

O-031-08

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION No. 2399804
STANDING IN THE NAME OF DOOSAN INFRACORE CO., LTD**

AND

**IN THE MATTER OF A REQUEST FOR A DECLARATION
OF INVALIDITY THERETO UNDER NO. 82710
BY DYSON LIMITED**

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standing in the name of Doosan Infracore Co., Ltd**

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**IN THE MATTER OF a request for a declaration
of Invalidity thereto under no. 82710
by Dyson Limited**

BACKGROUND

1. On 19 August 2005, Doosan Infracore Co., Ltd (which I will refer to as Doosan) applied to register the following as a trade mark:



2. The registration procedure was completed on 10 March 2006, and the mark stands registered for a range of goods in class 7.

3. On 10 November 2006, Dyson Limited (which I will refer to as Dyson) applied for a declaration of invalidity under sections 3(6), 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (the Act). Dyson ask for the trade mark in suit to be invalidated for the following, which they describe, and which I will refer to as, the “Offending Goods”:

Dish washing machines; electric wax-polishing machines; washing machines; vacuum cleaners; electric food blenders.

Dyson rely on five registered trade marks details of which are as follows:

Trade Mark	Number	Application date	Registration date	Goods
	2000035	31.10.1994	22.12.1995	<p>3 - Cleaning preparations for floors, carpets, upholstery and fabrics; preparations for removing dirt and odours from floors, carpets and fabric; floor polishing preparations</p> <p>7 - Electrical apparatus for kitchen and laundry use; washing machines and dishwashers; parts and fittings for all the aforesaid goods.</p> <p>9 -Apparatus for cleaning, polishing and shampooing floors and carpets; vacuum cleaners; carpet shampooers; floor polishers; parts and fittings for all the aforesaid goods.</p> <p>11 - Apparatus for refrigerating; refrigerators and freezers; drying apparatus; tumble dryers; hairdryers; parts and fittings for all the aforesaid goods.</p>
DYSON	CTM 36855	1.4.1996	4.3.1999	As above, save for the first clause of class 3 which reads: "Floor and carpet cleaning preparations;
DYSON	2195429	23.4.1999	29.10.1999	11 - Filters and filter apparatus; filters being parts of household appliances or installations; filters for vacuum cleaners.
	2316407	21.11.2002	25.04.2003	<p>3 - Cleaning preparations for floors, carpets, upholstery and fabrics; preparations for removing dirt and odours from floors, carpets and fabric; floor polishing preparations; dry cleaning preparations for carpets and fabric; stain removal preparations for carpets and fabric.</p> <p>7 - Electrical apparatus for kitchen and laundry use; washing machines and dishwashers; apparatus for cleaning, polishing and shampooing floors and carpets; vacuum cleaners; carpet</p>

				shampoos; floor polishers; dry cleaning apparatus for floors and carpets; floor tools for vacuum cleaners, carpet shampoos and floor polishers; apparatus for dispensing cleaning agents to floors and carpets; electric motors; electric motors for domestic appliances; switched-reluctance electric motors; separation apparatus; hoses and filters for vacuum cleaners; parts and fittings for all the aforesaid goods. 11 - Apparatus for refrigerating; refrigerators and freezers; drying apparatus; tumble dryers; hairdryers; parts and fittings for all the aforesaid goods.
dyson	CTM 3016011	21.01.2003	19.05.2005	As above – with the exception of drying apparatus in class 11

In so far as it is relevant, Dyson frame their attack in the following terms.

Under section 5(2)(b):

“9. The Applicant’s earlier trade marks each protect inter alia the following products in classes 7 and 9:

Class 7: Electrical apparatus for kitchen and laundry use; washing machines and dishwashers; parts and fittings for the aforesaid goods.

Class 9: Apparatus for cleaning, polishing and shampooing floors and carpets; vacuum cleaners; carpet shampoos; floor polishers; parts and fittings for all the aforesaid goods (the Identical Goods).

10. The Identical Goods fully encompass and are identical (and if not identical are similar) to the Offending Goods....

11. The Applicant will in particular rely upon the striking visual and aural similarity between DYSON and DOOSAN and the obvious likelihood of confusion and mis-association of one with the other were DOOSAN to be used in relation to the Offending Goods.”

Under section 5(3):

“12.....Such use would take unfair advantage of or would be detrimental to the distinctive character or repute of the earlier trade marks.

