

O-036-05

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2337964
BY PAUL DAVIS TO REGISTER A TRADE MARK
IN CLASSES 3, 9, 18 AND 25**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No. 92201
BY WILLIAM JOHN DICKINSON, ANTHONY FREDERICK
RICHARDSON, SIMON DICKIE AND GARY THORNEYCROFT
T/A POD TRADEMARKS PARTNERSHIP**

TRADE MARKS ACT 1994

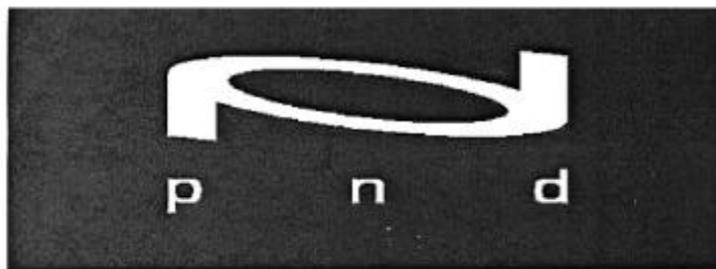
**IN THE MATTER OF Application No. 2337964
by Paul Davis
to register a Trade Mark in Classes 3, 9, 18 and 25**

and

**IN THE MATTER OF Opposition thereto under No. 92201
by William John Dickinson, Anthony Frederick Richardson,
Simon Dickie and Gary Thorneycroft t/a Pod Trademarks
Partnership**

BACKGROUND

1. On 17 July 2003 Paul Davis applied to register the following trade mark:



2. Registration was sought in respect of the following goods:

Class 03:

Perfumes, non-medicated toilet preparations, cosmetics, soaps, preparations for the hair, essential oils, depilatory preparations and anti-perspirants; preparations for the bath; pot pourri.

Class 09:

Sunglasses; spectacles; spectacle cases, chains and eyeglass frames; eyeshades, lenses, cameras, cases for cameras, parts and fittings for all the aforesaid goods.

Class 18:

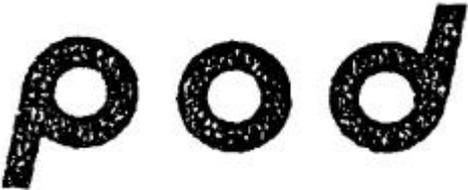
Bags, handbags, holdalls, rucksacks, belt bags, suitcases, travel bags, purses, wallets, trunks, pouches and umbrellas; all included in Class 18.

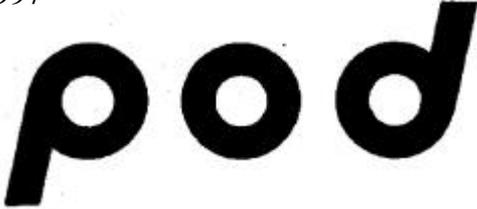
Class 25:

Clothing, headgear and footwear.

3. The application was subsequently published in the Trade Mark Journal and on 12 December 2003 William John Dickinson, Anthony Frederick Richardson, Simon Dickie and Gary Thorneycroft t/a Pod Trademarks Partnership (henceforth known as Pod), filed a Notice of Opposition. In summary the grounds were:

(i) Under Section 5(2)(b) of the Act because the mark applied for is similar to the following earlier trade mark owned by the opponent which cover identical and similar goods in Classes 3, 9, 18 and 25, and there exists a likelihood of confusion on the part of the public –

<p>2183342</p> 	<p>Class 3 Non-medicated toilet preparations; cosmetics; preparations for the hair; preparations for the skin; perfumes; eau de colognes; essential oils; toilet waters; soaps; shower gels; body sprays; sun tanning preparations. 30 November 1998 Advertised Trade Marks Journal No. 6288 Page 9420.</p>
<p>2295931</p> 	<p>Class 9 Protective clothing; protective footwear. 19 March 2002 Advertised Trade Marks Journal No. 6454 Page 18093</p>
<p>2021290</p> 	<p>Class 18 Rucksacks; haversacks; travelling bags; leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks; umbrellas; parasols and walking sticks. 23 May 1995 Advertised Trade Marks Journal No. 6110 Page 607</p>

<p>1084790</p> 	<p>Device</p>	<p>Class 25 Footwear being articles of clothing. 7 October 1977 Advertised Trade Marks Journal No. 5215 Page 1675</p>
<p>1110283</p> 	<p>Device</p>	<p>Class 25 Articles of clothing for children, articles of outer clothing for men and women. 28 February 1979 Advertised Trade Marks Journal No. 5331 Page 2133</p>
<p>CTM 192997</p> 		<p>Class 25 Shoes; boots and other footwear, and parts and fittings therefor; clothing; headgear. 1 April 1996 Published in the Official Bulletin 041/1998 of the 8 June 1998.</p>

(ii) Under Section 5(4)(a) of the Act by virtue of the law of passing off.

