

**O-049-17**

**In the matter of THE TRADE MARKS ACT 1994**

**And in the matter of REGISTRATION No. 3005632 in the name of ARGON  
CONSULTING & MANAGEMENT LIMITED**

**For the trade mark**

**ROCHESTER**

**In class 34**

**And in the matter of an APPLICATION FOR A DECLARATION OF INVALIDITY  
No. 500759 by JT INTERNATIONAL S.A.**

**Appeal from the Decision of the Hearing Officer, Mr Mark Bryant, on behalf  
of the Registrar, the Comptroller General, dated 4 February 2015**

**Guy Hollingworth (instructed by Marks & Clerk) for JT International  
Ian Bartlett (of Beck Greener) for Argon Consulting**

**DECISION OF THE APPOINTED PERSON**

**Introduction**

1. This is an appeal from the decision of the Hearing Officer, Mr Mark Bryant, dismissing an application for revocation.
2. The registered trade mark in issue is held by Argon Consulting & Management Limited ('the Proprietor') for the word ROCHESTER registered as of 13 May 2013 in class 34 for the following goods:

*Cigarettes; cigars; tobacco, whether manufactured or unmanufactured;  
substances for smoking sold separately or blended with tobacco;  
lighters, matches, tobacco pipes, cigarette rolling machines; smokers'*

*articles; cigar cutters; cigarette papers; snuff; snuff boxes; snuff takers' articles; parts and fittings for all the aforesaid.*

3. The application to revoke was brought by JT International S.A. ('JT'), under s47(2)(a) of the Trade Marks Act 1994, contending that the Mark was registered in contravention of s5(2)(b) of the Act, because the use of the Mark for the goods for which it was registered would be likely to cause confusion with its own registered trade marks for the word DORCHESTER.
4. JT has two prior registrations for the word DORCHESTER:
  - (a) UK Trade Mark 1262539 dated 14 March 1986 in class 34 in respect of *cigarettes and tobacco for making cigarettes*; and
  - (b) Community Trade Mark 1982156 dated 4 December 2000 in class 34 in respect of *tobacco, whether manufactured or unmanufactured, substances for smoking sold separately or blended with tobacco, none being for medicinal or curative purposes.*
5. There is no dispute that the registered mark in issue and the earlier registrations are registered for identical goods.
6. The Proprietor challenged JT's ability to rely on either of its DORCHESTER registrations on the grounds that it had not demonstrated genuine use of those registrations within the meaning of s47 of the Act. However, the Hearing Officer did not consider that it was necessary to make a finding on this point.

### **The Hearing Officer's Decision**

7. The Hearing Officer took a familiar, structured approach to considering the likelihood of confusion between DORCHESTER and ROCHESTER when used in relation to cigarettes.

8. He concluded that there was a 'reasonably high' level of visual similarity, and a 'medium' level of aural similarity. Neither party before me disputed this analysis. However, there is a significant challenge to the Hearing Officer's findings on conceptual similarity. It is therefore worth quoting paragraph 24 of the Decision in full.

*24) Conceptually the applicant submits that the respective marks are highly similar because they both consist of place names located in the south of England. I dismiss this approach. If the applicant's line of reasoning is followed then all town names would be conceptually similar. In the same way that two marks are not similar merely because they consist of personal names, marks are not conceptually similar merely because they are place names. The respective marks indicate different towns and I conclude that there is no conceptual similarity.*

9. The Hearing Officer went on to make some findings about the average consumer and the normal process of purchasing cigarettes. On the latter he noted that the process of purchase was controlled in that the goods must by law be hidden from view and be requested by name from the shop assistant. That meant that aural considerations were of particular importance, but he could not ignore visual considerations because the brand would become visible at the point of purchase. These findings were not the subject of any challenge.
10. The mark was found to have a 'medium level' of distinctive character, which had been enhanced by use. The Respondent challenged this finding on the basis that the evidence relied on by the Hearing Officer was inadequate. However, since the Hearing Officer concluded that the enhancement was '*not to any significant extent*', it would appear that the Decision was not influenced by this finding and I therefore do not propose to deal with it further.

