

O/670/19

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3276446
BY CHANEL LIMITED TO REGISTER THE TRADE MARK:**

CHANEL'S GABRIELLE

IN CLASSES 9, 14 AND 18

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO. 412303

BY CATHERINE SIDONIO

Background and pleadings

1. On 11 December 2017, Chanel Limited (“the applicant”) applied to register the trade mark CHANEL’S GABRIELLE. The application was made in respect of goods in classes 9, 14 and 18, details of which can be found in the Annex to this decision. The application was published for opposition purposes on 26 January 2018.

2. The application is partially opposed by Catherine Sidonio (“the opponent”). The opposition is based upon Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and is directed against the following goods in the application:

Class 9: *sunglasses, sunglasses frames and lenses.*

Class 14: *jewellery; charms; cufflinks; decorative pins; tie pins; brooches; medallions.*

Class 18: *handbags; vanity cases (not fitted), briefcases, articles of luggage, wallets, purses (not of precious metal or coated therewith), leather shoulder belts; bags; sporrans; credit card holders; card holders; key holders.*

3. The opponent relies upon her UK trade mark number 3192386 for the trade mark GABRIELLE. The mark was filed on 20 October 2016 and was entered in the register on 9 February 2018. It is registered for the following goods, all of which are relied upon by the opponent:

Class 25: *Articles of clothing, robes, dresses, tunics, cardigans, leggings, scarves, belts, tutus, trousers, t-shirts and sweatshirts; headgear; footwear, boots, shoes, slippers, flip-flops and slides; jumpers, caps, hats, jumpsuits, shorts, tights, skirts, swimsuits, lingerie.*

4. Given its date of filing, the opponent’s trade mark qualifies as an earlier mark in accordance with Section 6 of the Act. As the opponent’s earlier mark had not completed its registration process more than 5 years before the publication of the

applicant's mark, it is not subject to the proof of use provisions contained in Section 6A of the Act.

5. The opponent claims that the respective goods are similar and that the marks are similar. She submits that CHANEL'S GABRIELLE gives the impression of a brand extension or "a collaboration" between Chanel and the owner of the earlier mark GABRIELLE.

6. The applicant filed a Form TM8 notice of defence, including a counterstatement, denying the grounds of opposition. In its counterstatement, the applicant refers to a decision of the Registry (BL-O-646-17) which relates to a previous opposition involving the same parties in inverted roles. In that decision, the Hearing Officer held that there was no likelihood of confusion between the marks GABRIELLE and GABRIELLE CHANEL in the context of identical goods in class 25.

7. The opponent is represented by Kilburn & Strode LLP, the applicant by Withers & Rogers LLP. Both sides filed evidence in these proceedings. This will be summarised to the extent that is considered necessary. The opponent also filed written submissions dated 20 September 2018. A hearing was held on 30 August 2019. Ms Amanda Michael QC appeared as counsel for the opponent, instructed by Kilburn & Strode LLP. Mr Benet Brandreth QC appeared as counsel for the applicant, instructed by Withers & Rogers LLP.

The opponent's evidence

8. The opponent filed two witness statements from Carrollanne Lindley, who is a partner in the firm Kilburn & Strode LLP.

Ms Lindley's first witness statement

9. Some of the evidence produced by Ms Lindley in her first witness statement dated 20 September 2018 relates to other opposition proceedings. I earlier mentioned BL-O-646-17; Exhibit CL1 is a copy of that decision.

10. Other exhibits were attached to Ms Lindley's witness statement as follows:

- Exhibits CL4-6: are copies of 'Coco Chanel' posters which are said relate to three films produced in 2008-2009;
- Exhibits CL8-9: are web prints showing a number of clothing items branded "GABRIELLE BY MOLLY BRACKEN";
- Exhibit CL10: is a web print which says that MOLLY BRACKEN is a French brand and was launched by the opponent in 2008;
- Exhibit CL11: is a copy of an online article about collaborations between fashion designers and mass market retailers.

Ms Lindley's second witness statement

11. In her second witness statement of 22 March 2019, consisting of evidence in reply, Ms Lindley states that the opponent is a successful designer and that GABRIELLE is one of the opponent's brands, the others being MOLLY BRACKEN, LILI SIDONIO and MINI MOLLY. She attaches at Exhibit CL1 a list of 26 worldwide applications for registration of the mark GABRIELLE, 9 of which have proceeded to registration. Ms Lindley says that the GABRIELLE brand was launched on 9 August 2017 on the opponent's website (www.mollybracken.com) and has been promoted in the UK by the London model and influencer Rachel Susan Hyde who has 4,318 followers on an Instagram account. According to Ms Lindley, the UK relevant public is aware that GABRIELLE is one of MOLLY BRACKEN's brands.

12. The rest of the evidence seeks to support the argument that CHANEL'S GABRIELLE will be perceived as a collaboration between the brands CHANEL and GABRIELLE. This includes:

- Exhibits CL5-6: are online articles about collaborations in the fashion industry. They provide examples of collaborations between brands presented using the symbol 'X' to signify the collaboration, e.g. Uniqlo x Lemaire, Kenzo x H&M;

- Exhibits CL7-24: include examples of collaborations between brands offering different products or targeting different segments of the markets. These include:
 - (i) a collaboration between the fashion company Dolce & Gabbana and Smeg, a company which manufactures domestic appliances. The article shows a SMEG food processor decorated with a flowery pattern;
 - (ii) a collaboration between the French fashion shop Colette and the fast-food chain McDonalds. The co-branded products are items of merchandising featuring graphics from McDonalds' advertising campaigns in an abstract form;
 - (iii) a collaboration between the fashion house Givenchy and the confectioner Fauchon. The co-branded product is an éclair flavoured topped with an icing print displaying both Fauchon's and Givenchy's trade marks;
 - (iv) collaborations between motor vehicle manufacturers and fashion labels including a 'Vespa 946 Emporio Armani' and a 'Fiat 500 by Gucci';
 - (v) a collaboration between the technology company Apple and the sport brand Nike. The co-branded product is a 'Apple Watch Nike +', described as *"the ultimate tool for anyone who runs"*;
 - (vi) a collaboration between the brands Louis Vuitton and Supreme. The co-branded products are articles of fashion accessories featuring both the word SUPREME and the LV's monogram and decorative design;
 - (vii) a collaboration between Chanel and the singer Pharrell Williams referred to as 'Chanel-Pharrell';
 - (viii) a collaboration between the designer Jason Wu and the clothing company Eloquii referred as 'Jason Wu x Eloquii collection';
 - (ix) a collaboration between the fashion designer Michael Halpern and the clothing retailer Topshop.

