

O-314-07

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2412475
IN THE NAME OF LOIS LEVY**

AND

OPPOSITION THERETO UNDER NO. 94432 BY AMOR KG

TRADE MARKS ACT 1994

**IN THE MATTER OF application
No. 2412475 in the name of Lois Levy
and opposition thereto under No. 94432
by Amor KG.**

Background

1. Application No. 2412475 was applied for on 31 January 2006 and stands in the name of Lois Levy. The application is for the following trade mark:



and registration is sought in respect of: *Jewellery, costume jewellery* in Class 14.

2. On 21 June 2006, Notice of Opposition was filed on behalf of AMOR KG. There is a single ground of opposition, under Section 5(2)(b) of the Act, based on the opponent's Community Trade Mark No. 3457934.

3. The applicant filed a counter-statement essentially denying the grounds of opposition. Both parties filed evidence and indicated their preference for a decision from the papers without recourse to a hearing. The opponent filed written submissions. After a careful study of all the papers, I give this decision.

Opponent's evidence

4. This is a witness statement of Christopher James Benson and is dated 30 January 2007. Mr Benson states that he is a solicitor employed by Taylor Wessing, the opponent's professional representatives and that he is authorised to make the statement in connection with the opposition.

5. At CJB 1, Mr Benson exhibits a printout from the Community Trade Marks Office website showing details the Community trade mark relied on by the opponent in these proceedings. The remainder of Mr Benson's witness statement is given over to submissions on the likelihood of confusion between the parties' respective marks which I do not intend to summarise as it is not evidence of fact, though I take it into account as necessary in reaching my decision.

Applicant's evidence

6. This is a witness statement dated 25 April 2007 by Lynn Sheree Harris, a trade mark attorney employed by Scott & York Intellectual Property Limited, the applicant's professional representatives. Ms Harris states that she is authorised to make the statement on behalf of the applicant and that the information comes from her own knowledge or from the records of the applicant unless otherwise indicated. Again, much of Ms Harris' witness statement is given over to submissions which I do not intend to summarise but take into account as appropriate.

7. Ms Harris states that the applicant has been using her mark on jewellery and accessories since April 2002. The applicant is a director of XS Baggage Limited which was formed on 8 April 2002. At LSH 1 Ms Harris exhibits a copy of a printout from the Companies House website showing the company's details. Ms Harris states that the applicant has made and sold jewellery under the DIVINE mark both in her own and her company's name, through her shop in Exeter. Since 2002 she has also exhibited at retail shows around the country, such as at the Devon County Show from 2002 onwards. The applicant does not sell her goods through third parties.

8. Ms Harris states that "Since 2002 through 2006" the turnover of goods sold under the mark has been around £20,000 per year. No further details are provided. At LSH 2 Ms Harris exhibits sample invoices from June 2002 to April 2003 which she says relate to goods purchased by the applicant under her company name and which were to be sold on under the trade mark in suit. No evidence has been provided to show any sales as having been made. There are no invoices or other evidence to show what goods, if any, may have been sold under the trade mark.

9. At LSH 3 Ms Harris exhibits a copy of the home page of the applicant's website. I note that the printout is dated as being downloaded on 25 April 2007, well after the relevant date in these proceedings. Goods are said to have been sold throughout the southern and western regions of England and in Wales but no specific details are provided.

10. Ms Harris states that at no time since the applicant adopted her trade mark has any other party interfered with or hindered its use and that she is not aware of any instances of confusion having occurred.

11. No further evidence was filed by either party.

Decision

12. The opposition is based on an objection under Section 5(2)(b) of the Act which states:

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

(a)

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

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

13. The term “earlier trade mark” is defined in section 6 of the Act as follows:

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

- (a) a registered trade mark, international trade mark (UK) Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,”

14. The opponent’s registration is an earlier trade mark within the definition of Section 6 of the Act. The provisions of the Trade Marks (Proof of Use, etc.) Regulations 2004 do not apply.

