

IN THE MATTER OF UNITED KINGDOM REGISTERED TRADE MARK NO.  
2339714 IN THE NAME OF TERENCE BALL

AND IN THE MATTER OF APPLICATION NO. 81578 FOR A DECLARATION  
OF INVALIDITY BY BUFFALO BOOTS GMBH BUFFALO BOOTS GMBH

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DECISION

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Introduction

1. On 2 August 2003 Terence Ball applied to register the trade mark BUFFALO CREEK in respect of the following goods:

Class 18: Bags, travel bags, holdalls.

Class 25: Footwear, clothing and headgear.

2. The application was accepted and the mark was placed on the Register on 2 January 2004.

3. On 12 January 2004 Buffalo Boots GmbH applied for a declaration of invalidity under section 47(2)(a) of the Trade Marks Act 1994 on the ground that the mark had been registered in contravention of section 5(2)(b). As presented at the hearing, the application was based on the following earlier registrations:

- (1) International trade mark No. 669747 registered with effect in the UK as of 7 December 1996 in respect of “shoes” in Class 25. This registration is of the following mark:

Buffalo

- (2) Community trade marks Nos. 1495753 and 2183614 registered as of 7 February 2000 and 17 April 2001 in respect of “clothing, footwear and headgear” in Class 25 and a long list of goods of Class 18 including “travelling bags” and various other types of bags respectively. The mark which is the subject of both these registrations is as follows:



4. The only evidence filed was directed purely to formal matters, and so the application fell to be considered on the basis of the inherent qualities of the various marks. In a written decision dated 1 December 2004 (BL O/353/04) Mr George Salthouse for the Registrar held that the application was well founded and made the declaration sought. The proprietor now appeals.
5. Section 5(2)(b) provides:

A trade mark shall not be registered if because ... 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 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.

The hearing officer's decision

6. The hearing officer began by directing himself in accordance with the Registrar's standard summary of the jurisprudence of the Court of Justice of the European Communities in Case C-251/95 *SABEL BV v Puma AG* [1997] ECR I-6191, Case C-39/97 *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc* [1998] ECR I-5507, Case C-342/97 *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [1999] ECR I-3819 and Case C-425/98 *Marca Mode CV v Adidas AG* [2000] ECR I-4881. This summary is very well known and it is unnecessary to repeat it here.

7. The hearing officer proceeded to deal first with the case based upon the applicant's International registration and secondly with the case based upon the applicant's two Community registrations.

*The International registration*

8. It was agreed before the hearing officer that the relevant average consumer for the Class 25 goods was the general public. The hearing officer held that the average consumer of clothing and footwear would exercise some care in their selection and that (following *REACT Trade Mark* [1999] RPC 529) a majority of the public relied primarily upon visual means to identify the trade origin of clothing although this did not mean that aural means of identification were not relied upon.
9. It was common ground before the hearing officer that the applicant's International registration was registered in respect of goods which were identical to those covered by the proprietor's registration insofar as the latter was registered in respect of "footwear".
10. So far as the inherent distinctiveness of the applicant's mark was concerned, the hearing officer held as follows:
  20. ... The product in its specification, shoes, can be made of buffalo hide. The word can also be said to allude to strength which is a desirable characteristic in shoes. To my mind the mark has a degree of inherent distinctiveness although not in the Kodak class.
11. So far as the comparison between the respective marks was concerned, the hearing officer held as follows:
  17. The applicant's mark is in a plain script and is a well known word. Visually the respective marks share the same word, 'BUFFALO' although the registered proprietor's mark has a second word 'CREEK'.
  18. Aurally the marks share the first component 'BUFFALO' while the registered proprietor's mark has the additional word 'CREEK'. The second word of the registered proprietor's mark has a 'hard' sound and is unlikely to be lost if the mark is pronounced.

19. Conceptually the registered proprietor's mark suggests a geographical location, a stream of river which Buffalo frequent. The applicant contended that the registered proprietor's mark is also the name of a place in the USA. The applicant's mark brings to mind either the image of a large herbivore, or the geographical location in the USA. There are therefore potential similarities and differences dependent on how the mark strikes the consumer.

