

O-0352-23

**TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO 3610875
BY GEORGINE RATELBAND
TO REGISTER**

GEORGINE

**AS A TRADE MARK IN CLASSES 14, 18 & 25
AND
OPPOSITION THERETO (UNDER NO. 426414)
BY
WALMART APOLLO, LLC**

BACKGROUND

1) On 16 March 2021, Georgine Ratelband ('the applicant') applied to register the word GEORGINE as a trade mark in the UK in relation to the following goods:

Class 14: Jewellery, all aforementioned goods being high-end luxury goods.

Class 18: Luggage, bags, wallets and other carriers; all aforementioned goods being high-end luxury goods.

Class 25: Clothing; Footwear; Headgear; Hats; all aforementioned goods being high-end luxury goods.

The application claims a priority date of 02 January 2016 from EUTM application number 14972459.

2) The application was published in the Trade Marks Journal on 28 May 2021 and notice of opposition was later filed by Walmart Apollo, LLC ('the opponent'). The opponent claims that the trade mark application offends under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ('the Act').

3) In support of its grounds under sections 5(2)(b) and 5(3) of the Act, the opponent relies upon the following three trade mark registrations and all of the goods and services covered by the same:

- **UKTM 901282557 ('557')**

GEORGE

Filing date: 18 August 1999

Date of entry in register: 04 January 2012

This registration covers a range of goods in classes 3, 9, 18, 21, 24, 25 & 26.

- **UKTM 2113516 ('516)**

GEORGE

Filing date: 22 October 1996

Date of entry in register: 21 April 2000

This registration covers a range of goods in classes 14, 18 & 25.

- **UKTM 2343417D ('417D)**

GEORGE

Filing date: 16 September 2003

Date of entry in register: 02 May 2008

This registration covers a range of retail and mail order services in class 35.

4) It is claimed that the respective goods and services are either identical or similar and that the respective marks are similar such that there exists a likelihood of confusion under Section 5(2)(b).

5) It is also claimed that the earlier marks enjoy a reputation in the UK in respect of all of the goods/services covered by them and that use of the contested mark will take unfair advantage of, or be detrimental to, the reputation and/or distinctive character of the earlier marks.

6) The trade marks relied upon by the opponent under sections 5(2)(b) and 5(3) of the Act are earlier marks, in accordance with section 6 of the Act. As marks '516 and '417D completed their registration procedure more than five years prior to the priority date of the contested mark, they are subject to the proof of use conditions, as per section 6A of the Act. The opponent made a statement of use in respect of all the goods/services relied upon for each earlier mark. I note that the opponent also made a statement of use in respect of mark '557. However, that mark was registered on 04

January 2012, being less than five years prior to the priority date of the contested mark (being 02 January 2016) and it is therefore not subject to proof of use.

7) Under section 5(4)(a) of the Act, the opponent relies upon the use of the sign GEORGE, throughout the UK, since approximately 1990. That sign is said to have been used in relation to 'Precious metals and their alloys, jewellery, leather and imitations of leather, luggage, carrying bags, wallets, clothing, footwear, headgear' and 'retailing of [the aforementioned goods]'. It is claimed that use of the applicant's mark, in respect of the goods applied for, will lead to misrepresentation and damage to the opponent's goodwill associated with its earlier sign.

8) The applicant filed a counterstatement in which it denies all of the grounds of opposition and requests proof of use of all of the earlier marks. However, for the reasons given above, the opponent is not required to provide proof of use for earlier mark '557.

9) The opponent is represented by Appleyard Lees IP LLP. The applicant is represented by Sonder & Clay. Only the opponent filed evidence; the applicant has filed nothing beyond the counterstatement. The opponent's evidence consists of a witness statement from Daniel James Bailey with 3 exhibits¹ thereto and a witness statement from Graeme Morrison with 7 exhibits² thereto. Neither party requested a hearing. The opponent filed written submissions in lieu. I now make this decision after careful consideration of the papers before me.