11. Having set out the usual array of factors to be taken into account in assessing likelihood of confusion, and reminded himself of the doctrines of imperfect recollection and interdependence, the Hearing Officer went on at ¶34 of his Decision as follows:

*'The proprietor submits that the parties' marks are just two of a number of cigarette brands on the market consisting of place names that include CHESTER either as a suffix or prefix and it provides evidence of some of these. It further submits that the average consumer is familiar with the separate geographical place names, CHESTER is a common element of place names in the UK and the average consumer is experienced at distinguishing between these. In addition, the proprietor submits that the existence of other cigarette brands on the UK market such as CHESTERFIELD and MANCHESTER illustrates that the consumer can differentiate marks based upon place names without confusing them. Further, I keep in mind that the attention of the consumer is usually directed to the beginning of the word (see the judgment of the GC in El Corte Ingles, SA v OHIM, Cases T-183/02 and T-184/02, paragraph 83)'*

12. This is a slightly unfortunate paragraph in a number of respects:
- (a) It recites the submissions of the proprietor, including (twice) referring to the presence of other 'CHESTER' brands on the UK cigarette market, but fails to note that there was a serious dispute as to the adequacy and probative value of the evidence about those brands.
  - (b) It fails to make any actual findings of fact about the presence (and in particular the strength of reputation) of the other CHESTER brands on the UK cigarette market.
  - (c) The last sentence starting '*Further, I keep in mind that...*' recites a proposition which the Hearing Officer is plainly taking into

account. The phraseology adopted here might be taken to suggest (by the use of the word 'Further') that the Hearing Officer had accepted the propositions set out in the earlier part of the paragraph, even though he had not said so. Such ambiguities should be avoided.

13. The Hearing Officer then sets out his conclusion in summary at ¶35:

*'Taking all of the above into account, whilst I acknowledge that conceptual differences do not always overcome visual and aural similarities (see Nokia Oyj v OHIM, Case T-460/07), in this case I am in agreement with the proprietor. The respective marks are the names of different towns and because the consumer is experienced at differentiating between places by their names, this will result in the consumer being alert to the conceptual differences between the marks. This, together with the aural and visual differences in the marks that I have identified earlier, is sufficient to offset the effect of imperfect recollection, the similarities between the marks and the fact that the goods are identical.'*

### **Preliminary issue about the basis of the Decision**

14. Counsel for JT, Mr Hollingsworth, submitted that it appears from ¶35 quoted above that the Hearing Officer had accepted the submission about the CHESTERFIELD and MANCHESTER brands which he had recorded in ¶34. He submitted that this undermined and vitiated the Decision because in fact it had not been established on the evidence that either brand had a material presence on the market at the relevant date.
15. I have reviewed the evidence. So far as CHESTERFIELD is concerned, this showed that it was an international brand launched in 2011 by Philip Morris, one of the biggest cigarette companies in the world. By

2013 CHESTERFIELD turnover was 34 billion units worldwide. The evidence as to its turnover in the UK was not particularly clear – it was plainly launched here in 2011 but this seems to have been initially through pubs and clubs rather than in retail stores. The only evidence it being sold in major supermarkets in the UK dated from 2015. However, on balance, I would consider that there would have been enough here to justify a finding that CHESTERFIELD had a market presence in the UK at the relevant date of May 2013.

16. The position in relation to MANCHESTER however is quite different. The evidence was limited to a website page from 2006 claiming that MANCHESTER cigarettes were produced (it is entirely unclear by whom) in Russia and England, and an article from 2015 noting the existence of an illegal cigarette called MANCHESTER on sale in Australia. This plainly did not establish in any way that MANCHESTER had any significant presence on the UK market in 2013.
17. In the light of this, any reliance by the Hearing Officer on the presence of MANCHESTER cigarettes on the UK market on the question of likelihood of confusion would have been a material error.
18. However, having carefully considered paragraphs 34 and 35, I do not believe that he was in fact placing any reliance on this point. Whilst he recorded the submission based on MANCHESTER (and CHESTERFIELD) cigarettes in ¶34, it is notable that his reasoning in ¶35 does not in fact incorporate any reliance on the existence of the MANCHESTER and CHESTERFIELD brands. Rather it relies on the general proposition (which the Hearing Officer had correctly identified as a separate point in ¶34) that consumers are experienced at differentiating between places by their names. Nor do I take his use of the word 'Further' at the end of ¶34 to be indicating that he necessarily accepted all the submissions which he had recorded

earlier in that paragraph (although I do consider that the wording of that paragraph is unfortunate).

