

o/813/21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003581168

BY UK MK INT'L LIMITED

FOR THE FOLLOWING TRADE MARK:

MICAREL KMOR

IN CLASS 18

AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY

UNDER NO. 504122

BY MICHAEL KORS (SWITZERLAND) INTERNATIONAL GMBH

BACKGROUND AND PLEADINGS

1. UK MK INT'L LIMITED ("the proprietor") applied to register the trade mark shown on the cover page of this decision ("the Contested Mark") in the UK on 19 January 2021. It was registered on 21 May 2021 for the following goods:

Class 18 Bags; Fur; Trimmings of leather for furniture; Umbrellas; Walking sticks; Leather leashes; School bags; Travelling trunks; Handbags; Business card cases.

2. On 9 September 2021, Michael Kors (Switzerland) International GmbH ("the applicant") applied to have the Contested Mark declared invalid under section 47 of the Trade Marks Act 1994 ("the Act"). The application was originally based upon sections 5(2)(b) and 5(3) of the Act. However, in a post-CMC letter dated 24 March 2022, the Tribunal required a witness statement to be filed to consider the extension of time for evidence to be filed. The opponent informed the Tribunal that they were not in a position to file the required witness statement and that the matter should proceed without evidence. In accordance with Rule 42(4) of the Trade Marks Rules 2008, the application was deemed withdrawn in respect of section 5(3). The application, therefore, proceeds on the basis of section 5(2)(b) only. The applicant relies on the following trade mark:

MICHAEL KORS

UK registration no. UK00903140456

Filing date 22 April 2003; registration date 22 November 2004.

3. The applicant relies upon all of its goods and services, as set out in the Annex to this decision.

4. Under section 5(2)(b) the applicant claims that there is a likelihood of confusion because the marks are visually and phonetically similar, and the goods are identical or highly similar.

5. The proprietor filed a counterstatement denying the claims that the marks are similar. However, the proprietor admitted “that the goods of the later trade mark are all either highly similar or identical to the goods of the earlier trade mark”.

6. The applicant is represented by Baker & McKenzie LLP and the proprietor is represented by IPEY. Neither party filed evidence nor requested a hearing, but the applicant filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

DECISION

7. Section 5(2)(b) of the Act has application in invalidation proceedings pursuant to section 47 of the Act. Section 47 reads as follows:

“47. (1) [...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2ZA) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 5(6).

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

(a) the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with their consent in relation to the goods or services for which it is registered-

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(2D)-(2DA) [Repealed]

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are-

(a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

(c) that the application for a declaration of invalidity is based on section 5(3)(a) and the earlier trade mark had not yet acquired a reputation within the meaning of section 5(3).

(3) [...]

(4) [...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

8. 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 on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

Section 5(2)(b)

9. Section 5(2)(b) reads as follows:

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

(a)...

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

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

10. The trade mark upon which the applicant relies qualifies as an earlier trade mark because it was applied for at an earlier date than the proprietor’s mark pursuant to section 6(1)(aa) of the Act. As the earlier trade mark had completed its registration process more than five years before the date the applicant applied to invalidate the contested mark, it is subject to proof of use pursuant to section 6A(1) and (1A) of the Act. However, as the proprietor did not request that the applicant prove use of its mark, it is entitled to rely upon all of the goods and services identified.

Section 5(2)(b) case law

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

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

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

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a 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.

Comparison of goods and services

12. The competing goods and services are as follows:

Applicant's goods and services	Proprietor's goods
<p><u>Class 3</u> Cosmetics and perfumery; soaps and toilet preparations.</p> <p><u>Class 9</u> Eyeglass frames, eyeglasses, sunglasses, eyeglass cases, eye shades, protective eye wear and eye wear for sports.</p> <p><u>Class 14</u> Jewelry belonging in class 14 including jewelry made of precious and non-precious metals; watches, clocks and timers.</p> <p><u>Class 18</u> Carrying cases, bags, luggage, suitcases; umbrellas; handbags, purses; wallets; leather and leather imitations included in class 18.</p> <p><u>Class 20</u></p>	<p><u>Class 18</u> Bags; Fur; Trimmings of leather for furniture; Umbrellas; Walking sticks; Leather leashes; School bags; Travelling trunks; Handbags; Business card cases.</p>

Furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics.