4. The applicant filed a counterstatement denying the grounds of opposition. While the applicant admits that the respective goods in Classes 3, 18 and 25 are identical it denies that the goods in Class 9 are similar and it denies that the trade marks are similar.

5. The opponent filed evidence and both parties forwarded written submissions. Both parties have asked for an award of costs in their favour. The parties were content for a decision to be taken without recourse to a hearing.

Opponent's Evidence

6. The opponent's evidence consists of a witness statement by Anthony Frederick Richardson dated 10 August 2004.

7. Mr Richardson is a partner in Pod and he explains that the partnership is engaged in marketing activities and the promotion of its trade for use on footwear, clothing and bags by licensees and distributors.

8. Mr Richardson states that the pod trade mark has been in continuous use since 1997 in the United Kingdom in respect of footwear, clothing and bags. In support, he attaches the following exhibits to his statement:

- (i) Exhibit AFR 3 – a copy of European Community trade mark Registration 1036912 details (a mark not mentioned in the Statement of Grounds), together with a copy of how the mark forming the subject of this registration is used on footwear;
- (ii) Exhibit AFR 4 – copies of sample promotional materials and advertisements relating to the Pod mark;
- (iii) Exhibit AFR 5 – copies downloaded from the Pod website, together with sample labels for clothing from 2000 and 2001 and product literature;

9. Mr Richardson explains that from 1997 to 2000, Pod granted a clothing license to Rivergaro but as that company was liquidated in 2000 only limited information is available. However, Mr Richardson provides the following net sales figures for that period:

Year	£
1997	883,175
1998	1,936,464
1999	2,658,840
2000	704,440

10. Mr Richardson goes on to state that as of 2000, a new license was granted to Oceania and the sales figures for 2001 to 2003 are set out below:

Year	£
2001	3,371,266
2002	1,188,751
2003	853,400

11. Mr Richardson states that Rivergaro also had a license in respect of bags but that the sales figures up until 2000 are unavailable. In 2000, Pod Limited, another licensed company took over the sale of bags and gross sales figures for the years 2000 to 2003 (which also includes some caps as well as bags) total £451,378.36.

12. Next, Mr Richardson draws attention to the following exhibits to his statement, which relate to advertising and promotion:

- (i) Exhibit AFR 8 – some examples covering the period 1999 to 2004;
- (ii) Exhibit AFR 9 – a chart setting out advertising expenditure figures for the years 2001 to 2003, in relation to clothing, which amounts to a grand total of £263,723.90.

13. Mr Richardson states that Pod has promoted its clothing at the 40 Degrees Exhibition in February and August each year for the years 1997 to 2001. In 2002 it attended the February Exhibition only. Exhibit AFR 10 is a copy of sample purchase orders for pod clothing in March 2000, February 2001 and July 2002 from All Sports and June 2003 from M and M Sports.

Opponent's Written Submissions

14. The opponent's written submissions are attached to a letter dated 23 December 2004 from Forrester Ketley & Co, the opponent's professional representatives in these proceedings.

15. The opponent contends that the Trade Mark applied for comprises a device element bearing certain similarities to the letters p, o and d, together with the letters pnd appearing beneath. In view of this "arguably, "pod" can be "read" from the Device element of the Mark" and it is possible that people will not notice the letter n appearing beneath it. Furthermore, n is only one letter removed from the letter o so that people may be confused between pod and pnd. Thus, both the Opponent's Mark and the Applicant's Mark comprise three letters and people may be confused between pod and pnd.

16. In relation to Section 5(4)(a), the opponent submits that the sales and advertising figures provided by the opponent demonstrate that they have a substantial reputation and goodwill in the UK.

Applicant's Written Submissions

17. The applicant's written submissions are attached to a letter dated 29 December 2004 from Dechert, the applicant's professional advisors in these proceedings.

