

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION

No. 2530115

BY ASOS PLC

TO REGISTER THE TRADE MARK

ASOS

IN CLASSES 3, 8, 9, 11, 14, 18, 21, 25, 26, 35 & 36

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER Nos. 100351 BY

ANSON'S HERRENHAUS KG

BACKGROUND

1) On 28 October 2009 ASOS Plc (hereinafter the applicant), applied to register the trade mark ASOS in respect of the following goods and services:

Class 3: Soaps; cosmetics; perfumery; essential oils; eau de parfum; eau de toilette; cologne; fragrances and fragrance products for personal use; massage oils; hair lotions; cosmetics; cosmetic preparations for skin care; skin care cosmetics; skin care preparations; astringents for cosmetic purposes; preparations for the bath and shower; shower gel; bath gels; scented body lotions and creams; scented moisturizing skin cream; moisturisers; body lotions and creams; moisturising creams; scented skin soap; body oil; face, lip and cheek make-up; face powder; face glitter; lipstick, lip gloss, non-medicated lip balm, lip pencils; perfumed shimmer sticks; eye shadow, eye pencils, mascara, eye make-up, eyeliners, eye creams, eye gels, eye balms; highlighter; masks; cleansers; toners; clarifiers; exfoliators; foundation make-up; blusher; compacts; make-up remover; fragrance sachets; room fragrances; beauty care preparations; beauty care products; beauty creams; beauty tonics for application to the body; beauty tonics for application to the face; non-medicated beauty preparations; non-medicated skin care beauty products; skin care products for personal use, namely, face, eye and lip moisturisers; face and skin creams; lotions and serums; anti-aging treatments; foundation for the face; hair care products, shampoo, hair conditioners, hair mousses, hair moulding creams, hair gel and hair spray; nail care preparations, nail polish, nail strengtheners, and nail polish remover; shaving cream, shaving gel, after-shave preparations, after-shave lotion; depilatory preparations; personal deodorant; antiperspirants; potpourri; nail care preparations; nail varnish and remover thereof; sun tanning preparations; cosmetic preparations for skin tanning; artificial tanning preparations.

Class 8: Manicure sets; hand operated tools for hairdressing and cases for the same; hair clippers for personal use (electric and non-electric); non electric hair curling implements; scissors; non-electric hair styling implements; non-electric hair tongs; non-electric hair waving apparatus; hair removing tweezers; hair removing devices; hair cutting apparatus and instruments; electrical hair care products (hand implements); hand tools and implements for hair; hand tools and implements for curling, cutting, crimping, straightening, styling, trimming or waving hair; hairdressing appliances included in class 8, all for personal use; braiders; electric apparatus for hair cutting and trimming; hair styling apparatus; parts, fittings and accessories all for the aforesaid goods.

Class 9: Sunglasses; spectacles; eyewear; spectacle cases, chains and eyeglass frames; eyeshades, lenses; electrical appliances for styling the hair; electric hair curling irons; electric hair straightening irons; electric apparatus for hair crimping, straightening, styling.

Class 11: Apparatus for drying hair; apparatus for heating hair; hairdryers and cases for the same; parts, fittings and accessories all for the aforesaid goods.

Class 14: Precious metals and their alloys and goods in precious metals or coated therewith; precious and semi-precious stones; jewellery; fashion jewellery; amulets; bracelets; brooches and lapel pins; chains; charms; cuff links; earrings; rings; tie clips and pins; horological and chronometric instruments; wrist watches; clocks; boxes, cases and containers of precious metals; hat and shoe ornaments of precious metals; figurines and statuettes of precious metals; badges of precious metal; objects of imitation gold.

Class 18: Articles of leather and imitations of leather; trunks and travelling bags; travel cases; luggage; suitcases; holdalls; portmanteaux; valises; bags; handbags; shoulder bags; toilet bags; carrier bags; rucksacks; backpacks; bumbags; casual bags; briefcases; attaché cases; music cases; satchels; beauty cases; carriers for suits, for shirts and for dresses; tie cases; credit card cases and holders; wallets; purses; umbrellas; parasols; walking sticks; shooting sticks; belts; parts and fittings for all the aforesaid goods.

Class 21: Brushes; combs; comb cases; electric combs; large-toothed combs for the hair; hairbrushes; fitted cosmetic bags; parts, fittings and accessories for all the aforesaid goods.

