

**O-646-17**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF:**

**TRADE MARK APPLICATION 3192386**

**BY [REDACTED]**

**TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 25:**

**GABRIELLE**

**&**

**OPPOSITION THERETO (No 408705) BY CHANEL LIMITED**

## **Background and pleadings**

1. The trade mark **GABRIELLE** was filed by [REDACTED] ("the applicant") on 20 October 2016. It was published for opposition purposes on 9 December 2016. Registration is sought for the following goods in class 25:

Articles of clothing, robes, dresses, tunics, cardigans, leggings, scarves, belts, tutus, trousers, t-shirts and sweatshirts; headgear; footwear, boots, shoes, slippers, flip-flops and slides; jumpers, caps, hats, jumpsuits, shorts, tights, skirts, swimsuits, lingerie

2. Registration is opposed by Chanel Limited ("the opponent") under section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opponent relies on one earlier mark which consists of the words **GABRIELLE CHANEL**. The earlier mark was filed on 29 October 2015 and registered on 5 February 2016. The consequence of this date of registration is that the earlier mark is not subject to the requirement to show genuine use as per Section 6A of the Act. Although it is registered for more goods and services, the opponent relies only upon "clothing; footwear; headgear; gloves, scarves, belts" that forms part of its registration. The opposition is directed against all of the goods for which registration is sought. I note the following from the opponent's statement of case:

- i) That **GABRIELLE CHANEL** is an important heritage trade mark of the opponent and that it is the name of its founder.
- ii) That the name **GABRIELLE** is uncommon in the UK.
- iii) **GABRIELLE** forms a distinctive and dominant part of the opponent's mark.
- iv) That the marks are similar, with the applied for mark being wholly contained within the opponent's mark.
- v) That consumers pay greater attention to the beginnings of marks.
- vi) That the goods are identical.
- vii) That there is "an intrinsic link between the Opponent and **GABRIELLE**" and that the various factor combine to create a likelihood of confusion.

3. The applicant filed a counterstatement denying the grounds of opposition. I note the following:

- i) It is denied that the goods are identical.
- ii) It is denied that GABRIELLE is uncommon, with it being highlighted that the name is ranked 256<sup>th</sup> out of 978 popular names in London.
- iii) It is not admitted that GABRIELLE has high inherent distinctiveness or that it forms a distinctive and dominant part of the opponent's mark.
- iv) Whilst consumers typically pay greater attention to the beginnings of marks, family names have, in principle, higher intrinsic value as an indicator of origin.
- v) That the same first name may belong to a great number of people who have nothing in common. Where signs share the first name, but there is no common surname, there is no similarity.
- vi) A likelihood of confusion is denied.

4. Only the opponent filed evidence. The applicant filed written submissions in response. A hearing took place before me on 1 December 2017. The opponent was represented by Mr Andrew Norris, of counsel, instructed by Withers & Rogers LLP. The applicant was represented by Ms Amanda Michaels, also of counsel, instructed by Kilburn & Strode LLP.

### **The evidence**

5. The opponent's evidence takes the form of a witness statement by Ms Lucy Aboulian, the opponent's senior intellectual property counsel. She begins her evidence by discussing the popularity of the name Gabrielle and then moves on to discuss the use of GABRIELLE by the opponent and references to it in the press. As the applicant's submissions respond to Ms Aboulian's evidence, I also detail below what was submitted in response.

6. Ms Aboulian states that the popularity of the name in London (a reference to what was stated in the applicant's counterstatement) is not determinative. She, in any event, disagrees with the applicant's assertion as to the popularity of the name. Ms Aboulian provides Exhibit LKA1, which consists of a spreadsheet from the website of the Office for National Statistics ("ONS") listing the top 100 most popular girl's name. A top 100 is given for 1994 with the same then provided at ten year intervals back to 1904. It is highlighted that Gabrielle only appears in the 1994 list, at position 87. It is added that total numbers throughout the entirety of the period are not publically available.

