

O-280-09

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION NO. 929051
IN THE NAME OF
CHRISTOPHER HANLON**

OF THE TRADE MARK



**CHRISTOPHER
HANLON**

IN CLASSES 3 and 25

AND

**THE OPPOSITION THERETO
UNDER NO 71545
BY
CAROLINA HERRERA LTD**

Trade Marks Act 1994

In the matter of
international registration no. 929051
in the name of Christopher Hanlon
of the trade mark:



CHRISTOPHER
HANLON

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under no. 71545
by Carolina Herrera Ltd.

Introduction

1. Christopher Hanlon is the holder of the above international registration (the 'IR'). Protection in the United Kingdom is sought from 13 October 2006, claiming a priority date of 13 April 2000 (Australia). The request for protection was published in the United Kingdom, for opposition purposes, in *The Trade Marks Journal* on 12 October 2007. Protection is sought in respect of the following goods and services, classified according to the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended:

Class 3: *Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; cosmetic preparations, namely body scrubs, hair shampoos, hair conditioners, hair grooming creams, hair styling gels, hair styling creams, hair styling lotions, anti-wrinkle creams, eau de toilettes, perfumes, massage oils, acne creams, anti-acne face washes, beauty masks, anti-cellulite lotions, foot balms, anti-dandruff shampoos, anti-dandruff hair conditioners, nail varnish, eye mascara, coloured foundations, coloured eye shadows, lip glosses, lipsticks, whitening skin creams, after shave lotions, after shave balms, foaming face washes, non-foaming face washes, skin toning lotions, herbal skin mists, laundry detergents, dish washing liquids, hand creams, after sun creams, UV sun creams, self tanning lotions, self tanning creams, bronzing creams, eye gels, liquid hand washes, toothpastes, whitening toothpastes, whitening tooth gels, mouth rinses, hair colouring dyes, hair shining creams, body hair removing creams, face hair removing creams, hair removing waxes, hair removing gels, skin bleaching creams, skin bleaching lotions, skin bleaching liquids, peel-off nail varnish, lip thickening creams, lip*

thickening gels, breast firming gels, breast firming liquid creams, skin plumping gels, skin vitamin creams, hair vitamin creams, scalp vitamin creams, hand soaps, laundry soaps, guest soaps, personal lubricants for cosmetic purposes, age spot creams, hair perming lotions, hair curling lotions, hair styling lotions, skin concealing lotions, blemish creams.

Class 25: *Clothing, footwear, headgear including shirts, golf shirts, T-shirts, sweatshirts, tank tops, sweaters, jerseys, turtle-necks, golf shirts, shorts, sweatpants, warm-up suits, blazers, sport coats, sportswear, haute couture clothing, pants, jeans, skirts, scarves, suits, overalls, vests, jackets, coats, parkas, swimwear, bikinis, rainwear, wind-resistant jackets, sleepwear, underwear, lingerie, belts, ties, hats, wool hats, caps, bathrobes, boxer shorts, pyjamas, ties, socks, hosiery, shoes, boots, sneakers, sandals, cowboy boots, horse riding boots, slip-on yacht shoes, sports shoes, mountain climbing boots, shoes adapted to be worn with roller skates, construction site work boots, dinner shoes, casual weekend shoes, slippers, thongs, snowboard boots, gloves and suspenders, dinner suits, evening suits, work suits, baby clothes, nappies.*

2. On 11 January 2008, Carolina Herrera Ltd, which I will refer to as Ltd, filed notice of opposition to the protection of the entire international registration, raising a single ground of opposition under section 5(2)(b) of the Trade Marks Act 1994. This section of the Act is concerned with objection to registration on the grounds that owing to similarities between the marks and the goods or services there exists a likelihood of confusion on the part of the public. To support the ground, Ltd relies upon all the goods and services of its following two earlier registrations and one earlier application to attack all the goods of the international registration (the IR):

- Community trade mark registration (CTM) 4144994:

CH

CAROLINA HERRERA

Class 3: *Perfumery products, cosmetics, essential oils, soaps, talcum powder, shampoos, hair lotions, bath and shower gels, bath salts, not for medical purposes, deodorants for personal use, dentifrices.*

Class 9: *Spectacle frames, spectacles and components thereof; contact lenses, cases for spectacles and contact lenses.*

Class 14: *Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments.*

Class 18: *Handbags, wallets, purses, suitcases, umbrellas, parasols and walking sticks; rucksacks; shirts of leather; goods made from leather and imitations of leather not included in other classes.*

Class 25: *Clothing and ready-made clothing; bathing suits, dressing gowns, underwear; headgear, caps, bonnets, berets and visors, jerseys, sweaters and pullovers, clothing and trousers, including knitwear; coats, suits, gabardines, raincoats, gloves, scarves, ties, belts, stockings, socks and shoes of all kinds (except orthopaedic shoes).*

Class 35: *Retail services.*

CTM 4144994 has a filing date of 19 November 2004 and a registration date of 10 January 2006.

- CTM 4190468:

CH
HC

Class 14: *Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments.*

CTM 4190468 has a filing date of 2 December 2004 and a registration date of 28 April 2008.

- CTM 4758851:

CH

Class 3: *Perfumery products, cosmetics, essential oils, soaps, talcum powder, shampoos, hair lotions, bath and shower gels, bath salts, not for medical purposes, deodorants for personal use, dentifrices.*

Class 18: *Leather and imitations of leather, bags, handbags, trunks and travelling bags, wallets, purses, suitcases, umbrellas, parasols and walking sticks; rucksacks; goods made from leather and imitations of leather not included in other classes.*

Class 25: *Clothing and ready-made clothing; bathing suits, dressing gowns, underwear; headgear, caps, bonnets, berets and visors, jerseys, sweaters and pullovers, clothing and trousers, including knitwear; coats, suits, gabardines, raincoats, gloves, scarves, ties, belts, stockings, socks and shoes of all kinds (except orthopaedic shoes); shirts of leather.*

CTM 4758851 has a filing date of 24 November 2005 and a priority date of 17 June 2005 (Spain). It is not yet registered.

