

O-085-09

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2441920
BY B STORE LIMITED TO REGISTER A
TRADE MARK IN CLASSES 10, 35 & 42**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 96039 BY CALZEUS-CALCADO E
ACESSORIOS DE MODA, S.A.**

BACKGROUND

1. On 20 December 2006 B Store Limited (BS) applied to register the word SWEAR as a trade mark. Following examination, the application was accepted and published for opposition purposes on 9 November 2007 in Trade Marks Journal No.6709 for the following goods and services:

Class 10: Insoles for footwear; insoles for footwear made of leather and fabric covering synthetic materials.

Class 35: Retail services in the field of clothing, footwear and headgear; retail services connected with the sale of clothing, footwear and headgear, bags, rucksacks and backpacks, jewellery, imitation jewellery, perfumes, cosmetics and toilet articles; retail services connected with the sale of chronometric and horological instruments, by Internet, mail order, catalogue and other media including by means of telecommunications; provision of information to customers and advice or assistance in the selection of goods brought together as above; retail services connected with the sale of clothing, footwear and headgear in order to make it possible for other to conveniently view and purchase such goods; agency services for the importation of clothing, footwear and headgear; agency services for the selling on commission of personal property; research services relating to advertising, business and marketing; all in the field of clothing, footwear and headgear.

Class 42: Design of articles of clothing, footwear and headgear; fashion design; product design; research to develop new products, all in the field of clothing footwear and headgear; design services relating to packaging, textiles, clothing, footwear, headgear and fashion articles; technical consultancy and advisory services relating to the establishment of retail boutique stores and retail stores featuring clothing, footwear and headgear and related fashion accessories.

2. On 1 February 2008 Calzeus-Calcado e Acessorios De Moda S.A. (CC) filed a notice of opposition. This consists of a single ground based upon section 5(2)(a) of the Trade Marks Act 1994 (as amended) (the Act). In their Statement of Grounds CC indicate that the opposition (which is directed against all of the goods and services in the application) is based on the following trade mark:

Trade Mark	No.	Application Date	Registration date	Goods
SWEAR	CTM 2818565	14.08.2002	23.06.2004	9 – Spectacles. 18 – Leatherwear. 25 Footwear, clothing and headgear.

3. On 7 May 2008 BS filed a counterstatement which consists of a denial of the ground on which the opposition is based.

4. Neither party has filed evidence in these proceedings nor have they requested to be heard or filed written submissions in lieu of a hearing. The only submissions I have are those contained in BS's counterstatement in relation to the goods and services at issue; I shall refer to these submissions in a moment.

DECISION

5. The opposition is based upon section 5(2)(a) of the Act which reads as follows:

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

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

(b) ...

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

An earlier trade mark is defined in section 6 of the Act, the relevant part of which state:

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

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

6. In these proceedings CC is relying on the registered Community Trade Mark shown in paragraph 2 above. This has an application date of 14 August 2002 and as such it clearly qualifies as an earlier trade mark under the above provisions. The application for registration was published for opposition purposes on 9 November 2007 and the registration procedure for CC's earlier trade mark was completed on 23 June 2004. Consequently, CC's registration is not subject to The Trade Marks (Proof of Use, etc) Regulations 2004.

7. In reaching my decision I have taken into account the guidance provided by the European Court of Justice (ECJ) in a number of judgments germane to this issue i.e. *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Mayer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000]

E.T.M.R. 723, *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).

It is clear from all these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all the relevant factors; *Sabel BV v. Puma AG*, paragraph 22;

(b) the matter must be judged through the eyes of the average consumer of the good/services in question; *Sabel BV v. Puma AG*, paragraph 23, who is deemed to be reasonably well informed and 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel 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) when considering composite marks, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element; *Shaker di L. Laudato & Co. Sas* (C-334/05), paragraph 42;

(f) an element of a mark may play an independent distinctive role within it without necessarily constituting the dominant element; *Medion AG V Thomson multimedia Sales Germany & Austria GmbH*, paragraph 30;

(g) 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 Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;

(h) 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;

(i) 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;

(j) 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 + Adidas Benelux BV*, paragraph 41;

(k) 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.

The average consumer and the nature of the purchasing decision

8. As the case law above indicates, I must first determine who the average consumer is for the goods and services at issue. Once done, I must then establish the manner in which the respective goods and services are likely to be selected by this average consumer in the course of trade.

