

O-105-16

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION UNDER NUMBER 3 076 133
BY ROSABELLA LONDON LIMITED TO REGISTER IN CLASS 14 THE TRADE
MARK:



AND

IN THE MATTER OF OPPOSITION THERETO UNDER NUMBER 404 634 BY
ROLEX S.A.

Background and pleadings

1. Rosabella London Limited (the applicant) applied to register the trade mark



(under No 3 076 133) in the UK on 9 October 2014. It was accepted and published in the Trade Marks Journal on 31 October 2014 in respect of the following goods in Class 14:

Action figures (Decorative-) of precious metal;Agate [unwrought];Agates;Alarm clocks;Alarm watches;Alloys of precious metal;Amulets;Amulets being jewellery;Amulets [jewellery];Amulets [jewellery, jewelry (Am.)];Anchors [clock and watch making];Ankle bracelets;Apparatus for sports timing [stopwatches];Apparatus for timing sports events;Articles of imitation jewellery;Articles of jewellery;Articles of jewellery coated with precious metals;Articles of jewellery made from rope chain;Articles of jewellery made of precious metal alloys;Articles of jewellery made of precious metals;Articles of jewellery with ornamental stones;Articles of jewellery with precious stones;Artificial gem stones;Artificial jewellery;Artificial stones [precious or semi-precious];Atomic clocks;Automobile clocks;Badges of precious metal;Bands for watches;Bangle bracelets;Bangles;Barrels [clock and watch making];Barrels [clock and watchmaking];Beads for making jewelry;Body-piercing rings;Body-piercing studs;Bottle caps of precious metals;Boxes for timepieces;Boxes of precious metal;Bracelets;Bracelets and watches combined;Bracelets for watches;Bracelets [jewellery, jewelry (Am.)];Bracelets [jewelry];Bracelets of precious metal;Brooches [jewellery, jewelry (Am.)];Buckles for watchstraps;Busts of precious metal;Busts of precious metals;Cabinets for clocks;Cases adapted to contain horological articles;Cases adapted to contain items of jewellery;Cases adapted to contain watches;Cases [fitted] for clocks;Cases [fitted] for

horological articles;Cases [fitted] for jewels;Cases [fitted] for watches;Cases for chronometric instruments;Cases for clock- and watchmaking;Cases for clock and watch-making;Cases for horological chronometric instruments;Cases for jewels;Cases for watches;Cases for watches and clocks;Cases for watches [presentation];Cases of precious metals for clocks;Cases of precious metals for horological articles;Cases of precious metals for jewels;Cases of precious metals for watches;Caskets for clocks and jewels;Chain mesh of precious metals [jewellery];Chain mesh of semi-precious metals;Chains for watches;Chains [jewellery, jewelry (Am.)];Chains made of precious metals [jewellery];Chains of precious metals;Chains (Watch -);Chalcedony;Charity bracelets;Charms for collar jewelry and bracelet;Charms in precious metals or coated therewith;Charms [jewellery, jewelry (Am.)];Charms [jewellery] of common metals;Charms of precious metals;Charms of semi-precious metals;Chokers;Chronographs;Chronographs as watches;Chronographs for use as watches;Chronographs [watches];Chronological instruments;Chronometers;Chronometric apparatus and instruments;Chronometric instruments;Chronometrical instruments;Chronoscopes;Clip earrings;Clips of silver [jewellery];Clips (Tie -);Clock and watch hands;Clock cabinets;Clock cases;Clock dials;Clock faces;Clock hands [clock and watch making];Clock hands [clock and watch-making];Clock housings;Clock movements;Clocks;Clocks and parts therefor;Clocks and watches;Clocks and watches, electric;Clocks and watches for pigeon-fanciers;Clocks and watches in general;Clocks for world time zones;Clocks having quartz movements;Clocks incorporating ceramics;Clocks incorporating radios;Clockwork movements;Clockworks;Cloisonne jewellery;Cloisonné jewellery [jewelry (Am.)];Cloisonne pins;Closures for necklaces;Clothing ornaments of precious metals;Coins;Collectible coins;Collets being parts of jewellery;Commemorative coins;Commemorative medals;Control clocks [master clocks];Copper tokens;Costume jewellery;Costume jewelry;Crosses [jewellery];Cubic zirconia;Cuff

