

O-216-08

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2436523
BY LP DESIGNS
TO REGISTER THE TRADE MARK:**

The image shows a stylized, cursive logo for 'LUCKY PUNKY'. The letters are written in a bold, black, handwritten style. The 'L' is particularly large and prominent. Below the main text, there is a lightning bolt symbol, also rendered in a cursive, hand-drawn style.

IN CLASS 25

AND

**IN THE MATTER OF OPPOSITION NO 95265
BY LUCKY BRAND DUNGAREES, INC.**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2436523
by LP Designs
to register a trade mark in Class 25**

and

**IN THE MATTER OF Opposition No 95265
By Lucky Brand Dungarees, Inc.**

BACKGROUND

1. On 23 October 2006 LP Designs (“LP”) applied to register the following trade mark for the following goods:



Class 25 – Printed T-shirts, babies' clothing, sweatshirts, headwear, belts, wrist bands.

2. On 11 June 2007 Lucky Brand Dungarees, Inc. (“LBD”) opposed the above application on the sole ground of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”); LBD rely on the three earlier trade marks detailed below.

| Trade Mark | Relevant Dates | Specification |
|---|---|---|
| UK Registration 1548629 LUCKY BRAND The following disclaimer has been entered: Registration of this mark shall give no right to the exclusive use of the word "Brand". | Filed: 24/9/93 Registered: 1/12/95 | Shirts, blouses, t-shirts, tank tops, vests, sweaters, dresses, skirts, jumpers, jumpsuits, rompers, overalls, jackets, blazers, sports coats, boxer shorts, pants, jeans, shorts, leggings, sweatshirts, sweat pants, sweat suits, jogging suits, suits, rain coats, snow suits, sleepwear, socks, hosiery, tights, leotards, bodysuits, shoes, boots, sneakers, sandals, slippers, ties, gloves, mittens, belts, aprons, bandannas, swimwear, headbands, suspenders, robes, lingerie, scarves, hats, caps and visors; all included in Class 25. |

| | | |
|---|--|--|
| <p>CTM¹ Registration 003512365</p>  | <p>Filed: 31/10/2003</p> <p>Registered: 20/04/2005</p> | <p>Class 03: Perfume and cosmetics.</p> <p>Class 09: Eyewear.</p> <p>Class 14: Jewelry and watches.</p> <p>Class 18: Handbags, wallets, change purses, luggage, backpacks and tote bags.</p> <p>Class 25: Clothing, footwear and headgear.</p> |
| <p>CTM Registration 003952041</p>  <p>The colour red is claimed as an element of the mark.</p> | <p>Filed: 28/07/2004</p> <p>Registered: 6/10/2005</p> | <p>Class 35: Retail store services.</p> |

3. LP filed a counterstatement denying the grounds of opposition.

4. Both sides filed evidence, this is summarised below. LBD initially requested a hearing, but it rescinded its request, opting instead to file written submissions. Written submissions were also filed by LP. All submissions will be drawn upon and taken into account, but I do not intend to summarise them separately.

LBD's evidence

Witness statement of Felicity Kate Hyde

5. Ms Hyde is a trade mark attorney working for Boulton Wade Tennant, LBD's representatives in this matter. She attests to a visit to the *Selfridges* department store on 6 November 2007 where LBD had informed her that its products were to be found on sale. Ms Hyde states that the products were on sale in a department containing various items of casual/urban clothing and that LBD's goods were, in her opinion, directed at younger members of the public.

6. Ms Hyde states that during her visit to *Selfridges* she purchased a t-shirt and a pair of jeans bearing LBD's LUCKY BRAND trade mark. Photographs of the LUCKY BRAND trade mark, as it appeared on these garments, are provided in Exhibits FKH1 & FKH2. In relation to the t-shirt, I note the following: the word LUCKY, together with a device of a stars and stripes decorated spade (the heart shaped variety used on playing cards) appears on the front of the t-shirt; a swing-tag with the words LUCKY BRAND JEANS

¹ Community Trade Mark

(one word above the other, each word having equal dominance) in what I would describe as a curvy font; a neck label with the words LUCKY BRAND in an italicised font. In relation to the jeans, I note the following: there is a label on what could be the inside of the jeans (its position is not clear) with the words LUCKY BRAND in a relatively plain font (the words are one above the other but they are separated with the words “Good Luck TO THE OWNER” between them); a similar swing label to the one appearing on the t-shirt is also present; a traditional leather style label on the waist band is also shown with the words LUCKY BRAND DUNGAREES (the word LUCKY has much greater visual dominance); there is a long sticky label down the leg of the jeans which features the version of the mark as depicted in CTM registration 003512365, and also the words LUCKY BRAND in a basic (although not plain) font and another repetition of the words in a font reminiscent of a signature; finally, there is an inner label featuring the words LUCKY BRAND in an italicised font.