CC's goods

9. In my view all of CC's goods are consumer items likely to be selected by the general public (see below my comments in relation to Leatherware). While I have no evidence as to how the goods are likely to be selected, in my experience their selection is most likely (initially at least) to consist of a visual act made on the basis of self selection in either a retail environment, from a catalogue or on-line (the comments of the Appointed Person in *React Trade Mark* [2000] RPC 285 in relation to items of clothing refers). Whilst this is likely, in my view, to be the principal means by which the goods at issue are selected, I must also bear in mind that orders will be placed by telephone and that word of mouth recommendations will play a part in the selection process.

10. The cost of the goods in classes 9 and 25 which for the most part are for personal adornment, can vary from quite modest sums (for a pair of socks for example) to many hundreds (or even thousands of pounds) for a pair of designer spectacles or a couture dress. Insofar as spectacles are concerned the average consumer will want to ensure that these are the correct style, size, colour, material etc. and that they will be comfortable in use (in my experience this inevitably leads to many pairs being tried on and disregarded before a suitable pair is chosen). Similar considerations apply to items of clothing. While clothing many not be tried on to quite the same extent as spectacles, it is equally important that the correct style, material, size, colour etc. is found before a selection is made. In my view all these factors point to the average consumer displaying quite a high, if not the highest level of attention to the selection of the vast majority of the goods in these classes.

11. Insofar as the goods in class 18 of CC's registration are concerned, I am uncertain as to exactly what the term Leatherwear is intended to encompass. As clothing made of leather is proper to class 25, it cannot be items of clothing. In the absence of any indication to the contrary, it seems to me that the word Leatherwear in this context is broad enough to be capable of being construed as referring to any product made of

leather proper to class 18. So it would include, for example, bags, briefcases, credit card holders, handbags, key cases, purses and wallets as well as a range of other goods such as boxes, envelopes, figurines and leads. Given the varying nature of the goods at issue they are also likely to vary considerably in price. Compare for example the cost of a key case which is likely to be relatively inexpensive, with that of a handbag which may cost many hundred or even thousands of pounds. Consequently, the traits the average consumer will display are also likely to vary depending on the goods concerned. In relation to goods such as handbags and briefcases the average consumer would be conscious of, inter alia, cost, design, material, size, colour and ultimately if it was suitable for the purpose for which they intended to use it. While the same level of attention is unlikely to be paid to the selection of a key case, it is still likely to be significantly higher than one would pay to an impulse purchase such as a bag of sweets.

BS's goods and services

12. I now turn to BS's goods in class 10. These are also items which will be bought by the general public from retail outlets, catalogues or on-line; once again the selection of the goods is likely to consist primarily of a visual act. That said, the fact that the goods for which registration has been sought fall into class 10 (rather than class 25), means that the insoles with which I am concerned are for orthopaedic rather than general use. That being the case, it is possible that the average consumer when selecting such goods may be acting on the advice of a professional person (such as a chiropodist); in those circumstances word of mouth recommendations may take on somewhat greater importance. While I anticipate the cost of such goods being relatively modest, the need for the average consumer to ensure they are selecting an insole which is not only the correct size, but which has also been designed to correct the defect concerned, tends, in my view, to suggest that they are likely to pay a relatively high level of attention to their selection

13. BS have applied for a range of services in classes 35 and 42. It seems to me that:

Retail services in the field of clothing, footwear and headgear; retail services connected with the sale of clothing, footwear and headgear, bags, rucksacks and backpacks, jewellery, imitation jewellery, perfumes, cosmetics and toilet articles; retail services connected with the sale of chronometric and horological instruments, by Internet, mail order, catalogue and other media including by means of telecommunications; provision of information to customers and advice or assistance in the selection of goods brought together as above; retail services connected with the sale of clothing, footwear and headgear in order to make it possible for other to conveniently view and purchase such goods,

are all retail (and associated services) aimed at the general public. The selection of a retail outlet (whether on the high street or on-line) is likely to be primarily a visual act although oral recommendations from, for example, family or friends will inevitably play a part in the selection process. In the retail areas for which BS seek registration (which

can be broadly defined as clothing, bags, jewellery, perfumery and time pieces), there is in my experience a not insignificant degree of brand loyalty. That being the case, I anticipate the average consumer paying a relatively high level of attention to the selection of a retailer in these areas.