links;Cuff links and tie clips;Cuff links coated with precious metals;Cuff links made of gold;Cuff links made of imitation gold;Cuff links made of porcelain;Cuff links made of precious metals with precious stones;Cuff links made of precious metals with semi-precious stones;Cuff links made of silver plate;Cuff links of precious metal;Cuff links of precious metals with semi-precious stones;Cufflinks;Cuff-links;Cultured pearls;Cut diamonds;Decorative articles [trinkets or jewellery] for personal use;Decorative brooches [jewellery];Decorative cuff link covers;Decorative pins [jewellery];Decorative pins of precious metal;Desk clocks;Diadems;Dials [clock and watch making];Dials (clockmaking and watchmaking);Dials for clock and watch-making;Dials for clocks;Dials for horological articles;Dials for watches;Dials (Sun -);Diamond [unwrought];Diamonds;Digital clocks;Digital clocks being electronically controlled;Digital clocks incorporating radios;Digital clocks with automatic timers;Digital time indicators having temperature displays;Digital watches with automatic timers;Divers' watches;Diving watches;Dress ornaments in the nature of jewellery;Dress watches;Ear clips;Ear ornaments in the nature of jewellery;Ear studs;Earrings;Earrings of precious metal;Electric alarm clocks;Electric timepieces;Electric watches;Electrical timepieces;Electrically operated movements for clocks;Electrically operated movements for watches;Electronic alarm clocks;Electronic clocks;Electronic timepieces;Electronic watches;Electronically operated movements for clocks;Electronically operated movements for watches;Emerald;Emeralds;Enamelled jewellery;Escapements;Faces for chronometric instruments;Faces for clocks;Faces for horological instruments;Faces for watches;Fake jewellery;Fancy keyrings of precious metals;Fashion jewellery;Figures of precious metal;Figurines coated with precious metal;Figurines for ornamental purposes of precious stones;Figurines made from gold;Figurines made from silver;Figurines of precious metal;Figurines of precious stones;Figurines [statuettes] of precious metal;Finger rings;Flexible wire bands for wear as a bracelet;Floor clocks;Fobs for keys;Friendship rings;Gems;Gemstones;Gold;Gold alloy ingots;Gold alloys;Gold and its

alloys;Gold base alloys;Gold bracelets;Gold bullion coins;Gold chains;Gold coins;Gold earrings;Gold ingots;Gold jewellery;Gold medals;Gold plated bracelets;Gold plated brooches [jewellery];Gold plated chains;Gold plated earrings;Gold plated rings;Gold rings;Gold thread [jewellery, jewelry (Am.)];Gold thread jewelry;Gold, unworked or semi-worked;Gold, unwrought or beaten;Grandfather clocks;Hands (Clock -) [clock and watch making];Hands for clocks;Hands for watches;Hat ornaments of precious metal;Horological and chronometric instruments;Horological articles;Horological instruments;Horological instruments having quartz movements;Horological instruments made of gold;Horological products;Housings fo clocks and watches;Identification bracelets [jewelry];Imitation gold;Imitation jet;Imitation jewellery;Imitation jewellery ornaments;Imitation jewelry;Imitation pearls;Imitation precious stones;Industrial clocks;Ingots of precious metal;Ingots of precious metals;Insignia of precious metals;Insignias of precious metal;Iridium;Iridium and its alloys;Items of jewellery;Ivory [jewellery, jewelry (Am.)];Jade [jewellery];Jades;Jet;Jet (Ornaments of -);Jet, unwrought or semi-wrought;Jewel cases [fitted];Jewel cases of precious metal;Jewel chains;Jewel pendants;Jewellery;Jewellery articles;Jewellery being articles of precious metals;Jewellery being articles of precious stones;Jewellery boxes;Jewellery boxes [fitted];Jewellery boxes of precious metals;Jewellery cases;Jewellery cases [caskets];Jewellery cases [caskets] of precious metal;Jewellery cases [fitted];Jewellery chain;Jewellery chain of precious metal for anklets;Jewellery chain of precious metal for bracelets;Jewellery chain of precious metal for necklaces;Jewellery chains;Jewellery, clocks and watches;Jewellery coated with precious metal alloys;Jewellery coated with precious metals;Jewellery containing gold;Jewellery fashioned from bronze;Jewellery fashioned from non-precious metals;Jewellery fashioned of cultured pearls;Jewellery fashioned of precious metals;Jewellery fashioned of semi-precious stones;Jewellery for personal adornment;Jewellery for personal wear;Jewellery in non-precious metals;Jewellery in precious metals;Jewellery in semi-