7. She completes her evidence by stating her belief that, from her visit to the store and from the goods that she has seen bearing LBD’s trade mark, that consumers of these goods will be used to seeing the mark in a variety of different stylisations and presentations in relation to urban/casual clothing directed at the younger end of the market.

LP’s evidence

Witness statement of Mark Skeggs

8. Mr Skeggs is a joint partner in LP. He states that LP’s clothes have been sold through its web-site and its *EBay* store and not through *Selfridges* or any other department store. Sales are said mainly to be in relation to t-shirts for adults and babies, and hooded sweatshirts and caps. He states that LP’s range is themed towards music lovers with its designs bearing a relevance to songs, musical instruments and music artists; the tag line “music flavoured fashion” is said to be used on its web-site and clothing tags. The range of clothing is said to have a teen to middle age audience but also includes babies’ clothes.

9. Mr Skeggs states that LP’s garments bear the mark as sought to be registered on the inside back of the collar and it also appears on a swing label attached to the garments. He states that the label is only ever used in one stylisation (in the form applied for) and that the word LUCKY does not dominate this; “LUCKY PUNK” is the brand LP is trying to establish. Exhibit MS1 is a photograph of the neck label.

10. At Exhibits MS2 & MS3 there are pictures of t-shirts, one bearing the sign *Jakes Lucky 7* and the other *Super Lucky 7*. These are exhibited to support Mr Skeggs view that there are many t-shirt producers who sell t-shirts bearing the word “lucky”. He states that LBD’s claim is unjust as they appear to want to claim a monopoly in the word “lucky” in any shape or form. Mr Skeggs states that LP do not produce any designs that emphasise the word “lucky”, nor do they use any designs that use signs (clovers, charms etc) that are references to the word “lucky”. He completes his evidence by stating that the examples of

use of LBD's trade mark demonstrated in Ms Hyde's evidence is from after the relevant date.

LBD's reply evidence

11. Ms Hyde gives reply evidence on behalf of LBD. She states that the use of the tag-line "music flavoured fashion" highlights that within the context of the applicant's mark the word PUNK functions as a reference to a style of music which influences the applicant's clothing designs.

12. To counter Mr Skeggs' claim that LP's trade mark is not used in any other form of stylisation, she refers to various prints (shown in FKH1 of this, her second witness statement) obtained from LP's *EBay* shop. One shows the word LUCKY with nothing below it and the other, the word LUCKY with the word PUNK below; Ms Hyde explains that the letters in PUNK appear one by one until the words LUCKY PUNK are fully displayed, thus, she feels that the word LUCKY is being given greater prominence. The same prints also have an entry for products described as "Lucky Lyric t-shirts", and also an entry for the words LUCKY PUNK in plain lettering.

13. Ms Hyde also refers to FKH2 which features a product described as a "BORN LUCKY BABY TEE" which features the words BORN LUCKY on the front of the garment. This is filed to counter Mr Skeggs' statement that LP do not use any designs that emphasise the word "lucky". She completes her evidence by stating that normal and fair use of LP's mark must be taken into account and that the actual use of the mark is relevant to this question, giving, as it does, greater prominence to the word LUCKY. She also states that LP's use is relevant because it stresses the descriptive qualities of the word PUNK in relation to its products.

DECISION

Section 5(2)(b)

The law

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

"5.-(2) A trade mark shall not be registered if because –

(a)

(b) it is similar to an earlier trade mark and it 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."

15. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which read:

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

(a) a registered trade mark, international trade mark (UK), Community trade mark or International trade mark (EC) 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.

16. Of potential relevance to a ground of opposition under section 5(2) are the provisions that relate to proof of use. Section 6A² of the Act reads as follows:

6A Raising of relative grounds in opposition proceedings in case of non-use

(1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if -

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

² Section 6A was added to the Act by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004 (SI 2004/946) which came into force on 5th 2004.

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects -

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4)(relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).

