

BL O/0009/23

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3682309
AND THE REQUEST BY MONA KIKI LIMITED**

TO REGISTER THE TRADE MARK

Mona kiki

IN CLASS 14

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 430553
BY KIKI MCDONOUGH**

Background and pleadings

1. On 17 August 2021 Mona kiki Limited (“**the Applicant**”) applied to register the plain text words “Mona kiki” as a UK trade mark. On 26 November 2021 the trade mark was published for opposition purposes in respect of the following goods:

Class 14: Jewellery products; Necklaces [jewellery, jewelry (Am.)]; Bracelets; Rings [jewelry]; Earrings; Ornaments [jewellery, jewelry (Am.)]; Clocks and watches; Watchbands; Jewelry caskets; Cases for clock and watch-making.

2. On 26 January 2022 the mark was opposed, in full by Kiki McDonough. (“**the Opponent**”). The opposition is based on sections 5(2)(b) and 5(3) of the Trade Marks Act (“**the Act**”). The Opponent relies upon their UK trade mark:

KIKI

Trade mark number: 908766271

Filing date: 17 December 2009

Registration date: 7 August 2013

Relying on goods under Class 14:

Jewellery and imitation jewellery; earrings, necklaces, bracelets, anklet chains, brooches, rings, precious stones and watches.

3. An “earlier trade mark” is defined in section 6(1) of the Act as:

“(a) a registered trade mark, or international trade mark (UK), which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks”

4. The filing date of the Opponent’s trade mark registration is prior to the filing date of the contested mark. Therefore the Opponent’s mark constitutes an earlier mark under the Act.

5. Since the Opponent's UK mark had been registered for more than five years when the contested mark was applied for, it is subject to the use provisions under section 6A of the Act. The Opponent duly provided a statement of use in respect of all the goods relied on under Class 14. The Applicant requested that the Opponent provide proof of this use.

The Opponent's case

Section 5(2)(b)

6. Under section 5(2)(b) the Opponent submits that:

- (i) the marks are undoubtedly highly similar as the earlier mark "KIKI" is wholly encompassed within the Applicant's mark "Mona kiki";
- (ii) the similarity of the marks is enhanced through consumers' imperfect recollection;
- (iii) consumers are likely to recall the distinctive "KIKI" element and view the Applicant's mark as referring to goods originating from, or provided in association with the Opponent;
- (iv) the goods under the respective marks are identical or closely similar and are marketed to the same users, through the same trade channels.

Section 5(3)

7. Under Section 5(3), it is submitted that:

- (i) The Opponent is a prominent and highly acclaimed British jewellery designer, designing and retailing jewellery since the 1980's. Her jewellery is worn by Catherine, Princess of Wales and features in a collection at the Victoria and Albert Museum. The Opponent has expended substantial sums on development, advertising and promotion of the KIKI brand, resulting in a strong reputation in the UK with respect to jewellery;

(ii) due to the substantial reputation, and the similarity of the marks, consumers are likely to think that the Applicant's goods emanate from the Opponent, or are provided with their consent;

(iii) use of the contested mark would unfairly use the reputation and goodwill of the Opponent's mark for its own benefit, causing damage to the Opponent's rights and reputation. It would ride on the coattails of the Opponent's reputation and goodwill, with the Applicant seeking to associate itself with the Opponent and its well established brand;

(iv) use of the contested mark would cause detriment to the repute of the Opponent's earlier rights because the Opponent will not be able to control the manner in which the Applicant uses its mark, which may be adverse to the image created by the Opponent and erode the distinctiveness of its mark. Use by the Applicant will diminish the attractiveness and strength of the Opponent's mark as an indication of origin and will reduce the capacity of the Opponent to distinguish its goods. The link between the marks will affect the economic behaviour of consumers and is likely to lead to a decrease in revenue for the Opponent.

The Applicant's case

8. In response the Applicant denies the Opponent's grounds of opposition and contests the similarity of the marks and the reputation of the Opponent's mark.

Section 5(2)(b)

9. Under section 5(2)(b) the Applicant:

(i) does not contest the identity or similarity of the goods;

(ii) submits that consumers will pay a high degree of attention in purchasing the goods in question and so will easily spot the striking difference between the earlier mark and the contested mark;

(iii) submits that the word "Kiki" has a low degree of distinctive character and should be used freely on the market by competitors. The Applicant submits that "Kiki" is a female name that is increasing in popularity in the UK and asserts that

there are numerous undertakings offering goods and services of the type offered by the Opponent under the name “Kiki”;

(iv) submits that “Mona” possesses a high degree of distinctiveness, being arbitrary in respect of jewellery;

(v) submits that the marks are visually dissimilar and differ significantly from an aural perspective. The Applicant highlights that the point of difference between the marks is at the beginning of its mark, where consumers pay more attention. The Applicant submits that consumers will easily recognise the “Mona” element in its mark with “Kiki” not forming a memorable or important element within the mark.

