

O-074-05

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2332227
BY GEC S.R.L. TO REGISTER A
TRADE MARK IN CLASSES 18 AND 25**

AND

**IN THE MATTER OF OPPOSITION
THERE TO UNDER NO. 92096 BY PRINGLE OF SCOTLAND LIMITED**

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**IN THE MATTER OF Application No. 2332227
by GEC S.R.L. to register a
trade mark in Classes 18 & 25**

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**IN THE MATTER OF Opposition thereto
under No. 92096 by Pringle of Scotland Limited**

BACKGROUND

1. On 15 May 2003, GEC S.R.L., of Italy, applied to register the trade mark shown below for the following goods in Classes 18 and 25:

Class 18: Leather and imitations of leather, trunks, bags, suitcases, briefcases, key-rings, purses, travelling bags, handbags, umbrellas, wallets, beauty-cases.

Class 25: Clothing for men and women, belts, ties, gloves, hats, footwear for men and women.

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2. The application was accepted and published for opposition purposes.

3. On 6 November 2003, Cruikshank & Fairweather acting as agents for Pringle of Scotland Limited filed a notice of opposition. The grounds of opposition are, in summary:

That the Opponent is the owner of the following earlier trade marks:

Community Trade Mark No: 1807486 for the following mark:



Registered in respect of:

Class 18: Goods made of leather and leather imitations; luggage; trunks and travelling bags; purses; cosmetic bags; wallets; hip flasks; credit card holders; key cases; suitcases; briefcases; coin purses; bags; handbags; duffle bags; sports bags; flight bags; holdalls; shoe bags; umbrellas; umbrella covers; parasols; walking sticks; whips; harness and saddlery; skins and hides; golf shoebags.

Class 25: Articles of clothing, footwear and headgear.

Class 28: Sporting articles; games and playthings; golf gloves; gloves for use in sport and games; golf bags; golf bag covers; golf travel bags; golf club head covers; golf accessories; golf clubs; golf balls; raquets; sporting goods included in class 28 and not included in other classes.

United Kingdom Trade Mark No. 2038357 for the following mark:



Registered in respect of:

Class 25: Articles of clothing, none being footwear; headgear.

United Kingdom Trade Mark No: 1180509 for the following mark:



Registered in respect of:

Class 25: Knitted articles of clothing and articles of clothing made from knitted materials; but not including footwear.

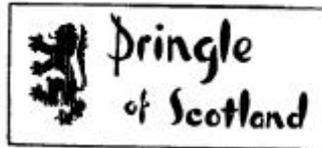
Community Trade Mark No. 1476183 for the following mark:



Registered in respect of:

Class 25: Articles of clothing, footwear and headgear; all included in class 25.

United Kingdom Trade Mark No: 771999 for the following mark:



Registered in respect of:

Class 25: Vests, pants, body belts, pullovers and cardigans, all for men; and combinations, vests, knicker body belts, pullovers, cardigans, boleros and scarves, all for women, all the aforesaid goods being knitted articles of clothing.

The Opponent frames their objections to the application in the following terms:

“3. The Opponent has used the device of a lion rampant as a Trade Mark either on its own or in combination with its other Trade Marks such as, for example PRINGLE OF SCOTLAND since early in the 20th century in relation to the conduct of its clothing business in relation to a wide range of clothing products, including particularly high quality knitwear and associated clothing accessories including leather goods, bags, handbags and the like. Virtually all products made and sold by the Opponent bear the Opponent’s distinctive lion rampant Trade Mark in a prominent position. Furthermore the Opponent has been actively involved in amateur and professional golfing sponsorship including the sponsorship of several internationally renowned golfers who all wore the Opponent’s clothing which included the lion rampant device Trade Mark prominently displayed. As a consequence of the use made by the Opponent of its lion rampant Trade Mark either solus or in combination with its other distinctive Trade Marks such as PRINGLE and PRINGLE OF SCOTLAND, the Opponent enjoys a substantial goodwill and reputation in its lion rampant Trade Mark in relation to clothing in International Class 25 including clothing accessories and hand luggage in Class 18. The Opponent has also made significant use of its lion rampant Trade Mark in relation to sporting articles, in particular sporting articles associated with the game of golf such as for example golf gloves, golf bags, golf travel bags, golf club head covers, golfing accessories, and other sporting articles in Class 28. The adoption by the Applicant of a Trade Mark which includes, in a prominent manner, the device of a lion rampant that is substantially similar to the Opponent’s well known lion rampant Trade Mark would constitute a misrepresentation and cause confusion with the Opponent’s established Trade Mark rights in a lion rampant device and will undoubtedly cause damage to the Opponent’s reputation. Use of the Trade Mark applied for by virtue of its inclusion, in a prominent manner, of the device of a lion rampant is liable to be prevented by the virtue of the law

