

O/1100/22

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATION NO. UK3669493
IN THE NAME OF SELAMI KARATAS
TO REGISTER AS A TRADE MARK**

JewelleryGemBox

IN CLASS 14

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 429108
BY JEWELLERYBOX LTD**

BACKGROUND AND PLEADINGS

1. On 16 July 2021, Selami Karatas (“the applicant”) applied to register trade mark number UK3669493 for the mark “**JewelleryGemBox**” in the United Kingdom. The application was accepted and published for opposition purposes on 10 September 2021, in respect of goods in Class 14, as listed under paragraph 17 of this decision.

2. The application is opposed by jewellerybox Ltd (“the opponent”). The opposition was filed on 10 December 2021 and is based upon Section 5(2)(b)¹ of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all of the goods in the application. The opponent relies upon the following comparable marks:

jewellerybox

UK trade mark registration number 914056071

Filing date: 12 May 2015

Registration date: 19 October 2015

Registered in Class 14

Relying on all goods (as listed under paragraph 17 of this decision)

(“**Mark 1**”); and

jewellerybox

UK trade mark registration number 914056113

Filing date: 12 May 2015

Registration date: 13 October 2015

Registered in Class 14

Relying on all goods (as listed under paragraph 17 of this decision).

(“**Mark 2**”)

¹ The grounds under sections 5(3) and 5(4)(a) as originally filed were deemed withdrawn by the Registry following failure by the opponent to file evidence in support of the same. In an email dated 8 June 2022, the opponent confirmed that the proceedings should progress based on Section 5(2)(b) only.

3. On 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing registered EUTM or International Trade Mark designating the EU. As a result, the opponent's marks were each converted into a comparable UK trade mark. Comparable UK marks are now recorded in the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.²

4. The opponent submits that the opposing marks are highly similar, and that the applicant's goods are identical or at least similar to the goods covered by the opponent's registrations, the combination of which creates a likelihood of confusion. The opponent submits that the application should therefore be refused under section 5(2)(b) of the Act.

5. The applicant filed a counterstatement denying the claims of the opposition in its entirety, however, it admits that some of the goods of the application are similar to the goods covered by the earlier marks, but does not state to what degree.

6. Only the opponent filed written submissions which will not be summarised, but will be referred to as and where appropriate during this decision. Only the applicant elected to file evidence, which will be summarised to the extent considered necessary. Neither party requested a hearing, therefore this decision is taken following careful consideration of the papers.

7. In these proceedings, the opponent is represented by Beck Greener LLP and the applicant is a litigant in person.

Evidence

8. The applicant filed evidence by way of a witness statement dated 11 July 2022 in the name of Selami Karatas. Mr Karatas adduces four exhibits in support of the

² See also Tribunal Practice Notice ("TPN") 2/2020 End of Transition Period – impact on tribunal proceedings.

application, labelled Exhibit 1 – Exhibit 4, accordingly. The main purpose of the evidence is to demonstrate the applicant's online presence, with the exhibits comprising screenshots showing the goods being offered for sale under the mark on platforms such as ebay, Etsy, and the applicant's own website, www.jewellerygembox.com, as well as showing seller reviews for JewelleryGemBox on Amazon. Mr Karatas states he has been selling the goods to customers in the UK and overseas since 2004.

9. I have read and considered all of the evidence and I will refer to the relevant parts at the appropriate points in the decision.

DECISION

10. Although the UK has left the European Union, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. Therefore, this decision contains references to the trade mark case-law of the European courts.

Section 5(2)(b)

11. Section 5(2)(b) of the Act reads as follows:

“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”.

12. Section 5A states:

“Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

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

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

(a) a registered trade mark, international trade mark (UK), European Union 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,

(aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

...”

14. Given their filing dates, each of the trade marks upon which the opponent relies qualify as an earlier trade mark under the above provisions. The earlier marks were registered more than 5 years before the date of application of the contested mark and so the applicant could have required the opponent to provide proof of use of the marks under section 6A of the Act. As it did not do so, the opponent is able to rely on all the goods for which the earlier marks are registered.

My Approach

15. The Class 14 goods covered by each of the earlier marks are identical. The opponent's Mark 1 is a word only mark, which may be used in any standard font or colour, whilst Mark 2 is a stylised version of the same. I therefore consider that Mark 1 represents the opponent's strongest case. In the event that I find a likelihood of confusion in respect of Mark 1, any finding of confusion in respect of the remaining mark does not further the opponent's case. If, however, I find no likelihood of confusion between the applicant's mark and the opponent's Mark 1, it follows that the same finding will apply to Mark 2 on the basis that it shares a lesser degree of similarity with the contested application. I will therefore focus my assessment under section 5(2)(b) on the opponent's Mark 1 only, which going forward, I will refer to as "the opponent's mark". If required, I will address this point further when considering any final remarks at the conclusion of this decision.

16. I am guided by the following principles which 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 Office for Harmonisation in the Internal Market (Trade Marks and Designs) ("OHIM")*, Case C-3/03, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

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

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a 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 to mind the earlier mark, 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

