

o/0048/23

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK3585460
BY CHARLOTTE TILBURY TM LIMITED
TO REGISTER THE TRADE MARK:**

CT

IN CLASSES 9, 14, 18, 25, & 35

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 426135
BY HERMANN HARTJE KG**

Background and pleadings

1. On 27 January 2021, Charlotte Tilbury TM Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 14 May 2021. Registration is sought for the following goods and services:

Class 9: Recorded and downloadable media; application software; computer software; sunglasses, glasses frames, ski-glasses; clothes for wiping glasses; wiping cloths impregnated with a cleaning preparation for cleaning eye glasses.

Class 14: Jewellery and imitation jewellery; cosmetic containers of precious and semi-precious metals; precious metals and their alloys; semi-precious and precious stones; key rings, key chains and charms; jewellery boxes; watches, clocks, parts and fittings for all the aforesaid goods.

Class 18: Leather and imitations of leather; animal skins and hides; luggage and carrying bags; umbrellas and parasols; walking sticks; whips, harness and saddlery; collars, leashes and clothing for animals; bags; briefcases; holdalls; rucksacks; sports bags; boot bags; satchels; wallets; belts; purses; card holders; umbrellas, parasols; record bags; beach bags; shoulder bags; handbags; sports bags; belt bags; duffle bags; hand bags; tote bags; shopping bags.

Class 25: Clothing; footwear; headgear.

Class 35: Advertising; business management, organization and administration; office functions; Advertising and promotion of cosmetics; conducting, arranging and organising trade fairs related to cosmetics; mail order retail services related to cosmetics; provision of business consultation, information and advisory services retail store services relating to cosmetics; arranging of cosmetics trade fairs; mail order catalogue services in relation to cosmetics; retail services connected with the sale of, bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, soaps,

perfumery, essential oils, cosmetics, hair lotions, dentifrices, cosmetic kits, cosmetics, eau de cologne, eyebrow cosmetics, eyebrow pencils, false eyelashes, false nails, lip glosses, lipsticks, make-up, make-up powder, make-up preparations, make-up removing preparations, mascara, nail polish, nail varnish, perfumery, perfumes, hand tools and implements (hand-operated), cutlery, side arms, razors, curling tongs, depilation appliances, electric and non-electric fingernail polishers, electric or nonelectric, flat irons, hair clippers for personal use matches, electric and non-electric hand implements for hair curling, hair-removing tweezers, manicure sets, manicure sets, electric, nail buffers, electric or non-electric, nail clippers, electric or non-electric, nail files, nail files, electric, pedicure sets, scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments, apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, apparatus for recording, transmission or reproduction of sound or images, magnetic data carriers, recording discs, compact discs, dvds and other digital recording media, mechanisms for coin-operated apparatus, cash registers, calculating machines, data processing equipment, computers, computer software, fire-extinguishing apparatus, sunglasses, spectacles, precious metals and their alloys, jewellery, precious stones, horological and chronometric instruments, paper, cardboard, printed matter, bookbinding material, photographs, stationery, adhesives for stationery or household purposes, artists' materials, paint brushes, typewriters and office requisites (except furniture), instructional and teaching material (except apparatus), plastic materials for packaging, printers' type, printing blocks, blotters, booklets, books, calendars, cards, document holders, drawing pads, drawing pens, drawing sets, envelopes, flyers, folders, greeting cards, magazines, newspapers, pamphlets, pencils, pens, periodicals, postcards, posters, printed matter, printed publications, scrapbooks, stationery, teaching materials (except apparatus), leather and imitations of leather, animal skins, hides, trunks and travelling bags, umbrellas and parasols, walking sticks, whips, harness and saddlery, backpacks, beach bags, boxes of leather or leather board, briefcases, canes, cases of leather or leatherboard, collars for animals, garment bags for travel, handbags, hat boxes of leather, haversacks, imitation