14. Because of the close visual and phonetic similarity between the Earlier Trade Marks and DOOSAN, the risk of confusion and mis-association is augmented. The proprietor has registered DOOSAN as a trade mark in relation to the Offending Goods with a view to encouraging custom to the detriment of the applicant.”

Under section 5(4)(a):

“17. Because of the close visual and phonetic similarity between the Earlier Trade Marks and DOOSAN, the risk of confusion and mis-association is augmented. Use of DOOSAN by the Proprietor in the course of trade in connection with the Offending Goods, would amount to the Proprietor passing off its business as being associated with the Applicant such that the applicant would suffer loss.”

Under section 3(6):

“..The Proprietor’s trade mark application was made in bad faith in two main respects:

a. At the time of the application, the mark DOOSAN was not being used by the Proprietor in connection with the broad specification of class 7 for which the mark has achieved registration, nor did the Proprietor have a bona fide intention that it should be so used as required under Section 32(3) of the Act. In particular, the Proprietor was not using and had no intention to use the registration as regards the Offending Goods. The proprietor was therefore acting in bad faith by applying for such a broad specification without any real or genuine use of DOOSAN in relation to the Offending Goods...

b. The Proprietor applied to register the mark DOOSAN seeking to take advantage of the similarity between DOOSAN and the earlier trade marks and to trade off the Applicant’s significant reputation and goodwill in relation to the Identical Goods.”

4. On 20 December 2006 Doosan filed a counter-statement paragraph 1 of which reads:

“1. The Registered Proprietor is a Korean company manufacturing a wide range of construction equipment, industrial vehicles, machine tools, automation systems, diesel engines and defence products and is a main driving force of the much larger Doosan group of companies who are active in the manufacture of a very much wider range of goods.”

Doosan then effectively deny the grounds on which the application is based and, where relevant, put Dyson to proof of use.

5. In her witness statement of 22 March 2007 which I summarise below, on the issue of bad faith, Ms Smith of Dyson says:

“30. Since 10 November 2006 when we filed the Statement of Grounds at the UK Patent Office, I understand that there has been a Court of Appeal judgement in the case of *Special Effects Limited v L’Oreal SA and Others* which overturned the recent High Court ruling.

31. I understand that the effect of this Court of Appeal judgement is that a party relying on a particular ground in invalidation proceedings before the UK Trade Marks Registry will no longer be estopped from relying on different grounds in subsequent High Court infringement proceedings.

32. Accordingly we wish to withdraw – without prejudice – our claim that the Registered Trade Mark was registered for the Offending Goods in bad faith by the Proprietor. There is therefore no need for me to expand on this claim in my witness statement.”

6. In their written submissions dated 7 December 2007 which I summarise below, Doosan say:

“The second Witness Statement of [Ms Smith] attempts to introduce an objection on the basis that the registered proprietor has failed to justify obtaining the registered Trade Mark in the UK for the offending goods even though the ground of invalidity based on Section 3(6) of the Act was withdrawn in the first Witness Statement of [Ms Smith] dated 22 March 2007.

And:

“...As far as the application for partial invalidation based on section 3(6) is concerned, we ask for confirmation that this ground is being treated as withdrawn as requested in the first Witness Statement of [Ms Smith]. If this ground still stands, we request additional time within which to make further submissions.”

7. In a letter dated 19 December 2007 Dyson say:

“As stated in paragraph 32 of the first Witness Statement of [Ms Smith], Dyson Limited has withdrawn its claim that the Registered Trade Mark was registered for the Offending Goods in bad faith by the Proprietor. The reasons for the withdrawal of this claim are set out in paragraphs 30 and 31 of that Witness Statement.”

8. In light of the above, I shall make no further reference in this decision to the ground based on section 3(6) of the Act.

9. Both parties filed evidence in these proceedings and both ask for an award of costs. Neither party requested to be heard but both filed written submissions. After a careful study of all the papers, I now give this decision.

EVIDENCE

Dyson’s evidence-in-chief

10. This consists of a witness statement, dated 22 March 2007, by Gillian Smith. Ms Smith is, *inter alia*, the Director of Intellectual Property at Dyson Technology Limited, Dyson Limited’s sister company; she has held this position since early 1998. She confirms that she is authorised to speak on Dyson’s behalf, adding that her statement is made on the basis of personal knowledge and from company records.