17. All of LBD's trade marks were filed before LP applied for its trade mark. Therefore, they all constitute earlier trade marks as defined in section 6(1) of the Act. In relation to the proof of use requirements, only one of the earlier trade marks (UK Registration 1548629) was registered five years or more before the date of publication of LP's trade mark; the proof of use provisions therefore apply to registration 1548629. LBD claimed in its statement of grounds that registration 1548629 had been put to use in the relevant period in relation to "shirts, t-shirts, jeans, sweatshirts". LP did not deny this claim or put LBD to proof. I must therefore accept the claim and I will assess the matter, in relation to any potential conflict with 1548629, on the basis of the goods claimed to have been used. The other earlier trade marks will be assessed on the basis of the goods covered by their actual specifications.

18. When reaching my decision I have taken into account the guidance provided by the European Court of Justice ("ECJ") in a number of judgments relating to article 7(2) of the Directive (section 5(2) as incorporated into the Act), notably in: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Mayer & 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. All of these judgments were highlighted in LBD's submissions. I would, however, add to the above list the judgment of the ECJ in *Shaker di L. Laudato & Co. Sas* (C-334/05). It is clear from all these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all the relevant factors: *Sabel BV v. Puma AG*, paragraph 22;

(b) the matter must be judged through the eyes of the average consumer of the good/services in question; *Sabel BV v. Puma AG*, paragraph 23, who is deemed to be reasonably well informed and 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* 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*, paragraph 23;

(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*, paragraph 23;

(e) when considering composite marks, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element; *Shaker di L. Laudato & Co. Sas (C-334/05)*, paragraph 42;

(f) 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*, paragraph 17;

(g) 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*, paragraph 24;

(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*, paragraph 26;

(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 + Adidas Benelux BV*, paragraph 41;

(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*, paragraph 29.

Relevant public and the purchasing act

19. As matters must be judged through the eyes of the relevant, average consumer (*Sabel BV v. Puma AG*, paragraph 23) it is important that I assess who this is. Both sets of goods cover various items of clothing. Although not expressly limited, the respective specifications cover, for the most part, articles of casual wear. Generally speaking, all items of clothing, particularly casual wear, are general consumer items purchased by the general public at large.

20. Both parties have referred to their target consumer, both appear to target the young to middle aged consumer. Whilst these types of consumer are part of the relevant consumer group, it is important that I do not limit my analysis to a particular target group given that the subjective circumstances surrounding the current marketing initiatives of either party may

change with time³. It is the notional use of the trade marks for the goods sought that must be assessed which could, inevitably, include the purchase of the goods by consumers not in this target group. However, this is not particularly significant because whatever way I assess it, the average consumer will be the same for both LP's and LBD's goods.

21. The average consumer, as I have said, will be a member of the general public and, from my experience, will possess a reasonable degree of brand awareness which equates, in my view, to reasonable degree of care and attention being applied during the purchasing process. The case-law⁴ also informs me that in relation to clothing, it is the visual impression of the trade mark that is most important given that the goods are normally selected from a clothes rail or a catalogue etc. rather than by oral request. However, this does not equate to visual similarity being the only relevant factor to consider; it is merely a question of weight.

Similarity of goods/services

22. All relevant factors relating to the goods in the respective specifications should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the ECJ stated at paragraph 23:

‘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 intended purpose and their method of use and whether they are in competition with each other or are complementary.’

23. Other factors may also be taken into account such as, for example, the distribution channels of the goods concerned (see, for example, paragraph 53 of the judgment of the Court of First Instance of the European Communities (“CFI”) in Case T-164/03 *Ampafrance v OHIM – Johnson & Johnson (monBeBé)*).

24. In submissions, LBD states that its best case is on the basis of UK Registration 1548629. Therefore, I will focus this, and all further analyses, on this earlier mark. I will, of course, refer to the other earlier marks should any of my findings require me to do so. For ease of reference, the goods being compared are:

LP's goods - Printed T-shirts, babies' clothing, sweatshirts, headwear, belts, wrist bands.