Class 25: Articles of clothing; footwear; boots, shoes, slippers, sandals, trainers, socks and hosiery; headgear; hats; caps; berets; scarves; gloves; mittens; belts (being articles of clothing); shirts, blouses, casual shirts, T-shirts, vests, camisoles, bodysuits, polo shirts, sports shirts, football and rugby shirts; trousers, jeans, shorts, sports shorts, swimwear; underwear; lingerie; tracksuits; articles of outerwear, coats, jackets, ski jackets, casual jackets, waterproof and weatherproof jackets and coats, parkas, body warmers, ski wear; suits; dresses; skirts; culottes; jumpsuits, playsuits; sweatshirts; jumpers, shrugs and cardigans; knitwear; leggings; neckties; pyjamas; waistcoats; headbands and wristbands; legwarmers; menswear; womenswear; childrenswear.

Class 26: Articles for the hair; badges; barrettes; bows for the hair; braids; false hair; hair bands; hair clips; hair fasteners; hair grips; hair slides; hair nets; hair ornaments; hair pins; plaited hair; tresses of hair; hair ribbons; ponytail holders; ribbons.

Class 35: The bringing together for the benefit of others, of a variety of perfumery, toiletries and cosmetics, bathing and personal cleansing and care products, candles, pharmacy goods, hardware and metal goods, cutlery, optical goods and sunglasses, lighting equipment and fixtures, jewellery, watches, horological and chronometric goods, musical instruments, furniture, furnishings and decorations, kitchenware, domestic utensils, crystal, glassware, porcelain and chinaware, brassware, ornaments, hair accessories, hampers, piece goods, sewing accessories, bags made from canvas, straw, plastic and PVC, bed and table linen, towels, bags, leather and travel goods, luggage, clothing and accessories, footwear, headgear, carpets and rugs, artwork, toys (including novelty toys), games, playthings and sporting goods, fitness equipment, equestrienne goods, decorations, food and confectionery, non-alcoholic and alcoholic

beverages, pets, enabling customers to conveniently view and purchase those goods from an Internet web site or by means of telecommunications or by means of a global network or by mail order catalogue or from a retail store.

Class 36: Arranging and providing credit, debit and charge card services; provision and arranging of payment protection insurance; arranging and providing hire purchase agreements; management of customer accounts and mail order accounts.

2) The application was examined and accepted, and subsequently published for opposition purposes on 1 January 2010 in Trade Marks Journal No.6817.

3) On 1 April 2010 Anson's Herrenhaus KG (hereinafter the opponent) filed a notice of opposition. The ground of opposition is in summary:

a) The opponent is the proprietor of the following trade marks:

Mark	Number	Filing date/ registration date	Class	Specification
Anson's	CTM 3292117	29.07.03 / 07.12.04	35	Retail trade services.
Anson's	CTM 1001999	30.11.98 / 16.03.01	3	Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.
			14	Precious metals and their alloys and goods in precious metals or coated therewith (included in class 14); jewellery, precious stones; horological and chronometric instruments.
			16	Paper, cardboard and goods made from these materials, included in class 16; 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, included in class 16; playing cards; printers' type; printing blocks.
			18	Leather and imitations of leather, and goods made of these materials, included in class 18; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.
			25	Clothing, footwear, headgear.
			35	Advertising; business management, business administration; office functions.
ANSON'S	CTM 303511	25.06.96 / 14.05.98	25	Clothing.

b) The opponent states that its marks above are earlier marks and that the goods and services and the trade marks are identical and/or similar to the mark applied for and its specification. As a result it contends that the mark in suit offends against Section 5(2)(b) of the Act.

4) On 1 March 2010 the applicant filed a counterstatement which whilst accepting that some of the goods were identical or similar, basically denied the opponent's claims.

5) Both parties filed evidence, and both seek an award of costs in their favour. The matter came to be heard on 6 September 2011. At the hearing, the applicant was represented by Ms Reid of Counsel instructed by Messrs Dechert LLP; the opponent was represented by Mr Brownlow of Bird & Bird LLP.

OPPONENT'S EVIDENCE

6) The opponent filed a witness statement, dated 3 June 2011, by Peter Robert Brownlow their Trade Mark Attorney. He provided exhibits and other evidence regarding the pronunciation of the applicant's mark. I shall refer to this information in my decision.

APPLICANT'S EVIDENCE

7) The applicant filed two witness statements. The first, dated 22 July 2011, is by Fergus Collins the Head of Legal in the applicant company. He provides considerable evidence which shows that the applicant has traded as ASOS since October 2002 and he contended that it enjoys a very significant reputation in the UK as a result of turnover and promotional activities.