The applicant's evidence

13. This comes from Lucy Kathryn Aboulian, who is the Head of Intellectual Property of the applicant. The purpose of Ms Aboulian's evidence is to establish that: a) the

applicant has marketed and promoted a CHANEL'S GABRIELLE bag prior to its application to register the mark; (b) Mlle Gabrielle Chanel is known in the UK as the founder of Chanel and (c) Chanel is a fashion brand with a global reputation.

14. Paragraphs 10, 18, 31 and 33 of Ms Aboulian's witness statement are the subject of an order for confidentiality. Accordingly, these parts of Ms Aboulian's evidence have been redacted from the public version of this decision with a full un-redacted copy being sent to the parties.

THE CHANEL'S GABRIELLE BAG

15. Ms Aboulian states that the applicant launched its CHANEL'S GABRIELLE bag in the UK in March 2017. The launch campaign featured four celebrity campaign ambassadors. Adverts were placed on a number of magazines including Elle, Marie Claire, Red, Tatler, Conde Nast Traveller, Vanity Fair, Vogue and Glamour. The examples provided feature use of both the mark CHANEL'S GABRIELLE (Exhibits LKA1-2) and the signature of Gabrielle Chanel (Exhibits LKA6-7). According to Ms Aboulian, in 2017 Chanel invested more than [REDACTED] in promoting the CHANEL'S GABRIELLE bag and the sales figure exceed [REDACTED] over the period March 2017 - January 2018. The CHANEL'S GABRIELLE bag was also actively promoted through the applicant's social media with the social media engagement being as follows: 7.6 million of people reached (size of the audience), 39 million impressions (or views) and 35,000 engagements (number of times consumers have actively interacted with a post).

THE DEGREE OF PUBLIC AWARENESS OF GABRIELLE CHANEL AS THE FOUNDER OF CHANEL

16. Ms Aboulian says that whilst the applicant acknowledges that consumers and media refer to Mlle Gabrielle Chanel as 'Coco Chanel', she is also known and referred to as 'Gabrielle Chanel' or 'Gabrielle Coco Chanel' and the applicant ensures that she is primarily referred to as 'Gabrielle Chanel' in promotional material. For the purpose of this first contention, she refers to:

- Clipping from Chanel's website and posts from Chanel's Facebook page dated between 2012 and 2017 in which the founder of Chanel is referred to as 'Chanel Gabrielle' (Exhibit LKA3);
- Press clipping which make references to 'Gabrielle Coco Chanel' and 'Gabrielle Chanel', including an article from The Sunday Telegraph (2005)¹ (Exhibit LKA9);
- Various books and films produced in the UK prior to the relevant date about 'Coco Chanel'. Notably, all of the films and books listed refer, in their title, to 'Coco' and 'Chanel' or 'Coco Chanel' though, it is said, they also make reference to Gabrielle Chanel's full name (Exhibits LKA11-13);
- Three web-based documentaries created by Chanel about Mlle Gabrielle Chanel's life. The documentaries were published on YouTube and released in 2014 ("Inside Chanel") and in February and May 2017 ("Chapter 18 Gabrielle a Rebel at Heart" and "Chapter 20 Gabrielle the Queen of Freedom") in coincidence with the launch of the CHANEL'S GABRIELLE bag (in March 2017) and the GABRIELLE CHANEL fragrance (in July 2017). They were viewed nearly 10 million times (Exhibit LKA4-5);

THE REPUTATION OF CHANEL

17. The rest of the evidence focuses on the reputation of Chanel as one of the world leading fashion house, with a global revenue of \$9.6 bn for 2017. Historically, Chanel has enjoyed considerable commercial success in the UK since the 1920's and its trade mark CHANEL has been used in the UK in relation to eyewear and jewellery and leather goods, including bags, since 1990 and 1980, respectively. Chanel operates in the context of a selective distribution network and has 8 fashion boutiques in the UK. It only sells its bags and jewellery via its own boutiques.

18. The approximate UK trade value of sales of fashion items including eyewear and costume jewellery bearing the trade mark CHANEL in the period 2012-2017 was between [REDACTED] and [REDACTED] per annum. The annual UK sales of all CHANEL watches and fine jewellery was between [REDACTED] and [REDACTED]

¹ Other articles are undated, or it is not possible to identify the magazine where they were published

per annum. UK advertising and promotional expenditure for the period 2012-2017 in relation to CHANEL eyewear, jewellery, watches and handbags was between [REDACTED] and [REDACTED] per annum. A selection of advertisements, press clippings, editorials and posts from social media, the majority of which are said to relate to the UK, is at Exhibits LKA15-LKA19.

DECISION

19. Section 5(2)(b) of the Act is as follows:

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

(a)

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

20. The following principles are gleaned from the decisions of the CJEU 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.

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to

make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

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

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

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

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

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

Comparison of goods

21. In the judgment of the Court of Justice of the European Union (CJEU) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

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

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

23. In *Kurt Hesse v OHIM* (Case C-50/15 P), the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity

between goods. In *Boston Scientific Ltd v OHIM*, (Case T-325/06), the General Court (GC) stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

24. The parties’ respective goods are:

The applicant’s goods	The opponent’s goods
<p><u>Class 9</u>: sunglasses, and sunglasses frames and lenses.</p> <p><u>Class 14</u>: jewellery; charms; cufflinks; decorative pins; tie pins; brooches; medallions.</p> <p><u>Class 18</u>: handbags; vanity cases (not fitted), briefcases, articles of luggage, wallets, purses (not of precious metal or coated therewith), leather shoulder belts; bags; sporrans; credit card holders; card holders; key holders.</p>	<p><u>Class 25</u>: Articles of clothing, robes, dresses, tunics, cardigans, leggings, scarves, belts, tutus, trousers, t-shirts and sweatshirts; headgear; footwear, boots, shoes, slippers, flip-flops and slides; jumpers, caps, hats, jumpsuits, shorts, tights, skirts, swimsuits, lingerie.</p>

25. At paragraph 10 of his skeleton arguments, Mr Brandreth stated:

“It is accepted, on the basis of authority, that there can be a low level of similarity between class 25 goods and the class 18 goods that arises from the fact they are sometimes sold in similar outlets, made of the same materials, and have an aesthetic function that may be related for certain consumers who look for common design. [...] That similarity is limited, however, by the distinctions of nature, primary purpose, method of use that exist in every case [...] Similar reasoning leads to the acceptance that “cufflinks” in class 14 have a low level of similarity. No such authority compels the same conclusion in respect of the

class 9 and the rest of the class 14 goods. To the contrary, the authorities indicate that it is necessary to establish that the average consumer considers that it is usual for these goods to be sold or distributed by the same undertaking and that proposition is not clear on the evidence or, we submit, correct”.