11. Ms Smith explains that James Dyson is well known around the world as an inventor, most notably as the inventor of the cyclonic vacuum cleaner; he established Dyson Limited (originally known as Dyson Appliances Limited) in July 1991. The first sales of the cyclonic vacuum cleaner in the United Kingdom were made in 1993 with, by reference to exhibit GRS1 (which consists of a copy of James Dyson’s autobiography “Against the Odds”), sales in the United Kingdom of the Dyson Dual Cyclone vacuum cleaner rising from less than 500 per month in January 1994 to approximately 14,000 per month in January 1997; by 1995 the Dyson Dual Cyclone vacuum cleaner had become the best selling vacuum cleaner in the United Kingdom. Ms Smith states that “in the last financial year”, Dyson had a worldwide turnover of £500 million and employed some 2,000 staff. Dyson she explains developed, designed and manufactured a range of different products including upright, cylinder, lightweight and handheld vacuum cleaners, washing machines and hand dryers, adding that Dyson are heralded for their design and innovation and have won a number of awards in this regard. Since 1993 Dyson has used its Dyson trade mark as its core brand and as a badge of origin for all of its products. Ms Smith explains that it would be very difficult to attribute a value to the Dyson brand and its importance to Dyson’s public profile.

12. Advertising and promotion of the Dyson brand in the United Kingdom by means of television, in-store promotions, hoardings, posters and print advertising were as follows:

Financial year ending 31 December	Amount Spent (£)
2002	2.6m
2003	2.4m
2004	5.7m
2005	5.0m

13. Turnover figures for Dyson products in the United Kingdom and worldwide were as follows:

Financial year ending 31 December	United Kingdom sales (£)	Turnover (£)
2002	1.14m	162m
2003	1.16m	159m
2004	1.16m	161m
2005	0.97m	135m

14. Ms Smith goes on to provide a time line of the significant events in the development of the Dyson brand. I do not propose to list them all here, but note, for example, the following:

1996 – subsidiaries established in France and Australia;

1997 – James Dyson wins Prince Philip Designers Prize;

1998 – subsidiaries established in Germany, Spain and Japan;

2000 – CR01 washing machine is launched;

2002 – Dyson products are launched in the United States;

2003 – Dyson wins a Queen’s Award for Innovation;

2006 – Dyson win a Queen’s Award for Enterprise; Airblade hand dryer is launched.

15. Ms Smith then turns her attention to what, in her view, are the similarities between Doosan’s registration and Dyson’s trade marks. These are of course submissions and not evidence. As such, I do not propose to summarise them here. I will of course keep them in mind when reaching my decision.

Doosan’s evidence-in-chief

16. This consists of two witness statements. The first, dated 13 August 2007, is from Sung Chul Choe who is the President of Doosan Infracore Co., Ltd a position he has held for 3 years. He explains that the facts in his witness statement are from his own knowledge or company records adding that he is authorised to speak on Doosan’s behalf.

17. Mr Sung explains that Doosan are part of the Doosan Group of Companies who were established in 1896 and who are Korea’s oldest corporation; this is confirmed by exhibit SCC1 which is an extract from the Guinness Book of Records.

18. Mr Sung then gives details of the development of the Doosan Group, and at exhibit SCC2 he provides a list of Korean trade mark registrations owned by them dating back to 1984 which incorporate the word Doosan; exhibit SCC3 consists of a list of their trade mark registrations and applications from a range of jurisdictions which consist (primarily) of the Doosan and device trade mark the subject of the registration in suit. It appears to me that this evidence has been filed in part to show the scope of Doosan’s trade (both in terms of breadth and geographical reach) in an effort to answer Dyson’s original objection based on section 3(6) of the Act. As this ground has now been withdrawn, it is not in my view necessary for me to deal with this background or evidence in any great detail.

19. At exhibit SCC4 Mr Sung provides a list of trade marks owned by Dyson in a range of jurisdictions. He comments that these trade marks have co-existed with trade marks owned by his company for the Doosan trade mark for a number of years, adding that he is not aware of any instances of confusion that have arisen. In so far as the former is concerned, given the comments of Jacob J (as he then was) in *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281, it would be inappropriate for me to place any reliance on this evidence.

20. Finally, Mr Sung refers to exhibit SCC5 which consists of copies of correspondence which suggest that Dyson’s oppositions to his company’s Doosan and device trade mark were rejected by the trade mark Authorities in a number of other jurisdictions. Copies of the decisions are not provided, nor is it clear to me whether the decisions were appealed, and if so, what the outcome of those appeals may have been. Regardless, this information is of little evidential value. It is well established that decisions from other jurisdictions are (at best) of marginal assistance, and at worst, of no assistance at all.