precious metals; Jewellery in the form of beads; Jewellery, including imitation jewellery and plastic jewellery; Jewellery incorporating diamonds; Jewellery incorporating pearls; Jewellery incorporating precious stones; Jewellery items; Jewellery made from gold; Jewellery made from silver; Jewellery made of bronze; Jewellery made of crystal; Jewellery made of crystal coated with precious metals; Jewellery made of glass; Jewellery made of non-precious metal; Jewellery made of plastics; Jewellery made of plated precious metals; Jewellery made of precious metals; Jewellery made of precious stones; Jewellery made of semi-precious materials; Jewellery of precious metals; Jewellery of yellow amber; Jewellery ornaments; Jewellery (Paste -); Jewellery plated with precious metals; Jewellery, precious stones; Jewellery products; Jewellery rope chain for anklets; Jewellery rope chain for bracelets; Jewellery rope chain for necklaces; Jewellery stones; Jewellery watches; Jewellery; Jewellery; Jewellery boxes; Jewellery boxes not of metal; Jewellery boxes of precious metal; Jewellery brooches; Jewellery cases; Jewellery cases [caskets]; Jewellery cases not of precious metal; Jewellery cases of precious metal; Jewellery caskets; Jewellery caskets of precious metal; Jewellery chains; Jewellery dishes; Jewellery findings; Jewellery for the head; Jewellery of yellow amber; Jewellery (Paste -) [costume jewellery]; Jewellery pins for use on hats; Jewellery stickpins; Jewellery watches; Jewellery; Jewellery; Key chains as jewellery [trinkets or fobs]; Key charms coated with precious metals; Key charms of precious metals; Key charms [trinkets or fobs]; Key fobs; Key fobs made of precious metal; Key fobs of precious metals; Key fobs [rings] coated with precious metal; Key holders of precious metals; Key holders [trinkets or fobs]; Key rings of precious metals; Key rings [trinkets or fobs]; Key rings [trinkets or fobs] of precious metal; Key tags [trinkets or fobs]; Lapel badges of precious metal; Lapel pins [jewellery]; Lapel pins [jewellery]; Lapel pins of precious metals [jewellery]; Leather watch straps; Links (Cuff -); Lockets; Man-made pearls; Mantle clocks; Marcassites; Master clocks; Mechanical watch oscillators; Mechanical watches; Mechanical watches with automatic winding; Mechanical watches with manual




winding;Medallions;Medallions [jewellery, jewelry (Am.)];Medallions made of non-precious metals;Medallions made of precious metals;Medals;Medals coated with precious metals;Medals made of precious metals;Metal badges for wear [precious metal];Metal expanding watch bracelets;Metal watch bands;Metal wire [precious metal];Metal works of art [precious metal];Miniature clocks;Miniature figurines [coated with precious metal];Model animals [ornaments] coated with precious metal;Model animals [ornaments] made of precious metal;Model figures [ornaments] coated with precious metal;Model figures [ornaments] made of precious metal;Movements for clocks and watches;Natural gem stones;Neck chains;Necklaces;Necklaces [jewellery];Necklaces [jewellery, jewelry (Am.)];Non-leather watch straps;Non-monetary coins;Objet d'art made of precious metals;Objet d'art made of precious stones;Objet d'art of enamelled gold;Objet d'art of enamelled silver;Olivine [gems];Olivine [peridot];Opal;Ornamental figurines made of precious metal;Ornamental lapel pins;Ornamental pins;Ornamental pins made of precious metal;Ornamental sculptures made of precious metal;Ornaments for clothing [of precious metal];Ornaments (Hat -) of precious metal;Ornaments [jewellery, jewelry (Am.)];Ornaments of jet;Ornaments (Shoe -) of precious metal;Ornaments [statues] made of precious metal;Osmium;Osmium and its alloys;Palladium;Palladium and its alloys;Parts for clocks;Parts for clockworks;Parts for watches;Paste jewellery;Paste jewellery [costume jewelry (Am.)];Pearl;Pearls;Pearls [jewellery];Pearls [jewellery, jewelry (Am.)];Pearls made of ambroid [pressed amber];Pendant watches;Pendants;Pendants for watch chains;Pendants [jewellery];Pendula;Pendulum clocks;Pendulums [clock and watch making];Pendulums [clock and watch-making];Personal jewellery;Personal ornaments of precious metal;Pewter jewellery;Pins being jewellery;Pins being jewelry;Pins [jewellery, jewelry (Am.)];Pins (Ornamental -);Pins (Tie -);Platinum;Platinum alloy ingots;Platinum and its alloys;Platinum ingots;Platinum [metal];Pocket watches;Precious and semi-precious gems;Precious gemstones;Precious