26. Citing the relevant case-law, including *El Corte Ingles*, Case T-443/05, which established that there is a degree of similarity between clothing (in class 25) and clothing accessories made of leather and imitations of leather (in class 18), Mr Brandreth made the following submissions at the hearing:

- The class 18 and 25 goods cannot be treated as dissimilar, but that does not mean that they are anything more than similar to a low degree;
- The applicant accepts that the reasoning in class 18 must apply to cufflinks in class 14 which should also be considered to be similar to a low degree;
- The remaining goods in class 9 and 14 should be treated as dissimilar because, even if they were held to have the relevant kind of aesthetic complementarity, it has not been shown that those goods are regularly produced by the same undertakings.

27. Ms Michael submitted that the degree of similarity with the applicant's goods in class 18 is higher, i.e. medium, that Mr Brandreth's concession as regards the degree of similarity with cufflinks should extend to tie pins and that there is a degree of similarity with the contested goods in class 9 and 14. She quoted the following passage from Case T-39/10, *El Corte Inglés v OHMI - Pucci International (PUCCI)*:

“78. In the present case, some consumers will perceive a close connection between men's clothing and footwear in Class 25 and covered by the earlier mark, and shoulder bags, attache-cases, briefcases, pouches, pocket wallets, purses, key-holders and card holders (Class 18 and covered by the mark applied for), and may therefore be led to believe that the same undertaking is responsible for the production of those goods. Therefore, as the applicant argues, the goods designated by the earlier mark and falling within class 25 show a degree of similarity with those goods in Class 18 and covered by the

mark applied for which cannot be classified as slight (see, to that effect, *PiraÑAM diseño original Juan Bolaños*, paragraph 76 above, paragraph 51).”(emphasis added)

28. I do not agree with Ms Michael that the expression “*show a degree of similarity [...] which cannot be classified as slight*” can be read as meaning that there is a medium degree of similarity between goods in class 18 and 25. In my view, what the court actually meant was a degree of similarity much closer to “low” than “medium”².

29. Taking all of the above into account, I conclude that:

- i. the applicant’s *handbags; vanity cases (not fitted), briefcases, articles of luggage, wallets, purses (not of precious metal or coated therewith), leather shoulder belts; bags; sporrans; credit card holders; card holders; key holders* (in class 18) are similar to a low degree to the opponent’s *clothing* (in class 25);
- ii. given Mr Brandreth’s concessions, the same conclusion extends to the applicant’s *cufflinks* (class 14) which are also similar to a low degree to the opponent’s *clothing*. The same goes for the applicant’s *tie pins* (class 14) because both cufflinks and tie pins are fashion accessories with a fastening function for specific types of garments, i.e. they serve to secure shirt cuffs together and hold the ends of a necktie in place, respectively. Further, in my experience, the goods can be sold in sets.

30. As regards the other goods in the application, namely *jewellery; charms; decorative pins; brooches; medallions* (class 14) and *sunglasses, sunglasses frames and lenses* (class 9), Ms Michael’s contention was that the fact that the applicant sells clothing as well as sunglasses and jewellery supports the conclusion that the goods are similar. The GC rejected a similar argument in *Compagnie des montres Longines, Francillon SA v OHIM*, Case T-505/12:

² See also T-443/05 at § 46 and § 47, where the court itself describe the degree of similarity between goods in class 18 and 25 as slight (not medium or average).

“46. In that regard, it must be stated at the outset that the goods which have to be compared in the present case, namely, on the one hand, the ‘optical sunglasses’ and ‘clothing and footwear’ in, respectively, Classes 9 and 25 of the Nice Agreement and, secondly, the various horological and jewellery goods, listed in paragraph 6 above, in Class 14 of that agreement, belong to adjacent market segments.

47. It may also be stated, by analogy with what the Court held in the context of an assessment relating to Article 8(5) of Regulation No 207/2009 in the case which gave rise to the judgment of 27 September 2012 in *El Corte Inglés v OHIM — Pucci International (Emidio Tucci)*, T-373/09, EU:T:2012:500, paragraph 66, that, even though those categories of goods are different, each of them includes goods which are often sold as luxury goods under the famous trade marks of renowned designers and manufacturers. That fact shows that there is a certain proximity between the goods at issue, in particular in the luxury goods sector.

48. Likewise, the Court held, still in the context of an assessment relating to the provision referred to in paragraph 47 above, in paragraph 79 of its judgment of 27 September 2012 in *Pucci International v OHIM — El Corte Inglés (Emidio Tucci)*, T-357/09, EU:T:2012:499, that, in the luxury items sector, goods like glasses, jewellery and watches are also sold under the famous trade marks of renowned designers and manufacturers and that clothing manufacturers are therefore turning towards the market for those goods. The Court deduced from that there was a certain proximity between the goods at issue.

49. However, notwithstanding the fact that the goods covered by the trade mark application and those protected by the earlier mark, which are referred to in paragraph 46 above, belong to adjacent market segments, it must, in the first place, be held that the Board of Appeal did not err in stating that they differed in their nature, their intended purpose and their method of use.

50. First, the raw materials from which they are manufactured are different, except for some similarities between certain materials which may be used both

in the manufacture of optical sunglasses and for certain horological goods or jewellery, such as glass.

51. Secondly, clothing and footwear in Class 25 are manufactured to cover, conceal, protect and adorn the human body. Optical sunglasses are above all produced to make it easier to see, to provide users with a feeling of comfort in certain meteorological conditions and, in particular, to protect their eyes from rays of sunlight. Watches and other horological goods are designed, inter alia, to measure and indicate the time. Lastly, jewellery has a purely ornamental function (see, to that effect, judgment in *nollie*, cited in paragraph 41 above, EU:T:2010:114, paragraph 33 and the case-law cited).

52. In the second place, it must be pointed out that as the nature, intended purpose and method of use of the goods at issue are different, they are neither in competition with each other nor interchangeable.

