

O/474/12

IN THE MATTER OF APPLICATION NO 2526406
IN THE NAME OF WASABI FROG LIMITED

AND

OPPOSITION THERETO UNDER NO 100472 BY TONY VAN GULCK

IN THE MATTER OF application
No 2526406 in the name of
Wasabi Frog Ltd and opposition
thereto under No 100472 by
Tony Van Gulck

Background

1. Application no 2526406 has a filing date of 7 September 2009 and stands in the name of Wasabi Frog Limited (~~the applicant~~). It seeks registration of the trade mark MissBoo in respect of a range of goods and services in classes 3, 9, 14, 16, 18 and 35.

2. Following publication in the *Trade Marks Journal* on 5 February 2010, notice of opposition was filed by Tony Van Gulck (~~the opponent~~). The opposition is based on grounds brought under section 5(2)(b) of the Act. The opposition is directed at those goods and services in classes 18 and 35 only, details of which are given later in this decision.

3. In support of his claim, the opponent relies on the following Community Trade Mark (~~CTM~~), insofar as it is registered for the following goods:

Mark	Filing/registration date	Specification of goods
CTM 1592377 BOO!	4 April 2000/ 27 February 2002	Class 18: Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery; handbags. Class 25: Clothing, footwear, headgear.

4. The applicant filed a counterstatement in which it denied the ground of opposition. It also put the opponent to proof of the use of its mark.

5. Only the opponent filed evidence. The applicant filed written submissions. The matter came before me for a hearing on 20 September 2012. The applicant was represented by Mr Carl Steele of Ashfords LLP, the opponent by Mr Philip Stephenson of Bailey Walsh & Co LLP.

Decision

6. There is a single ground of opposition founded on section 5(2)(b) of the Act which states:

—52) 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.”

7. 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~~ “earlier trade mark” means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) 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,
- (b)
- (c)

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

8. The opponent relies on the CTM set out at paragraph 3 above. It is an earlier mark within the meaning of section 6(1) of the Act. In its counterstatement, the applicant requested that the opponent prove use of its mark. As the earlier mark relied upon by the opponent was registered more than five years prior to the date the application was published, the requirements of Section 6A of the Act are relevant to this earlier mark. Section 6A of the Act reads:

—6A(1) This section applies where-

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

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

the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(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-

within the period of five years ending with the date of publication of the application 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 differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, 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)

(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.

(7)....”

9. Also of relevance is section 100 of the Act which states:

–400. 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.”

10. The relevant period in which the opponent is required to prove use of its mark is 6 February 2005 to 5 February 2010. The guiding principles to be applied in determining whether there has been genuine use of a mark are set out in *Ansul BV v Ajax Brandbeveiliging BV* [2003] RPC 40 and *Laboratoire de la Mer Trade Mark* [2006] FSR 5. From these cases it is clear that:

-genuine use entails use that is not merely token. It must also be consistent with the essential function of a trade mark, that is to say to guarantee the identity of the origin of goods or services to consumers or end users (*Ansul*, paragraph 36);

- the use must be on the market’ and not just internal to the undertaking concerned (*Ansul*, paragraph 37);

- it must be with a view to creating or preserving an outlet for the goods or services (*Ansul*, paragraph 37);

- the use must relate to goods or services already marketed or about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns (*Ansul*, paragraph 37);
- all the facts and circumstances relevant to determining whether the commercial exploitation of the mark is real must be taken into account (*Ansul*, paragraph 38);
- the assessment must have regard to the nature of the goods or services, the characteristics of the market concerned and the scale and frequency of use (*Ansul*, paragraph 39);
- but the use need not be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39);
- an act of importation could constitute putting goods on the market (*Laboratoire de la Mer*, paragraph 25 referring to the earlier reasoned order of the ECJ);
- there is no requirement that the mark must have come to the attention of the end user or consumer (*Laboratoire de la Mer*, paragraphs 32 and 48);
- what matters are the objective circumstances of each case and not just what the proprietor planned to do (*Laboratoire de la Mer*, paragraph 34);
- the need to show that the use is sufficient to create or preserve a market share should not be construed as imposing a requirement that a significant market share has to be achieved (*Laboratoire de la Mer*, paragraph 44).

11. I must also keep in mind the guidance in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32, in relation to determining what constitutes a fair specification, namely:

—Ponfrey J in *Decon* suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view the task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use".

12. In *Animal Trade Mark* [2004] FSR 19, Jacob J held:

—The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pernicky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for three-holed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) -three-holed razor blades

imported from Venezuela” is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say “razor blades” or just “razors”. Thus the “fair description” is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection (“the umbra”) for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods (“the penumbra”). A lot depends on the nature of the goods—are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.”

13. Also of relevance are the comments of the Court of First Instance in *Reckitt Benckiser (España) SL v OHIM*, Case T-126/03 where it said:

—45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories to which the goods or services for which the trade mark has actually been used belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of ‘part of the goods or services’ cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.”

14. Finally, I take into account the comments of Mr Geoffrey Hobbs Q.C. sitting as the appointed person in *Gima (UK) Ltd v Euro Gida Sanayi Ve Ticaret Ltd* (O-345-10) where he said:

—However, that does not appear to me to alter the basic nature of the required approach. As to that, I adhere to the view that I have expressed in a number

of previous decisions. 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.”

The opponent’s evidence

15. The opponent has filed evidence in the form of two witness statements by Tony Van Gulck (dated 28 April 2011 and 1 September 2011). Mr Van Gulck states he is the CEO of Peak-A-Boo BVBA, Belgium. He states that either personally, or through his company, he has sold leather goods, and in particular handbags and footwear, under the mark BOO!, in Europe, since 1995. He goes on to state that as far as the UK is concerned, handbags have been sold since 1998-2000, —accessories” (not defined), since 2003 and shoes since 2003.

16. Mr Van Gulck gives turnover figures, in euros, for products sold under the trade mark BOO! in Europe and the UK as follows:

	2004	2005	2006	2007	2008	2009
Europe	1,199,756	1,489,960	1,156,704	1,407,465	2,136,964	2,646,436
UK	164,429	139,778	99,104	62,935	115,474	30,226

It is not clear whether the UK figures are also included within the European figures. None of the figures given are separated in terms of the different products sold.

17. At TVG2 Mr Van Gulck exhibits a number of invoices which, he states, relate to handbags sold under the mark in the UK, Belgium, the Netherlands, Luxembourg and Ireland.

