

O/484/21

TRADE MARKS ACT 1994

TRADE MARK APPLICATION No. 3419713

BY SHAKERA TAYUB

AND

OPPOSITION No. 418473

BY SHAKIRA MEBARAK

Background and pleadings

1. This is an opposition by the musical artist known as Shakira (“the opponent”) to an application filed on 7th August 2019 (“the relevant date”) by Shakera Tayub (“the applicant”).

2. The contested trade mark is shown below.



3. The applicant applies to register the mark in relation to:

Class 4: Candles; fragranced or scented candles; aromatherapy candles; candle wicks; nightlights.

Class 20: Furniture; mirrors; picture frames; body pillows; pillow forms; cushions; picture frames; plate racks; seat cushions; furniture seats; window shades [blinds]; chair pads; seat covers; decorative fabric pillows; trinket boxes.

Class 21: Dishes; glassware; tableware; coffee pots; teapots and tea kettles; tea cups; trays; cake stands; cutting boards; pastry boards, candle holders; coasters; drying racks; sponges; flasks; food containers.

Class 24: Textiles; upholstery (fabrics); textile piece goods; bed and table covers; household linen; linen cloth; bed linen; bath linen; table linen; table cloths; curtains of textile or plastic; pillow shams; pillow cases; sheets; towels; duvets; covers for duvets; covers for cushions; cushion covering materials; table runners; table mats; napery; napkins; table mats (not of paper); towels; flannels; tissues (textile); traced cloth for embroidery; tapestry (wall hangings) of textile; rugs (travelling); furniture coverings of plastic; blankets; coasters; eider downs; furniture coverings; handkerchiefs; mattress covers.

Class 25: Clothing, namely, scarves, shawls, capes, saris, kimonos, headbands and wristbands, sarongs, headbands, ties and belts

4. The opponent, whose full name is Shakira Mebarak, is the proprietor of EU trade mark 2870863, which consists of the word SHAKIRA. The application to register this mark was filed on 1st October 2002 and the mark was entered in the EU trade mark register on 1st July 2004. The earlier trade mark is registered for goods and services in four classes, but the only goods and services relied on for the purposes of this opposition are *clothing* in class 25 and *entertainment services in the nature of live performances* in class 41.

5. The opponent claims that the earlier trade mark is highly similar to the contested trade mark and the goods in class 25 are identical. Therefore, there is a likelihood of confusion on the part of the public. Consequently, the application to register the contested trade mark in class 25 should be refused under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”).

6. Additionally, the opponent claims that the earlier mark has acquired a reputation in the EU (which included the UK at the date the opposition was filed) in relation to the goods/services described in paragraph 4 above. The opponent claims that the public will make a link between the earlier mark and the contested mark and that its use will, without due cause, take unfair advantage of, and /or be detrimental to, the reputation and distinctive character of the earlier mark. Consequently, the application should be refused in its entirety under section 5(3) of the Act.

7. Additionally, the opponent claims to be the proprietor of an earlier unregistered right in SHAKIRA as a result of the use of that mark in the UK since 2001 in relation to *clothing, entertainment services in the nature of live performances, recordings of live performances, music, and musical recordings*.

8. The opponent claims that use of the contested mark would constitute a misrepresentation to the public that the applicant is, or is connected to, the opponent. According to the opponent, this will result in damage to the opponent’s goodwill. Consequently, the application should be refused in its entirety under section 5(4)(a) of the Act.

9. The applicant filed a counterstatement denying the grounds of opposition. I note, in particular, that:

- (i) The opponent was put to proof of the use of the earlier trade mark relied on for the purposes of the ss.5(2) and 5(3) grounds of opposition;
- (ii) The opponent was put to proof of the reputation claimed under SHAKIRA in the EU and UK in relation to *clothing* in class 25 and *entertainment services in the nature of live performances* in class 41;
- (iii) The opponent was put to proof that she owned a protectable goodwill in the UK at the relevant date sufficient to provide a cause of action under the law of passing off;
- (iv) The applicant denied that the name Shakira designates only the opponent; the applicant asserts that the names Shakira and Shakera are common to those of South Asian or Middle Eastern descent, therefore such similar sounding names could designate many people;
- (v) The applicant claims to be an established print designer, therefore her customers will be looking for goods with quality designs, whereas the public seeking to purchase the opponent's merchandise will be looking for something bearing her name or image.

10. Both sides seek an award of costs.

Representation

11. The applicant is represented by Lewis Silken LLP. The opponent is represented by Bear & Wolf (UK) LLP. Only the opponent filed evidence. Both sides filed written submissions during the evidence rounds. Neither side requested a hearing, but both sides filed further written submissions in lieu. Therefore, this decision is taken after a careful appraisal of the opponent's evidence and all the submissions received.

The evidence

12. The opponent's evidence consists of two witness statements (with 46 exhibits) by Jaime Levine, who has been Shakira's manager since 2008. The second of Ms Levine's statements was filed in reply to the applicant's submissions criticising the evidence given in her first statement.

13. The purpose of Ms Levine's evidence is show that the earlier trade mark has been used in relation to clothing/live entertainment services and to substantiate the opponent's claims of a reputation and goodwill under the name Shakira.

Proof of use

14. The opponent's earlier trade mark had been registered for more than 5 years at the relevant date. Therefore, s.6A of the Act makes reliance on the registration of that mark subject to proof of genuine use of the trade mark in the EU during the 5 year period ending on the relevant date, i.e. 8th August 2014 to 7th August 2019.

15. Proof of such use of the earlier mark is required in relation to *clothing* in class 25 and *entertainment services in the nature of live performances* in class 41. In this connection, I note that s.100 of the Act states:

"100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it."

16. Ms Levine explains that all financial transactions relating to Ms Mebarak's career-related activities as an artist are made through a company registered in Luxembourg called Ace Entertainment. Ms Levine says that any use of the mark by that company, or by her management company (called JL Creative LLC), or by others working with Ms Mebarak, is with Ms Mebarak's consent.

17. According to Ms Levine, Ms Mebarak is an internationally renowned singer, songwriter, dancer, record producer and actress. She was born in Colombia. Her first four albums were in Spanish. Ms Mebarak's first English language album, entitled *Laundry Service*, was released in 2001. In 2006 she released the single *Hips Don't*

Lie which made it to number 1 in the UK and some other countries in the EU. The song stayed in the UK charts for 48 weeks.

18. Ms Mebarak appeared as Shakira on the UK TV show *The Voice* in 2014 where she performed live in front of a TV audience of over 8m.¹ However, this appears to have been in March 2014 and, therefore, before the beginning of the 5-year period during which the opponent must show use of the earlier mark in relation to live entertainment services.

