

O-158-10

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2506954
BY
GERARD DORAN
TO REGISTER THE TRADE MARK**



IN CLASS 25

AND

**THE OPPOSITION THERETO
UNDER NO 99118
BY
DRESSMASTER GMBH**

Trade Marks Act 1994

**In the matter of application 2506954
by Gerard Doran
to register the trade mark:**



**in class 25
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under no 99118
by DressMaster GmbH**

1. On 22 January 2009, Gerard Doran applied to register the above trade mark. Following examination, the application proceeded to publication in the *Trade Marks Journal* on 20 February 2009 for a goods specification of '*Clothing, footwear, headgear*', which is in class 25¹.
2. DressMaster GmbH (which I will refer to as DM) filed notice of opposition to the trade mark application, claiming that registration would be contrary to section 5(2)(b) of the Trade Marks Act 1994 (the Act). It relies upon all of the goods of its two earlier trade mark registrations, as follows:

i) UK registration 2444485

STONES

Class 25: Articles of clothing; boots, shoes and slippers, footwear, headgear.

Date of application: 23 January 2007; date of completion of registration process: 31 October 2008.

ii) International registration (EC designation) 00000891298:

STONES WOMAN

¹ Class 25 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

Class 18: *Goods made of leather or imitation leather (included in this class), particularly leather for bags, men's handbags, ladies bags and handbags, purses, men's wallets, zipped purses, ladies clip purses, belt purses, breast purses, wallets, note cases, key holders, key cases, empty bags and cases for toilet articles and cosmetics; shoulder bags, travel bags, briefcases, shopping bags; schoolbags, satchels, rucksacks, sports bags; carrying frames (leatherware) for satchels and other loads; suspension straps for harnesses, stirrups, saddles and suitcases; umbrellas, sun umbrellas and walking sticks; saddler's wares.*

Class 24: *Textile wares (included in this class) for household, kitchen and domestic use, namely curtains, domestic laundry, tablecloths and bedding; bed spreads and table cloths; handkerchiefs of textile material; curtains of textile materials and/or plastics, especially decorative curtains, shower curtains, standard curtains, dividing curtains (room dividers), stage curtains; interior and roller curtains of textile materials, curtains and curtain material; interior jalousies of textile materials; blankets, especially woollen, eiderdowns and decorative covers; sleeping bags (included in this class); woven and raised warp materials.*

Class 25: *Ladies and children's clothing, including sports clothes, underwear and bathing suits; head coverings; scarves, sarongs, headbands, leggings; shoe ware, including sports shoes; non-orthopaedic underwear.*

Date of protection in the EU: 9 November 2005.

3. DM relies on all of the goods of its earlier marks and opposes all the goods of the application. Neither of DM's earlier marks were registered more than five years prior to the publication date of the application and neither is therefore subject to proof of use.

4. Section 5(2)(b) of the Act states:

“(2) A trade mark shall not be registered if because –

....

(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.”

DM claims that the goods of the application are either identical or similar to the goods covered by its own marks and that the marks are visually, aurally and conceptually highly similar, all of which would cause a likelihood of confusion. Mr Doran filed a counterstatement denying any similarity between the marks which would cause a likelihood of confusion and denying a similarity with DM's goods in classes 18 and 24.

5. Only Mr Doran filed evidence, most of the content of which is actually submission rather than fact. I will not summarise it as evidence but will bear the contents in mind in making this decision. DM filed written submissions which I also bear in mind. Neither party asked for a hearing, both being content for a decision to be made from the papers on file.

Decision

6. The leading authorities which guide me in this ground are from the Court of Justice of the European Union: *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO)*.. 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 for 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) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the

distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(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 and Adidas Benelux BV*,

(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*.

k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*

l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*.

Comparison of goods

7. The earlier UK registration is registered for: *articles of clothing; boots, shoes and slippers, footwear, headgear*, while the application has been made in respect of *clothing, footwear, headgear*. The goods are clearly identical. Mr Doran states that he intends to use the mark in relation to goods made from hemp, but the goods are not limited in this way. Even if they were, the earlier mark's specification would cover such goods so they would still be identical.

8. DM's best chance of success lies with its UK registration since the goods are identical to that of the application and its single registered element is that with which it claims the application is in conflict. If DM cannot succeed with this earlier mark, it will be in no better position with its international registration. I will therefore confine my decision to a comparison between DM's earlier UK registration 2444485 and the application.