leather, key cases, leather leads, leather leashes, moleskin, pocket wallets, purses, rucksacks, school bags, school satchels, shopping bags, travelling bags, travelling trunks, valises, vanity cases, not fitted, wheeled shopping bags, furniture, mirrors, picture frames, wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of pearl, meerschaum, household or kitchen utensils and containers, combs and sponges, brushes (except paint brushes), brush-making materials, articles for cleaning purposes, steelwool, unworked or semi-worked glass (except glass used in building), glassware, porcelain and earthenware, mirrors, abrasive sponges for scrubbing the skin, aerosol dispensers, not for medical purposes, brushes, comb cases, combs, cosmetic utensils, deodorising apparatus for personal use, eyebrow brushes, hair for brushes, make-up removing appliances, nail brushes, perfume burners, perfume sprayers, perfume vaporizers, powder compacts, powder puffs, shaving brush stands, shaving brushes, soap boxes, soap dispensers, soap holders, soup bowls, sponge holders, stands for shaving brushes, toothbrushes, toothbrushes, electric, ropes, string, nets, tents, awnings, tarpaulins, sails, sacks and bags, padding and stuffing materials (except of rubber or plastics), raw fibrous textile materials, yarns and threads, for textile use, textiles and bedclothes, blankets, bedspreads, sheets, pillowcases, curtains of textile, towels, flannels, throws, tablecloths, bed covers, table covers, clothing, footwear, headgear, aprons, babies' pants, bandanas, bath robes, bath slippers, bathing drawers, bathing suits, bathing trunks, belts, berets, bodices, boots, brassieres, breeches for wear, camisoles, caps, coats, dresses, dressing gowns, ear muffs, footmuffs, not electrically heated, galoshes, garters, gloves, hats, headbands, hosiery, inner soles, jackets, jerseys, jumper dresses, jumpers, knitwear, leg warmers, leggings, leggings, masquerade costumes, mittens, money belts, muffs, neckties, outerclothing, overalls, overcoats, pants, parkas, petticoats, pinafore dresses, ponchos, pullovers, pyjamas, sandals, saris, sarongs, scarfs, shawls, shirts, shoes, short-sleeve shirts, shoulder wraps, shower caps, singlets, skirts, sleep masks, slippers, smocks, socks, sports jerseys, sports shoes, stockings, stuff jackets, suits, sun visors, suspenders, sweaters, swimsuits, tee-shirts, tights, top hats, trousers, turbans, underclothing, underpants, underwear, uniforms, veils, vests, waistcoats, waterproof clothing, wooden shoes, wristbands, lace and

embroidery, ribbons and braid, buttons, hooks and eyes, pins and needles, artificial flowers, carpets, rugs, mats and matting, linoleum and other materials for covering existing floors, wall hangings (non-textile), games and playthings, gymnastic and sporting articles, decorations for christmas trees, meat, fish, poultry and game, meat extracts, preserved, frozen, dried and cooked fruits and vegetables, jellies, jams, compotes, eggs, milk and milk products, edible oils and fats, coffee, tea, cocoa and artificial coffee, rice, tapioca and sago, flour and preparations made from cereals, bread, pastry and confectionery, ices, sugar, honey, treacle, yeast, baking-powder, salt, mustard, vinegar, sauces (condiments), spices, ice, grains and agricultural, horticultural and forestry products, live animals, fresh fruits and vegetables, seeds, natural plants and flowers, foodstuffs for animals, malt, beers, mineral and aerated waters and other non-alcoholic beverages, fruit beverages and fruit juices, syrups and other preparations for making beverages, soft drinks, energy drinks, wines, iced-tea, aperitifs, carbonated beverages, fruit extracts, ginger ale, grape must, must, fruit drinks made from concentrate, cordials, malt water, seltzer water, soda water, tonic water, vegetable juices, essences used in the preparation of liqueurs, barley waters, fruit squashes, sarsaparilla, alcoholic beverages (except beers), tobacco, smokers' articles, matches.