3. Christopher Hanlon is an eponymous trade mark; the counterstatement was filed by Christopher Hanlon, who is recorded as the address for service. I will refer to the IR holder as Mr Hanlon. Mr Hanlon's counterstatement denies that there would be a likelihood of confusion and he gives an analysis of Ltd's goods and marks, comparing them to his own, together with historical details relating to the Christopher Hanlon composite trade mark. Rather than list the contents of the counterstatement here, I will bear Mr Hanlon's submissions in mind and refer to them as necessary in reaching my decision.

4. Only Mr Hanlon filed evidence. The parties were advised that they had a right to a hearing and that if neither side requested a hearing a decision would be made from the papers and from any written submissions. Neither side requested a hearing and only Ltd filed written submissions (but see my comments regarding the counterstatement above).

Evidence

5. Mr Hanlon has filed a witness statement, dated 28 February 2009. The witness statement contains a mixture of facts about his use of the mark and submissions, expanding upon those in the counterstatement comparing the marks. I will bear these in mind in reaching my decision, but will not record them in this summary of factual evidence.

6. There are thirteen supporting exhibits, as follows:

Exhibit 1:

Six device marks from the Intellectual Property Office database which Mr Hanlon states are 'CH' trade marks in classes 3 and 25 (there is no indication as to the search criteria used to retrieve the marks, or any status information about the trade marks);

Exhibits 2, 4 and 10:

Commentary and diagrams indicating the graphic design concept of the device element of the IR;

Exhibit 3:

Example of the 'Bodini' typeface and reproduction of Ltd's CTM 4190468 trade mark using this typeface;

Exhibit 5:

Juxtaposition of the IR which is described as 'highly stylised' and CTM 4190468, and CH in the same typeface as CTM 4190468, both described as 'naïve' logos.

Exhibits 6, 7, 9 and 13:

Examples of marketing, products, retail store/boutique and online 'trade dress' showing the IR in use. These emphasise that Mr Hanlon is 'Australia's first perfumer', a 'men's skin care pioneer' and that the products are 'Australian made'.

Exhibit 11:

Screenshot from www.strawberrynet.com showing Ltd's class 3 goods for sale; Mr Hanlon states that this website is a 'mass distribution channel' and a 'cheap clearance website for mass produced designer merchandise'.

Exhibit 12:

Details of the Christopher Hanlon composite trade mark from the Australian trade mark register.

7. Mr Hanlon states that his trade mark is a niche, high end, luxury brand which is used to sell goods priced up to 100 times those of Ltd (he also states that both his trade marks and Ltd's are designer brands). There are no turnover figures or price lists in the evidence. Mr Hanlon states that Christopher Hanlon goods are 100% vegan, contain no synthetic ingredients or fragrances, and are manufactured using an ancient sixteenth century process unique to the company from solely Australian extracts and material. Exhibit 6 shows a product label which bears the legend "Australia's First Perfumer". The goods are only sold through Mr Hanlon's boutiques or his website. Mr Hanlon states that he first registered his trade mark in 1994, in Australia.

Decision

8. The relevant part of 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 marks 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.”

Section 6(1)(a) of the Act defines an earlier mark as:

“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”.

Ltd's trade marks upon which it relies is are earlier marks as per section 6(1)(a). Since two of Ltd's marks had been registered for less than five years at the date on which the IR was published, there is no statutory requirement for Ltd to prove use of those marks on the goods and services upon which it relies¹.

9. The leading authorities which guide me in this ground are from the European Court of Justice (ECJ): *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO)*. 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*,

(b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(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*,

(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*,

(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 Kaisha v Metro-Goldwyn-Mayer Inc*,

(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*,

¹ See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

(g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(h) 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*,

(i) 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 and Adidas Benelux BV*,

(j) 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*.

k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*

l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*.

The average, relevant consumer and the nature of the purchasing process

10. Ltd's marks are not subject to proof of use and so I must consider the relevant public across the entire range of the goods and services. The matter must be judged through the eyes of the average consumer for the goods or services in question (*Sabel*), so I have to assess the nature of the average consumer and how they are most likely to encounter and/or purchase the goods or services. Mr Hanlon states that his goods are high end/ luxury items, available only through a limited number of his own outlets. He states that both he and Ltd currently occupy what might be called the 'designer' market. He considers that purchasers will pay close attention to the selection of such goods:

"I believe these items are selected with particular care by the relevant public because the discerning consumer purchasing 'designer goods' wants to be sure that the product meets all the necessary requirements concerning colour, size, fit, function, price, fabric, ingredients, texture, aroma, shape, style, design, etc. These goods are usually held in hand, tried on or in any case attentively observed before being purchased."

The distinction Mr Hanlon has inferred between expensive and cheaper goods is not,

and cannot be, reflected in trade mark specifications. In *McQUEEN CLOTHING CO Trade Mark Application* [2005] R.P.C. 2, Geoffrey Hobbs Q.C., sitting as the appointed person, was faced with two parties: the opponent who was at the *haute couture* end of the clothing market, and the applicant who was not. In that case, the applicant tried to separate his specification from the opponent's by offering to exclude *haute couture* clothing from his specification. That was found to be contrary to law as stated by the ECJ in *Koninklijke KPN Nederland NV v. Benelux Merkenbureau (POSTKANTOOR)* Case C-363/99. At paragraph 31, Mr Hobbs said:

“When assessing the objections to registration in the present case, it is necessary to assume normal and fair use of the marks for which registered trade mark protection has been claimed. The context and manner in which the marks have actually been used by the applicant and the opponent in relation to goods of the kind specified may be treated as illustrative (not definitive) of the normal and fair use that must be taken into account.”