7. Various tables are also provided by Ms Aboulian which have been put together using calculations applied to a second spreadsheet downloaded from the ONS website. The headline figures to which Ms Aboulian draws attention are:

- Since 1996, Gabrielle has appeared in the Top 100 only three times (89<sup>th</sup> in 2002, 98<sup>th</sup> in 1997 and 99<sup>th</sup> in 1996).
- In 2015, Gabrielle was ranked 388<sup>th</sup>.
- In terms of numbers of girls who were born and given the name Gabrielle, there was a high of 574 in 2002 (21 out of every 10k) and a low of 118 in 2015 (4 out of every 10k). Between 1996 and 2015, this equates to 11 out of every 10k.
- To put this in context, a comparison is made with the name Amelia, which is ranked number 1 with 106 out of every 10k receiving this name over the same period. Ms Aboulian states that the above figures demonstrate the difference between a popular name and an uncommon one.

8. Ms Aboulian states that in view of the above, GABRIELLE is an uncommon name in the UK and possesses a high degree of inherent distinctiveness and forms a distinctive and dominant part of the opponent's mark.

9. The applicant's submissions also deal with the popularity point. It submits that GABRIELLE is a popular, well-known and recognisable name. It highlights various points from the spreadsheets in evidence including:

- That the spreadsheet between 1904 and 1994 is not helpful given the age of the data.
- Between 1996 and 2015 Gabrielle has appeared in the Top 200 12 years in a row.
- That 18823 potential names are in the more recent table.
- The name has been in various positions between 1998 and 2007, 107<sup>th</sup> at the highest and 191<sup>st</sup> at the lowest. **TO CHECK**

10. In relation to the opponent's use of the name, Ms Aboulion states that the opponent was founded by Mlle Gabrielle Chanel in 1910 and that Chanel is a well-known fashion house. It is stated that the first name, GABRIELLE, has come to be a distinctive part of Chanel's branding. It is added that whilst Mlle Chanel is often known as Coco Chanel, she is also known as Gabrielle and is referred to in the press as "Gabrielle "Coco" Chanel".

11. It is stated that Ms Chanel is one of the most famous fashion designers of all time. Exhibit LKA1 is a copy of an essay from the Metropolitan Museum of Art. Whilst the name "Gabrielle "Coco" Chanel" is used as part of the title and as part of the first introductory paragraph, the rest of the essay refers to the designer (and her fashion house) as "Chanel".

12. Exhibit LKA4 is a copy of a web based documentary titled "Inside Chanel", which is about Mlle Chanel. Ms Aboulion highlights that Chapter 18, which she says was first published in 2017 (and so after the relevant date), is called "Gabrielle, a Rebel at Heart". Chapter 20 of the documentary is provided in Exhibit LKA5 and, according to Mr Aboulion, describes "Gabrielle's philosophy of design".

13. Ms Aboulion then discusses the press coverage of the name GABRIELLE as part of the marketing of the opponent's goods. Four exhibits are provided as follows:

- An article from ft.com, dated 21 February 2017, titled "Why Gabrielle is still Chanel's biggest asset". What is clear from this is that the opponent is to launch

new products which use the name Gabrielle such as “the Chanel Gabrielle Handbag” and “Gabrielle Chanel the fragrance”.

- An article from elle.com dated 7 April 2017 which makes reference to the launch of the Gabrielle handbag.
- An article from the website of the Telegraph from March 2017 which is also about the Gabrielle handbag.
- An article from Beauty magazine about the Gabrielle Chanel fragrance that is to be launched. The article is not dated. There are references to “the rebellious spirit of Gabrielle Chanel before she was Coco”.

14. Ms Aboulian states that although the above post-dates the application, they still serve to demonstrate that GABRIELLE is intrinsically linked with GABRIELLE CHANEL in the mind of the consumer. She considers that the GABRIELLE part of the opponent’s mark will be linked with clothing in the mind of the consumer and, therefore, the use of GABRIELLE by the applicant will confuse consumers into believing that the goods originate from, or are economically linked, to the opponent.

15. The applicant’s submissions focus on the fact that much of the evidence is from after the relevant date and, further, that the essay is from a museum in New York. It further submits that the opponent’s business is known as Chanel and it is this that will form the dominant part of the earlier mark.

### **Section 5(2)(b)**

16. Section 5(2)(b) of the Act states that:

“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.”