...

24. Whilst there are differences between the marks there are also similarities. It was contended by the registered proprietor that the conceptual difference would provide such a different message that the concept of imperfect recollection could be ruled out. I accept that conceptual differences can and do permeate into visual and aural comparisons. However, in the instant case there are conceptual similarities as well as potential dissimilarities. Overall, to my mind there are similarities in the marks which outweigh the differences added to which the goods are identical.

12. The hearing officer expressed his overall conclusion as follows:

25. Considering the matter globally and weighing all the factors outlined at paragraph 12 above I come to the conclusion that there is a likelihood that the relevant consumer will believe that the 'footwear' of the registered proprietor would originate from the applicant or from an economically linked undertaking. Therefore the application for invalidity under Section 5(2)(b) is successful in relation to footwear.

#### *The Community trade marks*

13. It was again common ground that the Community trade marks were registered in respect of goods identical to those covered by the proprietor's registration. The hearing officer held that, although the applicant's marks were in a stylised script, they were still clearly recognizable as the word BUFFALO. On this basis, he held that his comparison of the respective marks was equally applicable here as were his other findings. Accordingly he reached the same conclusion.

#### Standard of review

14. This appeal is a review of the hearing officer's decision. The proprietor's attorney accepted that the hearing officer's decision with regard to section 5(2)(b) involved a multi-factorial assessment of the kind to which the approach set out by Robert Walker LJ in *REEF TM* [2002] EWCA Civ 763, [2003] RPC 5 at [28] applied:

In such circumstances an appellate court should in my view show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle.

#### Grounds of appeal

15. The proprietor contends that the hearing officer erred in principle in two main respects. First, that there was no evidence as to the geographical signification of the terms BUFFALO and BUFFALO CREEK, and in particular no evidence that the average consumer knew them to be places in the USA, and accordingly the hearing officer was wrong to proceed on the basis that those terms would be understood in that way. Secondly, that the hearing officer failed properly to consider the conceptual difference which resulted from adding the word CREEK to the word BUFFALO and the impact this would have on the overall assessment.

#### Matters not in issue

16. The proprietor's attorney accepted that the hearing officer had directed himself correctly as to the applicable legal principles, although she contended that he had failed correctly to apply those principles. She also accepted the hearing officer's assessments with regard to (i) the identity of the respective goods, (ii) the insignificance of the figurative elements in the applicant's marks, (iii) the distinctiveness of the applicant's marks, (iv) the visual comparison between the respective marks and (v) the aural comparison between the respective marks. Finally, she accepted that the cases based on the applicant's International and Community registrations stood or fell together. Accordingly, I shall concentrate upon the decision in respect of the International registration.

### First ground of appeal

17. So far as the first ground is concerned, it is correct that there was no evidence as to the geographical signification of the terms BUFFALO and BUFFALO CREEK, and in particular no evidence that the average consumer knew them to be places in the USA. In my judgment, however, the hearing officer was entitled to take judicial notice of the fact that Buffalo is a city in New York state, since this appears from the *Shorter Oxford English Dictionary*. It does not follow that the average consumer would know this, nor did the hearing officer say that it did. As I read his decision, the hearing officer proceeded upon the basis that some consumers would know it but others would not. In my view he was correct to do so: for example, I myself was aware of this, but in the absence of evidence to the contrary I would expect many consumers to be unaware of it. I do not read the hearing officer as having accepted the applicant's contention that Buffalo Creek was also the name of a place in the USA, as opposed to merely recording it. Rather, his assessment of BUFFALO CREEK was based on the ordinary meanings of the words BUFFALO and CREEK. Even if he did accept the applicant's contention, he again rightly proceeded on the basis that some consumers might know this but others would not. I would expect that rather fewer consumers would be aware that Buffalo Creek is a place in South-West Virginia: for example I myself was not previously aware of this.