2. The application was opposed by Hermann Hartje KG (“the opponent”) on 13 August 2021. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). Following receipt of the opponent’s email dated 18 October 2022, I note the extent of the opposition has now been limited to the following goods and services:

Class 9: Sunglasses, glasses frames, ski-glasses

Class 18: Rucksacks; sports bags; belt bags

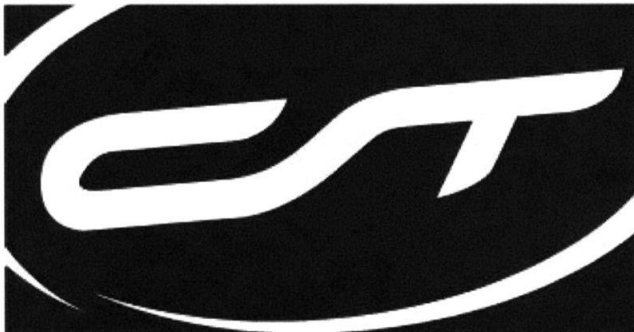
Class 25: Clothing; footwear; headgear.

Class 35: Retail services connected with the sale of sunglasses, spectacles, backpacks, rucksacks, clothing, footwear, headgear, aprons, babies' pants, bandanas, bath robes, bath slippers, bathing drawers, bathing suits, bathing

trunks, belts, berets, bodices, boots, brassieres, breeches for wear, camisoles, caps, coats, dresses, dressing gowns, ear muffs, footmuffs, not electrically heated, galoshes, garters, gloves, hats, headbands, hosiery, inner soles, jackets, jerseys, jumper dresses, jumpers, knitwear, leg warmers, leggings, leggings, masquerade costumes, mittens, money belts, muffs, neckties, outerclothing, overalls, overcoats, pants, parkas, petticoats, pinafore dresses, ponchos, pullovers, pyjamas, sandals, saris, sarongs, scarfs, shawls, shirts, shoes, short-sleeve shirts, shoulder wraps, shower caps, singlets, skirts, sleep masks, slippers, smocks, socks, sports jerseys, sports shoes, stockings, stuff jackets, suits, sun visors, suspenders, sweaters, swimsuits, tee-shirts, tights, top hats, trousers, turbans, underclothing, underpants, underwear, uniforms, veils, vests, waistcoats, waterproof clothing, wooden shoes, wristbands, lace and embroidery, ribbons and braid, buttons, hooks and eyes, gymnastic and sporting articles.

3. The opponent relies on the following trade mark:

UK801412311



Filing date: 06 April 2018

Registration date: 14 July 2020

Relying upon the following goods:

Class 8: Hand-operated tools.

Class 9: Batteries (electric); spectacles; sunglasses; anti-glare glasses; protective helmets, especially cyclist helmets; chargers for electric batteries; tachometers; bicycle computers.

Class 12: Luggage nets; panniers adapted for cycles.

Class 25: Clothing; footwear; headgear; cyclists' clothing.

4. The opponent claims that the marks are visually similar and conceptually and orally identical. The opponent furthers that the applicant's goods in classes 9 and 25 are identical and similar, the goods in class 18 are identical and similar to the goods in classes 12 and 25 and that the goods and services in classes 14 and 35 are similar to the goods in classes 8, 9 and 25 of the earlier mark.

5. The applicant filed a counterstatement denying the claims made.

6. The applicant is represented by Lane IP Limited and the opponent is represented by Meissner Bolte (UK) Limited.

7. Neither party filed evidence nor requested a hearing. Only the opponent provided submissions in lieu. This decision is therefore taken following careful perusal of the papers.

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.

Decision

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. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark 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.

...”

11. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 2, above, which qualifies as an earlier trade mark under the above provisions. As this trade mark had not completed its registration process more than 5 years before the filing date of the application in suit, it is not subject to proof of use, as per section 6A of the Act. The opponent can, as a consequence, rely upon all of the goods it has identified.

Case law

12. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case

C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

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

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a 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

13. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the "Nice Classification" means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

14. In the judgment of the 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”.

15. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of 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.