17. The following principles are gleaned from the judgments 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.

(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**

18. The competing specifications are set out below, both of which are in class 25:

<b>Applied for specification</b>	<b>Earlier mark's specification</b>
Articles of clothing, robes, dresses, tunics, cardigans, leggings, scarves, belts, tutus, trousers, t-shirts and sweatshirts; headgear; footwear, boots, shoes, slippers, flip-flops and slides; jumpers, caps, hats, jumpsuits, shorts, tights, skirts, swimsuits, lingerie.	Clothing; footwear' headgear; gloves, scarves, belts

19. It was accepted by Ms Michaels at the hearing that the goods are identical (see paragraph 14 of her skeleton argument).



## The average consumer and the purchasing process

20. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. 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. 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.”

21. The conflicting goods are items of clothing. The average consumer will be a member of the general public. I agree with Mr Norris' submission that such goods are likely to be selected by predominantly visual means, through self-selection, websites and brochures/catalogues. There is ample case-law to support this point<sup>1</sup>. I will not, though, ignore the aural impacts of the marks completely. The goods are purchased reasonably frequently and are not prohibitively expensive (indeed, some items of clothing are low cost). However, some care will be taken to ensure the correct fit, colour, and to ensure fitness for purpose. I come to the view that these are the type of goods where neither a materially higher nor lower than average degree of care will be deployed by the average consumer when selecting the goods.

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<sup>1</sup> Mr Norris referred to, for example, *Société provençale d'achat et de gestion (SPAG) SA v (OHIM)* Case T-57/03 and *React Trade Mark* [2000] RPC 285. I additionally note the decision in *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03.

## Comparison of marks

22. 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 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.”

23. 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. The competing marks are:

**GABRIELLE            v            GABRIELLE CHANEL**

24. In terms of overall impression, the applicant's mark has just one element, GABRIELLE, which, consequently, is the only thing that contributes to its overall impression.

25. In terms of the opponent's mark, this consists of two names: GABRIELLE and CHANEL. One will be seen as a forename, one will be seen as a surname, so they combine to create a full name. There was a discussion at the hearing as to whether some consumers may see CHANEL simply as a company name with the consequence that those average consumers would see the mark as the forename GABRIELLE (as

an independent distinctive element) alongside another independent distinctive element, CHANEL (the company). I reject this suggestion. Although Ms Michaels accepted that CHANEL was a well-known fashion house (and the name of a company), those who are familiar with CHANEL will know that it is a surname (of its founder, most often known as Coco Chanel) and, therefore, when combined with a forename, the whole mark will still be perceived as the full name of a person. I accept that an alternate view of matters need only be reached by a “significant proportion” of average consumers for it to be relevant (see *Interflora v M&S* [2012] EWCA Civ 150), but I do not consider that this is applicable here. In terms of the names that form the full name before the tribunal, neither side argued that one or other of the names lacks distinctive character completely. There are questions about which name is more distinctive, to which I return to shortly. For the time being, it is sufficient to record that neither the forename GABRIELLE nor the surname CHANEL is presented in a way (beyond GABRIELLE being the first part of the mark) which makes either name stand out. Both names, from the perspective of the impact they make on the eye and the ear, have a roughly equal weight in the overall impression of the mark.

26. Visually, that both marks comprise or contain the name GABRIELLE creates an inevitable degree of both visual and aural similarity. However, there is also a visual and aural difference due to the presence in the earlier mark of the surname CHANEL. This equates, in my view, to there being a medium degree of visual and aural similarity.

27. Conceptually, Ms Michaels submitted that there was a clear conceptual difference relying on the impact of the surname CHANEL in the mark and, also, the decision of the CJEU in *Claude Ruiz-Picasso and others v OHIM, DaimlerChrysler AG* (Case C-361/04 P. I will come onto Ms Michaels’ submissions about surnames shortly (and also those of Mr Norris). In terms of the CJEU case referred to, that related to a clash between PICASSO and PICARO and that the concept of the former, being a famous name, helped to counteract the visual and aural similarities between those marks. Beyond the general point that conceptual differences may have a counteractive effect, I do not consider this case to be particularly helpful. This is because the point of similarity here relates to a shared name, the forename GABRIELLE, thus there is some conceptual similarity because both marks refer to a person who has the forename GABRIELLE. I accept, though, that such conceptual similarity is low

because one mark relates to a specific Gabrielle whose surname is CHANEL, the other does not.