### Second ground of appeal

18. Stripped to its essentials, the proprietor's argument is that: (a) the hearing officer failed properly to consider the effect of combining the word CREEK with the word BUFFALO; (b) he should have concluded that the effect was that the 'idea' of the proprietor's mark, which was that of a place, was quite different to the 'idea' of the applicant's marks, which was that of a large animal; and (c) this was sufficient to negate any likelihood of confusion, particularly having regard to the low inherent distinctiveness of the applicant's marks and the visual and aural differences.

19. In support of this argument, the proprietor's attorney cited the decision of Geoffrey Hobbs QC in *Land Securities plc's Application* (BL O/339/04) (unreported, 28 October 2004). The applicant's attorney riposted with the recent decision of the Court of First Instance in Case T-22/04 *Reemark Gesellschaft für Markenkooperations mbH v OHIM* (4 May 2005). I then drew to the parties' attention the even more recent opinion of the Advocate General in Case C-120/04 *Medion AG v Thomson multimedia Sales Germany & Austria GmbH* (9 June 2005).

*The case law*

20. I will consider the principal cases relevant to this issue in chronological order, beginning with Case T-6/01 *Matratzen Concord GmbH v OHIM* [2002] ECR II-4335 and Case C-3/03P *Matratzen Concord GmbH v OHIM* (28 April 2004). In that case Matratzen Concord GmbH applied to register a device containing the words MATRATZEN MARKT CONCORD as a Community trade mark for goods in Classes 10, 20 and 24. The application was opposed by Hukla Germany SA, the proprietor of an earlier Spanish registration of the word mark MATRAZEN for goods in Class 20. The Opposition Division upheld the opposition in Classes 20 and 24 but rejected it in Class 10. Both sides appealed. The Second Board of Appeal dismissed Matratzen's appeal and upheld Hukla's appeal, holding that there was a likelihood of confusion in respect of all goods in issue. An appeal by Matratzen to the Court of First Instance was dismissed. A further appeal by Matratzen to the Court of Justice was dismissed as manifestly unfounded by reasoned order.
21. In its paragraphs 23-26 of its judgment the Court of First Instance summarised the jurisprudence of the Court of Justice in *SABEL*, *Canon*, *Lloyd* and *Marca Mode*. It went on:
30. In that regard, it should be pointed out, in general terms, that the two marks are similar when, from the point of view of the relevant public, they are at least partially identical as regards one or more relevant aspects. As the Court's case law indicates, the visual, aural and

conceptual aspects are relevant (*SABEL*, paragraph 23, and *Lloyd Schuhfabrik Meyer*, paragraph 25).

31. In this case the word MATRATZEN is both the earlier trade mark and one of the signs of which the trade mark applied for consists. It must therefore be held that the earlier mark is identical, from a visual and aural point of view, to one of the signs making up the trade mark applied for. However that finding is not in itself a sufficient basis for holding that the two trade marks in question, each considered as a whole, are similar.
  32. In this context, the Court of Justice has held that the assessment of the similarity between two marks must be based on the overall impression created by them, in light, in particular, of their distinctive and dominant components (*SABEL*, paragraph 23, and *Lloyd Schuhfabrik Meyer*, paragraph 25).
  33. Consequently, it must be held that a complex trade mark cannot be regarded as being similar to another trade mark which is identical or similar to one of the components of the complex mark, unless that component forms the dominant element within the overall impression created by the complex mark. That is the case where that component is likely to dominate, by itself, the image of that mark which the relevant public keeps in mind, with the result that all the other components of the mark are negligible within the overall impression created by it.
  34. It should be made clear that that approach does not amount to taking into consideration only one component of a complex trade mark and comparing it with another mark. On the contrary, such a comparison must be made by examining the marks in question, each considered as a whole. However, that does not mean that the overall impression created in the mind of the relevant public by a complex trade mark may not, in certain circumstances, be dominated by one or more of its components.
  35. With regard to the assessment of the dominant character of one or more given components of a complex trade mark, account must be taken, in particular of the intrinsic qualities of each of those components by comparing them with those of other components. In addition, and accessorially, account may be taken of the relative position of the various components within the arrangement of the complex mark.
22. In paragraphs 36-43 of its judgment the Court of First Instance held that the word MATRATZEN was the dominant element of the mark applied for. It therefore concluded in paragraph 44 that the Board of Appeal was fully entitled to hold that there was a visual and aural similarity between the two marks. It added that there was no conceptual difference because the word