18. There are seven invoices which date from within the relevant period. Though the printing is somewhat poor, it is possible to see that at the top left hand corner of each page the word BOO! Each lists the goods by code, description and colour (e.g. Tenayo (TEN1202-8178/01) –Yankee-Black (see page 24)) but otherwise they are silent as to the goods. Mr Van Gulck includes within the same exhibit several pages which he says are —~~ex~~cerpts of the website [which show] the names referred to on the invoices are names used for the different models of handbags, all bearing the trademark BOO!”. The website extracts referred to are all downloaded from the boo-fashion.com website and show the Spring/Summer 2011 range of handbags. The text is not easy to read as the extracts have been greatly reduced in size in the printing process. What I can see is that each of them shows a number of handbags and refers to the range under the names Nuevo, nuevostraw, pacco, Portofino, borabora and bocadero. Whilst the 2011 catalogue dates from after the relevant period, I do not know when each item within the range was introduced. Of the names mentioned only Nuevo appears on the invoices with the exhibit. The relevant invoices are:

- dated 28 January 2009 to an address in Liskeard for 10 Nuevo items
- dated 9 January 2008 to an address in Belgium for 21 Nuevo items

- dated 2 July 2009 to an address in the Netherlands for 156 Nuevo items
- dated 17 January 2008 to an address in the Netherlands for 4 Nuevo items
- dated 1 December 2009 to an address in Luxembourg for 15 Nuevo items

19. At TVG3, Mr Van Gulck exhibits a selection of invoices and —~~order~~ confirmations” to show sales of shoes under the trade mark Boo! in the UK in 2006. Each shows the word BOO! at the top left-hand corner and each is headed BOO! SHOES. The invoices are as follows:

- dated 23 March 2006 to an address in Dulwich for 23 pairs
- dated 12 September 2006 to an address in Dulwich for 48 pairs
- dated 24 February 2006 to an address in Sussex for 141 pairs
- dated 9 January 2006 to an address in Sussex for 204 pairs
- dated 16 October 2006 to an address in Sussex for 36 Pairs
- dated 19 April 2006 to an address in Sussex for 60 pairs

20. Mr Van Gulck states his company has exhibited a range of products, including —leather accessories”, shoes and handbags under the trade mark Boo! at the PURE trade fashion show and the MODA Accessories show both held in London. At TVG4 he exhibits copies of invoices relating to these events. Whilst some relate to events after the relevant period, there are a number which relate to charges made for the provision of space etc. at these shows in 2006, 2007, 2008 and 2009. Page 36 of the exhibit (duplicated at page 40) refers to an exhibition in April 2006 and describes the products being displayed as —~~handbags~~ and shoes at affordable prices” whilst at page 38 the description of the exhibits is given as —~~a~~ collection of fashion hanbags (sic) and leather footwear at affordable prices”.

21. At TVG5 Mr Van Gulck exhibits a number of invoices along with articles from various publications. He states these publications —~~have~~ an effect on UK-based fashion buyers and the relevant public when looking towards importing continental European fashion”. I am not entirely sure what he means by this. None is in English though some of these have handwritten on them what appears to be a translation of part of the text by person(s) unknown. Whilst some show handbags and the trade mark Boo!, many are undated or are dated (or downloaded) outside the relevant period. Only pages 6, 7 and 8 appear to be from within the relevant period. They are copies from Bagsmagazine of August 2009. The handwritten notation on page 6 indicates that it is a magazine —~~providing~~ business information for [the] leather trade.” I do not know where or how many copies of the magazine may have been circulated.

22. At TVG6, Mr Van Gulck exhibits his company’s sales catalogue for Summer 2007. Mr Van Gluck states that the catalogue was distributed to all retailers of Boo! shoes in the UK and, at TVG3A, he provides a list of these retailers. There are numerous retailers throughout England, Ireland, Scotland and Wales. The catalogue is a ten page document showing brief details of a number of styles of women’s shoes. The mark BOO! appears at the top of each page (albeit with each character made up of horizontal lines rather than being solid).

23. At TVG7, Mr Van Gluck exhibits a number of what he refers to as —~~polished~~ advertising and articles relating to [his business] and in particular shoes sold under the Boo! mark in Europe”. All appear to date from before the relevant period

(2002/2003) and seem to have been taken from the trade magazine SHOES. None are in English.

24. Other than a vague claim to have used the mark in respect of undefined “accessories” Mr Van Gulck makes no claim to have used, nor has he provided evidence to show use of, the mark on anything other than handbags and shoes. Some of the references to the mark BOO! show use in a form other than that for which the mark is registered. This takes the form of the letters made up of horizontal lines rather than solid letters.

25. The question of whether a mark used differs in elements which alter the distinctive character of the mark in the form in which it was registered was considered (albeit in relation to section 46(2) of the Act) in *Bud and Budweiser Budbrau* [2003] RPC 25, where Lord Walker stated:

—43. The first part of the necessary inquiry is, what are the points of difference between the mark as used and the mark as registered? Once those differences have been identified, the second part of the inquiry is, do they alter the distinctive character of the mark as registered?

44 ...

45... It is for the Registrar, through the hearing officer’s specialised experience and judgment, to analyse the “visual, aural and conceptual” qualities of a mark and make a “global appreciation” of its likely impact on the average consumer, who “normally perceives a mark as a whole and does not proceed to analyse its various details.”

26. The same issue has been considered by both the General Court and the CJEU. These cases have been reviewed by Richard Arnold Q.C. sitting as the Appointed Person, in *NIRVANA Trade Mark* (BL O/262/06) and *REMUS TRADE MARK* (BL O/061/08). He summarised his review in *NIRVANA*, and repeated it in *REMUS*, thus;

—33. The first question is what sign was presented as the trade mark on the goods and in the marketing material during the relevant period...

34. The second question is whether the sign differs from the registered trade mark in elements which do not alter the latter’s distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all...”

27. In *Orient Express*, BL O/299/08, Ms Carboni, sitting as the Appointed Person, commented positively on Mr Arnold’s summation as being fully consistent with the approach laid down in *Bud*. I, therefore, approach the issue by applying Mr Arnold’s process to the circumstances of the case before me.

28. The mark as registered is presented in plain block capitals. As indicated above, the evidence also shows it to have been used in a form in which each character is made up of thin, closely spaced, horizontal lines. The presentation of the characters in this form does not, in any way, mean the characters are seen as anything other than the letters BOO and an exclamation mark. In my view, those differences are likely to go unnoticed by the average consumer and I do not consider that the differences alter the distinctive character of the mark as registered and I take that use into account. In any event, use of the mark as registered is also shown.

29. Whilst the evidence is not in any way extensive, it includes invoices dating from 2006 for shoes and invoices dating from 2008/09 in relation to handbags all to addresses in the UK. There is documentation relating to exhibitions in London for shoes and handbags which took place within the relevant period and a shoe catalogue dating from 2007.

30. Taking the evidence as a whole, I consider it to be sufficient to show that genuine use of the mark has been made within the relevant period in relation to the sale of handbags and shoes. Handbags make up a clearly defined category of goods and one which it is not possible to separate into any meaningful sub-categories. Shoes are also a clearly defined category of goods, however, this is a category which can be separated into coherent sub-categories. One of those categories is shoes for women and it is these goods which are shown in the evidence. 'Handbags' and 'shoes for women' are terms which will be well understood and used by the average consumer for such goods and they are terms which I shall take into account in my consideration of the objection brought under section 5(2)(b) of the Act.