14. Insofar as:

Agency services for the importation of clothing, footwear and headgear,

and:

Research services relating to advertising, business and marketing; all in the field of clothing, footwear and headgear

are concerned, I am inclined to agree with the comments in BS's counterstatement to the effect that these are services which will be primarily aimed at businesses rather than the general public. As I have no evidence as to how businesses would select such services (and no experience on which I can draw), I intend to proceed on the basis that while both visual and aural considerations are likely to come into play, I am not in a position to determine which (if any) method is likely to dominate. As the average consumer is likely to be a business user, one may reasonably assume that not insignificant sums will be involved. All of which tends to suggest that the average consumer will pay a high level of attention to their selection.

15. This leaves:

Agency services for the selling on commission of personal property

in relation to which I note the counterstatement is silent. In my view the average consumer for these services could be either the general public or businesses i.e. any person or business who had an item that they wanted sold on their behalf. I have no evidence as to how these services are likely to be selected, but from my own experience I think that the act of selecting competing traders from business listings, magazines etc (be it in either hard copy or on line) is once again likely to be primarily a visual act, although I am equally sure that word of mouth recommendations will also play a part in the selection process. Inevitably when selecting such services the average consumer will be eager to ensure that they are choosing the most appropriate trader to sell their goods, and that they are able to realise the best price for the item at the lowest rate of commission. As this is likely to involve the average consumer in an element of research prior to choosing a suitable trader, it all points to a reasonably high level of attention being paid to the selection of these services.

16. Finally I turn to BS's services in class 42 which in their counterstatement BS suggest are all services provided to businesses rather than the general public. While this statement may be true in relation to some of the services claimed, for example:

Research to develop new products, all in the field of clothing footwear and headgear

and:

Design services relating to packaging

and

Technical consultancy and advisory services relating to the establishment of retail boutique stores and retail stores featuring clothing, footwear and headgear and related fashion accessories,

it is not I think true in relation to:

Design of articles of clothing, footwear and headgear, fashion design, product design (the precise meaning of which appears to me at least to be uncertain and could include the design of, inter alia, clothing)

and

Design services relating to textiles, clothing, footwear, headgear and fashion articles.

17. I see no reason why a member of the general public could not, for example, commission from an appropriate designer a bespoke wedding dress and associated accessories (which could include footwear and headgear) or perhaps commission the design of a co-ordinated range of textiles for use in the home. Once again I have no evidence as to how the services would be selected, but it is inevitable that both visual and aural considerations will play a part in the process (although here again I do not find myself in a position to judge which method if any is likely to dominate). What I think is clear, is that whether it be a member of the public commissioning design services or a business seeking technical advice on the establishment of a retail store, significant sums are likely to be in play; I doubt that either consumer group would approach their selection without a good deal of care.

Comparison of trade marks

18. The respective parties' trade marks both consist solely of the dictionary word SWEAR presented in upper case. They are, self evidently, identical.

Comparison of goods and services

CC's goods	BS's goods and services
9 – Spectacles.	Class 10: Insoles for footwear; insoles for footwear made of leather and fabric covering synthetic materials.
18 – Leatherwear.	

<p>25 - Footwear, clothing and headgear.</p>	<p>Class 35: Retail services in the field of clothing, footwear and headgear; retail services connected with the sale of clothing, footwear and headgear, bags, rucksacks and backpacks, jewellery, imitation jewellery, perfumes, cosmetics and toilet articles; retail services connected with the sale of chronometric and horological instruments, by Internet, mail order, catalogue and other media including by means of telecommunications; provision of information to customers and advice or assistance in the selection of goods brought together as above; retail services connected with the sale of clothing, footwear and headgear in order to make it possible for other to conveniently view and purchase such goods; agency services for the importation of clothing, footwear and headgear; agency services for the selling on commission of personal property; research services relating to advertising, business and marketing; all in the field of clothing, footwear and headgear.</p> <p>Class 42: Design of articles of clothing, footwear and headgear; fashion design; product design; research to develop new products, all in the field of clothing footwear and headgear; design services relating to packaging, textiles, clothing, footwear, headgear and fashion articles; technical consultancy and advisory services relating to the establishment of retail boutique stores and retail stores featuring clothing, footwear and headgear and related fashion accessories.</p>
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19. The leading authorities on how to determine similarity between goods and services are considered to be the *Canon* case (supra) and *British Sugar Plc v James Robertson & Sons Ltd (Treat)* [1996] R.P.C. 281. In the first of these cases the ECJ accepted that all relevant factors should be taken into account including the nature of the goods/services, their intended purpose, their method of use and whether they are in competition with each other or are complementary. The criteria identified in the *Treat* case 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.

