstone often used to make jewellery. The term has been qualified as jewellery itself and I therefore consider it to be identical to the term “*jewellery*” in the opponent’s specification.

26. “*Gold plated bracelets; Gold plated brooches [jewellery]; Gold plated earrings; Gold plated rings; Bracelets [jewellery]; Bracelets [jewelry]; Brooches [jewellery]; Ear clips; Jewellery in non-precious metals; Jewellery in semi-precious metals; Silver-plated bracelets; Silver-plated earrings; Silver-plated necklaces; Silver-plated rings; Gold jewellery; Gold necklaces; Gold plated bracelets; Gold plated brooches [jewellery]; Gold plated chains; Gold plated earrings; Gold plated rings; Gold-plated earrings; Gold-plated necklaces; Gold-plated rings*”. These goods are all types of jewellery and are therefore encompassed in the broader category of “*jewellery*” of the earlier mark, rendering them identical to the term as per the principle outlined in *Meric*.

27. “*Jewellery stones; Gemstones*”. A gemstone is a jewel or stone used in jewellery which is commonly classified as being either precious or semi-precious. The opponent’s specification includes “*precious stones*”. I find precious stones to fall within the broader category of “*Jewellery stones; Gemstones*” in the applicant’s specification. I therefore find the goods to be identical as per *Meric*.

28. “*Semi-precious gemstones; Semi-precious stones; Semi-precious gemstones; Semi-precious stones*”. As mentioned previously, a gemstone is a jewel or stone often used in jewellery, rather than being jewellery *per se*. The physical nature of these goods is highly similar to that of the opponent’s *Precious stones*. Both precious and semi-precious stones would serve the same use as a component of jewellery, by the same users and they would share the same channels of trade. There is a degree of competition between them as a jeweller could decide to use either type of stone. I therefore consider that there is a high degree of similarity between the semi-precious gemstones/stones in the contested mark and the “*precious stones*” of the earlier mark.

29. “*Semi-precious articles of bijouterie*”. The word “*bijouterie*” is defined by the Collins English Dictionary as “1. *jewellery esteemed for the delicacy of the work rather than the value of the materials*” and “2. *a collection of such jewellery*”<sup>4</sup>. As such, I find the term to be identical to the term “*jewellery*” in the opponent’s mark as per *Meric*.

### **The average consumer and the nature of the purchasing act**

30. As case law indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods. I must then decide the manner in which these goods are likely to be selected by the average consumer 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. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

32. Jewellery may be classed as “costume” jewellery, i.e. jewellery that is decorative but has little intrinsic value, or may be high end which has been crafted from valuable metal such as gold and may be adorned with precious or semi-precious stones.

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<sup>4</sup> <https://www.collinsdictionary.com/dictionary/english/bijouterie>

33. The average consumer of the goods at issue is a member of the general public, or, particularly in the case of *precious stones*, *semi-precious gemstones*, and *jewellery stones*, professional jewellery designers/makers and hobbyists.

34. The goods are sold through a range of channels, including retail premises such as jewellery stores, department stores and from gemstone specialists, as well as online. The act of purchasing will be based on aesthetics and functionality and will be a primarily visual process. In retail stores, jewellery goods/bijouterie may be displayed on shelves, where they will be viewed and self-selected by the consumer. A similar process will apply to websites, where the consumer will select the goods having viewed an image displayed on a web page. More expensive items will be stored in a cabinet/behind the counter of the retail outlet where the consumer will need to make a request to view and/or purchase them.

35. Considered overall, the selection process by the general public will, in my view, be a predominantly visual one, although aural considerations will play their part and may include verbal recommendations from specialists. The value of the goods will vary from relatively inexpensive for costume jewellery and bijouterie which, while not an everyday purchase, may be bought on a semi-regular basis, to moderately expensive/very expensive for gemstones and high quality pieces of jewellery which are purchased infrequently. The level of attention will therefore vary accordingly from a medium level of attention for costume jewellery and the like and to a high level of attention for the most expensive items of goods.

