

O-159-11

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION 2524088
BY REEDS PROFESSIONAL CLEANING AND ALTERATIONS LTD TO
REGISTER THE TRADE MARK**

REEDS

IN CLASSES 37 AND 40

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 99991
BY AUSTIN REED LTD**

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By Reeds Professional Cleaning & Alterations Ltd to register the trade mark

REEDS

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IN THE MATTER OF opposition thereto under No 99991 by Austin Reed Ltd

BACKGROUND AND PLEADINGS

1. On 19th August 2009, Reeds Professional Cleaning & Alterations Ltd (hereafter "Pro") of 126 Regents Crescent, Trafford Centre, Manchester M17 8AP applied to register the mark REEDS in Classes 37 and 40 for the following:

Class 37:

Repair, maintenance, renovation and cleaning of clothing; ironing and pressing of clothing; information, advisory and consultancy services relating to the aforesaid services.

Class 40:

Tailoring alterations; clothing alterations; application of appliqués and motifs to clothing; dyeing of clothing; information, advisory and consultancy services relating to the aforesaid services.

2. The application was allocated number 2524088 and was published in the Trade Marks Journal on 9th October 2009, and on 11th January 2010 Austin Reed Ltd (hereafter "Austin") of Station Road, Thirsk, North Yorkshire YO7 1QH lodged an opposition against the services specified above.
3. Austin has opposed on the sole basis of section 5(2)(b), citing the following earlier marks:

Marks. Filing and registration dates	Goods and services relied upon under section 5(2)(b)
<p>CTM 4335451 ('451)</p> <p>AUSTIN REED</p> <p>11th March 2005</p> <p>18th April 2006</p>	<p>Class 37:</p> <p>Tailoring repair services; ironing and pressing services.</p> <p>Class 40:</p> <p>Tailoring alteration services</p>
<p>UK 688870 ('870)</p> <p>AUSTIN REED</p> <p>8th May 1950</p>	<p>Class 25:</p> <p>Complete articles of clothing for men.</p>
<p>UK 1136256 ('256)</p> <p>AUSTIN REED</p> <p>1st July 1980</p>	<p>Class 25:</p> <p>Complete articles of clothing for men; skirts, blouses, dresses, blazers, jackets, trousers, shirts, knitted articles of clothing and articles of clothing made from knitted material, coats, suits, scarves, hats and ties for wear, all for women.</p>
<p>CTM 1516129 ('129)</p> <p>AUSTIN REED</p> <p>18th February 2000</p> <p>5th October 2001</p>	<p>Class 25:</p> <p>Clothing, footwear, headgear; scarves, belts, ties; sportswear.</p>

<p>UK 2020113 ('113)</p> <p>AUSTIN REED</p> <p>AUSTIN REED</p> <p>11th May 1995</p> <p>4th October 1996</p>	<p>Class 25:</p> <p>Clothing, footwear and headgear; sportswear.</p>
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4. Austin say, in respect of all earlier marks, they contain the distinctive and dominant element, REED, common to the application. As regards the '451 mark they say the services are identical to those of the application. As regards the other earlier marks they say the respective goods are similar to the services of the application. Taking all factors into account, there is a likelihood of confusion.
5. Pro filed a counterstatement denying that the goods of '870, '256, '129 and '113 are similar to the services of the application, but not denying that the services of '451 may be identical or similar to some of the services of the application. They deny that the distinctive and dominant element of the opponent's marks is REED and further deny that their mark is sufficiently similar to the opponent's marks for there to be a likelihood of confusion. The obvious differences outweigh any similarities they say.
6. No evidence was filed by either party but submissions were received from both sides which I shall take into account below. No hearing was requested by either party either and so I give my decision based upon a careful reading of the papers.

DECISION

Section 5(2)(b)

7. The opposition is founded upon Section 5(2) (b) of the Act. This reads:

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

(a).....