19. I therefore reject Mr Hollingsworth's submission, whilst recognizing that it was an understandable one in the circumstances. It would plainly have been better for the Hearing Officer to have resolved the dispute on the evidence and to have made clear that he was not taking at least the MANCHESTER evidence into account.

### **The Appellate Function**

20. In opening this Appeal, Mr Guy Hollingsworth, referred me to a recent decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person in ALDI GmbH v Sig Trading O-169-16. This was a successful Appeal against a finding of the Hearing Officer that two marks (the word mark ALDI and the stylized mark ALTI) were not sufficiently similar to be likely to cause confusion.
21. In the course of his Decision, Mr Hobbs QC cited the Speech of Lord Neuberger PSC in Re B (a child) (Care Order Proceedings) [2013] UKSC 33 in particular at [93] and [94]. Here, Lord Neuberger was considering the circumstances in which an appeal court could overturn a care order made against the wishes of the natural parents on the grounds that it did not comply with Article 8 of the European Convention for the Protection of Human Rights and Fundamental Freedoms 1950, because it was not a proportionate interference with the right to respect for family life. This ultimate question is referred to in the judgments of the Supreme Court as the 'proportionality' question.
22. An issue which concerned all the Judges in that case was how to express the circumstances in which it was appropriate for an Appellate Court to overturn a decision of a lower Court on the

proportionality question (which required the evaluation of a number of different factors, many of which were difficult to assess) in circumstances where the lower Court had not made an error of law or fact. It is well established that mere disagreement with the end-result is not sufficient. Something more is required. Lord Neuberger approached the question by identifying 7 different theoretical levels of agreement/disagreement which an Appellate Court might have with the decision of the tribunal below, and explained by reference to these categories whether an appeal could be allowed. The first 4 of these were said to be categories where an appeal must be dismissed. The second 3 were categories where the appeal must be allowed.

23. Of significance are his categories (iv) and (v). Category (iv) is a case where the trial judge's conclusion is '*a view which she [the Appellate Tribunal] cannot say was right or wrong*'. There, the appeal must be dismissed. Category (v) is a case where the trial judge's conclusion is '*a view on which she has doubts but on balance considers was wrong*'. There, the appeal must be allowed. Lord Neuberger went on in ¶94 to discuss these two categories further. In particular he noted in relation to category (iv):

*'As to category (iv), there will be a number of cases where an appellate court may think that there is no right answer, in the sense that reasonable judges could differ in their conclusions. As with many evaluative assessment, cases raising an issue on proportionality will include those where the answer is in a grey area, as well as those where the answer is in a black or a white area.'*

24. In ALDI, Mr Hobbs QC noted that these observations formed part of an examination of the principles and parameters of appellate review in civil proceedings in the course of which Lord Neuberger had considered the guidance provided by numerous earlier cases, including those cases most commonly cited on the Appellate role in

appeals from the Trade Marks Registry, namely Bessant v South Cone Inc ('REEF') [2002] EWCA Civ 763 and EI Du Pont de Nemours & Co. v ST Dupont (DUPONT) [2003] EWCA Civ 1368. He went on to say:

*'The approach to appellate review envisaged by the paragraphs I have quoted appears to me to be of general application. I think it is appropriate to apply it in the context of the present appeal.'*