The objection under section 5(2)(b) of the Act

31. In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (CJEU) in *Sabel v Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R 77, *Marca Mode CV v Adidas AG* [2000] E.T.M.R.723, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di Laudato & C. Sas v OHIM* C-334/05 (Limoncello), as cited with approval in *Och-Ziff Management Europe Ltd and Oz Management LP v Och Capital LLP, Union Investment Management Ltd and Ochoki* [2010] EWCH 2599 (Ch). It is clear from these cases that:

- (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, in certain circumstances, be dominated by one or more of its components;
- (f) 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 of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks 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.

Comparison of goods and services

32. The opposition is directed against the application only insofar as it seeks registration for goods and services in classes 18 and 35. Taking this, and my finding as to the extent of use made of the earlier mark in account, the respective goods and services to be compared are as follows:

Opponent's goods following proof of use	Applicant's goods and services
Class 18: Handbags.	Class 18: Leather and imitation leather; bags; belts; cases; trunks and travelling bags; satchels; pouches; rucksacks; shopping bags; beach bags; handbags; briefcases; wallets; key cases; credit

	card cases; purses; umbrellas; parasols; walking sticks; back packs; hat boxes; animal skins.
Class 25: Shoes for women	<p>Class 35: Retail shop services relating to items of clothing; the bringing together, for the benefit of others a variety of goods, namely soaps, cosmetics, perfumery, essential oils, eau de parfum, eau de toilette, cologne, fragrances and fragrance products for personal use, massage oils, hair lotions, dentifrices, 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 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, sun tanning preparations, cosmetic preparations for skin tanning, artificial tanning preparations, jewellery and imitation jewellery, precious stones, goods of precious metal or coated therewith, watches and clocks, wrist watch bands, tie clips, cuff links, key rings of precious metal, watch straps, tie pins, catalogues, calendars, printed matter, pages downloaded from the internet, printed publications, magazines, pamphlets, stationery, posters, transfers, decalcomanias, diaries, pencil cases, pencils, pens, erasers, notebooks, paperweights, staplers, writing paper, envelopes, albums, binders, cardboard articles, packaging, files, fountain pens, hat boxes of cardboard, holders for cheque books, mats for beer glasses, coasters of paper, greeting cards, napkins of paper, newsletters, note books, packing paper, writing pads, passport holders, pictures,</p>