11. There is no method by which the specifications can reflect the relative expense and market of the goods. I also bear in mind what was said by the Court of First Instance (CFI), in *Saint-Gobain SA v OHIM* in Case T- 364/05:

“67. With regard to the conditions under which the goods at issue are marketed, the applicant's argument that the goods covered by the earlier mark are sold almost exclusively in shops and supermarkets, whereas the mark applied for refers solely to goods sold by mail order, is without foundation. As has already been held, on a comparison of the goods, nothing prevents the goods covered by the earlier mark from also being sold by mail order. In addition, it is apparent from the file that the intervener makes almost 5% of its sales by mail order. Furthermore, it is important to reiterate that the comparison between the goods in question is to be made on the basis of the description of the goods set out in the registration of the earlier mark. That description in no way limits the methods by which the goods covered by the earlier mark are likely to be marketed.”

12. Both parties could choose to vary how they use their marks to the point that they both occupy identical market positions, be they bespoke perfumery and clothing or a more 'average' market. A trade mark specification is designed to specify goods or services, not how they are sold or for how much². A trade mark registration can be sold and a new or subsequent proprietor may decide to use it in an altogether different market. In *Devinlec Développement Innovation Leclerc SA v OHIM* Case T-147/03, the CFI said:

“104 Consideration of the objective circumstances in which the goods covered by the marks are marketed is fully justified. The examination of the likelihood of confusion which the OHIM authorities are called on to carry out is a prospective examination. Since the particular circumstances in which the

² *Bang & Olufsen A/S v OHIM Case T-460/05*, in the context of distinctiveness : “According to the case-law, the price of the product concerned is also immaterial as regards the definition of the relevant public, since price will also not be the subject of the registration (Joined Cases T-324/01 and T-110/02 *Axions and Belce v OHIM (Brown cigar shape and gold ingot shape)* [2003] ECR II-1897, paragraph 36).”

goods covered by the marks are marketed may vary in time and depending on the wishes of the proprietors of the trade marks, the prospective analysis of the likelihood of confusion between two marks, which pursues an aim in the general interest, that is, the aim that the relevant public may not be exposed to the risk of being misled as to the commercial origin of the goods in question, cannot be dependent on the commercial intentions, whether carried out or not, and naturally subjective, of the trade mark proprietors.”

Notwithstanding Mr Hanlon’s own view of the market distinction between his goods and Ltd’s, the latter may take the view that Mr Hanlon currently occupies a section of the perfumery and clothing market which it considers is similar to its own (designer) and it may also be concerned that Mr Hanlon may not always be the owner of his trade mark³. I must make a prospective analysis of the nature of the average consumer across the notional, objective breadth of the specifications, rather than based upon the subjective views of Mr Hanlon.

13. In relation to the class 3 goods, these are goods used by the general public, of all ages. It is as possible within this class to buy very expensive items as it is to buy them cheaply. The level of attention of the purchaser will vary according to the amount the item costs. It will also vary according to the priorities of the purchaser. For example, someone who just wants shampoo to clean their hair is not likely to give a great deal of thought to the purchase. However, a consumer with highlighted hair may be more interested in the alleged colour retention properties which that shampoo claims. Most people will try perfume before they buy it and may retain a loyalty to a particular scent for years. The level of attention will be greater in this respect. Aesthetics of packaging play a not insignificant part of the purchasing decision in relation to personal care and perfumery goods. There is room for a great variety in the level of attention paid during the purchasing act and also a variety of person within the term average consumer for these goods. The average consumer for the class 3 goods, the general public, is deemed to be reasonably observant and circumspect, but this must be relative to the goods purchased. An expensive perfume may be purchased more irregularly and subjected to greater scrutiny than a bar of soap for the family washbasin.

14. The purchase of class 3 goods is, as evidenced by Mr Hanlon and in my experience, overwhelmingly a visual purchase, whether in a physical retail environment or by way of mail/website ordering. I consider the same to be true of clothing purchase; the Court of First Instance of the European Communities (CFI) has on several occasions found that buying clothing is primarily a visual activity⁴. The level of attention in this area will also vary according to the type and price of the item being bought. Defining the average consumer for clothing and personal care goods (class 3) could start and stop with the ‘general public’, since everyone wears clothes and everyone uses personal care goods, but I think that would be an oversimplification which does not reflect the large variation in item types and pricing.

³ Mr Hanlon is at liberty to sell his mark to a concern which may ultimately use it on goods which are different to those he currently endorses.

⁴See, for example, *Société provençale d'achat and de gestion (SPAG) SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-57/03 and New Look Ltd v OHIM* Joined cases T-117/03 to T-119/03 and T-171/03.

I consider that the ‘average’ consumer is the general public but that the level of attention of that reasonably observant and circumspect average consumer will vary according to economic purchasing power, price of the item, style preference, usage and occasion. I also bear in mind that modern consumers are particularly aware of and frequently loyal to trade marks used to sell goods in classes 3 and 25, for example as a personal lifestyle statement. Those to whom brand loyalty is important are likely to make a considered selection.

Comparison of goods and services

15. Following the established tests in *Canon* and in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281, I must consider the nature of the goods and services, their intended purpose, their method of use, whether the goods or services are in competition with or complementary to each other and also the nature of the users and the channels of trade.

16. Mr Hanlon’s specification covers classes 3 and 25. Of Ltd’s three earlier marks, CTM 4758851 and CTM 4144994 cover goods in classes 3 and 25, while CTM 4190468 is registered for goods in class 14.

17. The class 3 specifications for 4758851 and 4144994 are both:

Perfumery products, cosmetics, essential oils, soaps, talcum powder, shampoos, hair lotions, bath and shower gels, bath salts, not for medical purposes, deodorants for personal use, dentifrices.