Class 21

Small domestic utensils and containers; glassware, dishes, cups, mugs, bowls and basins; soaptrays; combs and sponges; brushes (other than paint brushes) including tooth, hair and make-up brushes; household articles of porcelain and earthenware.

Class 24

Table cloths, napkins and placemats; bed covers, bedding including sheets and pillow cases; towels and wash cloths, and textiles (piece goods) and textile household articles not included in other classes.

Class 25

Clothing, footwear and headgear; belts.

Class 35

Advertising and publicity services and retail store services.

13. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the

Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 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.”

14. Guidance on this issue has 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

15. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut for 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.”

16. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... 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.”

17. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

18. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal*

Market (Trade Marks and Designs) (OHIM), Case T-325/06, the GC stated that “complementary” means:

“... there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think the responsibility for those goods lies with the same undertaking.”

19. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted, as the Appointed Person, in *Sandra Amalia Mary Elliot v LRC Holdings Limited*, BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes.” Whilst on the other hand: “... it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

Whilst on the other hand:

“... it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

20. Firstly, I note that although the proprietor has admitted that the goods are all either identical or highly similar, they have not specified what terms in the specification are identical and which are not. Therefore, I shall carry out a full comparison of the specifications.

21. “Bags”, “handbags” and “umbrellas” appears identically in both the applicant’s and the proprietor’s specifications.

22. “School bags” in the proprietor’s specification falls within the broader category of “bags” in the applicant’s specification. I consider them identical on the principle outlined in *Meric*.

23. “Trimmings of leather for furniture” in the proprietor’s specification falls within the broader category of “leather and leather imitations included in class 18” in the applicant’s specification. I consider them identical on the principle outlined in *Meric*.

24. I consider that the proprietor’s “travelling trunks” is a type of luggage, in the form of a cuboid container, which is designed and used to hold personal belongings. I consider that these goods would overlap with the applicant’s “carrying cases”. I consider that the goods overlap in nature, method of use and purpose, because they are all types of luggage used to transport and carry the users items. I consider that the goods may overlap in trade channels, as general luggage specialists would sell all of the goods. The goods may be in competition; however, they are not complementary. Taking the above into account, I consider that the goods are similar to a high degree.

25. I consider that “fur” in the proprietor’s specification may overlap with the applicant’s “leather and leather imitations included in class 18”. I consider that an undertaking which specialised in materials derived from animals, such as fur and leather, would sell these goods all together, and to the same undertakings, to eventually make rugs, upholster furniture or to make clothing. Therefore, to some extent they may overlap in user, purpose and method of use. However, they differ in nature. The goods are not complementary, but they may be in competition. Consequently, I consider that the goods are similar to between a medium and high degree.

26. I consider that “business card cases” in the proprietor’s specification may overlap with the applicant’s “wallets”. I consider that all of the goods are used to contain card-based items, with the applicant’s goods having compartments and slots which can hold both credit cards, and business cards, whereas the proprietor’s goods would most likely only hold business cards. I note that all of goods also would appear in a similar

design, being a small rectangular case, which can also be made out of similar materials such as leather. Therefore, I consider that the goods overlap in user, method of use, nature and purpose. However, I do not consider that there would be an overlap in trade channels because either printing undertakings or specialists in business card holders would sell the proprietor's goods, whereas the applicant's goods would be sold by (leather) handbag and accessories companies, or even general retail stores. I also do not consider that the goods are in competition or complementary. Therefore, I consider that the goods are similar to a medium degree.

27. As established in *Les Éditions Albert René v OHIM*¹, it is clear that just because a particular good is used as a part, element or component of another, it should not result in a finding of similarity between those goods. Therefore, although the proprietor's "leather leashes" would be made out of the applicant's "leather and leather imitations included in class 18", this is not sufficient in itself to establish similarity. The applicant's goods do not overlap in nature, purpose or method of use with the proprietor's goods because leashes are used to walk domestic animals such as dogs, whereas the applicants goods would be used either to make leather leashes, or even used to make clothing or upholster furniture. Therefore, I do not consider that there is an overlap in user. I also do not consider that there is an overlap in trade channels because the applicant's goods would be sold by leather specialists, whereas the proprietor's goods would be sold by pet supplies retailers. The goods are not in competition or complementary because they are not important or indispensable for each other. Taking the above into account, I consider the proprietor's goods to be dissimilar to the applicant's goods.