	<p>photographs, stands for pens and pencils, tissues of paper for removing make-up, artists materials, wrapping paper, bags of paper or plastic for packaging, boxes of paper or card or plastic for packaging, leather and imitation leather, bags, belts, cases, trunks and travelling bags, satchels, pouches, rucksacks, shopping bags, beach bags, handbags, briefcases, wallets, key cases, credit card cases, purses, umbrellas, parasols, walking sticks, back packs, hat boxes, animal skins, articles of clothing, lingerie, bras, pants, thongs, stockings, tights, suspender belts, camisoles, dressing gowns, negligees, corsets, night dresses, sleep shirts, sarongs, shoulder wraps, shorts, leggings, footwear, headgear, belts, trousers, shorts, jeans, wristbands, headbands, hats, gloves, jackets, coats, jumpers, shirts, t-shirts, sweaters, vests, trousers, skirts, waistcoats, waterproof clothing, bathing costumes, pyjamas, undergarments, scarves, socks, suits, dresses, blouses, sun visors, anoraks, articles of clothing for leisurewear, articles of clothing for casualwear, articles of clothing for sportswear, articles of outer clothing, articles of weatherproof clothing, blazers, denims, jerseys, knitwear, parkas, sweatshirts, tops, and windcheaters, enabling customers to conveniently view and purchase those goods by mail order or by means of telecommunications; the bringing together, for the benefit of others a variety of goods, namely soaps, cosmetics, perfumery, essential oils, eau de parfum, eau de toilette, cologne, fragrances and fragrance products for personal use, massage oils, hair lotions, dentifrices, 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 gel and hair spray, nail care</p>
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	<p>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, sun tanning preparations, cosmetic preparations for skin tanning, artificial tanning preparations, jewellery and imitation jewellery, precious stones, goods of precious metal or coated therewith, watches and clocks, wrist watch bands, tie clips, cuff links, key rings of precious metal, watch straps, tie pins, catalogues, calendars, printed matter, pages downloaded from the Internet, printed publications, magazines, pamphlets, stationery, posters, transfers, decalcomanias, diaries, pencil cases, pencils, pens, erasers, notebooks, paperweights, staplers, writing paper, envelopes, albums, binders, cardboard articles, packaging, files, fountain pens, hat boxes of cardboard, holders for cheque books, mats for beer glasses, coasters of paper, greeting cards, napkins of paper, newsletters, note books, packing paper, writing pads, passport holders, pictures, photographs, stands for pens and pencils, tissues of paper for removing make-up, artists materials, wrapping paper, bags of paper or plastic for packaging, boxes of paper or card or plastic for packaging, leather and imitation leather, bags, belts, cases, trunks and travelling bags, satchels, pouches, rucksacks, shopping bags, beach bags, handbags, briefcases, wallets, key cases, credit card cases, purses, umbrellas, parasols, walking sticks, back packs, hat boxes, animal skins, articles of clothing, lingerie, bras, pants, thongs, stockings, tights, suspender belts, camisoles, dressing gowns, negligees, corsets, night dresses, sleep shirts, sarongs, shoulder wraps, shorts, leggings, footwear, headgear, belts, trousers, shorts, jeans, wristbands, headbands, hats, gloves, jackets, coats, jumpers, shirts, t-shirts, sweaters, vests, trousers, skirts, waistcoats, waterproof clothing, bathing costumes, pyjamas, undergarments, scarves, socks, suits, dresses, blouses, sun visors, anoraks, articles of clothing for leisurewear, articles of clothing for casualwear, articles of clothing for sportswear, articles of outer clothing, articles of weatherproof clothing, blazers, denims, jerseys, knitwear, parkas, sweatshirts, tops, and windcheaters, enabling customers to conveniently view and purchase those goods; retail services connected with soaps, cosmetics, perfumery, essential oils, eau de parfum, eau de toilette, cologne, fragrances and fragrance products for personal use, massage oils, hair lotions, dentifrices, 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</p>
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	<p>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 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, sun tanning preparations, cosmetic preparations for skin tanning, artificial tanning preparations, jewellery, precious stones, goods of precious metal or coated therewith, watches and clocks, wrist watch bands, tie clips, cuff links, key rings of precious metal, watch straps, tie pins, catalogues, calendars, printed matter, pages downloaded from the internet, printed publications, magazines, pamphlets, stationery, posters, transfers, decalcomanias, diaries, pencil cases, pencils, pens, erasers, notebooks, paperweights, staplers, writing paper, envelopes, albums, binders, cardboard articles, packaging, files, fountain pens, hat boxes of cardboard, holders for cheque books, mats for beer glasses, coasters of paper, greeting cards, napkins of paper, newsletters, note books, packing paper, writing pads, passport holders, pictures, photographs, stands for pens and pencils, tissues of paper for removing make-up, artists materials, wrapping paper, bags of paper or plastic for packaging, boxes of paper or card or plastic for packaging, leather and imitation leather, bags, belts, cases, trunks and travelling bags, satchels, pouches, rucksacks, shopping bags, beach bags, handbags, briefcases, wallets, key cases, credit card cases, purses, umbrellas, parasols, walking sticks, back packs, hat boxes, animal skins, articles of clothing, lingerie, bras, pants, thongs, stockings, tights, suspender belts, camisoles, dressing gowns, negligees, corsets, night dresses, sleep shirts, sarongs, shoulder wraps, shorts, leggings, footwear, headgear, belts, trousers, shorts, jeans, wristbands, headbands,</p>
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	<p>hats, gloves, jackets, coats, jumpers, shirts, t-shirts, sweaters, vests, trousers, skirts, waistcoats, waterproof clothing, bathing costumes, pyjamas, undergarments, scarves, socks, suits, dresses, blouses, sun visors, anoraks, articles of clothing for leisurewear, articles of clothing for casualwear, articles of clothing for sportswear, articles of outer clothing, articles of weatherproof clothing, blazers, denims, jerseys, knitwear, parkas, sweatshirts, tops, and windcheaters; mail order retail services connected soaps, cosmetics, perfumery, essential oils, eau de parfum, eau de toilette, cologne, fragrances and fragrance products for personal use, massage oils, hair lotions, dentifrices, 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 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, sun tanning preparations, cosmetic preparations for skin tanning, artificial tanning preparations, with jewellery, precious stones, goods of precious metal or coated therewith, watches and clocks, wrist watch bands, tie clips, cuff links, key rings of precious metal, watch straps, tie pins, catalogues, calendars, printed matter, pages downloaded from the internet, printed publications, magazines, pamphlets, stationery, posters, transfers, decalcomanias, diaries, pencil cases, pencils, pens, erasers, notebooks, paperweights, staplers, writing paper, envelopes, albums, binders, cardboard articles, packaging, files, fountain pens, hat boxes of cardboard,</p>
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	<p>holders for cheque books, mats for beer glasses, coasters of paper, greeting cards, napkins of paper, newsletters, note books, packing paper, writing pads, passport holders, pictures, photographs, stands for pens and pencils, tissues of paper for removing make-up, artists materials, wrapping paper, bags of paper or plastic for packaging, boxes of paper or card or plastic for packaging, leather and imitation leather, bags, belts, cases, trunks and travelling bags, satchels, pouches, rucksacks, shopping bags, beach bags, handbags, briefcases, wallets, key cases, credit card cases, purses, umbrellas, parasols, walking sticks, back packs, hat boxes, animal skins, articles of clothing, lingerie, bras, pants, thongs, stockings, tights, suspender belts, camisoles, dressing gowns, negligees, corsets, night dresses, sleep shirts, sarongs, shoulder wraps, shorts, leggings, footwear, headgear, belts, trousers, shorts, jeans, wristbands, headbands, hats, gloves, jackets, coats, jumpers, shirts, t-shirts, sweaters, vests, trousers, skirts, waistcoats, waterproof clothing, bathing costumes, pyjamas, undergarments, scarves, socks, suits, dresses, blouses, sun visors, anoraks, articles of clothing for leisurewear, articles of clothing for casualwear, articles of clothing for sportswear, articles of outer clothing, articles of weatherproof clothing, blazers, denims, jerseys, knitwear, parkas, sweatshirts, tops, and windcheaters; electronic shopping retail services connected with soaps, cosmetics, perfumery, essential oils, eau de parfum, eau de toilette, cologne, fragrances and fragrance products for personal use, massage oils, hair lotions, dentifrices, 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</p>
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	<p>conditioners, 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, sun tanning preparations, cosmetic preparations for skin tanning, artificial tanning preparations, jewellery, precious stones, goods of precious metal or coated therewith, watches and clocks, wrist watch bands, tie clips, cuff links, key rings of precious metal, watch straps, tie pins, catalogues, calendars, printed matters, pages downloaded from the internet, printed publications, magazines, pamphlets, stationery, posters, transfers, decalcomanias, diaries, pencil cases, pencils, pens, erasers, notebooks, paperweights, staplers, writing paper, envelopes, albums, binders, cardboard articles, packaging, files, fountain pens, hat boxes of cardboard, holders for cheque books, mats for beer glasses, coasters of paper, greeting cards, napkins of paper, newsletters, note books, packing paper, writing pads, passport holders, pictures, photographs, stands for pens and pencils, tissues of paper for removing make-up, artists materials, wrapping paper, bags of paper or plastic for packaging, boxes of paper or card or plastic for packaging, leather and imitation leather, bags, belts, cases, trunks and travelling bags, satchels, pouches, rucksacks, shopping bags, beach bags, handbags, briefcases, wallets, key cases, credit card cases, purses, umbrellas, parasols, walking sticks, back packs, hat boxes, animal skins, articles of clothing, lingerie, bras, pants, thongs, stockings, tights, suspender belts, camisoles, dressing gowns, negligees, corsets, night dresses, sleep shirts, sarongs, shoulder wraps, shorts, leggings, footwear, headgear, belts, trousers, shorts, jeans, wristbands, headbands, hats, gloves, jackets, coats, jumpers, shirts, t-shirts, sweaters, vests, trousers, skirts, waistcoats, waterproof clothing, bathing costumes, pyjamas, undergarments, scarves, socks, suits, dresses, blouses, sun visors, anoraks, articles of clothing for leisurewear, articles of clothing for casualwear, articles of clothing for sportswear, articles of outer clothing, articles of weatherproof clothing, blazers, denims, jerseys, knitwear, parkas, sweatshirts, tops, and windcheaters.</p>
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The average consumer and the nature of the purchasing process

33. The goods of each party as appear in class 18 are goods which will be bought by the general public, albeit that handbags are, more usually, bought by women. Shoes for women as appear in class 25 will also, almost invariably, be bought by women. Each of the goods in classes 18 and 25 of the respective parties are such as would

be bought on a fairly irregular basis and, whilst the cost of each will vary from, perhaps a few pounds for a key case to a few hundred of pounds for a pair of bespoke shoes, all are items that are widely available whether on the High Street, via mail order or the Internet.