DECISION

Approach

10) The contested mark covers goods in classes 14, 18 and 25. Although a large number of goods and services are relied upon by the opponent in a number of different classes, it is obvious, bearing in mind the content of the evidence before me

¹ DJB1 – DJB3

² GM1 – GM7

and the identity between some of the respective goods, that the opponent's best prospect of success lies with its reliance upon i) the goods covered by mark '557 in classes 18 and 25 and the goods covered by mark '516 in class 14 under section 5(2) and 5(3) and ii) use in relation to the same goods covered by those three classes under Section 5(4)(a). I will therefore assess the grounds on that basis first.

Proof of use

11) Section 6A of the Act states:

“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),
(b) 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.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(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.”

12) Section 100 is also relevant, which 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.”

Consequently, the onus is upon the opponent to prove that genuine use of the earlier mark GEORGE was made in the relevant period. In accordance with section 6A(1A) of the Act, that period is the five-year period ending on the priority date of the contested mark i.e. 03 January 2011 to 02 January 2016.

13) 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 Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

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

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

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

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

14) Mr Morrison’s evidence shows, inter alia, the following:

- The GEORGE brand was established in the UK in around 1990 and it has been used continuously since then.
- Sales of GEORGE branded goods has taken place through the opponent’s website since 2008. GEORGE branded goods are also sold through the Opponent’s stores. As of 2016, the opponent had more than 500 stores.
- In 2014, total sales of goods under the GEORGE brand products amounted to greater than £1.6 billion.
- The total estimated value of sales of GEORGE branded products in the UK, between 2014 and 2016, was more than £2.1 billion per year.

- Sales of GEORGE branded clothing in the years 2010 – 2016 was in the region of £1.6 billion per year.
- The prints from the opponent’s website in the relevant period show use of GEORGE in relation to a wide variety of items of clothing, footwear and headgear for men, women and children including tops, trousers, dresses, cardigans, hats, trainers, boots, shoes, handbags, shopper bags, backpacks/rucksacks, satchels, purses, necklaces, bracelets and earrings³.
- Photographs of the clothing section inside the opponent’s ASDA stores showing prominent use on signage of GEORGE.⁴
- The opponent spends many millions of pounds each year on promoting the GEORGE brand through tv, radio, magazine and press adverts.
- The opponent’s website is promoted by methods such as pay-per-click (PPC).⁵ The website is also optimised by search engine optimisation (SEO), retain targeting (RT) and affiliates marketing. The total amount spent on the aforementioned activities in 2015 was over £4.8 million.
- An on-line newspaper article dated 15 August 2014 is entitled ‘Asda’s George overtakes Marks & Spencer as Britain’s second biggest clothing chain’.⁶

15) Mr Bailey’s evidence shows, inter alia, the following:

- An article from ‘RetailWeek’ dated 17 June 2013 states that ‘George at Asda remains arguably the best-known UK supermarket clothing own brand and is enjoying strong growth’.

16) The sales figures provided are substantial, particularly for clothing. Further, although it is not clear what precise goods the rest of the sales figures relate to, taking a collective view of the evidence and the kinds of goods that are present on the opponent’s website, I find that the earlier mark, GEORGE, has been put to genuine use in the relevant period for the following goods: handbags, purses and rucksacks/backpacks, a wide variety of different kinds of clothing, footwear and

³ Exhibit GM1

⁴ Exhibit GM3

⁵ Exhibit GM7

⁶ Exhibit GM6 (page 88)

headgear for men, women and children (such as tops, trousers, dresses, cardigans, boots, trainers, hats) and on various items of jewellery (such as earrings, necklaces and bracelets).

17) I now need to consider what constitutes a fair specification for earlier mark '516, having regard for the goods upon which genuine use has been shown. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, 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.”

18) 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.

“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."

19) As noted above, there has been genuine use shown for a variety of goods in classes 18 and 25 and various items of jewellery. For the reasons I gave at paragraph 10, I need only determine a fair specification for mark '516 in class 14. Given that there has been use on numerous different items of jewellery, I find that a fair specification for earlier mark '516 in class 14 is 'Jewellery'.

Section 5(2)(b)

20) This section of the Act states:

"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.