36. The professional consumer will purchase the goods more frequently and will wish to ensure that the goods are fit for purpose and most importantly that they are of a quality commensurate with the reputation of their business. The purchasing process will be predominantly visual, although I do not discount the aural element as the consumer may seek information from the purveyor of the goods. They are therefore likely to pay a high degree of attention to their selection.



## Comparison of marks

37. 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.”

38. It would be wrong, therefore, to artificially dissect the trade marks, 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.

39. The trade marks to be compared are as follows:

Opponent's trade mark (series of 2)	Applicant's trade mark
	

40. The opponent's trade mark consists of a series of two marks as shown above.

While the font differs slightly between the two marks of the series, in both, the mark consists of the word “AGATHA” presented in a standard font and capital letters without any other elements to contribute to the overall impression. The overall impression conveyed by the marks therefore rest in the word itself. As nothing turns upon the slight difference in stylisation of the series of marks, for convenience, I will, from this point refer to the series in the singular, though my comments should be taken as referring equally to both marks in the series.

41. The earlier mark is a plain word and I agree with the opponent’s submission that the word would be perceived as a woman’s name “AGATHA”. The opponent further submits that the name Agatha is also commonly spelt as ‘Agata’ and has included a Wikipedia entry to support this by way of *Exhibit AR1* which has been reproduced in full at paragraph 14 of this decision.

42. The applicant’s mark consists of a number of components. The mark is presented in monochrome with the number 3 and the letters AGATA conjoined in large black capitals in a fairly standard font. I agree with the opponent’s view that the composite phrase would be pronounced as two separate words “THREE AGATA”. However, I disagree that the “AGATA” element would be the dominant component within the mark as a whole. In *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the General Court noted that the beginning of words tend to have more visual and aural impact than the ends, although I accept that this is not always the case. However, in this instance I consider that it is the combination of the number and letter which together would make the greater contribution to the overall impression of the mark. Directly above the letter “G” is a small device element that is likely to be perceived as a shining gemstone. This device is not particularly striking or fanciful and reinforces the message of gemstones and/or jewellery. The contribution it makes to the overall impression of the mark is, in my view, small.

### **Visual comparison**

43. As the opponent submits, both parties’ marks are of identical length, both presented as a single word consisting of 6 characters which share 5 letters in



common. The applicant's mark, which has the number 3 at the start of the word, contains the additional figurative element as previously described, resulting in what I find to be a low degree of visual similarity between the two marks.

### **Aural comparison**

44. The earlier mark would be pronounced as three syllables "A-GA-THA" with the stress on the first syllable. The contested mark would be pronounced as two separate words of one and three syllables respectively: "THREE" and either "A-GA-TA" with the emphasis on the first syllable, or "A-GAT- A", with the emphasis on the second syllable. The figurative element within the applicant's mark would not be articulated. In view of this, I find the competing marks to be aurally similar to a low to medium degree, depending on how the applicant's mark is articulated.

### **Conceptual comparison**

45. In my view, it is likely that the average consumer would consider the earlier mark to be an invented word, although the device might make some consumers draw a link with "agate".

46. As mentioned above, the earlier mark would be recognised as a female forename. In *Luciano Sandrone v European Union Intellectual Property Office (EUIPO)*, Case T-268/18, General Court ("GC") held that:

"84. Similarly, according to the case-law, conceptual similarity means that the signs at issue convey analogous semantic content (judgment of 11 November 1997, *SABEL*, C-251/95, EU:C:1997:528, paragraph 24).

85. Therefore, a first name or a surname which does not convey a 'general and abstract idea' and which is devoid of semantic content, is lacking any 'concept', so that a conceptual comparison between two signs consisting solely of such first names or surnames is not possible.

86. Conversely, a conceptual comparison remains possible where the first name or surname in question has become the symbol of a concept, due, for example, to the celebrity of the person carrying that first name or surname, or where that first name or that surname has a clear and immediately recognisable semantic content.

87. The Court has thus previously held that the relevant public would perceive marks containing surnames or first names of persons as having no specific conceptual meaning, unless the first name or surname is particularly well known as the name of a famous person (see, to that effect, judgments of 18 May 2011, *IIC v OHIM — McKenzie (McKENZIE)*, T-502/07, not published, EU:T:2011:223, paragraph 40; of 8 May 2014, *Pedro Group v OHIM — Cortefiel (PEDRO)*, T-38/13, not published, EU:T:2014:241, paragraphs 71 to 73; and of 11 July 2018, *ANTONIO RUBINI*, T-707/16, not published, EU:T:2018:424, paragraph 65).”