25. Mr Hollingsworth made two points based on Re B.
26. The first was that Mr Hobbs was right to say that Lord Neuberger's 7 category approach was of general application, and that I should therefore treat it as having superseded previous statements of the Appellate role in trade mark appeals, in particular the guidance given in REEF. I do not accept that this is the case, for at least 2 reasons.
27. First, as I read Lord Neuberger's categorization, it was not intended to be applied generally. Indeed, at ¶96 he noted that it was not necessary to decide whether what he had said in ¶¶85-90 (the analysis which led to his analysis at 93-4) was appropriate to *'any appeal concerning an evaluation even where no Convention right is involved'*. He also noted that *'it was not a topic on which we had any argument, as the submissions were limited to the proper approach on an appeal on proportionality, or necessity, under the convention, and I say no more about it'*. Second, Lord Neuberger (together with other SC Judges in that case) specifically approved REEF. I perfectly agree that some Judges may find Lord Neuberger's categorisations a useful way to approach appeals on evaluative questions, but they are certainly not a compulsory approach.
28. The second point made by Mr Hollingsworth was that Lord Neuberger and a number of the other Supreme Court Judges in Re B had criticised the application of words like 'plainly' or 'clearly' to the word 'wrong'

to characterize the circumstances in which an Appellate tribunal should overturn a judgment. Mr Hollingsworth had in mind the oft-used formulation on Appeals from the Trade Marks Registry on evaluative questions such as ‘likelihood of confusion’ (adopting wording used by the Court of Appeal in REEF) that they will only be allowed where there has been a *‘distinct and material error of principle’* or where the Decision was *‘plainly wrong’*. He submitted that the word ‘plainly’ should not be used in future to characterize the test being applied, and that Appellate tribunals should content themselves with the word ‘wrong’.

29. It is true that a number of the SC Judges in Re B noted that there was no obvious mandate for such qualifying adverbs under the Civil Procedure Rules which define the jurisdiction of Appellate Courts (and are applied by analogy to the jurisdiction of the Appointed Persons). CPR 52.11(3) simply provides that the Appellate Court will allow an appeal where the decision of the lower Court was *‘wrong’*, not *‘plainly wrong’*. However, once again, the Supreme Court did not take the opportunity to overrule the numerous decisions of Courts up to the highest level in which similar formulations had been adopted to define the appropriateness of appellate intervention in particular types of case outside the question of proportionality under the Convention. I have already noted that Lord Neuberger shied away from making a general pronouncement on the approach to appeals. Similarly, both Lord Kerr at ¶110 (referring to *‘in this sphere’*) and Lord Clarke at ¶139 (*‘in the context of care orders’*) specifically limited their comments about the word ‘wrong’ to the context of the dispute before the Supreme Court in that case. Lord Clarke also said this at ¶137:

*“The rule does not require that the decision be “plainly wrong”. However, the courts have traditionally required that the appeal court must hold that the judge was plainly wrong before it can interfere with his or her decision in a number of different classes of case. I referred to some of*

*them in Assicurazioni Generali SpA v Arab Insurance Group [2003] 1 WLR 577, to which Lord Neuberger refers at para 57, at my paras 9 to 23. It seemed to me then and it seems to me now that the correct approach of an appellate court in a particular case may depend upon all the circumstances of that case. So, for example, it has traditionally been held that, absent an error of principle, the Court of Appeal will not interfere with the exercise of a discretion unless the judge was plainly wrong. On the other hand, where the process involves a consideration of a number of different factors, all will depend on the circumstances. As Hoffmann LJ put it in In re Grayan Building Services Ltd [1995] Ch 241 at 254,*

*“generally speaking, the vaguer the standard and the greater the number of factors which the court has to weigh up in deciding whether or not the standards have been met, the more reluctant an appellate court will be to interfere with the trial judge's decision.”*

30. It may also be noted that in Datec [2007] 1 WLR 1325 Lord Mance had approved the judgment of Clarke LJ (as he then was) in the Assicurazioni case cited above, in particular the following passage:

*16. Some conclusions of fact are, however, not conclusions of primary fact of the kind to which I have just referred. They involve an assessment of a number of different factors which have to be weighed against each other. This is sometimes called an evaluation of the facts and is often a matter of degree upon which different judges can legitimately differ. Such cases may be closely analogous to the exercise of a discretion and, in my opinion, appellate courts should approach them in a similar way.’*

31. I therefore believe that the phrases ‘plainly wrong’ or ‘clearly wrong’ are still legitimate phrases to use when considering whether to overturn a decision on an evaluative issue which is as indeterminate and open to debate as the question of likelihood of confusion. REEF is a

good example of the utility of such phrases. The Court of Appeal in that case plainly considered that they would (left to themselves) have reached a different decision on the issue of likelihood of confusion from the decision reached by the Hearing Officer. Nonetheless, they restored his decision because it could not be said to have been '*clearly wrong*' [paragraph 40]. As I have said, REEF was cited with approval by the Supreme Court in Re B.