of passing off in relation to the rights subsisting in the Opponent's distinctive lion rampant device Trade Mark."

Stemming from the above, objection is said to arise under sections 5(2)(b), 5(3) and 5(4)(a) of the Act.

4. On 25 February 2004, Urquhart Dykes & Lord acting as agents for the Applicant filed a counterstatement, in which they comment, inter alia, as follows:

"3. The Applicant denies the allegations made in point 3 of the Grounds of Opposition and deny that the Opponent has any reputation or goodwill in the mark. If any reputation or goodwill can be shown, the Applicant denies that this is sufficient to rely on the provisions of Section 5(4) of the Act.The Applicant is aware of a number of other UK trade mark registrations in the names of different proprietors which covers the goods relevant to these proceedings and which include lion rampant devices. Examples of some of the marks which include the device solus are attached.

According to Jacob J in *Origins Natural Resources Inc v Origin Clothing Limited* [1995] FSR 280, "Section 10 of the Trade Marks Act 1994 presupposes that the plaintiff's mark is in use or will come into use. It requires the court to assume the mark of the plaintiff is used in a normal and fair manner in relation to the goods for which it is registered". As such, it cannot be possible for any one entity to claim exclusive rights in the device of a rampant lion in relation to goods relevant to these proceedings.

4. The Applicant denies the allegations made in point 4 of the Grounds of Opposition. The Applicant denies any similarity between the marks and as a result, the Applicant denies there is any likelihood of confusion on the part of the public, including the likelihood of association. The Applicant's mark includes the distinctive words "WILLIAMS WILSON" which is how the mark would be referred to orally. The Opponent's mark would be referred to as the Pringle device and as such the marks are readily distinguishable. Visually the totalities of the marks are also different. It cannot be denied that both marks include lion devices, however it was recognised in the case of *Sabel BV v Puma AG* (C251/95) that "the mere fact that the two marks were conceptually similar was not sufficient to give rise to a likelihood of confusion."

5. Section 5(3) of the Trade Marks Act 1994 requires that the marks are "to be registered for goods or services which are not similar". The Opponent has made no mention as to whether this is claimed and, if so, the goods which are considered dissimilar. In the absence of further particularisation, the Applicant denies the allegations made in point 5 of the Grounds of Opposition and request that it be struck from the proceedings."

5. Both sides filed evidence and both ask for an award of costs in their favour. The parties were invited to say whether they wished to be heard. Neither indicated a wish to do so. However, written submissions have been received on behalf of the Applicant from Urquhart Dykes & Lord (their letter of 12 January 2005). Acting on behalf of the Registrar I give this decision.

EVIDENCE

Opponent's Evidence

6. This consists of a statutory declaration dated 3 June 2004 by Campbell Newell. Mr Newell is a Trade Mark Attorney in the employ of Cruikshank and Fairweather, the Opponent's professional representatives in these proceedings. Mr Newell explains that his evidence comes from his own personal knowledge as a result of his dealings with the Opponent since March 2000 (when the Opponent acquired the Pringle business from the previous owners Dawson International Holdings (UK) Ltd) and also from information provided to him by the Opponent; he confirms that he is authorised to make his declaration on the Opponent's behalf.