Breaking down Ltd’s class 3 specifications by good, I have listed the most obvious comparisons with the class 3 specification of the IR which demonstrate identity below:

Ltd	Christopher Hanlon
perfumery products	perfumery
cosmetics	cosmetics
essential oils	essential oils
soaps	soaps
shampoos	hair shampoos
hair lotions	hair lotions
dentifrices	dentifrices

That leaves talcum powder, bath and shower gels bath salts and deodorants. These are all highly similar to the IR’s body scrubs, eau de toilettes and perfumery/perfumes. Such goods are frequently perfumed, and often form part of a range of goods fragranced with a particular perfume.

18. With regard to class 25, 4758851 and 4144994 both cover :

Clothing and ready-made clothing; bathing suits, dressing gowns, underwear; headgear, caps, bonnets, berets and visors, jerseys, sweaters and pullovers, clothing and trousers, including knitwear; coats, suits,

gabardines, raincoats, gloves, scarves, ties, belts, stockings, socks and shoes of all kinds (except orthopaedic shoes).

The IR includes the terms “clothing, footwear, headgear”, which it can be seen from my underlining are covered by the terms appearing in Ltd’s specification. The goods are clearly identical.

19. I also note that 4144994 includes “retail services” (class 35). In *Oakley, Inc v OHIM*, Case T-116/06, the CFI considered a retail services specification, part of which was unrestricted: “Retail and wholesale services, including on-line retail store services”. The court said:

“59 In the second place, with regard to the comparison of ‘retail and wholesale services, including on-line retail store services’ with the goods in question, it must be recalled that the Court held, in paragraph 50 of *Praktiker Bau- und Heimwerkermärkte*, paragraph 17 above, that the applicant for the Community trade mark must be required to specify the goods or types of goods to which those services relate.

60 In that regard, it must be pointed out that the applicant has, as correctly stated by the Board of Appeal in paragraph 32 of the contested decision, failed to provide any specification whatsoever of the goods or types of goods to which the ‘retail and wholesale services, including on-line retail store services’ relate.

61 Thus, it must be held that ‘retail and wholesale services, including on-line retail store services’, on account of the very general wording, can include all goods, including those covered by the earlier trade mark. Therefore, it must be held that ‘retail and wholesale services, including on-line retail store services’, display similarities to the goods concerned.

62 It follows from all of the foregoing that the Board of Appeal was right to consider that services consisting of ‘retail and wholesale of clothing, headwear, footwear, athletic bags, backpacks and knapsacks and wallets’, and ‘retail and wholesale services, including on-line retail store services’, are similar to the goods covered by the earlier trade mark.”

The judgment means that Ltd’s unrestricted specification for ‘retail services’ will necessarily include retail of class 3 and 25 goods. It follows that there is a high degree of similarity between all the goods of the IR and the class 35 specification of CTM 4144994.

20. Separate considerations apply to CTM 4190468 because this is registered for goods (and for a class) which do not appear in the IR:

Class 14: *Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments.*

Comparing the class 3 goods of the IR, I find that the users will be the same (the general public). The nature and purpose of jewellery is not the same as personal care or cleaning preparations and neither are their methods of use. The channels of trade are not the same, except at a general level such as in large supermarkets or department stores (but see below). They are not in competition with each other. The question which I will go on to answer below is whether there exists a complementary relationship between class 3 goods and those in class 14.

21. Jewellery is for personal adornment; watches are functional but may also be for personal adornment. Their nature, method of use and purpose (other than the fact, at a high level of generality, that they are worn) differ from clothing. Users for both are the general public. The channels of trade may differ or converge; there are specialist outlets for class 14 goods, but equally many clothes shops also sell costume or fashion jewellery side by side. They are not in competition; one would not substitute one for the other. This leaves a question as to whether jewellery and watches are complementary to clothing. These represent Ltd's best case in this class; whatever similarity there may be between clothing and watches/jewellery, the above logic means that there will be less between clothing, precious metals and their alloys and goods in precious metals and coated therewith, precious stones and chronometric instruments.

22. In *Oakley*, the meaning of complementary in the context of a comparison of goods and services was given as:

“52 Regarding, third, the complementary nature of the services and goods in question, found to exist by the Board of Appeal in paragraph 23 of the contested decision, it should be pointed out that, according to settled case-law, complementary goods are those which are closely connected in the sense that one is indispensable or important for the use of the other, so that consumers may think that the same undertaking is responsible for both (see, to that effect, *SISSI ROSSI*, paragraph 49 above, paragraph 60; *PAM PLUVIAL*, paragraph 49 above, paragraph 94; and *PiraÑAM diseño original Juan Bolaños*, paragraph 49 above, paragraph 48).”

Ltd submits that its registrations cover ‘fashion items’ which are identical or similar to the goods of the IR. Although the point is unexpanded, Ltd submits that there is a similarity in nature and purpose between ‘fashion items’, which would include goods in class 14 and classes 3 and 25. It is pertinent to consider what the CFI said in *Mühlens GmbH & Co KG v OHIM* Case T-150/04, where the comparison was between class 3 goods (perfumery and toiletries) and goods in classes 18 and 25 (bags and clothing). The court stated:

“34 In this regard, it is clear from Article 8(1)(b) of Regulation No 40/94 that a likelihood of confusion between two identical or similar marks can exist only within the limits of the principle of speciality, that is to say, where, as has been pointed out at paragraph 27, regardless of the distinctive character which the earlier mark enjoys as a result of the awareness which the relevant public may have of it, the goods or services at issue are identical or similar in the eyes of that relevant public.

35 Nevertheless, it cannot be ruled out, particularly in the fashion and body and facial care sectors, that goods whose nature, purpose and method of use are different, quite apart from being functionally complementary, may be aesthetically complementary in the eyes of the relevant public.

36 In order to give rise to a degree of similarity for the purposes of Article 8(1)(b) of Regulation No 40/94, this aesthetically complementary nature must involve a genuine aesthetic necessity, in that one product is indispensable or important for the use of the other and consumers consider it ordinary and natural to use these products together (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (S/SSI ROSSI)* [2005] ECR II-685, paragraphs 60 and 62).