20. When construing the services in BS's application I will keep in mind the comments of Jacob J (as he then was) in *Avnet Incorporated v Isoact Limited* [1998] FSR 16, namely:

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

21. In their counterstatement BS comment on the comparison of the goods and services at issue. As these are the only submissions I have to assist me, their comments are, insofar as it is necessary, reproduced verbatim below:

“5. The Applicant denies that any of the goods on which the Opponent relies..are similar enough to any of the goods and services specified in the Application in order for there to exist a likelihood of confusion on the part of the public or a likelihood of association with the Opponent's Mark. Under *Canon Kabushiki Kaisha v Metro-Goldwyn Mayer Inc.*...the factors to be taken into account in assessing similarity include their nature; their end users and their method of use and whether they are in competition with each other or are complementary.

Goods in class 10

6. The Opponent's Mark covers only goods and no services. The only goods covered by the Application are those contained in class 10..... The goods in class 10 differ from the goods designated under the Mark in a number of ways.

7. Insoles have an entirely different purpose to spectacles. Insoles are used to provide support and comfort to the feet. Spectacles are used for fashion purposes and to correct vision. They also differ in their purpose from all of the

goods designated under the Opponent's Mark in that all of the goods designated under the Opponent's Mark are largely intended as fashion items. The purpose of insoles is entirely functional, to provide comfort and support to feet.

8. Further, insoles can not be said to be in competition with any of the goods designated under the Opponent's Mark.

Services in class 35

9. By their nature goods are generally dissimilar to services. This is because goods are articles of trade, wares, merchandise or real estate. Their sale usually entails the transfer of title in something physical, i.e. moveables or real estate. Services, on the other hand, consist in the provision of intangible activities. Goods and services are therefore fundamentally different in their nature and in the use made of them.

10. The risk of confusion between goods sold at retail and retail services is generally unlikely except in specific situations as customers will generally not believe that goods will be manufactured and sold at retail by the same undertaking. This point was well made by OHIM Communication No 03/01 of the President of the Office of 12 March 2001. This naturally extends to the provision of information relating to goods.

11. The retail and provision of information services designated under the Application include retail of goods not designated under the Opponent's Mark, including bags, rucksacks and backpacks, jewellery, imitation jewellery, perfumes, cosmetics and toilet articles and chronometric and horological instruments. The claim that there may be a likelihood of confusion is particularly weak in relation to retail services relating to these goods.

12. The Application designates "agency services for the importation of clothing, footwear and headgear". Again these services differ from the goods designated under the Opponent's Mark in their nature and use, being services as opposed to goods. They also differ greatly in respect of the end user as agency services are generally business to business services offered to the trade, whereas the end users for the goods designated in the Opponent's mark are consumers. No argument has been put forward by the Opponent as to why a likelihood of confusion exists.

13. The Application designates "research services relating to advertising, business and marketing" [the comments in paragraph 12 are repeated]

Services in class 42

14. [As paragraph 9 above].

15. The services of design and research and “technical consultancy relating to the establishment of retail boutique stores and retail stores featuring clothing, footwear and headgear and related fashion accessories” designated in class 42 of the Application are professional business to business services offered to people in the trade. End users for the goods designated in the Opponent’s Mark are consumers. The services designated in class 42 of the Application differ from the goods designated under the Opponent’s Mark in relation to the end user and in the point of sale/provision.”

22. With these considerations in mind and in the absence of any evidence or written submissions from either party, I will now consider the respective goods and services on a class by class basis.

Class 10

23. In class 10 BS have applied for insoles for footwear (as I mentioned above these insoles are for orthopaedic rather than general use); CC have a registration in class 25 covering, inter alia, footwear. Both sets of goods are intended for use on the feet. While I note the comment in BS’s counterstatement to the effect that their goods in class 10 are entirely functional whereas CC’s goods are fashion items, it would not be fanciful to suggest that the respective goods could be produced by the same manufacturer and may reach the market through the same trade channels. In addition, they are likely to be selected by the same average consumer in retail outlets, in catalogues or on line. While the respective goods are not in competition they are, in my view, clearly complementary. **BS’s insoles in class 10 are similar to CC’s footwear in class 25 to a reasonable degree.**

Class 35

24. The Trade Marks Registry (TMR) has published guidance on how it intends to approach what it considers to be the relationship between a trade in goods and the provision of a retail service. Insofar as it is relevant this reads as follows:

“14 Retail Services: search of the Register

In case C-418/02, Advocate General Phillippe Leger opined [agreeing with communication No. 3/01 from the President of OHIM] that “the risk of confusion between [retail] services and the products, if it cannot be excluded, is nevertheless improbable except in particular circumstances, for example when the respective marks are identical or almost identical and well established on the market.”