8) The second witness statement, dated 20 July 2011, is by Paul Anthony Kavanagh the applicant's Trade Mark Attorney. He provides, at exhibit PK1 the results of a search using Google on 7 June 2010 for both "Anson" and "Anson's". There are 345,000 results for the former and 19,700 for the latter. At exhibit PK2 he provides copies of two earlier decisions by the UKIPO, cases O-276-08 and O-101-09. In both cases Anson's Herrenhaus KG (the opponent in the instant case) contended that its mark "Anson's" would be seen by the average consumer as a surname.

9) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

10) There is only one ground of opposition under Section 5(2)(b) which reads:

"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."

11) An “earlier trade mark” is defined in section 6, the relevant part of which states:

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

- (a) a registered trade mark, international trade mark (UK) or Community trade mark 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.”

12) In these proceedings the opponent is relying upon three earlier mark which have registration dates of 14 May 1998, 16 March 2001 and 7 December 2004. All are clearly earlier trade marks, and as they had been registered for five years at the point which the application was published they are subject to The Trade Marks (Proof of Use, etc) Regulations 2004. However, despite the opponent not filing evidence of use of its trade marks the applicant waived winning on a technicality in order to obtain a substantive decision.

13) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). In the recent case of *La Chemise Lacoste SA v Baker Street Clothing Ltd* [ALLIGATOR O/333/10) Mr Hobbs QC acting as the Appointed Person set out the test shown below which was endorsed by Arnold J. in *Och-Ziff Management Europe Ltd and Oz Management Lp v Och Capital LLP; Union Investment Management Ltd & Ochocki*, [2010] EWCH 2599 (Ch).

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

(e) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 in that mark;

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

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

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

(i) 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;

(j) if the association between the marks causes the public to wrongly believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

14) In essence the test under section 5(2)(b) is whether there are similarities in marks and goods and services which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgments mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods and services, the category of goods and services in question and how they are marketed. Furthermore, I must compare the applicant's mark and the marks relied upon by the opponent on the basis of their inherent characteristics assuming normal and fair use of the marks on the goods and services in their specifications.

15) The opponent has not provided any evidence regarding use of its marks and therefore the opponent's marks cannot benefit from an enhanced reputation. Despite the fact that the opponent's marks are clearly a surname I am going to regard them for

the purposes of this decision as being inherently highly distinctive for all the goods and services for which they are registered. The average consumer for the goods and services of the two parties was agreed at the hearing to be the general public.

16) I will first consider the marks of the two parties. I note that all two of the opponent's marks, CTM 3292117 and CTM 1001999 are identical whilst CTM 303511 only differs in that it is all in upper case instead of title case. The three marks must therefore be regarded as identical and so for this comparison I shall refer to them as a single mark. For ease of reference these are reproduced below:

Applicant's mark	Opponent's marks
ASOS	ANSON'S

17) The opponent contends:

“15, Furthermore, aural similarity is particularly significant for marks which are primarily used orally, such as in the fashion industry where word of mouth recommendation is relied upon heavily. When the two marks are heard separately, the overall impression of the two marks is essentially the same. As such, the simultaneous use of two such similar marks in relation to the goods in question is more likely than not to result in confusion between them by virtue of imperfect recollection and word of mouth recommendation.”

18) I note that the specification applied for by the applicant encompasses cosmetics in Class 3, electrical goods in Class 9 as well as clothing in Class 25. Similarly, the opponent's marks include bleaching and laundry substances in Class 3, office requisites in Class 16, clothing in Class 25 and business administration in Class 35. It is not clear to me why such substance should be placed upon the fashion industry. However, even if the fashion industry is the segment that both party's goods fit into I do not accept the contention that such reliance be placed upon aural confusion. Items of clothing can vary enormously in price and so the level of attention paid by the consumer will vary. However, given that clothing needs to fit, and that fabrics are increasingly a consideration in the purchasing decision, it is likely that a reasonable level of attention will be paid by the average consumer. I take into account the judgment of the Court of First Instance in case T-117/03 *New Look* the court said:

“49. However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the

signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.