5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

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

The principles

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

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

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

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

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

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

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

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

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

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

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

Comparison of goods

22) All relevant factors relating to the goods should be taken into account when making the comparison. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU, Case C-39/97, stated at paragraph 23 of its judgment:

“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.”

23) Guidance on this issue has also come from Jacob J where, in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, the following factors were highlighted as being relevant:

- (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.

24) In *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM Case T-133/05) ('Meric'), where the General Court held 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 the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedial v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

25) The goods to be compared are:

Opponent's goods	Applicant's goods
<p><u>Mark '516:</u></p> <p>Class 14: Jewellery.</p> <p><u>Mark '557:</u></p> <p>Class 18: Leather and imitations of leather, and goods made of these materials; ... trunks and travelling bags; ...pocket wallets;...</p> <p>Class 25: Clothing, footwear, headgear....</p>	<p>Class 14: Jewellery, all aforementioned goods being high-end luxury goods.</p> <p>Class 18: Luggage, bags, wallets and other carriers; all aforementioned goods being high-end luxury goods.</p> <p>Class 25: Clothing; Footwear; Headgear; Hats; all aforementioned goods being high-end luxury goods.</p>

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26) The respective goods in classes 14 and 25 are either self- evidently identical or identical on the *Meric* principle.

27) Turning to the applicant's goods in class 18, the applicant's 'luggage', 'bags' and 'other carriers' are identical to the opponent's 'trunks and travelling bags' on the *Meric* principle. The applicant's 'wallets' are also obviously identical to the opponent's 'pocket wallets'.

28) The term 'all aforementioned goods being high-end luxury goods' does not disturb any of these findings.

Average consumer and the purchasing process

29) It is necessary to determine who the average consumer is for the respective goods and the manner in which they are likely to be selected. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

30) The average consumer for the goods at issue is the general public. The purchasing act will be primarily visual on account of the goods being commonly purchased based on their aesthetic appeal; they are likely to be selected after perusal of racks/shelves in retail establishments, or from photographs on Internet websites or in catalogues. That is not to say though that the aural aspect should be

ignored since the goods may sometimes be the subject of discussions with retail staff, for example. The cost of the goods is likely to vary. However, factors such as size, material, aesthetic appeal or suitability for purpose are likely to be taken account of by the consumer in relation to all the goods, even those at the more inexpensive end of the spectrum. Generally speaking, I find a medium degree of attention is likely to be paid during the purchase. This conclusion is not disturbed by the term 'all aforementioned goods being high-end luxury goods' in the applicant's specification.

Distinctive character of the earlier mark

31) The distinctive character of the earlier marks must be considered. The more distinctive they are, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). 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).

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).”

32) GEORGE is a well-known forename in the UK. It has no descriptive or allusive qualities in relation to the earlier goods. Inherently, I find it to be possessed of a normal degree of distinctive character in relation to all of the goods in classes 14, 18 and 25.

33) Turning to the question of whether the distinctiveness of GEORGE has been enhanced through the use made of it, bearing in mind my earlier assessment of the evidence that has been put before me, I find that it had been enhanced to a high degree in relation to ‘clothing, footwear and headgear’ at the relevant date. The evidence shows significant sales of those goods in the UK in the years prior to that date, substantial sums on advertising, exposure in UK newspapers and publications and recognition of GEORGE as being one of the UK’s ‘biggest clothing brands’ by third parties. As to the opponent’s goods in classes 14 and 18, whilst the evidence shows that there has been use in relation to jewellery and certain goods in class 18, it falls short of satisfying me that the earlier mark has enhanced distinctiveness in relation to any of them.

Comparison of marks

34) 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.”

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

35) The marks to be compared are:

GEORGE v GEORGINE

Neither mark lends itself to deconstruction into separate elements. Their overall impressions are based solely upon the single word of which they are comprised.

36) Both marks clearly have the same five letters at the beginning. In the opponent’s mark, those letters are followed by the letter ‘E’ and, in the applicant’s mark, they are followed by the three letters ‘INE’. I agree with the opponent that there is a high degree of visual similarity between the marks.