The following information emerges from Mr Newell's declaration:

- that the Opponent and its predecessors in title have been using the device of a lion rampant for "many tens of years". He adds that it is not possible to state with any certainty when use first commenced, but it is believed to be in the early 20th or late 19th century; Mr Newell accepts that there is no evidence available to support this claim;
- that the Pringle business was founded by Robert Pringle in 1815 who traded under the name Robert Pringle & Son and that a device of a lion rampant was used in relation to the business. Exhibit CN1 consists of an extract from the "Heritage of Pringle of Scotland" which in turn refers to a publication entitled "The Early History of Robert Pringle & Son", the latter of which bears a device of a lion rampant;
- that the Pringle lion has been synonymous with the Pringle business and that the Pringle lion appears prominently on virtually all Pringle products either alone or in combination with the word Pringle. Exhibit CN2 consists of an extract showing what I take to be the front covers of the Pringle Bulletin/Annual from 1949 to 1971. I note that a number of the covers feature the device of a lion rampant;
- that Exhibit CN3 consists of extracts from Pringle brochures dating from the mid 1980s which show the Pringle range of clothing products and accessories bearing the Pringle lion rampant device. I note that in the examples provided, which appear to be solely in relation to items of clothing, the lion rampant device always appears with the word Pringle;
- that in March 2000 the Pringle of Scotland business was acquired by the Opponent and that since that time considerable expenditure and effort has been put into further development of the Pringle brand including the Pringle lion. Exhibit CN4 consists of an extract from the Scotsman newspaper dated 26 March 2003 in this regard entitled "Rebirth of a Brand";
- that since 2000, Pringle Products bearing the Pringle lion have been endorsed by celebrities such as Mr & Mrs David Beckham, Julia Roberts, Sophie Dhal and others. Exhibit CN5 consists of two apparently undated photographs of celebrities wearing Pringle clothing bearing the Pringle lion. Exhibits CN6, CN7 and CN8 consist of photographs of Pringle

products (principally items of clothing) some of which bear the Pringle lion from 2001, 2002 and 2003;

- in paragraph 8 of his declaration Mr Newell says:

“The Opponent is a privately owned company and has a policy of not making information regarding its financial position publicly available. I am authorised by the Opponent to state that it enjoys a multi-million pound turnover on products sold around the world and spends significant sums promoting, protecting and enforcing the PRINGLE Trade Mark and its distinctive Pringle Lion Trade Mark.”

- that the Opponent has become aware of counterfeit clothing bearing the Pringle lion and that a Magistrate’s Court in Spain has impounded counterfeit items bearing the Pringle lion – examples of which are provided at Exhibit CN9.

Applicant’s Evidence

7. This consists of a witness statement dated 27 August 2004 from Alison Jane Cole. Ms Cole is a Trade Mark Attorney in the employ of Urquhart Dykes & Lord, the Applicant’s professional representatives in these proceedings; she confirms that she is authorised to speak on the Applicant’s behalf.

In paragraph 2 of her witness statement Ms Cole comments:

“By virtue of their opposition to the above application, the Opponents are attempting to claim an exclusive monopoly over all devices featuring “rampant” lions in relation to the goods covered by their registrations and goods and services similar and dissimilar thereto. For the reasons given below, although not for these reasons alone, it is submitted that the Opponents are not entitled to such broad rights and that, in fact, their rights should be construed very narrowly.”

8. Ms Cole explains that a search of the United Kingdom and Community Trade Mark Registers in respect of marks which include devices of “rampant” lions has been conducted and the results of the search are provided at Exhibit AJC1. In relation to those marks which consist of a device of a lion “rampant” solus which are registered in respect of goods similar and identical to the goods the subject of the application for registration, Ms Cole notes that six of the nine marks identified in the counterstatement proceeded to registration without opposition being lodged.

9. Ms Cole adds that on 24 August 2004, she carried out a search using the Google Internet search engine “images” tool for all images containing “lion rampant”. Exhibit AJC3 is said to consist of the first three pages of results of this search. Ms Cole observes that the search identified 3390 hits and that although no limitation was made as to the goods or services covered by the search, Ms Cole comments that it should be noted that many relate to goods which would fall into the classes covered by the Opponent’s registrations.

10. Ms Cole concludes her statement in the following terms:

“As a result of the searches carried out, it is clear that the Opponents are not the only proprietors of registered trade marks which consist of a rampant lion device, nor are they the only provider of the goods in question bearing a rampant lion device.

