

O-069-17

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3150004 BY
CHIEMEKA EJIOCHI
TO REGISTER:**

alaanyi

AS A TRADE MARK IN CLASSES 24, 25, 27 & 42

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 406759 BY DM-DROGERIE MARKT GMBH + CO. KG**

BACKGROUND & PLEADINGS

1. On 16 February 2016, Chiemeka Ejiochi (“the applicant”) applied to register **alaanyi** as a trade mark for goods and services in classes 24, 25, 27 and 42 (the full specifications are shown in the Annex to this decision). The application was published for opposition purposes on 11 March 2016.

2. The application is opposed by dm-drogerie markt GmbH + Co. KG (“the opponent”) under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”); the opposition is directed against the goods and services shown in paragraph 11 below. The opponent relies upon the goods (also shown in paragraph 11 below) in the following International Registration designating the EU (“IREU”):

No. 1123649 for the trade mark: **ALANA** which designated the EU on 30 January 2012 (claiming an International Convention priority date of 2 August 2011 from an earlier filing in Germany) and which was granted protection on 2 August 2016.

3. The applicant filed a counterstatement in which the basis of the opposition is denied. As these are the only comments I have from the applicant, they are reproduced below in full:

“The origins of my trade mark, Alaanyi are Igbo; a language spoken around the world and originating in Southeast Nigeria. Alaanyi is comprised of two Igbo words. “ala” (pronounced “a-lah”) meaning “our”; and “anyi” (pronounced “an-yee”) meaning land. Spoken together these words imply a meaning close to the English word “homeland”. My mark Alaanyi would therefore be pronounced as “alan-yee”. From an aural perspective, this constitutes a marked difference from the pronunciation of the opponent’s mark of Alana which would be pronounced “alan-ah”.

It is also my belief that the two marks are significantly different visually. The presence of two juxtaposed “a’s in the midst of Alaanyi is not easily overlooked.

Because this phoneme does not occur naturally in the English language, it will set Alaanyi apart from other more Anglo-centric marks. This combined with the fact that Alaanyi is 2 letters longer than ALANA supports my argument that one mark could not be easily confused for the other.”

4. In these proceedings, the opponent is represented by Kilburn & Strode LLP; the applicant is unrepresented; only the opponent filed evidence. Although neither party elected to attend a hearing, the opponent filed written submissions in lieu of attendance.

The opponent’s evidence

5. This consists of a witness statement from Lorraine Newell Neale a Solicitor at Kilburn & Strode. Ms Neale explains that she has:

“1...conducted research online and note that it is common for clothing to be co-branded i.e. branded under the clothing manufacturer’s trade mark, but also branded with the fabric manufacturer’s trade mark.”

6. In support of the above, Ms Neale provides exhibits in relation to GORE-TEX® fabric (exhibits LLN1-LLN5), LYCRA® Fiber (exhibits LLN6-LLN9) and the Woolmark Certification Trade Mark® (exhibit LLN10). Although I have reviewed these exhibits, it is not necessary for me to summarise their contents here. I will keep them in mind and, if necessary, refer to them later in this decision.

DECISION

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

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

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

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

8. An earlier trade mark is defined in section 6 of the Act, which states:

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

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

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

9. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 2 above which qualifies as an earlier trade mark under the above provisions. As this trade mark had not been registered for more than five years at the date when the application was published, it is not subject to proof of use, as per section 6A of the Act. The opponent can, as a consequence, rely upon all of the goods it has identified.

Section 5(2)(b) – case law

10. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-

342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles:

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

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

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

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

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

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

Comparison of goods and services

11. The competing goods and services are as follows:

The opponent's goods	The applicant's goods and services
Class 21 - Glassware, porcelain, earthenware, not included in other classes; cups of paper and/or plastic;	Class 24 - Cloth; Coasters of textile; Coated textiles; Coated woven textile materials; Composite textile materials; Cotton base mixed fabrics; Cotton fabric;
Class 25 - Clothing, footwear, headgear	Cotton fabrics; Elastic woven material;