34. All of the goods will be bought with a reasonable degree of care to ensure they are suitable for their purpose and are of the desired colour, style, etc. particularly those such as shoes which will be worn on the person. Many of the goods may be bought to co-ordinate either with each other or with other items as part of a set or outfit. Each of the goods will be bought by visual inspection, whether from a store or a catalogue and thus the visual aspects of the mark are likely to be of primary importance though not to the extent that other aspects can be ignored.

35. Insofar as the applicant's retail services are concerned, they are each retail services for which the average consumer will be a member of the public who is likely to select the retail outlet concerned by primarily visual means having encountered the trade mark in, for example, signage on the high street, in magazines and on the Internet. As to the degree of care that is likely to be taken when selecting a retail outlet, once again this is likely to vary depending on the nature of the retail outlet and the goods which are being retailed. For example, the average consumer is likely, in my view, to be more attentive when selecting a retail outlet selling, for example, shoes than they would when selecting a retail outlet to purchase an inexpensive and disposable item such as a magazine. Considered in the context of the goods at issue and, much like the selection of the goods themselves, the average consumer will pay at least a reasonable level of attention to the selection of the services.

Comparison of goods and services

36. In *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 280 (‐TREAT‐), Jacob J said (at 289):

‐When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all, a trade mark specification is concerned with use in trade.‐

He went on (at 295) to set out the following factors as being relevant to the question of similarity of services without reference to the classes in which they may fall:

- (a) the respective uses of the respective services;
- (b) the respective users of the respective services;
- (c) the nature of the services;
- (d) the respective trade channels through which the services are marketed;
- (e) the extent to which the respective services are competitive. This inquiry may take into account how those in trade classify the services, for instance whether market research companies put them into the same or different sectors.

37. Subsequently, in *Canon Kabushiki Kaisha v MGM Inc* the CJEU stated:

—23In assessing the similarity of the goods or services concerned.....all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their end users and their method of use and whether they are in competition with each other or are complementary.”

38. In Case T-420/03 – *El Corte Inglés v OHIM- Abril Sanchez and Ricote Sauger* (Boomerang TV) the General Court commented:

—96...Goods or services which are complementary are those where 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 the production of those goods or provision of those services lies with the same undertaking (Case T14169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, and judgment of 15 March 2006 in Case T-31/04 *Eurodrive Services and Distribution v OHIM – Gomez Frias* (euroMASTER), not published in the ECR, paragraph 35).”

39. I also take into account Jacob J's comment in *Avnet* (supra) where he said:

—In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meaning attributable to the rather general phrase.”

40. Finally, in *Gérard Meric v OHIM*, Case T-133/05, the General Court said:

—29In 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).”

41. The opponent's goods in class 18 are handbags which is a term which also appears in the specification of the application. They are clearly identical goods. *Bags* as appears in the application, includes *handbags* as appears in the earlier mark and these are also identical goods.

42. Handbags came in all shapes and sizes and are used to carry a wide variety of things considered essential by its user. The term handbags includes not only bags

for carrying in the hand (e.g. a clutch bag) but also bags which will be carried over one's shoulder or held by a strap or handle of some sort (e.g. a tote or shoulder bag). All handbags are used to carry things within them and the larger the bag, the more diverse and numerous are the items that are likely to be carried in it. I consider *handbags* to be highly similar to *travelling bags*, *shopping bags* and *beach bags*. The nature, uses, users and trade channels all overlap. Whilst not strictly in competition with each other, the respective goods may also form part of a co-ordinated set and to that extent may be complementary goods.

43. To the extent that *cases*, *trunks*, *satchels*, *pouches*, *rucksacks*, *briefcases*, *wallets*, *key cases*, *credit card cases*, *purses* and *back packs* are each goods for holding something safely whilst the user moves from one place to another, they have similar uses to those of *handbags*. They may also have the same users as handbags. Handbags come in a wide variety of styles. As the evidence shows, some are designed to resemble e.g. satchels, a briefcase or small cases (see page 26 of exhibit TGV5) or a purse (page 31) or backpack (page 16). Each of the respective goods may also form part of a co-ordinated set and handbags will sometimes have e.g. a key case or purse attached to it (page 29). There is a reasonable degree of similarity between these goods and *handbags*.

44. It is well established that women often buy handbags and shoes to match or co-ordinate as part of an ensemble. There is a degree of complementarity, and thus similarity, between the opponent's *shoes* and *handbags* as appears in the application.

45. *Belts* as are proper to class 18 are not belts in the nature of e.g. an article for wearing to secure one's trousers (they are proper to class 25) but belts in the nature of e.g. a shoulder belt for a bag. As part of a bag, there is a degree of complementarity between the respective goods and thus I consider *handbags* to be similar, albeit to a low degree, to *belts*.

46. *Handbags* and *shoes for women* are finished articles used by individuals to carry things whereas *leather and imitation leather* are raw materials used by those involved in manufacturing to produce other goods. They are dissimilar goods. *Umbrellas*, *parasols*, *walking sticks*, *hat boxes* and *animal skins* are also dissimilar goods to *handbags* and *shoes for women*. Self evidently, the respective goods have different natures and purposes, the trade channels also differ and neither are they in competition or complementary.

47. The application seeks registration of a number of services in class 35. Whilst the specification as set out above, is extremely lengthy it breaks down to the following:

- Retail shop services relating to items of clothing;
- The bringing together, for the benefit of others a variety of [named] goods enabling customers to conveniently view and purchase those goods by mail order or by means of telecommunications;
- The bringing together, for the benefit of others, a variety of [named] goods enabling customers to conveniently view and purchase those goods;

- Retail services connected with [named] goods;
- Mail order retail services connected with [named] goods;
- Electronic shopping retail services connected with [named] goods.

48. I note the comments of the General Court in *Oakley, Inc v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-116/06. In that case the conflict was between an earlier mark which was registered for goods in classes 18 and 25 and a later mark which had been registered for —Retail and wholesale services, including on-line retail store services; retail and wholesale of eyewear, sunglasses, optical goods and accessories, clothing, headwear, footwear, watches, timepieces, jewellery, decals, posters, athletic bags, backpacks and knapsacks and wallets”. The GC upheld OHIM’s decision that the goods in classes 18 and 25 were similar to the services as there was a complementary relationship between the retailing of the goods and the goods themselves. The Court said:

—54Clearly, in the present case, the relationship between the retail services and the goods covered by the earlier trade mark is close in the sense that the goods are indispensable to or at the very least, important for the provision of those services, which are specifically provided when those goods are sold. As the Court held in paragraph 34 of *Praktiker Bau-und Heimwerkermärkte*, paragraph 17 above, the objective of retail trade is the sale of goods to consumers, the Court having also pointed out that that trade includes, in addition to the legal sales transaction, all activity carried out by the trader for the purpose of encouraging the conclusion of such a transaction. Such services, which are provided with the aim of selling certain specific goods, would make no sense without the goods.”