19. In 2018, Ms Mebarak, as Shakira, embarked on her *El Dorado* World Tour in support of her eleventh studio album of the same name. The tour comprised a total of fifty-four live concert performances in Europe, Asia, North America and Latin America. The tour began on 3 June 2018 in Hamburg, Germany and ended on 3 November 2018 in Bogotá, Colombia. Eighteen of those concert performances took place at sixteen locations in the EU, including Paris (2), London, Madrid, Lisbon, Milan, Munich, Bordeaux and Barcelona (2). Over 240k people attended the events held in the EU generating over £11.5m in revenue. SHAKIRA was used, inter alia, on the tickets for these events.² The tour received considerable publicity, including in UK national papers, such as *The Times*, *The Telegraph* and *The Guardian*.³

20. As regards the use of the SHAKIRA mark in relation to clothing, Ms Levine's evidence is that "*Shakira has for many years designed, marketed and sold various items of clothing and apparel, bearing the mark.*" The clothing is sold at Ms Mebarak's concerts and also through the website *shakira.com*, and the associated website *shakiramerchandise-eu.com*. According to Ms Levine, the clothing sold under the mark comprises T-shirts, tank tops, hoodies/sweatshirts, crop tops, jackets, vests, sweatpants/joggers, shorts, caps, beanies and tote bags. Exhibit JAL24 is said to illustrate the range of clothing sold under the mark. I note this shows use of SHAKIRA on t-shirts, crop tops, denim jackets, sweatshirts, hoodies, sweatpants, shorts, caps and beanies.

21. All of this is clearly merchandise for the *El Dorado* tour. Most of the items shown reference the tour. As one would expect, they are replete with images of Shakira and

¹ See exhibit JAL3

² See exhibit JAL18

³ See exhibit JAL17

most bear her name. Some of these are emblazoned across the chest of the garment, but others are more typical of trade mark use. For example, the t-shirt on page 7 of JAL24 has the name Shakira in relatively small letters across the arm of the garment. The sweatshirts on pages 21 - 23 of the exhibit show Shakira in small letters on one side of the chest where one would typically see a trade mark. The sweatshirt on page 28 has the word Shakira on the arm with other words emblazoned across the chest in a decorative manner. The sweatpants shown on page 32 of the exhibit show Shakira running down the side of the leg. Most of the goods have no other trade marks visible, such as in the neck label. The only exception to this is the denim jacket shown on page 19 of the exhibit, which has Urban Classics in the neck label.

22. Exhibit RAL25 is said to show all the clothing sold on the El Dorado tour in the EU during 2018. The figures show that 811 items were sold at the UK concert in London. Roughly the same sort of sales were achieved in Belgium and the Netherlands. Rather more sales of clothing items occurred at the concerts held in Germany, France and Spain, but fewer sales of these items were made in Italy, Portugal and Luxembourg.

23. Exhibit JAL23 shows the online EU sales of Shakira clothing between 2018 and 2019 associated with the El Dorado tour. Just over 100 sales in the EU are recorded. Twelve of these sales were made to UK consumers. The prices of the goods ranged from 15 – 60 euros.

24. Exhibit JAL28 shows sales made by Live Nation, which dealt with sales for the El Dorado tour. The sales of clothing shown appear to mostly match/duplicate the information provided in JAL25. They show that 100s of thousands of pounds of merchandise was sold on the EU leg of the El Dorado tour. Most of this was clothing, although the figures include sales of non-clothing items, such as jewellery and posters.

25. I now turn to the law. Although the UK has left the EU, 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 upon in these proceedings are derived from an EU Directive. That is why this decision continues to reference EU trade mark law.

26. In *Walton International Ltd & Anor v Verweij Fashion BV*,⁴ Arnold J. (as he then was) summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 Ansul BV v Ajax Brandbeveiliging BV [2003] ECR I-2439, La Mer (cited above), Case C-416/04 P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs) [2006] ECR I-4237, Case C-442/07 Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’ [2008] ECR I-9223, Case C-495/07 Silberquelle GmbH v Maselli-Strickmode GmbH [2009] ECR I-2759, Case C-149/11 Leno Merken BV v Hagelkruis Beheer BV [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG [EU:C:2013:592], [2014] ETMR, Case C-141/13 P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) [EU:C:2014:2089] and Case C-689/15 W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse [EU:C:2017:434], [2017] Bus LR 1795.

115. *The principles established by these cases may be summarised as follows:*

(1) *Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: Ansul at [35] and [37].*

(2) *The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: Ansul at [36]; Sunrider at [70]; Verein at [13]; Leno at [29]; Centrotherm at [71]; Reber at [29].*

(3) *The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the*

⁴ [2018] EWHC 1608 (Ch)

goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide;

and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) *Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no de minimis rule: Ansul at [39]; La Mer at [21], [24] and [25]; Sunrider at [72] and [76]-[77]; Leno at [55].*

(8) *It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: Reber at [32].”*

27. The applicant points out that:

- (i) Much of the evidence filed by the opponent is use of the name SHAKIRA to designate the artist, which would not necessarily indicate the trade origin of the goods and services on which the opposition is based;
- (ii) Much of the use described in the opponent’s evidence is outside the relevant period and/or outside the EU;
- (iii) The pictures showing clothing for sale on the opponent’s website appear to be from 2020, i.e. after the relevant date.

28. In support of the first point, the applicant draws my attention to the decision of Mr Richard Arnold QC (as he then was) as the Appointed Person in *Linkin Park LLC’s Application*.⁵ Linkin Park is the name of a musical group. The Appointed Person upheld the Registrar’s decision to refuse to register Linkin Park as a trade mark for, inter alia,

⁵ [2006] E.T.M.R. 74

posters. The Appointed Person agreed with the Registrar that the name described posters showing pictures of the group and was therefore ineligible for registration as a trade mark for such goods under section 3(1)(c) of the Act.