(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. All Austin's trade marks qualify for consideration as 'earlier trade marks' in accordance with section 6(1) of the Act. That said, only '451 is not subject to proof of use requirements under section 6A of the Act; its date of registration being under 5 years prior to the date of publication of the application. In addition to this, the specification of '451, comprises (unlike the other earlier marks which are all for goods) services in the same classes as the application, and this mark then presents Austin with its best possible case. I will then focus on this mark. At this point, I should perhaps note for the record that the other earlier marks are, of course, the same in content; that is, with the exception of '113 which is a series of two, but although the script differs in '113, the words are the same as the other earlier marks.
9. Further, as Austin has not filed any evidence of use of its mark 'AUSTIN REED', effectively the opposition must be decided on the sole basis of the '451 mark and its specification.
10. In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the Court of Justice of the European Union ("CJEU") in *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 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) 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*

The average consumer and nature of the purchase

11. The average end consumer for both parties' products, in a notional sense, will be the general public who require repair and/or alterations to clothing. The average consumers for the respective marks will be identical.
12. Such services may well be offered by the outlet from which the garment itself has been purchased, or alternatively from a specialist outlet not responsible for the supply of the original garment. The specialist outlet may offer specifically and exclusively, tailoring services, or offer, in addition, dry cleaning services for example. In any event, the consumer is likely to have given the matter some thought before selecting a service provider.
13. Such services are not accessed on a regular, everyday basis and many items of clothing will not require alteration in the first place or the consumer will simply discard them at the end of their natural usage without bothering with any repair. These days, in pure economic terms, for access to such services to be justified it is likely that the original garment is itself of some value (which includes sentimental value) to the consumer.
14. I will factor these observations into my analysis of likelihood of confusion.

Comparison of marks

15. The case law makes it clear I must undertake a full comparison (taking account of visual, phonetic and conceptual similarities and dissimilarities), from the perspective of the average consumer. Marks need to be considered in their totalities and overall impression (see authority (k) above in para 10), taking account of distinctive and dominant elements.

Visual comparison

16. Pro's mark is a single five letter word, REEDS, in plain script and upper case. Austin's mark comprises two words 'AUSTIN' and 'REED' in that order. There is visual similarity, clearly, around the word 'REED', which, although it is REEDS in Pro's mark, the 's' may simply indicate the possessive version. Taking the similarities and dissimilarities into account I find the respective marks to be visually similar.

Phonetic comparison

17. Pro's mark will be pronounced REE-DS whereas Austin's mark will be pronounced OS-TIN REE-D. In my view it will be pronounced in full. There is no evidence that it is abbreviated or shortened to REE-D or REE-DS. Taking the similarities and dissimilarities into account, I find the respective marks to be phonetically similar.

Conceptual comparison

18. By conceptual similarity, it is meant 'semantic' conceptual similarity. Insofar as either mark will convey any 'concept', it will be that of a personal name. I think it most unlikely therefore that the alternative definition of 'REED', that of a stalk or straw, will have any resonance with the average consumer when seen in the context of the services on offer.
19. In Austin's case the name will be both forename (Christian) name and surname. I have considered whether 'AUSTIN REEDS' may alternatively be viewed as two surnames, but I think on balance this is unlikely as AUSTIN, although not the commonest forename is nonetheless recognisable as a forename, eg AUSTIN POWERS. In Pro's case, the word 'REEDS' may either be the actual surname 'REEDS' (including the 's'), or alternatively, the possessive version of the surname 'REED'. Whilst there is no apostrophe to properly indicate the possessive, I must take into account that it is the perception of the average consumer that matters in my analysis and the correct use of apostrophes is notoriously elusive these days. Moreover, I accept as fact that REED is a popular surname, whereas REEDS is not as popular. Given these factors, I think it more likely than that REEDS will be seen as the possessive version of 'REED' by the average consumer.
20. So, to the extent that both marks will both evoke a person by the name of REED, then some degree of conceptual similarity must arise. But of course this is not the whole picture, and I must consider the marks as wholes, taking account of distinctive and dominant elements.

Overall similarity of marks

21. Fortunately, the CJEU has given some guidance on the question of approaching the comparison of names, where one mark is the full name and the other mark is just the surname. Case C-51/09P *Barbara Becker v Harman International Industries Inc and OHIM* ("Becker") is worth quoting at length:

35. In the present case, having repeated all of the rules set out in paragraphs 30 to 33 of this judgment, the General Court held essentially, in its assessment of the conceptual similarity of the marks at issue, first, that, as consumers in part of the European Union generally attribute greater distinctiveness to the surname than to the forename in word signs, the component 'Becker' in the mark applied for was likely to have attributed to it a stronger distinctive character than the component 'Barbara'; second, that the fact that Ms Becker is famous in Germany had no effect on the similarity of the marks at issue since they refer to the same surname and the component 'Barbara' is merely a forename and, third, that the component 'Becker' retained an independent distinctive role in the composite mark because it would be perceived as a surname.

36. Although it is possible that, in a part of the European Union, surnames have, as a general rule, a more distinctive character than forenames, it is appropriate, however, to take account of factors specific to the case and, in particular, the fact that the surname concerned is unusual or, on the contrary, very common, which is likely to have an effect on that distinctive character. That is true of the surname 'Becker' which the Board of Appeal noted is common.