21. The second witness statement, dated 28 August 2007, is from Julie Turner a trade mark attorney at Murgitroyd & Company who are Doosan’s professional representatives in these proceedings. Her witness statement consists of submissions on the likelihood of confusion between Doosan’s registration and

Dyson's trade marks. Like Ms Smith's submissions for Dyson, I do not propose to summarise them here; I will of course keep them in mind when making my decision.

Dyson's evidence-in-reply

22. This consists of a further witness statement, dated 2 October 2007, from the same Gillian Smith mentioned above. Not surprisingly this consists primarily of submissions on Doosan's evidence; as such it is not necessary for me to summarise these submissions here. As before, I will of course keep them in mind when making my decision.

23. That concludes my review of the evidence filed in these proceedings insofar as I consider it necessary.

Dyson's written submissions

24. The main points emerging from Dyson's written submissions are, in my view, as follows:

- that the witness statement of Ms Turner for Doosan fails to take into account the decisions of the ECJ in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117 and *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77. These cases ought, say Dyson, to assist me in finding, given the similarities between Doosan's registration and Dyson's trade marks, particularly given the outstanding reputation of Dyson in respect of the design and engineering of domestic appliances and bearing in mind the identical nature of the offending goods, that a likelihood of confusion between the respective parties' trade marks has been established;
- that Doosan have failed to address in their evidence the grounds based on sections 5(3) and 5(4)(a) of the Act;
- that in so far as Doosan rely on co-existence of their respective trade marks in other jurisdictions, such reliance is misguided. Co-existence can only operate where both trade marks are in use, and there is no evidence that Doosan have to date used the trade mark the subject of its registration in respect of the offending goods anywhere in the world;
- that notwithstanding Doosan's evidence regarding the diverse nature of its business, it does not extend to any business connected with the offending goods, nor does it explain the business of Doosan in the United Kingdom;
- that Doosan's evidence provides no information as to why or how it seeks to use the registration in suit in respect of the offending goods.

Doosan's written submissions

25. The main points emerging from Doosan's written submissions are, in my view, as follows:

- that Dyson's trade marks and the registration in suit would not be regarded as similar by the relevant public when viewed as a whole;

- that the beginnings of the trade marks are pronounced differently, namely DY- which is a short, harsh syllable as against DOO- which is a long, soft syllable. The respective trade marks are phonetically different;
- that the respective trade marks are visually different. Although they share the same initial letter “D”, there is a strong visual difference between the letter “Y” appearing in Dyson’s trade marks and the letters “OO” in Doosan’s registration. Furthermore, Doosan’s registration includes a device element consisting of three squares which are positioned in a haphazard manner which further differentiates the respective trade marks from a visual standpoint. Although the device element may not form the most distinctive part of Doosan’s registration, its inclusion must not be overlooked when comparing the trade marks as wholes;
- that neither of the respective parties’ trade marks have any meaning, and, as such, there are no conceptual similarities. If anything there is a conceptual dissimilarity in that Dyson may be recognised and remembered as a surname whereas Doosan would be regarded as an invented word;
- that the beginning of a trade mark is usually the most important for the purposes of comparison, as there is a tendency to slur the endings of trade marks. There are significant differences between the letters DY and DOO;
- that trade marks should not be compared letter by letter as this results in an overly analytical comparison which would not be replicated by the relevant public when purchasing the goods;
- that the beginnings of the respective trade marks are phonetically dissimilar. As such, there would be no confusion if the goods were ordered over the telephone. That in the context of these proceedings, it is unlikely that goods such as vacuum cleaners, dishwashing machines, electrical wax polishing machines, washing machines and electric food blenders would be ordered over the telephone, without first having viewed the goods either in a retail outlet, catalogue or on the Internet. These goods are fairly expensive items which would be examined in detail to ensure they meet the consumer’s specific requirements before they are purchased;
- that in their decision in *Lloyd Schuhfabrik* the ECJ noted: “it should 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”. In these proceedings the goods at issue are relatively expensive and are therefore likely to be viewed carefully before being purchased, as such there is a reduced risk of confusion. They add that notwithstanding the comments in Dyson’s evidence-in-reply, the goods at issue are still relatively expensive when compared with, for example, a bag of sweets;
- that notwithstanding the identity of the goods, given the strong visual differences between the respective trade marks there would be no likelihood of confusion;
- that in relation to the objection based on section 5(3) of the Act, Doosan do not dispute that Dyson have a reputation in their trade marks in respect of the goods the subject of the application for invalidity. However use of Doosan’s registered trade mark would not take advantage of or be detrimental to the distinctive character or repute of Dyson’s trade marks, because the respective trade

marks are not similar and as a consequence the public would not make any link or association between the respective trade marks;