29. In *AS v Deutsches Patent – und Markenamt*,⁶ the CJEU held that all the relevant facts and circumstances must be taken into account when examining the distinctive character of a trade mark. In the absence of other indications, this means taking into account the types of use which, in the light of the customs in the sector concerned, can be “*practically significant*.” I accept that use of the name of an artist or musical group as a means of identifying the subject matter of a poster is a “*practically significant*” use of the name. However, I am not concerned here with whether the word SHAKIRA may be used to designate a characteristic of the goods/services at issue, and is therefore descriptive and barred by section 3(1)(c) of the Act from *prima facie* registration for clothing and live entertainment performances. The earlier EU trade mark relied on by the opponent is registered in relation to such goods/services. The earlier mark must therefore be treated as valid. The issue I am addressing is whether the proprietor has used the earlier mark in accordance with its essential function, i.e. “*to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin.*”

30. Whilst some of the uses of SHAKIRA relied on by the opponent are ambiguous in nature, I am satisfied that most of the uses of the earlier mark in relation to clothing (as described in paragraph 21 above) represent use of the earlier mark for the purpose of distinguishing clothing authorised by the opponent from clothing which is not so authorised. Consequently, I accept that the use shown of the earlier mark in relation to clothing was use in accordance with the essential function of a trade mark.

31. The use shown of the earlier mark in relation to *entertainment services in the nature of live performances* clearly served to identify services authorised by the opponent from services which were not so authorised. The issue may be more complicated when it comes to use of the earlier mark in relation to recordings of

⁶ Case C-541/18

performances, but I have no difficulty in accepting that the use of the name of a music artist in relation to live performances designates the trade source of those services.

32. In my view, the extent of the use of SHAKIRA shown in relation to the EU leg of the El Dorado tour in 2018 is more than sufficient to demonstrate genuine use of the earlier mark during the relevant period, in the EU, in relation to *entertainment services in the nature of live performances*. This finding is not disturbed by the fact that the opponent's evidence includes significant use of the mark in relation to such services outside the EU and/or outside the relevant period.

33. I accept the position is less clear cut when it comes to the use of the earlier mark in the EU during the relevant period in relation to clothing. In particular, the pictures in evidence showing use of the earlier mark in relation to clothing appear to postdate the relevant date. Further, the extent of the use of the mark in relation to clothing is relatively limited in extent and is concentrated in a relatively short period in 2018/19.

34. As regards the first point, Ms Levine's second witness statement explains that it was not possible to obtain printouts of the 'shop' section of the opponent's website from the internet archive site known as the 'WayBack Machine'. However, she confirms that the pictures of clothing shown in her first statement (some of which she also exhibits to her second statement⁷) represent clothing sold during the relevant period. I accept this evidence. Further, although the sales shown of Shakira clothing marketed in the EU during the relevant period was not on a massive scale, I find that the use of the mark was "*warranted in the economic sector concerned to maintain or create a share in the market for the goods.. in question.*" Consequently, I find that the opponent has shown use of the earlier trade mark in relation to certain kinds of clothing, specifically t-shirts, crop tops, denim jackets, sweatshirts, hoodies, sweatpants, shorts, caps and beanies.

35. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors*,⁸ Mr Justice Carr summed up the law relating to partial revocation as follows.

⁷ As exhibit JAL46

⁸ [2016] EWHC 3103 (Ch)

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; Thomas Pink Ltd v Victoria's Secret UK Ltd [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; Thomas Pink at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in Pan World Brands v Tripp Ltd (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; Thomas Pink at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. Maier v Asos Plc [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark

*has been used and which are not in substance different from them;
Mundipharma AG v OHIM (Case T-256/04) ECR II-449; EU:T:2007:46.”*

36. The case law in relation to partial revocation is also applicable to the task of deciding on an appropriate specification to cover the use shown of the earlier mark in opposition proceedings.

37. In my view, an average consumer would view the clothing sold under the mark SHAKIRA as representing the following sub-categories of clothing; namely, T-shirts, tops, jackets, sweatshirts, hoodies, pants and headgear. Consequently, I find that this list represents the clothing for which the opponent has established genuine of the earlier trade mark.

The section 5(2) ground of opposition

38. Section 5(2)(b) of the Act is 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”.

Identity/similarity of goods

38. The applicant’s submissions included a concession that the respective goods in class 25 are identical. However, that was on the basis of the registered specification of the earlier mark, not the reduced list of clothing for which genuine use has been established. The goods in class 25 at which the opposition under section 5(2) is directed, and the goods in the same class which are (a) relied on by the opponent under this ground, and (b) for which the earlier mark is entitled to protection having regard to the proof of use provided, are shown below.

Class 25 goods of the application	Goods in class 25 for which the earlier mark is entitled to protection
Clothing, namely, scarves, shawls, capes, saris, kimonos, headbands and wristbands, sarongs, headbands, ties and belts	T-shirts, tops, jackets, sweatshirts, hoodies, pants and headgear

39. *Head bands* are self-evidently items of *headgear*. These are identical goods. None of the other goods are identical.

40. In the judgment of the CJEU in *Canon*,⁹ the court stated at paragraph 23 of its judgment that:

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

41. Wristbands and headbands are similar in nature, both being small items of clothing intended to fit tightly around the head or wrists. The method of use is similar. They serve similar purposes, i.e. controlling the effects of perspiration and for decoration. In my experience, they may also be sold together as matching items. Although not in competition, I find these goods highly similar.

42. Ties and belts are items of clothing sold as accessories to other goods, such as jackets and pants. They are likely to be sold in the same type of shops. The same undertaking may be responsible for these goods. Therefore, they appear to be complementary goods in the sense described in the case law.¹⁰ In my view, these goods are similar to a medium degree.

⁹ Case C-39/97

¹⁰ See, by analogy, *Gitana SA, v OHIM*, Case T-569/11, concerning the similarity between clothing and leather goods in class 18, particularly paragraph 45 of the judgment

43. Scarves, shawls, and capes are pieces of fabric worn around the head and/or shoulders, usually over other clothes. They are used to provide additional warmth and for protection against the weather. Jackets and, to a lesser degree, hoodies, serve similar purposes. However, the method of use is different and the goods are not usually in competition. They are likely to be sold in the same type of shops. A cape, shawl or scarf may also be purchased so as to match a jacket. The same undertaking could be responsible for the goods. Therefore, they appear to be complementary goods in the sense described in the case law.¹¹ In my view, these goods are similar to a low to medium degree.

44. Sarongs and kimonos are worn around the body, partly for protection against the sun or wind, but also for modesty purposes. They are sometimes worn over beachwear. Tops and t-shirts may serve similar purposes. They are all items of casual clothing and are, therefore, similar in nature too. These goods are also likely to be sold in the same type of shops. However, the respective goods are not normally in competition, and I have no evidence that they are complementary in the sense described in the case law. In my view, sarongs and kimonos are similar to tops and t-shirts to a low degree.