37. Account must also be taken of whether the person who requests that his first name and surname, taken together, be registered as a trade mark is well known, since that factor may obviously influence the perception of the mark by the relevant public.

38. Furthermore, it must be held that, in a composite mark, a surname does not retain an independent distinctive role in every case solely because it will be perceived as a surname. The finding with respect to such a role may be based only on an examination of all the relevant factors of each case.

39. Moreover, as the Advocate General pointed out in essence, in point 59 of his Opinion, the grounds relied on by the General Court in order to conclude that the marks at issue are conceptually similar, if they were held to be consistent with Article 8(1)(b) of Regulation No 40/94, would result in acknowledging that any surname which constitutes an earlier mark could be effectively relied on to oppose registration of a mark composed of a first name and that surname, even though, for example, the surname was common or the addition of the first name would have an effect, from a conceptual point of view, on the perception by the relevant public of the composite mark.

40. It follows from all the foregoing that the General Court erred in law in basing its assessment of the conceptual similarity of the marks on general considerations taken from the case-law without analysing all the relevant

factors specific to the case, in disregard of the requirement of an overall assessment of the likelihood of confusion, taking account of all factors relevant to the circumstances of the case, and based on the overall impression produced by the marks at issue."

22. This is yet another example of the CJEU cautioning against the application of general, or '*a priori*' rules in any assessment, which then take precedence over, or tend to supplant in some way, the specific circumstances of the case.
23. In particular, the CJEU urges courts and tribunals to take account of the fact, for example, that the surname involved may be common or, to the contrary, unusual, as this is a question relevant to the distinctiveness of the mark containing the surname. Also, the CJEU asks courts to take account of the fact that the person requesting his first and surname to be registered is well known, as that fact may also affect the perception of the public. Finally, the CJEU notes that a surname in a composite mark does not necessarily retain an independent role in a combined forename and surname mark solely by virtue of being perceived as a surname. All these observations are relevant to the case before me, albeit that in the case before the CJEU the roles were reversed, and the later mark was the full name and the earlier mark comprised just the surname.
24. Unsurprisingly, Austin asks me, in effect, to skew my analysis of distinctiveness and dominant elements towards the surname, 'REED'. They say, for example, that in relation to clothing, it would be the case that such items would be named after, "designers or personalities and therefore the surname is given far greater emphasis. We previously gave examples of these as being Armani, Versace, Davidoff and Zandra Rhodes."
25. At the very least, Austin ask me to treat their mark as a simple two-word mark, with both words having "equal weight" in terms of their distinctiveness.
26. These submissions are not persuasive for a number of reasons. Firstly, I am not concerned with 'clothing' per se in this case. This case concerns the rather more mundane activity of repairs and alterations to clothing. Secondly, even if I was concerned with clothing per se, the designers selected by Austin invariably have, to the UK English-speaking consumer, very distinctive surnames. Such names, even 'Rhodes', would not be popular in the UK. 'Reed', however, is. Pro say that, according to the British Surnames and Surname Profiles website, there are currently more than 27,000 people in the UK with the surname 'Reed'. Although this fact is not formally in evidence I accept it to be Pro's position. The Court of Appeal in *Reed Executive Plc v Reed Business Information Ltd* [2004] RPC 40 at para 38 also found that REED is a common or popular surname without formal evidence on the point. Thirdly, I think there is inherent danger in treating the *name* 'AUSTIN REED' as a 'complex' two-word mark, both '*words*' having equal status in

terms of dominance and distinctive quality. The fact is that it is personal *name* to be read as a whole; Reed qualifies Austin and Austin qualifies Reed, the full name being AUSTIN REED. The ‘distinctiveness’, in trade mark terms, thus lies in the combination of the two names rather than an artificial and forensic separation of so-called ‘elements’ or words. To reinforce the point, para 39 of *Becker* makes it clear for example that the presence of a Christian name can have an effect upon the conceptual perception of the average consumer. In this case, I believe it does.

27. I would just note also that there is no evidence before me to the effect that ‘Austin Reed’ (a factor, as I have already noted, in *Becker*) is a well known person, which may have also impacted upon my analysis.
28. Taking all these factors into consideration, I find that, overall, the respective marks only share a low level of similarity.