- that in relation to the objection based on section 5(4)(a) of the Act, again Doosan do not dispute that Dyson have goodwill/reputation in their trade marks in respect of the goods the subject of the application for invalidity. That said, use of Doosan's registered trade mark would not in their view amount to a misrepresentation which would result in confusion of the public, because the respective trade marks are not similar and as such no damage would be caused to Dyson's business.

DECISION

26. Section 47 of the Act reads as follows:

“47.-(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

(2) The registration of a trade mark may be declared invalid on the ground -

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

(2A)* But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

(a) within the period of five years ending with the date of the application for the declaration the earlier trade mark has been put to genuine use in the United

Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(2D) In relation to a Community trade mark, any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Community.

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(3) An application for a declaration of invalidity may be made by any person, and may be made either to the registrar or to the court, except that—

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(4)

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:

Provided that this shall not affect transactions past and closed.”

27. I turn first to the ground based on section 5(2)(b) of the Act. I note that in their Form TM8 and counterstatement Doosan puts Dyson to proof of use of those of their trade marks which have been registered for more than five years prior to the date of the application for the declaration of invalidity. Dyson’s application was filed on 10 November 2006, consequently this effects the following trade marks:

Nos: 2000035 (registered on 22 December 1995), CTM 36855 (registered on 4 March 1999) and 2195429 (registered on 29 October 1999). In their Statement of Grounds, Dyson say:

“19. The use conditions referred to in section 47(2A) of the Act have been met by the Applicant in respect of the relevant earlier trade marks...Specifically, within the five year period ending with the date of this application, the relevant earlier trade marks have been put to genuine use in the United Kingdom by the Applicant or with the Applicant’s consent in relation to vacuum cleaners, washing machines and hand dryers and fittings, parts and accessories therefore.”

28. Ordinarily, it is at this point in my decision that I would analyse what use Dyson had made of these trade marks in light of the guidance to be found in *Ansul BV and Ajax BrandbeveiligingBV (Minimax)* [2003] RPC 40, and then using the guidance provided in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32, I would determine what, in my view, would constitute a fair specification of goods having regard to the use that had been shown. However in these proceedings it is not, I think, necessary for me to do so. There has been no suggestion by Doosan that the trade marks on which Dyson rely in these proceedings are anything other than trade marks consisting of the word Dyson. I note of course that No. 2000035 consists of a series of two trade marks, the second mark of which is represented in a stylised manner. Similarly while Nos: 2316407 (registered on 25 April 2003) and CTM 3016011 (registered on 19 May 2005) both consist of the word Dyson presented in bold in a lower case script, nonetheless they are still quite clearly Dyson trade marks. Given that these two registrations are not subject to the proof of use provisions, and that (at least) No. 2316407 contains a range of goods which include goods which are identical to the offending goods in Doosan’s registration, it is not, in my view, necessary for me to consider Dyson’s claimed use.

29. Section 5(2)(b) reads as follows:

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

(a)

(b) it is similar to an earlier 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.”

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

The trade marks on which Dyson rely are earlier trade marks as defined by Section 6(1) of the Act.

31. In reaching a decision I take into account the well established guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723.

It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all the relevant factors; *Sabel BV v. Puma AG*;
- (b) the matter must be judged through the eyes of the average consumer of the good/services in question; *Sabel BV v. Puma AG* who is deemed to be reasonably well informed and circumspect and observant – but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc.*;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*;
- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG & Adidas Benelux BV*
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc.*

The relevant consumer and the nature of the purchasing decision

32. All of the offending goods, i.e. dish washing machines, electric wax-polishing machines, washing machines, vacuum cleaners and electric food blenders can be purchased by members of the general public

for use in the home. Equally, all of the offending goods may be designed specifically for either household or industrial purposes. As such, they are also likely to be purchased by those in the trade buying them for use in a commercial context. All of the offending goods are most likely in my view to be bought by self selection either from a shelf, from a catalogue, or on-line and as a result, it is the visual and conceptual characteristics of the respective trade marks that are, in my view, the most important. However as Dyson comment, I must not rule out telephone ordering of the goods. I accept that, but agree with Doosan that given the nature of the goods at issue, any telephone ordering of the goods is likely to take place only after the potential purchaser has examined the goods in either a retail setting, in a catalogue or on-line. I accept of course that oral recommendations may also play a part in the selection process.