37 However, the existence of an aesthetically complementary nature between the goods at issue, such as that referred to in the previous paragraph, is not enough to establish similarity between those goods. For that, the consumers must consider it normal that the goods are marketed under the same trade mark, which normally implies that a large number of producers or distributors of these products are the same (*S/SSI ROSSI*, paragraph 63).

38 In the current proceedings, the applicant claims only that the public is accustomed to fashion industry products being marketed under perfume trade marks owing to the practice of granting licences. Yet, if proved, that point alone would not be sufficient to compensate for the absence of similarity between the goods at issue. Such a point does not, in particular, establish the existence of an aesthetically complementary connection between perfumery goods on the one hand and the leather goods and clothing, referred to at paragraph 3 above, on the other hand, so as to mean that one is indispensable or important for the use of the other and that consumers consider it ordinary and natural to use those goods together.

39 The applicant nevertheless claims that the goods at issue have in common their importance for a person's image and appear together in fashion magazines. In this respect, it should be pointed out that, apart from the fact that this argument, which was not pleaded in the hearings before OHIM, has been submitted out of time, the point does not suffice, in any event, to establish the existence of an aesthetically complementary nature, such as that referred to above in paragraph 36."

In *El Corte Inglés SA v OHIM* Case T-443/05, the CFI considered whether there was a complementary relationship between classes 18 and 25:

"44 On the one hand, as regards the second group of goods in class 18 (leather and imitations of leather, animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery), the Board of Appeal rightly held that the distribution channels were different from those used for the distribution of goods in class 25. The fact that those two categories of goods may be sold in the same commercial establishments, such as department stores or supermarkets, is not particularly significant since very different kinds of goods may be found in such shops, without consumers automatically believing that they have the same origin (see, to that effect, Case T-8/03 *El Corte Inglés v OHIM – Pucci (EMILIO PUCCI)* [2004] ECR II-4297, paragraph 43).

45 On the other hand, as regards the first group of goods in class 18, namely leather and imitation leather goods not included in other classes such as, for example, handbags, purses or wallets, it should be noted that those goods are often sold with goods in class 25 at points of sale in both major retail establishments and more specialised shops. That is a factor which must be taken into account in assessing the similarity of those goods.

46 It must be recalled that the Court has also confirmed the existence of a slight similarity between 'ladies' bags' and 'ladies' shoes' (*SISSI ROSSI*, paragraph 42 above, paragraph 68). That finding must be extended to the relationships between all the goods in class 25 designated by the mark applied for and the leather and imitation leather goods not included in other classes, in class 18, designated by the earlier mark.

47 In light of the foregoing, it must be held that there is a slight similarity between the goods in class 25 and the first group of goods in class 18. Consequently, the Board of Appeal could not conclude that there was no likelihood of confusion on the part of the relevant public solely on the basis of a comparison of the goods concerned.

48 As to whether clothing, footwear and headgear in class 25 are complementary to 'leather and imitations of leather, and goods made of these materials and not included in other classes' in class 18, it must be recalled that, according to the case-law, goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for the production of those goods lies with the same undertaking (*SISSI ROSSI*, paragraph 42 above, paragraph 60).

49 Goods such as shoes, clothing, hats or handbags may, in addition to their basic function, have a common aesthetic function by jointly contributing to the external image ('look') of the consumer concerned.

50 The perception of the connections between them must therefore be assessed by taking account of any attempt at coordinating presentation of that look, that is to say coordination of its various components at the design stage or when they are purchased. That coordination may exist in particular between clothing, footwear and headgear in class 25 and the various clothing accessories which complement them such as handbags in class 18. Any such coordination depends on the consumer concerned, the type of activity for which that look is put together (work, sport or leisure in particular), or the marketing strategies of the businesses in the sector. Furthermore, the fact that the goods are often sold in the same specialist sales outlets is likely to facilitate the perception by the relevant consumer of the close connections between them and strengthen the perception that the same undertaking is responsible for the production of those goods.

51 It is clear that some consumers may perceive a close connection between clothing, footwear and headgear in class 25 and certain 'leather and imitations of leather, and goods made of these materials and not included in other classes' in class 18 which are clothing accessories, and that they may therefore be led to believe that the same undertaking is responsible for the production of those goods. Therefore, the goods designated by the mark applied for in class 25 show a degree of similarity with the clothing

accessories included in 'leather and imitations of leather, and goods made of these materials and not included in other classes' in class 18 which cannot be classified as slight."

23. Jewellery is unnecessary for the use of cleaning preparations, toiletries and perfumery and vice versa. Are the goods of an 'aesthetically complementary nature'? It seems to me that if perfumery and clothing are not considered by the CFI to be complementary and therefore not similar, then any link between perfumery and jewellery is even more tenuous. The argument may be stronger where clothing and jewellery is concerned, although not as strong as in *El Corte Inglés* (for shoes and bags). In *Oakley*, the CFI considered how far one can take an argument about aesthetically complementary goods, in particular, with regard to jewellery/watches and clothing:

"85 Notwithstanding the fact that, as held in paragraphs 63 to 70 above, the signs are very similar, there is no similarity whatsoever between, in particular, retail services concerning eyewear, on the one hand, and items of clothing and leather goods, on the other hand. The earlier trade mark does not cover, directly or indirectly, goods similar to 'eyewear, sunglasses, optical goods and accessories, watches, timepieces, jewellery, decals, and posters'.

86 The intervener's argument that eyewear, jewellery and watches could be similar or complementary to items of clothing cannot succeed, since, as correctly pointed out by OHIM, the relationship between those goods is too indirect to be regarded as conclusive. It must be borne in mind that the search for a certain aesthetic harmony in clothing is a common feature in the entire fashion and clothing sector and is too general a factor to justify, by itself, a finding that all the goods concerned are complementary and, thus, similar (*SISSI ROSSI*, paragraph 49 above, paragraph 62)."