28. Ms Michaels submitted that there was no overall similarity between the marks. However, as can be seen from the objective assessment I have made on the visual, aural and conceptual levels, I do not agree that this is so. I must, therefore, go on to consider whether a likelihood of confusion will arise.

### **Likelihood of confusion**

29. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17) and a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

30. I begin by dealing with two arguments based upon the opponent's evidence. The first relates to the claimed heritage of the name GABRIELLE CHANEL. Put simply, I consider the evidence to be wholly insufficient to show that the average consumer (even those with an interest in haute couture) will know that the real name of the founder of CHANEL, Coco Chanel, was Gabrielle Chanel. The only pre-relevant date material is the essay in a museum in New York. Further, whilst I accept that post-relevant date material may sometimes be instructive of the position that existed before the relevant date, the evidence filed is not persuasive because, as I will come on to say, the use in press articles etc appears to be simply the result of the opponent's post-relevant date marketing.

31. The second issue relates to Mr Norris' submission that the post-relevant date press articles at least show that the press have regarded GABRIELLE as a sub-brand within the used (post-relevant date) mark GABRIELLE CHANEL, and that such an assumption (of being a sub-brand) will likely to be taken by the average consumer. Whilst I will come back to the sub-brand argument later, I should say, from an evidential point of view, that the press articles do not assist. This is because the use

of GABRIELLE by the press appears to stem from a particular form of use by the opponent, where greater emphasis is placed on GABRIELLE as an independent element. For example, Ms Abouljian states in paragraph 19 of her witness statement that the bag to which much of the evidence relates is marketed as “CHANEL’S GABRIELLE” bag.

32. It is useful at this stage to set out some applicable guidance relating to the treatment of conflicts which involve forenames and full names. In *Harman International Industries, Inc v OHIM*, Case C-51/09P, the CJEU found that:

“Although it is possible that, in a part of the European Union, surnames have, as a general rule, a more distinctive character than forenames, it is appropriate, however, to take account of factors specific to the case and, in particular, the fact that the surname concerned is unusual or, on the contrary, very common, which is likely to have an effect on that distinctive character. That is true of the surname ‘Becker’ which the Board of Appeal noted is common”.

33. In *El Corte Inglés, SA v OHIM*, Case T-39/10, the General Court found that:

“54. As the applicant asserted in its pleadings, according to the case-law, the Italian consumer will generally attribute greater distinctiveness to the surname than to the forename in the marks at issue (Case T-185/03 *Fusco v OHIM – Fusco International (ENZO FUSCO)* [2005] ECR II-715, paragraph 54). The General Court applied a similar conclusion concerning Spanish consumers, having established that the first name that appeared in the mark in question was relatively common and, therefore, not very distinctive (Case T-40/03 *Murúa Entrena v OHIM – Bodegas Murúa (Julián Murúa Entrena)* [2005] ECR II-2831, paragraphs 66 to 68).

55. Nevertheless, it is also clear from the case-law that that rule, drawn from experience, cannot be applied automatically without taking account of the specific features of each case (judgment of 12 July 2006 in Case T-97/05 *Rossi v OHIM – Marcorossi (MARCOROSS)*, not published in the ECR, paragraph 45). In that regard, the Court of Justice has held that account had to be taken,

in particular, of the fact that the surname concerned was unusual or, on the contrary, very common, which is likely to have an effect on its distinctive character. Account also had to be taken of whether the person who requests that his first name and surname, taken together, be registered as a trade mark is well known (Case C-51/09 P Becker v Harman International Industries [2010] ECR I-5805, paragraphs 36 and 37). Likewise, according to the case-law cited in the previous paragraph, the distinctive character of the first name is a fact that should play a role in the implementation of that rule based on experience.”