49. With the above in mind, and taking into account my comments earlier on the similarity of the respective goods, I consider the following of the applicant’s services to be similar to the opponent’s *handbags* and *shoes for women*:

Retail shop services relating to items of clothing;

The bringing together, for the benefit of others, a variety of goods, namely bags, belts, cases, trunks and travelling bags, satchels, pouches, rucksacks, shopping bags, beach bags, handbags, briefcases, wallets, key cases, credit card cases, purses, back packs; articles of clothing, lingerie, bras, pants, thongs, stockings, tights, suspender belts, camisoles, dressing gowns, negligees, corsets, night dresses, sleep shirts, sarongs, shoulder wraps, shorts, leggings, footwear, headgear, belts, trousers, shorts, jeans, wristbands, headbands, hats, gloves, jackets, coats, jumpers, shirts, t-shirts, sweaters, vests, trousers, skirts, waistcoats, waterproof clothing, bathing costumes, pyjamas, undergarments, scarves, socks, suits, dresses, blouses, sun visors, anoraks, articles of clothing for leisurewear, articles of clothing for casualwear, articles of clothing for sportswear, articles of outer clothing, articles of weatherproof clothing, blazers, denims, jerseys, knitwear, parkas,

sweatshirts, tops, and windcheaters, enabling customers to conveniently view and purchase those goods by mail order or by means of telecommunications;

the bringing together, for the benefit of others a variety of goods, namely bags, belts, cases, trunks and travelling bags, satchels, pouches, rucksacks, shopping bags, beach bags, handbags, briefcases, wallets, key cases, credit card cases, purses, back packs, articles of clothing, lingerie, bras, pants, thongs, stockings, tights, suspender belts, camisoles, dressing gowns, negligees, corsets, night dresses, sleep shirts, sarongs, shoulder wraps, shorts, leggings, footwear, headgear, belts, trousers, shorts, jeans, wristbands, headbands, hats, gloves, jackets, coats, jumpers, shirts, t-shirts, sweaters, vests, trousers, skirts, waistcoats, waterproof clothing, bathing costumes, pyjamas, undergarments, scarves, socks, suits, dresses, blouses, sun visors, anoraks, articles of clothing for leisurewear, articles of clothing for casualwear, articles of clothing for sportswear, articles of outer clothing, articles of weatherproof clothing, blazers, denims, jerseys, knitwear, parkas, sweatshirts, tops, and windcheaters, enabling customers to conveniently view and purchase those goods;

retail services connected with bags, belts, cases, trunks and travelling bags, satchels, pouches, rucksacks, shopping bags, beach bags, handbags, briefcases, wallets, key cases, credit card cases, purses, back packs, articles of clothing, lingerie, bras, pants, thongs, stockings, tights, suspender belts, camisoles, dressing gowns, negligees, corsets, night dresses, sleep shirts, sarongs, shoulder wraps, shorts, leggings, footwear, headgear, belts, trousers, shorts, jeans, wristbands, headbands, hats, gloves, jackets, coats, jumpers, shirts, t-shirts, sweaters, vests, trousers, skirts, waistcoats, waterproof clothing, bathing costumes, pyjamas, undergarments, scarves, socks, suits, dresses, blouses, sun visors, anoraks, articles of clothing for leisurewear, articles of clothing for casualwear, articles of clothing for sportswear, articles of outer clothing, articles of weatherproof clothing, blazers, denims, jerseys, knitwear, parkas, sweatshirts, tops, and windcheaters;

mail order retail services connected with bags, belts, cases, trunks and travelling bags, satchels, pouches, rucksacks, shopping bags, beach bags, handbags, briefcases, wallets, key cases, credit card cases, purses, back packs, articles of clothing, lingerie, bras, pants, thongs, stockings, tights, suspender belts, camisoles, dressing gowns, negligees, corsets, night dresses, sleep shirts, sarongs, shoulder wraps, shorts, leggings, footwear, headgear, belts, trousers, shorts, jeans, wristbands, headbands, hats, gloves, jackets, coats, jumpers, shirts, t-shirts, sweaters, vests, trousers, skirts, waistcoats, waterproof clothing, bathing costumes, pyjamas, undergarments, scarves, socks, suits, dresses, blouses, sun visors, anoraks, articles of clothing for leisurewear, articles of clothing for casualwear, articles of clothing for sportswear, articles of outer clothing, articles of weatherproof clothing, blazers, denims, jerseys, knitwear, parkas, sweatshirts, tops, and windcheaters;

electronic shopping retail services connected with bags, belts, cases, trunks and travelling bags, satchels, pouches, rucksacks, shopping bags, beach bags, handbags, briefcases, wallets, key cases, credit card cases, purses, back packs, articles of clothing, lingerie, bras, pants, thongs, stockings, tights, suspender belts, camisoles, dressing gowns, negligees, corsets, night dresses, sleep shirts, sarongs, shoulder wraps, shorts, leggings, footwear, headgear, belts, trousers, shorts, jeans, wristbands, headbands, hats, gloves, jackets, coats, jumpers, shirts, t-shirts, sweaters, vests, trousers, skirts, waistcoats, waterproof clothing, bathing costumes, pyjamas, undergarments, scarves, socks, suits, dresses, blouses, sun visors, anoraks, articles of clothing for leisurewear, articles of clothing for casualwear, articles of clothing for sportswear, articles of outer clothing, articles of weatherproof clothing, blazers, denims, jerseys, knitwear, parkas, sweatshirts, tops, and windcheaters.

50. I consider the remainder of the applicant's services to be dissimilar to the opponent's goods. There is not a close connection between them as per *Oakley* and their uses, nature and trade channels differ.

Comparison of the respective marks

51. The average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as wholes and does not pause to analyse their various details. In addition, he/she rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he/she has kept in his/her mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant components of the respective trade marks and, with that conclusion in mind, I must then go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

52. For ease of reference, the marks to be compared are as follows:

Earlier mark	Application
BOO!	MissBoo

The earlier mark consists of the word BOO presented in plain block capitals followed by an exclamation mark. To the extent that the exclamation mark will be noticed, the two elements hang together as its use is indicative of the fact that the word BOO is an interjection used in syntactic isolation to express surprise. The distinctiveness of the mark lies in its whole. The mark applied for is presented as a single word, however, it naturally breaks down into two component words Miss and Boo, more especially so given that the initial letters of each component part are presented in upper case with the remaining letters being in lower case. The word Miss is commonly used to refer to a female and is not distinctive of goods and services for women. The word Boo is a distinctive element of the mark.

53. From both the visual and aural perspectives, as both marks contain the word Boo there is a degree of similarity between them. There are also differences given that the mark applied for begins with the word Miss which is absent from the earlier

mark. Whilst the exclamation mark will not be articulated of itself, it may lead some to place a vocal stress on the word BOO which will not be given to the mark applied for. From both perspectives the respective marks are similar to a fairly high degree.