15. In determining the question under Section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R 77 and *Marca Mode CV v Adidas AG and Adidas Benelux BV* [2000] E.T.M.R.723. It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors: *Sabel BV v Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question: *Sabel BV v Puma AG*, paragraph 23, 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 he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen B.V.* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details: *Sabel BV v Puma AG*, paragraph 23;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki v Metro-Goldwyn-Mayer Inc*, paragraph 17;

- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*, paragraph 26;
- (h) further, 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; *Marca Mode CV v Adidas AG*, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, paragraph 29.

16. In essence the test under Section 5(2) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements and taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed.

17. There is no dispute that identical goods are involved. I therefore go on to compare the respective trade marks. For ease of reference, I set out the respective marks below:

Applicant's mark	Opponent's mark
	DIVINA

18. In its counter-statement, the applicant states that DIVINA is an Italian word meaning DIVINE. There is no evidence that the average consumer would be aware of this fact. I have not been made aware that the word DIVINA has any meaning in the English language and I therefore regard it as an invented word. The word DIVINE is a well known word with a laudatory meaning but it seems to me that the distinctiveness of the mark applied for rests in the presentation of the word due to the inclusion of the devices. In relation to the goods at issue, it seems to me that the word DIVINA possesses a good degree of distinctive character. No evidence of use of the earlier mark has been provided therefore the opponent cannot rely on any enhanced reputation through use.

19. The respective marks must be compared as wholes and by reference to their overall impression but, as recognised in *Sabel BV v Puma AG*, in any comparison, reference will inevitably be made to the distinctiveness and dominance of individual elements. I must be careful not to over analyse the marks as the real test is how

customers would perceive the marks in the normal course and circumstances of the trade. The average customer rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture he or she has of them which he or she has kept in his or her mind.

20. The opponent's mark consists of the word DIVINA in plain block capitals. Although the mark applied for is referred to by the applicant as the word DIVINE it is more than that in that the letters "i" have been stylised with the usually relatively small tittles of each of the letters "i" replaced with what are said to be devices of gemstones. One device appears to me to be heart-shaped with the other a more side-on view. Whereas a tittle on a letter "i" would generally be small in proportion to the letter itself, in this case, the gemstone devices appear to me to be proportionately large in that they form half the height of the "letters". The inclusion of the devices gives a certain prominence to the letter "V" which appears between them. Whilst both marks share the letters "D" "V" and "N" as their first, third and fifth characters and therefore there is some visual similarity, when considered in totality the respective marks also have significant visual differences.

21. I consider the earlier mark would be pronounced DIV-EE-NAR. In contrast, and despite the stylisation of some of the letters within it, the mark applied for would be pronounced DIV-INE. Whilst both marks begin with the same sound, they end differently. The earlier mark consists of three syllables, the mark applied for only two. I consider that there are some aural similarities but also significant aural differences between the respective marks.

22. As an invented word, the earlier mark has no particular conceptual meaning though is reminiscent of the female forename Davina. With its laudatory meaning and use of gemstone devices, the mark applied for brings to mind a jewel or something containing a jewel and which is highly desirable or would give great pleasure. The respective marks are conceptually different.

23. Jewellery is bought by the public in general. Such goods are sold through a wide variety of outlets and at a wide range of prices. Pieces will range from the fashion or costume type jewellery for everyday wear at the cheaper end of the market, to commissioned or individually designed pieces for special occasions at the more expensive end. Whatever the price range of the goods, it seems to me that the wearing of jewellery is such a personal statement that the goods are likely to be bought with at least a reasonable degree of care e.g. as to size, colour, appearance and content etc.

24. Whilst there are some similarities between the respective marks, there are also significant differences between them. I believe the differences outweigh the similarities. Taking all factors into account, I do not believe there is a likelihood of confusion on the part of the relevant public even where identical goods are involved and thus the opposition fails under Section 5(2)(b).

Costs

25. The applicant has been successful and is entitled to a contribution towards costs. I take into account that no hearing has taken place, that the evidence filed was minimal and indeed did not influence my decision and that the applicant did not file any

written submissions. I order the opponent to pay the applicant the sum of £500. This sum is to be paid with seven days of the expiry of the appeal period or within seven days of the final determinations of this case if any appeal against this decision is unsuccessful.

Dated this 29th day of October 2007

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