	<p>Elastic woven materials; Elasticated woven textile materials; Fabric; Fabric for use in the manufacture of clothing; Fabrics made from cotton, other than for insulation; Fabrics made from natural fibres, other than for insulation; Fabrics made of mixed synthetic and natural fibres, other than for insulation; Textile fabrics; Textile fabrics for making into clothing; Textile fabrics for the manufacture of clothing; Textile fabrics for use in manufacture; Textiles for making up into articles of clothing.</p> <p>And (see paragraph 12 below):</p> <p>Textile material.</p> <p>Class 25 - Blouses; Casual clothing; Clothing; Hats; Sun hats.</p> <p>Class 42 - Design of clothing; Design of clothing, footwear and headgear; Design of fashion accessories; Design services for clothing; Designing of clothing.</p> <p>And (see paragraph 12 below):</p> <p>Clothing design services, Dress design Fashion design, Fashion design consulting services.</p>
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12. Insofar as the opposition to classes 24 and 42 of the application are concerned, the goods and services above (shown in bold in the Annex to this decision) were specifically identified by the opponent in both its Notice of Opposition and written submissions. Having reviewed the opponent's claim in light of the comments of the Appointed Person, Mr Geoffrey Hobbs Q.C. in *Hench Nutrition Limited and Ademola Adeyeba and Get Hench Ltd – BL – O/242/14*), it is, in my view, logical to assume that (save for an oversight on the opponent's part), the scope of the opposition should be construed as also relating to "textile material" in class 24 and to "Clothing design services" and "Dress design" in class 42 (underlined in the Annex); that, in my view, is likely to be uncontroversial. Although I accept less clear cut, given the meaning of "fashion" in collinsdictionary.com i.e. "the area of activity that involves styles of clothing and appearance", I think the same applies to "Fashion design" and "Fashion design consulting services" in class 42 (also underlined in the Annex); it is on that basis I intend to proceed.

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

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

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

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;

- c) The respective trade channels through which the goods or services reach the market;
- d) 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;
- e) 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.

In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in *Case C-307/10 The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in

question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the General Court (“GC”) stated:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

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

In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel

Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

14. I begin by noting that in its counterstatement, the applicant did not deny the opponent’s original claims (contained in its Notice of opposition and which are substantially the same as those reproduced below) as to the identity/similarity between the competing goods and services; I will, regardless, conduct a full comparison.

Class 24

15. The opponent’s arguments in this class are twofold. In relation to “Coasters of textile”, in its submissions, it states:

“38. The “coasters of textile” [in the application] are similar to “glassware, porcelain, earthenware, cups of paper and/or plastic” in class 21. The goods are related in that the class 21 goods of the earlier registration would be placed on the coasters subject of the opposition. The goods are complementary and therefore similar.”

16. That, in my view, is a desperate submission. Although the users of the competing goods may be the same, that tells one very little. The nature of the goods is different as is their intended purpose and method of use. They are unlikely to be routinely sold in

the same area of either a bricks and mortar retail outlet or in the same area of a website. The competing goods are not complementary in the sense that one is indispensable or important for the use of the other. The opponent's argument is, on the most generous reading, akin to the "wine" and "glassware" example mentioned above; an argument which the AP rejected. In my view there is no similarity between the applicant's "coasters of textile" and the opponent's named goods in class 21. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

"49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity."

17. Having concluded that there is no similarity between the opponent's goods and the applicant's "coasters of textile" in class 24, there can be no likelihood of confusion and the opposition to these goods fails and is dismissed accordingly.

18. In relation to the remaining goods in class 24 which are opposed, the opponent states:

"37. The above [i.e. Ms Neale's evidence] serves to highlight that the [class 24 goods opposed] are closely associated with the class 25 goods of the earlier registration. It is common for brands of clothing to be used alongside brands for textiles, fabric and other materials, which are used in the construction of the clothing itself. Consumers are used to seeing the marks being used side by side and in conjunction with one another as part of marketing and promotional activity."

19. The applicant's specification includes a number of broad terms which would include a wide range of textiles with a wide range of applications. However, as it specifically refers to "fabric for use in the manufacture of clothing", "textile fabrics for making into clothing", "textile fabrics for the manufacture of clothing" and "textiles for making up into articles of clothing", I must proceed on the basis that the goods which are unlimited may be used in the making up into/manufacture of clothing.

20. Although the opponent filed evidence to demonstrate the connection between the applicant's goods in this class and its goods in class 25, Ms Neale's evidence does no more than reflect what, in my experience, has been a pattern of trade which has been in existence for many years. Bearing that in mind and given what is likely to be the similarity in the users, intended purpose, method of use and trade channels through which the competing goods reach the market combined with the obvious complementarity between them, I find that the opponent's goods in class 25 are similar to the applicant's named goods in class 24 to at least a medium degree. However, as many of the terms in the applicant's specification are broad enough to include a multitude of uses other than in relation to clothing, it may be appropriate to invite the applicant to offer a fall-back specification; I will, if necessary, return to this point later in my decision.