The ECJ did not feel the need to answer the referring court’s question about the scope of protection of retailers’ marks and so there is no definitive statement of law. Nevertheless, the Advocate General’s Opinion is of persuasive value. In the light of it we will consider notifying the earlier right holders in the course of official

examination where:

- a mark is registered (or proposed to be registered) for retail services (or similar descriptions of this service) connected with the sale of specific goods or types of goods;
- another mark is registered (or proposed to be registered) by a different undertaking for goods of the type expressly mentioned in the specification of the retail services trade mark;
- the earlier trade mark has at least a normal degree of distinctive character, i.e. marks with low distinctive character, such as, for example, common surnames, need not be cited;
- the later trade mark is not just similar to the earlier mark but is identical or virtually identical to it, or contains a dominant and/or independently distinctive feature of it.

The reputation of the earlier trade mark and (unless it is obvious) the practices of the trade will only be taken into account on the basis of evidence in opposition or invalidation proceedings.

In view of these factors, we will conduct a search for earlier trade marks as detailed in the guide to cross searching .”

25. BS have applied to register a range of services in this class. I shall deal first with:

Retail services in the field of clothing, footwear and headgear; retail services connected with the sale of clothing, footwear and headgear, bags, rucksacks and backpacks, jewellery, imitation jewellery, perfumes, cosmetics and toilet articles; retail services connected with the sale of chronometric and horological instruments, by Internet, mail order, catalogue and other media including by means of telecommunications; provision of information to customers and advice or assistance in the selection of goods brought together as above; retail services connected with the sale of clothing, footwear and headgear in order to make it possible for other to conveniently view and purchase such goods.

26. CC's registration is in class 18 for Leatherware and class 25 for Footwear, clothing and headgear. I have reproduced above BS's views on the relationship between goods and services and their reliance on OHIM Communication No 03/01. Insofar as the latter is concerned, I note that this was specifically considered by the TMR in the guidance mentioned above. In my view and in the absence of submissions to the contrary, the TMR's published approach represents a sensible starting point. Other factors that need to be borne in mind when determining how similar a trade in goods may be to the provision of a retail service were considered by the Hearing Officer (Mr Reynolds) in *Timothy Roy Barrett-Smith and Glenbeigh Limited BL [O-319-05]* in which he said:

“50. Accepting for present purposes that the unrestricted term retail services lends itself to a broad interpretation, and if a polarised view of the matter is not considered appropriate, the degree of similarity between such services and any particular goods item or categories of goods is likely to turn on a number of considerations. It seems to me that these would include:

- how specialised the goods are. The more narrowly focussed and specialised they are the less likely it is that consumers would expect to see the same or closely similar sign also in use as a retail service mark. Thus it is not uncommon in the clothing trade for retailers to offer own brand clothing. On the other hand, whilst retailers will sell, for instance, rubber bands, there is no specialist trade in such goods nor to the best of my knowledge is there a widespread practice of offering such goods under the same brand name as the retail source;

- whether it is common practice to have retail outlets dedicated to the goods in question;

- whether consumers would expect to encounter the same mark in use both in relation to the retail service and in relation to the goods (that is own brand goods) or whether traders in that particular goods area normally only sell third party brands;

- whether the retail trade is one where the goods themselves may not normally carry a mark (meat in a butcher’s shop for instance) and therefore, the customer may make a particular association between the retail service and the goods as distinct from retail services where the goods themselves are prominently branded.”

27. Although these considerations were identified in circumstances where the retail services were unrestricted, in my view the factors must apply with equal (or even greater force) to a retail services specification where the items which are to be retailed are specifically identified. While I do not wish to put words in BS’s mouth, they appear to have accepted as much when in their counterstatement they said:

“11. The retail and provision of information services designated under the Application include retail of goods not designated under the Opponent’s Mark, including bags, rucksacks and backpacks, jewellery, imitation jewellery, perfumes, cosmetics and toilet articles and chronometric and horological instruments. The claim that there may be a likelihood of confusion is particularly weak in relation to retail services relating to these goods.”

