

O-229-08

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2426472
BY RICHARD HAWORTH LIMITED T/A BELDORM
TO REGISTER THE TRADE MARK:**

BELLE DORM

IN CLASS 24

AND

**IN THE MATTER OF OPPOSITION NO 95044
BY DORMA GROUP LIMITED**

TRADE MARKS ACT 1994

IN THE MATTER OF Application No 2426472
by Richard Haworth Limited t/a Beldorm
to register a trade mark in Class 24

and

IN THE MATTER OF Opposition No 95044
By Dorma Group Limited

BACKGROUND

1. On 6 July 2006 Richard Haworth Limited (trading as Beldorm) (“RH”) applied to register the words BELLE DORM as a trade mark for the following goods:

Class 24 – Household textiles; textile articles; bed covers; table covers; towels.

2. On 8 March 2007 Dorma Group Limited (“DGL”) opposed the above application on grounds under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). In relation to the ground under section 5(4)(a), DGL relies on its use of the sign DORMA. In relation to the grounds under sections 5(2)(b) and 5(3), DGL relies on six of its earlier trade marks, namely:

Trade Mark	Relevant Dates	Specification
UK Registration 1120615 for the mark: DORMA	Filed: 12/09/1979 Registered: 28/01/1981	Class 24: All goods included in Class 24.
UK Registration 143871 for the mark: DORMA	Filed: 14/04/1934 Registered: 17/01/1935	Class 24: Blankets made wholly of cotton and not in the piece; bedspreads and mattress covers made wholly or mainly of cotton and not in the piece; and pillow cases and bolster cases made wholly or mainly of cotton; all being goods for sale in the United Kingdom of Great Britain and Northern Ireland and for export to and sale in the Irish Free State, Canada, Union of South Africa, Australia and New Zealand. ++ Specification converted under Rule 6 to Schedule IV, Class 24, in respect of: - Bed blankets, bedspreads, mattress covers, pillow cases and bolster cases, all made wholly or principally of cotton, and for sale in the United

		Kingdom of Great Britain and Northern Ireland, and for export to and sale in the Irish Republic, Canada, South Africa, Australia And New Zealand; artificial silk piece goods; bed sheets, pillow cases, bolster cases, pyjama cases and nightdress cases, all made wholly or principally of artificial silk.
UK Registration 907903 for the mark: DORMA	Filed: 11/04/1967 Registered: 13/12/1967	Class 24: Textile piece goods.
UK Registration 2417899 for the mark: DORMA BOUTIQUE 5(2) ground of opposition only.	Filed: 28/03/2006 Registered: 22/09/2006	Class 20: Furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother of pearl, meerschaum and substitutes for all these materials, or of plastics; sleeping bags, mattresses, pillows and cushions. Class 24: Towels, duvets, textiles and textile piece goods not included in other classes; bed and table covers.
UK Registration 2353302 for the mark: DORMATOUCH 5(2) ground of opposition only.	Filed: 14/01/2004 Registered: 25/06/2004	Class 03: Soaps, perfumery, essential oils, preparations for the hair; non-medicated toilet preparations; oils, cream and lotions for the skin; crystals, salts, foams, gels and milks, all being bath preparations; shower foam and gel; room fragrances all included in Class 3 Class 24: Textiles and textile goods, not included in other classes; bed and table covers; all included in Class 24.
Community Trade Mark registration 2481034 for the mark: DORMA	Filed: 28/11/2001 Registered: 29/08/2005	Class 11: Installations and apparatus all for lighting; lights, lamps, lamp bases, lampshades. Class 20: Bedding for beds (other than bed linen), sleeping bags, mattresses, bolsters, pillows, cushions, curtain tie backs, curtain hooks, curtain rails, curtain rings, curtain rods and curtain rollers. Class 21: Household or kitchen utensils and containers (not of precious metal or coated therewith), combs and sponges, hair brushes, brushes for domestic cleaning purposes,

		<p>glassware, porcelain and earthenware not included in other classes.</p> <p>Class 24: Piece goods of textile materials and household textile articles; duvets.</p> <p>Class 25: Nightwear, lingerie, nightdresses, bed jackets and dressing gowns.</p> <p>Class 27: Carpets, rugs, mats, bath mats and matting, linoleum and other materials for covering existing floors; wall paper and wall hangings (non-textile).</p>
--	--	---

3. RH filed a counterstatement denying the grounds of opposition. Although it conceded that the goods involved were either identical or similar, it argued that the marks were not “confusingly similar” and also highlighted its prior use of another of its trade marks, BELDORM, which it says has been honestly and concurrently used with DGL’s mark without confusion.