Average consumer and the purchasing process

9. The average consumer of clothing, footwear and headgear is the general public. The level of attention will vary according to the particular nature of the item being purchased or hired. Buying clothing items will be a considered purchase. The level of attention of a consumer of clothing (footwear and headgear) may vary depending on cost and the occasion; in general, clothing is a reasonably considered purchase as items may be tried on, but not highly considered (as with specialist or technical goods). Buying clothes is a visual activity²; the public is increasingly brand conscious and the visual appearance of the trade mark and where it is placed on the clothing or footwear item is of some importance to many purchasers. The potential for imperfect recollection may be increased in relation to low cost goods, but if frequently purchased, that potential may be reduced. If items of high cost are infrequently bought, the higher level of attention may decrease the risk of imperfect recollection, but conversely the infrequency of purchase may lead to a greater potential for imperfect recollection.

Comparison of trade marks

10. The authorities direct that, in making a comparison between the marks, I must have regard to each mark's visual, aural and conceptual characteristics. I have to decide which, if any, of their components I consider to be distinctive and dominant, without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

Earlier mark	Application
STONES	

The application contains a device element while the earlier mark is a word-only mark. The mark is divided horizontally, with the device at the top and the word at the bottom. The word elements in the marks are both six letters in length, with

² See *Société provençale d'achat and de gestion (SPAG) SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-57/03*, paragraph 66, and *React Trade Mark* [2000] RPC 285.

the first five letters being identical. In what are relatively short words, the words are visually highly similar. Neither word has any descriptive meaning in relation to the goods so both words are distinctive. The device in the application is also distinctive and the more dominant element in the mark because of the combination of its size and position, relative to the word: the device takes up more than half the mark (Mr Doran states it is 75% of the mark), proportionately. The O in the application is slightly higher than the remaining letters; if both marks had been word-only, the elevated O may have been more conspicuous than it is, but the dominant device reduces the O's visual impact. Balancing the dominant and distinctive device against the high degree of visual similarity between the words there is, overall, a reasonable of visual similarity between the marks.

11. The device plays no aural part in the perception of the application, so the aural comparison is to be made between the respective word elements. The earlier mark is one syllable in length and the word in the application is two, the second syllable being created by the 'r' at the end of the word. The syllabic stress falls on the first 'stone' syllable which is almost identical in sound to the single syllable of the earlier mark; although the earlier mark ends in an 's', this is a soft sibilant sound so that the aural impression of the earlier mark is predominantly 'stone'. The dominant sound of both marks is therefore 'stone'. There is a high degree of aural similarity between the marks.

12. Mr Doran states at paragraph 7 of his witness statement:

“Although the linguistic markers which distinguish the respective markers are slight (i.e. “-S” as opposed to “-ER”) they have profound importance in distinguishing stone-related references from references to hemp. The opponent understandably wishes to trivialise these differences but I submit that these linguistic markers are sufficient to allow consumers to distinguish between marks which are fundamentally different in connotation – in much the same way that ‘Break’ is different from ‘Breaker’, or ‘Flake’ different from ‘Flaker’, and so on. The fact is that ‘Stones’ calls to mind just that – stones, whereas the Mark calls to mind hemp-related issues. The opponent would seek to somehow align these meanings but I submit that they are clearly very different, call to mind very different things and that their respective references are not such as to give rise to the likelihood of confusion or association. Consumers and users of English generally are able to focus on linguistic markers and so distinguish quite different references.”

Mr Doran focuses in this paragraph on what he says are the conceptual differences between the marks: the earlier mark relates to stone, his mark relates to hemp products. The meaning of 'stone' (as in rock, pebble) is well known. There is no explanation as to why 'stoner' relates to hemp. The following definition is from the Penguin English Dictionary, 2003 Edition:

“stoner”

noun

slang a person who smokes cannabis”.

It is not a word with which I am familiar, although I am aware that to be ‘stoned’ means to be intoxicated (through drug usage). The definition does not appear in Collins English Dictionary. The conceptual meaning of the earlier mark will be the plural of ‘stone’, as in rock or pebble. I am not prepared to find that the conceptual meaning of ‘stoner’ as a drug user would be widely known and then extrapolated to mean something relating to hemp. It is more likely to be seen as an invented word. Invented words have a high inherent distinctive character, but no obvious concept of their own in contrast to dictionary words. However, invented words can be evocative of an idea³. I consider that the word stoner when coupled with the device of a stone creates an impression which is evocative of or connected with the concept of stone.