18. The applicant submits that the opponent's earlier marks would be pronounced "Pod" while the mark applied for would be pronounced "pnd". It is stated that the mark applied for has been in use since 1995 with the letters pnd being taken from the name of the applicant, Paul Nathan Davis. Copies of the "original design" dated 11 February 1995 are attached to the Dechert's letter as are examples of labels and swing-tags.

19. This concludes my summary of the evidence and submissions. I now turn to the decision.

DECISION

Section 5(2)(b)

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

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

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

21. An earlier right is defined in Section 6, the relevant parts state:

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

- (a) a registered trade mark, international trade mark (UK) or Community trade mark 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”.

22. 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 Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723.

23. It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG*;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*;

- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*;
- (g) account should be taken on 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 was registered; *Lloyd*;
- (h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*;
- (i) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG*;
- (j) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*.

24. The reputation of a trade mark is an element to which importance may be attached in Section 5(2) considerations in that it may enhance the distinctive character of the mark at issue and widen the penumbra of protection for such a mark. The opponent has filed evidence relating to the use of its pod trade mark. While the evidence confirms use of the mark and provides information on the turnover of goods sold under the mark, it provides no evidence of its market share or the extent of its reputation. Given the very large market for the goods in question – clothing, footwear and bags – it seems to me that the turnover details provided may not indicate a particularly high market share and does not enable me to infer that the opponent has a great reputation under the mark. Furthermore, expenditure on the marketing and promotion of the mark while significant is by no means remarkable and there are no details as to the extent of the circulation of the catalogues and advertising material referred to in the evidence. I would add that no supporting evidence from third parties or the trade has been filed.

25. On the evidence filed, I have no doubt that the opponent possesses goodwill and a not insignificant reputation in its “pod” mark. However, it has not been shown to be a household name amongst the relevant public.

26. The effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act was recently considered by David Kitchen QC sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchen concluded at paragraph 17 of his decision:

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion.”

27. In the present case it seems to me that the opponent’s “pod” mark on a balance of its reputation and inherent nature, is fully distinctive and deserving of a wide penumbra of protection.

28. In essence the test under Section 5(2) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those differing elements, taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed. Furthermore, in addition to making comparisons which take into account the actual use of the respective marks, I must compare the mark applied for and the opponent’s registrations on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods within the respective specification.

29. In its evidence the opponent refers to its Community Trade Mark Registration No. 1036912 and the trade mark covered thereby. However, as this mark is not referred to in its Statement of Grounds I cannot take it into account for the purposes of this decision.

30. I turn to a consideration of the respective goods covered by the application in suit and the opponent’s earlier registrations. It is obvious and it is sensibly conceded by the applicant, that the respective goods in Classes 3, 18 and 25 are identical or similar.

31. In relation to Class 9 of the application the opponent contends that “there could conceivably be an overlap between the protective clothing and footwear of interest to the Opponents and certain protective items such as sunglasses, spectacles, eyeshades and lenses of interest to the “Applicant”. I agree insofar as the eyewear of the applicant may be of a protective nature in that, clothing and eyewear for protective purposes e.g. for use in industry to protect the wearer, shares the same purpose and is likely to follow the same trade channels to the customer.

32. I now turn to a comparison of the respective marks. The mark applied for consists of the letters PND (spaced out on the same line and presented in lower case) and incorporating an oval shaped device with a descending line on its left hand side and an ascending line on its

right hand side. The opponent's earlier marks comprise the obvious dictionary word POD presented in lower case and a slightly unusual font. I would add that the Statement of Grounds also refers under registrations No. 1084790 and 1110283 which are for device marks which bear no resemblance whatsoever to the mark in suit, are in no way similar and to which I do not intend to give any further consideration.

33. The guiding authorities make it clear that I must compare the marks as a whole and by reference to overall impression. However, as recognised in *Sabel BV v Puma AG* (mentioned earlier in this decision) in my comparison, reference will inevitably be made to the distinctiveness and dominance of individual elements. It is, of course, possible to over analyse marks and in doing so shift away from the real test which is how the marks would be perceived by customers in the normal course and circumstances of trade. I must bear this in mind when making the comparisons.