37) Aurally, the opponent’s mark will be pronounced J-ORGE and the applicant’s mark as J-ORGE-EEN. I disagree with the opponent that this results in a high degree of aural similarity. Although the first syllable of the contested mark is identical to that in the earlier mark, the former also contains a second syllable which is entirely absent from the latter. In my view, this results in a medium degree of aural similarity overall.

38) The opponent’s mark is likely to be perceived as a well-known forename (most likely a male one). The applicant’s mark is also likely to be perceived as a forename (most likely a female one). Whilst the names may share a common origin, as submitted by the opponent⁷, the average consumer will nevertheless recognise that they are different names, referring to different individuals. I therefore do not agree

⁷ See the opponent’s submissions in lieu, paragraphs 23- 24

with the opponent that the marks are conceptually identical or at least highly similar. I find that the marks are conceptually different⁸.

Likelihood of confusion

39) I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

40) I have found the respective goods to be identical. That is a strong factor weighing in the opponent's favour and so too is the high degree of distinctiveness of the earlier mark consequent upon the use made of it for 'clothing, footwear and headgear' (the mark is of a normal degree of distinctiveness for the goods in classes 14 and 18). However, although there is a high degree of visual similarity and a medium degree of aural similarity between the marks, they are conceptually different. Taking all these factors together, I find that an average consumer paying a medium degree of attention, is unlikely to mistake one mark for the other, notwithstanding the potential for imperfect recollection; there is no likelihood of direct confusion. This is also not a case where I can see any reason why the average consumer, having realised that the marks are not the same, would nevertheless be likely to put the similarities between them down to the applicant's mark being another brand or sub brand of the opponent or of some linked undertaking. The circumstances of this case clearly do not fall within any of the categories identified by Mr Iain Purvis QC, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 and

⁸ In this connection, I note the decision of Daniel Alexander QC (as he then was) in BL O-040-20, (paragraph 49) in an appeal against an earlier decision of mine (in BL O-344/19). Whilst the marks at issue in that case were not the same as here, it seems to me that the same reasoning is applicable in the instant case.

nor can I see any other reason, falling outside of those categories, why there would be a likelihood of indirect confusion. **The opposition under section 5(2)(b) of the Act fails.**

Section 5(3)

41) Section 5(3) of the Act provides:

“(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.”

Reputation

42) Bearing in mind my earlier assessment of the evidence before me, I am satisfied that GEORGE had a qualifying reputation at the relevant date for ‘clothing, footwear and headgear’, as per Case C-375/97, *General Motors* [1999] ETMR 950.

Link

43) Whether the public will make the required mental ‘link’ between the applicant’s mark and GEORGE must take account of all relevant factors. The relevant factors identified in Case C-252/07, *Intel* [2009] ETMR 13 are:

i) *The degree of similarity between the conflicting marks*

I have already assessed this under section 5(2)(b). The respective marks are visually similar to a high degree, aurally similar to a medium degree and conceptually different.

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

The term 'all being high-end luxury goods' in the applicant's specification has no bearing on my assessment of who the relevant public is or the similarity between the respective goods.

The relevant public is the general public

The opponent's 'clothing, footwear and headgear' are identical to the contested goods in class 25.

As regards the similarity between the contested goods in class 14 and the opponent's 'clothing, footwear and headgear', I find that they are not similar. Their respective nature, intended purpose and methods of use differ and they are not in competition nor complementary in the sense described in the case law.⁹

Turning to the contested goods in class 18, I remind myself that these are 'luggage, bags, wallets and other carriers'. As regards the 'bags, wallets and other carriers', I find that there is at least a low degree of similarity between those goods and the opponent's 'clothing'. This is because the respective goods may be sold in the same outlets and may be combined to 'contribute to the external image ('look')' of the consumer and thus have a close connection between them.¹⁰ (In reaching this conclusion, I have borne in mind that the term 'bags' and 'other carriers' would include handbags and the like). However, it is not obvious to me that there is any similarity between the opponent's

⁹ See, for example, T-116/06, T-363/08 and T-435/17

¹⁰ See, for example, T-569/11 [42-46]

'clothing, footwear and headgear' and the applicant's 'luggage'. The respective nature, methods of use and intended purpose are not the same and it is not obvious to me that there is any close connection between the goods in the sense that they may be used to contribute to an external 'look' or that the trade channels are likely to overlap to any significant extent. I find no similarity between 'luggage' and 'clothing, footwear and headgear'.

iii) The strength of the earlier mark's reputation

I find that GEORGE had a strong reputation at the relevant date in relation to 'clothing, footwear and headgear'.

