

O-191-04

TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION No 2161371  
BY THE HON. MRS FRANCES SHAND KYDD, THE LADY SARAH  
MCCORQUODALE THE EXECUTRICES OF THE ESTATE OF DIANA,  
PRINCESS OF WALES, DECEASED.  
TO REGISTER THE TRADE MARK  
**DIANA**  
IN CLASSES 3, 4, 12, 18, 20, 21, 24, 25, 26, 27, 28, 30, 39, 41 & 42,  
  
AND IN THE MATTER OF OPPOSITION THERETO  
UNDER NUMBER 50459  
BY DALAN KIMYA ENDUSTRI A.S.

## BACKGROUND

1) On 18 March 1998, The Hon. Mrs Frances Shand Kydd, The Lady Sarah McCorquodale the Executrices of the Estate of Diana, Princess of Wales, Deceased, (hereafter referred to as the applicants) of Callinesh, Isle of Seil, Oban, Scotland, and Grange Farm, Stoke Rochford, Grantham, Lincs, NG33 5BD applied under the Trade Marks Act 1994 for registration of the following trade mark:



2) Registration was sought in respect of goods in Classes 3, 4, 12, 18, 20, 21, 24, 25, 26, 27, 28, 30, 39, 41 & 42. However, as the opposition relates only to the Class 3 goods I shall only detail that part of the specification:

Class 3: "Toilet water; essential oils, but excluding essential oils for food; perfumes; cosmetics; cosmetic kits; beauty masks; perfumery; lipsticks; nail varnish and polish."

3) On the 30 November 1999 Dalan Kimya Endustri A.S. of Kemalpasa Cad. No.9, Pinarbasi 35060, Izmir, Turkey filed notice of opposition to the application. The grounds of opposition are in summary:

a) The opponent is the proprietor of Community Trade Mark 375253 "Diana" for goods in Classes 3, 5 and 16. Therefore, the application offends against Sections 5(1) & 5(2)(b) of the Trade Marks Act 1994.

4) The applicants subsequently filed a counterstatement denying the opponent's claims.

5) Neither side filed evidence, both ask for an award of costs. Neither side wished to be heard although both provided written submissions. I shall refer to these submissions as and when relevant in my decision.

## DECISION

6) The grounds of opposition are under Sections 5(1) and 5(2)(b) which read:

"5.-(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(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.”

7) An “earlier trade mark” is defined in Section 6, the relevant parts of which state:

“6.-(1) In this Act an "earlier trade mark" means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,”

8) The opponent is relying on Community Trade Mark Registration No 375253 “Diana” registered with effect from 27 September 1996, which is plainly an “earlier trade mark”.

9). In determining the question under Section 5(1) I look to the recent decision of the European Court of Justice (ECJ) in the *LTJ Diffusion SA v Sadas* case C-291/00 [2003] FSR 34 where at paragraphs 49-54 they stated:

“49. On the other hand, Article 5(1)(a) of the directive does not require evidence of such a likelihood in order to afford absolute protection in the case of identity of the sign and the trade mark and of the goods or services.

50. The criterion of identity of the sign and the trade mark must be interpreted strictly. The very definition implies that the two elements compared should be the same in all respects. Indeed, the absolute protection in the case of a sign which is identical with the trade mark in relation to goods or services which are identical with those for which the trade mark is registered, which is guaranteed by Article 5(1)(a) of the directive, cannot be extended beyond the situations for which it was envisaged, in particular, to those situations which are more specifically protected by Article 5(1)(b) of the directive.

51. There is therefore identity between the sign and the trade mark where the former reproduces, without any modification or addition, all the elements constituting the latter.

52. However, the perception of identity between the sign and the trade mark must be assessed globally with respect to an average consumer who is deemed to be reasonably well informed, reasonably observant and circumspect. The sign produces an overall impression on such a consumer. That consumer only rarely has the chance to make a direct comparison between signs and trade marks and must place his trust in the imperfect picture of them that he has kept in his mind. Moreover, his level of attention is likely to vary according to the

category of goods or services in question (see, to that effect, Case C-342/97 Lloyd Schuhfabrik Meyer [1999] ECR I-3819, paragraph 26).

53. Since the perception of identity between the sign and the trade mark is not the result of a direct comparison of all the characteristics of the elements compared, insignificant differences between the sign and the trade mark may go unnoticed by the average consumer.

54. In those circumstances, the answer to the question referred must be that Article 5(1)(a) of the directive must be interpreted as meaning that a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

10) For ease of reference I reproduce the marks of the two parties below:

Applicants' Trade Mark	Opponent's Trade Mark
	Diana

11) Clearly the two marks are for the same word “Diana”. However, one is hand written in a stylised manner whereas the other is the word in normal typeface. They are identical in aural and conceptual terms but there are visual differences which are more than “insignificant differences”. In my view the average consumer would see this difference and would not regard the marks as identical. The opposition based upon Section 5(1) fails.

12) I now turn to the ground of opposition based upon Section 5(2)(b). In determining the question under this section, I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel Bv v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer 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. 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* page 224;

(b) the matter must be judged through the eyes of the average consumer, of the goods / services in question; *Sabel Bv v Puma AG* page 224, 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.* page 84, paragraph 27;

(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* page 224;

(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* page 224;

(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-Meyer Inc.* page 7 paragraph 17;

(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* page 8, paragraph 24;

(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* page 224;

(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* page 732, paragraph 41;

(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-Meyer Inc.* page 9, paragraph 29.

13) In essence the test under Section 5(2) is whether there are similarities in marks and goods and/or services which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgements of the European Court of Justice mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods and/or services, the category of goods and/or services in question and how they are marketed. Furthermore, I must compare the mark applied for and the opponent's registration on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods and services covered within the respective specifications.

14) The applicants accept that the goods in Class 3 are the same and/or similar.

15) Earlier in this decision I compared the marks and found that they were not identical. The applicants contend that the mark in suit will be perceived as a signature and there is thus a conceptual difference between the mark in suit and the opponent's mark. They also contend that "signatures are recognised as the unique identifier of a

particular individual”, whereas they describe the opponent’s mark as being “a plain word mark, and as such is effectively ‘origin neutral’”.

16) Whilst I accept that the mark in suit will be seen as a stylised version of the word “Diana” and possibly a signature I do not accept that there is a conceptual difference. Both are clearly the word or name “Diana”. The average consumer would view both as “Diana” marks. Though there are visual differences, they are conceptually and aurally identical. Therefore, given that the respective goods are at least similar it seems to me that it must follow that the ground of opposition under Section 5(2)(b) is made out. Registration of the applicants’ trade mark is likely to lead to confusion on the part of the public. The application for registration is therefore refused in respect of the goods in Class 3.

17) As grounds for refusal exist only in respect of the goods in Class 3 the application will be allowed to proceed to registration if, within one month of the end of the appeal period for this decision, the applicants file a TM21 restricting the specification to the goods in Classes 4, 12, 18, 20, 21, 24, 25, 26, 27, 28, 30, 39, 41 & 42. If the applicant does not file a TM21 restricting the specification as set out above the application will be refused in its entirety.

18) The opposition having been successful I order the applicants to pay the opponent the sum of £1000. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 5<sup>th</sup> day of July 2004

George W Salthouse  
For the Registrar,  
the Comptroller-General