jewellery;Precious jewels;Precious metal alloys;Precious metal alloys [other than for use in dentistry];Precious metals;Precious metals and alloys thereof;Precious metals, unwrought or semi-wrought;Precious stones;Precious stones and watches;Presentation boxes for horological articles;Presentation boxes for watches;Presentation cases for horological articles;Presentation cases for watches;Processed or semi-processed precious metals;Quartz clocks;Quartz watches;Rhodium;Rhodium and its alloys;Ring bands [jewellery];Ring holders of precious metal;Rings being jewellery;Rings coated with precious metals;Rings [jewellery];Rings [jewellery, jewelry (Am.)];Rings [jewellery] made of non-precious metal;Rings [jewellery] made of precious metal;Rings [jewelry];Rings [trinket];Rope chain [jewellery] made of common metal;Rope chain made of precious metal;Ruby;Ruthenium;Ruthenium and its alloys;Sapphire;Sapphires;Sardonyx [unwrought];Scale models [ornaments] of precious metal;Sculptures made from precious metal;Sculptures made of precious metal;Semi-finished articles of precious metals for use in the manufacture of jewellery;Semi-finished articles of precious stones for use in the manufacture of jewellery;Semi-precious articles of bijouterie;Semi-precious gemstones;Semi-precious stones;Semi-wrought precious stones and their imitations;Ship's chronometers;Shoe ornaments of precious metal;Silver;Silver alloy ingots;Silver and its alloys;Silver ingots;Silver objets d'art;Silver thread;Silver, unwrought or beaten;Small clocks;Small jewellery boxes of precious metals;Spinel [precious stones];Spinels;Sports watches;Springs (Watch -);Spun silver [silver wire];Square gold chain;Stands for clocks;Statues of precious metal;Statues of precious metal and their alloys;Statues of precious metals;Statuettes made of semi-precious metals;Statuettes made of semi-precious stones;Statuettes of precious metal;Statuettes of precious metal and their alloys;Sterling silver jewellery;Stop watches;Stopwatches;Straps for watches;Straps for wrist watches;Straps for wristwatches;Sun dials;Sundials;Synthetic precious stones;Synthetic stones [jewellery];Table clocks;Table

watches;Threads of precious metal [jewellery, jewelry (Am.)];Threads of precious metals;Tiaras;Tie bars of precious metals;Tie chains of precious metal;Tie clasps of precious metals;Tie clips;Tie clips of precious metal;Tie holders of precious metal;Tie pins;Tie pins of precious metal;Tie tacks of precious metals;Tie-pins of precious metal;Time clocks [master clocks] for controlling other clocks;Timekeeping instruments;Timekeeping systems for sports;Timepieces;Timing clocks;Tokens (Copper -);Topaz;Travel clocks;Trinkets coated with precious metal;Trinkets [jewellery, jewelry (Am.)];Trinkets of bronze;Trinkets of precious metal;Trophies coated with precious metal alloys;Trophies coated with precious metals;Trophies made of precious metal alloys;Trophies made of precious metals;Trophies of precious metals;Unwrought and semi-wrought precious stones and their imitations;Unwrought precious stones;Unwrought silver;Unwrought silver alloys;Wall clocks;Wall clocks [horological];Watch and clock springs;Watch bands;Watch boxes;Watch bracelets;Watch cases;Watch casings;Watch chains;Watch clasps;Watch crowns;Watch crystals;Watch dials;Watch faces;Watch fobs;Watch glasses;Watch movements;Watch parts;Watch pouches;Watch springs;Watch straps;Watch straps made of metal or leather or plastic;Watch straps of nylon;Watch straps of plastic;Watch straps of polyvinyl chloride;Watch straps of synthetic material;Watchbands;Watches;Watches bearing insignia;Watches containing a game function;Watches containing an electronic game function;Watches for nurses;Watches for outdoor use;Watches for sporting use;Watches incorporating a memory function;Watches incorporating automatic generating systems;Watches made of gold;Watches made of plated gold;Watches made of precious metals;Watches made of precious metals or coated therewith;Watches made of rolled gold;Watchstraps;Watchstraps made of leather;Wedding bands (Jewellery);Wedding rings;Wire of precious metal [jewellery, jewelry (Am.)];Wire thread of precious metal;Women's jewelry;Women's watches;Wooden jewellery boxes;Works of art of precious metal;Wrist bands [charity];Wrist straps for watches;Wrist

watch bands;Wrist watches;Wristlet watches;Wristlets
[jewellery];Wristwatches.

2. Rolex SA (the opponent) oppose the trade mark on the basis of Section 5(2)(b) and Section 5(3) of the Trade Marks Act 1994 (the Act). This is on the basis of its earlier UK and Community Trade Marks:

- a) UK Trade Mark No 854 289  relied upon for watches and jewellery in Class 14;
- b) UK Trade Mark No 2 482 493  relied upon for watches and jewellery in Class 14;
- c) Community Trade Mark No 1 455 757 
ROLEX relied upon for watches and jewellery in Class 14.