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

GEORGE has a normal degree of inherent distinctiveness for the relevant goods which had, by the relevant date, been enhanced to a high level.

v) Whether there is a likelihood of confusion

There is no likelihood of confusion.

44) I will first consider the likelihood of a link being made between the identical goods at issue in class 25. As well as the identity between the goods, there are a number of other factors weighing in the opponent's favour, namely, the strong reputation and high degree of enhanced distinctiveness of the earlier mark and the high degree of visual similarity between the marks. There is also a medium degree of aural similarity between the marks. However, weighing against those factors is the conceptual difference between the marks. Taking all of those factors into account, I come to the conclusion that the earlier mark will not be brought to mind when the relevant public encounters the contested mark. Further, even if I am wrong, and those factors would lead to a link, I consider that any such link would be so

weak/fleeting as to be incapable of giving rise to any of the heads of damage. The likelihood of a link being made in respect of the contested goods in classes 14 and 18 is even less likely, given the lesser degree of closeness/dissimilarity between the respective goods. **The opposition under section 5(3) of the Act fails.**

Section 5(4)(a)

45) Section 5(4)(a) states:

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

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) [.....]

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

46) In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

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

56. In relation to deception, the court must assess whether “a substantial number” of the Claimants’ customers or potential customers are deceived, but

it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

47) The opponent relies upon the use of the sign GEORGE under this ground, which is identical to that which I have already considered under section 5(2)(b) of the Act. I recognise that the test for misrepresentation is different to that for likelihood of confusion because misrepresentation requires “*a substantial number of members of the public are deceived*” rather than considering whether the “*average consumer is confused*”. However, as recognised by Lewinson L.J. in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, it is doubtful whether the difference between the legal tests will produce different outcomes. I believe that to be the case here. I accept that the opponent had the requisite goodwill in the UK at the relevant date in relation to a business selling clothing, footwear, headgear, jewellery and certain bags and purses and that GEORGE was distinctive of that goodwill. However, I find it unlikely that a substantial number of the opponent’s customers will be misled into purchasing any of the applicant’s goods in the belief that they are those of the opponent, for essentially the same reasons that I set out when considering the likelihood of confusion under section 5(2)(b). **The opposition under section 5(4)(a) of the Act fails.**

Final remarks

48) I have not overlooked the fact that the opponent has claimed that its evidence shows use for a ‘wide range of retail services’ in relation to its GEORGE mark. For the avoidance of doubt, I add here that, even if I had found that GEORGE had: i) been put to genuine use in relation to any of the retail services relied upon, ii) a high degree of enhanced distinctiveness and a strong reputation in relation to any of the same and iii) the requisite goodwill under the sign GEORGE for any of the same, the opponent would not have been in any better position under any of the pleaded grounds. This is because, as the opponent has not succeeded under any of the grounds for identical goods, it logically follows that it could not have been any better off in relation to any of the retail services relied upon or, indeed, any of the other goods relied upon, given

that those services/goods could, at best, be no more than similar (rather than identical) to the contested goods.

OVERALL OUTCOME

49) The opposition fails on all grounds.

COSTS

50) As the applicant has been successful, it is entitled to an award of costs. Using the guidance in Tribunal Practice Notice 2/2016, and keeping in mind that the applicant has filed nothing beyond the counterstatement, I award the applicant costs on the following basis:

Preparing a statement and considering the other side's statements	£300
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51) I order Walmart Apollo, LLC to pay Georgine Ratelband the sum of **£300**. 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 11th day of April 2023

**Beverley Hedley
For the Registrar,
the Comptroller-General**