LBD's goods - Shirts, t-shirts, jeans, sweatshirts

25. As can be seen, some of LP's goods (printed t-shirts and sweatshirts) are identical to goods covered by LBD's specification. In relation to LP's “babies' clothing”, some of the

³ See to that effect the judgment of the Court of First Instance of the European Communities (“CFI”) in *Devinlec Développement Innovation Leclerc SA v OHIM* Case T- 147/03

⁴ See *Société provençale d'achat and de gestion (SPAG) SA v OHIM* Case T-57/03 and *React Trade Mark* [2000] RPC 285.

goods covered by this term are also identical (insofar as the term covers baby versions of shirts, t-shirts, jeans and sweatshirts). There is the potential for other goods within the ambit of “babies’ clothing” to only be similar (to varying degrees) to LBD’s goods (or even not similar at all), however, no such goods have been particularised and it is sufficient as a finding that LP’s babies clothing covers identical goods to LBD’s goods.

26. This leaves LP’s “headwear, belts and wrist bands”. LBD stated in its grounds of opposition and in its submissions that the remaining goods are strongly similar to the goods covered by its specification. It comes to this view because it says the goods are of the same nature, have the same purpose, are distributed through the same trade channels and have the same end users. LP have not commented on the degree, or otherwise, of the similarity. To some extent, all items of clothing are similar to a degree, however, the degree of similarity will vary according to the goods being compared. For example, in comparison to a pair of jeans, a wedding dress is unlikely to be regarded as highly similar whereas a pair of cords will.

27. In terms of LP’s headwear, I am conscious that this would include items such as baseball caps and beanie style hats. In comparison to LBD’s goods, they share the fact that they are all items of outerwear, albeit, they differ in terms of the parts of the body which they clothe. They are all manufactured from materials such as cotton and denim etc, although, the nature differs in shape due to the part of the body on which they are worn. The goods are what I would describe as casual wear and, from experience, these types of headwear are often sold in the same establishments as other types of casual wear. The goods are not in competition, and, although one is not necessarily indispensable for the use of the other, there is a degree of aesthetic complementarity⁵. As with babies’ clothing, there may be goods within LP’s headwear that may be similar to only a small degree (or not similar at all), however, no such goods are particularised. I must, therefore, find that LP’s headwear covers goods which are reasonably similar to LBD’s goods.

28. In relation to LP’s belts, this, again, is categorised as an item of clothing but one which does not really clothe in the normal understanding of the word, and one which has a slightly different functional nature. However, the degree of complementarity (particularly in comparison to LBD’s jeans) is much higher due to functional and aesthetic considerations. I consider these goods to be reasonably similar.

29. LP’s “wrist bands” present a more difficult proposition given that no evidence has been filed to tell me what these are; my personal experience does not assist. However, the inherent properties of the words inform me that they are likely to be items of what could best be described as accessories that clothe the wrist. These do not strike me as being highly similar to items of clothing such as jeans and t-shirts. Although there may be a degree of aesthetic complementarity, I have no evidence before me as to whether these items are likely to be sold through the same establishments. On this basis, I consider that any similarity must be low.

⁵ The relevance of this factor is highlighted by the CFI in its judgment in *El Corte Inglés SA v OHIM* (Case T-443/05).

Similarity of trade marks

30. When assessing this factor I must do so with reference to the visual, aural and conceptual similarities between the respective trade marks bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*, para 23). For ease of reference, the respective trade marks are:

LP's trade mark



LBD's trade mark

LUCKY BRAND

31. On visual similarity, LBD submits that the word LUCKY is the dominant and distinctive element of both marks. It comes to this view because it says consumers pay more attention to the beginnings of marks (to support this, reference is made to the judgment of the CFI in *Citigroup, Inc v OHIM* (Case T-325/04) and a number of UK Registry decisions). LBD also states that notional and fair use of its mark would include use in different forms and would include use where the LUCKY element may be stressed more (as demonstrated in its evidence). Similar submissions are made in relation to aural similarity, but LBD adds that the word PUNK has even less aural significance because it is a shorter word than LUCKY.

32. LBD also refers to the judgment of the ECJ in *Medion AG V Thompson Multimedia Sales Germany & Austria GmbH* (Case C-120/04) ("*Medion*"). In this judgment, the ECJ indicated that the overall impression of a mark may be dominated by one or more of its components and, further, that a component may play an independent distinctive role in the mark without necessarily constituting the dominant element of it. In this regard, LBD submits that the removal of the word LUCKY would have a significant impact on the visual perception of either mark which, consequently, means that the word LUCKY is an essential part of the mark playing an independent distinctive role.