45. Saris are large pieces of usually highly decorative fabric. When worn, they normally cover the shoulders, torso, legs and ankles. They are customarily used by women of Indian, Pakistani or Bangladeshi descent, although I recognise that they have acquired broader appeal. Because they cover the body, they would usually be seen as an alternative to a dress. I do not know whether saris would normally be sold through the same trade channels as the clothing for which the earlier mark is protected. There is no evidence to assist me. *Saris* are not in competition with the goods for which the earlier mark is protected. I have no evidence that they are complementary in the sense described in the case law. In my view, the opponent has not established that *saris* are similar to t-shirts, tops, jackets, sweatshirts, hoodies, pants and headgear.

Average consumer and the selection process

46. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood

¹¹ See, for example, *Boston Scientific Ltd v OHIM*, Case T-325/06

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.¹²

47. In my experience, consumers pay at least an average degree of attention when selecting items of clothing so as to ensure they get clothes that fit and suit them.

48. Clothing is usually selected by eye, from displays or racks in shops, or from websites. However, oral orders or recommendations may also play some part in the selection process. Therefore, the way the marks sound must also be taken into account, albeit as a secondary factor compared to how they look.

Distinctive character of the earlier mark

49. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*,¹³ 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

¹² *Lloyd Schuhfabrik Meyer*, CJEU, Case C-342/97

¹³ Case C-342/97

chambers of commerce and industry or other trade and professional associations (see Windsurfing Chiemsee, paragraph 51)."

50. SHAKIRA may be descriptive of posters depicting a well-known music artist, but it does not appear to be descriptive of a characteristic of clothing. The mere fact that the opponent has affixed the name SHAKIRA to items of official merchandise, including clothing, does not necessarily mean that the mark designates a characteristic of clothing. The judgment of the CJEU in *Bundesverband Souvenir – Gesschenke – Ehrenpreise eV v EUIPO*¹⁴ suggests that there are limits to how far the approach taken in *Linkin Park* can be extended to other goods merely because they could be used as 'image carriers'. There is no evidence that anyone, other than the opponent, has used SHAKIRA on, or in relation to, clothing.

51. The opponent accepts that 'Shakira' and 'Shakera' are female forenames of Arabic origin.¹⁵ However, the opponent disputes that either version of the name is common in the UK. I accept that SHAKIRA is not a common name in the UK. However, it has the look and feel of a forename of foreign origin. Although I accept that many consumers will see it as word without meaning, I find that a significant section of the relevant UK public are likely to recognise Shakira as a female forename of foreign origin.

52. Taking all of the above into account, I find the earlier mark is inherently distinctive to an average or 'normal' degree. Even if I am wrong about that, the mere fact that the earlier mark is registered means that it must be considered to be distinctive to at least a minimum degree.¹⁶

53. The applicant submits that the opponent has only used the earlier mark on clothing in order to promote her entertainment services. I reject that submission. I find that the opponent has used the earlier mark to identify items of clothing placed on the market with her consent. Consequently, I do not accept that the distinctive character of the earlier mark has been diminished by the nature of the opponent's use of it. I remind myself that it is the perception of the earlier mark in the minds of UK consumers that

¹⁴ Case C-488/16P

¹⁵ Exhibit JAL42 consists of an extract from the website babycenter.com showing that Shakira and Shakera are girls names of Arabic origin derived from the word 'shakir' meaning 'grateful'.

¹⁶ *Formula One Licensing BV v OHIM*, Case C-196/11P, CJEU


counts for the purposes of assessing the likelihood of confusion in the UK. With this in mind, I find the length and extent of use of the earlier mark in relation to clothing marketed in the UK insufficient to have materially enhanced the average or 'normal' degree distinctive character of the mark in relation to such goods.

Comparison of marks

54. The CJEU stated at paragraph 34 of its judgment in *Bimbo SA v OHIM*¹⁷ that:

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

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

Earlier trade mark	Contested trade mark
SHAKIRA	

55. The device of two elided letters S (the second reversed) is not a negligible element of the contested mark because it will have some visual impact on average consumers. It is also reasonably distinctive. However, the relative size and positioning of the word SHAKERA means that it will be perceived as the dominant visual element of the contested mark.

¹⁷ CJEU, Case C-591/12P

56. The registration of SHAKIRA in block capital letters signifies that the earlier mark consists of the word itself, irrespective of minor differences of presentation, such as the use of upper or lower case letters. SHAKIRA and SHAKERA are self-evidently highly similar from a visual perspective. And as the word Shakera dominates the contested mark, I extend this finding to the marks as wholes.

57. The device element of the contested mark is unlikely to be verbalised when the contested mark is spoken. The opponent submits that average consumers will pronounce SHAKERA as “Sha-ker-ah (three syllables), pronouncing the “e” similarly to the vowel sound heard in “era”. According to the opponent, consumers pronounce SHAKIRA as Sha-kair-ah” (also three syllables), pronouncing the “i” similarly to the vowel sound heard in “air”. I accept these submissions. Consumers will find it difficult to distinguish the sound of the contested mark from SHAKIRA. Therefore, the marks are virtually identical from an aural perspective.

58. As regards conceptual similarity, the applicant submits that:

“..the respective marks are both first names, but their different spellings is arguably enough for the average consumer to see them as different names. If, as the Opponent contends, the marks will not be seen as having any meaning to the average consumer, then they have no conceptual similarity to one another.”

59. The applicant seeks to build on this ‘different names’ point by likening the current case to *EU IPO v Messi Cuccittini*.¹⁸ In that case, the General Court of the EU followed the principles set out in the earlier case of *PICASSO/PICARO*.¹⁹ The EU courts accepted that the conceptual identities of *PICASSO* and *MESSI* (as the names of a famous artist and famous footballer, respectively) was sufficient for consumers to distinguish *PICASSO* and a figurative mark including *MESSI*, from *PICARO* and *MASSI*. I reject the applicant’s submission for two reasons. Firstly, I do not accept that the music artist known as Shakira has the exceptional level of fame with the UK public, comparable to Picasso or Lionel Messi. Consequently, I do not consider that SHAKIRA would immediately strike the average consumer of candles, furniture, glassware,

¹⁸ Joined cases *C-449/18 P et C-474/18 P*) 17 September 2020

¹⁹ Case *C-361/04 P*

textiles, clothing, or similar goods as the name of a musical performer. Secondly, even if such consumers did make that link, I doubt that many would be confident about whether the name of the music artist is spelt SHAKIRA or SHAKERA. Therefore, it is unlikely that many consumers would see (or hear) SHAKIRA as the name of a musical performer, but SHAKERA as having no conceptual meaning, as the applicant contends.