28. In my own experience there are (and would have been at the date of application) a range of traders who use the same trade mark to identify both their retail service and their trade in goods such as clothing, footwear and headgear in class 25 and (what I will

broadly describe as bags and associated products) in class 18. That being the case, it seems to me that the following services in BS's application i.e.

Retail services in the field of clothing, footwear and headgear; retail services connected with the sale of clothing, footwear and headgear, bags, rucksacks and backpacks; provision of information to customers and advice or assistance in the selection of goods brought together as above; retail services connected with the sale of clothing, footwear and headgear in order to make it possible for other to conveniently view and purchase such goods

are similar to CC's goods in classes 18 and 25 to a significant degree.

However insofar as:

Retail services connected with the sale of jewellery, imitation jewellery, perfumes, cosmetics and toilet articles; retail services connected with the sale of chronometric and horological instruments, by Internet, mail order, catalogue and other media including by means of telecommunications; provision of information to customers and advice or assistance in the selection of goods brought together as above

are concerned, there is in my experience no such affinity between a trade in clothing or bags and associated products in class 18 and the provision of retail and associated services in relation to jewellery, perfumery, cosmetics, toilet articles and timepieces.

29. I now turn to consider:

Agency services for the importation of clothing, footwear and headgear.

And.

Research services relating to advertising, business and marketing; all in the field of clothing, footwear and headgear.

30. Being services as opposed to goods the uses are clearly different. I agree with BS's submissions to the effect that in the main these are services which are more likely to be provided to businesses than to the general public. In my view the services may be provided on either a stand alone basis or an adjunct to other services. While the same business may be involved in both the services and a trade in clothing, it seems to me that their involvement in the services are more likely to be as part and parcel of the operation of their own business rather than services which they offer to others. **Taking the best view I can of the mater, if there is any similarity between the named services and CC's goods in class 25 it must, I think, be at a relatively low level.**

31. That leaves the following services in class 35:

Agency services for the selling on commission of personal property.

32. The agency services mentioned are unlimited and would include the selling on commission of goods proper to classes 18 and 25. While the respective uses of the goods and services are again different, the average consumer may be the same. Once again the services could be provided on either a stand alone basis or as an adjunct to a retail service and, importantly in my view, provided in a retail environment. When provided on a stand alone basis the services would neither be in competition with or complementary to a trade in goods in classes 18 or 25. However when provided as an adjunct to a retail service, the average consumer may be asking a retailer (who trades in goods in classes 18 and 25 and also provides retail services under the same trade mark) to sell goods on their behalf. In those circumstances, the goods and services are somewhat closer. **Based on the second scenario, I consider there to be a moderate degree of similarity between BS's services and CC's goods.**

Class 42

33. BS have applied for a range of services in this class. I shall deal first with:

“Design of articles of clothing, footwear and headgear; fashion design; product design; design services relating to textiles, clothing, footwear, headgear and fashion articles.”

(Although unlimited the phrases “fashion design” and “product design” would obviously include the design of, inter alia, clothing).

34. CC's registration includes footwear, clothing and headgear. I note that in its Guide to Cross Searching the TMR has indicated that it considers the link between the conducting of a trade in clothing in class 25 and the provision of a clothing and footwear design service in class 42, to be sufficiently well established that when conducting a search for earlier rights it will (when there is also sufficient similarity in the trade marks themselves) consider notifying the owners of an earlier right of the presence of a later filed application. While this is obviously only a guide, in the absence of submissions from the parties to the contrary, I think it provides a useful starting point.

35. Although the uses will be different (being services as opposed to goods), the average consumer is likely to be the same. In addition, I am prepared to accept that the average consumer would be aware that in this area of trade it is commonplace for those who provide clothing and textile design services (perhaps under their own name) to also trade (under their own name) in the textiles or clothing which result from their designs; examples such as Laura Ashley, Chanel and Ralph Lauren come immediately to mind although there are many others. In those circumstances there is a very close almost symbiotic relationship between the design service and the goods which result from them. **The TMR's approach in this regard merely reinforces my own view that**

there is a high degree of similarity between these services and CC's goods in class 25.