Section 5(3)

10. Under section 5(3), the Applicant:

- (i) contests the reputation of the Opponent’s mark;
- (ii) submits that the marks are dissimilar;
- (iii) submits that considering the dissimilarity of the marks and the high degree of attention of the relevant public, consumers will be able to distinguish the marks, and there are no reasons to believe that the consumer would establish a link between the marks.

Representation and papers filed

11. The Applicant is represented by Marcin Barczyk; the Opponent by CMS Cameron McKenna Nabarro Olswang LLP (“**CMS**”).

12. Only the Opponent filed evidence in these proceedings. This evidence comprises two witness statements, the first of the Opponent Kiki McDonough, dated 4th July 2022. Ms McDonough introduces Exhibits KM1 to KM23 concerning use of the earlier trade mark. The second witness statement is of Kara Tompsett, Senior Associate at CMS, dated 4th July 2022. Ms Tompsett introduces Exhibits KT1 to KT3 concerning the relevant consumer and distinctiveness of the word “KIKI”.

13. The Applicant filed a lengthy counterstatement with its notice of defence, but did not file any further submissions. The Opponent filed submissions in lieu of a hearing. As no hearing was requested, this decision is taken following a careful assessment of the papers.

Decision

14. 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 refer to EU trade mark law.

Proof of use

15. The relevant statutory provisions are as follows:

“Raising of relative grounds in opposition proceedings in case of non-use”

6A(1) This section applies where

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

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

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) 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.

[...]

(6) 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.”

16. Paragraph 7 of Schedule 2A of the Act concerns the application of section 6A to comparable trade marks:

7.(1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

[...]

(3) Where IP completion day falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day -

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A to the United Kingdom include the European Union.

17. Section 100 of the Act is also relevant; it reads:

“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.”

18. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J 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 Bunderversammlung 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 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].”

19. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

and further at paragraph 28:

“28. I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

20. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in Matsushita Electric Industrial Co. v. Comptroller- General of Patents [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

21. The Opponent claims to have used their mark in respect of all of the goods relied upon in Class 14, that is: *Jewellery and imitation jewellery; earrings, necklaces, bracelets, anklet chains, brooches, rings, precious stones and watches.* The

“relevant period” for use to be shown is from 18 August 2016 to 17 August 2021. As already mentioned, since filing the TM8, notice of defence and counterstatement, the Applicant has filed no further evidence or submissions. However, in its counterstatement the Applicant put forward two arguments in respect of use made by the Opponent, which I understand to be on the basis of information shared with the Applicant prior to proceedings being launched. In respect of this information the Applicant submits that:

- (i) the use made by the Opponent is of the mark “Kiki McDonough”, which features a distinctive element that does not feature in the Opponent’s mark “KIKI”, which itself is low in distinctive character. As the distinctiveness of the mark is altered in use, the Applicant submits that genuine use is not shown;
- (ii) the owner of the “KIKI” trade mark is different to the parties who are using the mark and there is no link between them, meaning that the mark has not been put to use by the Opponent.

22. I will address the form of use shown in my assessment of the Opponent’s evidence filed in the proceedings. The second point can be dealt with briefly in that the Act confirms that use may be *“by the proprietor or with his consent...”* The proprietor of the earlier mark is Kiki McDonough. In her witness statement, Ms McDonough confirms that she is founder and Creative Director of Kiki McDonough Limited, who design and produce luxury jewellery. It is therefore apparent that Ms McDonough consents to Kiki McDonough Limited using the “KIKI” trade mark.

23. The evidence shows that Kiki McDonough is a well-known name within the market for high-end jewellery, with profiles of the designer appearing in mainstream media including The Telegraph, Marie Claire and The Independent. Press attention also stems from Catherine, Princess of Wales wearing Kiki McDonough jewellery with it being stated that the Princess owns tens of thousands of pounds worth of her designs. What is not clear is whether the earlier registered trade mark “KIKI” solus has been put to genuine use.

24. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in Nestlé, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35 Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)". (emphasis added)

25. In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under s. 46(2). He said:

*"13. [...] While the law has developed since Nirvana [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 Grupo Textil Brownie v EU*IPO, EU:T:2020:22, [63 and 64]).*

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 Hypen v EUIPO, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 M & K v EUIPO, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 Fashioneast v AM.VI. Srl, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree

with it). Fourthly, the addition of descriptive or suggestive words (or it is supposed figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 Artkis, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 Alder, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 Mood Media v EUIPO, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still”.

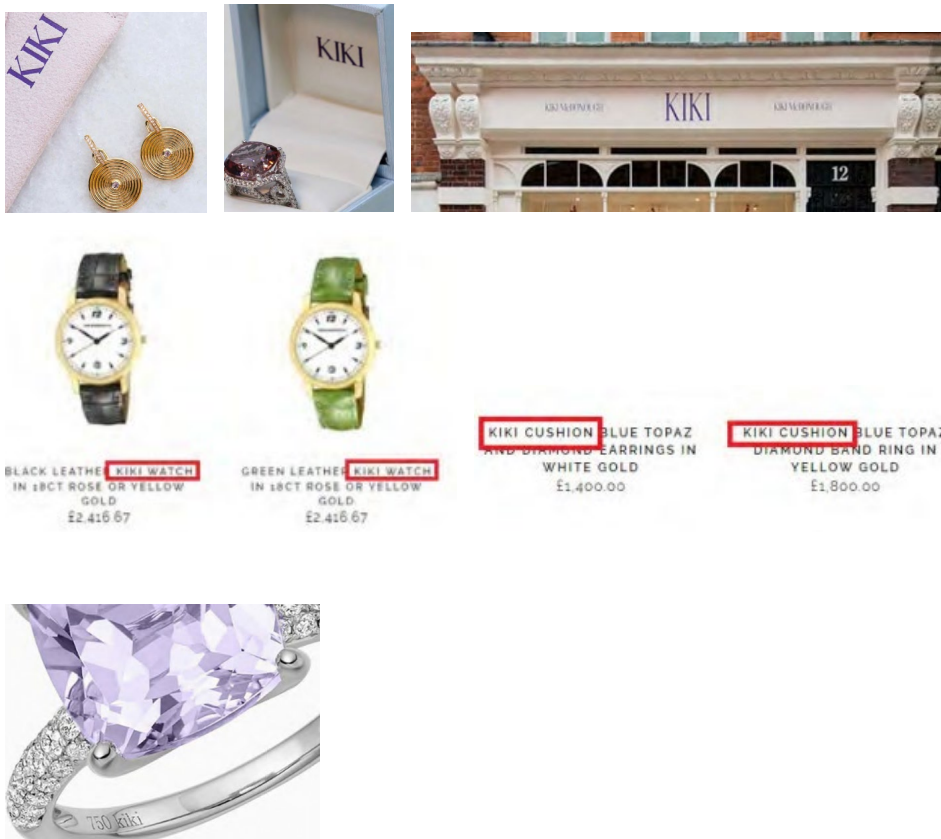
26. I acknowledge that use can be independent use, or use with another mark. The assessment to be made is whether the registered mark continues to be perceived as indicative of the Opponent’s goods when it is used in the form “Kiki McDonough”, instead of the form as registered: “KIKI”.¹ In my view “McDonough” represents a distinctive element, being a surname which possesses an average degree of distinctive character. I consider that use of the composite “Kiki McDonough” forms a first name and surname which results in a different overall distinctive character to the registered mark. When seen in the form “Kiki McDonough”, I do not consider that that “KIKI” solus will be perceived as indicative of the Opponent’s goods.

27. In their submissions in lieu of a hearing, the Opponent lists examples from the evidence where “KIKI” solus is used. Reviewing this list, I note that three of the examples from Exhibit KM6 are dated outside the relevant period, and the fourth example refers to an intention to launch “Kiki Uniques” but does not indicate the type of products the name will be used in respect of. Other examples of “KIKI” in use without “McDonough” cannot be seen to be from within the relevant period, for

¹ *Colloseum Holdings AG v Levi Strauss & Co.*

example, the third party retail sites at Exhibit KM16 and the presentation boxes at KM19.