17. The goods to be compared are:

Opponent's goods	Applicant's goods
<p><u>Class 14</u></p> <p><i>Agates; Alarm clocks; Alarm watches; Alloys of precious metal; Amulets; Amulets being jewellery; Amulets [jewellery]; Amulets [jewellery, jewelry (Am)]; Ankle bracelets; Artificial gem stones; Artificial stones [precious or semi-precious]; Badges of precious metal; Bands for watches; Bangle bracelets; Bangles; Barrels [clock and watch making]; Barrels [clock and watchmaking]; Beads for making jewelry; Body-piercing rings; Body-piercing studs; Bottle caps of precious metals; Bracelets; Bracelets and watches combined; Bracelets for watches; Bracelets [jewellery, jewelry (Am)]; Bracelets [jewelry]; Bracelets of precious metal; Brooches [jewellery, jewelry (Am)]; Buckles for watchstraps; Busts of precious metal; Busts of precious metals; Cabinets for clocks; Chain mesh of precious metals [jewellery]; Chain mesh of semi-precious metals; Chains for watches; Chains [jewellery, jewelry (Am)]; Chains made of precious metals [jewellery]; Chains of precious metals; Chains (Watch -); Chalcedony; Charity bracelets; Charms in precious metals or coated therewith; Charms [jewellery, jewelry (Am)]; Charms [jewellery] of common metals; Charms of precious metals; Charms of semi-precious</i></p>	<p><u>Class 14</u></p> <p><i>Silver stud; silver drop earrings; silver dangle earrings; silver hoop earrings; silver huggies; silver bracelet; silver bangle; silver charm; silver locket; silver pendant; silver thimble; silver brooch; silver bookmark; silver money clips; silver chain; curb chain; snake chain; silver necklace; silver cufflinks; gemstones; onyx; Amethyst; jade; emerald; turquoise; opal; lapis lazuli; topaz; agate; citrine; ruby; peridot; jasper; pearl; gold chain; gold locket; gold pendant; gold bracelet; gold bangle; gold brooch; gold earrings; gold hoop; gold stud; ; Gems; Olivine [gems]; Natural gem stones; Artificial gem stones; Chalcedony used as gems; Jewellery; Jewellery, including imitation jewellery and plastic jewellery; Precious and semi-precious gems; Ornaments [jewellery]; Enamelled jewellery; Wristlets [jewellery]; Bracelets [jewellery]; Pearls [jewellery]; Shoe jewellery; Imitation jewellery; Fashion jewellery; Costume jewellery; Facial jewellery; Jade [jewellery]; Necklaces [jewellery]; Precious jewellery; Cloisonné jewellery; Paste jewellery; Artificial jewellery; Charms [jewellery]; Pendants [jewellery]; Jewellery items; Jewellery chains; Chains [jewellery]; Body</i></p>