28. I consider that "walking sticks" in the proprietor's specification is dissimilar to all of the applicant's goods and services. The proprietor's goods are primarily used to aid walking. I therefore do not consider that there would be an overlap in nature, method of use, purpose or trade channels with the applicant's, inter alia, class 3 cosmetics, class 9 eyewear, class 14 jewellery and watches, class 18 luggage, class 20 furniture, class 21 utensils, class 24 textiles, class 25 clothing and class 35 advertising services. The goods and services are neither in competition nor complementary. There may be

¹ Case T-336/03

an overlap in user, but this is not enough on its own to establish similarity. Therefore, I consider that the goods and services are dissimilar.

29. Furthermore, I also note that in the applicant's class 20 specification, it contains the term "goods (not included in other classes) [my emphasis] of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics". This term, consequently, eliminates any similarity or identity with the proprietor's "walking sticks" which appears in class 18.

30. It is a prerequisite of section 5(2)(b) that the goods be identical or at least similar. The opposition will, therefore, fail in respect of the goods that I have found to be dissimilar.²

31. The opposition under section 5(2)(b) fails for the following goods:

Class 18 Walking sticks; Leather leashes.

The average consumer and the nature of the purchasing act

32. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. 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

² eSure Insurance v Direct Line Insurance, [2008] ETMR 77 CA

“average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

33. The average consumer for the goods will be members of the general public. The price of the goods is likely to vary, and they are likely to be a reasonably frequent purchase. However, even where the cost is low, various factors will be taken into consideration such as cost, durability, aesthetic, and material. Taking all of this into consideration, I consider it likely that a medium degree of attention will be paid during the purchasing process.

34. The goods are likely to be purchased by self-selection from the shelves of a retail outlet or an online equivalent. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there will also be an aural component to the purchase given that advice may be sought from retail assistants.

Comparison of the trade marks

35. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade 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.”

36. 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.

37. The respective trade marks are shown below:

Applicant's trade mark	Proprietor's trade mark
MICHAEL KORS	MICAREL KMOR

38. The applicant's trade mark consists of the words MICHAEL KORS. I consider that these two words, together, will be recognised as a first name and surname. I consider that as a general rule, surnames are more distinctive than forenames and that the surname KORS appears to be more unusual than the forename MICHAEL. However, it is also true that the consumer tends to pay more attention to the beginning of marks. Therefore, I consider that the overall impression of the mark lies in the combination of these elements.

39. The proprietor's trade mark consists of the invented words MICAREL KMOR. The overall impression of the mark lies in the combination of these elements.

40. Visually, the marks coincide in that the respective first words consist of seven letters and the second words consist of four letters. They also coincide in the presence of the letters M, I and C at the beginning of the first word in both marks, in the presence of the letter A in the middle of the first word in both marks, and the letters E and L at the end of the first word in both marks. The second word in both marks also starts with the letter K. Furthermore, I also note that the second word in both marks contains the letters O and R next to each other, however, in different positions in the word (in the middle of the applicant's mark and at the end of the proprietor's mark). I consider that these all act as visual points of similarity. However, the applicant's mark contains the letter H in the middle of the first word and the letter S at the end of the second word, whereas the proprietor's mark contains the letter R in the middle of the first word and

the letter M in the middle of the second word. I consider that these letters are not visually similar and therefore they act as visual points of difference. Taking the above into account, I consider the marks to be visually similar to at least a medium degree.

41. Aurally, the applicant's mark will be pronounced as MY-CALL-KORS. The applicant submits that the first part of the proprietor's mark will be pronounced MIKE-AH-REL. If so, I consider that the proprietor's mark, as a whole, will be pronounced as MIKE-AH-REL K-MORE. However, I also consider that the mark may be pronounced as MICK-AH-REL K-MORE. I consider that both variations are likely to be used by the general public. Consequently, as all of the marks overlap in the 'M' element of the first syllable, the 'K' element, and the 'OR' element of the last syllable, I consider that the marks are aurally similar to between a low and medium degree.