53. The applicant has not shown that it is typical, notwithstanding the abovementioned differences, for a consumer who, for example, intends to buy himself a new watch or some jewellery, to decide, suddenly, to buy himself, on the contrary, clothing, footwear or optical sunglasses, and vice versa.

54. In that regard, in particular, it must also be stated that the applicant has not proved its claim that, in the luxury and fashion sector, it is generally the trade mark and its prestige among consumers that motivate the consumer's decision to purchase a specific item and not the actual necessity to purchase that item, inter alia for its functionalities and to fulfil a very specific need. Likewise, it is necessary to reject as not proved the applicant's claim that, as the appearance and value of the goods prevail over other factors relating to their nature, consumers in the sector concerned are principally in search not of specific goods, but of satisfaction for their 'hedonistic needs' or that they seek the instant gratification generated by an impulse purchase.

55. Moreover, it must be stated that to accept that such claims are well-founded would be tantamount, in essence, to rendering irrelevant any differentiation

between goods which belong to the luxury sector and are protected by the respective marks, since the applicant's theory relating to the impulse purchase aimed at the instant gratification of consumers leads to the conclusion that a likelihood of confusion may actually exist irrespective of the goods concerned, on the sole condition that they all fall within that sector. Such an approach, by which the applicant in actual fact alleges that all the goods at issue are interchangeable, is manifestly contrary to the principle of speciality of marks which the Court must take into account in its analysis in accordance with Article 8(1)(b) of Regulation No 207/2009 and would improperly extend the area of protection of trade marks. For the same reasons, it is necessary to reject as irrelevant the applicant's claim that the goods are interchangeable inasmuch as each of them may be given as a gift and the consumer impulsively chooses one or other of them. To accept such a vague connection would lead to holding that goods which are manifestly different in their nature and intended purpose are similar.

56. What is more, it must be stated that the relevant market within which the abovementioned goods fall cannot be limited to the 'luxury' or 'haute couture' market segment alone and that specific significance cannot, in addition, be attributed to that market segment in the present case, since the categories of goods protected by the marks at issue are defined in a manner which is sufficiently broad to include both 'consumer' goods falling within a generally affordable price range and certain 'inexpensive' goods. The applicant has not claimed, in relation to the 'basic' goods falling within those market segments, that they are also purchased by consumers acting in an impulsive and hedonistic manner, with the result that those consumers may indiscriminately replace some goods with others.

57. In the third place, it must be pointed out that, by its other arguments, the applicant attempts, in essence, to establish a complementary connection between the goods at issue.

58. It must be borne in mind that, in accordance with the case-law, complementary goods or services are those which are closely connected in the

sense that one is indispensable or important for the use of the other in such a way that consumers may think that the same undertaking is responsible for manufacturing those goods or for providing those services. By definition, goods intended for different publics cannot be complementary (see, to that effect, judgment in *Emidio Tucci*, cited in paragraph 48 above, EU:T:2012:499, paragraph 50 and the case-law cited).

59. Furthermore, according to the case-law, aesthetic complementarity between goods may give rise to a degree of similarity for the purposes of Article 8(1)(b) of Regulation No 207/2009. Such aesthetic complementarity must involve a genuine aesthetic necessity, in the sense that one product is indispensable or important for the use of the other and consumers consider it ordinary and natural to use those products together. That aesthetic complementarity is subjective and is determined by the habits and preferences of consumers, to which producers' marketing strategies or even simple fashion trends may give rise (see judgment in *Emidio Tucci*, cited in paragraph 48 above, EU:T:2012:499, paragraph 51 and the case-law cited).

60 However, it is important to point out that the mere existence of aesthetic complementarity between the goods is not sufficient to conclude that there is a similarity between them. For that, the consumers must consider it usual that the goods are sold under the same trade mark, which normally implies that a large number of the producers or distributors of the goods are the same (see judgment in *Emidio Tucci*, cited in paragraph 48 above, EU:T:2012:499, paragraph 52 and the case-law cited)."

31. Lastly, Ms Michael brought to my attention two decisions of the Registry namely BL-O-501-13 *100% Capri* and BL-O-465-13 *Little Mix*, in which it was found that sunglasses in class 9 and jewellery in class 14 were similar to clothing in class 25.

32. Whilst I recognise the importance of consistent criteria being applied to similar issues in opposition proceedings, the decisions to which Ms Michael referred are not binding upon me and were issued in 2013, two year before the GC issued its judgement in T-505/12 (in 2015), so they appear now to be effectively superseded by

the GC's decision. Accordingly, I conclude that with the exception of *cufflinks* and *tie pins*, the opposed goods in class 9 and 14 are dissimilar.

The average consumer and the nature of the purchasing act

33. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which these goods are likely to be selected by the average consumer. 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".

34. The average consumer for the respective goods in class 14, 18 and 25 is composed of the general public who will pay a normal degree of attention when selecting the goods. The goods will be obtained by self-selection from a retail outlet or online or catalogue equivalent. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there will also be an aural component to the purchase of the goods, bearing in mind that advice may be sought from a sales assistant.

Comparison of the trade marks

35. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall

impressions created by the trade marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“CJEU”) stated, at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

36. 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. The respective trade marks are shown below:

The applicant’s mark	The opponent’s mark
CHANEL’S GABRIELLE	GABRIELLE

37. The opponent’s mark consists of the word GABRIELLE. There are no other elements to contribute to the overall impression of the mark, which lies in the word itself.

38. The applicant’s mark consists of possessive form of the word CHANEL and the word GABRIELLE. The presence of the apostrophe and the letter S creates a message that the second element, GABRIELLE, is something that is possessed by CHANEL with both elements making a roughly equal contribution to the overall impression of the mark.

39. At paragraph 7 of his skeleton arguments, Mr Brandreth submitted that *“account should also be taken of the fact that the element CHANEL’S calls out to the distinctive surname that is the brand of the world-famous fashion house, yet this reference is totally absent from the conceptual message of the earlier mark”*. Ms Michael expressly took issue with this submission stating that the reputation of the earlier mark should play no part in the comparison of the signs. In this connection, there was some discussion at the hearing as to who was the relevant authority for the purpose of establishing the proposition advanced by Ms Michael. Mr Brandreth did not object to Ms Michael sending a copy of the relevant authority after the hearing, which I allowed. I was later referred to Case C-552/09, *Ferrero v OHIM* [2011] ETMR 30, and Case T-215/17 *Pear Technologies* [2019] ETMR 26. The paragraph upon which Ms Michael relied reads as follows: *“The reputation and the distinctive character of the earlier mark constitute relevant factors for the purpose of assessing, not whether the marks at issue are similar, but whether the relevant section of the public makes a link between them”*. These comments were made in the context of the Court ruling out that a minimal degree of similarity between the signs cannot be offset by the reputation of the earlier mark.