<p>metals; Chokers; Chronographs as watches; Chronographs for use as watches; Chronographs [watches]; Chronological instruments; Chronometers; Chronometric apparatus and instruments; Chronometric instruments; Chronometrical instruments; Chronoscopes; Clip earrings; Clips of silver [jewellery]; Clips (Tie -); Clock and watch hands; Clock cabinets; Clock cases; Clock dials; Clock faces; Clock hands [clock and watch making]; Clock hands [clock and watch-making]; Clock housings; Clock movements; Clocks; Clocks and parts therefor; Clocks and watches; Clocks and watches, electric; Clocks and watches for pigeon-fanciers; Clocks and watches in general; Clocks for world time zones; Clocks having quartz movements; Clocks incorporating ceramics; Clocks incorporating radios; Clockwork movements; Clockworks; Cloisonne pins; Closures for necklaces; Clothing ornaments of precious metals; Coins; Collectible coins; Collets being parts of jewellery; Commemorative coins; Commemorative medals; Control clocks [master clocks]; Copper tokens; Costume jewellery; Costume jewelry; Crosses [jewellery]; Cubic zirconia; Cuff links; Cuff links and tie clips; Cuff links coated with precious metals; Cuff links made of gold; Cuff links made of imitation gold; Cuff links made of porcelain; Cuff links made of precious metals with precious stones; Cuff links made of precious metals with semi-</p>	<p>jewellery; Pewter jewellery; Locketts [jewellery]; Jewellery findings; Crosses [jewellery]; Rings [jewellery]; Jewellery (Paste -); Amulets [jewellery]; Brooches [jewellery]; Jewellery brooches; Jewellery cases; Jewellery caskets; Jewellery articles; Jewellery stones; Personal jewellery; Cloisonne jewellery; Gold jewellery; Hat jewellery; Ivory jewellery; Fake jewellery; Trinkets [jewellery]; Jewellery charms; Pins [jewellery]; Jewellery boxes; Jewellery products; Jewellery chain; Jewellery rolls; Lapel pins [jewellery]; Jewellery incorporating pearls; Agate as jewellery; Amulets being jewellery; Articles of jewellery; Decorative brooches [jewellery]; Jewellery incorporating diamonds; Jewellery cases [fitted]; Wooden jewellery boxes; Rings being jewellery; Charms for jewellery; Items of jewellery; Plastic costume jewellery; Crucifixes as jewellery; Jewellery hat pins; Jewellery foot chains; Decorative pins [jewellery]; Imitation jewellery ornaments; Jewellery boxes [fitted]; Ring bands [jewellery]; Clasps for jewellery; Jewellery cases [caskets]; Body costume jewellery; Synthetic stones [jewellery]; Gold thread [jewellery]; Jewellery containing gold; Sterling silver jewellery; Pins being jewellery; Silver thread [jewellery]; Ornaments [jewellery, jewelry (Am.)]; Jewellery of precious metals; Beads for making jewellery; Clips of silver [jewellery]; Locketts [jewellery, jewelry (Am.)]; Articles of imitation</p>
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<p>precious stones; Cuff links made of silver plate; Cuff links of precious metal; Cuff links of precious metals with semi-precious stones; Cufflinks; Cuff-links; Cultured pearls; Cut diamonds; Decorative brooches [jewellery]; Decorative cuff link covers; Decorative pins [jewellery]; Decorative pins of precious metal; Desk clocks; Diadems; Dials [clock and watch making]; Dials (clockmaking and watchmaking); Dials for clock and watch-making; Dials for clocks; Dials for horological articles; Dials for watches; Dials (Sun -); Diamond [unwrought]; Diamonds; Digital clocks; Digital clocks being electronically controlled; Digital clocks incorporating radios; Digital clocks with automatic timers; Digital time indicators having temperature displays; Digital watches with automatic timers; Divers' watches; Diving watches; Dress ornaments in the nature of jewellery; Dress watches; Ear clips; Ear ornaments in the nature of jewellery; Ear studs; Earrings; Earrings of precious metal; Electric alarm clocks; Electric timepieces; Electric watches; Electrical timepieces; Electrically operated movements for clocks; Electrically operated movements for watches; Electronic alarm clocks; Electronic clocks; Electronic timepieces; Electronic watches; Electronically operated movements for clocks; Electronically operated movements for watches; Emerald; Emeralds; Escapements; Faces for chronometric</p>	<p>jewellery; Amberoid pendants being jewellery; Jewellery fashioned from bronze; Cloisonné jewellery [jewelry (Am.)]; Jewellery made from gold; Ivory [jewellery, jewelry (Am.)]; Jewellery incorporating precious stones; Brooches [jewellery, jewelry (Am.)]; Gold plated brooches [jewellery]; Bracelets [jewellery, jewelry (Am.)]; Amulets [jewellery, jewelry (Am.)]; Trinkets [jewellery, jewelry (Am.)]; Chains [jewellery, jewelry (Am.)]; Jewellery for personal wear; Jewellery made from silver; Jewellery in precious metals; Necklaces [jewellery, jewelry (Am.)]; Jewellery made of bronze; Jewellery for personal adornment; Jewellery made of plastics; Medallions [jewellery, jewelry (Am.)]; Jewellery made of crystal; Pearls [jewellery, jewelry (Am.)]; Jewellery made of glass; Rings [jewellery, jewelry (Am.)]; Charms [jewellery, jewelry (Am.)]; Pins [jewellery, jewelry (Am.)]; Cabochons for making jewellery; Presentation boxes for jewellery; Jewellery fashioned of precious metals; Wire of precious metal [jewellery]; Paste jewellery [costume jewelry (Am.)]; Jewellery boxes of precious metals; Parts and fittings for jewellery; Hoop earrings; Ear studs; Drop earrings; Silver earrings; Silver-plated earrings; Spun silver [silver wire]; Silver; Earrings; Silver ingots; Silver watches; Ear clips; Clip earrings; Unwrought silver; Silver alloys; Silver rings; Pierced earrings; Body-piercing studs; Gold earrings; Silver bullion; Silver</p>
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<p>instruments; Faces for clocks; Faces for watches; Fancy keyrings of precious metals; Figures of precious metal; Figurines coated with precious metal; Figurines for ornamental purposes of precious stones; Figurines made from gold; Figurines made from silver; Figurines of precious metal; Figurines of precious stones; Figurines [statuettes] of precious metal; Finger rings; Flexible wire bands for wear as a bracelet; Floor clocks; Fobs for keys; Friendship rings; Gems; Gemstones; Gold; Gold alloy ingots; Gold alloys; Gold and its alloys; Gold base alloys; Gold bracelets; Gold bullion coins; Gold chains; Gold coins; Gold earrings; Gold ingots; Gold medals; Gold plated bracelets; Gold plated brooches [jewellery]; Gold plated chains; Gold plated earrings; Gold plated rings; Gold rings; Gold thread [jewellery, jewelry (Am)]; Gold thread jewelry; Gold, unworked or semi-worked; Gold, unwrought or beaten; Grandfather clocks; Hands (Clock -) [clock and watch making]; Hands for clocks; Hat ornaments of precious metal; Horological articles; Horological instruments; Horological instruments having quartz movements; Horological instruments made of gold; Horological products; Identification bracelets [jewellery]; Imitation gold; Imitation jet; Imitation jewellery; Imitation jewellery ornaments; Imitation jewelry; Imitation pearls; Imitation precious stones; Industrial clocks; Ingots of precious metal;</p>	<p>necklaces; Silver thread; Silver-plated necklaces; Silver bracelets; Gold plated earrings; Bangle bracelets; Cufflinks; Bangles; Pendants; Locket; Necklaces; Jewellery rope chain for bracelets; Locket [jewellery]; Pendant watches; Gemstones; Jewellery chain of precious metal for necklaces; Necklaces [jewellery]; Boxes for cufflinks; Jewellery chain of precious metal for bracelets; Bracelets; Gold necklaces; Brooches [jewellery]; Jewelry brooches; Pendants [jewellery]; Jewel pendants; Choker necklaces; Bib necklaces; Necklace charms; Artificial gemstones; Precious gemstones; Semi-precious gemstones; Closures for necklaces; Gold bracelets; Bracelet charms; Watch bracelets; Charity bracelets; Friendship bracelets; Bead bracelets; Gold-plated necklaces; Bracelets [charity]; Brooches being jewelry; Ankle bracelets; Bracelets [jewellery]; Necklaces of precious metal; Tanzanite being gemstones; Presentation boxes for gemstones.</p>
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<p><i>Ingots of precious metals; Insignia of precious metals; Insignias of precious metal; Iridium; Iridium and its alloys; Ivory [jewellery, jewelry (Am)]; Jade [jewellery]; Jades; Jet; Jet (Ornaments of -); Jet, unwrought or semi-wrought; Jewel chains; Jewel pendants; Jewellery chain; Jewellery chain of precious metal for anklets; Jewellery chain of precious metal for bracelets; Jewellery chain of precious metal for necklaces; Jewellery chains; Clocks and watches; Jewellery for personal adornment; Jewellery for personal wear; Jewellery in the form of beads; Jewellery rope chain for anklets; Jewellery rope chain for bracelets; Jewellery rope chain for necklaces; Jewellery stones; Jewellery watches; Jewelry brooches; Jewelry chains; Jewelry findings; Jewelry for the head; Jewelry (Paste -) [costume jewelry]; Jewelry pins for use on hats; Jewelry stickpins; Jewelry watches; Key chains as jewellery [trinkets or fobs]; Key charms coated with precious metals; Key charms of precious metals; Key charms [trinkets or fobs]; Key fobs made of precious metal; Key fobs of precious metals; Key fobs [rings] coated with precious metal; Key holders of precious metals; Key holders [trinkets or fobs]; Key rings of precious metals; Key rings [trinkets or fobs]; Key rings [trinkets or fobs] of precious metal; Key tags [trinkets or fobs]; Lapel badges of precious metal; Lapel pins [jewellery]; Lapel pins [jewelry]; Lapel pins of precious metals</i></p>	
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[jewellery]; Leather watch straps; Links (Cuff -); Locketts; Man-made pearls; Mantle clocks; Marcassites; Master clocks; Mechanical watch oscillators; Mechanical watches; Mechanical watches with automatic winding; Mechanical watches with manual winding; Medallions; Medallions [jewellery, jewelry (Am)]; Medallions made of non-precious metals; Medallions made of precious metals; Medals; Medals coated with precious metals; Medals made of precious metals; Metal badges for wear [precious metal]; Metal expanding watch bracelets; Metal watch bands; Metal wire [precious metal]; Miniature clocks; Miniature figurines [coated with precious metal]; Model animals [ornaments] coated with precious metal; Model animals [ornaments] made of precious metal; Model figures [ornaments] coated with precious metal; Model figures [ornaments] made of precious metal; Movements for clocks and watches; Natural gem stones; Neck chains; Necklaces; Necklaces [jewellery]; Necklaces [jewellery, jewelry (Am)]; Non-leather watch straps; Non-monetary coins; Olivine [gems]; Olivine [peridot]; Opal; Ornamental figurines made of precious metal; Ornamental lapel pins; Ornamental pins; Ornamental pins made of precious metal; Ornamental sculptures made of precious metal; Ornaments for clothing [of precious metal]; Ornaments (Hat -) of precious metal; Ornaments [jewellery, jewelry (Am)]; Ornaments of jet;