28. What the evidence does show during the relevant period are the existence of a website “kiki.co.uk” where the Opponent’s goods are sold; social media posts featuring “KIKI” on a ring box (KM17) and pouches (Exhibit KM7); a store front confirmed to have been in situ since 2016 (Exhibit KM20); and extracts from the Opponent’s website, obtained from the WayBack Machine and which show use of “KIKI” in relation to watches, earrings and rings. Ms McDonough also states that the “KIKI” hallmark, as seen in Exhibit KM16 has been in use since the business launched. The use of “KIKI” that I have described are shown below:



29. The Opponent has not provided figures for sales or promotional spend in respect of the goods sold under the “KIKI” trade mark, however, I remind myself that use of the mark need not always be quantitatively significant for it to be deemed genuine. The evidence shows that during the relevant period, the Opponent has offered certain goods for sale under the trade mark “KIKI” solus, where the mark is seen on

the packaging, the hallmark, product description, or shop front. The examples of use shown and the types of products are very limited and I consider that through websites, catalogues and invoices for example, more solid evidence of use of “KIKI” could have been provided.

30. In reaching a fair specification I have in mind the relevant case law, including *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, where Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

31. And, in *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows (at [47]):

“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."

32. While I am alive to the fact that I must not unduly strip the Opponent's protection down to specific goods, given the nature of the evidence of the registered mark, the list of terms claimed by the Opponent in Class 14 is overly broad. I consider that use has been shown in respect of rings, earrings and watches. I consider that a fair specification of "jewellery" would be overly broad, given the limited examples of use shown during the relevant period. I therefore find a fair specification of goods to be limited to earrings, rings and watches.

Section 5(2)(b)

33. Section 5(2)(b) of the Act states:

"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”.

The case law on section 5(2)(b)

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

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

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

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other

components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

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

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

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

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

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

Comparison of the goods

35. The respective goods are set out in the table below:

Opponent's Goods	Applicant's Goods
<u>Class 14</u> earrings, rings and watches	<u>Class 14</u> Jewellery products; Ornaments [jewellery, jewelry (Am.)]; Necklaces [jewellery, jewelry (Am.)]; Bracelets; Rings [jewelry]; Earrings; Clocks and watches; Watchbands; Jewelry caskets; Cases for clock and watch-making.

36. In considering the extent to which there may be similarity between the goods, I take account of the guidance from relevant case law. Thus, in Canon the CJEU stated that:

*“In assessing the similarity of the goods or services concerned, ... 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”.*²

37. The relevant factors identified by Jacob J. (as he then was) in the Treat³ case for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;

² Case C-39/97, at paragraph 23.

³ British Sugar PLC v James Robertson & Sons Ltd., 1996 R.P.C. 281.

(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.

38. In *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM)*, the General Court of the European Union stated that goods and/or services can be considered as identical when the goods and/or services designated by the trade mark application are included in a more general category designated by the earlier mark (and vice versa).⁴

39. The Applicant did not dispute the similarity of the goods, however, due to my finding of genuine use being in respect of a narrower list of goods than claimed by the Opponent, I will compare the Applicant's goods to the fair specification that I have identified.

Rings [jewelry]; Earrings; watches

40. The Applicant's rings [jewelry]; Earrings; and watches are plainly identical to the Opponent's rings; earrings and watches.

Jewellery products; Ornaments [jewellery, jewelry (Am.)]

41. The Applicant's jewellery products and ornaments [jewellery] are broad terms that cover rings and earrings under the Opponent's mark. As such, the respective goods are identical under the *Meric* principle.

⁴ *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM)*, case T-133/05 at paragraph 29. See Case T-388/00 *Institut für Lernsysteme v OHIM — Educational Services (ELS)* at paragraph 53 for this principle applied to services.

Necklaces [jewellery, jewelry (Am.)]; Bracelets

42. The Applicant's necklaces and bracelets are types of jewellery. They share the same intended purpose of adorning the body as the Opponent's rings and earrings. The respective goods will be made from similar materials, will target the same users, and will share the same channels of trade. I find the Applicant's necklaces and bracelets to be similar to the Opponent's goods to a high degree.

Jewelry caskets

43. The Applicant's jewelry caskets refer to a box or case for storing jewellery. I consider that these goods will often be sold alongside the Opponent's rings and earrings and may be seen as complementary with consumers being likely to think that responsibility for cases would reside with the same undertaking as the jewellery that they hold. With the same channels of trade, target consumer and likelihood of complementarity, I find the Applicant's and Opponent's goods to be similar to at least a medium degree.

Watchbands

44. The Applicant's watchbands constitute a part of watches under the Opponent's mark. The goods will share the same distribution channels and relevant consumer. The goods will also be seen as complementary, with consumers being likely to think that responsibility for the watchband lies with the same undertaking as the watch itself. I find the respective goods to be similar to at least a medium degree.

Cases for watch-making.