60. I find that a significant section of the relevant UK public will see the earlier mark and the word element of the contested mark as female forenames of foreign origin, whilst many other average consumers will not recognise Shakira/Shakera as having any clear meaning. Either way, there is nothing to distinguish the marks from a conceptual perspective.

Likelihood of confusion

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

The principles

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

62. The applicant submits that it is a small business selling hand crafted and printed items. According to the applicant's representative, this reduces the risk of 'real world' confusion with goods marketed under the earlier mark, which are merchandise bearing the name and/or image of a music performer. I reject this submission for two reasons. Firstly, the applicant has not filed any evidence showing how the applicant uses its mark. Secondly, and more importantly, in *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*,²⁰ the CJEU stated that when assessing the likelihood of confusion under Section 5(2) it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered. It is not, therefore, appropriate to limit the assessment of the likelihood of confusion so as to consider the use of the contested mark solely in relation to hand crafted and printed items. Similarly, it is necessary to consider all normal and fair uses of the earlier mark, not just use in relation to merchandise bearing the name and/or image of a music performer.²¹

63. Taking account of:

- (i) the high degree of similarity between the marks, including their virtual identity from an aural perspective;
 - (ii) the risk of imperfect recollection of the earlier mark;
 - (iii) the interdependency principle, whereby a high degree of similarity between the marks may offset a lower degree of similarity between the goods;
 - (iv) the average degree of distinctiveness of the earlier mark;
 - (v) the normal or average level of attention paid by average consumers of the goods in class 25 during the selection process;
- I find that there is a likelihood of direct confusion if the contested mark is used in relation to identical or (even) goods similar to a low degree.

64. The s.5(2)(b) ground of opposition therefore succeeds in relation to all the goods in class 25, except for *saris*, which I have found are not similar goods. As the similarity

²⁰ Case C-533/06 at paragraph 66 of the judgment

²¹ See *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220 at paragraph 78 of the judgment

of the goods is an essential requirement under s.5(2) of the Act,²² this ground of opposition fails in respect of *saris*.

65. In case I am found to be wrong to have attributed an average degree of distinctive character to the earlier mark in the light of *Linkin Park*, I should make it clear that I would have come to the same conclusion, even if I had attributed a low degree of distinctive character to the earlier mark.

The section 5(3) ground of opposition

66. At the relevant date, section 5(3) stated:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark”.

Section 5(3A) states:

“(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected”.

67. As the opposition under s.5(2) has succeeded in class 25 (except for *saris*), I shall focus on the applicability of the s.5(3) ground in relation to the goods in classes 3, 20, 21, 24, and *saris* in class 25.

68. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer*

²² See *Waterford Wedgwood plc v OHIM* – C-398/07 P, CJEU

v Interflora and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24*.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure*).

Reputation

69. The goods and services the opponent relies on for this purpose are *clothing* in class 25 and *entertainment services in the nature of live performances* in class 41. I gave my reasons in paragraph 51 above for rejecting the opponent's claim that the earlier mark has acquired an enhanced degree of distinctiveness in the UK through use in relation to clothing. However, the earlier mark is registered as an EU trade mark. In order to qualify as having a reputation in the EU, it is necessary for the opponent to show that the earlier mark was known (at the relevant date) by a significant part of the relevant public in the EU as a trade mark for clothing.

70. The opponent's use of the earlier mark in the EU in relation to clothing is set out in paragraphs 20 – 24 above. The EU market for clothing is comprised of the general public. This is more than 400m consumers. There is no evidence as to the value of the EU clothing market, but it must be measured in €billions. The opponent's share of the EU clothing market under the earlier mark is likely to be miniscule. It is also concentrated in a niche of the market, i.e. amongst the opponent's fans in the EU. Further, the use of the earlier mark appears to be concentrated around the periods when the opponent is touring or releasing new records, both of which appear to have been intermittent in recent years. In my view, the opponent's evidence comes nowhere near establishing that the earlier mark had a qualifying reputation in the EU at the relevant date for clothing.

71. In order to properly assess the reputation of the earlier mark at the relevant date in relation to *entertainment services in the nature of live performances*, it is necessary to consider all the use made of the mark in the EU in relation to such services. In my judgement, it is also necessary to take account of the use of the mark in relation to closely related goods including, in particular, the sale of music recordings bearing the mark. This is because such sales provide the context within which the live entertainment services were provided, which is relevant when assessing the extent of the reputation generated under the earlier mark in relation to those services.

72. According to Ms Levine, Shakira entered the English-language market with her fifth album, *Laundry Service* in 2001. She says that it sold over 13 million copies. It is not clear how many of these were sold in the EU or UK. In 2006, Shakira released the song "*Hips Don't Lie*" which Ms Levine says reached number 1 in the charts in the UK, and spent 48 weeks in the UK charts overall, as well as hitting number 1 in the charts of various other EU countries, including Belgium, France, Germany, Ireland and Netherlands.²³

73. In 2002/2003 Shakira performed eighteen concerts at seventeen locations in the EU as part of a tour entitled *Tour of the Mongoose*. The show in *Atlantic Pavilion, Lisbon* attracted 19,136 people.

²³ See JAL2

74. This was followed by her *Oral Fixation Tour* in 2006–2007 during which she performed 34 concerts in the EU, fifteen of which were in Spain, ten in Germany and one in the UK (at Wembley Arena).

75. In 2010 – 2011, Shakira undertook her *The Sun Comes Out World Tour*, which included 30 concerts in the EU. This included four concerts in the UK (London, Belfast, Manchester and Glasgow).

76. In 2014 Shakira released an album under that name. In 2016, she released a single called “*Chantaje*”. This was followed in 2017 by her *El Dorado* album, which was followed by the tour of the same name (described earlier).

77. Ms Levine gives evidence that Shakira has received numerous awards throughout her career, including three *Grammy Awards* in 2000, 2005 and 2017, the last for the *El Dorado* album. The awards take place in the USA. However, exhibit JAL44 shows five articles published in the UK between 2015 – 2017 covering the Grammy Awards. I note that only one of these features the opponent (A *BBC News* website article from 2017, showing Shakira as one of six nominations in the category *Best Song Written for Visual Media*).

78. According to Ms Levine, over 28m listened to Shakira’s music on Spotify during July 2020. Information extracted from [spotify.com](https://www.spotify.com) indicates that over 2m of these were based in Spain and 1m – 1.5m were based in each of Germany, the UK, and Italy.