Ornaments (Shoe -) of precious metal; Ornaments [statues] made of precious metal; Osmium; Osmium and its alloys; Palladium; Palladium and its alloys; Parts for clocks; Parts for clockworks; Parts for watches; Paste jewellery; Paste jewellery [costume jewelry (Am)]; Pearl; Pearls; Pearls [jewellery]; Pearls [jewellery, jewelry (Am)]; Pearls made of ambroid [pressed amber]; Pendant watches; Pendants; Pendants for watch chains; Pendants [jewellery]; Pendulum clocks; Pendulums [clock and watch making]; Pendulums [clock and watch-making]; Personal ornaments of precious metal; Pins being jewellery; Pins being jewelry; Pins [jewellery, jewelry (Am)]; Pins (Ornamental -); Pins (Tie -); Platinum; Platinum alloy ingots; Platinum and its alloys; Platinum ingots; Platinum [metal]; Pocket watches; Precious and semi-precious gems; Precious gemstones; Precious metal alloys; Precious metal alloys [other than for use in dentistry]; Precious metals; Precious metals, unwrought or semi-wrought; Precious stones; Precious stones and watches; Processed or semi-processed precious metals; Quartz clocks; Quartz watches; Rhodium; Rhodium and its alloys; Ring bands [jewellery]; Ring holders of precious metal; Rings being jewellery; Rings coated with precious metals; Rings [jewellery]; Rings [jewellery, jewelry (Am)]; Rings [jewellery] made of non-precious metal; Rings [jewellery] made of precious metal;

Rings [jewelry]; Rings [trinket]; Rope chain [jewellery] made of common metal; Rope chain made of precious metal; Ruby; Ruthenium; Ruthenium and its alloys; Sapphire; Sapphires; Sardonyx [unwrought]; Scale models [ornaments] of precious metal; Sculptures made from precious metal; Sculptures made of precious metal; Semi-finished articles of precious metals for use in the manufacture of jewellery; Semi-finished articles of precious stones for use in the manufacture of jewellery; Semi-precious articles of bijouterie; Semi-precious gemstones; Semi-precious stones; Semi-wrought precious stones and their imitations; Ship's chronometers; Shoe ornaments of precious metal; Silver; Silver alloy ingots; Silver and its alloys; Silver ingots; Silver thread; Silver, unwrought or beaten; Small clocks; Spinel [precious stones]; Sports watches; Springs (Watch -); Spun silver [silver wire]; Square gold chain; Stands for clocks; Statues of precious metal; Statues of precious metal and their alloys; Statues of precious metals; Statuettes made of semi-precious metals; Statuettes made of semi-precious stones; Statuettes of precious metal; Statuettes of precious metal and their alloys; Stop watches; Stopwatches; Straps for watches; Straps for wrist watches; Straps for wristwatches; Sun dials; Sundials; Synthetic precious stones; Synthetic stones [jewellery]; Table clocks; Table watches; Threads of precious metal

[jewellery, jewelry (Am)]; Threads of precious metals; Tiaras; Tie bars of precious metals; Tie chains of precious metal; Tie clasps of precious metals; Tie clips; Tie clips of precious metal; Tie holders of precious metal; Tie pins; Tie pins of precious metal; Tie-pins of precious metal; Time clocks [master clocks] for controlling other clocks; Timekeeping instruments; Timekeeping systems for sports; Timepieces; Timing clocks; Tokens (Copper -); Topaz; Travel clocks; Trinkets coated with precious metal; Trinkets [jewellery, jewelry (Am)]; Trinkets of bronze; Trinkets of precious metal; Trophies coated with precious metal alloys; Trophies coated with precious metals; Trophies made of precious metal alloys; Trophies made of precious metals; Trophies of precious metals; Unwrought and semi-wrought precious stones and their imitations; Unwrought precious stones; Unwrought silver; Unwrought silver alloys; Wall clocks; Watch and clock springs; Watch bands; Watch bracelets; Watch chains; Watch clasps; Watch crowns; Watch crystals; Watch dials; Watch faces; Watch fobs; Watch glasses; Watch movements; Watch parts; Watch pouches; Watch springs; Watch straps; Watch straps made of metal or leather or plastic; Watch straps of nylon; Watch straps of plastic; Watch straps of polyvinyl chloride; Watch straps of synthetic material; Watchbands; Watches; Watches bearing insignia;

Watches containing a game function; Watches containing an electronic game function; Watches for nurses; Watches for outdoor use; Watches for sporting use; Watches incorporating a memory function; Watches made of gold; Watches made of plated gold; Watches made of precious metals; Watches made of precious metals or coated therewith; Watches made of rolled gold; Watchstraps; Watchstraps made of leather; Wedding bands; Wedding rings; Wire of precious metal [jewellery, jewelry (Am)]; Wire thread of precious metal; Women's watches; Wrist bands [charity]; Wrist straps for watches; Wrist watch bands; Wrist watches; Wristlet watches; Wristlets [jewellery]; Wristwatches; Agate [unwrought]; Agate as jewellery; Clasps for jewelry; Fitted covers for jewelry rings to protect against impact, abrasion, and damage to the ring's band and stones; Jewelry clips for adapting pierced earrings to clip-on earrings; Tie bars; Action figures (Decorative-) of precious metal; Commemorative shields of precious metal; Prize cups of precious metals; Monetary coin sets for collecting purposes; Identity plates of precious metal; Gold bullion; Commemorative shields; Statues of precious metal of religious icons; Time instruments; Anchors [clock- and watchmaking]; Apparatus for sports timing [stopwatches]; Apparatus for timing sports events; Atomic clocks; Automobile clocks; Watchbands that

<p><i>communicate data to smartphones;</i> <i>Watches incorporating a</i> <i>telecommunication function.</i></p>	
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18. In *Gérard Meric v OHIM*, Case T-133/05, the General Court (“GC”) stated that:

“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 trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM - Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.³

19. In *Canon*, Case C-39/97, the Court of Justice of the European Union (“CJEU”) stated 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”.⁴

20. Additionally, the factors for assessing similarity between goods and services identified in *British Sugar Plc v James Robertson & Sons Limited* (“Treat”) [1996] R.P.C. 281 include an assessment of the channels of trade of the respective goods or services.