40. The fact that the reputation of a sign cannot assist where there a number of differences in the signs which preclude the signs from being perceived as similar does not mean that I should ignore the applicant’s reputation when assessing (not whether the signs are similar but rather) how the element CHANEL in the applicant’s mark is likely to be viewed by the relevant public. In any event, Ms Michael herself accepted that CHANEL is a famous fashion house and stated that *“whether or not a consumer is familiar with the name Chanel, it will be seen as the/a house mark possessing Gabrielle³”*. Accordingly, I conclude that:

- a large group of consumers of the applicant’s fashion accessories in classes 14 and 18 will recognise Chanel as the name of the renowned fashion house;
- consumers who are familiar with Chanel are also likely to know that Chanel trades under the name of its founder. In this connection, whilst there is some evidence of marketing and promotional material which show that the applicant

³ §20 of skeleton argument

has taken steps to educate consumers that Gabrielle Chanel is the real name of the founder of Chanel, such material is relatively recent and it clear that the applicant has traded for many years under the mark CHANEL or COCO CHANEL (without the addition of the name GABRIELLE) and that Coco Chanel is the iconic name by which the founder of Chanel is best known. Although some people may know that Gabrielle was the first name of Mlle. Chanel, it is not enough to impute such knowledge to all (or most) average consumers;

- consumers who are familiar with Chanel will perceive CHANEL as the house mark. The presence of the apostrophe and genitive letter 'S' is likely to result in the personal name GABRIELLE being seen as a secondary indication of origin and being taken as, for example, a brand or product name of CHANEL. This, in my view, carries the corollary that GABRIELLE performs an independent distinctive role in the context of the applicant's mark.

Visual, aural and conceptual similarity

41. Mr Brandreth submitted that the signs are visually and aurally similar to a very low degree. He said that the differentiating element CHANEL'S appears at the beginning of the applicant's mark and referred to the case-law that the beginnings of marks are generally more focused upon. Ms Michael submitted that the visual and phonetic similarity between the marks is no different from the position which pertained in BL-O-646-17 where the Hearing Officer found that there was a medium degree of visual and aural similarity between the signs GABRIELLE and GABRIELLE CHANEL. I agree with Ms Michael that the presence in both marks of the identical name GABRIELLE gives rise to a medium degree of visual and aural similarity.

42. Conceptually, Ms Michael argued that the average consumer is likely to see CHANEL'S GABRIELLE *"as a reference to someone (or perhaps something) called Gabrielle who (or which) belongs to Chanel, whether Chanel is recognised as a name or seen as an invented word mark"* and that *"the marks are conceptually similar to some degree, or at worst, conceptually neutral"*. At the hearing Ms Michael also said that the element CHANEL'S adds an indication that *"this is a particular version of GABRIELLE", but it does not detract completely from the conceptual similarity"*.

43. At paragraph 7 of his skeleton arguments, Mr Brandreth stated that *“the mere fact that two marks are both perceived by the average consumers as containing names is not, in itself, enough to create a conceptual similarity. Something more is needed, such as that they are perceived to refer to the same person or creator. However, the first name element does not do that, since many people may be called Gabrielle, and nothing suggests there is the same reference point called out to in both signs. Moreover, again, the possessive predecessor element CHANEL’S fundamentally alters the message of the sign as a whole. There is no part of the Earlier Mark that carries the conceptual message this is CHANEL’S Gabrielle [...]”* He also relied on two cases for the proposition that the presence of a common forename does not create a conceptual connection. In particular he referred me to T-557/10, *H.Eich Srl v OHIM*, in which it was held that there was no likelihood of confusion between H SILVIAN HEACH (stylised) and h.eich and T-502/07 *IIC - Intersport International Corp. GmbH v OHIM*, in which it was held that McKinley and McKenzie (stylised) were not confusingly similar. However, these cases involve a clash between marks incorporating different names, so the analogy is not relevant.

44. I agree with Ms Michael that the fact that both marks contain the element GABRIELLE gives rise to a degree of conceptual similarity. In *SANDRA Trade Mark*, BL-O-276-18, Miss Emma Himsworth QC, sitting as the Appointed Person, considered the question of the conceptual similarity of trade marks incorporating names. She stated:

“27. The EU courts have accepted that names may have a concept. Therefore, to the extent that the Hearing Officer proceeded with an analysis of conceptual similarity on the basis that the marks in issue were names he was in my view correct to do so.

28. It is also clear that the mere fact that the marks the subject of the comparison can be grouped under a common generic term of ‘names’ does not automatically lead to a finding of conceptual similarity. This is well illustrated by the examples given in Part C, Section 2, Chapter 4 Comparison of Signs of the Guidelines for Examination of European Trade Marks issued by the EUIPO on 1 October 2017 where the names FRANK and MIKE are identified as being

names which would not lead to a finding of conceptual similarity because the public is not likely to make a conceptual link between the two words; whereas the contrary is the case where the names in issue are FRANK and FRANKIE one being a different version of the other such that the public is likely to make a conceptual link.”

45. It is common ground that the identical element GABRIELLE will be recognised by the average consumer as being a female forename. To the extent that it will be perceived by the average consumer as being associated with a woman bearing the same name, the element GABRIELLE carries the same conceptual significance in each mark. Further, I have already dismissed the applicant’s argument that GABRIELLE in CHANEL’S GABRIELLE will be widely understood as a reference to the real name of the founder of Chanel. Consequently, the case is not comparable to that in BL-O-646-17, in so far as the Hearing Officer compared a name, i.e. GABRIELLE, and a full name, i.e. GABRIELLE CHANEL. The fact that the contested mark also conveys the additional concept that GABRIELLE belongs to CHANEL does not remove the conceptual similarity of the marks at issue and the extent of the applicant’s popularity in the UK does not detract from that conceptual similarity. I find that the marks are conceptually similar to a medium degree.

Distinctive character of the earlier mark

46. 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-2779, 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 promotion of 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).”