32. The phrase '*clearly wrong*' was being used by Robert Walker LJ in REEF as a shorthand for the principles which he had explained earlier in his Judgment – namely that in the absence of a distinct and material error of principle, an Appeal Court should show a real reluctance to overturn a decision on an evaluative issue such as likelihood of confusion by an experienced Hearing Officer, even if (like the Judge at the original appeal in that case) it disagreed with the result. For completeness, I should add that the phrase '*plainly wrong*' was used by the Judge below (Pumfrey J) for precisely the same purpose (as is apparent from ¶21 of the Judgment of Robert Walker LJ). Both remain useful phrases provided that this is borne in mind. I respectfully agree with Daniel Alexander QC's explanation in Talk for Writing O-017-17, that:

*"plainly" is not to be taken as a term denoting a higher degree of wrongness but a degree of confidence that the Appointed Person should have that there is a genuine error rather than simply an evaluation which he or she would not have made'*

33. I fear that far too much ink has been already spilled by Appellate Courts on these issues with diminishing returns, and I therefore do not propose to say a great deal more. So far as the particular context of this appeal is concerned, I would simply add that the reluctance of the Appointed Person to interfere with a decision of a Hearing Officer on likelihood of confusion is quite high for at least the following reasons:

- (i) The decision involves the consideration of a large number of factors, whose relative weight is not laid down by law but is a matter of judgment for the tribunal on the particular facts of each case
- (ii) The legal test 'likely to cause confusion amongst the average consumer' is inherently imprecise, not least because the average consumer is not a real person
- (iii) The Hearing Officer is an experienced and well-trained tribunal, who deals with far more cases on a day-to-day basis than the Appellate tribunal
- (iv) The legal test involves a prediction as to how the public might react to the presence of two trade marks in ordinary use in trade. Any wise person who has practised in this field will have come to recognize that it is often very difficult to make such a prediction with confidence. Jacob J (as he then was) made this point in the passing off case Neutrogena v Golden [1996] RPC 473 at 482:

*'It was certainly my experience in practice that my own view as to the likelihood of deception was not always reliable. As I grew more experienced I said more and more "it depends on the evidence."*

Any sensible Appellate tribunal will therefore apply a healthy degree of self-doubt to its own opinion on the result of the legal test in any particular case.

34. I shall therefore approach this appeal on the basis that in the absence of a distinct and material error of principle, I ought not to interfere

with the decision of the Hearing Officer unless I consider that his view on the issue of likelihood of confusion was clearly wrong in the sense that it was outside the range of views which could have been reasonably taken on the established facts.

**Place names and conceptual similarity**

35. Mr Hollingsworth's main point on this appeal was that the Hearing Officer erred in concluding that there was no conceptual similarity between the marks. In his skeleton argument he suggested that there were two possibilities in terms of the reaction of the average consumer to the marks:
- (a) The public would recognize both names as place names, but have no particular idea about the nature of either place, such that '*a conceptual comparison is not warranted*'.
  - (b) The public would recognize both places as medium-sized historic towns, possibly knowing that they are each in the south of England, and that both had their origins in a Roman military base (derived from their understanding of the derivation of the suffix 'CHESTER' from the Latin 'castrum'). In that case, there would be a degree of conceptual similarity between the marks.
36. In his oral submissions he recognised that the degree of geographical and historical understanding of the towns of England of the average consumer was probably rather more limited than approach (b) above would require. He tended to accept the proposition that the average consumer would be aware that ROCHESTER and DORCHESTER were towns somewhere in England (possibly in Southern England), but probably have no real knowledge beyond that.