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

³ Paragraph 29

⁴ Paragraph 23

between goods. In *Boston Scientific Ltd v 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”.⁵

22. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where appropriate. In *Separode Trade Mark*, BL O-399-10, Mr Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person, said:

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”⁶

23. In his Counterstatement, and as referred to in the witness statement of Mr Karatas, the applicant admits that some of the opponent’s goods, “like hoops, bangles, drop earrings, chains etc.” are identical or similar to his own goods. However, the applicant has not made a full comparison of the goods or stated to what degree any of the goods are considered to be similar.

24. The dictionary definition of jewellery is “objects that are worn for personal adornment, such as bracelets, rings, necklaces, etc, as considered collectively”⁷ I note that as well as individual items of jewellery, such as bracelets and necklaces, the goods covered under both the applicant’s and the opponent’s marks include the broad categories “*Jewellery for personal adornment; Jewellery for personal wear*” (as

⁵ Paragraph 82

⁶ Paragraph 5

⁷ Source: collinsdictionary.com, accessed on 28 November 2022.

included in the opponent's specification), and "*Articles of jewellery; Jewellery*" (as included in the applicant's specification). I therefore find that any individual items under the applicant's mark which can be classified as jewellery are encompassed within the wider term as defined above, rendering them identical as per the principles outlined in *Meric*.

25. Given the breadth of the applicant's specification, I do not intend to compare individual items which would fall into the category of jewellery. However, I have carefully considered all of the terms within the applicant's specification, and I will now proceed to compare the remaining goods which I do not consider fall within the given definition of jewellery, *per se*.

26. *Jewellery findings; Clasps for jewellery; Beads for making jewellery; Wire of precious metal [jewellery]; Spun silver [silver wire]; Closures for necklaces.*

The applicant's goods listed above are self-evidently identical to the following goods of the earlier mark: "*Jewelry findings; Clasps for jewelry; Beads for making jewelry; Wire of precious metal [jewellery, jewelry (Am)]; Spun silver [silver wire]; Closures for necklaces*".

27. *Silver; Silver ingots; Unwrought silver; Silver alloys; Silver bullion; Silver thread.*

The above goods are self-evidently identical to the opponent's "*Silver; Silver ingots; Unwrought silver; Silver and its alloys; Silver ingots; Silver thread.*"

28. *gemstones; Gems; Natural gem stones; Artificial gem stones; Precious and semi-precious gems; Jewellery stones; Gemstones; Artificial gemstones; Precious gemstones; Semi-precious gemstones.*

The above goods are self-evidently identical to the earlier "*Gems; Gemstones*".

29. *onyx; Amethyst; jade; emerald; turquoise; opal; lapis lazuli; topaz; agate; citrine; ruby; peridot; jasper; pearl; Olivine [gems]; Chalcedony used as gems; Cabochons for making jewellery; Tanzanite being gemstones.*

As well as including various types of named gems and gemstones in the earlier specification, the opponent's goods include the broad term "*Gems; Gemstones*",

which I consider encompasses all of the applicant's goods listed above. Accordingly, the competing goods are *Meric* identical.

30. *Silver watches; Pendant watches; Watch bracelets.*

The applicant's *Pendant watches* are identical to the opponent's *Pendant watches*; and the applicant's "*Watch bracelets*" are identical to the opponent's "*Watch bracelets*". Meanwhile, the applicants "*Silver watches*" are encompassed within the wider term "*Watches*" in the opponent's specification, rendering them identical as per *Meric*.

31. *Parts and fittings for jewellery.*

In *Les Éditions Albert René v OHIM*, Case T-336/03, the General Court found that:

"61... The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different."

As individual components, the uses and the physical nature of "*Parts and fittings for jewellery*" are different to finished jewellery items. However, the respective trade channels are likely to be the same, and there would be some overlap in users, as jewellery owners may seek to embellish and/or replace parts for their jewellery. Bearing in mind the findings of the GC in *Les Éditions Albert René*, although some undertakings may provide both the parts and fittings as well as the finished articles, I do not consider that the average consumer would automatically expect the same undertaking to provide both. I therefore find there to be a low degree of similarity between them.

32. *Jewellery cases; Jewellery caskets; Jewellery boxes; Jewellery rolls; Jewellery cases [fitted]; Wooden jewellery boxes; Jewellery boxes [fitted]; Jewellery cases [caskets]; Presentation boxes for jewellery; Jewellery boxes of precious metals; Boxes for cufflinks; Presentation boxes for gemstones.*

While the purpose of the above items is to store jewellery, meaning there will be an overlap in the users of the aforementioned goods and the opponents “*Jewellery for personal adornment; Jewellery for personal wear*”, the respective goods are different in nature, although they are likely to share the same channels of trade. While some providers of jewellery may also give a presentation box with the purchased jewellery item, I do not consider the likes of jewellery boxes etc to be complementary in a trade mark sense to the jewellery itself, as outlined in *Boston Scientific*. As Mr Daniel Alexander Q.C. (as he then was) noted as the Appointed Person in *Sandra Amalia Mary Elliot v LRC Holdings Limited* BL-O-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.”⁸

I do not consider that the average consumer would automatically believe that the opposing goods are provided by the same or economically linked undertakings. Overall, I consider the aforementioned applicant’s goods to be similar to “*Jewellery for personal adornment; Jewellery for personal wear*” to a low degree.

33. *silver thimble; silver bookmark; silver money clips.*

While the opponent’s goods include silver at large, which would be used in the manufacture of the applicant’s “*silver thimble; silver bookmark; silver money clips*”, as per *Les Éditions Albert René*, I consider that the nature, intended purpose and the users of the applicant’s goods to be different to those of silver, to the degree that I find the competing goods dissimilar.

34. A degree of similarity between the goods and/or services is essential for there to be a finding of likelihood of confusion. 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

⁸ Paragraph 18

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.”

35. In relation to the goods which I have found to be dissimilar, as there can be no likelihood of confusion under section 5(2)(b), I will take no further account of such goods, with the opposition failing to that extent.

The average consumer and the nature of the purchasing act

36. 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. (as he was then) described the average consumer in these terms:

“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 word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median”.⁹

37. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

38. Jewellery may be classed as “costume” jewellery, i.e. jewellery that is decorative but has little intrinsic value, or may be high end which has been crafted from valuable metal such as gold and may be adorned with precious or semi-precious stones.