MATRATZEN had no meaning in Spanish. Finally, in paragraphs 45-50 of its judgment the Court of First Instance held that, considered cumulatively, the degree of similarity of the respective marks and the degree of similarity between the respective goods was such that the Board of Appeal was fully entitled to conclude that there was a likelihood of confusion.

23. In paragraphs 28-29 of its reasoned order the Court of Justice summarised its jurisprudence in *SABEL*, *Canon*, *Lloyd* and *Marca Mode*. In paragraph 30 it held that the Court of First Instance had not erred in its interpretation of Article 8(1)(b) of the CTM Regulation. It went on:
  31. In that regard, the claim that the Court, by considering separately the elements of the trade mark applied for, failed to assess globally the likelihood of confusion, taking into account all the factors relevant to the circumstances of the case, is unfounded.
  32. The Court rightly pointed out, in paragraph 34 of the contested judgment, that the assessment of the similarity between two marks does not amount to taking into consideration only one component of a complex trade mark and comparing it with another mark. On the contrary, such a comparison must be made by examining the marks in question, each considered as a whole. It also held that that does not mean that the overall impression created in the mind of the relevant public by a complex trade mark may not, in certain circumstances, be dominated by one or more of its components.
  33. Furthermore, as is clear from paragraphs 38 to 48 of the contested judgment, the Court, in order to decide whether the two marks are similar from the point of view of the relevant public, devoted a significant part of its reasoning to an appreciation of their distinctive and dominant components and of the likelihood of confusion on the part of the public, a likelihood which it appreciated globally, taking into account all of the factors relevant to the circumstances of the case.
  34. Moreover, by maintaining that the Court, in a misinterpretation of the facts of the case, held that the word MATRATZEN constitutes the dominant element of the trade mark applied for, Matratzen is in fact merely challenging the Court's appraisal of the facts without, however, alleging any distortion of the evidence before the Court. That appraisal does not constitute a point of law which is subject, as such, to review by the Court of Justice on appeal [citations omitted].
24. In *Land Securities plc's Application* Land Securities applied to register the trade mark CARDINAL PLACE in respect of various services in Class 36.

The Registrar refused to accept the application on the ground that there was a likelihood of confusion with two earlier trade marks both of which consisted of the word CARDINAL in slightly stylised form registered for various services in Class 36. Mr Hobbs, who observed in paragraph 20 of his decision that “the Registrar acts as a watchdog not a bloodhound when raising *ex officio* objections to registration on relative grounds”, allowed an appeal. It does not appear from his decision that either the judgment of the Court of First Instance or the reasoned order of the Court of Justice in *Matratzen* was cited in argument, although I would expect Mr Hobbs to have been acquainted with them.

25. On the appeal Land Securities offered to limit the specification of services for which it sought registration, but Mr Hobbs concluded that there was nevertheless an overlap between the services covered by the earlier registrations and the services in respect of which registration was sought. Mr Hobbs went on:
  12. The marks in issue are not identical. In order to resolve the objection to registration it was necessary to assess the net effect of the differences and similarities between them from the perspective of the average consumer of the services concerned. Each mark had to be considered without excision or dismemberment. The differences and similarities has to be given as much as little significance as the average consumer would have attached to them at the date of the application for registration.
  13. I agree with the hearing officer in thinking that the mark graphically represented in the earlier trade mark applications possesses a high degree of distinctive character per se and that the word CARDINAL is the dominant and distinctive feature of it from a visual, aural and conceptual point of view.
  14. However, I am not comfortable with his finding that the word CARDINAL operates with no change of meaning as the dominant and distinctive element of the Applicant’s mark.
  15. The perceptions and recollections triggered by the earlier mark are likely to have been ecclesiastical whereas the perceptions and recollections triggered by the Applicant’s mark are likely to have been locational as a result of the qualifying effect of the word PLACE upon the word CARDINAL. A qualifying effect of that kind can be quite powerful as indicated by the examples cited in argument on behalf of

the Applicant: SOMERSET as compared with SOMERSET HOUSE; COUNTY as compared with COUNTY HALL; CANARY as compared with CANARY WHARF.