45. I understand cases for watch-making to refer to the shell of a watch before any mechanism for telling the time, or watchstrap has been introduced. The nature and intended purpose of a watch case is not the same as that of the watch as a whole and I consider that cases will be used primarily by manufacturers of watches. However, the case is a significant part of the watch, affecting its aesthetic quality and I consider that consumers, particularly of more expensive watches will expect

responsibility for the case and the watch to lie with the same undertaking, they may also select cases for custom built watches. Given these factors, I consider there to be an overlap in the channels of trade, and complementarity between the goods. I find that the Applicant's cases for watch-making and the Opponent's watches to be similar to at least a medium degree.

Clocks

46. The Applicant's clocks and the Opponent's watches share the same overall intended purpose of telling the time. I agree with the Opponent's contention in their submissions in lieu of a hearing that the goods can be sold through the same channels of trade. However, I consider that the goods differ in respect of their intended user and their nature; also, they are not complementary, nor are they in competition with each other. I find the Applicant's clocks and the Opponent's watches to be similar to a low degree.

Cases for clock-making

47. The Applicant's cases for clock-making are a further step away from the Opponent's watches. The case of a clock is different in its nature, intended purpose, user and channel of trade as compared to the Opponent's watches. The goods are not complementary, nor are they in competition. I find the Applicant's cases for clock-making to be dissimilar to the Opponent's goods. Given that there is no similarity in respect of cases for clock-making, the opposition under section 5(2)(b) fails in respect of these goods.

Average consumer and the purchasing act

48. It is necessary to determine who is the average consumer for the respective goods and how the consumer is likely to select them.

49. In *Hearst Holdings Inc*,⁵ Birss J. explained that:

⁵ *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), at paragraph 60.

“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 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 word “average” denotes that the person is typical ...”

50. It must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods in question: *Lloyd Schuhfabrik Meyer*⁶.

51. In its counterstatement, the Applicant submits that the average consumer of jewellery products will pay a higher degree of attention due to the goods being expensive and because they constitute an infrequent purchase. Conversely, the Opponent gives evidence that jewellery can also be very inexpensive. The witness statement of Kara Tompsett introduces screen shots from websites (at Exhibit KT1) where jewellery is priced at a few pounds, or less. In the Opponent's view (as set out in their submissions in lieu of a hearing), the level of attention for the goods varies from average for inexpensive items, to high for more luxury goods, or those purchased for a special occasion, such as a wedding ring. I agree with the Opponent's view and find that the level of attention paid will vary from medium to high. I consider that even where jewellery is very low-priced, due to its function of adorning the body, consumers will pay attention to the appearance of the item when purchasing it.

52. In terms of the nature of the purchasing act, I consider that visual considerations will be key with goods being examined in shop displays, on a website, or in a catalogue. I agree with the Opponent that aural considerations will also play a part, for example, where a shop assistant or jeweller provides assistance, or advice.

⁶ Case C-342/97.

Distinctive character of the earlier mark

53. Distinctive character is the capacity of the mark to identify the goods or services for which it is registered as coming from a particular undertaking, and to distinguish those goods or services from those of other undertakings: see *Lloyd Schuhfabrik Meyer*, paragraph 22.

54. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words. The inherent distinctive character may be enhanced through the use that has been made of the mark.

55. In *Lloyd Schuhfabrik Meyer*, the CJEU set out how an assessment of a mark's distinctive character should be made:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee v Huber and Attenberger [1999] ECR I-0000, paragraph 49).

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

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

56. In its counterstatement, the Applicant submits that the Opponent's mark is low in distinctive character being a female name that is gaining popularity in the UK. As an example of its renown, the Applicant states that the mark is the first name of the famous singer Kiki Dee. The Applicant also argues that there are numerous undertakings in the UK providing goods and services under the mark, meaning it should be free to be used by all. The Applicant has not provided evidence in support of its view that the name is gaining popularity, nor that it is commonly used in trade. The Opponent has brought evidence that Kiki is not a common name, with Exhibit KT2 showing Office for National Statistics data that a total of 56 girls born in the years 2019 and 2020 were named Kiki. The Opponent submits that their mark possesses at least a normal degree of inherent distinctive character.

57. Having considered the parties' submissions and the evidence filed by the Opponent, I consider that the earlier mark will be understood as a female name. The name is not a particularly popular name, nor is it extremely rare. I do not consider the name to have a descriptive or non-distinctive meaning in respect of the goods and the argument of low distinctiveness advanced by the Applicant has not been substantiated. I find the Opponent's mark to possess an average degree of distinctive character.