⁹ Paragraph 60

39. The average consumer of the goods at issue is a member of the general public. Particularly in the case of parts and fittings, and the various artificial, precious and semi-precious gemstones, as well as unwrought silver, the consumer will also be a professional jewellery designer/maker or a hobbyist.

40. The goods are sold through a range of channels, including retail premises such as dedicated jewellery stores, department stores and through gemstone/silver specialists, as well as online. The act of purchasing will be based on aesthetics and functionality and will be a primarily visual process. In retail stores, items of jewellery may be displayed on shelves, where they will be viewed and self-selected by the consumer. A similar process will apply to websites, where the consumer will select the goods having viewed an image displayed on a web page. More expensive items will be stored in a cabinet/behind the counter of the retail outlet, where the consumer will need to make a request to view and/or purchase them.

41. Considered overall, the selection process by the general public will, in my view, be a predominantly visual one, although aural considerations will play their part and may include verbal recommendations from specialists. The value of the goods will vary from relatively inexpensive for costume jewellery which, while not an everyday purchase, may be bought on a semi-regular basis, to moderately expensive/very expensive for gemstones and high quality pieces of jewellery which are purchased infrequently. The level of attention will therefore vary accordingly from a medium level of attention for costume jewellery and the like, to a high level of attention for the most expensive items of goods.

42. The professional consumer will purchase the goods more frequently and will wish to ensure that the goods are fit for purpose and, most importantly, that they are of a quality commensurate with the reputation of their business. The purchasing process will be predominantly visual, although I do not discount the aural element as the consumer may seek information from the purveyor of the goods. They are therefore likely to pay a high degree of attention to their selection.

Comparison of marks

43. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM* Case C-591/12P, 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.”¹⁰

44. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

45. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
jewellerybox	JewelleryGemBox

46. In its written submissions, the opponent submits that the marks are visually and phonetically highly similar, with the word elements of the opponent's mark, namely "jewellerybox" being wholly contained in the applicant's mark. Further, it submits that when the applicant's mark is taken as a whole, it is conceptually identical, or at least

¹⁰ Paragraph 34

near identical to the opponent's mark as both pertain to the concept of a box, case or container which is used to keep gems or jewellery.

47. The applicant submits that the earlier mark consists of a generic term. I will address this later in my decision.

Overall impression

48. The opponent's mark consists of two conjoined words "jewellerybox", presented as a single word in a standard black font in lower case, without any other elements to contribute to the overall impression. Although the two dictionary defined words have been combined to form a single word, I consider that the average consumer, although not in the habit of dissecting marks, would immediately identify the two words within the mark, rather than perceiving it as an invented word, and they would recognise that the word "box" is qualified by the preceding word "jewellery". Neither word dominates and therefore the overall impression conveyed by the mark rests in the two word combination.

49. The applicant's mark consists of the conjoined words "JewelleryGemBox", presented as a single word in a standard black font in title case, without any other elements to contribute to the overall impression. The use of capital letters at the start of each individual word immediately leads the consumer to read the mark as three individual words, even though there are no spaces between those words. The overall impression conveyed by the mark therefore rests in the three word combination.

Visual comparison

50. The opponent's mark is made up of two words presented as a single conjoined word consisting of the elements "jewellery" and "box". These words are wholly contained within the applicant's mark, being the first and last words of the three conjoined elements which make up the applicant's mark, which has the additional word "Gem" positioned between them, resulting in what I find to be at least a medium degree of visual similarity between the two marks.

Aural comparison

51. The common elements of the competing marks are the words “jewellery” and “box”, and as the words are conjoined in both marks, I would expect the average consumer to voice each mark in its entirety. The applicant’s mark has the additional word “Gem” in the middle of these two elements which will also be pronounced, the whole being articulated as four syllables, JOOL-REE-JEM-BOX (dʒu:əlri dʒem bɒks), or possibly as five syllables, JOOL-UR-EE-JEM-BOX. Meanwhile, the opponent’s mark will be articulated as either three syllables, JOOL-REE-BOX ((dʒu:əlri bɒks), or as four syllables, JOOL-UR-EE-BOX. Either way, the common elements will be pronounced identically in both marks. Consequently, I consider the competing marks to be aurally similar to at least a medium degree.

Conceptual comparison

52. With regard to conceptual comparison, in *Luciano Sandrone v European Union Intellectual Property Office (EUIPO)*, Case T-268/18, the GC held:

“... In that regard, it must be borne in mind that the purpose of the conceptual comparison is to compare the ‘concepts’ that the signs at issue convey. The term ‘concept’ means, according to the definition given, for example, by the Larousse dictionary, a ‘general and abstract idea used to denote a specific or abstract thought which enables a person to associate with that thought the various perceptions which that person has of it and to organise knowledge about it.’¹¹

53. Both marks describe a box for storage of jewellery and/or gems, and as such the marks allude to the goods at issue being used in conjunction with such a container.

54. The opponent submits that the marks only differ in the word “gem” in the applicant’s mark and that as a gem is a subcategory of jewellery, the meanings conveyed by the competing marks are synonymous. In my view, although gems may be used in

¹¹ Paragraph 8.

jewellery, they are not jewellery items *per se*, and may have other uses, such as to adorn items of clothing or for use in spiritual practices. In order to be utilised as jewellery, a gem would need to be combined with other materials and incorporated in to the design of the desired jewellery item. To my mind, the additional word “Gem” in the applicant’s mark merely suggests that the gems which may be stored in the box are specifically in relation to jewellery use.

55. Overall, I consider that both marks clearly send the message of a container specifically for storing jewellery and/or gems, rendering the marks as being conceptually similar to a very high degree.

Distinctive character of the earlier mark

56. 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.

57. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically

widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

58. Registered trade marks possess varying degrees of inherent distinctive character, being lower where they are allusive or suggestive of a characteristic of the goods, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it. The opponent has not claimed that its mark has enhanced distinctiveness and no evidence of use has been filed. Therefore, I only have the inherent characteristics of the mark to consider.