24. The inevitable conclusion is that there is no similarity between the goods of CTM 4190466 and those of the IR. There is identity or high similarity between the goods and services of CTMs 4144994 and 4758851 and the IR.



Comparison of the marks

25. The authorities direct that, in making a comparison between the marks, I must have regard to each mark's visual, aural and conceptual characteristics. I have to decide which, if any, of their components I consider to be distinctive and dominant. The likelihood of confusion must be appreciated globally by evaluating the importance to be attached to those different elements, taking into account the degree of similarity in the goods and services, the category of goods and services in question and how they are marketed. However, I should guard against dissecting the marks so as to distort the average consumer's perception of them; the average consumer perceives trade marks as wholes and rarely has the opportunity to compare marks side by side, relying instead upon the imperfect picture he has of them in his mind.

26. Mr Hanlon's counterstatement and witness statement contain comprehensive comparisons of Ltd's marks and the IR. There are points of similarity between Ltd's

three marks, but there are also differences. Although, as stated, the average consumer rarely has the opportunity to compare marks side by side, for the purposes of this legal comparison I will repeat the marks, for convenience.

27.

Ltd's 4144994	IR
	

My immediate observation is that both trade marks appear to contain full personal names (ie. forename and surname). I say 'appear' because Carolina is not a forename which is common in the UK, although Caroline is. Carolina is a location in the USA; however, in preceding the word 'Herrera' the impression is that of a female personal name. The words in the IR, to the UK eye, form a male personal name. The name in Ltd's mark is placed beneath the letters CH, appearing subservient to the letters, which are considerably larger in size. In the IR, it is the surname which is larger than the forename. While the name is also positioned beneath the device element, its size in the overall composition of the trade mark is larger than can be said of the name in Ltd's mark.

28. Ltd's mark clearly contains the letters CH, represented as capitals. Ltd submits that the IR contains "the dominant element 'CH'". Mr Hanlon states that the device in his mark is hand-drawn, almost abstract and is not the letters CH, per se. A capital H is relatively easy to make out – relative, that is, to the capital C which both parties claim also exists. I do not think it is as obvious a 'C' as Ltd suggests. Mr Hanlon describes the presence of the C as "consisting of three arcs...distinctively reversed out of the vertical bars of the H." "This intrinsically unique feature is an exclusive optical illusion using positive and negative spatial relationships...the mind fills in the missing links based on existing spatial relationships." I assume this refers to the absence of a complete C crescent traversing the gap between the pillars of the H and that the eye will compensate, according to what it expects to see. I am not sure that the average consumer would perceive the device as comprising a C and an H without the prompt provided by the initials of the name Christopher Hanlon (to adopt a phrase of Mr Hanlon, the device is "decoded in specific context of the words"). Consumers do not pause to analyse the finer points of trade mark graphic design when making a decision to purchase. The device could be an 'HC' (the H is larger

and more dominant than the C), although I appreciate that if the personal name acts as a prompt, then interpretation as 'CH' is more likely.



29. The letters CH are the dominant element of Ltd's mark. Letters have the capacity to distinguish the goods and services of one undertaking from another; Mr Hanlon's statement that the CH in Ltd's mark is naïve and consists of an ordinary typeface (Bodini) does not diminish this capacity⁵. The device is both distinctive and dominant in the IR. Both marks contain personal names which are by no means negligible, particularly in the IR. Personal names are distinctive; they form one of the earliest methods of differentiating one's goods from those of another. Consumers are accustomed to their use as natural tools of differentiation, whether in trade (the trade marks of department stores and larger retailers, where a great variety of consumer items are sold, are often personal names/surnames) or in other walks of life. Coupled with my comments in relation to the nature of the device in the IR, the difference in personal names means that visually, the marks are quite different, the only similarity being that the forenames begin with C and the surnames with H. Any aural similarity will depend on the consumer being aware that the IR represents a CH. Conceptually, the marks consist of entirely different personal names, the only similarity being that the forenames begin with C and the surnames with H. Conceptually, the marks are similar to the extent that they both contain full names beginning with C and H and to the extent that the average consumer would interpret the IR as containing the letters CH. However, the overall impression is of two very different trade marks; consequently, I find that there is little similarity between them.

30.

⁵ *BORCO-Marken-Import Matthiesen GmbH & Co KG v OHIM* (CFI) Case T-23/07: "43 Not only is it clear from Article 4 of Regulation No 40/94 that Community trade marks may consist of letters, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings (E, paragraph 38; to that effect, see also Case T-441/05 *IVG Immobilien v OHIM* (I) [2007] ECR II-1937, paragraph 47), registration of a sign as a trade mark is not conditional upon a finding of a specific level of creativity or artistic imaginativeness on the part of the applicant for the trade mark (Case C-329/02 *P SAT.1 v OHIM* [2004] ECR I-8317, paragraph 41), but only upon the ability of the sign to distinguish the goods of the applicant from goods offered by competitors (Case T-79/00 *Rewe-Zentral v OHIM* (LITE) [2002] ECR II-705, paragraph 30). As it is, however, the Board of Appeal did not carry out an examination, based on the facts, of the sign at issue in that regard.


.....

56 It follows from all of the foregoing that, by assuming from its lack of graphical modifications or ornamentations that, by definition, the sign at issue lacked distinctive character in relation to the Times New Roman character font, without carrying out an examination as to whether, on the facts, that sign is capable of distinguishing, in the mind of the reference public, the goods at issue from those of the applicant's competitors, the Board of Appeal misapplied Article 7(1)(b) of Regulation No 40/94."