34. Ms Michaels also referred to a recent decision of Mr Daniel Alexander QC, sitting as the Appointed Person, in *Pia Hallstrom* BL O/303/17, where at paragraph 37, when summing up the nature of the overall evaluation that had to be made, he stated:

“Moreover, if a trader chooses a forename as a trade mark, the average consumer is not particularly likely to think that another trader who uses a full name incorporating that forename is thereby denoting goods or services from the first undertaking rather than those connected with someone else who happens to share that forename. That is a problem which arises as a result of a choice of mark which, precisely because it is a name which others either do or could reasonably wish to use to denote themselves, does not start high on the distinctiveness scale. Large-scale use of such a mark does not, as such, enhance its distinctiveness in a relevant way, namely so as to increase the likelihood of confusion (see above).”

35. Mr Norris, in an attempt to show that each case must be considered on its own facts and merits (which they clearly must), referred to a decision of the Second Board of Appeal in Case R-391/2016-2 which concerned a conflict between the marks JULIETTE CROWE and JULIETTE. It stated at paragraph 38:

“As such, since it has not been established that surnames have, in principle, a more distinctive character than first names, there are no grounds to ascribe a priori greater distinctive character to the element ‘CROWE’ of the earlier mark than to ‘JULIETTE’”.

and concluded at paragraph 62 by stating:

“Since average consumers will retain in their minds the sole word element of the contested mark ‘JULIETTE’, when they find goods of the same or similar kind designated by the earlier mark ‘JULIETTE CROWE (fig)’, they might think that those goods have the same commercial origin. It is quite possible for an undertaking active on the market in the provision of the goods in question to use sub-brands, that is to say signs that derive from a principal mark and which share with it a common element, in order to distinguish the scope of one product from another. It is, therefore, conceivable that the public targeted may regard the aforementioned goods designated by the conflicting signs as belonging to two types of goods but as coming, none the less, from the same undertaking or from related ones. Accordingly, the applicant’s argument that the presence of the different element ‘CROWE’, being also shorter in length than ‘JULIETTE’ and placed at the end of the earlier mark, is sufficient to avoid any similarity, cannot succeed.”

36. Although not a case based on names, I also note the judgment of Mr Justice Arnold where he set out further guidance in relation to the assessment of composite marks (further to the guidance he gave in *Aveda Corp v Dabur India Ltd* [2013] EWHC 589 (Ch), [2013] ETMR 33 at [19]-[38] where he reviewed *Medion v Thomson* and six subsequent cases) to reflect the judgment of the CJEU in Case C-591/12 P *Bimbo SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:305]. Mr Justice Arnold stated:

“18. The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19. The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks - visually, aurally and conceptually - as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20. The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21. The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

37. Both counsel made submissions on the relative levels of distinctiveness as between the forename GABRIELLE and the surname CHANEL. It is fair to say, though, that most discussion focused on the forename. Mr Norris’ submission was that Gabrielle was an unusual name. At one point he described it as “exotic”. He referred to the various ONS statistics highlighting that just under 4 (the exact number is 3.83) girls out of 10k were named Gabrielle in 2015. He further submitted that even at its highpoint (in terms of numbers), the numbers were still low (21 out of 10k in 2002). Whilst Ms Michaels did not seek to argue that the name was one of the most popular names in the UK, she submitted that it was easily recognisable as a forename. She



went on to say that the name would not strike the average consumer as unusual in any way and it would not stand out as being particularly memorable or striking.

38. I have considered the ONS statistics in detail. Whilst they do not suggest a name that is highly popular, neither do they suggest a name that is particularly unusual. I note, for example, the submissions filed in response to the opponent's evidence which highlights the large number of all female names given. I also note Ms Abouljian's own evidence that for the most popular name, Amelia, there were still only 106 out of 10k over the given time period compared to 11 out of 10k for Gabrielle. Whilst this indicates that Amelia is significantly more popular than Gabrielle (it was given as a name around 10 times more over the course of the same period), this does not strike me as showing a stark difference between a (the most) popular name and an uncommon one.

39. My finding is that the female forename Gabrielle, whilst not necessarily one of the most popular girl's name in the UK, is not one that can be described as uncommon or unusual. This finding is not undermined by the acceptance by the IPO of the opponent's application to register GABRIELLE, for which an objection had been raised in respect of certain goods in class 14. A hearing officer was persuaded (based on the evidence filed in these proceedings) that the name was not a common one. Put simply, this does not bind me in anyway.