37. In the present case, I agree with Mr Hollingsworth that there is no reason to assume a great deal of geographical or historical knowledge on the part of the average consumer. Any individual consumer may have some particular knowledge of either or both towns, as a result of his individual background or education. Some might know of the literary connotations of the towns, associating them with Dickens or Thomas Hardy. Others might know that Rochester is an ancient port, and Dorchester a market town. Some may know that Rochester is in Kent and Dorchester is in Dorset. Those who had actually lived in or near the towns would of course know a great deal more about them. However, the average consumer tends towards the lowest common denominator and therefore I believe that it is fair to assume simply that he/she would know of the existence of each town, and probably that it was somewhere in Southern England.
38. Before turning to the particular issue in this case, it may be useful to consider the relevance of conceptual similarities and differences in more general terms. The case law of the European Union has recognised the self-evident proposition that where marks evoke particular, different concepts, this tends to counteract any visual or aural similarities between them and reduce the likelihood of confusion. This may be the case even where only one of the marks conveys a particular concept, and the other is concept-free. The CJEU in Ruiz-Picasso v OHIM [C-361/04] put it as follows:

*'55 From the conceptual point of view, the word sign PICASSO is particularly well known to the relevant public as being the name of the famous painter Pablo Picasso. The word sign PICARO may be understood by Spanish-speaking persons as referring inter alia to a character in Spanish literature, whereas it has no semantic content for the (majority) non-Spanish-speaking section of the relevant public. The signs are not thus similar from the conceptual point of view.*

*56 Such conceptual differences can in certain circumstances counteract the visual and phonetic similarities between the signs concerned. For there to be such a counteraction, at least one of the signs at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately [Case T-292/01 Phillips-Van Heusen v OHIM - Pash Textilvertrieb und Einzelhandel (BASS) [2003] ECR II-4335, paragraph 54].*

*57 The word sign PICASSO has a clear and specific semantic content for the relevant public. Contrary to the applicants' submissions, the relevance of the meaning of the sign for the purposes of assessing the likelihood of confusion is not affected in the present case by the fact that that meaning has no connection with the goods concerned. The reputation of the painter Pablo Picasso is such that it is not plausible to consider, in the absence of specific evidence to the contrary, that the sign PICASSO as a mark for motor vehicles may, in the perception of the average consumer, override the name of the painter so that that consumer, confronted with the sign PICASSO in the context of the goods concerned, will henceforth disregard the meaning of the sign as the name of the painter and perceive it principally as a mark, among other marks, of motor vehicles.'*

39. The interesting point here is that the absence of a particular concept is said to 'counteract' confusion, by making the marks easier to distinguish. So lack of conceptual similarity is not merely a 'neutral' factor. That is the case even where one of the two marks has no particular meaning at all to the average consumer.
40. The argument works as follows. Taking the Ruiz-Picasso case as an example, the word PICASSO is inextricably linked in the mind of the average consumer with the famous painter. When they see the mark, even when used on a car, they cannot help but think of the painter. For any individual consumer, the idea of PICASSO conjured up in their

mind's eye will no doubt be different – Guernica, a cubist painting or an image of the man himself – but it will be clear and specific. When they see the mark PICARO on a different car, any risk of confusion which would otherwise exist between the marks based purely on their verbal similarity is overcome by the absence of the image. So if the earlier mark had been PICANNO, the case for confusing similarity would have been stronger.

41. It should of course be remembered that conceptual similarity between marks may increase the likelihood of confusion – marks which might otherwise be considered not visually or aurally very similar may be confused because they convey the same concept. An average consumer may not recollect the precise wording or image of a mark but may still recall the concept which it conveyed. This was the point made by the CJEU in Sabel v Puma C-251/95, although it should be noted that they stressed the importance of considering the level of distinctiveness of the earlier mark when making this assessment:

*'24 In that perspective, the more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either per se or because of the reputation it enjoys with the public.*

*25 However, in circumstances such as those in point in the main proceedings, where the earlier mark is not especially well known to the public and consists of an image with little imaginative content, the mere fact that the two marks are conceptually similar is not sufficient to give rise to a likelihood of confusion.'*