Ltd's 4190468	IR
	

Ltd's mark comprises CH placed on top of HC. It is neither primarily a CH mark or an HC mark, although the natural propensity to read from the top down gives the CH element a degree of prominence over the HC element. It has visual symmetry, particularly diagonally. There are no other elements in Ltd's marks, in contrast to the IR which contains the device, already described, and a male personal name. Ltd's mark does not contain any dominant distinctive element over and above my comments regarding the relative position of the letters; it forms a cohesive, distinctive trade mark. The device in the IR is both distinctive and, by virtue of its presentation (size, appearance and position) is the dominant element, although the personal name is also distinctive and by no means negligible. However, the idea of a representation of CH is much altered in the IR. This would be the only point of similarity between the marks. The marks are visually very different. Any aural similarity would depend upon the average consumer interpreting the device in the IR as a CH or an HC and upon Ltd's mark being referred to as CHHC. Conceptually, the marks are similar to the extent that the average consumer would interpret the IR as containing the letters CH or HC. The overall impression is of two very different trade marks; consequently, I find that there is little similarity between them.

31.

Ltd's 4758851	IR
<p data-bbox="454 1514 523 1559">CH</p>	

Ltd's mark consists entirely of the letters CH. In contrast to the letters in its other two marks, this application for a CTM is categorised on the OHIM trade mark database as 'word only'. It is not represented in the typeface which Mr Hanlon states is Bodini. There are no other elements in Ltd's marks, in contrast to the IR which contains the device, already described, and a male personal name. The letters CH have the capacity to distinguish the goods and are distinctive. The device in the IR is both distinctive and, by virtue of its presentation (size, appearance and position) is the

dominant element, although the personal name is also distinctive and by no means negligible. Whether it conveys a CH is debateable, although I appreciate that if the personal name Christopher Hanlon acts as a prompt, then the device may be interpreted as a 'CH' monogram. This would be the only point of similarity between the marks. The marks are visually very different. Any aural similarity would depend upon the average consumer interpreting the device in the IR as a CH or an HC. Conceptually, the marks are similar to the extent that the average consumer would interpret the IR as containing the letters CH or HC. The overall impression is of two very different trade marks; consequently, I find that there is little similarity between them.

Distinctive character of the Ltd's trade marks

32. The marks are all different in character but are, to a greater or lesser extent, inherently distinctive. Ltd, in its submissions, reproduces paragraph 17 of the decision of David Kitchen Q.C., sitting as the appointed person in *Steelco Trade Mark* (BL O/268/04):

17. The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in *Reed Executive & Ors v. Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become more distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case."

Ltd has not filed any evidence of use and/or reputation in these proceedings. Its claim that the distinctive nature of the marks has been enhanced through reputation is unsubstantiated. I can only consider the inherent distinctive character of the marks, as in the comparisons above.

Likelihood of confusion

32. In considering the likelihood of confusion, I have to bear in mind the nature of the goods and services, the purchasing process and the relevant consumer. The proximity of the goods and services against the relative distance between the marks

(the interdependency principle) must be weighed because a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon*). I must consider the relative importance that the phonetic and visual similarities have in relation to the goods and services during the purchasing process. I must also appraise the distinctive character of the earlier mark, because the more distinctive it is (either *per se* or by reputation), the greater will be the likelihood of confusion (*Sabel*). The distinctive character of a mark must be assessed by reference to the particular goods or services to which it is attached and by reference to the relevant consumer's perception of the mark.

33. I will deal with CTM 4190468 first because in my comparison of goods I found that there was no similarity of goods. The ECJ stated in *Waterford Wedgwood plc v OHIM* Case C-398/07:

“30 According to established case-law, the likelihood of confusion on the part of the public must be assessed globally, taking into account all the relevant factors of the case in hand (see, to that effect, *SABEL*, paragraphs 22, and Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 18).

31 That global assessment of the likelihood of confusion implies some interdependence between the factors taken into account and, in particular, between the similarity of the trade marks and that of the goods or services concerned. Accordingly, a low degree of similarity between the goods or services covered may be offset by a high degree of similarity between the marks, and vice versa. The interdependence of those factors is expressly referred to in the 7th recital of Regulation No 40/94, according to which the concept of similarity is to be interpreted in relation to the likelihood of confusion, the assessment of which depends, in particular, on the recognition of the trade mark on the market and the degree of similarity between the mark and the sign and between the goods or services designated (see, by way of analogy, *Canon*, paragraph 17, and *Lloyd Schuhfabrik Meyer*, paragraph 19).

32 Moreover, given that the more distinctive the earlier mark, the greater will be the likelihood of confusion (*Sabel*, paragraph 24), marks with a highly distinctive character, either *per se* or because of the recognition of them on the market, enjoy broader protection than marks with a less distinctive character (see *Canon*, paragraph 18, and *Lloyd Schuhfabrik Meyer*, paragraph 20).

33 It follows that there may be a likelihood of confusion, notwithstanding a low degree of similarity between the trade marks, where the goods or services covered by them are very similar and the earlier mark is highly distinctive (see, to that effect, *Canon*, paragraph 19, and *Lloyd Schuhfabrik Meyer*, paragraph 21).

34 However, the interdependence of those different factors does not mean that the complete lack of similarity can be fully offset by the strong distinctive character of the earlier trade mark. For the purposes of applying Article 8(1)(b) of Regulation No 40/94, even where one trade mark is identical to another with a particularly high distinctive character, it is still necessary to adduce evidence

of similarity between the goods or services covered. In contrast to Article 8(5) of Regulation No 40/94, which expressly refers to the situation in which the goods or services are not similar, Article 8(1)(b) of Regulation No 40/94 provides that the likelihood of confusion presupposes that the goods or services covered are identical or similar (see, by way of analogy, *Canon*, paragraph 22).