40. Before giving my views on whether a likelihood of confusion will arise, I must touch on the degree of distinctiveness of the earlier mark. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). 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 *Windsurfing Chiemsee 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)."

41. There is no evidence of use from before the relevant date so I have only the inherent characteristics of the earlier mark to consider. Whilst names are, in most cases, perfectly registrable as trade marks, they often do not make for the most distinctive of marks, although, this, of course, depends on the name itself. GABRIELLE CHANEL strikes me, as a result of the combination of the names here, as a mark with a medium level of inherent distinctiveness. However, it is the distinctiveness of the common element which is the most important factor<sup>2</sup>. From that perspective, given what I have said about the name Gabrielle, and given what I have said about names generally, I consider that the common element has a moderate (between low and medium) level of inherent distinctiveness.

42. Confusion can be direct (effectively occurring when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same, but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related). In terms of direct confusion, even bearing in mind the concept of imperfect recollection, and even though the goods are identical, there is no likelihood of the consumer mistaking one mark for

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<sup>2</sup> See, for example, the decision of Mr Iain Purvis QC, sitting as the Appointed Person, in *Kurt Geiger v A-List Corporate Limited*, BL O/075/13

the other. Whatever significance is given to the name GABRIELLE, this will not swamp the earlier mark so that CHANEL will be overlooked or misremembered/miscalled.

43. In terms of indirect confusion, this was dealt with by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 where he noted that:

“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).”

44. I touched earlier on Mr Norris' submission about sub-brands. I dismissed the significance of the evidence he relied upon as demonstrating that GABRIELLE may be seen as a sub-brand of GABRIELLE CHANEL due to the nature of the use which led the trade press to call the goods in question GABRIELLE. However, I still need to consider whether GABRIELLE will be seen as a sub-brand or whether the marks will be seen as some other form of brand extension or variant of each other (or whether there is some other reason for indirect confusion to arise). Mr Norris referred to the decision of the General Court in *Claudia Oberhauser v OHIM*, T-104/01 [2003] ETMR 58 at [49] where it held [emphasis added by Mr Norris]:

“It must further be observed, with regard to the conditions in which the products in question are marketed, that it is **common in the clothing sector** for the same mark to be configured in various different ways according to the type of product which it designates. It is **also common for the same clothing manufacturer** to use sub-brands, that is to say signs that derive from a principal mark and which share with it a common dominant element, in order to distinguish his various lines from one another (women's, men's, youth). In such circumstances it is conceivable that the targeted public may regard the clothing designated by the conflicting marks as belonging, admittedly, to two distinct ranges of products but as coming, none the less, from the same manufacturer”

45. I take no issue with the above guidance. However, I am not persuaded that indirect confusion will arise on this basis. It is not as though GABRIELLE will be perceived as a reconfiguration of GABRIELLE CHANEL. It would not be usual to reconfigure a mark in such a way, leaving out a key part of the name itself. Further, in terms of perception of a sub-brand, I do not believe that the average consumer will make such an assumption. GABRIELLE is a forename and, as I have held, it is not uncommon. The average consumer will not put the sharing of that name down to the responsible undertakings being the same or being related. They will put the commonality down to a co-incidental sharing of a not uncommon female forename with nothing to suggest a same-stable relationship. As Mr Alexander stated in *Pia Hallstrom* “..the average consumer is not particularly likely to think that another trader who uses a full name

incorporating that forename is thereby denoting goods or services from the first undertaking rather than those connected with someone else who happens to share that forename". This is applicable in the case before me.

### **Conclusion**

46. Subject to appeal, the opposition is dismissed and the application may proceed to registration.

### **Costs**

47. The applicant has been successful and is, therefore, entitled to a contribution towards its costs. My assessment, based upon the published scale, is set out below:

*Preparing a statement of case and considering the counterstatement - £300*

*Considering evidence and filing reply submissions - £700*

*Attending the hearing - £700*

***Total - £1700***

48. I order Chanel Limited to pay [REDACTED] the sum of £1700 within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 14<sup>th</sup> day of December 2017**

**Oliver Morris**

**For the Registrar,**

**The Comptroller-General**