It is also evident that there are many more marks in use and on the Trade Mark Register which include a rampant lion device. Turning specifically to the Applicants’ trade mark, it must be noted that the mark consists of a lion device *combined with* the words WILLIAMS WILSON. As such, the Applicants’ mark is further distinguished from the Opponents’ than those identified.”

11. That concludes my summary of the evidence filed in so far as I consider it necessary.

The Applicant’s written submissions

12. The Applicant’s submissions are contained in a letter from Urquhart Dykes & Lord dated 12 January 2005; I do not propose to summarise them here, but will refer to them as necessary in my decision. I do however note that the Applicant has only provided written submissions in relation to the grounds of objection based on sections 5(3) and 5(4)(a) of the Act; no mention is made of the ground based on section 5(2)(b) of the Act.

DECISION

13. The first ground of opposition is based on section 5(2)(b) of the Act. This reads:

“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.”

An earlier right 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) 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,”

All of the trade marks on which the Opponent’s rely are “earlier trade marks” as defined by Section 6(1) of the Act.

14. 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 Mayer & 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.

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*;

(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*.

Comparison of goods

15. The Applicant seeks registration for a range of goods in Classes 18 and 25, namely:

Class 18: Leather and imitations of leather, trunks, bags, suitcases, briefcases, key-rings, purses, travelling bags, handbags, umbrellas, wallets, beauty-cases.

Class 25: Clothing for men and women, belts, ties, gloves, hats, footwear for men and women.

The Opponent bases its opposition on five earlier registrations (see paragraph 3 above). Having reviewed the specifications of these registrations, I conclude that:

No. 1807486 – the application for registration is in respect of goods in Classes 18 and 25 which are identical to the goods in the Class 18 and 25 elements of the registration;

No. 2038357 – with the exception of footwear, the application for registration is in respect of goods in Class 25 which are identical to the goods in the registration;

No. 1180509 - with the exception of footwear, the application for registration contains goods in Class 25 which are identical or similar to the goods of the registration;

No. 1476183 – the application for registration is in respect of goods in Class 25 which are identical to the goods of the registration;

No. 771999 – the application for registration is in respect of goods in Class 25 which are identical or similar to the goods of the registration.

Comparison of marks

16. For the sake of convenience, the respective trade marks at issue in these proceedings are reproduced below:

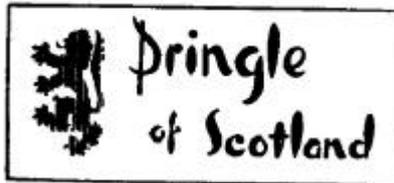
Opponent's trade marks:



Applicant's trade mark:

**WILLIAMS
WILSON**





17. The reputation of a trade mark is an important consideration when making a determination under Section 5(2) of the Act, as it may enhance the distinctive character of the earlier trade marks and in so doing widen the penumbra of protection. In their written submissions, the Applicant's comment (albeit in the context of the ground based on section 5(3) of the Act) as follows:

“The evidence submitted by the opponent does not provide any substantiated information about the length of use of the marks or the goods on which they have been used, the turnover or extent of the use, the market share attained, the geographic spread of the use or the amount spent on advertising or promoting the marks.....There is also no evidence from the trade or from the public verifying that they would recognise the lion device alone as their (sic) opponent's trade mark without the addition of the word PRINGLE.”

18. In my view many of the Applicant's criticisms of the Opponent's evidence are well founded. In my summary of the Opponent's evidence, I reproduced the comments of Mr Newell in which he explained that the Opponent was a privately owned company who does not make its financial information publicly available. Mr Newell's comment that the Opponent: "...enjoys a multi-million pound turnover on products sold around the world and spends significant sums promoting....." etc is extremely imprecise, and does not allow me to determine either the amount of turnover or promotional spend relevant to the United Kingdom or indeed the precise goods to which these statements apply. I note that in use (principally it would appear in relation to items of clothing), the lion device is primarily used together with the word PRINGLE. In the absence of more precise evidence, I am unable to conclude that any of the Opponent's earlier registrations have a reputation such that they may enjoy an enhanced penumbra of protection.