35 It must be noted that the Court of First Instance, in paragraphs 30 to 35 of the judgment under appeal, carried out a detailed assessment of the similarity of the goods in question on the basis of the factors mentioned in paragraph 23 of the judgment in *Canon*. However, it cannot be alleged that the Court of First Instance did not take into account the distinctiveness of the earlier trade mark when carrying out that assessment, since the strong reputation of that trade mark relied on by Waterford Wedgwood can only offset a low degree of similarity of goods for the purpose of assessing the likelihood of confusion, and cannot make up for the total absence of similarity. Since the Court of First Instance found, in paragraph 35 of the judgment under appeal, that the goods in question were not similar, one of the conditions necessary in order to establish a likelihood of confusion was lacking (see, to that effect, *Canon*, paragraph 22) and therefore, the Court of First Instance was right to hold that there was no such likelihood.”

I found that the marks share little, if any similarity, but even if I had found that the marks were similar to a high degree, the goods are dissimilar. Ltd cannot succeed under 5(2)(b) where there is dissimilarity of goods. The section 5(2)(b) ground fails in relation to CTM 4190468.

34. CTM 4144994 (CH CAROLINA HERRERA) and the IR both contain personal names. Both the forenames and surnames are entirely different and, furthermore, point to different genders. The name in the IR, to the average relevant consumer in the UK will be seen as a typical English male forename/surname combination. In contrast, the name in Ltd’s mark has the appearance of a female forename/surname combination of possible Mediterranean origin. There is nothing about the names which are similar beyond their initials; they would not be confused or even associated. The question is whether the combination of a name and letters as opposed to a (different) name and letters which are allegedly the same, and which intricately forming a device, would lead the average consumer in the UK to be confused as to the origin of the goods. The public are used to differentiating between personal names, even when they are similar: that is what names are for⁶. Despite the close proximity of the goods and services and supposing an average level of attention at purchase, I think that confusion is unlikely in the extreme. The marks are very different visually; aurally, the only point of similarity is a possible enunciation of the device in the IR. Given that there is a much more readily accessible way of referring to the IR, ‘Christopher Hanlon’, and that the purchasing

⁶ *Buler Trade Mark* [1966] RPC 141, Buckley J: “It seems to me that surnames stand in a different position from the point of view of spelling from ordinary words in the English language, for spelling is a matter of considerable importance in distinguishing one surname from another. One may easily understand the meaning of an ordinary word in the English language, although it is misspelt: but if one finds a surname spelt in a way which one does not expect it to be spelt one is immediately put upon enquiry as to whether or not it is the name of some other person than the person to whom one supposed the name to belong”.

process is visual rather than aural, this is insufficient to lead to a conclusion in favour of Ltd. The concept of the marks consisting of a name plus corresponding initial letters is similar on too superficial a level to cause direct or indirect confusion (in the sense of linked undertakings). The section 5(2)(b) ground fails in relation to CTM 4144994.

35. With regard to CTM 4758851 (CH), it is pertinent to consider the judgment of the CFI in *Calvin Klein Trademark Trust v OHIM* Case T-185/07:

“47 The mere visual resemblance, therefore, of the sole or dominant figurative element ‘ck’ in the earlier marks and the element ‘ck’ in the mark applied for does not serve to create a visual similarity between the marks at issue, in the light of the overall impression created by the mark CK CREACIONES KENNYA and the specific graphic representation which characterises the earlier marks, namely the smaller size and centring of the letter ‘c’ in relation to the letter ‘k’.

48 In that regard, it is important to point out, as the Board of Appeal stated in paragraph 23 of the contested decision, that the examination of the similarity of the marks at issue takes into consideration those marks in their entirety, as they have been registered or as they have been applied for. A word mark is a mark consisting entirely of letters, of words or of associations of words, written in printed characters in normal font, without any specific graphic element. The protection which results from registration of a word mark concerns the word mentioned in the application for registration and not the specific graphic or stylistic elements accompanying that mark. The graphic representation which the mark applied for may have in the future must not, therefore, be taken into account for the purposes of the examination of similarity (see to that effect, Case T-211/03 *Faber Chimica v OHIM – Naberska (Faber)* [2005] ECR II-1297, paragraphs 36 and 37; Case T-353/04 *Ontex v OHIM – Curon Medical (CURON)* [2007], not published in the ECR, paragraph 74; and Case T-254/06 *Radio Regenbogen Hörfunk in Baden v OHIM (RadioCom)*, not published in the ECR, paragraph 43).”

I have to consider Ltd’s CH mark, applied for without specific or stylistic graphic representation, against the whole of the IR, which includes a highly stylised device which could be perceived as the letter CH. They are entirely different visually and aurally; as I have said, I think it more likely that the IR would be referred to by the personal name it contains. Allowing for a scenario where the IR is referred to as CH, Ltd still has to clear the hurdle that the purchasing process is primarily visual and that more weight must be accorded to visual perception⁷. The IR is a much more

⁷ In *New Look Ltd v OHIM* Joined cases T-117/03 to T-119/03 and T-171/03, the CFI stated: “49 However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

complex mark than Ltd's and I consider that they are conceptually far removed from one another, even allowing for the device in the IR containing the letters C and H. The ground fails also in relation to this earlier right.

Conclusion

36. There is no likelihood of confusion between the IR and any of the three earlier marks relied upon by Ltd. The opposition is dismissed.

Costs

37. Christopher Hanlon has been successful and is entitled to a contribution towards costs.

Considering notice of opposition	£50
Filing counterstatement	£100
Filing evidence	£200
Total	£350

38. In calculating the above costs, I have taken into account the fact that Christopher Hanlon has not been legally represented and the guidance given by the appointed persons on the relevance of this factor⁸.

Accordingly, I order Carolina Herrera Ltd to pay to Christopher Hanlon the sum of £350. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 16th day of September 2009

**Judi Pike
For the Registrar,
the Comptroller-General**

⁸ See the decisions of Mr Simon Thorley QC in *Adrenalin* (BL O/040/02) and Mr Richard Arnold QC in *South Beck* (BL O/160/08).