59. As mentioned earlier in this decision, in his counterstatement, the applicant submits that the earlier mark is a generic term and that allowing a single company to claim trade mark rights in the term “jewellerybox” would “impoverish the language and unfairly hamper competition”. In regard to the applicant’s submissions, I refer to *Formula One Licensing BV v OHIM*, Case C-196/11P where the CJEU held that:

“41.it is not possible to find, with regard to a sign identical to a trade mark protected in a Member State, an absolute ground for refusal, such as the lack of distinctive character, provided by Article 7(1)(b) of Regulation No 40/94 and Article 3(1)(b) of Directives 89/104 and 2008/95. In this respect, it should be noted that the characterisation of a sign as descriptive or generic is equivalent to denying its distinctive character.

42. It is true that, as is clear from paragraph 48 of the judgment under appeal, where an opposition, based on the existence of an earlier national trade mark, is filed against the registration of a Community trade mark, OHIM and, consequently, the General Court, must verify the way in which the relevant public perceives the sign which is identical to the national trade mark in the

mark applied for and evaluate, if necessary, the degree of distinctiveness of that sign.

43. However, as the appellant rightly points out, their verification has limits.

44. Their verification may not culminate in a finding of the lack of distinctive character of a sign identical to a registered and protected national trade mark, since such a finding would not be compatible with the coexistence of Community trade marks and national trade marks or with Article 8(1)(b) of Regulation No 40/94, read in conjunction with Article 8(2)(a)(ii)."

60. The earlier mark is made up of the conjoined words "jewellery" and "box". The word "box" is qualified by the word "jewellery", which together, and in direct reference to the goods at issue, describe a container in which those goods may be stored. Although the mark does not describe the actual jewellery goods themselves, it is highly allusive. As such, I consider it to be low in inherent distinctive character.

Likelihood of confusion

61. There is no simple formula for determining whether there is a likelihood of confusion. It is clear that I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them 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 vice versa (*Canon* at [17]). I must consider the various factors from the perspective of the average consumer, bearing in mind 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 (*Lloyd Schuhfabrik* at [26]).

62. There are two types of possible confusion: direct, where the average consumer mistakes one mark for the other, or indirect, where the average consumer recognises that the marks are different, but assumes that the goods and/or services are the responsibility of the same or connected undertakings. The distinction between these

was explained by Mr Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v Back Beat Inc*, Case BL-O/375/10. He said:

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

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

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

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

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

63. The above are examples only which are intended to be illustrative of the general approach. These examples are not exhaustive but provide helpful focus.

64. Earlier in this decision, I found that:

- All the contested goods except for “*silver thimble; silver bookmark; silver money clips*” are identical or similar to at least a low degree to the opponent’s goods;
- The level of attention of the general public as the average consumer will range between medium to high when selecting the goods, while the professional consumer is likely to pay a high degree of attention to the selection process;
- Both groups, whilst not ignoring aural considerations, will select the goods at issue by predominantly visual means;
- The competing trade marks are visually and aurally similar to at least a medium degree, with a very high degree of conceptual similarity;
- The earlier mark is inherently distinctive to a low degree.

65. In his counterstatement, the applicant states that “if identity and similarity between the marks and between the goods combines to create a likelihood of confusion, it would’ve happened for the past 18 years.” Mr Karatas has also filed evidence to demonstrate the applicant’s online presence in defence of the application. However, this has no bearing on my decision. Absence of evidence of confusion does not necessarily mean an absence of actual confusion. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. stated that:

“80.the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in *Specsavers* at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this

may be powerful evidence that their similarity is such that there exists a likelihood of confusion. But conversely, the absence of actual confusion despite side by side use may be powerful evidence that they are not sufficiently similar to give rise to a likelihood of confusion. This may not always be so, however. The reason for the absence of confusion may be that the mark has only been used to a limited extent or in relation to only some of the goods or services for which it is registered, or in such a way that there has been no possibility of the one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur.”

66. I bear in mind the decision of the CJEU in *L’Oréal SA v OHIM*, Case C-235/05 P, in which the CJEU confirmed that weak distinctive character of the earlier trade mark does not preclude a likelihood of confusion:

“The applicant’s approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”¹²

67. It is settled case-law that the average consumer is unlikely to see the marks side-by-side and will therefore be reliant on the imperfect picture of them they have kept in their mind. In spite of the low distinctive character of the earlier mark, allowing for

¹² Paragraph 45.

imperfect recollection, and taking into account the respective goods which are considered to be identical, which offsets a lesser degree of similarity between the marks, I consider the differences between the marks to be insufficient to avoid them being mistakenly recalled as each other. Consequently, I find that there is a likelihood of direct confusion for identical goods. For those goods which I found to share only a low degree of similarity, being *Jewellery cases; Jewellery caskets; Jewellery boxes; Jewellery rolls; Jewellery cases [fitted]; Wooden jewellery boxes; Jewellery boxes [fitted]; Jewellery cases [caskets]; Presentation boxes for jewellery; Jewellery boxes of precious metals; Boxes for cufflinks; Presentation boxes for gemstones; Parts and fittings for jewellery*, given the low degree of distinctive character of the earlier mark, I do not consider that the average consumer would associate the goods with those of the opponent and I therefore find there to be no likelihood of direct confusion for those goods.

68. Taking into account the previously outlined guidance of Mr Iain Purvis Q.C. (as he then was) in *L.A. Sugar*, I will now consider whether there might be a likelihood of indirect confusion. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C. (as he then was), as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

69. The only point of difference between the marks is the word “gem” which is positioned between the words “jewellery” and “box. Keeping in mind the global assessment of the competing factors in my decision, it is my view that where the average consumer notices the differences between the marks, it would be entirely plausible for the consumer to believe that the mark is a sub-brand or brand extension which focusses on goods which contain gemstones, or they would assume that there is an economic connection between the undertakings. I therefore find that there is a likelihood of indirect confusion in relation to those goods which were considered to be identical. For the same reasons outlined under paragraph 67, I do not consider there to be a likelihood of indirect confusion in relation to the goods which I found to share only a low degree of similarity.

