

O-098-05

**TRADE MARKS ACT 1994
AND
THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996**

**IN THE MATTER OF INTERNATIONAL REGISTRATION NO. 805288
AND THE REQUEST BY CANNA B.V.
TO PROTECT A TRADE MARK IN CLASSES 1, 16 AND 25**

Background

1. On 4 June 2003 Canna BV of Tuinbouwlaan 9, NL-4817 LE Breda, Netherlands, on the basis of International Registration No 805288 requested protection in the United Kingdom, under the provisions of the Madrid Protocol, of the trade mark:



2. The application was made in respect of the following goods:

Class 01:

Chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry; manures.

Class 16:

Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; office requisites (except furniture); plastic materials for packaging (not included in other classes; printers' type; printing blocks.

Class 25:

Clothing, footwear, headgear.

3. It was considered that the request failed to satisfy the requirements for registration in accordance with Article 3 of the Trade Marks (International Registration) Order 1996 and Notice of Refusal under Article 9(3) was given because the mark is excluded from registration by Section 5(2) of the Trade Marks Act 1994. Initially this was because of three registered marks, but one of these was subsequently waived. The remaining two earlier marks are:

Number	Mark	Specification
1451672		Shirts, shorts, trousers, jackets, headwear and gloves; all included in Class 25.
2020699	GORILLA WEAR	Shirts, T-shirts, shorts, trousers, jackets, hats, socks, gloves and footwear.

4. A hearing was held on 17 March 2004 at which the applicant was represented by Mr Law of Marshall Law, their trade mark attorneys. At the hearing the objection under Section 5(2) of the Act was again maintained and notice of refusal was issued on 9 April 2005.

5. I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Marks Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.

6. No evidence has been put before me, therefore no claim under Section 7 of the Act has been made.

DECISION

The Law

7. 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.”

8. An earlier trade mark is defined in Section 6(1) which states:

“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,”

The prima face case for registration

9. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] R.P.C. 199, *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.

10. 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) 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*.

Distinctive character of the earlier trade marks

11. It is clear from the ECJ's judgment in the case of *Sabel BV v Puma AG* that the likelihood of confusion may be increased where the earlier trade mark has a highly distinctive character.

12. The earlier trade marks are all registered trade marks and are therefore deemed to possess distinctive character (Section 72 of the Act refers). One consists of the words GORILLA WEAR and the other consists of the words GORILLA WEAR (slightly stylised) together with a device of a gorilla. I note that in citation 1451672 rights to the exclusive use of the word WEAR have been disclaimed.

13. The word WEAR is meaningful for many goods in Class 25. It is defined in Collins English Dictionary as:

“14a anything designed to be worn: *leisure wear.....nightwear.*”

However, when presented in combination with the word GORILLA I consider that the word is to some degree subsumed by the highly distinctive word GORILLA. Presentation of the two words together does not detract from this level of distinctiveness. The addition of the device of a gorilla to citation 1451672 simply reinforces the emphasis on the word GORILLA and does nothing to reduce this level of distinctive character. The conflicting goods are all articles of clothing, footwear and headwear and when considered in relation to such goods I consider both marks to possess a relatively high degree of distinctive character because they are in no sense descriptive of the goods for which they are registered. The earlier marks are registered trade marks and although they do not possess the highest level of distinctive character, which is reserved for invented words, they do possess a relatively high level of distinctive character per se.

Similarity of the goods

14. The applicant has applied for registration of their trade mark in Classes 1, 16 and 25. I note that the objection under Section 5(2) of the Act relates to Class 25 only. The specification applied for in Class 25 is sufficiently wide in its coverage that there is a direct conflict with the goods contained within the specifications of all of the earlier trade marks as identical goods are involved. In my view the holder's goods are identical to the goods covered by the earlier trade mark No 2020699, and clothing and headgear are identical to the goods covered by earlier trade mark No 1451672

Similarity of the marks

15. Since the trade mark of this application is not identical to the earlier trade marks the matter falls to be decided under sub-section (b) of Section 5(2) of the Act. The question therefore, is whether the trade mark of this application is so similar to the earlier trade marks that there exists a likelihood of confusion which includes the likelihood of association on the part of the public.

16. The similarity of the trade marks must be assessed by reference to the visual, aural and conceptual similarities of the trade marks. It is clear from the judgment of the ECJ in the case of *Sabel BV v Puma AG* that I must assess the overall impressions created by the trade marks bearing in mind their distinctive and dominant components.