33. LBD's submissions on conceptual similarity are that the word LUCKY dominates both the concept of its earlier mark (given the non-distinctive nature of the word BRAND) and also the concept that underpins LP's mark given that the word PUNK will be seen as a reference to a particular style of music and fashion. LBD highlights the evidence demonstrating how LP's mark is used, such use portraying a music related theme. LBD also states that any further conceptual meaning can only be that the consumer may recognise the line "do you feel lucky, punk?" from the film *Dirty Harry*. However, it says that even if this reference is recognised, the consumer will also recognise that the words LUCKY and PUNK, in the context of this phrase, have a pause between them which stresses the semantically different functions of the two words.

34. For its part, LP states that the marks as a whole are not similar and that it would be wrong to allow LBD to monopolise the use of the word LUCKY.

35. In terms of notional and fair use, it is right that I should take into account the fact that LBD's mark may be used in different forms of presentation, but I do not agree that notional and fair use would include use which places greater stress or emphasis on a particular element of it. I also consider it appropriate to take into account the fact that LP's goods may have a music related theme and to consider the impact that this is likely to have on the consumer's perception of LP's mark; such use is, after all, the use which has been demonstrated. LBD states in evidence that LP's use emphasises the word LUCKY through use of the words LUCKY LYRIC and BORN LUCKY and the manner of display of a variant form of the LUCKY PUNK mark (where the letters in PUNK are displayed one by one). I note this, however, this goes beyond the realms of notional and fair use of the mark applied for and is therefore not relevant.

36. From a visual point of view, it is clear that both marks contain the word LUCKY and that this will be noticed by the eye. However, there is nothing in the presentation of the respective marks (even taking into account notional and fair use) which gives the word LUCKY a greater degree of visual impact compared to the words BRAND or PUNK. The existence of an additional word in the respective marks and the stylisation in LP's mark creates a noticeable point of visual difference. Similar observations apply in relation to aural similarity, although, I should add that I do not agree with LBD that the word PUNK has less aural significance due to its length; although it is a shorter word than LUCKY, it seems to me to have an equal degree of impact.

37. I have taken into account LBD's submission that the beginnings of marks may have more attention paid to them by the consumer. However, as indicated in the CFI judgment relied upon by LBD, even though the initial element may be slightly more pronounced in view of its position, all other factors (including its conceptual construction) need to be taken into account. Indeed, in the CFI's judgment in the cited case, although the word WORLD in the trade mark WORLDLINK was at the beginning of the mark, the fact that it played a qualifying role to the word LINK meant that the word LINK had more importance (without necessarily constituting the dominant and distinctive element) in the overall impression of the mark. In relation to visual and aural similarity, I find that there is some similarity (due to the common element LUCKY), but, given the points of difference, such similarity is not high.

38. This leads me to conceptual similarity. In relation to LBD's mark, I agree with it that the primary concept and significance relates to the word LUCKY. The word BRAND is a known and understood word relating to a product name. The whole, therefore, simply indicates a range of goods marketed under the word LUCKY, the word LUCKY meaning to have or to bring good fortune⁶. Taking this into account, I am happy to concur with LBD that the word LUCKY is the dominant and distinctive element of its mark and it is the element that will be focused upon and remembered by the average consumer.

⁶ Collins English Dictionary 5th Edition – definition 1.

39. In relation to LP's mark, I am conscious that the word PUNK is not only short for punk rock music⁷ but that it also indicates a person who is a follower or practitioner of it⁸. This is of significance because the word LUCKY is an adjective (a word which imputes a characteristic) which, in the context of the mark as a whole, could be seen as describing or qualifying a punk (a person). In other words, LUCKY PUNK is a phrase which indicates a follower of punk rock music who is also an individual of good fortune. I also take the view that the presentation inherent in LP's mark lends itself to it being seen as a self standing phrase even when used on music related goods. In my view, this is the conceptual meaning that the average consumer is likely to take rather than LBD's view that the word PUNK in the mark will simply function as a descriptive word.

40. LBD referred in its submissions to a line from the film *Dirty Harry* as the only other possible conceptual meaning and that the quotation indicates a pause between the two words, thus highlighting the semantic separation of the words rather than it standing as a single composite phrase. However, I can take little from this as there is no evidence to suggest that this phrase will be known by the average consumer. Anna Carboni (sitting as the Appointed Person) highlighted the danger in accepting too readily the knowledge that the average consumer may or may not possess in her decision in *Cherokee* BL-O-048-08; this is particularly relevant in this case given that the film to which LBD refers was made in the early 1970s. Having said that, even if this conceptual meaning was known, it still results in the concept relating to the whole phrase rather than any greater significance being placed on the word LUCKY. In view of all the above, the word LUCKY is not the dominant and distinctive element of the mark – the whole phrase performs this function.