58. The Opponent claims that the distinctive character of their mark has been enhanced to a high level of distinctive character by virtue of their extensive reputation. In *Société des Produits Nestlé SA v Mars UK Ltd*, Case C-353/03, the Court of Justice of the European Union stated that:

"30. Yet, such identification, and thus acquisition of distinctive character, may be as a result both of the use, as part of a registered trade mark, of a component thereof and of the use of a separate mark in conjunction with a registered trade mark. In both cases it is sufficient that, in consequence of such use, the relevant class of persons actually perceive the product or service,

designated exclusively by the mark applied for, as originating from a given undertaking.

31. The matters capable of demonstrating that the mark has come to identify the product or service concerned must be assessed globally and, in the context of that assessment, the following items may be taken into consideration: 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 class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (judgment in Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee [1999] ECR I-2779, paragraphs 49 and 51).

32. In the final analysis, the reply to the question raised must be that the distinctive character of a mark referred to in Article 3(3) of the directive may be acquired in consequence of the use of that mark as part of or in conjunction with a registered trade mark.”

59. As previously set out in this decision, use shown in the evidence is primarily of the mark “Kiki McDonough”. I acknowledge that, in accordance with the judgment in *Nestlé*, distinctive character is not only acquired through use of the mark in the form it is registered, however the relevant consumer must perceive the goods as originating from a particular undertaking. In my view, due to the difference the addition of a surname makes to the mark and its distinctive character, use of the registered mark in the form “Kiki McDonough” does not enable the relevant consumer to perceive the mark “KIKI” solus as originating from a particular undertaking. As I have already identified in this decision, the Opponent has shown limited use of the mark as registered. I therefore disagree with the Opponent’s submission that the distinctive character of its mark has been enhanced to a high level of distinctive character.

60. I will therefore make an assessment of enhanced distinctiveness based on the use of “KIKI” that has been shown. The relevant factors to take into account include *“the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; and the amount invested by the undertaking in promoting the mark.”*⁷ The evidence of “KIKI” used without “McDonough” is limited, and some press articles are dated after the date of application for the contested mark. There are no sales or promotional figures and no indication of where sales have been made. As a result, it is not possible to assess the market share, geographical spread, or promotional investment in “KIKI”. Where “KIKI” is shown to be used on its own, it can be seen to have been used over several years, however, I consider that this alone is not sufficient to show that the distinctiveness of the mark has been enhanced through use and I find that there has been no enhancement of the distinctive character of the earlier mark.

Comparison of the marks

61. It is clear from *Sabel BV v. Puma AG*⁸ (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo SA v OHIM*,⁹ 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.”

⁷ *Windsurfing Chiemsee*.

⁸ Case C-251/95.

⁹ Case C-591/12P.

62. 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.

63. The Applicant's and Opponent's marks are shown below:

The Opponent's earlier mark	The Applicant's mark
KIKI	Mona Kiki

64. The overall impression of the Opponent's mark is of the female first name "KIKI", for the reasons set out above, I consider that the average consumer would recognise this as a female name.

65. The overall impression of the Applicant's mark is of the word "Mona". The Applicant submits that "Mona" is an arbitrary term while the Opponent submits that it will be recognised as a first name, with the order of wording in the Applicant's mark meaning that "Kiki" will be seen as a surname. I doubt that "Kiki" would be understood as a surname in the Applicant's mark. Both parties agree that "Kiki" is a female first name, not a surname and it is not in my view uncommon for first names to either be "double-barrelled", or a middle name to be given. I consider that if "Mona" is understood as a first name, the overall impression of the mark will be formed by two given names, with each being afforded similar weight. If "Mona" is not understood as a name, the Applicant's mark will be understood as an invented word, followed by a female first name. If seen as an invented word and first name, I consider that both elements would be afforded similar weight.

66. Visually, the marks align in respect of the word "KIKI", which is the entirety of the Opponent's mark and is reproduced in the Applicant's mark. The marks differ visually in respect of the additional word "Mona" in the Applicant's mark. As submitted by the Applicant, the positioning of the "Mona", as the first word in the mark is relevant as

consumers tend to pay more attention to the beginning of the mark.¹⁰ Overall I find the marks to be similar visually to a medium degree.

67. Aurally, the Opponent's mark consists of two syllables pronounced "KEY" "KEY". These sounds are also reproduced in the Applicant's mark, with the Applicant's mark beginning with two syllables "MOW" "NAH" that do not feature in the Opponent's mark. Again the positioning of "Mona" is relevant in the aural comparison, as consumers tend to pay more attention to the beginning of the mark. Overall I find the marks to be aurally similar to a medium degree.