54. As I set out above, the earlier mark will be seen as an interjection of surprise whereas the mark applied for might be seen as the name of a female called Boo in which case there would be no conceptual similarity between the respective marks. MissBoo could, however, also be seen as referring to Boo goods designed or intended for women in which case there would be a high degree of conceptual similarity between them.

Distinctiveness of the earlier mark

55. The distinctive character of a trade mark can be appraised only, first, by reference to the goods and services in respect of which it has been registered and, secondly, by reference to the way it is perceived by the relevant public (see *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods and services for which it has been registered as coming from a particular undertaking and thus to distinguish those goods and services from those of other undertakings (see *Windsurfing Chiemsee v Huber and Attenburger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585).

56. I set out above the evidence of use filed of the earlier mark. Whilst the evidence is not extensive and suffers from a number of flaws, I found it to be sufficient to prove use of the mark on a limited range of goods. The evidence does not, however, enable me to find that the distinctiveness of the mark has been enhanced, to any material extent, through its use. That said, the earlier mark has a relatively high degree of inherent distinctiveness.

Likelihood of confusion

57. In determining whether there is a likelihood of confusion, a number of factors have to be borne in mind. The first is the interdependency principle whereby a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. I also have to factor in the distinctive character of the earlier mark as the more distinctive it is the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely on the imperfect picture of them he has retained in his mind.

58. Earlier in this decision I found the respective marks to have a fairly high degree of similarity from both the visual and aural perspectives. I found, from the conceptual perspective, that for some the respective marks would be dissimilar whereas, for others, there would be a high degree of similarity.

59. In relation to the similarity of the respective goods and services I found:

Opponent's goods		Applicant's goods and services
Handbags	To be identical to	Handbags, bags
Handbags	To be highly similar to	Travelling bags, shopping bags, beach bags
Handbags	To be reasonably similar to	Cases, trunks, satchels, pouches, rucksacks, briefcases, wallets, key cases, credit card cases, purses and back packs
Handbags	To be of low similarity to	Belts
Shoes for women	To be similar to	Handbags
Handbags and women's shoes	To be similar to	Retail shop services relating to items of clothing; the bringing together, for the benefit of others, a variety of goods, namely bags, belts, cases, trunks and travelling bags, satchels, pouches, rucksacks, shopping bags, beach bags, handbags, briefcases, wallets, key cases, credit card cases, purses, back packs; articles of clothing, lingerie, bras, pants, thongs, stockings, tights, suspender belts, camisoles, dressing gowns, negligees, corsets, night dresses, sleep shirts, sarongs, shoulder wraps, shorts, leggings, footwear, headgear, belts, trousers, shorts, jeans, wristbands, headbands, hats, gloves, jackets, coats, jumpers, shirts, t-shirts, sweaters, vests, trousers, skirts, waistcoats, waterproof clothing, bathing costumes, pyjamas, undergarments, scarves, socks, suits, dresses, blouses, sun visors, anoraks, articles of clothing for leisurewear, articles of clothing for casualwear, articles of clothing for sportswear, articles of outer clothing, articles of weatherproof clothing, blazers, denims, jerseys, knitwear, parkas, sweatshirts, tops, and windcheaters, enabling customers to conveniently view and purchase those goods by mail order or by means of telecommunications; the bringing together, for the benefit of others a variety of goods, namely bags, belts, cases, trunks and travelling bags, satchels, pouches, rucksacks, shopping bags, beach bags, handbags, briefcases, wallets, key cases, credit card cases, purses, back packs, articles of clothing, lingerie, bras, pants, thongs, stockings, tights, suspender belts, camisoles, dressing gowns, negligees, corsets, night dresses, sleep shirts, sarongs, shoulder wraps, shorts, leggings, footwear, headgear, belts, trousers, shorts, jeans, wristbands, headbands, hats, gloves, jackets, coats, jumpers, shirts, t-shirts, sweaters, vests, trousers, skirts, waistcoats, waterproof clothing, bathing costumes, pyjamas, undergarments, scarves, socks, suits, dresses, blouses, sun visors, anoraks, articles of clothing for leisurewear, articles of clothing for casualwear, articles of clothing for sportswear, articles of outer clothing, articles of weatherproof clothing, blazers, denims, jerseys, knitwear, parkas, sweatshirts, tops, and windcheaters, enabling

	<p>customers to conveniently view and purchase those goods; retail services connected with bags, belts, cases, trunks and travelling bags, satchels, pouches, rucksacks, shopping bags, beach bags, handbags, briefcases, wallets, key cases, credit card cases, purses, back packs, articles of clothing, lingerie, bras, pants, thongs, stockings, tights, suspender belts, camisoles, dressing gowns, negligees, corsets, night dresses, sleep shirts, sarongs, shoulder wraps, shorts, leggings, footwear, headgear, belts, trousers, shorts, jeans, wristbands, headbands, hats, gloves, jackets, coats, jumpers, shirts, t-shirts, sweaters, vests, trousers, skirts, waistcoats, waterproof clothing, bathing costumes, pyjamas, undergarments, scarves, socks, suits, dresses, blouses, sun visors, anoraks, articles of clothing for leisurewear, articles of clothing for casualwear, articles of clothing for sportswear, articles of outer clothing, articles of weatherproof clothing, blazers, denims, jerseys, knitwear, parkas, sweatshirts, tops, and windcheaters; mail order retail services connected with bags, belts, cases, trunks and travelling bags, satchels, pouches, rucksacks, shopping bags, beach bags, handbags, briefcases, wallets, key cases, credit card cases, purses, back packs, articles of clothing, lingerie, bras, pants, thongs, stockings, tights, suspender belts, camisoles, dressing gowns, negligees, corsets, night dresses, sleep shirts, sarongs, shoulder wraps, shorts, leggings, footwear, headgear, belts, trousers, shorts, jeans, wristbands, headbands, hats, gloves, jackets, coats, jumpers, shirts, t-shirts, sweaters, vests, trousers, skirts, waistcoats, waterproof clothing, bathing costumes, pyjamas, undergarments, scarves, socks, suits, dresses, blouses, sun visors, anoraks, articles of clothing for leisurewear, articles of clothing for casualwear, articles of clothing for sportswear, articles of outer clothing, articles of weatherproof clothing, blazers, denims, jerseys, knitwear, parkas, sweatshirts, tops, and windcheaters; electronic shopping retail services connected with bags, belts, cases, trunks and travelling bags, satchels, pouches, rucksacks, shopping bags, beach bags, handbags, briefcases, wallets, key cases, credit card cases, purses, back packs, articles of clothing, lingerie, bras, pants, thongs, stockings, tights, suspender belts, camisoles, dressing gowns, negligees, corsets, night dresses, sleep shirts, sarongs, shoulder wraps, shorts, leggings, footwear, headgear, belts, trousers, shorts, jeans, wristbands, headbands, hats, gloves, jackets, coats, jumpers, shirts, t-shirts, sweaters, vests, trousers, skirts, waistcoats, waterproof clothing, bathing costumes, pyjamas, undergarments, scarves, socks, suits, dresses, blouses, sun visors, anoraks, articles of clothing for leisurewear, articles of clothing for casualwear, articles of clothing for sportswear, articles of outer clothing, articles of weatherproof clothing, blazers, denims, jerseys, knitwear, parkas, sweatshirts, tops, and windcheaters.</p>
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60. All other of the applicant's goods and services I found to be dissimilar to the opponent's goods.