3. The opponent argues that the respective goods are identical or similar and that the marks are similar. Further, it argues that it enjoys a significant reputation in its earlier marks and that the applicant's mark, if registered, would take unfair advantage by riding on the coat tails of this reputation and benefit from the power of attraction, the reputation and prestige of the opponent's earlier mark. Finally, the opponent's aura of prestige will be damaged as would its ability of immediate association with the ROLEX + crown device and crown device alone.

4. The applicant filed a counterstatement denying the claims made. It did not request that the opponent provide proof of use of its earlier trade marks relied upon.
5. Both sides filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate.
6. A Hearing took place on 13 January 2016, with the opponent represented by Mr Thomas St Quintin of Counsel, instructed by D Young & Co, Trade Mark Attorney for the opponent and the applicant was self represented by Mr Jonathan Johnson.

Evidence

The Opponent's evidence

7. This is comprised of two witness statements: from David John Cutler and Carl Allen Richard Lamberton. Mr Cutler is the Head of Communications for the Rolex Watch Company Limited, an affiliate company of Rolex S.A (the opponent). In order to support its claim to a substantial reputation in all of the earlier marks relied upon, the following relevant information is contained therein:
 - The ROLEX brand has been the pre-eminent symbol of performance and prestige in watch making for over a century. All watches feature the ROLEX + Crown on the dial of the watch, with the Rolex crown featured on the winding mechanism of every watch and the clasp of every watch bracelet. Exhibit DC2 contains photographs demonstrated the aforesaid;
 - The Rolex crown is the sole trade mark featured on the exterior of the presentation box/outer sleeve/watch block which accompanies all watches sold. The Rolex + Crown is present on the interior of the presentation box and also on the guarantee which is provided with all Rolex watches. Exhibits DC3 and DC4 includes photographs in support.

- The opponent has manufactured and sold a very substantial number of watches in the UK and worldwide over the last 60 years. Revenue for 2013 was in excess of £12.5 million and in 2014 was in excess of £15 million, the vast majority of which was derived from the sale of watches, all of which feature both the earlier trade marks relied upon;
- There are more than 100 Official Rolex Retailers in the UK. Exhibit DC5 is photographs illustrating typical use of the earlier trade marks by the Official Retailers, such as watch blocks, trays, desks and door handles;
- Between the years 2010 to 2014, Rolex have spent around £200,000 per annum on advertising. Exhibit DC6 provides examples of advertising activities.
- The earlier trade marks are also used extensively in sponsorship of major sporting and cultural events and institutions. These include (but are not limited to), Wimbledon, the Ryder Cup, Formula One, The Royal Opera House. Examples are included at Exhibits DC9 and DC10;
- The earlier marks are also promoted through sponsorship and endorsement of high profile sporting and cultural figures such as: Placido Domingo, Roger Federer and Jack Nicklaus;
- The Rolex brand is frequently ranked as one of the most successful and prestigious brands by independent and third party publications. The following are examples: An article in Ad Week stating that “the Rolex Crown is one of the most recognisable luxury brand symbols in existence” (ExhibitDC13 contains a copy of the relevant article); ranked No 1 on the list of Consumer Superbrands Official Top 500 in 2012 and 2013 and No 2 in 2014 and 2015 (by the Centre for Brand Analysis).

8. The second witness statement from Mr Lamerton contains his opinion regarding the strength of the Rolex brand. According to him, his background in the brand creation industry bestows on him the experience to comment on the position of Rolex in respect of its recognisability. It is considered that the content of Mr Lamerton’s witness statement does not materially add to the opponent’s case in these proceedings, as the thrust of Mr Lamerton’s opinion is in any case demonstrated by the other evidence filed. It is clear that the

opponent enjoys a significant reputation in respect of all the earlier marks relied upon, in respect of watches. Further, that the nature of this reputation is in respect of quality, luxury and prestige.

The Applicant's evidence

9. This is comprised of two witness statements: from Ms Jane Padginton, the owner of a brand design and strategy agency and from My Jonathan Johnson, the applicant.

10. The majority of Ms Padginton's witness statement will not be summarised as it contains opinion rather than fact. It is noted that details are provided of other traders who utilise a crown device as part of its brand, for example Fortis and Pandora.