33. Given the nature of the offending goods and their potential cost, I agree with Doosan that the purchase of such goods is likely to be approached with a good deal of care and attention, thus ensuring that they meet the potential purchaser's specific requirements. In this regard, I must keep in mind that the case law indicates that a potential purchaser's attention is likely to vary according to the category of goods in question. While I note Dyson's comments to the effect that for example, vacuum cleaners and electric food blenders can be purchased in the United Kingdom for less than £40 and £20 respectively, I agree with Doosan that given the nature of the goods and the importance of them meeting the purchaser's specific requirements, the purchase of even relatively low cost variants of the offending goods will still be approached with a good deal of care.

Comparison of goods

34. As I indicated at paragraph 28 above, registration No. 2316407 stands registered for a range of goods which are, in my view, identical to the offending goods. For the sake of convenience, the goods covered by this registration and the offending goods are reproduced below:

Offending Goods	Goods of No. 2316407 in classes 7 & 11
Dish washing machines; electric wax-polishing machines; washing machines; vacuum cleaners; electric food blenders.	<p>7 - Electrical apparatus for kitchen and laundry use; washing machines and dishwashers; apparatus for cleaning, polishing and shampooing floors and carpets; vacuum cleaners; carpet shampooers; floor polishers; dry cleaning apparatus for floors and carpets; floor tools for vacuum cleaners, carpet shampooers and floor polishers; apparatus for dispensing cleaning agents to floors and carpets; electric motors; electric motors for domestic appliances; switched-reluctance electric motors; separation apparatus; hoses and filters for vacuum cleaners; parts and fittings for all the aforesaid goods.</p> <p>11 - Apparatus for refrigerating; refrigerators and freezers; drying apparatus; tumble dryers; hairdryers; parts and fittings for all the aforesaid goods.</p>

35. It is quite clear that the dish washing machines, washing machines and vacuum cleaners appearing in Doosan's registration are identical to the dishwashers, washing machines and vacuum cleaners appearing

in Dyson’s registration. The electric wax polishing machines and electric food blenders appearing in Doosan’s registration are, in my view, contained within the terms apparatus for cleaning, polishing and shampooing floors and carpets, and electrical apparatus for kitchen and laundry use appearing in Dyson’s registration. As I mentioned above, I note that in their written submissions, Doosan say: “Notwithstanding the identity of the goods...”; a clear indication in my view that they too consider the respective parties’ goods to be identical.

Comparison of trade marks

36. It is well established that the relevant consumer is considered to be someone who is reasonably well informed, circumspect and observant, who perceives trade marks as a whole and does not pause to analyse their various details; in addition, he/she rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he/she has kept in his or her mind. I have also to bear in mind the distinctive and dominant components of the respective trade marks.

37. All of Dyson’s earlier trade marks consist of the word DYSON presented either alone, in a stylised script, or presented in bold in lower case. For the purposes of these proceedings, I intend to carry out a comparison between Doosan’s registration and Dyson’s earlier trade mark No. 2316407. If Dyson do not succeed on the basis of this registration, they are, in my view, in no better position in so far as their other registrations are concerned. That being the case, it is now appropriate for me to consider the following trade marks from the visual, oral/aural and conceptual standpoints mentioned in the case law.

Doosan’s trade mark	Dyson’s trade mark
	

Visual similarity

38. Dyson argue that the dominant elements of both trade marks are the letter sequence, D, S and N, adding that in so far as Doosan’s registration includes a device element, it is the word Doosan that is the dominant element. While Doosan appear to accept that the device element is not the most distinctive part of their registration, they argue that it should not be overlooked when comparing the trade marks as a whole. Doosan add that Dyson’s approach to comparing the trade marks letter by letter is not appropriate, as this results in an overly analytical comparison which is not reflected in the way the relevant consumer would approach the trade marks. They say that while the respective trade marks share the same initial letter “D” there is a strong visual difference between the letter “Y” appearing in Dyson’s trade marks and the letters “OO” appearing in their registration.