Comparison of the goods

29. In assessing the similarity of the goods, it is necessary to apply the approach advocated by case law and to take account of all the relevant factors relating to the services in the respective specifications. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at para 23 of the Judgment:

‘In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their end users and their method of use and whether they are in competition with each other or are complementary.’

30. Other factors have been identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281, such as the nature of the users and the channels of trade.
31. It is important to recognise that even though the factual evidence on similarity is non-existent, I nevertheless have the statements of case, submissions and am able to draw upon commonly known facts. [Mr Geoffrey Hobbs QC sitting as the appointed person said in *Raleigh International trade mark* [2001] R.P.C. 11, at para 20, that such evidence will be required if the goods or services specified in the opposed application for registration are not identical or self-evidently similar to those for which the earlier trade mark is registered. But where there is self-evident similarity, and especially in relation to everyday items, evidence may not be necessary.
32. I should also mention a further case in terms of the application of legal principle, and that is the European Court of First Instance (“CFI”) in *Gérard*

Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) ("Meric") Case T-133/05, where, at para 29, it is stated:

“In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

33. The relevant services to be compared are:

Austin’s services	Pro’s services
<p>Class 37: Tailoring repair services; ironing and pressing services.</p> <p>Class 40: Tailoring alteration services</p>	<p>Class 37: Repair, maintenance, renovation and cleaning of clothing; ironing and pressing of clothing; information, advisory and consultancy services relating to the aforesaid services.</p> <p>Class 40: Tailoring alterations; clothing alterations; application of appliquéés and motifs to clothing; dyeing of clothing; information, advisory and consultancy services relating to the aforesaid services.</p>

34. Although Pro’s services include ‘information advisory and consultancy relating to the aforesaid’ main services, and Austin’s specification does not include those terms, I regard such services as ancillary to the main services specified, and as such I find they are highly similar to the main services in Austin’s specification. Insofar as Pro’s specification does not use precisely the same terminology as Austin, plainly such terms as Pro use also fall within, and are encompassed by, the terms used by Austin.

35. On that basis I find that the respective services are identical with the exception of 'information, advisory and consultancy services relating to the aforesaid services', which are highly similar.

Likelihood of confusion

36. Before proceeding to bring all my findings together in an overall global assessment, I need to make an assessment of the distinctive character of the earlier mark. An invented word having no derivation from known words is, in its inherent characteristics, very high on the scale of distinctiveness, KODAK being the prime example.

37. The earlier mark is the name, AUSTIN REED. Although as I have said, the surname REED is common, I am far from certain the Christian name, AUSTIN, is common, or at least as common. I have already noted that AUSTIN is recognisable as a Christian name (eg, as in AUSTIN POWERS), but it is not necessarily common. Plainly the combination of the two names will be even less common. On that basis, the earlier mark can be said to be inherently distinctive to a average level. Austin has submitted no evidence of its use of AUSTIN REED, whereby I can assess whether the inherent distinctiveness of their mark is enhanced through use, and so this is not a factor in my analysis.

38. Nor has Austin submitted any evidence to the effect that AUSTIN REED himself is a well known person, such that the perceptions of the average consumer may in some way be affected.

39. At this point I need to remind myself of my various findings and bring them together in a global assessment taking, of course, into account, the doctrine of imperfect recollection, namely that consumers rarely have the opportunity to compare marks side by side.

40. I have found that the respective services are identical or highly similar. I have made observations on the respective average consumers, namely that they are also identical and I have found the purchasing process to involve considered purchasing. Finally, I have found the respective marks to share a low level of similarity. Needless to say that in making a global assessment, it is not a 'tick box' exercise, whereby if I find more factors in one parties favour, it inevitably wins. All factors must be weighed in the evaluation of likelihood of confusion.

41. Nonetheless, in all the circumstances **I find there is no likelihood of confusion in this case and the opposition fails in its entirety.** In particular, it is telling in this case that the surname 'REED' is common, and that the average consumer is not likely therefore to assume that the relevant

services offered under the names 'AUSTIN REED' and 'REEDS' derive from the same economic undertaking.

Costs

42. Pro has been totally successful in defending against the opposition. Accordingly, it is entitled to a contribution towards its costs and neither party sought costs off the normal scale. In the circumstances I award Reeds Professional Cleaning & Alterations Ltd the sum of £700 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

1. Filing counterstatement and considering statement - £300
2. Filing submissions - £ 400

Total £700

43. I order Austin Reed Ltd to pay Reeds Professional Cleaning & Alterations Ltd the sum of £700. The sum should 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 12 day of May 2011

**Edward Smith
For the Registrar,
the Comptroller-General**