11. Mr Johnson's witness statement explains that the initials "RL" in the trade mark applied for are reference to the name of the applicant company – Rosabella London. Details of use of the trade mark applied for are provided: from October 2014 onwards. In respect of the goods relevant to these proceedings, namely those in Class 14, there is activity from December 2014 onwards, though it is accepted that the pieces involved are in commission and will be released at a future date. Mr Johnson provides his opinion as to the grounds of opposition and outlines details of other brands including a crown device. Further, he provides details of the similarities between car logos and seeks to draw an analogy with this industry.

The opponent's evidence in reply

12. This is a witness statement from the same Mr Cutler as previously. He argues that much of the applicant's evidence is opinion and cannot be viewed as "expert" evidence. In respect of use of the trade mark applied for by the applicant, Mr Cutler is of the view that the evidence provided does not demonstrate reputation. Rather, that the applicant is in the "start up phase".

13. In response to the witness statement of Ms Padginton and specifically where she provides details of other brands using crown devices, Mr Cutler argues that none of these are shown “in use” and certainly none with a crown device is used separately from the respective verbal elements.

Conclusions on the opponent’s evidence

14. The evidence filed is clear in respect of length and scope of use. There are numerous examples of advertising and sponsorship activities on a significant scale. Turnover figures are also impressive. It is considered that the evidence filed unequivocally demonstrates that the opponent enjoys a significant reputation in respect of watches. This is true of the earlier crown only and ROLEX + crown trade marks relied upon.

Conclusions on the applicant’s evidence

15. The content of what has been filed has been duly noted, including Mr Johnson’s assertion that the letters RL in the contested trade mark refers to the initials of the company: Rosabella London. However, on the whole, the relevance of the materials filed is extremely limited. Most notably, the applicant has attempted to provide information in the form of opinions from “brand experts”. In this respect, I bear in mind the following guidance:

In esure Insurance Ltd v Direct Line Insurance Plc, [2008] EWCA Civ 842, L. J. Arden stated that:

“62. Firstly, given that the critical issue of confusion of any kind is to be assessed from the viewpoint of the average consumer, it is difficult to see what is gained from the evidence of an expert as to his own opinion where the tribunal is in a position to form its own view. That is not to say that there may not be a role for an expert where the markets in question are ones with which

judges are unfamiliar: see, for example, Taittinger SA v Allbev Ltd [1993] F.S.R. 641”

16. The goods in question here are general consumer goods. As such, I am the jury in these proceedings and so whether or not there is a likelihood of confusion is a matter for me alone to decide.

DECISION

Section 5(2)(b)

Sections 5(2)(b) of the Act is as follows:

“5(2) A trade mark shall not be registered if because-

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

Comparison of goods

17. Some of the contested goods, i.e. watches are identical to the goods on which the opposition is based. For reasons of procedural economy, the Tribunal will not undertake a full comparison of the goods listed above. The examination of the opposition will proceed on the basis that the contested goods are identical to those covered by the earlier trade marks. If the opposition fails, even where the goods are identical, it follows that the opposition will also fail where the goods are only similar.

Comparison of marks

18. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

20. The respective trade marks are shown below:

	
Earlier trade marks	Contested trade mark

21. As regards distinctive and dominant components, it is the highly cursive script of the letters RL which stands out visually in the contested trade mark due to its central position and larger size. The crown device which sits on top is of course, not negligent and can clearly be seen. Both elements are considered distinctive. As regards the earlier marks, the answer is straightforward in respect of the crown only mark as this is the sole element. In respect of the ROLEX + crown mark, it is considered that ROLEX is just about more dominant visually, though the crown can be clearly seen and is in no way negligible. They are also both distinctive elements. As such, the correct comparison to be made here is as between the trade marks as complete wholes.

22. I will consider the position in respect of the earlier crown mark first. Visually, I note that the earlier crown has an ellipse at the bottom, creating a semi three dimensional effect. This is not present in the crown in the contested trade mark. Each of the crowns have five arches. In the earlier mark, these have an elongated appearance with a circle at the end of each arch. In the contested mark, the arches are shorter with a stubby appearance and a full or half arrow head at the end of each. Further, the contested trade mark has an ornate script: the letters RL. There is no counterpart in the earlier trade mark and so this provides an additional point of visual difference. As each contain crown devices, it is conceded that this provides a point of similarity in a broad sense. However due to the differences between the crowns in question, this is pitched as being at an extremely low degree.
23. Aurally, it is difficult to know how the earlier trade mark would be referred to. It is possible that it will be referred to as “crown”. The contested trade mark could be referred to in the same manner, but is more likely to be articulated as RL or RL crown. In respect of the former, there will be no aural similarity. In respect of the latter, it would be a low degree.
24. Conceptually, the earlier mark will be understood as being a crown, i.e. headgear worn by a Royal. The latter trade mark will convey the same message, tempered by the letters RL which may be understood as initials. There is a shared concept here in respect of crowns.
25. Now to consider the position as regards the earlier ROLEX + crown trade mark. Some of the analysis mirrors that already mentioned and so will not be repeated verbatim but will be referred to where appropriate. Visually, the differences in the crowns (as already outlined) remain. However, both of these trade marks also has a verbal element. It is noted that this is ROLEX and in the earlier trade mark and RL in the later trade mark: elements with vastly different lengths and so, obvious visual difference. The letter R in the contested trade mark is highly ornate. The respective letter L in each of the marks appears in similar script. At the hearing Mr St Quintin sought to persuade me that the letters RL will be seen as an abbreviation of ROLEX as