4. Both sides filed evidence, this is summarised below. Neither side requested a hearing or filed written submissions.

DGL’s evidence

Witness statement of Robert Walker

5. Mr Walker is the managing director of DGL. He begins his evidence by detailing the origins of the DORMA brand. In summary, the DORMA brand stemmed from a business set up in 1817 by Mr John Foulkes Roberts. The business originally dealt with the provision of silk and buttons for the tailoring trade and then moved into shirt making. The business was joined by his brother Hugh in 1847 to form JF & H Roberts. However, after the first world war (the exact date is not given) the company entered the soft furnishing trade as a manufacturer of furnishing fabrics including fabrics for the bedroom and curtains; the DORMA trade mark was established for these products. Mr Walker states that the name derived from dormer windows where curtaining was provided in the attic rooms frequented by the maid of the house. In 1923, the use of the mark was extended to sheets and pillowcases packaged together for presentation and subsequent sale through retail outlets. The company was granted a royal warrant by the Queen in 1961 and 2 further royal warrants were granted in 1987 and 1992.

6. The evidence details a number of assignments and mergers relating to the original JF & H Roberts business which have taken place over the years. I will not summarise them all, it is sufficient to record that the chain of assignments and mergers ended in 1986 with a merger that resulted in the creation of *Coats Viyella* which, Mr Walker states, is one of the world’s largest producers of domestic and industrial sewing thread. The trade under the DORMA name is currently conducted under the DGL company designation, which I presume is part of the *Coats Viyella* group. The evidence also establishes a number of

links with individuals and companies ranging from *Marks and Spencer*, *ICI* and *Mary Quant* (the famous clothing designer).

7. Mr Walker lists a number of goods and indicates from when (at the least) they have been sold under the DORMA name, these are: quilt covers (before 1975), pillowcases, flat sheets, sheet and pillowcase sets (1923), fitted sheets, valances and curtains (before 1975), pelmets, tiebacks and cushion covers (1984), luxury throws and bedspreads (1975); filled pillows (1982) and filled quilts (1981). The annual sales value (excluding VAT) of these goods in the UK and the amounts spent on their marketing are given as:

YEAR	Sales value (£'000)	Marketing spend (£'000)
1994	36579	1524
1995	39901	726
1996	41688	1033
1997	43843	1132
1998	44160	1229
1999	42503	960
2000	42910	958
2001	43099	928
2002	41847	817
2003	37633	703
2004	39653	327
2005	32097	242
2006	26685	599

8. Mr Walker states that the goods are sold through DGL's own website, through 300 independent stores and a number of retail chains and mail order companies. To support all of his evidence, Mr Walker provides six exhibits which contain the following:

Exhibit A – This contains a number of brochures and price lists for the DORMA range. This earliest is from 1981 and they range to the present day. An extract from the DORMA web based shop is also provided.

Exhibit B – A large number of invoices to a number of customers are provided. DORMA appears on each invoice as the name of the business itself, but, the products being sold use the DORMA name; some of this use is with what would be taken to be a secondary or sub-brand. They are all dated between 2000-2006.

Exhibit C – This contains various advertisements that have been placed in the UK media. One is from the *Manchester Evening News* dated June 2003. There are six others, but it is not clear where they have been published, although one (entitled *Menarys*) is from 2003 and another, *Arnotts*, is from 2004. They all refer to the DORMA name and its range of goods.

Exhibit D – This provides details of DORMA stockists in London, Manchester, Scotland (8 towns or cities) and Wales (6 towns or cities).