36. This leaves the following services in class 42:

“Research to develop new products, all in the field of clothing footwear and headgear; design services relating to packaging”, technical consultancy and advisory services relating to the establishment of retail boutique stores and retail stores featuring clothing, footwear and headgear and related fashion accessories.”

37. Once again the uses are clearly different to CC's goods in class 25; as I mentioned above the average consumer for such services is more likely to be a business than a member of the general public. The services are not in competition with CC's goods in class 25 but at a very high level of generality it could be argued that they are complementary. **If there is any similarity in the named services and CC's goods in class 25 the degree of similarity must be at a very low level.**

Likelihood of confusion

38. 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 trade marks may be offset by a greater degree of similarity between the goods and services and vice versa. It is also necessary for me to consider the distinctive character of the earlier trade mark, as the more distinctive it is (either inherently or as a result of any use that has been made of it), the greater the likelihood of confusion. The distinctive character must be appraised by reference to the goods in respect of which it is registered and also by reference to the way it will be perceived by the average consumer. I must also keep in mind the average consumers for the goods and services and the nature of the selection process.

39. CC's earlier trade mark consists of the well known dictionary word SWEAR presented in upper case. As far as I am aware it has no meaning for the goods for which it stands registered. Although not in the category of an invented word, it is a trade mark which absent use (no evidence of its use having been provided), is possessed of a significant degree of inherent distinctive character.

40. The respective trade marks are of course identical. In relation to CC's goods I concluded that the average consumer will be a member of the general public and that the selecting of the goods will be primarily a visual act (whilst accepting that aural considerations cannot be disregarded). I also concluded that in relation to the vast majority of goods the average consumer will pay quite a high if not the very highest level of attention to their selection.

41. BS have applied for a range of goods and services for which the average consumer varies. In relation to some goods and services it may be the general public while in relation to other services it is more likely to be another business. Where I have felt able I have concluded that visual means are likely to dominate the selection process, whilst recognising that aural considerations will also play their part. While I have concluded that the degree of attention the average consumer is likely to pay to the selection of BS's goods and services may vary, even at its lowest point the average consumer's level of attention is still likely to be at a relatively high level.

42. I shall now apply the global approach advocated to these findings. In reaching a conclusion I have kept in mind that the respective parties' trade marks are identical and that CC's earlier trade mark enjoys a significant degree of inherent distinctiveness; I have also kept in mind the factors identified by the Hearing Officer in paragraph 26 above. Having done so, I have concluded that the opposition succeeds in relation to the following goods and services:

Class 10 – Insoles for footwear; insoles for footwear made of leather and fabric covering synthetic materials.

Class 35 - Retail services in the field of clothing, footwear and headgear; retail services connected with the sale of clothing, footwear and headgear, bags, rucksacks and backpacks; provision of information to customers and advice or assistance in the selection of goods brought together as above; retail services connected with the sale of clothing, footwear and headgear in order to make it possible for other to conveniently view and purchase such goods; agency services for the selling on commission of personal property.

Class 42 - Design of articles of clothing, footwear and headgear; fashion design; product design; design services relating to textiles, clothing, footwear, headgear and fashion articles.

43. I have kept the considerations mentioned in paragraph 42 in mind when approaching the services in classes 35 and 42 that remain. Notwithstanding the identity in the trade marks, I have concluded that bearing in mind the nature of the average consumer and the traits that they are likely to display when selecting such goods and services, together with what I consider to be the distance between the remaining services and CC's goods, that the likelihood of confusion is unlikely. Consequently, the opposition fails in relation to the following services:

Class 35 –Retail services connected with the sale of jewellery, imitation jewellery, perfumes, cosmetics and toilet articles; retail services connected with the sale of chronometric and horological instruments, by Internet, mail order, catalogue and other media including by means of telecommunications; provision of information to customers and advice or assistance in the selection of goods brought together as above; agency services for the importation of clothing,

footwear and headgear; research services relating to advertising, business and marketing; all in the field of clothing, footwear and headgear.

Class 42 - Research to develop new products, all in the field of clothing footwear and headgear; design services relating to packaging; technical consultancy and advisory services relating to the establishment of retail boutique stores and retail stores featuring clothing, footwear and headgear and related fashion accessories.

Costs

44. As both parties have achieved a measure of success in these proceedings, I do not intend to favour either with an award of costs.

Dated this 27th day of March 2009

**C J BOWEN
For the Registrar
The Comptroller-General**