41. In terms of conceptual comparison, although the concept of being lucky exists in both trade marks, I am left with LBD's mark relating purely to this concept whereas LP's mark relates to an individual as I have described above. This, in my view, cannot equate to a finding of conceptual similarity. This also has significance when assessing overall similarity because it has been held by the ECJ that conceptual differences can in certain circumstances counteract visual and aural similarities. In case C-361/04P (*Picaro/Picasso*) the ECJ, in paragraph 20 of its judgment, approved the following paragraph in the CFI's judgment (paragraph 56 of case T-185/02):

“Such conceptual differences can in certain circumstances counteract the visual and phonetic similarities between the signs concerned. For there to be such a counteraction, at least one of the signs at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately....”

42. Given all this, the visual and aural similarities that I have found (although these are not, in any event, high) are negated somewhat by the conceptual difference. Even though, as I have said in paragraph 21, the visual impression may be accorded more weight, the counteraction based on concept still operates. Overall, I consider any similarity between the respective trade marks to be minimal.

⁷ Collins English Dictionary 5th Edition – definition 4.

⁸ Collins English Dictionary 5th Edition – definition 2.

43. I should add that LBD referred in its submissions to the *Medion* case which highlights the principle that an element of a mark, even though it may not constitute the dominant and distinctive element, may nevertheless be an independent distinctive element within the mark as a whole. LBD submit that the word LUCKY will, at the least, be an independent distinctive element. In my view, such a finding can only be made if the element said to be independent and distinctive plays a truly independent role within the mark. Given my findings in relation to conceptual similarity and the qualifying role that the word LUCKY plays, I cannot find that the word LUCKY plays an independent role within LP's mark. The simple fact that the word LUCKY plays an important role in the mark as a whole does not mean, contrary to what LBD states, that it is playing an independent and distinctive role.

Distinctiveness of the earlier trade marks

44. The distinctiveness of an earlier mark is another important factor to consider because the more distinctive it is (based either on inherent qualities or because of the use made of it), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). LBD has filed no use of its mark (other than evidence demonstrating that LUCKY BRAND goods are currently offered for sale in *Selfridges*), therefore, I can only assess the inherent qualities of the mark. In its submissions in relation to the likelihood of confusion, LBD submits that the word LUCKY is not a natural or particularly apposite word to use in relation to clothing. There is some merit in this proposition. The word LUCKY does not describe or even allude to any characteristic of the goods. It is, therefore, a reasonably distinctive trade mark.

Likelihood of confusion

45. LBD submits that some of the goods are identical which, therefore, leads to a greater likelihood of confusion, and it repeats its view that LUCKY is the dominant and distinctive element of both marks or, at the very least, that the word LUCKY plays an independent and distinctive role in both. It says that the average consumer will see both marks as LUCKY marks. It also refers to the decision of the High Court in *Coco De Mer* [2004] EWCH 992 (Ch) ("*Coco De Mer*"), and it relies, in particular, on two statements in that decision, namely:

In paragraph 24, the test in that decision was whether:

“...when taken together, the combination of the conceptual, aural and visual characteristics of the mark left COCO as the strong and obvious element in it.”

In paragraph 27, when commenting on the stylisation and additional wording present in the *Coco De Mer* trade mark, it was stated that the additional elements:

“...are not, in my judgement, likely to be sufficient to negative the effect of COCO in the applied for mark when used on identical types of goods, particularly in a single retail outlet. It seems to me that the average consumer (particularly one with little prior experience of either mark) may

well assume that there is an economic link between the two products and that the goods bearing the COCO DE MER mark are simply a brand or variant of those marked COCO.”

46. LP summarises its position by re-enforcing its view that LBD cannot claim any monopoly in the word LUCKY itself and that the respective marks as a whole are not confusingly similar. I also note that LP has filed evidence to show that the word LUCKY is used by other traders (examples of t-shirts bearing the word LUCKY with additional matter have been put forward). Furthermore, in its counter-statement, LP filed a list of 51 trade marks that cover clothing which all include the word LUCKY.