34. I go to a visual comparison of the respective marks. The differences are readily apparent. In addition to the device element within the mark in suit, the spacing between the letters pnd accentuates the impact of the separate letters. The opponent's pod mark shares the letters p and d with that of the mark applied for. However, pod is an obvious dictionary word. In this context I believe the meaning and look of a word will be closely associated by the public. A common word will be identified within its meaning when it is viewed and the visual interpretation will be based upon the identification of the word. In my view this is a key factor leading to a conclusion that the respective marks are visually different and would be readily distinguished in visual use.

35. In relation to the aural comparison of trade marks used in respect of articles of clothing, I agree with the view expressed by the Registrar's Hearing Officer in the matter of Opposition thereto by Update Clothing Limited under No. 45787 (BL O/258/98) when he said:

“There is no evidence to support Ms Clarke's submission that, in the absence of any particular reputation, consumers select clothes by eye rather than by placing orders by word of mouth. Nevertheless, my own experience tells me it is true of most casual shopping. I have not overlooked the fact that catalogues and telephone orders play a significant role in this trade, but in my experience the initial selection of goods is still made by eye and subsequent order usually placed primarily by reference to a catalogue number. I am therefore prepared to accept that a majority of the public rely *primarily* on visual means to identify the trade origin of clothing, although I would not go so far as to say that aural means of identification are not relied upon”.

36. This view was supported on appeal to the Appointed Person (*REACT Trade Mark* [2000] 8 RPC 285 lines 22 to 26) and I believe it appropriate to the present case. I also believe it relevant to footwear and bags (particularly hand bags) where purchasing considerations are similar and also to most eyewear products.

37. In relation to oral use the mark in suit is likely to be described as a pnd mark as the letters “would speak louder than the device”. However, in such use each letter would be emphasised separately within the whole and the totality would sound obviously different to the word pod. The marks would be readily distinguished in oral use.

38. Next a conceptual comparison of the marks. Although they share the letters p and d, the mark in suit consists of three letters and a device, whereas the opponent's earlier mark is a

dictionary word. I do not believe the average consumer would infer any conceptual similarity between the marks.

39. In my considerations I must also consider the relevant customer for the goods, which, in these proceedings, are the public at large. The relevant goods are often necessities as well as being fashion items and are sold through a wide variety of outlets and at a wide range of prices. They are usually purchased with a reasonable degree of care e.g. as to size, colour, appearance, function, and after a visual reference.

40. On a global appreciation, taking into account all the relevant factors, I have reached the conclusion that while the goods of interest are identical or similar, the differences in the respective trade marks are such that there is no likelihood of confusion to the average customer for the goods.

41. The opposition under Section 5(2)(b) of the Act fails.

Section 5(4)(a)

42. Next, the Section 5(4)(a) ground. Section 5(4)(a) of the Act states:

“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) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

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.”

43. I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC in the *WILD CHILD* case [1998] 14 RPC 455. In that decision Mr Hobbs states that:

“The question raised by the grounds of opposition is whether normal and fair use of the designation WILD CHILD for the purpose of distinguishing the goods of interest to the applicant from those of other undertakings (see Section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Article 4(4)(b) of the Directive and Section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the applicant in accordance with the law of passing off.”

"A helpful summary of the elements of an action for passing off can be found in Halsbury's Laws of England 4th Edition Vol 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v Borden Inc* [1990] RPC 341 and *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1979] ACT 731 is (with footnotes omitted) as follows:

"The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

- (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.””

44. The date at which the matter must be judged is not entirely clear from Section 5(4)(a) of the Act. This provision is clearly intended to implement Article 4(4)(b) of Directive 89/104/EEC. It is now well settled that it is appropriate to look to the wording of the Directive in order to settle matters of doubt arising from the wording of equivalent provisions of the Act. It is clear from Article 4(4)(b) that the earlier right had to have been “acquired prior to the date of application for registration of the subsequent trade mark, or the date of the priority claimed” the relevant date is therefore the date of the application for the mark in suit.

45. Earlier in this decision I found that the application in suit and the opponent’s registration was not likely to be confused. Accordingly, it is my view that the necessary misrepresentation required by the tort of passing off will not occur. The opposition under Section 5(4)(a) therefore fails.

COSTS

46. The applicant is entitled to a contribution towards costs and I order the opponent to pay the applicant the sum of £1000, which takes into account that no hearing took place on this case. 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 8th day of February 2005

JOHN MacGILLIVRAY
For the Registrar
the Comptroller-General