47. It is my view that the forename “AGATHA” does not have any clear and recognisable semantic content, and so no conceptual comparison can be made.

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

48. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

49. 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 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 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 1-0000, paragraph 49).

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

50. The opponent submits that the mark has no obvious descriptive relation to the registered goods in Class 14 or the jewellery sector as a whole and therefore has a high level of inherent distinctiveness for jewellery products. It does not claim that the distinctiveness of the mark has been enhanced through use.

51. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

52. Forenames will, according to Registry practice, normally be accepted as having distinctive character. Although there are some goods which are commonly personalised, such as bracelets or necklaces, the fact that the mark has been registered for these goods means that I must assess it as having some distinctive character.

53. Agatha is not currently a name that I consider to be a common forename. I consider the mark to be neither descriptive nor allusive of the opponent's goods. It is not, however, highly unusual as an invented word would be. Therefore, I find the earlier mark to be inherently distinctive to a medium degree for all the goods covered by the mark.

### **Likelihood of confusion**

54. There is no simple formula for determining whether there is a likelihood of confusion. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind.

55. I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them 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 (*Canon* at [17]). In making my assessment, I must consider the various factors from the perspective of the average consumer, bearing in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

56. There are two types of possible confusion: direct, where the average consumer mistakes one mark for the other, or indirect, where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related. The distinction between these was explained by Mr Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v Back Beat Inc*, Case BL-O/375/10. He said:

“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)."

57. The above are examples only which are intended to be illustrative of the general approach. These examples are not exhaustive but provide helpful focus.

58. Earlier in this decision, I found that:

- The competing goods are either identical or similar to a high degree;

- The average consumer is a member of the general public or a professional, such as a jewellery designer/maker or a hobbyist, and for all consumers the selection of goods will be predominantly visual, although I do not discount aural considerations;
- The level of attention paid by the general consumer in the purchasing process will vary from a medium degree for costume jewellery and the like and to a high level of attention for the most expensive items of goods, with the professional consumer paying a high level of attention during the purchasing act;
- The competing trade marks are visually similar to a low degree and are aurally similar to a low to medium degree, depending on how the applicant's mark is articulated;
- Some consumers would see "AGATA" as an alternate spelling of "AGATHA", however, the forename "AGATHA" is conceptually neutral;
- Some consumers would see "3AGATA" as an invented word which would have no concept, while other consumers would make the link between the mark "3AGATA" and the English word "agate";
- The earlier mark is inherently distinctive to a medium degree.

59. Even allowing for imperfect recollection and taking into account that I consider the respective goods to be identical or highly similar, which offsets a lesser degree of similarity between the marks, I do not consider there is any likelihood of direct confusion as the differences between the marks are too great for confusion to arise.

60. The opponent submits that even though the marks may not be directly confused and mistaken for one another, the average consumer will believe that the goods sold under the respective marks are the goods of the same or an economically linked undertaking.

61. I am unconvinced by the opponent's argument that there is a likelihood of indirect confusion. I acknowledge that the categories listed by Mr Iain Purvis Q.C. in *L.A. Sugar* are not exhaustive, but I do not see anything which would lead the average consumer into believing that one mark is a brand extension of the other. I therefore find no likelihood of indirect confusion.

### **Outcome**

62. The opposition has failed and, subject to any successful appeal, the application may proceed to registration.

### **Costs**

63. The applicant has been successful and consequently would be entitled to a contribution towards its costs. As he is a litigant in person, the Registry invited him to submit a proforma detailing the time spent on particular activities associated with this opposition. It informed him that, if the proforma were not returned, then, should he be successful, no costs would be awarded beyond the reimbursement of any official fees. No fees are charged for a defence and so I make no award of costs.

**Dated this 19<sup>th</sup> day of February 2021**

**Suzanne Hitchings**  
**For the Registrar,**  
**the Comptroller-General**