RL are the letters which appear at the start of each syllable. I am unpersuaded by this argument and considered it far more likely that RL will be seen as initials or as a random letter string. The result visually is that these marks contain far more (and more significant) differences visually than similarities. It is true that they each contain the letter L in a similar script, but overall there is little visual similarity here. If there is similarity, it is considered to be at a very low degree.

26. Aurally, the earlier trade mark will be referred to as RO-LEX; the later mark most likely as RL. There is at best, a very low degree of aural similarity.

27. Conceptually, ROLEX has no meaning, RL may be seen as initials or as a random letter pair. There is no conceptual similarity in this respect. I will not discount the possibility that the crowns in each will provide the concept here and to that extent there is a shared concept.

Average consumer and the purchasing act

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

29. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The

words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

30. The goods in question are watches and jewellery. These are general consumer items, aimed at the public at large. I note the following as regards prices:

In *Bang & Olufsen A/S v OHIM*, Case T-460/05, the General Court stated that:

“According to the case-law, the price of the product concerned is also immaterial as regards the definition of the relevant public, since price will also not be the subject of the registration (Joined Cases T-324/01 and T-110/02 *Axions and Belce v OHIM* (Brown cigar shape and gold ingot shape) [2003] ECR II-1897, paragraph 36).”

31. Bearing in mind the foregoing, it is irrelevant as to whether the goods are in reality high or low in cost. Further, that the opponent’s mark is used in reality on luxury goods is irrelevant. All market sectors must be considered when assessing the likelihood of confusion.

32. As such, for watches which are relatively higher in cost, it is likely that the average consumer will display a higher than average degree of attention during the purchasing process. For those which are lower in cost it remains that they are likely to display an average degree of attention.

Distinctive character of the earlier trade mark

33. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an

overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

34. At the hearing, Mr St Quintin referred to a previous decision of the Registrar in BL O – 350-14¹. In this decision, the Hearing Officer, accepted that the opponent enjoyed an enhanced degree of distinctive character in respect of its crown marks. I have noted the content of this decision and in perusing the evidence in the current proceedings, accept that it clearly demonstrates that the earlier marks relied upon have acquired an enhanced distinctive character as a result of the use made in respect of watches. Much of the evidence shows the earlier ROLEX + crown mark. However, there are also ample examples of the crown mark alone. Further, I also bear in mind the guidance from the CJEU² which held that use in conjunction with another mark can enable a mark to acquire an enhanced distinctive character.

¹ Scott & Scott v Rolex S.A.

² Mars v Nestle, Case C-353/03, CJEU

35. The earlier trade marks are unequivocally highly distinctive for watches because of the use made of them.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.

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

The principles

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

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

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

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

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

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

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

37. In assessing the likelihood of confusion, the respective goods are identical in so far as both include watches in their specifications. Further, that the earlier trade marks enjoy an enhanced degree of distinctive character in respect of watches.

38. Further, I note the following guidance which was referred to in the aforementioned previous decision of the Registrar: ³

In *Quelle AG v OHIM*, Case T-88/05, the General Court found that visual similarity (and difference) is most important in the case of goods that are self selected or where the consumer sees the mark when purchasing the goods. The Court stated that:

“68..... If the goods covered by the marks in question are usually sold in self-service stores where consumers 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

³ BL O/350/14

orally, greater weight will usually be attributed to any phonetic similarity between the signs (*NLSPORT*, *NLJEANS*, *NLACTIVE* and *NLCollection*, paragraph 53 supra, paragraph 49).