70. The opposition under section 5(2)(b) succeeds with respect to the following goods in Class 14:

Silver stud; silver drop earrings; silver dangle earrings; silver hoop earrings; silver huggies; silver bracelet; silver bangle; silver charm; silver locket; silver pendant; silver brooch; silver chain; curb chain; snake chain; silver necklace; silver cufflinks; gemstones; onyx; Amethyst; jade; emerald; turquoise; opal; lapis lazuli; topaz; agate; citrine; ruby; peridot; jasper; pearl; gold chain; gold locket; gold pendant; gold bracelet; gold bangle; gold brooch; gold earrings; gold hoop; gold stud; Gems; Olivine [gems]; Natural gem stones; Artificial gem stones; Chalcedony used as gems; Jewellery; Jewellery, including imitation jewellery and plastic jewellery; Precious and semi-precious gems; Ornaments [jewellery]; Enamelled jewellery; Wristlets [jewellery]; Bracelets [jewellery]; Pearls [jewellery]; Shoe jewellery; Imitation jewellery; Fashion jewellery; Costume jewellery; Facial jewellery; Jade [jewellery]; Necklaces [jewellery]; Precious jewellery; Cloisonné jewellery; Paste jewellery; Artificial jewellery; Charms [jewellery]; Pendants [jewellery]; Jewellery items; Jewellery chains; Chains [jewellery]; Body jewellery; Pewter jewellery; Locketts [jewellery]; Jewellery findings; Crosses [jewellery]; Rings [jewellery]; Jewellery (Paste -); Amulets [jewellery]; Brooches [jewellery]; Jewellery brooches; Jewellery articles; Jewellery stones; Personal jewellery; Cloisonne jewellery; Gold jewellery; Hat jewellery; Ivory jewellery; Fake jewellery; Trinkets [jewellery]; Jewellery charms; Pins [jewellery]; Jewellery products; Jewellery chain; Lapel pins [jewellery]; Jewellery incorporating pearls; Agate as jewellery; Amulets being jewellery; Articles of jewellery; Decorative brooches [jewellery]; Jewellery incorporating diamonds; Rings being jewellery; Charms for jewellery; Items of jewellery; Plastic costume jewellery; Crucifixes as jewellery; Jewellery hat pins; Jewellery foot chains; Decorative pins [jewellery]; Imitation jewellery ornaments; Ring bands [jewellery]; Clasps for jewellery; Body costume jewellery; Synthetic stones [jewellery]; Gold thread [jewellery]; Jewellery containing gold; Sterling silver jewellery; Pins being jewellery; Silver thread [jewellery]; Ornaments [jewellery, jewelry (Am.)]; Jewellery of precious metals; Beads for making jewellery; Clips of silver [jewellery]; Locketts [jewellery, jewelry (Am.)]; Articles of imitation jewellery; Amberoid pendants being jewellery; Jewellery fashioned from bronze; Cloisonné jewellery [jewelry (Am.)]; Jewellery made from gold; Ivory [jewellery, jewelry (Am.)]; Jewellery incorporating precious stones; Brooches [jewellery, jewelry

(Am.); Gold plated brooches [jewellery]; Bracelets [jewellery, jewelry (Am.)]; Amulets [jewellery, jewelry (Am.)]; Trinkets [jewellery, jewelry (Am.)]; Chains [jewellery, jewelry (Am.)]; Jewellery for personal wear; Jewellery made from silver; Jewellery in precious metals; Necklaces [jewellery, jewelry (Am.)]; Jewellery made of bronze; Jewellery for personal adornment; Jewellery made of plastics; Medallions [jewellery, jewelry (Am.)]; Jewellery made of crystal; Pearls [jewellery, jewelry (Am.)]; Jewellery made of glass; Rings [jewellery, jewelry (Am.)]; Charms [jewellery, jewelry (Am.)]; Pins [jewellery, jewelry (Am.)]; Cabochons for making jewellery; Jewellery fashioned of precious metals; Wire of precious metal [jewellery]; Paste jewellery [costume jewelry (Am.)]; Hoop earrings; Ear studs; Drop earrings; Silver earrings; Silver-plated earrings; Spun silver [silver wire]; Silver; Earrings; Silver ingots; Silver watches; Ear clips; Clip earrings; Unwrought silver; Silver alloys; Silver rings; Pierced earrings; Body-piercing studs; Gold earrings; Silver bullion; Silver necklaces; Silver thread; Silver-plated necklaces; Silver bracelets; Gold plated earrings; Bangle bracelets; Cufflinks; Bangles; Pendants; Locketts; Necklaces; Jewellery rope chain for bracelets; Locketts [jewelry]; Pendant watches; Gemstones; Jewellery chain of precious metal for necklaces; Necklaces [jewelry]; Jewellery chain of precious metal for bracelets; Bracelets; Gold necklaces; Brooches [jewelry]; Jewelry brooches; Pendants [jewelry]; Jewel pendants; Choker necklaces; Bib necklaces; Necklace charms; Artificial gemstones; Precious gemstones; Semi-precious gemstones; Closures for necklaces; Gold bracelets; Bracelet charms; Watch bracelets; Charity bracelets; Friendship bracelets; Bead bracelets; Gold-plated necklaces; Bracelets [charity]; Brooches being jewelry; Ankle bracelets; Bracelets [jewelry]; Necklaces of precious metal; Tanzanite being gemstones.

CONCLUSION

71. The opposition has been partially successful. The application by Selami Karatas may proceed to registration in respect of the following goods only in Class 14:

Silver thimble; silver bookmark; silver money clips; Jewellery cases; Jewellery caskets; Jewellery boxes; Jewellery rolls; Jewellery cases [fitted]; Wooden jewellery boxes; Jewellery boxes [fitted]; Jewellery cases [caskets]; Presentation boxes for jewellery;

Jewellery boxes of precious metals; Boxes for cufflinks; Presentation boxes for gemstones; Parts and fittings for jewellery.

COSTS

72. Both parties have enjoyed a share of success, with the greater part going to the opponent, who is therefore entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice (“TPN”) 2/2016. I have made a slight reduction to the costs on account of the partial success of the opponent. Applying the guidance in that TPN, I award the opponent the sum of £600, which is calculated as follows:

Official fee ¹³ :	£100
Filing a notice of opposition and considering the counterstatement:	£250
Filing written submissions:	£250
Total:	£600

73. I therefore order Selami Karatas to pay jewellerybox Ltd the sum of £600. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 13th day of December 2022

Suzanne Hitchings
For the Registrar,
the Comptroller-General

¹³ I note that the opponent paid an official fee of £200 to take into account the initial opposition under section 5(2)(b), 5(3) and 5(4)(a). As the grounds under 5(3) and 5(4)(a) were later withdrawn, I award the official fee of £100 to reflect the grounds of the opposition under section 5(2)(b) only.