68. With regards to the conceptual comparison, the EU courts have accepted that names may have a concept. On this issue, I note the following from the decision of Emma Himsworth KC in O/276/18.

"28. It is also clear that the mere fact that the marks the subject of the comparison can be grouped under a common generic term of 'names' does not automatically lead to a finding of conceptual similarity. This is well illustrated by the examples given in Part C, Section 2, Chapter 4 Comparison of Signs of the Guidelines for Examination of European Trade Marks issued by the EUIPO on 1 October 2017 where the names FRANK and MIKE are identified as being names which would not lead to a finding of conceptual similarity because the public is not likely to make a conceptual link between the two words; whereas the contrary is the case where the names in issue are FRANK and FRANKIE one being a different version of the other such that the public is likely to make a conceptual link.

29. Moreover, the fact that a mark is a name does not automatically mean that the mark has a clear and specific semantic content for the relevant public (see for example C-361/04 P Claude Ruiz-Picasso and Others v EUIPO EU:C:2006:25).

30. It is therefore necessary to make an assessment of conceptual similarity between names on the basis of each individual case."

¹⁰ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

69. The conceptual identity of the Opponent's mark resides in the female name "KIKI". Whether or not "Mona" is understood as a name, the concept of the female name "Kiki" is replicated in the Applicant's mark and I consider the marks to be conceptually similar to somewhere between a medium and high degree.

Likelihood of confusion

70. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all of the factors, weighing them, and looking at their combined effect, in accordance with the authorities set out earlier, in particular at my paragraph 34.

71. There are two types of confusion that I may find. The first type is direct confusion which occurs where the consumer mistakes one mark for another. The second type is indirect confusion, where the consumer notices the differences between the marks, but due to the similarities between the common elements, they believe that the goods or services derive from the same, or a related economic undertaking. Indirect confusion was explained by Mr Iain Purvis QC, sitting as the Appointed Person, in *Back Beat Inc v L.A. Sugar (UK) Limited*, 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".

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

72. That the three categories in that case are non-exhaustive has recently been confirmed by the Court of Appeal in *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others*.¹¹ Arnold LJ said, of the explanation given about how indirect confusion arises in *LA Sugar*:

“12. This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition. For example, one category of indirect confusion which is not mentioned is where the sign complained of incorporates the trade mark (or a similar sign) in such a way as to lead consumers to believe that the goods or services have been co-branded and thus that there is an economic link between the proprietor of the sign and the proprietor of the trade mark (such as through merger, acquisition or licensing).”

¹¹ [2021] EWCA Civ 1207.

73. In comparing the goods and services, the opposition under section 5(2)(b) has already been found to have failed in respect of *cases for clock-making*. In respect of the remaining goods under the Applicant's mark, in my decision, I have found some goods to be identical, with others ranging between a high and low degree of similarity. I have found the Opponent's mark to possess a medium degree of inherent distinctive character and that this has not been enhanced through the use that has been shown. I have found that the level of attention paid in the purchase of the goods will vary from medium to high and that the purchase will be predominantly visual in nature, but that aural considerations may also play a part. In terms of the marks themselves, I have found them to be visually and aurally similar to a medium degree and conceptually similar to a degree that is somewhere between medium and high.

74. I do not consider that the first word in the Applicant's mark "Mona" will be overlooked by the average consumer, even paying a medium degree of attention and in respect of identical goods. Consequently, I do not consider it likely that the marks will be mistakenly recalled, or misremembered as each other. I do not consider there to be a likelihood of direct confusion.

75. As to whether there is a likelihood of indirect confusion, I consider that the common element "KIKI", when used on identical goods, or those that are similar to at least a medium degree, is likely to result in the average consumer concluding that the marks originate from the same or economically linked undertakings. I consider that the medium degree of distinctive character of the Opponent's mark, together with the medium degree of visual and aural similarity, and between medium and high degree of conceptual similarity mean that even where the consumer pays a high degree of attention, there is a likelihood that they will indirectly confuse the marks. I do not consider that this likelihood of indirect confusion would extend to goods that I have found to be similar to a low degree, and the opposition under section 5(2)(b) therefore fails in respect of "clocks".

Outcome under section 5(2)(b)

76. The section 5(2)(b) ground of opposition succeeds in part, for the following goods:

Class 14: Jewellery products; Necklaces [jewellery, jewelry (Am.)]; Bracelets; Rings [jewelry]; Earrings; Ornaments [jewellery, jewelry (Am.)]; watches; Watchbands; Jewelry caskets; Cases for watch-making.