16. This accounts for the hearing officer's finding that there is a degree of conceptual dissimilarity between the marks. His finding that the marks were unlikely to be directly confused also appears to recognise (and I would agree) that the conceptual dissimilarity is sufficient to render the visual and aural differences significant from the perspective of the average consumer.
17. So why should it be thought that the visual, aural and conceptual differences are sufficiently significant to render the marks distinguishable, but not sufficiently significant to enable them to be used concurrently without giving rise to a likelihood of confusion? This, to my mind, is the critical question. The answer to it depends on how much or how little the word PLACE would be likely to contribute to the distinctive character of the mark CARDINAL PLACE taken as a whole.
18. As I have already indicated, the hearing officer addressed this point to the following effect:

'... the addition of the word PLACE to the applicant's mark is, to my mind, allusive when used in relation to property, buildings etc. and as the applicant's services include property management and investment the word PLACE is not a particularly strong distinguishing feature. The word CARDINAL in my view is a strong trade mark for these services ... The meaning of the word CARDINAL does not, in my view change when used in the applicant's mark.'

However, his characterisation of the Applicant's mark as the allusive word PLACE added to the strong trade mark CARDINAL appears to me to be open to the objection that it effectively ignores the blend of meaning and significance produced by combining the word CARDINAL with the word PLACE in the designation CARDINAL PLACE.

19. Having held that the visual, aural and conceptual differences were sufficient to render the marks distinguishable, the hearing officer ought to have recognised that the underlying reason for that conclusion (i.e. the perceptions and recollections triggered by the designation CARDINAL were essentially ecclesiastical whereas those triggered by the designation were essentially locational) pointed to the further conclusion that the marks could be used concurrently without giving rise to a likelihood of confusion.

26. In my judgment this decision is simply an application of the principles laid down by the Court of Justice in *SABEL*, *Canon*, *Lloyd* and *Marca Mode* to the particular facts of the case. The proprietor's attorney accepted that in the second sentence of paragraph 15 of his decision Mr Hobbs was not purporting to lay down a universal rule, as is clear from his careful use of the words "can be". Furthermore, the applicant's attorney pointed out that the examples given in that sentence all involves place names which are well known to Londoners and which have largely, if not entirely, lost any association that they may once have had with the word which comprises the first part of the name.
27. In *Reemark v OHIM* (cited above) BMG Music applied to register WESTLIFE as a Community trade mark in respect of goods and services in Classes 9, 16, 25 and 41. Reemark Gesellschaft für Markenkooperations mbH opposed the application on the basis of an earlier German registration of the mark LIFE in Classes 9, 16, 25 and 41. The Opposition Division upheld the opposition. The Second Board of Appeal allowed an appeal from this decision and dismissed the opposition. The Court of First Instance allowed Reemark's appeal against the Board of Appeal's decision.
28. In paragraph 26 of its judgment the Court stated:
- It is clear from the case-law that the global assessment of the likelihood of confusion between the trade marks must, as regards the visual, aural or conceptual similarity of the signs in question, be based on the overall impression created by them, bearing in mind, in particular, their distinctive and dominant components (see, by analogy, Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 23, and Case C-342 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 25).
29. In paragraphs 28-30 the Court considered the conceptual similarities between the respective marks, in paragraphs 31-33 the aural similarities and in paragraphs 34-35 the visual similarities. In each case it concluded that there was some degree of similarity. In paragraph 36 the Court held that in the mark applied for neither WEST nor LIFE was dominant.
30. The Court went on:

37. It must also be borne in mind that the Court of First Instance has already held that, on an initial analysis, where one of the two words which alone constitute a word mark is identical, both visually and aurally, to the single word which constitutes an earlier word mark, and where those words, taken together or in isolation, have no conceptual meaning for the public concerned, the marks at issue, each considered as a whole, are normally to be regarded as similar (Case T-286/02 *Oriental Kitchen v OHIM – Mou Dybfrost (KIAP MOU)* [2003] ECR II-000, paragraph 39).
38. In this instance one of the two words which alone constitute the word mark applied for is actually identically in appearance to the sole word forming the earlier word mark. Aurally, there is a degree of similarity, although the pronunciation of the word WEST is not identical, at least as regards the whole of the relevant public. In this instance, the two words forming the mark WESTLIFE mean something to the relevant public but they do not describe either the goods or the services in question or their qualities and therefore do not have any particular connotation in relation to them.
39. Although the approach described in paragraph 37 above is not therefore directly applicable in this case, it must none the less be stated that the only visual difference between the two word marks at issue is that one of them contains a further element added to the first. Moreover, as stated above, there is a degree of similarity between the two marks in aural terms and, in particular, in conceptual terms.
40. It must therefore be held, in this case, that the fact that the WESTLIFE trade mark consists exclusively of the earlier WEST trade mark, to which another word, LIFE, has been added, is an indication that the two trade marks are similar.
31. In paragraph 42 the Court held that the relevant public might well perceive WESTLIFE as a variant of the earlier trade mark. Accordingly it held in paragraph 43 that there was a likelihood of confusion.
32. In *Medion v Thomson* (cited above) Medion AG was the proprietor of the German trade mark LIFE registered for electronic entertainment goods. It claimed that Thomson multimedia Sales Germany & Austria's use of the sign THOMSON LIFE in relation to such goods was an infringement of its registration. The first instance court dismissed the claim, holding that there was no likelihood of confusion. Medion appealed and the appeal court referred a question to the Court of Justice as to the circumstances in which a composite

mark which includes a trade mark should be held to give rise to a likelihood of confusion within the meaning of Article 5(1)(b) of the EC Trade Marks Directive. The question was prompted by the *Prägertheorie*, a doctrine developed by the Bundesgerichtshof.

33. In paragraph 17 of his opinion the Advocate General observed:

As a preliminary point I am not convinced that a specific theory which formally articulates a set of rule to apply automatically in certain cases is always, or necessarily, a useful approach to determining the outcome of a given trade mark conflict. In my view the principles which the Court has already laid down in its series of rulings on the relevant principles of the Directive, Articles 4(1)(b) and 5(1)(b) provide a sufficient conceptual framework for the resolution of such conflicts. Reliance upon a theoretical answer to my mind carries the risk that national courts may be diverted from themselves applying the essential tests of similarity and confusion which have been laid down by the Community legislature and developed by the Court. Where however a theory simply provides relevant guidance on how to apply those essential tests in a given area or to particular categories of marks, I consider that it may none the less be helpful provided that the national court always bears in mind that, ultimately, it must ensure that the principles laid down by the Court are applied in a given situation.

34. In paragraphs 18-25 the Advocate General summarised the principles laid down in *SABEL*, *Canon*, *Lloyd* and *Marca Mode*.

35. In paragraph 26 the Advocate General noted that the Court of Justice had not had occasion to rule directly on the criteria for determining whether a composite mark which included an earlier mark was confusingly similar to the earlier mark, but pointed out that its reasoned order in *Matratzen v OHIM* related to such a situation. In paragraphs 27-31 he cited from the judgment of the Court of First Instance and the Court of Justice's reasoned order. In paragraph 32 he drew the following conclusion:

It appears therefore that the Court has endorsed an approach similar to the *Prägertheorie*, which essentially consists in comparing the overall impression conveyed by two conflicting marks one of which is a component of the other. That to my mind is perfectly understandable, since it can be regarded as an application to a particular category of cases of the principles articulated in the Court's earlier case law. That

case-law, it will be recalled, calls for a global appreciation based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components: *SABEL*, paragraph 23. The Court's statement in *Matratzen* that the overall impression of a composite mark may, in certain circumstances, be dominated by one or more of its components reflects that proposition. The extent to which the overall impression is so dominated is a question of fact for the national court.