16. In *Gérard Meric v OHIM* ('Meric'), Case T-133/05, the General Court ("the GC") stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services* (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

17. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

18. In *Boston Scientific Ltd v 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 that the responsibility for those goods lies with the same undertaking”.

Applicant’s goods and services	Opponent’s goods
<p>Class 9: Sunglasses, glasses frames, ski-glasses</p> <p>Class 18: Rucksacks; sports bags; belt bags</p> <p>Class 25: Clothing; footwear; headgear.</p> <p>Class 35: Retail services connected with the sale of sunglasses, spectacles,</p>	<p>Class 8: Hand-operated tools.</p> <p>Class 9: Batteries (electric); spectacles; sunglasses; anti-glare glasses; protective helmets, especially cyclist helmets; chargers for electric batteries; tachometers; bicycle computers.</p> <p>Class 12: Luggage nets; panniers adapted for cycles.</p>

<p>backpacks, rucksacks, clothing, footwear, headgear, aprons, babies' pants, bandanas, bath robes, bath slippers, bathing drawers, bathing suits, bathing trunks, belts, berets, bodices, boots, brassieres, breeches for wear, camisoles, caps, coats, dresses, dressing gowns, ear muffs, footmuffs, not electrically heated, galoshes, garters, gloves, hats, headbands, hosiery, inner soles, jackets, jerseys, jumper dresses, jumpers, knitwear, leg warmers, leggings, leggings, masquerade costumes, mittens, money belts, muffs, neckties, outerclothing, overalls, overcoats, pants, parkas, petticoats, pinafore dresses, ponchos, pullovers, pyjamas, sandals, saris, sarongs, scarfs, shawls, shirts, shoes, short-sleeve shirts, shoulder wraps, shower caps, singlets, skirts, sleep masks, slippers, smocks, socks, sports jerseys, sports shoes, stockings, stuff jackets, suits, sun visors, suspenders, sweaters, swimsuits, tee-shirts, tights, top hats, trousers, turbans, underclothing, underpants, underwear, uniforms, veils, vests, waistcoats, waterproof clothing, wooden shoes, wristbands, lace and embroidery, ribbons and braid, buttons, hooks and eyes, gymnastic and sporting articles.</p>	<p>Class 25: Clothing; footwear; headgear; cyclists' clothing.</p>
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19. I consider the following goods to be replicated identically within both specifications:

Sunglasses; clothing; footwear; headgear.

Glasses frames

20. I find that the above goods will be a part that make up the opponent's 'spectacles' (glasses and spectacles being interchangeable in meaning), I consider that the nature will overlap as the frame of the spectacles will form the main structure of the goods, the frames will simply be missing the required lenses. The use and user will overlap as they are goods which add persons to see better, or even perhaps to be worn as fashion accessories at times. The trade channels will also overlap; it is usual for glasses stores to offer many types of frames for the consumer to choose from and offer to insert the required lenses for the consumer, in this instance purchasing just the frames may allow the lenses to be inserted elsewhere. I therefore find these goods to be similar to a high degree.

Ski-glasses

21. I consider that these will fall within the wider category of the opponent's 'anti-glare glasses' as the ski-glasses are designed to prevent the glare from the snow from getting in the eyes of skiers. Therefore, I find them to be identical under the *Meric* principles.

Rucksacks; sports bags; belt bags

22. In relation to the above goods, there is an overlap of purpose and use with the opponent's 'panniers adapted for cycles' as all items are intended to carry other items in a practical manner. They could overlap in nature as well as it is possible they would be made from the same or similar materials and will be structured in a way to have a space inside for other items to be stored. They will also have straps which could be adjustable. I consider that they differ in that the applicant goods are likely to be worn on a person whereas the panniers are for placement on a bicycle. There could be an overlap in trade channels but I also believe the opponent's goods might be found in

more specialist shops relating to cycling. I therefore find these goods to be similar to a medium degree.