79. Ms Levine also provides sales figures obtained from Sony (presumably her music publisher) showing sales of physical albums as well as downloads of albums and individual tracks in EU countries during the period 2014 – 2019. Ms Levine chose not to summarise what these records show in terms of sales/income. Instead, I am left to work that out for myself. I find the information provided in exhibit JAL30 difficult to read. So far as I can see, there were 31k permanent downloads of the opponent’s albums in Spain in the second half of 2014, and 95k individual tracks were downloaded. Oddly, sales of physical albums during this period is shown in red and in brackets, which usually indicates a negative figure. There were also music sales in France and Sweden, but none are shown for the UK during this period. UK sales are shown for 2015. I have difficulty making out the figures. The figures for the first half of 2016 show

sales of over 9000 physical albums in the UK, and downloads of around 9200 albums and 31k individual tracks generating income of over 39k (presumably \$). The number of album downloads dipped in 2016, but downloads of individual tracks rose to around 90k in Spain, France, the UK and Germany. This was probably due to the release of the single *Chantaje* in 2016.

80. Album sales appear to have increased substantially in the first half of 2017, probably as a result of the release of the *El Dorado* album. I again have difficulty in making out the precise figures, but I can see that sales of physical albums in France in this period were several millions, and sales in Germany, Spain and Italy were in 100s of thousands. Sales in the UK appear to have been more modest: around 32k physical albums, 31k album downloads and 93k downloads of individual tracks. However, the UK generated substantial income from music streaming. The UK appears to have been the opponent's 5th highest source of income from music sales in the second half of 2018 accounting for around 3% of total music sales income. Of EU member states, Spain was first accounting for around 11% of income generated from music sales. Germany was second (I cannot make out the figures for Germany). The UK appears to have been the 7th highest source of income from music sales during the first half of 2019 accounting for 3.4% of such income. Of the EU member states, Spain, France and Germany accounted for more music sales.

81. Not surprisingly, the opponent has a strong presence on social media, with 99m followers on Facebook, 67m on Instagram and 52m on Twitter. It is not clear how many of these are based in the EU or UK.

82. In my view, the evidence clearly shows that SHAKIRA had a qualifying reputation in the EU at the relevant date in relation to *entertainment services in the nature of live performances*.

Link

83. As I noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks

84. The marks are highly similar.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

85. The opponent submits that the goods in classes 3, 20, 21 and 24 are similar to clothing because (a) they are sold to the same consumers, i.e. the general public, and (b) department stores stock these goods and clothing, and (c) the respective goods are complementary. I do not accept these arguments because (a) the first two points describe very high level 'similarities' which are insufficient to establish any real similarity in the perception of average consumers, and (b) there is no evidence that the goods are *complementary* in the sense described in the case law.²⁴ In any event, the opponent has not established that the earlier mark has a qualifying reputation in the EU or UK for clothing.

Comparing the applicant's goods in classes 3, 20, 21, 24 and *saris* in class 25 to the services in class 41 for which the earlier mark has a qualifying reputation, I find that the only similarity between them is that there is an overlap in users because they are all aimed at the general public. However, that much could be said of most goods/services. By contrast, I find that the opponent's services are wholly different in nature to the applicant's goods, serve a completely different purpose, and the method of use is different. There is no material similarity between them.

²⁴ According to the EU courts this 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." See, *Kurt Hesse v OHIM*, Case C-50/15P.

The strength of the earlier mark's reputation

86. Although there only appears to have one tour with 18 concerts in the EU during the period 2012 – 2019, and only two live performances in the UK during this period,²⁵ I am satisfied that the earlier mark had a reasonably strong reputation in the EU in relation to live entertainment services at the relevant date. This is partly because of earlier concerts held in the UK, partly because of spill over reputation from concerts held elsewhere, and partly because of the effect of continued music sales. However, judging from the small number of SHAKIRA concerts held in the UK compared to (say) Spain and Germany, it seems likely that the earlier mark had a stronger reputation in these parts of the EU than in the UK. This is significant because although the reputation of the earlier mark in the EU as a whole can be taken into account to the extent that it overflows into the UK, it is ultimately the perception of the earlier mark in the minds of UK consumers that determines whether use of the contested mark will create a relevant link with the earlier mark.²⁶ In my view, the earlier mark had a reasonably strong reputation for live entertainment services in the minds of the UK public at the relevant date, but not a huge reputation.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

87. I am satisfied that the earlier mark was highly distinctive in relation to *entertainment services in the nature of live performances* at the relevant date.

Whether there is a likelihood of confusion

88. There is no risk whatsoever that use of the contested mark in relation to the goods in classes 3, 20, 21, 24, or *saris* in class 25, will confuse the UK public into thinking that those goods are connected with the user of the earlier mark. This is mainly because of the distance between the services for which the earlier mark has a reputation and the goods under consideration. However, I also take into account

²⁵ On the UK TV show *The Voice* in 2014 and the UK concert of the *El Dorado* tour in 2018

²⁶ See *Iron & Smith kft v Unilever NV*, CJEU, Case C-125/14 and *China Construction Bank Corporation v Groupement Des Cartes Bancaires*, Case BL O/281/14

the further one moves away from the context of music/musical recordings the less distinctive SHAKIRA becomes to the section of the public that recognise it as a female forename of foreign origin, and therefore as a sign that is apt to be used by others bearing the same name.²⁷

Conclusion

89. Taking all of the above into account, I find that use of the contested mark in relation to the goods covered by classes 3, 20, 21, 24 of the application, and *saris* in class 25, would not have caused the UK public to make a mental link between the contested mark and the earlier mark. This is mainly because (a) the respective goods/services are so distant, (b) the reputation of the earlier mark for live entertainment services, although reasonably strong, was not so huge as to bridge the gap between live entertainment services and the goods at issue.

90. In the absence of the requisite link between the marks, the s.5(3) ground of opposition is bound to fail. This is because absent such a link, use of the contested mark would not take unfair advantage of, or be detrimental to, the reputation or distinctive character of the earlier mark.

Unfair advantage/detriment to distinctive character

91. I would add that, even if I had found that a section of the public would make a link between the marks, I would still have rejected the opposition under s.5(3). This is because:

(a) the strength of any such link would be weak;

(b) the use of a highly similar mark in relation to the goods at issue would be seen by the public as a mere coincidence, particularly to those that recognise SHAKIRA and Shakera as female forenames of foreign origin;

²⁷ Unlike (say) Madonna

(c) there does not appear to be anything about the image associated with the earlier mark for live entertainment services which would readily transfer to the goods at issue;

(d) In the light of (a) to (c) it is unlikely that there would be any economic consequences, either increasing sales under the contested mark, or reducing sales under the earlier mark, if a section of the public were to make a mental link between the marks.