47. At the hearing Ms Michael confirmed that no enhanced distinctiveness is claimed for the earlier mark. As regards the inherent position, Ms Michael stated:

“The submissions in Opposition 408705 and Mr Morris’s findings are relevant to this extent: what is the impact of GABRIELLE upon the average consumer? Chanel argued before Mr Morris that Gabrielle was an “exotic” forename and would not necessarily be recognised as such by the average member of the public (see paragraph [37] of the Decision). Mr Morris found at paragraph [39] that the name is not uncommon or unusual. In the last sentence of paragraph [41] he found that GABRIELLE has a moderate (between low and medium) level of inherent distinctiveness. The Opponent does not seek to dispute those findings, but on the contrary relies upon them. Chanel’s current argument [...], that GABRIELLE will be perceived as a forename with a low degree of inherent distinctiveness, cannot be sustained. Plainly, it has a moderate or average level of inherent distinctiveness.”

48. At the hearing, Mr Brandreth pointed out that the finding of the Hearing Officer in BL-O-646-17 that GABRIELLE has a moderate degree of inherent distinctive character, did not equate to a finding that it has a medium degree of distinctiveness because the Hearing Officer clearly explained that his understanding of “moderate level of distinctiveness” was more than low but less than medium. He also stated that the moderate level of distinctiveness of the earlier mark was “*closer to the lower end*

than to the medium end” but he was content with moderate, somewhere in between the two.

49. So, whilst both Ms Michael and Mr Brandreth were content to rely on the Hearing Officer’s finding that GABRIELLE was distinctive to a moderate degree, they obviously gave different interpretations of what “*moderate*” meant in the context of that decision. I also bear in mind what Hearing Officer said in his decision:

“Whilst [the ONS statistics] do not suggest a name that is highly popular, neither do they suggest a name that is particularly unusual. [...] Whilst names are, in most cases, perfectly registrable as trade marks, they often do not make for the most distinctive of marks, although, this of course depends on the name itself. [...] From that perspective, given what I have said about names generally, I consider that the common element has a moderate (between low and medium) level of inherent distinctiveness”.

50. The ONS statistics to which the Hearing Officer referred showed that in 2015 just under 4 girls out of 10,000 were named Gabrielle. Notably, this evidence was presented by Chanel (i.e. the applicant in this case), who then argued (as the opponent in that case) that the name GABRIELLE was unusual. However, the Hearing Officer found that GABRIELLE was neither particularly unusual nor particularly popular and explained that there was another factor which he considered, namely that names often do not make for the most distinctive of marks.

51. Having considered the above, I am not persuaded that the degree of distinctiveness of GABRIELLE is at the lowest end of the scale or that this is what the Hearing Officer meant. If anything, given that the Hearing Officer found that Gabrielle was neither particularly common nor particularly rare in the UK, he cannot reasonably be supposed to have meant something closer to low than medium. In any event, the Hearing Officer’s finding is not binding upon me. I therefore reject the submission that the average consumer would attribute a low (or materially lower than medium) level of distinctiveness to GABRIELLE just because it is a name. In my view, the opponent’s mark is distinctive to a medium degree.

Likelihood of confusion

52. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and vice versa. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has retained in his mind.

53. The thrust of the opponent's case is that there is indirect confusion⁴. Indirect confusion was explained in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, by Mr Iain Purvis Q.C., sitting as the Appointed Person:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

⁴ Ms Michael accepted at the hearing that the opponent was not arguing direct confusion

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

54. In her skeleton arguments, Ms Michael relied on the case-law relating to composite signs⁵, the so-called *Medion* case, and the type of confusion identified by it. She also referred to *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), in which Arnold J. considered the impact of the CJEU’s judgment in *Bimbo*, Case C-591/12P, on the court’s earlier judgment in *Medion*. The following passages are relevant:

“18. The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19. The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the

⁵ Case C-120/04 *Medion* [2005] ECR I-8551

average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20. The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

55. Ms Michael also submitted that the distinctiveness of the element CHANEL in the applicant’s mark will not preclude confusion. She further relied on *ANGEL’S ENVY*, BL-O-334/18, in which Mr Thomas Mitcheson QC, sitting as the Appointed Person, upheld the Hearing Officer’s decision that there was a likelihood of indirect confusion between ENVY and ANGEL’S ENVY. He stated:

“37. [...] The mere presence within a composite mark of a separate word with some or even dominant distinctiveness does not mean that the *Medion* principle should be automatically disapplied – otherwise it would rarely come in to play at all. As the CJEU explained in *Bimbo* at §32, a finding that there is a likelihood of confusion should not be subject to the condition that the overall impression produced by the composite sign be dominated by the part of it which is represented by the earlier mark. It suffices that the earlier mark still has

sufficient independent distinctive role for confusion as to origin to arise (*Bimbo*, §36). Thus, it is all a matter of fact and degree as to whether the average consumer would perceive the composite mark as a unit having a different meaning to the meaning of the separate components or whether the part in common between the marks had distinctive significance independently of the whole.”

56. At the hearing Ms Michael’s developed the collaboration argument as follows. She argued that CHANEL’S GABRIELLE could be seen as a collaboration between the owner of the brand CHANEL and the owner of the brand GABRIELLE. She contended that, if the average consumer were to see, for example, the mark CHANEL’S CHLOE, CHLOE being (I was told) a well-known brand in the fashion industry, he would think that there is some sort of collaboration between those two fashion houses. Addressing the argument that a collaboration between CHANEL and GABRIELLE would be more likely to result in CHANEL FOR GABRIELLE or GABRIELLE FOR CHANEL rather than in the contested CHANEL’S GABRIELLE, Ms Michael argued that it is unrealistic to expect the average consumer to be able to distinguish between a collaboration in the form of CHANEL FOR GABRIELLE and the contested CHANEL’S GABRIELLE.

57. Mr Brandreth argued that given that the goods are similar only to a low degree and the marks are conceptually distinct, there cannot be either direct or indirect confusion. Citing the categories of indirect confusion set out by Mr Purvis, he argued that it is unlikely that CHANEL’S GABRIELLE will be seen as a brand extension of GABRIELLE, because the additional element is strikingly distinctive as a result of the vast reputation of CHANEL and the mark conveys the message that GABRIELLE is a brand of CHANEL, not a diffusion of the opponent’s GABRIELLE. Mr Brandreth also relied on *The Cheeky Indian*, BL-O-219/16, in which James Mellor QC, sitting as the Appointed Person, stated:

“[...] there are one or two points to add to Mr Purvis’ explanation:

16.1. First, a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion. It should be

kept in mind that the differences which mean that one mark would not be mistaken for the other might well dispel indirect confusion as well.