Exhibit E – Two types of material are provided. Firstly there are articles from the press which highlight the DORMA range of goods. The publications are dated between 2000-2004. Some are in the local press (e.g. the Wigan Observer), some are in the national press (e.g. the Daily Telegraph) and others are in what I would describe as home/lifestyle magazines (e.g. BBC Good Homes). The second type of material is what Mr Walker describes as an independent report about the DORMA brand. In this report it states that DORMA bed linen has a 10% market share and is significantly bigger than its nearest competitor. Although this is said to be an independent report, it is more in the nature of a “pitch” of DORMA’s goods, using language such as “our products...”. It is not clear to whom this report was sent.

Exhibit F – This consists of a lengthy report (dated November 2005) containing the data tables of an “in street survey”. Unfortunately, there is no summary or highlight information or any indications regarding the manner in which the survey was conducted. However, from what I can tell, the report appears to support the proposition that there is a reasonable degree of awareness of the DORMA brand.

9. Mr Walker completes his evidence by stating that the DORMA brand has a substantial reputation and goodwill and that the use of RH’s mark would cause confusion, particularly given that the word BELLE in RH’s mark would be known by the UK consumer as meaning beautiful and that this is combined with the invented word DORM which is visually, phonetically and conceptually similar to DORMA. Further, that RH’s other mark, BELDORM is an invented word and that use of BELLE DORM is intended to misrepresent which will lead to damage to DGL’s business in terms of loss of sales and damage to its reputation.

RH’s evidence

Witness statement of Sunil Ruia

10. Mr Ruia is the managing director of RH. He states that RH is the owner of UK trade mark registration 1561675 for the trade mark BELDORM (the UK-IPO web-site details of this mark are included in Exhibit RH1); the mark was applied for on 9 February 1994. The mark was registered by a predecessor in title, but RH has continued to market textile articles, particularly bedcovers and household textile articles, under the BELDORM name.

11. Mr Ruia then sets out some historical facts. He joined a company called Beldorn Ltd in 1983. He states that at that time customers assumed that Beldorn was Beldorm because they sold bed linen (due to the allusion to the French word “dormir” meaning to sleep). Two companies within the same group then merged to form Hector Beldorn, but then “Hector” was dropped so the company reverted again to just Beldorn. At some point after this (the exact date is not given) the name was changed to BELDORM. He summarises that Beldorn/Beldorm has been a company of constant change. Exhibits RH2 A-G show various items of packaging, price lists etc that show the respective changes. RH2A shows

the original BELDORN name on *Harrods* packaging; RH2B shows the company name Hector Beldorn on a price list, the items on the list are headed Beldorn Coordinates, another price list simply has the name Hector Beldorn; RH2C shows a brochure with price lists headed BELDORN (this is dated March 1994); RH2D shows packaging for BELDORM COORDINATES and Exhibits RH2E, F & G show a form of use of BELDORM as depicted below (there are slight variations in this, but they are essentially the same); RH2G also has a web address listed namely www.beldorm.co.uk:



12. Mr Ruia states that from 1994 to the present day, its BELDORM mark has been concurrently used with DGL's DORMA mark and that he is not aware of any instances of confusion. He states that Beldorm is a trading division of RH which is within the Ruia Group established in 1993. Its activities are said to include the import, supply and distribution of household textiles, hosiery and apparel to some of the UK's foremost retailers, wholesalers, and hospitality and healthcare organisations. He adds that Beldorm has won awards such as the *Associated Independent Stores* award for "Linen Supplier of the Year (2004)". The approximate annual turnover figures for goods labelled or sold under the BELDORM mark are then given as:

Year	Turnover
2002	£5.2 million
2003	£5.6 million
2004	£6.05 million
2005	£5.6 million
2006	£6.05 million

13. Information on what Mr Ruia calls “direct retail concessions” is then provided. These concessions are in 3 UK locations and are hosted by *Boundary Mill Stores*. He states that in the linen departments of these stores there are between 5-7 brand names including BELDORM and DORMA. He states that the respective ranges complement each other rather than compete. Turnover in these concession stores is stated as being: 2003 (£403,000), 2004 (£484,000), 2005 (£618,000), 2006 (£841,000) & 2007 (£1, 161,000).