19. With these observations on the distinctive character of the Opponent's trade marks in mind, I now go on to compare the respective trade marks from the visual, oral/aural and conceptual standpoints.

20. In their written submissions, the Applicant comments on the respective marks (once again in the context of an objection based on section 5(3) of the Act) in the following terms:

"When comparing the marks and global appreciation of the visual, aural or conceptual similarity of the marks in question must be based on the overall impression given by the marks bearing in mind in particular the distinctive and dominant components.

In the case of the present opposition the mark under opposition is WILLIAMS WILSON & device. The earlier marks GB 771999 and CTM 1476183 both comprise the mark PRINGLE OF SCOTLAND with a lion device. In each case the lion device is different to that of the opposed mark and indeed it is not the same lion device in the two earlier marks. There are clear differences to the head, legs and tails of the two "Pringle" versions. UK registration No. 1180509 comprises a lion device together with the letter "P" and UK Registration No. 2038357 comprises a device of a lion holding a golf club. CTM Registration No. 1807486 comprises a lion device alone but again the lion device is different to that of the two UK Registrations. In each case the lion device is different to that of the opposed mark. In any event given the number of other "lion devices" co-existing in the register in different proprietor names, the device of a lion rampant *per se* cannot be considered as being particularly distinctive. The dominant and distinctive element of the present mark must be the words WILLIAMS WILSON and on this basis the earlier mark cannot be considered similar to any of the earlier marks belonging to the opponent."

21. Turning first to the visual comparison. The Opponent's trade marks all consist of a device of a lion rampant either alone, or in combination with other elements i.e. holding a device of a golf club, with the letter P, or with the words Pringle of Scotland, whereas the Applicant's mark consists of the words WILLIAMS WILSON below which is a device of a lion rampant. To the extent that the respective marks share a device of a lion rampant, there is a degree of visual similarity.

22. Whilst I accept that the Opponent's lion rampant devices may vary one to another and from the lion rampant device present in the application for registration, these differences may go unnoticed bearing in mind that one of the traits of the average consumer of the goods in question (who in the context of the goods at issue are the general public) is that they rely upon the imperfect picture of the marks they have kept in their mind.

23. More telling is the Applicant's comment regarding the distinctive and dominant components of the application for registration. In my view the words WILLIAMS WILSON are (as the Applicant suggests) the distinctive and dominant components of the application for registration; they appear as the first elements of the mark above the device of a lion rampant and are likely, in my view, to be the elements of the mark that will fix themselves in the mind of the average consumer when the mark is considered from a visual standpoint; the same would be true of the Opponent's registrations which contain the words Pringle of Scotland. In this regard, I note the comments of the Appointed Person in *React Trade Mark* [2000] RPC 285 when he said:

“The Hearing Officer was prepared of his own experience to hold that the initial selection of goods would be made by eye, and I believe this is correct. I must therefore, in taking into account the likelihood of aural confusion, bear in mind the fact that the primary use of the trade marks in the purchasing of clothes is a visual act.”

24. Although this comment was made in relation to the purchase of articles of clothing, I see nothing in the evidence, or indeed from my own experience, which suggests that the same would not be true for the goods in Class 18 of the application. With that in mind, I have concluded that while there is a degree of visual similarity between the respective marks, it is a low degree of similarity.

25. Turning now to the oral/aural comparison, I bear in mind the well established principle that words in marks speak louder than devices (see in this regard the comments of the Hearing Officer in *Oasis Stores Ltd's Application* [1998] RPC 631). While one can not rule out the possibility that the average consumer may remember and refer to the application for registration as the lion mark, it is, in my view, much more likely to be remembered and referred to as WILLIAMS WILSON. In so far as the Opponent's registrations are concerned, they are, in my view, likely to be referred to as either Pringle of Scotland (where these words appear in the marks), or the lion device where they do not. Consequently, I consider there to be the potential for oral/aural similarity, but once again I consider the degree similarity to be low.

26. Turning finally to the conceptual comparison. Both parties marks share the device of a lion rampant, either alone or with other elements. To that extent at least there is a degree of conceptual similarity but in my view the degree of similarity is not great.