42. Before considering the impact of 'concept' on the likelihood of confusion, one first has to decide what concept if any each sign conveys to the average consumer. Here one must be careful about levels of generality. We are concerned not with theoretical abstractions but how the sign would actually strike the average consumer in real life. Taking Sabel v Puma, the concept conveyed by the Claimant's mark was said by the Court to be a 'bounding feline'. It would not have been right to characterize the concept in that case simply as a 'cat', because that abstraction does not capture the essence of the sign as the average consumer would see it.
43. In the present case, at a high level of generality, each mark could theoretically be said to convey the same concept – a town, or perhaps a town in Southern England. However, I do not believe that this is a reasonable way to understand the way in which the individual marks would strike the average consumer. The concept of JT's mark is the town of Dorchester, not any old town in Southern England. It is clear and specific. The concept of the Proprietor's mark is the town of Rochester. Once again, that is clear and specific and is a different concept from Dorchester. The conceptual difference will tend to reduce any risk of confusion. It is not necessary to establish any particular knowledge on the part of the average consumer about either town – no doubt each would give rise to different associations to different people. The point is that the concepts are specific and different because the towns are specific and different.
44. I should add that the mere fact that two towns which have been adopted as trade marks have a common geographical feature does not, in my view, increase the likelihood of direct confusion between them. I can just about imagine cases where a common feature of this kind might be said to increase the likelihood of 'indirect confusion', where the public recognize that the marks are different but assume from their common features that there must be an economic link between

them. This would be more likely if the earlier mark was known to be part of a distinctive 'family' of registered marks, the feature in question being the common link between the marks in the family. However, Mr Hollingsworth rightly disclaimed any reliance on 'indirect confusion' in the present case.

45. I therefore reject Mr Hollingsworth's principal submission that the Hearing Officer should have held that either (i) that the marks in this case were neither conceptually similar nor conceptually different; or (ii) that the marks were conceptually similar. In my view he was correct to hold that the marks were conceptually different because each specifically and clearly conveys the concept of a different town.

#### **Conclusions on this Appeal**

46. In the light of those remarks, I turn to the decision of the Hearing Officer. From the extract I have quoted above it is apparent that he considered that the conceptual differences between the marks were sufficient to outweigh what he had considered to be the 'reasonably high' and 'medium' levels of visual and aural similarity between them. JT's mark would be recognised as conveying the town of Rochester, and the Proprietor's mark would be recognised as conveying the town of Dorchester. The public would be clear that these were different towns and were well used to distinguishing between different towns by their names. The ordinary consumer, using reasonable care would not mistakenly buy a train ticket to Dorchester if he meant to go to Rochester, so there is no particular reason to believe that he or she would buy Dorchester cigarettes mistaking them for Rochester cigarettes.
47. I do not believe that the Hearing Officer made any error of principle in coming to this Decision. It is, as I have noted above, well-established that conceptual differences can create clear distinctions between

marks even where there are visual or aural similarities between them. This is even the case where one of the marks conveys no particular concept at all. *A fortiori* where the marks convey different concepts which the average consumer is well-used to distinguishing.

48. Nor do I consider that the decision of the Hearing Officer on this multi-factorial, evaluative question was outside the range of reasonable decisions which could have been made.
49. That is sufficient to dispose of this appeal. However, for the avoidance of doubt I will say that I believe I would have reached the same decision on the evidence. My reasoning would have been along the following lines:
  - (i) JT's mark is not particularly inherently distinctive: the adoption of names of towns as trade marks is commonplace and familiar to the average consumer, including in the field of cigarettes.
  - (ii) The public would recognize the suffix 'Chester' as a very common element of town names, and therefore the least distinctive element of the mark. The initial syllable of the mark is therefore much more important to the average consumer in the present case.
  - (iii) The similarities between 'ROCH' and 'DOR' are so low that the relevant visual and aural similarities between mark and sign can be considered to be low.
  - (iv) The marks convey different concepts – one the town of Rochester and the other the town of Dorchester.

(v) On a global assessment, therefore, there is no real likelihood of the average consumer exercising ordinary care being confused.

50. I therefore reject the Appeal in this case. In the circumstances it is not necessary for me to deal with the Respondent's Notice.

51. I shall award a sum of £1,000 to the Respondent towards the costs of the oral hearing before me and the preparation of the skeleton argument.

**IAIN PURVIS QC**  
**The Appointed Person**

**1 February 2017**