Class 25

21. Both specifications include a reference to "clothing"; these goods are literally identical. As (i) "blouses" and "casual clothing" and (ii) "hats" and "sun hats" in the application are encompassed by (i) "clothing" and (ii) "headgear" in the opponent's specification in this class, the competing goods are to be regarded as identical on the principles outlined in *Meric*.

Class 42

22. The applicant seeks registration in respect of a range of, broadly speaking, design services relating to clothing, footwear, headgear and fashion. In its submissions, the opponent states:

“39. The class 42 services of the opposed application are similar to the class 25 goods of the earlier registration. There is a degree of similarity between clothing and fashion design services since the respective goods/services share the same relevant public. Further, the goods/services might also coincide in originating from the same producer or provider. It is common that the producers of ready-made clothing, such as suits or wedding dresses, also provided tailoring services. These are obviously closely related to fashion design which is part of the clothing production process...”

23. The opponent’s submission to the effect that undertakings that design clothing, footwear, headgear etc. also conduct a trade in such goods is unsurprising. It reflects my own experience and, more importantly, is likely to reflect the average consumer’s view of the matter. The applicant’s services I have identified are, as a consequence, complementary to the opponent’s goods in class 25 in these sense that one is important for the use of the other such that the average consumer will think that the responsibility for both lies with the same undertaking. The well-established connection between the goods and services at issue results, in my view, in at least a medium degree of similarity.

The average consumer and the nature of the purchasing act

24. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods and services; I must then determine the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios*

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

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

25. The opponent states:

“15. The goods covered [by the competing trade marks] will be purchased from a variety of retail establishments including online. The average consumer of the goods at issue will be a member of the general public.”

26. The opponent refers to the decision of the GC in *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, in which it stated that:

“50. The applicant has not mentioned any particular conditions under which the goods are marketed. Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

27. The opponent further states:

“16. We consider that the observations [above] would also be pertinent to the selection and purchase of the class 24 goods. In particular, those which are to be used in the manufacture of clothing. Further, we consider the principles to apply also to the selection of class 42 services. The services are connected to the clothing and fashion industry. It may also be that beyond the visual perception of the respective marks, the aural element may play a stronger role in connection with class 42 services, where the service may be recommended or selected aurally.

17...The goods may be purchased physically on the high street or by mail order. The level of attention paid will be reasonable for the goods in class...25. The consumer will pay attention to obtain e.g. the correct size, colour and fit of clothing, footwear or headgear...Likewise, reasonable attention will be paid when selecting the class 24 goods to ensure that colours and fabrics/textiles are appropriate. In particular if being used for clothing. A similar approach would be taken in respect of the selection of the relevant design services in class 42.”

28. While I agree with the opponent that the average consumer of all the goods and services at issue is a member of the general public, I would add that in relation to, in particular, the services in class 42, business users should also be kept in mind. I also agree (for the reasons mentioned by the GC and the opponent) that while aural considerations must not be overlooked (particularly in relation to the services in class 42) visual considerations are likely to dominate the selection process. If by “reasonable” the opponent meant a normal degree of attention will be paid during the selection process then, once again, I agree.

Comparison of trade marks

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

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

30. It would be wrong, therefore, artificially to dissect the trade marks, although, it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create. The trade marks to be compared are as follows:

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31. Both parties' trade marks consist of single words presented in upper case and lower case letters respectively. As no part of either trade mark is emphasised or highlighted in any way, the overall impression they convey and their distinctiveness lies in their totalities.

32. The applicant's views on the degree of visual, aural and conceptual similarity between the competing trade marks is shown in paragraph 3 above. In relation to the visual comparison, the opponent states:

"21. The respective marks share the prefix ALA. The suffix elements –ANA and -ANYI share the letters AN. The double letter "A" does not contribute to a significant visual difference. It is submitted that the opponent's mark and the applicant's mark are visually similar...If viewed from a distance, or if misremembered, having regard to the imperfect recollection of consumers, then it is evident that the shared letters result in a mark which is visually similar. One may consider the marks to comprise the following letters ALA(A)N."

33. The competing trade marks consists of five and seven letters respectively; they share the same first three letters "A-L-A" and the letters "A-N" in the third and fourth and fourth and fifth letter positions respectively. The applicant's trade mark contains an additional letter "A" in the fourth letter position and the competing trade marks differ in that they end with a letter "A" and letters "YI" respectively. In so far as the double letter "A" in the applicant's trade mark is concerned, I think it creates a more significant visual difference than the opponent suggests. It is, of course, a well-established rule of thumb that the beginning of a trade mark is likely to be more important than its ending. Balancing the similarities and differences I have identified, I consider there to be at least a medium degree of visual similarity between the competing trade marks.