42. Conceptually, the proprietor submits that their mark is comprised of 2 invented words. I agree. Therefore, the mark will not be attributed any particular meaning. I consider applicant's mark is comprised of a first name and surname. I consider that the first name MICHAEL is a common name within the UK, however, I consider that the last name KORS is unusual. I note that the proprietor submits that the applicant's mark consists of the "name of the American fashion designer MICHAEL KORS". However, I do not have any evidence before me to support this submission. Consequently, as the proprietor's mark doesn't convey any meaning, and the applicant's mark has a concept, namely, as a name of a person, I consider that the marks are conceptually dissimilar.

Distinctive character of the earlier trade mark

43. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other

undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, 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 promotion of 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).”

44. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

45. As the applicant has not filed any evidence to show that the distinctiveness of its mark has been enhanced through use, I only have the inherent position to consider.

46. As highlighted above, I consider that MICHAEL KORS will be viewed as a full name which is neither allusive nor descriptive in relation to the goods for which the mark is registered. The surname KORS is an unusual surname which is not common. Therefore, I consider the opponent’s mark to be inherently distinctive to at least a medium degree.

Likelihood of confusion

47. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the

average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact 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 that he has retained in his mind.

48. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the marks to be visually similar to at least a medium degree.
- I have found the marks to be aurally similar to between a low and medium degree.
- I have found the marks to be conceptually dissimilar.
- I have found the opponent's mark to be inherently distinctive to at least a medium degree.
- I have identified the average consumer to be members of the general public who will select the goods primarily by visual means, although I do not discount an aural component.
- I have concluded that a medium degree of attention will be paid during the purchasing process for the goods.
- Excluding the goods which I found not to be similar, I have found the parties' goods to be identical.

49. Taking all of the factors listed in paragraph 48 into account, particularly the visual, aural and conceptual differences between the marks, I am satisfied that the marks are unlikely to be mistakenly recalled or misremembered as each other. I do not consider

that the average consumer would overlook the differing letters in the middle of the marks, especially as the effect is to change invented words to a full name (or vice versa), which creates a clear conceptual hook in which to differentiate the marks. Consequently, I do not consider there to be a likelihood of direct confusion.

50. It now falls to me to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

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

51. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

52. Having noticed that the competing trade marks are different, I see no reason why the average consumer would assume that they come from the same or economically linked undertakings. I do not consider that the average consumer would think the applicant’s trade mark was connected with the proprietor or vice versa. They are not

natural variants or brand extensions of each other. Consequently, I consider there is no likelihood of indirect confusion.

CONCLUSION

53. The application for a declaration of invalidity has failed in its entirety and the proprietor's trade mark will remain registered.

COSTS

54. The proprietor has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of **£200** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Considering the Notice of opposition and preparing a Counterstatement	£200
Total	£200

55. I therefore order Michael Kors (Switzerland) International GmbH to pay UK MK INT'L LIMITED the sum of £500. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 21st day of September 2022

L FAYTER

For the Registrar

ANNEX

The opponent's mark

Class 3

Cosmetics and perfumery; soaps and toilet preparations.

Class 9

Eyeglass frames, eyeglasses, sunglasses, eyeglass cases, eye shades, protective eye wear and eye wear for sports.

Class 14

Jewelry belonging in class 14 including jewelry made of precious and non-precious metals; watches, clocks and timers.

Class 18

Carrying cases, bags, luggage, suitcases; umbrellas; handbags, purses; wallets; leather and leather imitations included in class 18.

Class 20

Furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics.

Class 21

Small domestic utensils and containers; glassware, dishes, cups, mugs, bowls and basins; soaptrays; combs and sponges; brushes (other than paint brushes) including tooth, hair and make-up brushes; household articles of porcelain and earthenware.

Class 24

Table cloths, napkins and placemats; bed covers, bedding including sheets and pillow cases; towels and wash cloths, and textiles (piece goods) and textile household articles not included in other classes.

Class 25

Clothing, footwear and headgear; belts.

Class 35

Advertising and publicity services and retail store services.