92. For the reasons given above, the ground of opposition under s.5(3) fails insofar as it is directed at the goods covered by classes 3, 20, 21, 24 of the application, and *aris* in class 25

The section 5(4)(a) ground of opposition

93. Section 5(4)(a) states:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) [...]

(b) [...]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

94. In *Discount Outlet v Feel Good UK*,²⁸ Her Honour Judge Melissa Clarke, sitting as a Deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the Jif Lemon case (Reckitt & Colman Product v Borden [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “a substantial number” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per Interflora Inc v Marks and Spencer Plc [2012] EWCA Civ 1501, [2013] FSR 21).”

95. As the opposition succeeded under s.5(2)(b) in relation to the applicant’s goods in class 25 (except for saris), I will again focus on the opposition under this ground against the applicant’s goods in classes 3, 20, 21, 24 and saris in class 25.

Goodwill and distinctiveness

96. The opponent claims to own an earlier right in SHAKIRA as a result of the use of that sign in the UK since 2001 in relation to *clothing, entertainment services in the nature of live performances, recordings of live performances, music, and musical recordings.*

97. It is not clear precisely which goods/services the opponent has in mind when she claims to have acquired a goodwill in the UK under SHAKIRA in relation to *music*. Music as such is not a product or service. However, I accept that the opponent has established that, at the relevant date, she had acquired goodwill in the UK under the sign SHAKIRA in relation to *entertainment services in the nature of live performances,*

²⁸ [2017] EWHC 1400 IPEC

recordings of live performances, and musical recordings. For the purposes of this decision, I am also prepared to accept that SHAKIRA was distinctive of T-shirts, tops, jackets, sweatshirts, hoodies, pants and headgear marketed in the UK with the opponent's consent. For the reasons explained above, I find that the opponent's goodwill amongst UK customers in relation to a trade in clothing items was limited both in scope (to clothing merchandise sold mainly at, or in connection with, her records and concerts) and was on a relatively modest scale.

Misrepresentation

98. Clothing apart, the goods for which the applicant seeks to register the contested mark are dissimilar to the goods/services for which the opponent has established goodwill, i.e. household goods and *saris* v musical recordings, live entertainment services and clothing merchandise. The respective goods/services are normally traded in different fields of commercial activity. In *Harrods Limited v Harrodian School Limited*,²⁹ Millet L.J. made the following findings about the lack of a requirement for the parties to operate in a common field of activity, and about the additional burden of establishing misrepresentation and damage when they do not:

“There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff's business. The expression “common field of activity” was coined by Wynn-Parry J. in McCulloch v. May (1948) 65 R.P.C. 58, when he dismissed the plaintiff's claim for want of this factor. This was contrary to numerous previous authorities (see, for example, Eastman Photographic Materials Co. Ltd. v. John Griffiths Cycle Corporation Ltd. (1898) 15 R.P.C. 105 (cameras and bicycles); Walter v. Ashton [1902] 2 Ch. 282 (The Times newspaper and bicycles) and is now discredited. In the Advocaat case Lord Diplock expressly recognised that an action for passing off would lie although “the plaintiff and the defendant were not competing traders in the same line of business”. In the Lego case Falconer J. acted on evidence that the public had been deceived into thinking that the plaintiffs, who were manufacturers of plastic toy construction kits, had diversified into

²⁹ [1996] RPC 697 (CA)

the manufacture of plastic irrigation equipment for the domestic garden. What the plaintiff in an action for passing off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties.

The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration

'...whether there is any kind of association, or could be in the minds of the public any kind of association, between the field of activities of the plaintiff and the field of activities of the defendant':

Annabel's (Berkeley Square) Ltd. v. G. Schock (trading as Annabel's Escort Agency) [1972] R.P.C. 838 at page 844 per Russell L.J.

In the Lego case Falconer J. likewise held that the proximity of the defendant's field of activity to that of the plaintiff was a factor to be taken into account when deciding whether the defendant's conduct would cause the necessary confusion.

Where the plaintiff's business name is a household name the degree of overlap between the fields of activity of the parties' respective businesses may often be a less important consideration in assessing whether there is likely to be confusion, but in my opinion it is always a relevant factor to be taken into account.

Where there is no or only a tenuous degree of overlap between the parties' respective fields of activity the burden of proving the likelihood of confusion and resulting damage is a heavy one. In Stringfellow v. McCain Foods (G.B.) Ltd. [1984] R.P.C. 501 Slade L.J. said (at page 535) that the further removed from one another the respective fields of activities, the less likely was it that any member of the public could reasonably be confused into thinking that the one business was connected with the other; and he added (at page 545) that

'even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.'

99. In my judgement, the nature and extent of the opponent's goodwill under SHAKIRA was insufficient at the relevant date to cause a substantial number of her UK customers, or potential customers, to believe that the applicant's goods in classes 3, 20, 21, 24, or *saris* in class 25, marketed under the contested mark, were connected with *entertainment services in the nature of live performances, recordings of live performances, musical recordings* and clothing merchandise marketed under SHAKIRA. At the most, the high degree of similarity between the marks may have reminded a small number of consumers of the opponent. But even if that caused an even smaller number of them to wonder whether the applicant's goods in classes 3, 20, 21, 24 and *saris* in class 25 were somehow connected with the opponent, that would not justify the opponent's complaint that use of the contested mark constitutes a misrepresentation to the public.³⁰

Damage

100. In the absence of misrepresentation, the question of damage to the opponent's goodwill does not arise. Further, even if I had found that there was a small risk of confusion, I would have been slow to infer the likelihood of more than minimal damage to the opponent's goodwill under SHAKIRA in relation to *entertainment services in the nature of live performances, recordings of live performances, musical recordings*, or her limited goodwill under that sign in relation to items of clothing merchandise.

³⁰ *Phones 4U Ltd v Phone 4U.co.uk Internet Ltd* [2007] RPC 5 at paragraphs 16–17 of Jacob LJ's judgment. Mere causing consumers to wonder is not enough. The use of the contested sign must cause a substantial number of the opponent's customers or potential customers to believe that the applicant's goods are connected with the opponent.

101. Finally, turning to the opposition based on the opponent's unregistered rights directed at the registration of the contested mark in relation to clothing items (other than saris) in class 25, I find it takes the opponent's case no further than the opposition under s.5(2)(b). If I am wrong about the opposition succeeding under s.5(2)(b) in relation to these goods, then I see no reason why the opposition to the registration of the contested mark for the same goods could yet succeed under s.5(4)(a).

Overall conclusion

102. The opposition based on s.5(2)(b) succeeds in relation to all the goods in class 25, except for *saris*. The application to register the contested mark will therefore be refused for these goods.