16.2. Second, if (as here) the differences between the marks are such that there is no likelihood of direct confusion, one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion. This is what Mr Purvis was pointing out in those paragraphs in *LA Sugar*.

16.3. Third, when making a finding of a likelihood of indirect confusion, in my view it is necessary to be specific as to the mental process involved on the part of the average consumer. Whilst the categories of case where indirect confusion may be found is not closed, Mr Purvis' three categories are distinct, each reflecting a slightly different thought process on the part of the average consumer."

58. I shall now draw my conclusions on the question of the likelihood of indirect confusion.

59. Earlier in my decision I found that some of the opposed goods are similar to a low degree and others are dissimilar. The average consumer will select the goods visually with a normal degree of attention, although I do not ignore aural considerations. The marks are visually, aurally and conceptually similar to a medium degree. The earlier mark is the single word GABRIELLE and is distinctive to a medium degree. The element CHANEL in the contested mark will be recognised by most consumers as a reference to Chanel, the renowned fashion house, and the significance of CHANEL'S GABRIELLE as whole, will be that of GABRIELLE belonging to CHANEL with GABRIELLE performing an independent distinctive role within the mark.

60. I agree with Mr Brandreth that the mark CHANEL'S GABRIELLE does not involve a combination which is likely to be seen by the average consumer as signifying a collaboration or tie-up of some kind between CHANEL and GABRIELLE. Although the word GABRIELLE is registered as a trade mark and has a medium degree of distinctive character, it is a forename and there is no evidence that the opponent has become recognised by the name GABRIELLE. Further, none of the forms in which co-

branding is presented in the opponent's evidence - namely (1) the format "brand X brand", i.e. "Kenzo x H&M", (2) the format "brand BY brand", i.e. "Fiat 500 by Gucci", (3) the format "brand-brand", i.e. "Chanel-Pharrell", or (4) the format involving multiple brand names, logos or decorative patterns jointly used on a single product, i.e. Louis Vuitton/Supreme, Dolce & Gabban/Smeg - support the opponent's claim that the average consumer is likely to regard the combination CHANEL'S GABRIELLE as co-branding. In my view, the average consumer is more likely to assume that the element GABRIELLE in the applicant's mark is a secondary indication of origin and perceive it as an in-house brand.

61. Albeit I have rejected the co-branding argument, that is not the end of the matter. The sign GABRIELLE is sufficiently distinctive to retain a distinctive role independent of CHANEL'S. Further, although a mark consisting of a first name has a different function than a full name as such, which identifies a specific person, it still enables the average consumer to distinguish the goods covered by the mark containing that first name from those which have a different commercial origin⁶. I have therefore considered whether another type of confusion could arise.

62. It is true that the applicant's CHANEL brand is a famous one in the fashion industry. However, I do not accept the applicant's reasoning that there is no likelihood of indirect confusion between the signs GABRIELLE and CHANEL'S GABRIELLE simply because the element CHANEL, which is strikingly distinctive, is not present in the earlier mark. Neither do I accept that confusion cannot arise because, in a realistic scenario, consumers will scrutinise the goods before they make a purchase and will realise, from the garment labels on clothing, that the opponent's products sold under the mark GABRIELLE do not originate from CHANEL. The question I must address is whether the average consumer is likely to be confused based on the overall impression given by the signs in normal and fair use in relation to similar goods, not after checking the facts for himself. If that was the approach to be taken, there would rarely be confusion.

⁶ *Harrys Pubar v OHMI - Harry's New York Bar (HARRY'S BAR) T-711/13* at paragraph 97

63. I also consider that, according to the case law on genuine use, a trade mark can be used either independently of any other mark or jointly with other marks⁷. Consequently, when a trader uses a sub-brand, it can use it jointly and autonomously, with or without the name of the manufacturer's company. Furthermore, it is fair to consider the applicant's goods absent the context of the applicant's CHANEL boutiques, even if this is the way the applicant currently trades. A consumer might see, for example, a picture of the opponent's goods sold under the mark GABRIELLE in advertising or on a billboard and assume that Chanel sometimes uses GABRIELLE with the house mark, and sometimes without it. In that event, consumers would be likely to think that the user of GABRIELLE and CHANEL'S GABRIELLE were one and the same undertaking, or economically related undertakings. Although that sort of confusion is, in a way, the wrong way round, in *Comic Enterprises*⁸ the Court of Appeal ruled that 'wrong way round confusion' can be relevant to establish whether there is a likelihood of confusion.

64. In my view, if GABRIELLE in CHANEL'S GABRIELLE is perceived as a sub-brand of CHANEL, there is a likelihood that consumers who see the mark GABRIELLE on similar goods, are likely to believe that it has some connection with CHANEL'S GABRIELLE. Even if the degree of similarity between the goods is low, given the sector in which the parties operate, i.e. the fashion industry, it is material and not sufficient to avoid confusion.

65. **There is a likelihood of indirect confusion.** For the avoidance of doubt, even if I had considered the earlier mark to be distinctive to a low to medium degree, I would have reached the same conclusions on the likelihood of confusion.

66. For there to be a likelihood of confusion under section 5(2)(b) of the Act, there must be some degree of similarity between the parties' respective goods⁹.

⁷ *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12

⁸ *Comic Enterprises v Twentieth Century Fox* [2014] EWHC 185 (Glee) at 75-84

⁹ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

67. The opposition under Section 5(2)(b) of the Act fails therefore in respect of *sunglasses, sunglasses frames and lenses* (in class 9) and *jewellery; charms; decorative pins; brooches; medallions* (in class 14) as these goods are dissimilar.

68. However, there is some tension between this conclusion and my earlier finding that *cufflinks* and *tie pins* are similar to the opponent's clothing. This is because, to my mind, cufflinks and tie pins are also items of jewellery since they are commonly made of the same materials and are purchased, not just for their functional purpose, but also, as an item of personal adornment. If I am right about that, any similarity with *cufflinks* and *tie pins* would extend to jewellery. The issue of partial refusal is dealt in TPN 1/2012. That TPN includes the following:

"In a case where amendment to the specification(s) of goods and/or services is required as the result of the outcome of contested proceedings the Hearing Officer will, where appropriate, adopt one or a combination of the following approaches:

a) Where the proceedings should only succeed in part, or where the proceedings are directed against only some of the goods/services covered by the trade mark and the result can be easily reflected through the simple deletion of the offending descriptions of goods/services, the Hearing Officer will take a "blue pencil" approach to remove the offending descriptions of goods/services.