36. In paragraphs 33-35 the Advocate General considered *Reemark v OHIM*. In the first sentence of paragraph 36 he pointed out that the fact that the Court of First Instance considered that WESTLIFE and WEST were confusingly similar in the circumstances of that case did not necessarily mean that THOMSON LIFE and LIFE were confusingly similar in the circumstances of the instant case. In the remainder of paragraph 36 and in paragraphs 37 and 38 he reiterated that it was for the national court to apply the principles laid down by the Court of Justice which he had previously discussed.
37. The conclusion I draw from this review of the case law is that there are no special rules to be applied when comparing a composite mark which includes an earlier mark with the earlier mark. The principles laid down in *SABEL*, *Canon*, *Lloyd* and *Marca Mode* remain the applicable principles. In particular, the tribunal must consider the overall impression given by each mark as a whole bearing in mind its distinctive and dominant components. In some cases the overall impression given by a composite mark may be dominated by one component of that mark.

#### *The present case*

38. On this basis, I am not persuaded that the hearing officer made any error of principle in the present case. He applied the principles laid down by the Court of Justice to the facts of the case before him. In doing so he considered the overall impression given by each mark as a whole.
39. The principal focus of the proprietor's attack was the first sentence of paragraph 19 of the hearing officer's decision. The proprietor's attorney

argued that, while the hearing officer was correct to say that the proprietor mark suggests a geographical location, he was wrong to go on to say that it suggested a stream or river which buffalo frequent. She argued that he should have held that the overall impression conveyed by BUFFALO CREEK was of a location while the overall impression conveyed by BUFFALO was of a large animal. In my judgment, however, the first sentence of paragraph 19 of the hearing officer's decision does not disclose an error of principle on the part of the hearing officer. It was an assessment of the impression conveyed by the mark BUFFALO CREEK as a whole which he was entitled to make. It appears from this that he did not consider that either component of the mark was dominant but that both components contributed to the overall impression. The hearing officer did not make the mistake made by the hearing officer in *Land Securities* of proceeding on the basis that the addition of the second word did not qualify the meaning of the first word. On the contrary, he recognised that the combination primarily designated a location.

40. Furthermore, the hearing officer's assessment did not stop at paragraph 19. In paragraph 25 he reiterated that there were conceptual differences as well as similarities between the marks, but concluded that overall the similarities outweighed the differences. As the applicant's attorney argued, it is clear that he took particular account of the visual similarity between the marks, such as it was, because the goods under consideration were clothing and similar items. He was justified in doing so having regard to the decisions of Simon Thorley QC sitting as the Appointed Person in *REACT Trade Mark* [2000] RPC 285 of the Court of First Instance in Joined Cases T-117/03 to T-119/03 and T-171/03 *New Look Ltd v OHIM* [2005] ETMR 35 at paragraphs 49-50. In my judgment his assessment that the similarities outweighed the differences was one which he was entitled to make.
41. It follows that there is no basis for impeaching the hearing officer's conclusion that there was a likelihood of confusion. He did not state whether the sort of confusion he had in mind was the possibility that the proprietor's mark might be mistaken for the applicant's or the possibility that the first might be taken for a variant of the second, but in my judgment it was not essential for him to



do so. He was clearly of the view that at least one form of confusion was likely and that is sufficient.

Conclusion

42. The appeal is dismissed.

Costs

43. The hearing officer ordered the proprietor to pay the applicant the sum of £2000 as a contribution to its costs of the opposition. I shall order the proprietor to pay the applicant the sum of £1000 in respect of the costs of the appeal, making a total of £3000.

17 June 2005

RICHARD ARNOLD QC

Margaret Arnott of Mathys & Squire appeared for the proprietor.

Keith Hodkinson of Marks & Clerk (Leeds) appeared for the applicant.