50. The applicant has not mentioned any particular conditions under which the goods are marketed. Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

19) The opponent contends “the opposed mark is reproduced in its entirety in the earlier trade mark”. Whilst I accept that all four letters of the instant mark are included in the opponent’s mark they are interspersed by two letter “N’s”, which to my mind makes a considerable visual difference. In my opinion, the average consumer does not look at a trade mark and see if it can rearrange the letters to make other trade marks. Visually there are significant differences between the marks, not least in their length. The mark in suit is a very short mark of only four letters, whereas the opponent’s mark has six letters and an apostrophe. It is accepted that such differences in short marks are significant. Whilst they share the initial letter “A”, and both have the letters “so” within them, albeit not in exactly the same place, that is the extent of their visual similarity. Overall the visual differences far outweigh the minor similarity.

20) The opponent puts great store in the pronunciation of the two marks. It adduced evidence which it states shows that the mark can be pronounced as “ay-sos” or “ass-os”. The opponent contends that the latter increases the chance of confusion with the earlier mark. I am willing to accept that both pronunciations will be used. The opponent contends that both marks have the same vowel structure “A-s-O-s” and “A-n-s-O-n-s”. To my mind whichever of the pronunciations one uses for the instant mark there is a considerable difference between the instant mark and the earlier mark.

21) Conceptually, the opponent’s mark will be seen as a surname. It is quite a common name in the UK as demonstrated in the evidence. Moving onto the applicant’s mark unless educated into its meaning the mark in suit is simply a meaningless word. It is not obviously an acronym as the letters are not interspersed by full stops. Taken overall I consider that the differences in the marks far outweigh any slight similarity. I do not take into account the fact that the opponent has, in an earlier case before the Registry, accepted that its mark will be seen as a surname.

22) I now turn to the goods and services of the parties’ marks. Mr Brownlow contended that his client’s specification in Classes 3, 14, 18, 25 & 35 were Class Heading and so covered all the goods and services within those classes. I was referred to the IP Translator case where Mr Hobbs acting as the Appointed Person referred this issue to the CJEU. In the instant case I do not believe that the issue is crucial. To my mind the

goods in Classes 14, 18 & 25 are identical or very similar simply on the basis of the specification as set out for each registration. Also I believe that the Class 3 goods are also identical or very similar with the exception of “fragrance sachets; room fragrances; potpourri”. The Class 35 services are similar to the opponent’s goods in classes 3, 14 except for “candles, pharmacy goods, hardware and metal goods, cutlery, optical goods and sunglasses, lighting equipment and fixtures, musical instruments, furniture, furnishings and decorations, kitchenware, domestic utensils, crystal, glassware, porcelain and chinaware, brassware, ornaments, hair accessories, hampers, piece goods, sewing accessories, bags made from canvas, straw, plastic and PVC, bed and table linen, towels, carpets and rugs, artwork, toys (including novelty toys), games, playthings and sporting goods, fitness equipment, equestrienne goods, decorations, food and confectionery, non-alcoholic and alcoholic beverages, pets.” Ms Reid was in broad agreement with these views although she raised issues with part of my findings. However, I do not intend to detail them here, suffice to say that I do not accept them.

23) It is also my view that none of the goods and services applied for in Classes 8, 9, 11, 21, 26 or 36 are in any way similar to any of the goods and services for which the opponent’s marks are registered. Mr Brownlow, in addition to his class headings contention sought to persuade me that certain products such as electrical goods for what he referred to as hair beautification purposes were similar to hair lotions, shampoos etc in his client’s Class 3 specification. He contended that sunglasses were similar to clothing, and that charge cards are similar to retail services. I have not set out his contentions in detail merely giving the broad view, as I reject all of his arguments.

24) I must now take all the above into account and consider the matter globally taking into account the interdependency principle- a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods and vice versa. In this case a number of the goods and services are identical or very similar. However, the marks of the two parties are, overall, totally dissimilar. The very minor aspects which are similar are completely swamped by the differences. Even when used on goods which could be purchased with relatively little consideration, and taking into account the opponent’s mark is inherently highly distinctive, there is no likelihood of confusion, nor is there a likelihood of association with the earlier trade mark. The ground of opposition under Section 5(2)(b) therefore fails.

COSTS

25) The opponent has failed on the ground pleaded. As such the applicant is entitled to a contribution towards its costs. I have also factored in the costs associated with an earlier interlocutory hearing.

Preparing a statement and considering the other side’s statement	£200
Preparing evidence and considering and commenting on the other side’s evidence	£800
Preparing for and attending a hearing	£800
TOTAL	£1,800

26) I order the opponent to pay the applicant the sum of £1,800. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 3rd day of October 2011

**George W Salthouse
For the Registrar,
the Comptroller-General**