....

b) Where the result cannot be easily reflected through simple deletion, but the Hearing Officer can clearly reflect the result by adding a "save for" type exclusion to the existing descriptions of goods/services, he or she will do so. This will not require the filing of a Form TM21 on the part of the owner. If, however, any rewording of the specification is proposed by the owner in order to overcome the objection, then the decision of the Hearing Officer will take that rewording into account subject to it being sanctioned by the Registrar as acceptable from a classification perspective:"

69. In those circumstances, the text I have highlighted above seems apposite and points towards limiting the applicant's specification as *jewellery save for cufflinks and tie pins*.

CONCLUSION

70. The opposition succeeds in relation to the following goods which, subject to appeal, will be refused registration:

Class 14: *cufflinks and tie pins*

Class 18: *handbags; vanity cases (not fitted), briefcases, articles of luggage, wallets, purses (not of precious metal or coated therewith), leather shoulder belts; bags; sporrans; credit card holders; card holders; key holders.*

71. The opposition fails in relation to the following goods which, subject to appeal, will proceed to registration:

Class 9: *sunglasses, sunglasses frames and lenses.*

Class 14: *jewellery save for cufflinks and tie pins; charms; decorative pins; brooches; medallions.*

72. The following goods were not opposed and will proceed to registration:

Class 9: *Optical apparatus and instruments; spectacles, eye glasses, field glasses, binoculars; cases, cords and chains for the aforesaid goods; spectacle; headphones; earphones; cases for headphones; anti-glare glasses and visors; contact lens cases; anti-theft apparatus for skis and ski equipment; clothing and gloves for protection against accidents; helmets; riding hats; goggles; personal safety alarms; fascias, cases, covers and carry bags for telephones and telecommunications apparatus and instruments; fascias, cases, covers and carry bags for computer apparatus and instruments; fascias, cases, covers and carry bags for electronic devices; battery power packs;*

mobile phone accessories; mobile telephone cards; downloadable ring tones and icons; machine readable mobile airtime vouchers; downloadable electronic publications; stands, holders and mounts for telephones, telecommunication apparatus and instruments, computer apparatus and instruments and electronic handheld devices; club cards, charge cards, payment cards, loyalty cards, debit cards, education and teaching apparatus and instruments; electronic teaching apparatus; electronic learning aids; apparatus for recording, transmission or reproduction of sound or images; equipment for information processing and computers; printed publications (downloadable) in electronically readable form; computer software; computer software applications for electronic devices; computer software applications for hand held mobile devices; mouse mats; CD Rom, DVD and digital optical discs; decorative magnets; smart phones in the shape of a watch; computer peripherals and accessories; memory apparatus, modules, cards, sticks and devices; flash drives; portable computer peripherals; personal digital assistants; multifunctional electronic devices for tracking and managing personal health and fitness information; films for covering and protecting surfaces of electronic devices; measuring tapes.

Class 14: *cases for jewellery and jewels; precious stones; precious metals; badges; medals; ornaments and ornamental figures; trophies; keyrings; horological and chronometric instruments; watches, clocks, watch bands, watch straps, watch bracelets; cases for watches and clocks; parts and fittings for all the aforesaid goods.*

Class 18: *Skins and hides; pocket wallets, umbrellas, parasols, make-up bags and cases; cloth pouches and sleeves; pet clothing; pet collars; dog leashes; riding whips; carrying cases; parts and fittings for the aforesaid goods.*

COSTS

73. Since each party has succeeded in part, I consider that each side should bear its own costs associated with this opposition.

Dated this 4th day of November 2019

T Perks

For the Registrar,

Comptroller-General

REDACTED

Annex

Class 9: Optical apparatus and instruments; spectacles, sunglasses, eye glasses, field glasses, binoculars; cases, cords and chains for the aforesaid goods; spectacle and sunglasses frames and lenses; headphones; earphones; cases for headphones; anti-glare glasses and visors; contact lens cases; anti-theft apparatus for skis and ski equipment; clothing and gloves for protection against accidents; helmets; riding hats; goggles; personal safety alarms; fascias, cases, covers and carry bags for telephones and telecommunications apparatus and instruments; fascias, cases, covers and carry bags for computer apparatus and instruments; fascias, cases, covers and carry bags for electronic devices; battery power packs; mobile phone accessories; mobile telephone cards; downloadable ring tones and icons; machine readable mobile airtime vouchers; downloadable electronic publications; stands, holders and mounts for telephones, telecommunication apparatus and instruments, computer apparatus and instruments and electronic handheld devices; club cards, charge cards, payment cards, loyalty cards, debit cards, education and teaching apparatus and instruments; electronic teaching apparatus; electronic learning aids; apparatus for recording, transmission or reproduction of sound or images; equipment for information processing and computers; printed publications (downloadable) in electronically readable form; computer software; computer software applications for electronic devices; computer software applications for hand held mobile devices; mouse mats; CD Rom, DVD and digital optical discs; decorative magnets; smart phones in the shape of a watch; computer peripherals and accessories; memory apparatus, modules, cards, sticks and devices; flash drives; portable computer peripherals; personal digital assistants; multifunctional electronic devices for tracking and managing personal health and fitness information; films for covering and protecting surfaces of electronic devices; measuring tapes.

Class 14: Jewellery; cases for jewellery and jewels; precious stones; precious metals; charms; cufflinks; decorative pins; tie pins; brooches; badges; medallions; medals; ornaments and ornamental figures; trophies; keyrings; horological and chronometric instruments; watches, clocks, watch bands, watch straps, watch

bracelets; cases for watches and clocks; parts and fittings for all the aforesaid goods.

Class 18: Skins and hides; handbags; pocket wallets, umbrellas, parasols, vanity cases (not fitted), briefcases, articles of luggage, wallets, purses (not of precious metal or coated therewith), leather shoulder belts; bags; sporrans; credit card holders; card holders; make-up bags and cases; cloth pouches and sleeves; key holders; pet clothing; pet collars; dog leashes; riding whips; carrying cases; parts and fittings for the aforesaid goods.

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