69. Likewise, the degree of phonetic similarity between two marks is of less importance in the case of goods which are marketed in such a way that, when making a purchase, the relevant public usually perceives visually the mark designating those goods (*BASS*, paragraph 56 supra, paragraph 55, and Case T-301/03 *Canali Ireland v OHIM – Canal Jean (CANAL JEAN CO. NEW YORK)* [2005] ECR II-2479, paragraph 55). That is the case with respect to the goods at issue here. Although the applicant states that it is a mail order company, it does not submit that its goods are sold outside normal distribution channels for clothing and shoes (shops) or without a visual assessment of them by the relevant consumer. Moreover, while oral communication in respect of the product and the trade mark is not excluded, the choice of an item of clothing or a pair of shoes 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 (*NLSPORT*, *NLJEANS*, *NLACTIVE* and *NLCollection*, paragraph 53 supra, paragraph 50). The same is true of catalogue selling, which involves as much as does shop selling a visual assessment of the item purchased by the consumer, whether clothing or shoes, and does not generally allow him to obtain the help of a sales assistant. Where a sales discussion by telephone is possible, it takes place usually only after the consumer has consulted the catalogue and seen the goods. The fact that those products may, in some circumstances, be the subject of discussion between consumers is therefore irrelevant, since, at the time of purchase, the goods in question and, therefore, the marks which are affixed to them are visually perceived by consumers.”

39. In concurring with the finding in BL O/350/14, it is the degree of visual similarity between these trade marks which is the most important as it is

industry standard for watches to be displayed in the front windows of shops. This is clearly supported by the evidence. In respect of the earlier crown mark, there is low visual similarity and indeed overall similarity is low at best. In respect of the earlier ROLEX+ crown mark, the overall degree of similarity has been found to be low, with many (and significant) differences. It is true that in respect of all the earlier trade marks and the contested trade mark there may be a shared concept. However, it is considered that the extent of the visual differences here, together with the (at least) average degree of attention that is expected to be displayed during the purchasing process, easily negates against the effect of imperfect recollection. There is considered to be no likelihood of confusion here. As such, the opposition based upon Section 5(2)(b) of the Act fails.

Section 5(3)

40. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC), in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

41. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in

particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

Reputation

42. It is considered that the evidence establishes that the opponent's trade marks have a qualifying reputation in relation to watches.

The Link

43. I have already found that the level of similarity between marks means there is no likelihood of confusion. However, this does not necessarily mean that no link will be established:

In *Intra-Press SAS v OHIM*, Joined cases C-581/13P & C-582/13P, the Court of Justice of the European Union stated (at paragraph 72 of its judgment) that:

"The Court has consistently held that the degree of similarity required under Article 8(1)(b) of Regulation No 40/94, on the one hand, and Article 8(5) of that regulation, on the other, is different. Whereas the implementation of the protection provided for under Article 8(1)(b) of Regulation No 40/94 is conditional upon a finding of a degree of similarity between the marks at issue so that there exists a likelihood of confusion between them on the part of the relevant section of the public, the existence of such a likelihood is not necessary for the protection conferred by Article 8(5) of that regulation. Accordingly, the types of injury referred to in Article 8(5) of Regulation No 40/94 may be the consequence of a lesser degree of similarity between the earlier and the later marks, provided that it is sufficient for the relevant section of the public to make a connection between those marks, that is to say,

to establish a link between them (see judgment in *Ferrero v OHMI*, C-552/09 P, EU:C:2011:177, paragraph 53 and the case-law cited).”

44. It seems therefore that a relatively lower threshold is to be applied when establishing a link as opposed to a confusing similarity. I have already found these marks to be significantly different, most notably visually. It is true that each contain a crown, but these are visually different from one another. It is also true that the letters R and L appear in both, but there is nothing to suggest that a link would be made. For the letters RL to be viewed as an abbreviation of ROLEX is, in my view, a stretch too far. The vast reputation of the opponent does not remedy the major defect in its case: that these marks are not similar enough to establish a link.

45. The opposition under Section 5(3) therefore also fails.

46. Bearing in mind the aforesaid, the opposition fails in its entirety.

COSTS

47. The applicant has been successful and is entitled to a contribution towards its costs. In the circumstances I award the applicant the sum of £700 as a contribution towards the cost of the proceedings⁴. The sum is calculated as follows:

Considering notice of opposition and preparing a statement of grounds: £200

Preparing evidence and considering other side's evidence: £250

Preparing for and attending a Hearing: £250

TOTAL: £700

⁴ It should be noted that the applicant is a litigant in person. As such, the overall cost award has been reduced to reflect the fact that no legal costs have been incurred.

48. I therefore order ROLEX SA to pay Rosabella London Limited the sum of £700. The above sum should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 2nd day of March 2016

Louise White
For the Registrar,