34. In relation to the aural comparison, the opponent states:

"23. The respective marks would be pronounced "ALAN-AH" and "ALAN-YEE"/"ALAN-YEH" respectively. From an aural perspective, the element ALA(A)N is shared between the marks. The double letter "A" does not contribute to a difference in terms of pronunciation. The suffixes –A/-YI respectively can have a similar pronunciation.

24. In its counterstatement the applicant indicated that the origin of the opposed mark is from the Nigerian language. The explanation of the pronunciation of the marks corresponds approximately with our view of the likely pronunciation and similarities between the marks.”

35. The parties agree, as do I, that the opponent’s trade mark will most likely be pronounced as ALAN-AH. Although the pronunciation of the applicant’s trade mark is, in my view, far less certain, the applicant suggests it will be articulated as ALAN-YEE; the opponent agrees but suggests ALAN-YEH as an alternative. When articulated, both trade marks will begin with the sound created by the letters ALAN. Although their endings differ (which is likely to be of less significance), there is, once again, at least a medium degree of aural similarity between the trade marks at issue.

36. Finally, in relation to the conceptual comparison, the opponent states:

“25. Although the applicant has indicated that the origin of their trade mark is in the Nigerian language this would not be evident to many consumers in the UK. There is no conceptual similarity to speak of...”

37. The opponent’s trade mark will be understood as a feminine forename. While I note the derivation of the applicant’s trade mark, I agree with the opponent that this meaning will not be known to the average consumer in this country. The applicant’s trade mark may, for example, be construed as an invented word (with no meaning) or a word from an unspecified foreign language (the meaning of which will be unknown). In short, the opponent’s trade mark will convey a concrete conceptual message whereas the applicant’s will not.

Distinctive character of the earlier trade mark

38. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the

way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

39. Although the opponent has filed evidence in these proceedings, as none of this evidence was directed to the use it may have made of its earlier trade mark, I have only its inherent credentials to consider. As I mentioned above, ALANA will be known as a feminine forename albeit, in my experience, one that is not terribly common. Although feminine forenames are fairly commonplace as designations of origin in the fashion and clothing sectors, as a relatively uncommon forename, the opponent's earlier trade mark is, in my view, possessed of an average degree of inherent distinctive character.

Likelihood of confusion

40. 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 respective goods and services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision I concluded that:

- the remaining goods in the applicant's specification in class 24 and its services in class 42 are similar to the opponent's goods in class 25 to at least a medium degree;
- the competing goods in class 25 are identical;
- the average consumer of the goods and services at issue is a member of the general public (including business users) who are likely to make their selection by predominately visual means paying a normal degree of attention during that process;
- the overall impression created by the competing trade marks and their distinctiveness lies in their totalities;
- the competing trade marks are visually and aurally similar to at least a medium degree;
- the opponent's trade mark will convey a clear conceptual message whereas the applicant's trade mark will not;
- the earlier trade mark is possessed of an average degree of inherent distinctive character.

41. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks/goods and services down to the responsible undertakings being the same or related.

42. In *The Picasso Estate v OHIM*, Case C-361/04 P, the CJEU found that:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it

can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

However, in *Nokia Oyj v OHIM*, Case T-460/07, the GC stated that:

“Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established (see, to that effect, Case C-16/06 P *Éditions Albert René* [2008] ECR I-0000, paragraph 98).”

43. In reaching a conclusion, I begin by reminding myself that the competing goods and services are either identical or similar to at least a medium degree and that the trade marks at issue are visually and aurally similar also to at least a medium degree. However, I have also concluded that the opponent’s trade mark will create a concrete conceptual image in the mind of the average consumer (of a feminine forename) whereas the applicant’s trade mark will not convey any conceptual message. Although I am conscious of the guidance in *Nokia*, each case turns on its own facts and I am satisfied that the very clear conceptual message conveyed by the opponent’s trade mark, a message which will, in turn, act as a hook in the mind of the average consumer (paying a normal degree of attention during the selection process) and thus aid their recall, is sufficient to avoid a likelihood of either direct or indirect confusion.