103. The opposition under ss.5(3) and 5(4)(a) fails in relation to the remaining goods in classes 3, 20, 21, 24, and for *saris* in class 25. The contested mark will therefore be registered in relation to these goods.

Costs

104. The applicant has been more successful than the opponent. Therefore, in my view, the applicant is entitled to an award of costs.

105. The applicant complains that the opponent's evidence was unfocussed and irrelevant to the extent that it went to use of the opponent's mark outside the UK and EU. The applicant also requests costs for a case management conference ("CMC") held on 20th August 2020.

106. A CMC was necessary to deal with the opponent's applications to file more than the standard volume of evidence-in-chief (832 pages instead of the usual maximum of 300), and for an order that significant parts of the evidence be made confidential from public inspection. Following the CMC, I issued the following directions on 21st August 2020:

- "(i) The opponent's request to file 832 pages of evidence is refused;*
- (ii) The opponent has leave to file up to 400 pages of evidence-in-chief (not including exhibit header pages);*

(iii) The documents exhibited to the witness statement(s) should be divided into logical numbered exhibits;

(iv) Each such exhibit should have a cover page with an index listing the contents of the exhibit and, where the pages in the exhibit show different things, the index should indicate which pages show what;

(v) The opponent's request that pages 301-332, 423-458, 470-488, 493-508, 520-522, 536, 544-545, 549, 554, 561-672, 737-741 of the existing exhibit to Ms Levine's statement be covered by an order preventing public inspection of those documents, is refused."

107. I gave my reasons for these directions in a letter dated 21st August 2020. The essential parts of which were as follows:

"In response to the applicant's request for strict proof of the opponent's use and reputation of the earlier EU trade mark, and UK goodwill under the sign, the opponent has prepared voluminous evidence. This includes (repetitive) internet downloads appearing to show the same thing many times, extensive forensic details of certain aspects of concerts and music and clothing sales, and other material that is of little or no relevance. This is mainly because it relates to use outside the EU and/or does not show use of the mark/sign in relation to the goods/services relied on. As filed, the evidence is hard (and time consuming) to understand. I was not satisfied that it was necessary to file so many pages of evidence to establish the use and reputation of the earlier mark/sign in the EU and UK."

"As regards confidentiality, I made it clear that the registrar was unlikely to accept requests for confidentiality which prevent the public from understanding the essential aspects of the reputation on which the opponent's case is based, i.e. the number and location of live performances in the UK/EU, particularly in the years leading up the relevant date, the attendance at those events, the number of sales of musical recordings and downloads in the UK over the same period, the number of listeners to the opponent's music in the UK/EU, the number of clothing items bearing the earlier mark sold in the UK/EU at concerts or from internet sites, the number of UK/EU-based

followers of the opponent on social media sites, and the amount spent promoting the opponent's trade mark."

108. The applicant's representative indicated at the CMC that the applicant was likely to focus on the extent of the use and reputation of the earlier mark in the UK at the relevant date, and whether the earlier mark had been used and acquired a reputation as a trade mark for clothing. I asked the opponent to bear this in mind when preparing its evidence. I also confirmed that if the applicant challenged the accuracy or sufficiency of the opponent's evidence-in-chief in specific respects, the opponent would be allowed to file additional evidence-in-reply answering those criticisms.

109. Following the CMC, the opponent submitted 400 pages of evidence-in-chief. The request for confidentiality was scaled down to two spreadsheets showing the gross income and detailed costs associated with the European concerts on the opponent's *El Dorado* would tour. This information was made subject to an order preventing public inspection of one exhibit (JAL19).

110. The applicant subsequently filed written submissions making numerous criticisms of the opponent's evidence-in-chief, particularly as regards the proof-of-use requirement. In line with my earlier directions, the opponent was allowed to file evidence-in-reply seeking to answer the criticisms. The applicant later criticised the opponent for re-filing some of the evidence it had previously removed as evidence-in-chief. There is no basis for this criticism. The opponent was entitled to file this additional evidence.

111. I see more force in the applicant's complaint that even after it was scaled down and divided into exhibits and (to only a very limited extent) indexed, the opponent's evidence still lacked sufficient focus on use of the earlier mark in the UK and EU. It also included a significant amount of material from after the relevant date. I would add that it was also hard to read parts of it. Further, the significance of many of the exhibits, particularly the many webpages, was often hard to understand without (and sometimes even with) forensic analysis. This was made worse by the absence of sufficient explanation from the witness about potentially important parts of the exhibited documents, e.g. the information about SHAKIRA's music sales in the UK

and EU in exhibit JAL30. It should be remembered that exhibited documents are meant to support what the witness says in his or her evidence. They are not intended to relieve the witness from having to give narrative evidence. It is not helpful to leave it to the other party and/or the tribunal to work out from exhibits key aspects of the opponent's case, such as how many sales of recorded music are claimed in the relevant territory prior to the relevant date. Apart from running the risk that the evidence will not be correctly understood, this approach unnecessarily increases the other side's costs. I will take this into account.

112. For its part, the opponent complains that the applicant put it to proof of use of the earlier mark in relation to clothing, and also of the reputation of the earlier mark, even for musical recordings and live entertainment. The opponent points out that the applicant went on to seek to use the fame of Shakira, the artist, as creating a conceptual difference from the word 'Shakera' in the contested mark. In my view, the applicant was fully entitled to ask for proof of use of the earlier mark as a trade mark for clothing. I agree that the applicant should have accepted from the outset that SHAKIRA had a reputation for musical recordings and live entertainment in the EU/UK. However, the applicant was entitled to request proof of the extent of that reputation. I therefore see little merit in the opponent's criticisms about the applicant's behaviour.

113. Neither side expressly asks for off-scale costs. In any event, I do not consider that off-scale costs are justified. I will, instead, award costs at the higher end of the published scale, particularly costs for reviewing the opponent's initial and revised evidence, and filing written submissions about it.

114. I will, of course, also take into account that the opponent was mostly successful in class 25.

115. Taking all of the above into account, I determine the applicant's costs as follows:

- (a) Considering the notice of opposition and filing a counterstatement - £300
- (b) Considering the opponent's evidence and filing written submissions – £2000
- (c) Preparing for and attending a CMC – £350

(d) Filing written submissions in lieu of a hearing - £150

116. I order Shakira Mebarak to pay Shakera Tayub the sum of £2800. This to be paid within 21 days of the end of the period allowed for appeal or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings (subject to any order made by the appellate tribunal).

Dated 25th June 2021

Allan James

For the Registrar