14. Mr Ruia states that the range of goods sold under the BELDORM name include sheets, pillowcases, duvet covers, rugs, table linen, towels, duvets and mattress protectors. He states that customers are located throughout the UK, EU and the Middle East. He lists 20 establishments who are such customers, many of whom I recognise as being UK establishments. Reference is then made to Exhibit RH3 which contains product packaging for 18 of its customers. All the packaging features the name of the particular establishment with the words “Luxury bed linen By Beldorm” or some similar type of wording. The sites are located in Fakenham, Dorchester, Turriff, Clevedon, Falmouth, Downham Market, Newbury, Saffron Walden, Hereford, Salisbury, Halifax, Stowmarket, Clitheroe, Isle of Wight, Broughty Ferry (Scotland), Carmarthen and Llantrissant. He states that the goods have also been sold through a number of on-line retailers and Beldorm’s own commercial web-site.

15. In terms of advertising and promotion, Mr Ruia states that BELDORM goods are advertised on established web-sites (e.g. www.sockshop.co.uk), search engines and affiliated commercial networks. Advertising/exposure is also gained via television (e.g. QVC), newspaper (e.g. Sunday Times supplement) and magazines (e.g. Home & Gardens Magazine). Exhibit RH4 are copies of such advertisements dated between 2000-2006. In total just over 100 advertisements are provided, the majority use the words BELDORM but some (22) also use the version as depicted in paragraph 11 above.

16. Mr Ruia then refers to the BELLE DORM trade mark. This stems, he states, from 2006 when one of RH’s customers requested goods to be labelled BELLE DORM instead of BELDORM. RH felt this to be a minor variant and agreed to the change and also filed the trade mark application. Following objection by DGL to the advertisement featuring BELLE DORM, RH, in order to allay DGL’s concern, conjoined the two words and ensured that the DORM element was given no greater prominence. Exhibit RH5 shows an advertisement for the conjoined variant, the mark is presented as “belledorm”. Mr Ruia states that he requested that the present application be amended to just one word but that the request was not accepted by the UK-IPO.

17. Mr Ruia completes his evidence by stating that in view of the inherent differences between the marks, and the history he has outlined regarding co-existence of BELDORM and DORMA for over 12 years, he does not believe that the consumer will consider there to be a connection between the respective suppliers.

DECISION

The proof of use regulations

18. Of potential relevance to the grounds of opposition under sections 5(2) & 5(3) of the Act are the provisions that relate to proof of use. Section 6A¹ 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
- (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.

¹ 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 May 2004.

(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).”

19. Three of DGL’s trade marks (1120615, 143871 & 907903) were registered five years or more before the date on which RH’s trade mark was published and, therefore, the proof of use regulations apply to them. DGL claimed in its statement of grounds that these marks had been put to genuine use in the relevant period for certain goods. RH accepted these claims. Therefore, for the purpose of all further analyses, 1120615, 143871 & 907903 will be assessed on the basis of the respective goods claimed to have been used. The other marks will be assessed on the basis of their actual specifications. The claims are:

1120615 – Household textiles, including bedware.

143871 – Bedspreads, mattress covers, sheets and pillow cases.

907903 – Textile piece goods (this is, in any event, the specification as registered)

Section 5(2)(b)

The law

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

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

(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.”

21. 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.”

22. When reaching my decision I have taken into account the guidance provided by the European Court of Justice (“ECJ”) in a number of judgments germane to this issue, 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, *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *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) an element of a mark may play an independent distinctive role within it without necessarily constituting the dominant element; *Medion AG V Thomson multimedia Sales Germany & Austria GmbH*, paragraph 30;

(g) 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;

(h) 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;

(i) 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;

(j) 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;

(k) 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

23. 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 textile articles, the evidence shows that this is primarily in the nature of items such as bed linen etc. These types of goods are not specialist in any way and are likely to be purchased by the general public at large. Whilst not everyday purchases, their cost (relatively low) and use (something to place on your bed or to sleep on or under) mean that the level of attention utilised during the purchasing process is unlikely to be of the highest degree. In my experience, the goods are selected predominantly on the basis of material, colour, style, size, feel etc. These considerations are paramount in the selection process which means that the goods are not simple “grab and go” items and, consequently, a reasonable degree of care and attention will be utilised when selecting them. These factors also mean that the purchasing act will normally be via self-selection from a shelf or a catalogue rather than by oral ordering. However, brand awareness, although not irrelevant, will not be as high compared, for example, to articles of clothing. Overall, these are general consumer items purchased with a reasonable degree of attention.