13. Mr Doran says that his mark is targeted at a young, environmentally conscious group whereas the opponent’s website indicates its goods are targeted at a “prestige professional audience” and his consumer group would make the hemp connection. Whether or not either of these is the case cannot have a bearing on the conceptual analysis because current marketing strategies can change, as can ownership of trade marks⁴. The conceptual analysis is from the viewpoint of the average consumer for clothing, which is the general public.

14. Even though it is anthropomorphised by its smiling face, the device is clearly a stone. In combination with an invented word which is evocative of ‘stone’,

³ The General Court has considered how trade marks or parts of trade marks may have a conceptual connotation despite not being in themselves dictionary words. In *Usinor SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-189/05* the CFI referred to a “suggestive connotation”. In *Ontex NV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 353/04* it referred to the “evocative effect” and in *Hipp & Co v OHIM T-221/06* the perception of words that consist of parts with concrete meanings.

⁴ *Oakley, Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-116/06*: “76 Consideration of the objective circumstances in which the goods and services covered by the marks in dispute are marketed is fully justified. The examination of the likelihood of confusion which the OHIM authorities are called on to carry out is prospective. Since the particular circumstances in which the goods covered by the marks are marketed may vary in time, and depending on the wishes of the proprietors of the trade marks, the prospective analysis of the likelihood of confusion between two marks, which pursues an aim in the general interest, that is, that the relevant public may not be exposed to the risk of being misled as to the commercial origin of the goods in question, cannot be dependent on the commercial intentions, whether carried out or not – and which are naturally subjective – of the trade mark proprietors (*QUANTUM*, paragraph 75 above, paragraph 104, and *T.I.M.E. ART/Devinlec v OHIM*, paragraph 75 above, paragraph 59).”

there is a high level of conceptual similarity with the earlier mark, the concept of which is the plural of 'stone'.

Likelihood of confusion

15. It is necessary to consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade mark (either by nature or nurture) the greater the likelihood of confusion⁵. The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public⁶. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the goods for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings⁷. DM has not filed any evidence of a claim to an enhanced distinctive character through use; I therefore approach the earlier mark on the basis of inherent distinctive character. STONES would appear to have no descriptiveness or even allusiveness in relation to clothing, footwear and headgear. 'Stone' could be a colour, but not if pluralised, as here. I consider the earlier mark to possess a high degree of inherent distinctive character.

16. Single letter differences, particularly in short words, can have a decisive effect in putting a visual and conceptual distance between marks, but I do not think that is the case here because the word STONER with a picture of a stone leads to an evocative perception and memory of 'stone'. The average consumer rarely has the opportunity to compare trade marks side by side, relying instead upon the imperfect picture he has of them in his mind. Bearing in mind the interdependency principle (*Canon*), whereby a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa, the position here is of identical goods, a reasonable degree of visual similarity and a high level of aural and conceptual similarity between the marks. I have found that the concept of the word STONER is reinforced by the device of a stone; it is also the case that the word plays an independent role in the mark⁸. The words in the two marks are visually, aurally and conceptually highly similar.

17. In considering the likelihood of confusion it is necessary to bear in mind how the trade marks are likely to be encountered, which in the case of clothing is

⁵ *Sabel BV v Puma AG* [1998] RPC 199.

⁶ *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

⁷ *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

⁸ *Medion*, supra.

visually. Mr Doran submits his device is 'humorous and unique', which the average consumer will remember and recognise. The device makes it unlikely that one mark will be directly mistaken for the other. However, I must also have regard to a scenario where, although the marks are not mistaken directly, there is a belief or an expectation upon the part of the average consumer that the goods bearing the individual marks emanate from a single undertaking because there are points of similarity which lead to association. If the association between the marks causes the public wrongly to believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion. It does not matter whose mark is associated to whose, there will be confusion in the mind of the public.

18. I consider that the identity of goods and the close conceptual similarity between the marks will lead to such an association in the mind of the purchasing public. There is a likelihood of confusion and the opposition succeeds.

Costs

19. DM has been successful and is entitled to an award of costs on the following basis:

Preparing a statement and considering Mr Doran's statement:	£200
Official fee:	£200
Considering Mr Doran's evidence and submissions:	£300
Written submissions:	£200
Total:	£900

20. I order Mr Doran to pay DressMaster GmbH the sum of £900. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 20 day of May 2010

**Judi Pike
For the Registrar,
the Comptroller-General**