Section 5(3)

77. Section 5(3) of the Act states:

“(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.

(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”.

78. The relevant case law in respect of section 5(3) 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 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*).

79. The conditions of section 5(3) are cumulative. Firstly, the Opponent must show that the earlier mark is similar to the Applicant's mark. Secondly, that the earlier mark has achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the later mark. Fourthly, assuming that the first three conditions have been met, section 5(3) requires that one or more of the three types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

80. The first condition of similarity between the marks is satisfied: as found earlier in my decision, the Opponent's earlier mark is visually and aurally similar to the Applicant's mark to a medium degree, and is conceptually similar to somewhere between a medium and high degree.

81. The next condition is reputation. I found earlier in my decision that the Opponent had shown use in respect of “rings, earrings and watches” and I concluded that these goods represented a fair specification. Under this ground of opposition I must consider whether the Opponent had a reputation amongst a significant proportion of the relevant public at the relevant date. In *General Motors*, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined. Page 40 of 52 26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

82. In my view, the Opponent has not shown that their mark “KIKI” has a reputation and this follows my earlier finding that the distinctive character had not been enhanced. The evidence shows a long established jewellery business, a very high profile customer, in respect of The Princess of Wales, and mentions in mainstream press. However this points towards the Opponent having a reputation for “Kiki McDonough” with evidence of “KIKI” being used on its own being more limited and insufficient in my view to show that the mark has a reputation in the relevant market, which is undoubtedly large. With no reputation, the ground of opposition under section 5(3) fails.

Outcome under section 5(3)

83. The section 5(3) ground of opposition fails.

Overall outcome

84. The ground of opposition under section 5(2)(b) has succeeded in part. Subject to any appeal, the Application is refused in respect of:

Class 14: Jewellery products; Necklaces [jewellery, jewelry (Am.)]; Bracelets; Rings [jewelry]; Earrings; Ornaments [jewellery, jewelry (Am.)]; watches; Watchbands; Jewelry caskets; Cases for watch-making.

85. The Application may proceed to registration in respect of:

Class 14: Clocks; Cases for clock-making.

Costs

86. The Opponent has requested that off-scale costs be awarded, amounting to £12,460.90. The Opponent submits that such costs should be awarded as compensation for being put to the expense of preparing evidence. Before filing the opposition, the Opponent sent a sample of evidence to the Applicant which it claims showed that use was not limited to “Kiki McDonough”. The Opponent contends that the Applicant acted unreasonably because, in spite of having sight of the evidence beforehand, they required the Opponent to prove genuine use in these proceedings.

87. The Opponent refers to the discretion of the Registrar under section 68 of the Act and Rule 67 of the Trade Mark Rules 2008. The Opponent also refers to Anthony Watson Q.C. statement in *Rizla Ltd.’s Application*, [1993] RPC 365, that “*The wording of section 107 could not in my view be clearer and confers on the*

Comptroller a very wide discretion with no fetter other than the overriding one that he must act judicially.”

88. I have considered the Opponent’s submissions, however, I see no reason to award costs off the scale in this case. Earlier in my decision, I set out the relevant legislative provisions under section 6A and section 100 of the Act, which confer a requirement on the proprietor of the earlier mark to prove that it has made genuine use of its mark. I consider that the Applicant was entitled to require the Opponent to prove genuine use. I also note that the Applicant’s counterstatement raised similar concerns to those I have raised about the nature of use that the evidence shows. I do not know if the evidence seen by the Applicant prior to the proceedings is the same as that which has been filed, however, if the evidence was similar to that which has been presented in these proceedings, the doubts about the nature of the use suggest that the Applicant’s request for use to be proved is warranted.

89. I would also point out that the Opponent brought their case under section 5(3), which normally requires evidence to be filed, so it is not clear to me what additional cost the Applicant has been put to in gathering evidence that wouldn’t anyway have been required in pursuance of the opposition under section 5(3).

90. I therefore decline to award costs off the scale and will make my assessment under the scale set out in Tribunal Practice Notice (2/2016).

91. The opposition has in the most part succeeded with only two items in the list of goods not being refused. Taking account of this, I award the following costs:

Preparing a statement and considering the other side’s statement	£400
Preparing evidence	£800
Preparing submissions in lieu of a hearing	£400
TOTAL	£1,600

92. I order Mona Kiki Limited to pay Kiki McDonough the sum of £1,600. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 5th day of January 2023

Charlotte Champion

For the Registrar