Similarity of goods/services

24. RH's goods are:

Household textiles; textile articles; bed covers; table covers; towels.

25. RH concedes in its counterstatement that the respective goods are either identical or similar to DGL's goods. DGL's registration 1120615 claims use in respect of household textiles at large, this must cover any textile article for use in the home (e.g. bedding, curtaining, towels etc). As such, the terms household textiles, bed covers, table covers and towels all fall within the ambit of DGL's goods and are, therefore, identical. The term textile articles in RH's specification goes wider than this and, consequently, may include within it goods that may only be similar, however, such goods have not been particularised and it is appropriate to simply record that this wider term is also identical to goods covered by registration 1120615.

Similarity of trade marks

26. 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:

<u>RH's trade mark</u>	<u>DGL's trade mark</u>
BELLE DORM	DORMA

27. Neither party filed written submissions, but some comments on similarity were made in evidence and in initial statements. DGL say that the word BELLE will be known by the relevant consumer as meaning beautiful and that this word is combined with a word DORM which is phonetically, visually and conceptually similar to DORMA. RH refers to what it describes as the inherent differences between the marks.

28. From a visual point of view, whilst I agree that there are obvious similarities between the words DORM and DORMA, the assessment must be made on the basis of the marks as a whole given that the word DORM does not dominate the overall impression of RH's mark and that even if it did, it would not dominate the mark to the extent that the word BELLE was negligible (see *Shaker di L. Laudato & Co. Sas*, paragraph 42). Looking at the marks as a whole, the average consumer may notice some visual similarity due to the common presence of the word/letters DORM in both marks. However, the additional word BELLE in RH's mark and the final letter "A" in DGL's mark create points of difference. Furthermore, the word DORM in RH's mark does not impact on the eye to any greater extent relative to the word BELLE. In my view, this results in any visual similarity being on the low side.

29. Similar observations and conclusions apply in relation to aural similarity. RH's mark will be pronounced as BELL DORM or BELL-ER DORM whereas DGL's mark will be pronounced DORM-A. Again, although the words DORM and DORMA have a similar pronunciation (although not identical), there is nothing in the construction of RH's mark that gives the DORM element any greater degree of aural significance.

30. Turning to conceptual similarity, DGL's mark consists of the word DORMA which is not, as far as I am aware, a known English word. However, it is the phonetic equivalent of a word, namely, the word "dormer", which relates to a construction with a window that projects from a sloping roof². Indeed, in its evidence, DGL highlights that this is what led to the mark's selection back in the 1920s. However, it is the average consumer's perception of concept that is important and not the intentions of the mark's creator. In terms of the average consumer, I am aware of the danger in accepting too readily what knowledge they may or may not possess³, and that for conceptual differences (and by extension conceptual similarities) to be significant in the analysis then such meanings must be clear and immediate⁴. I accept that some consumers (but not all) may know what a dormer is, but when presented with the word DORMA, such a meaning may not readily present itself. It could be argued that use of the mark in relation to goods such as bed linen will more likely trigger the response that the word is a misspelling of dormer, but, in my view, this requires a process of analysis and speculation and would not be an immediate impression. I am left with the view that the relevant, average consumer will see the word DORMA, even when used on bed linen, as an invented word.