39. Now my own view. The parties’ trade marks consists of six and five letters respectively, both beginning with the letter “D”, with the letter “S” in the fourth and third letter positions respectively, and both ending with the letter “N”; to that extent at least, there must be a degree of visual similarity. While I agree with Dyson that the word Doosan is the dominant element of the registration in suit, equally I agree with Doosan that the device element is more than a mere background and assists in differentiating the

trade marks from a visual standpoint, as do the letters which are not shared. **Overall, I consider there to be a low degree of visual similarity between the respective trade marks.**

Oral/aural similarity

40. In relation to this aspect of the comparison Dyson argue that: the trade marks are only differentiated by soft vowels which blend into one another when spoken, that the trade marks sound almost identical, and that the device element present in Doosan's registration should be disregarded in so far as the oral/aural comparison is concerned. Doosan argue that the case law advises that it is the beginnings of trade marks which are the most important for the purposes of comparison, given the natural tendency for the endings of words to be slurred. In their view, the beginnings of the trade marks are pronounced quite differently, the letters DY in Dyson's trade mark would they say be articulated as a short, harsh sound, whereas the letters DOO in their own registration would be articulated as a long, soft syllable.

41. Now my own view. Both trade marks consist of two syllables which would in my view be articulated as Doo san and Dy son. I agree with Dyson that in oral/aural usage the device element present in Doosan's registration would not be articulated and as such does not assist them in relation to this aspect of the comparison. Notwithstanding Doosan's comments as to how the beginnings of the respective trade marks are likely to be articulated, both trade marks begin with the letter "D", are of similar overall length and structure and have similar endings. **Overall, I consider there to be a reasonable degree of oral/aural similarity between the respective trade marks.**

Conceptual similarity

42. Dyson do not comment on this aspect of the comparison. Doosan argue that neither of the trade marks has any meaning and as such there is no conceptual similarity. Alternatively, they argue that there is conceptual dissimilarity because Dyson may be recognised and remembered as a surname, whereas Doosan would be regarded as an invented word. Although I have no evidence on the point, I am inclined to agree with the second of Doosan's submissions. In my view, it is likely that the word Dyson would be recognised as a surname, whereas Doosan would be regarded as an invented word, possibly of foreign origin. **If I am right then there would be conceptual dissimilarity, if I am wrong, I accept Doosan's first submission to the effect that there would be no conceptual similarity.**

43. **In summary, I have concluded that that the respective parties' trade marks share (i) a low degree of visual similarity, (ii) a reasonable degree of oral/aural similarity and (iii), either no conceptual similarity, or conceptual dissimilarity.**

Likelihood of confusion

44. When determining whether there is a likelihood of confusion a number of factors need to be considered. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the goods and vice versa. It is also necessary for me to consider the distinctive character of the earlier trade mark as the more distinctive the earlier trade mark (either inherently or as a result of any use that has been made of it) the greater the likelihood of confusion. The distinctive character of the earlier trade mark must be appraised

by reference to the goods in respect of which it is registered and also by reference to the way it will be perceived by the relevant consumer.

45. In her first witness statement Ms Smith of Dyson explains that Dyson first made use of their Dyson trade mark in the United Kingdom in 1993 in relation to a cyclonic vacuum cleaner, with sales in the United Kingdom of the Dyson Dual Cyclone vacuum cleaner rising from less than 500 per month in January 1994 to approximately 14,000 per month in January 1997, and that by 1995 the Dyson Dual Cyclone vacuum cleaner had become the best selling vacuum cleaner in the United Kingdom. She went on to explain that Dyson have developed, designed and manufactured a range of different products including upright, cylinder, lightweight and handheld vacuum cleaners, washing machines and hand dryers, adding that Dyson are heralded for their design and innovation and have won a number of awards in this regard. Turnover of Dyson branded products in the United Kingdom in the period 2002-2005 amounted to approximately £4.7m, with advertising and promotional spend in the United Kingdom during the same period amounting to approximately £15.7m. The only exhibit filed to support these claims came in the form of James Dyson's autobiography. However, given the comments of the Appointed Person Mr Richard Arnold QC in *Extreme Trade Mark* (BL O/154/07) regarding the challenging of evidence in inter partes proceedings before the Trade Marks Registry, and in view of the following comment which appeared in Doosan's written submissions (albeit it in the context of the ground based on section 5(3) of the Act), i.e.

“We do not dispute that [Dyson] has a reputation in the marks which form the basis of the application for partial invalidity in respect of the goods the subject of the application...”,

I am prepared to accept that the inherent characteristics of the Dyson trade mark have been enhanced by virtue of the use which has been made of it, and that, in line with the guidance provided in the case law there is as a result a greater likelihood of confusion between the respective parties' trade marks.