17. At the hearing Mr Law suggested that the mark applied for would not be seen as a device of a gorilla but as a representation of any primate of which there are numerous different breeds. I am aware that there are many different breeds of primates and I accept that there is a degree of stylisation to this mark but in my view this will only be perceived as a device of a gorilla's head and hence a gorilla.

18. It seems quite clear to me that the earlier trade marks will prevent any subsequent application for the word GORILLA from achieving registration for identical goods. Faced with such a potential barrier to any such application should an application for a pictorial representation of that word be allowed to achieve registration? In my view it should not. This concept is not new and has its roots in a decision dating back as far as 1894 when in a decision of the Court of Appeal when considering an application by *La societe Anonyme des Verreries de L'etoile* 11 RPC 142 on 14 March 1894 Lindley, L.J. made the following comments at page 145 line 51 to page 46 line 7:

“A trade mark may be registered in any colour, and such registration shall (subject to the provisions of this Act) confer on the registered owner the exclusive right to use the same in that or any other colour.” So that Messrs. *Brooks*, if they liked, could use this star for their glass in any colour they like – green, red, blue, orange or anything else. That being the case, it seems obvious that the Belgian Company could not register in England, for glass, a red star. Now it does seem a little startling that if they cannot register a simple red star they should be enabled to register the description of that very same thing in words, that is to say, that although they cannot appeal to the eye they may appeal to the ear. I cannot say that is right and that I understand is the real view taken by the learned Judge in the Judgment which has been read. Two marks may be calculated to deceive either by appealing to the eye or to the ear,

or one appealing to the eye and one to the ear. Finding that the Applicants' glass is sold as "Star glass" or "Star Brand" and bearing in mind that the star may be in any colour, I cannot see that "red star brand" is not calculated to deceive."

And on page 147 at lines 35 to 38 he said:

"To my mind the words "Red Star" do so nearly resemble the device of the star which the Applicants have registered as to be calculated to deceive, and I confess I should have come to that conclusion even without the evidence that is before us..."

19. Although there are visual differences between the marks I consider the aural and conceptual similarities to be high. All marks are likely to be referred to as GORILLA marks and conceptually they are practically identical. Given the level of distinctive character that the marks possess in relation to the goods in question I consider them to be similar. In my view both of the earlier trade marks are similar to the applicant's trade mark.

Likelihood of confusion

20. The goods in question are identical and I have found that all of the earlier trade marks are similar to the applicant's trade mark. The goods in conflict are not specialised in nature but are such that may be described as everyday goods which may be purchased without a great deal of consideration. Although there are clear differences between the conflicting trade marks the similarities I have identified result in there being a genuine likelihood of aural confusion between the conflicting marks.

21. I am aware that many purchasers of the goods in question may make their purchase choice by visual reference to the trade mark the goods bear. However, this does not detract from the likelihood that prospective purchasers, when faced with goods from many different manufacturers, will ask for assistance e.g Do you have any GORILLA goods please?

22. I must, of course, bear in mind that a mere possibility of confusion is not sufficient. (See eg *React Trade Mark* [2000] RPC 285 at page 290). The Act requires that there must be a likelihood of confusion. I have already found the goods in conflict to be identical. It is also clear that where there is a lesser degree of similarity between the trade marks this may be offset by a greater degree of similarity between the goods (and vice versa) - see *Lloyd Schuhfabrik Meyer & CO GmbH v Klijsen Handel BV*.

23. Furthermore, it is now well established that the matter must be determined by reference to the likely reaction of an average consumer of the goods in question, who is deemed to be reasonably well informed, reasonably observant and circumspect. In relation to these goods I consider the average consumer to be the general public. The average consumer generally relies upon the imperfect picture of the earlier trade marks that he or she has kept in his or her mind and must therefore rely upon the overall impression created by the trade marks in order to avoid confusion. In this case I believe the identity of the goods in Class 25 coupled with the relatively high degree of distinctive character of the trade marks and the similarity between them, is

sufficient to give rise to a likelihood of confusion within the meaning of Section 5(2)(b) of the Act.

24. I therefore conclude that there is a likelihood of confusion which includes the likelihood of association. In reaching this conclusion I bear in mind that it is sufficient if an average consumer encountering the respective trade marks would assume that the marks identify a single undertaking or undertakings with an economic connection.

Conclusion

25. The application is not registrable because it is debarred from registration by section 5(2) of the Act.

26. In this decision I have considered all of the documents filed by the applicant and all of the arguments submitted to me in relation to this application and, for the reasons given above, it is refused under the terms of Section 37(4) of the Act.

Dated this 15th day of April 2005

**A J PIKE
For the Registrar
the Comptroller-General**