31. Applying the same approach to RH's mark, I am prepared to accept that the relevant, average consumer will recognise the word BELLE as a French word (or simply a foreign word) meaning or alluding to the word "beautiful"; it seems to me to be a word that has passed into the general knowledge of the average English speaker in the United Kingdom. Whilst I am aware that the word DORM is short for "dormitory" (meaning a large room containing a number of beds), I have more difficulty in assessing whether this meaning is generally known by the average consumer. Regardless of this, even if it is a known word, its combination with the word BELLE may point away from this meaning as it would be unusual to combine an English word with a foreign word. In view of these factors, my view is that the meaning of DORM will not be immediately noticed and grasped by the average consumer when they encounter BELLE DORM. Nevertheless, the recognition of the word BELLE and the non-recognition of the word DORM is likely to have the result that the average consumer will see BELLE DORM as a combination of two foreign words, one of which they will know means beautiful. Although this does not give the mark as a whole a specific and clear conceptual meaning, it does result in the mark as a whole being seen as a single phrase with the word BELLE qualifying the word DORM; in other words the consumer will see the words BELLE DORM as a single phrase even if they do not know what it means. This is also significant because the word

² Collins English Dictionary 5th Edition.

³ See the decision of Anna Carboni (sitting as the Appointed Person) in *Cherokee* BL-O-198-08

⁴ See the judgment of the CFI in *Devinlec Développement Innovation Leclerc SA v OHIM* (Case T- 147/03)

DORM in RH's mark does not, therefore, play an independent and distinctive role in the sense described by the ECJ in *Medion*.

32. I have taken into account in the above analysis that both the word "dormer" and the word DORM are words derived from the French word "dormir" meaning "sleep". Other words exist in English that have similar derivations, e.g. dormant. However, I do not consider that the common derivation of these types of words is so obvious that I can infer that the average consumer will be aware of the shared root. Without this, and without the words themselves being attributed any immediate and specific meaning, the result of the conceptual analysis is that there is neither conceptual similarity nor dissimilarity. There is no conceptual hook that will be shared between the two, nor is there a key conceptual meaning that creates a point of distinction between them. The impact is, therefore, neutral. I am, nevertheless, left with the visual and aural similarities, although, as indicated above, such similarities are at the lower end of the scale.

Distinctiveness of the earlier trade marks

33. 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). In terms of the inherent qualities of DGL's mark, I have already commented in my analysis of the conceptual meaning that the relevant, average consumer will see the mark as an invented word. This, therefore, gives the mark, as a starting point, a relatively high level of distinctive character.

34. Distinctiveness can be enhanced through use. The use filed by DGL is significant. The use of the word DORMA by DGL and its predecessors in title dates back nearly 100 years. It appears to be a market leader in respect of bed linen (and is also known for other types of bedding and other textile articles such as curtaining), and its sales figures are extremely impressive. The distinctiveness of the mark cannot fail to be enhanced on the basis of this evidence. Overall, the mark is one of a high degree of distinctive character.

Parallel trading

35. In addition to stating that the inherent qualities in the respective marks will not lead to confusion, RH's further argument is that the DORMA mark has been used in the marketplace alongside RH's BELDORM mark without any instances of confusion.

36. Evidence of what is often referred as "parallel trading" is a factor which could, potentially, assist in deciding whether there exists a likelihood of confusion. This is because if the evidence establishes that the respective marks have actually been put to use in the same market (as opposed to the notional use which is normally considered) without the consumer being confused regarding economic origin, then this can inform the tribunal's decision. Alan Steinfield QC, sitting as a deputy judge of the High Court, in *Fiorelli Trade Mark* [2007] RPC 18 gave weight to an absence of confusion in the marketplace, however, this should be tempered by a number of decisions which express

caution about the circumstances in which it is appropriate to give these factors weight (see the Court of Appeal in *The European Ltd v. The Economist Newspaper Ltd* [1998] FSR 283 at page 291, Laddie J in *Compass Publishing BV v. Compass Logistics Ltd* [2004] RPC 41 at 809 and the Court of Appeal in *Phones 4U Ltd v. Phone 4u. co. uk Internet Ltd* [2007] RPC 5 at paragraphs 42 to 45.) In the first of the above cases Millet LJ stated:

“Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff’s registered trade mark.”