Conclusion

44. The opposition has failed and, subject to any successful appeal, the application will proceed to registration.

Costs

45. As the applicant has been successful he is, in principle, entitled to a contribution towards his costs. As the applicant is unrepresented, at the conclusion of the evidence rounds the tribunal invited him to indicate if he intended to make a request for an award of costs, and if so, to complete a pro-forma indicating a breakdown of his actual costs, including providing accurate estimates of the number of hours spent on a range of activities relating to the prosecution of the opposition; it was made clear to the applicant that if the pro-forma was not completed "no costs will be awarded". As the applicant did not respond to that invitation, I make no award of costs.

Dated this 15th day of February 2017

A handwritten signature in black ink, appearing to be 'C J Bowen', written over a horizontal line.

C J BOWEN

For the Registrar

The Comptroller-General

The applicant's specifications

Class 24 - Bed coverings; **Cloth; Coasters of textile; Coated textiles; Coated woven textile materials; Composite textile materials; Cotton base mixed fabrics; Cotton fabric; Cotton fabrics;** Duvet covers; **Elastic woven material; Elastic woven materials; Elasticated woven textile materials; Fabric; Fabric for use in the manufacture of clothing;** Fabrics for furniture; Fabrics for interior decorating; Fabrics for the manufacture of furnishings; **Fabrics made from cotton, other than for insulation; Fabrics made from natural fibres, other than for insulation; Fabrics made of mixed synthetic and natural fibres, other than for insulation; Textile fabrics; Textile fabrics for making into clothing;** Textile fabrics for making up into household textile articles; **Textile fabrics for the manufacture of clothing; Textile fabrics for use in manufacture;** Textile fabrics for use in the manufacture of furniture; Textile material; Textiles for interior decorating; **Textiles for making up into articles of clothing;** Textiles for upholstery; Throws; Upholstery fabrics; Upholstery materials.

Class 25 - Blouses; Casual clothing; Clothing; Hats; Sun hats.

Class 27 - Area rugs; Carpets; Cloth wall coverings; Mats; Rugs.

Class 42 - Advisory services relating to architecture; Advisory services relating to building design; Advisory services relating to interior design; Architectural advisory services; Architectural and engineering services; Architectural consultancy; Architectural consultancy services; Architectural consultation; Architectural consultation services; Architectural design; Architectural design for exterior decoration; Architectural design for interior decoration; Architectural design for town planning; Architectural design services; Architectural design

services relating to exhibitions; Architectural planning services; Architectural plans (preparation of-); Architectural project management; Architectural services; Architectural services for the design of buildings; Architectural services for the design of commercial buildings; Architectural services for the design of industrial buildings; Architectural services for the design of office facilities; Architectural services for the design of retail premises; Architectural services for the design of shopping centers; Architectural services for the preparation of architectural plans; Architectural services relating to land development; Architectural services relating to the development of land; Architecture; Architecture consultancy services; Architecture design services; Architecture services; Architecture services for the preparation of architectural plans; Art work design; Brand design services; Clothing design services; Commercial design services; Commercial interior design; Computer aided design services; Computer aided design services relating to architecture; Computer aided design services relating to building projects; Consultancy relating to selection of curtaining [interior design]; Consultancy relating to selection of furnishing fabrics [interior design]; Consultancy relating to selection of loose covers for furniture [interior design]; Consultancy services relating to architecture; Consultancy services relating to design; Consultancy services relating to interior design; Consultation services relating to architectural planning; Consultation services relating to interior design; Consumer product design; Decor (Design of interior -); Design consultancy; Design consultation; Design of building interiors; Design of buildings; Design of carpets; **Design of clothing; Design of clothing, footwear and headgear; Design of fashion accessories**; Design of floor coverings; Design of furnishings; Design of furniture; Design of interior decor; Design of interior decoration; Design of jewellery; Design of layouts for office furniture; Design of layouts for offices; Design of manufacturing methods; Design of products; Design of restaurants; Design planning; Design services; Design services for building interiors; **Design services for clothing**; Design services for furniture; Design services relating to shop interiors; **Designing of clothing**; Designing of furniture; Designing of jewellery; Draftsman's services; Draughtsman's services; Dress

design; Fashion design; Fashion design consulting services; Furniture design;
Information services relating to the combination of colours, paints and furnishings
for interior design; Information services relating to the harmonisation of colours,
paints and furnishings for interior design; Interior and exterior design services;
Interior decor design; Interior decorating design; Interior decoration consultation;
Interior design; Interior design services; Interior design services and information
and advisory services relating thereto; Interior space planning services; Pattern
design; Professional consultancy relating to architecture; Styling; Textile design
services.