Retail services connected with the sale of sunglasses, spectacles, clothing, footwear, headgear, aprons, babies' pants, bandanas, bath robes, bath slippers, bathing drawers, bathing suits, bathing trunks, belts, berets, bodices, boots, brassieres, breeches for wear, camisoles, caps, coats, dresses, dressing gowns, ear muffs, footmuffs, not electrically heated, galoshes, garters, gloves, hats, headbands, hosiery, inner soles, jackets, jerseys, jumper dresses, jumpers, knitwear, leg warmers, leggings, leggings, masquerade costumes, mittens, money belts, muffs, neckties, outerclothing, overalls, overcoats, pants, parkas, petticoats, pinafore dresses, ponchos, pullovers, pyjamas, sandals, saris, sarongs, scarfs, shawls, shirts, shoes, short-sleeve shirts, shoulder wraps, shower caps, singlets, skirts, sleep masks, slippers, smocks, socks, sports jerseys, sports shoes, stockings, stuff jackets, suits, sun visors, suspenders, sweaters, swimsuits, tee-shirts, tights, top hats, trousers, turbans, underclothing, underpants, underwear, uniforms, veils, vests, waistcoats, waterproof clothing, wooden shoes, wristbands

23. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning the comparison of retail services to goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent's earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are 'similar' to goods

are not clear cut.”

24. However, on the basis of the European courts’ judgments in *Sanco SA v OHIM*¹, and *Assembled Investments (Proprietary) Ltd v. OHIM*², upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd*³, Mr Hobbs concluded that:

i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer’s point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent’s goods and then to compare the opponent’s goods with the retail services covered by the applicant’s trade mark;

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

iv) The General Court’s findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party’s trade mark was registered (or proposed to be registered).

25. The opponent’s goods are contained within the retail services mentioned above in the applicant’s specification. Some of the retail items i.e. coats, dresses etc fall within the wider categories found in the opponent’s goods. The goods are indispensable to the retail services relating to them. Additionally, there is an overlap in trade channels

¹ Case C-411/13P

² Case T-105/05 at paragraphs [30] to [35] of the judgement

³ Case C-398/07P

through which the goods and services reach the average consumer. I therefore find there to be a medium degree of similarity between these goods and services.

Retail services connected with the sale of backpacks, rucksacks, lace and embroidery, ribbons and braid, buttons, hooks and eyes, gymnastic and sporting articles

26. As noted above, in *Waterford Wedgwood Plc*, goods do not have to be the same as the goods being retailed by the services for there to be a finding of similarity. However, I find the goods being retailed in these services are not likely to be found in the same establishments. I therefore do not believe there to be a complementarity between these goods and services and find them to be dissimilar.

27. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.”

28. Therefore, as I have found no similarity for the applicant’s ‘retail services connected with the sale of backpacks, rucksacks, lace and embroidery, ribbons and braid, buttons, hooks and eyes, gymnastic and sporting articles’ the opposition fails in relation to them.

29. The opposition will continue in respect of the applicant’s class 9, 18 and 25 goods and ‘Retail services connected with the sale of sunglasses, spectacles, clothing, footwear, headgear, aprons, babies' pants, bandanas, bath robes, bath slippers, bathing drawers, bathing suits, bathing trunks, belts, berets, bodices, boots, brassieres, breeches for wear, camisoles, caps, coats, dresses, dressing gowns, ear muffs, footmuffs, not electrically heated, galoshes, garters, gloves, hats, headbands,

hosiery, inner soles, jackets, jerseys, jumper dresses, jumpers, knitwear, leg warmers, leggings, leggings, masquerade costumes, mittens, money belts, muffs, neckties, outerclothing, overalls, overcoats, pants, parkas, petticoats, pinafore dresses, ponchos, pullovers, pyjamas, sandals, saris, sarongs, scarfs, shawls, shirts, shoes, short-sleeve shirts, shoulder wraps, shower caps, singlets, skirts, sleep masks, slippers, smocks, socks, sports jerseys, sports shoes, stockings, stuff jackets, suits, sun visors, suspenders, sweaters, swimsuits, tee-shirts, tights, top hats, trousers, turbans, underclothing, underpants, underwear, uniforms, veils, vests, waistcoats, waterproof clothing, wooden shoes, wristbands' in Class 35.