46. In summary, I have concluded that: (i) the goods at issue in these proceedings are identical, (ii) that there is a low degree of visual similarity, (iii) a reasonable degree of oral/aural similarity (vi), at worst there is no conceptual similarity (in fact there may actually be conceptual dissimilarity) and (v), that Dyson are entitled to an enhanced level of protection for their Dyson trade mark. In addition, I have concluded that given the nature of the goods at issue and the traits of the relevant consumer when purchasing such goods, the visual and conceptual aspects of the comparison are the most important. Applying the global approach advocated to these findings, in my view, the significant visual and conceptual differences more than offsets the identity in the goods and the reasonable degree of oral/aural similarity in the respective trade marks.

47. Consequently there is, in my view, no likelihood of either direct confusion i.e. that the trade marks will be mistaken for one another, or indirect confusion on the basis that the relevant consumer would think that goods sold under Doosan's trade mark were from an undertaking economically linked to Dyson; the ground based on section 5(2)(b) of the Act fails accordingly.

The objections based on sections 5(3) and 5(4)(a) of the Act

48. Section 5(3) of the Act reads as follows:

“5.-(3) A trade mark which -

(a) is identical with or similar to an earlier trade mark,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark EC in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

49. The first requirement to be met under Section 5(3) of the Act is for the earlier trade mark to be identical or similar to the trade mark the subject of the registration; only if that condition is satisfied need I go on to determine if the Dyson trade mark possesses a reputation in the United Kingdom to the extent set out by the ECJ in *General Motors Corporation v. Yplon SA* [1999] E.T.M.R. 122; although I note that in their written submissions it appears that Doosan accepts that it does. However, having taking into account the similarities and differences between the parties’ trade marks, and keeping in mind the identity in the goods, I have concluded that the relevant consumer is not going to make a connection between the respective trade marks. In my view, Doosan’s registration will not even bring the Dyson trade mark to mind; the ground based on section 5(3) of the Act is dismissed accordingly.

50. Section 5(4) of the Act reads as follows:

“5.-(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

51. Mr Geoffrey Hobbs QC, sitting as the Appointed Person set out a summary of the elements of an action for passing off in his decision in the *Wild Child* Trade Mark case [1998] RPC 455. Mr Hobbs summarised the requirements as follows:

“(1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.”

52. In their written submissions. Doosan say, *inter alia*, in relation to the above ground:

“Again we do not dispute that [Dyson] has goodwill/reputation in the marks which form the basis of the application for partial invalidity in respect of the goods the subject of the application. However, use of the mark covered by [Doosan’s registration] would not amount to a misrepresentation which would result in public confusion because the respective marks are in no way similar. As such, no damage would be caused to [Dyson’s] business.”

53. Notwithstanding that Dyson may have the necessary goodwill to satisfy the first leg of the test for passing off, my comments in paragraph 49 above apply equally to this ground of objection. There will not, in my view, be a misrepresentation likely to lead the public to believe that goods offered by Doosan are the goods of Dyson. Consequently, Dyson will not suffer damage; the application based on section 5(4)(a) of the Act is also dismissed.

Summary

54. The application for the invalidation of the offending goods based on sections 5(2)(b), 5(3) and 5(4)(a) of the Act has failed.

COSTS

55. The application has failed and Doosan are entitled to a contribution towards their costs. Doosan’s evidence consisted of the two witness statements mentioned above. The first was from Mr Sung and was accompanied by exhibits showing, *inter alia*, trade marks owned by them both in Korea and other jurisdictions, trade marks owned by Dyson primarily in other jurisdictions and correspondence showing Doosan’s apparent success in legal proceedings between the parties also in other jurisdictions; none of which was of any assistance in determining the issues in these proceedings. The second witness statement was from Doosan’s legal representative Ms Turner and consisted entirely of submissions. Dyson’s evidence, which Doosan were of course required to review, consisted of two short witness statements (running to some 7 and 4 pages respectively) and each was accompanied by one exhibit. Taking all of the above factors into account, I award costs to Doosan on the following basis:

Considering the Application and accompanying statement: £200

Statement of case in reply: £300

Considering Dyson’s evidence: £300

Filing of written submissions: £100

Total £900

56. I order Dyson to pay to Doosan the sum of £900. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 5th day of February 2008

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