61. Taking all matters into account, I find that there is a likelihood of confusion in relation to those goods and services which I have found to be identical or similar (to whatever degree) and the opposition succeeds to this extent.

Summary

62. The opposition under section 5(2)(b) succeeds insofar as the following goods and services of the application are concerned:

Class 18

Bags; belts; cases; trunks and travelling bags; satchels; pouches; rucksacks; shopping bags; beach bags; handbags; briefcases; wallets; key cases; credit card cases; purses; back packs.

Class 35

Retail shop services relating to items of clothing; the bringing together, for the benefit of others, a variety of goods, namely bags, belts, cases, trunks and travelling bags, satchels, pouches, rucksacks, shopping bags, beach bags, handbags, briefcases, wallets, key cases, credit card cases, purses, back packs; articles of clothing, lingerie, bras, pants, thongs, stockings, tights, suspender belts, camisoles, dressing gowns, negligees, corsets, night dresses, sleep shirts, sarongs, shoulder wraps, shorts, leggings, footwear, headgear, belts, trousers, shorts, jeans, wristbands, headbands, hats, gloves, jackets, coats, jumpers, shirts, t-shirts, sweaters, vests, trousers, skirts, waistcoats, waterproof clothing, bathing costumes, pyjamas, undergarments, scarves, socks, suits, dresses, blouses, sun visors, anoraks, articles of clothing for leisurewear, articles of clothing for casualwear, articles of clothing for sportswear, articles of outer clothing, articles of weatherproof clothing, blazers, denims, jerseys, knitwear, parkas, sweatshirts, tops, and windcheaters, enabling customers to conveniently view and purchase those goods by mail order or by means of telecommunications; the bringing together, for the benefit of others a variety of goods, namely bags, belts, cases, trunks and travelling bags, satchels, pouches, rucksacks, shopping bags, beach bags, handbags, briefcases, wallets, key cases, credit card cases, purses, back packs, articles of clothing, lingerie, bras, pants, thongs, stockings, tights, suspender belts, camisoles, dressing gowns, negligees, corsets, night dresses, sleep shirts, sarongs, shoulder wraps, shorts, leggings, footwear, headgear, belts, trousers, shorts, jeans, wristbands, headbands, hats, gloves, jackets, coats, jumpers, shirts, t-shirts, sweaters, vests, trousers, skirts, waistcoats, waterproof clothing, bathing costumes, pyjamas, undergarments, scarves, socks, suits, dresses, blouses, sun visors, anoraks, articles of clothing for leisurewear, articles of clothing for casualwear, articles of clothing for sportswear, articles of outer clothing, articles of weatherproof clothing, blazers, denims, jerseys, knitwear, parkas, sweatshirts, tops, and windcheaters, enabling customers to conveniently view and purchase those goods; retail services connected with bags, belts, cases, trunks and travelling bags, satchels, pouches, rucksacks, shopping bags, beach bags, handbags, briefcases, wallets, key cases, credit card cases, purses, back packs, articles of clothing, lingerie, bras, pants, thongs, stockings, tights, suspender belts, camisoles, dressing gowns, negligees, corsets, night

dresses, sleep shirts, sarongs, shoulder wraps, shorts, leggings, footwear, headgear, belts, trousers, shorts, jeans, wristbands, headbands, hats, gloves, jackets, coats, jumpers, shirts, t-shirts, sweaters, vests, trousers, skirts, waistcoats, waterproof clothing, bathing costumes, pyjamas, undergarments, scarves, socks, suits, dresses, blouses, sun visors, anoraks, articles of clothing for leisurewear, articles of clothing for casualwear, articles of clothing for sportswear, articles of outer clothing, articles of weatherproof clothing, blazers, denims, jerseys, knitwear, parkas, sweatshirts, tops, and windcheaters; mail order retail services connected with bags, belts, cases, trunks and travelling bags, satchels, pouches, rucksacks, shopping bags, beach bags, handbags, briefcases, wallets, key cases, credit card cases, purses, back packs, articles of clothing, lingerie, bras, pants, thongs, stockings, tights, suspender belts, camisoles, dressing gowns, negligees, corsets, night dresses, sleep shirts, sarongs, shoulder wraps, shorts, leggings, footwear, headgear, belts, trousers, shorts, jeans, wristbands, headbands, hats, gloves, jackets, coats, jumpers, shirts, t-shirts, sweaters, vests, trousers, skirts, waistcoats, waterproof clothing, bathing costumes, pyjamas, undergarments, scarves, socks, suits, dresses, blouses, sun visors, anoraks, articles of clothing for leisurewear, articles of clothing for casualwear, articles of clothing for sportswear, articles of outer clothing, articles of weatherproof clothing, blazers, denims, jerseys, knitwear, parkas, sweatshirts, tops, and windcheaters; electronic shopping retail services connected with bags, belts, cases, trunks and travelling bags, satchels, pouches, rucksacks, shopping bags, beach bags, handbags, briefcases, wallets, key cases, credit card cases, purses, back packs, articles of clothing, lingerie, bras, pants, thongs, stockings, tights, suspender belts, camisoles, dressing gowns, negligees, corsets, night dresses, sleep shirts, sarongs, shoulder wraps, shorts, leggings, footwear, headgear, belts, trousers, shorts, jeans, wristbands, headbands, hats, gloves, jackets, coats, jumpers, shirts, t-shirts, sweaters, vests, trousers, skirts, waistcoats, waterproof clothing, bathing costumes, pyjamas, undergarments, scarves, socks, suits, dresses, blouses, sun visors, anoraks, articles of clothing for leisurewear, articles of clothing for casualwear, articles of clothing for sportswear, articles of outer clothing, articles of weatherproof clothing, blazers, denims, jerseys, knitwear, parkas, sweatshirts, tops, and windcheaters.

63. The opposition fails in respect of all other goods and services:

Costs

64. Both sides have achieved a largely equal measure of success and I consider that each should bear its own costs.

Dated this 29th day of November 2012

**Ann Corbett
For the Registrar
The Comptroller-General**