Average consumer and the purchasing act

30. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

31. 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. (as he then was) 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 word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

32. The average consumer of the goods in classes 9, 12, 18 and 25 will predominantly be the general public.

33. The selection of such goods is largely a visual process, as the average consumer will wish to physically handle the goods in store to ensure the correct size has been selected, whilst simultaneously appraising the overall aesthetic impact. If the consumer is buying online then I also note they will see the marks on the websites. This means that the visual element of the mark will be the most significant: see *New Look Limited v OHIM*, Joined cases T-117/03 to T-119/03 and T-171/03, paragraph 50. I do not, however, ignore the potential for the marks to be spoken, for example, by sales assistants in a retail establishment or when making a purchase from a catalogue, over the telephone. However, in the latter circumstances, the consumer will have had an opportunity to view the goods, perhaps electronically via an online catalogue or website, or on paper in the traditional sense of catalogue shopping. Therefore, when considering the aural impact of the marks, the visual impression of these goods will already have played a part in the consumer's mind.

34. Although the prices of individual items will vary greatly, I consider that the average consumer will pay at least a medium degree of attention (but not the highest level) during the purchase of the remaining goods.

35. For the remaining class 35 services, I believe the average consumer will be the public at large. Retail services are likely to have been chosen by viewing promotional material (either hard copy, on television or online) and high street signage. The choice of all of the services at issue will be largely influenced by visual considerations. There is also the possibility of word of mouth recommendations. When selecting the services at issue, the average consumer is likely to consider such things as stock, price of goods offered in comparison to other retailers, delivery method (for online retail) and knowledge of the staff. I therefore believe the average consumer will pay a medium degree of attention during the selection process.

Comparison of the marks


36. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions

created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

37. 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.

38. The respective trade marks are shown below:

Contested mark	Earlier mark
CT	

39. The contested mark is a word mark made up of two letters: C and T. The overall impression lies in those two letters.

40. The earlier mark is a figurative mark which features a black background with a device element in the middle which is made of thick curved white lines that forms what could be a type of hook/tool or other abstract device. There are also two curved white lines around the device on the left hand side and the bottom of the mark. Due to the

heavy stylisation of the earlier mark, I find that the distinctiveness lies in the mark as a whole.

41. The contested mark is simply made up of two letters. It is a word mark so can be presented in different fonts, upper and lower cases and sizing.⁴ I have described the earlier mark in paragraph 40 above in detail. I understand that the opponent has submitted that the device in the middle of the mark represents the letters 'CT'. I consider that perhaps some consumers might view the above mark as containing those two letters. In terms of a visual comparison between the marks, the earlier mark is very heavily stylised and as such, is very different to look at to the applicant's mark. For these consumers, I find the marks to be visually similar to a very low degree. I also consider that there will be some consumers who will not recognise the letters 'CT' within the earlier mark at all and will view the device element as simply an abstract device or hook. In this case, they would find the marks visually dissimilar.

42. For those consumers who do see the element in the centre of the earlier mark as the letters 'CT' this will likely be pronounced one letter at a time given their normal pronunciation. This pronunciation will be the same for the contested mark and therefore, for these consumers the marks are aurally identical. For the consumers that view the earlier mark as something other than letters, they would not pronounce the mark and therefore, the marks would be aurally dissimilar.

43. Conceptually, the applicant's mark consists of random letters which aren't likely to convey any particular meaning. The same will apply for those who view the earlier mark as containing the letters 'CT' and therefore, insofar as both marks contain the same letters, there would be conceptual identity. For those that view the earlier mark as an abstract device it will have no particular meaning and therefore, the marks would be conceptually dissimilar.