27. In their evidence and written submissions, the Applicant points out that the device of a lion rampant either alone or with other elements is common place in a wide number of trade mark registrations standing in the names of different proprietors and which are registered for identical and similar goods to the application for registration (Exhibit AJC1 refers). In addition, at Exhibit AJC3, the Applicant provides the results of a Google Internet search which I presume has been

filed to show that the lion rampant device is not only the subject of a number of registrations but is actually in use for a wide range of goods.

28. In so far as the existing trade mark registrations are concerned, I would point to the comments of Jacob J (as he then was) in *British Sugar Plc v. James Robertson & Sons Ltd* [1996] RPC 281 when he said:

“In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the registrar to put the marks concerned on the register. It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, see *e.g.* [MADAME Trade Mark](#) [FN26] and the same must be true under the 1994 Act. I disregard the state of the register evidence.”

29. In so far as Exhibit AJC3 is concerned, which may have been filed to answer the concerns of Jacob J in *British Sugar* namely: “...does not tell you what is actually happening out in the market.”, I note that the search was conducted on 24 August 2004, some fifteen months after the material date in these proceedings; as such, it is of little assistance.

30. With those reservations on the Applicant’s state-of-the-register and Internet evidence in mind, the evidence provided does suggest that the device of a lion rampant is one that other traders may wish to use, particularly it would appear by those like the Opponent who may wish to indicate a Scottish connection for their goods. This is not surprising, given that the lion rampant is, as I understand it, a Scottish national emblem. As such, I conclude that the device of a lion rampant alone has a low distinctive character.

Likelihood of confusion

31. I have considered the Opponent’s marks and the application for registration from the visual, oral/aural and conceptual standpoints. In doing so, I have kept in mind that the device of a lion rampant alone is of low distinctive character, whilst remembering that the goods for which registration is sought in Classes 18 and 25 are identical or similar to the goods contained in a number of the Opponent’s registrations. I have also considered the interdependency principle i.e. that a lesser degree of similarity between marks may be offset by a greater degree of similarity between goods, and vice versa, whilst bearing in mind the characteristics of the average consumer of the goods in question (who in this case are the general public) and who are deemed to be reasonably well informed, circumspect and observant, but who rarely have the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their mind.

32. Having done so, I have concluded that although the application for registration and the Opponent’s marks (which do not also include the words Pringle of Scotland – which are a further distinguishing feature) share a device of a lion rampant, that the device of a lion rampant alone has a low distinctive character and that there is a low degree of visual, oral/aural and conceptual similarity. In my view the words WILLIAMS WILSON are the distinctive and dominant components of the application for registration and are the elements which are likely to fix

themselves in the mind of the average consumer and by which the application is likely to be remembered and referred to. As a consequence of these conclusions, and applying the global test advocated, I have concluded that there is no likelihood of confusion and the opposition based on Section 5(2)(b) of the Act is dismissed.

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

33. In order to qualify for consideration under section 5(3) of the Act, the Opponent is required to demonstrate that they have a reputation in their trade marks in the United Kingdom; in this regard, see the guidance provided by the Court of Justice in *General Motors Corporation v Yplon SA* [2000] RPC 572. Similarly, under Section 5(4)(a), I bear in mind the comments of Pumfrey J in *South Cone Inc. v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19, namely:

"There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s 11 of the 1938 Act (see *Smith Hayden (OVAX)* (1946) 63 RPC 97 as qualified by *BALI* [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date."

34. As I mentioned in paragraph 18 above, the evidence provided by the Opponent was too imprecise for me to determine whether the marks on which they rely in these proceedings were deserving of an enhanced degree of protection. For the same reasons, the evidence is too imprecise for me to discern whether the Opponent enjoys a reputation in its marks (for the purposes of section 5(3) of the Act), or enjoys a goodwill in the marks sufficient to satisfy the first of the three elements of the test for passing off. That said, given my decision on the lack of similarity between the respective marks, my comments in this regard are largely academic. The objections based on sections 5(3) and 5(4)(a) of the Act are dismissed.

COSTS

35. The opposition has failed and the Applicant is entitled to a contribution towards his costs. I order the Opponent to pay to the Applicant the sum of £1000. This sum 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 22nd day of March 2005

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