47. Whilst I understand LP’s comments in relation to the monopolising of the word LUCKY, it should be noted that the registration of LBD’s mark does give them a form of monopoly, albeit, other than in relation to identical marks (which are not in issue here) the monopoly can only be used (in the context of this case) to prevent the use of latter trade marks that, due to the similarity between the marks and their goods, are likely to confuse the average consumer regarding economic origin. The question rests on the likelihood of confusion. I also add that there is little I can take from the evidence filed of other traders using LUCKY on t-shirts or the list of other trade marks provided. In relation to the list of trade marks, the registrar does not know what is happening in the marketplace, the marks listed may or may not be in use and, therefore, it does not tell me anything about the impact on the consumer. In relation to the two t-shirt examples provided, they do not paint an overwhelming picture of the use of LUCKY based marks, nor does the information tell me anything about the nature and scale of such use and the consequent effect on the mind of the consumer. However, the question of confusion is still to be answered.

48. There are two types of confusion that need to be considered. Both are relevant for the purposes of section 5(2) of the Act. The first is known as “direct confusion” whereby the marks in question are directly confused for each other by the average consumer. The second is known as “indirect confusion” where, due to the similarities between the respective marks, the consumer will, although they can differentiate one mark from the other, nevertheless believe that the goods sold under the marks are the responsibility of the same or an economically linked undertaking. I will start my analysis by considering identical goods as I accept that this is more likely to lead to confusion; if LBD cannot succeed here then they are unlikely to succeed in relation to goods that are merely similar.

49. In relation to direct confusion, I take into account that the average consumer rarely has the chance to make direct comparisons between marks but must instead rely upon the imperfect picture of them that he has kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). However, the conceptual meaning that the consumer will take from LP’s mark will, in my view, lodge firmly in their mind and the difference in concept from that underpinning LBD’s mark will consequently mitigate against the marks being confused as a consequence of imperfect recollection. If the marks were perfectly recalled by a very attentive consumer, or if the goods and their respective marks were positioned alongside each other on the same shelf or rail, the difference between the

marks and their concepts will undoubtedly be noticed. **Therefore, I find that direct confusion is not likely.**

50. In relation to indirect confusion, LBD submits that the average consumer will regard LP's trade mark as a brand extension of its trade mark, in other words, the consumer will see LUCKY PUNK goods as being part of the LUCKY BRAND range, but that such goods have a punk or music related theme. I understand these submissions, particularly in the context of its other submission to the extent that the word LUCKY plays, at the very least, an independent distinctive role in the context of LP's mark. However, I have already found that the words LUCKY PUNK, even in the context of music themed goods, will be seen as a single self standing phrase relating to a follower of punk rock music who is also an individual of good fortune and, therefore, the word LUCKY will not play an independent and distinctive role with LP's mark. This, in itself, does not necessarily rule out confusion because, even taking into account the conceptual meaning, it is still possible that a consumer will notice the shared element between the marks and that this could lead to them to believe that there is an economic link. Despite the fact that I have found LBD's mark to be reasonably distinctive and that the word LUCKY is the dominant and distinctive element of it, the qualifying role that the word LUCKY plays in LP's mark (qualifying a characteristic of the punk) means that the consumer is unlikely to base their expectations of trade origin on the presence of this word. In the context of LBD's reliance on *Coco De Mer* the word LUCKY is not the strong and obvious element in the mark and, given the additional word, the mark's conceptual whole, and its stylisation, this is all more than enough to negate the single point of similarity. **Therefore, I find that indirect confusion is not likely.**

51. LBD has other earlier marks to consider, but they are no closer to LP's mark than UK registration 1548629. I will say no more about them.

CONCLUSION

52. **The opposition under section 5(2) of the Act, and consequently the whole opposition, fails.**

COSTS

53. LP has been successful and is entitled to a contribution towards its costs. I hereby order Lucky Brands Dungarees, Inc. to pay LP Designs the sum of £500. This sum is calculated as follows:

| | |
|----------------------------------|-------------|
| Considering notice of opposition | £150 |
| Statement of case in reply | £200 |
| Preparing and filing evidence | £100 |
| Considering evidence | £50 |
| Total | £500 |

54. It should be noted that when calculating the above costs, I have taken into account the fact that LP has not been legally represented and the guidance given by the Appointed Person on the relevance of this factor⁹.

55. The above 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 29th day of July 2008

**Oliver Morris
For the Registrar
The Comptroller-General**

⁹ See the decisions of Mr Simon Thorley QC in *Adrenalin* (BL 0/040/02) and Mr Arnold QC in *South Beck* (BL O/160/08).