⁴ *Groupement Des Cartes Bancaires v China Construction Bank Corporation*, case BL O/281/14

Distinctive Character of the Earlier Mark

44. 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 C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).”

45. The opponent made no claim and put forward no evidence relating to an enhanced level of distinctiveness of their earlier marks. I will therefore consider the position based solely on its inherent distinctiveness.

46. For the consumers who view the mark as containing the letters ‘CT’, owing mainly to the heavy stylisation, I find the mark to be inherently distinctive to a medium degree.

47. As I have stated above, I believe the earlier mark will be viewed as an abstract device or perhaps a stylised hook and therefore, as it appears to be a wholly invented device, I would consider that the mark might be inherently distinctive to a high degree.

Likelihood of Confusion

48. There are two types of confusion that I must consider. Firstly, direct confusion i.e. where one mark is mistaken for the other. The second is indirect confusion which is where the consumer appreciates that the marks are different, but the similarities between the marks lead the consumer to believe that the respective goods or services originate from the same or a related source.

49. In *L.A. Sugar Limited v Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“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.

50. The conclusions I have reached above regarding the marks depend on whether or not the average consumer views the earlier mark as containing the letters ‘CT’ or whether they view the item in the middle of the mark as a hook or other figurative element. In the event consumers do view the mark as containing the letters ‘CT’ then I have found the marks at issue are visually similar to very low degree and aurally and conceptually identical. For the consumers who do not view the device in the centre of the earlier mark as the letters ‘CT’ then they are dissimilar. The average consumer would pay between a medium and at least a medium degree of attention during the purchasing process. The remaining goods and services at issue have been found to be between identical and similar to a medium degree. The earlier mark is inherently distinctive to a medium degree (or high). I found the overall impression of the contested mark to be in the letters themselves and in the earlier mark to be in the device in the centre of the mark, be that viewed as the letters CT or otherwise.

51. For those that view the earlier mark as a device element (be that an invented device or some hook type device), there would be no similarities between the marks and therefore, there can be no likelihood of confusion, either direct or indirect.

52. Next, I turn to the consumers who will view the earlier mark as containing the letters 'CT'. Although I have found that these consumers will find the marks to be aurally and conceptually identical, the finding of the marks to only be visually similar to a very low degree is of particular importance in this case given that as per *New Look Limited v OHIM* the purchasing process is predominantly visual, especially for the applicant's and opponent's clothing goods (being obtained by self-selection from the shelves of a clothing retail outlet, online or catalogue equivalent).⁵ Even as I have found the degree of distinctive character of the earlier mark to be medium for those who view the mark as containing the letters 'CT', this is mainly due to the heavy stylisation of the mark and not the letters themselves. There is no such styling of the contested mark. Bearing all of this in mind, I do not believe that the average consumer will mistake one mark for the other and therefore, there can be no direct confusion between the marks.

53. Nor do I find that there any "proper basis" why the average consumer would consider the contested mark to be another brand of the owner of the earlier mark, so no indirect confusion arises either.⁶ A finding of indirect confusion should not be made merely because the two marks share a common element.⁷ Due to the heavy stylisation of the earlier mark which does not feature at all within the contested mark, I am not convinced that there is enough between the marks to call one to mind on encountering the other. If they did call the marks to mind it would be mere association and not indirect confusion.

Conclusion

54. The opposition under section 5(2)(b) fails in its entirety.

⁵ Joined cases T-117/03 to T-199/03 and T-171/03

⁶ See Arnold LJ at [13] of the judgement in *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207.

⁷ As noted, for instance, by James Mellor Q.C. (as he then was), as the Appointed Person in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

Costs

55. The applicant has successful and is therefore entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. After due consideration, I believe that an award of costs to the applicant is appropriate as follows:

Considering the Notice of Opposition and preparing Counter Statement	£350
TOTAL	£350

56. I therefore order Hermann Hartje KG to pay Charlotte Tilbury TM Limited the sum of £350. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 17th day of January 2023

L Nicholas
For the Registrar