37. There are a number of factors to consider when assessing the evidence of parallel trading. The first relates to the marks themselves. It is clear from DGL’s evidence that its mark is DORMA and it is used and promoted as such. However, RH’s evidence does not demonstrate use of the BELLE DORM mark as per its application, but instead, the use is of the mark BELDORM. There is also some use of a variant of BELDORM, I will return to this shortly. In relation to BELDORM, I do not rule out its significance simply on the principle that it is not the mark applied for, but it strikes me that this mark is further away from DORMA than BELLE DORM and, therefore, is less likely to cause confusion. I say this because BELDORM gives no stress to the DORM element and, in my view, this element is effectively lost within its overall impression. The simple fact that BELDORM may have been concurrently used alongside DORMA without confusion is of little significance.

38. Returning to what I have described as the variant form of BELDORM, this is the version of this sign as depicted in paragraph 11 above. It can be seen from the representation that the syllables that make up BELDORM have been split to form BEL DORM and they are separated onto different lines. This, inevitably, gives the DORM element a greater degree of prominence than it would in the combined version, although, this does not necessarily mean that the element DORM is the dominant and distinctive element of it. This sort of use is, therefore, of greater potential relevance if confusion free parallel trading can be established.

39. Neither side have provided full and exact details of every establishment in which they trade. DGL appear to operate, to a large extent, through a network of independent stores, some of these are listed, and, of the establishments listed by RH, there appear to be two or three that overlap. There are also the *Boundary Mill Stores* where Mr Ruia (for RH) states that both parties’ goods are sold. This evidence is not challenged by DGL. Therefore, there is some evidence of parallel trade. Advertising has also taken place within similar types of media. However, of some concern is the fact that this variant form of use does not appear, from the evidence, to be the primary form of use. Over 100 advertisements were supplied by RH, but only 22 feature the variant sign. Numerous types of packaging were given in evidence for RH, but the majority do not feature the variant sign. No information has been provided as to the nature of the packaging used in the establishments where parallel trade has taken place. I can infer, at the most, that the

material put forward by RH is indicative of its use and, therefore, the variant sign is not the one that the consumer will encounter most often.

40. I have also noted that when referring to the parallel trading in the *Boundary Mill Stores*, Mr Ruia states that the respective goods do not compete with each other, instead, they “work together”. He explains that DORMA sell mainly designed linens whereas BELDORM offer plain dyed linens. This has some (although not overwhelming) significance because, in my experience, one of the first points of attraction for the consumer of these types of goods is the pattern or colour used on them. If the goods differ in the terms described, the consumer may inspect one, but not the other. The consumer can only be confused regarding economic origin if both marks are being encountered. I am not satisfied, on the basis of the evidence, that this is happening to any significant extent in relation to the variant version of BELDORM. All of this leads me to doubt how significant the evidence is, it certainly does not present an overwhelming case of confusion free parallel trade and, therefore, whilst it will be borne in mind in my determinations, its weight is limited.

Likelihood of confusion

41. I need to consider both direct and indirect confusion. In relation to direct confusion (where the average consumer mistakes one mark for the other) I consider that the obvious points of difference, but primarily the presence of the word BELLE in RH’s mark, mitigates strongly against direct confusion. This is so even when taking 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). Even when taking into account the identical goods and the high degree of distinctiveness in DGL’s mark, the differences in the marks outweigh these factors. **Direct confusion is not likely.**

42. In relation to indirect confusion (where the similarities between the marks lead the consumer to believe that the goods sold under them are the responsibility of the same or an economically linked undertaking) the question is more evenly balanced. I note the identity of the goods and that this increases the likelihood of confusion and I also note the high degree of distinctiveness in DGL’s mark which is another important factor. However, as stated in my assessment on similarity, the word DORM does not stand as the dominant and distinctive element in RH’s mark, nor does it play an independent distinctive role within it. There is no real conceptual hook to either mark that the consumer will rely on other than that in RH’s mark the mark as whole may be perceived as complete phrase in a foreign (possibly French) language. This aspect of RH’s mark, despite the fact that BELLE means beautiful, re-enforces the lack of independence and reduces the likelihood of the consumer making assumptions about economic origin merely on the presence of the element DORM. There is also the fact that the element in RH’s mark that is said to give rise to an economic link is DORM and not DORMA which creates a further point of distinction. I have stated that the goods lends themselves to self selection rather than oral ordering, but the analysis already made is no different when considering visual similarity.

43. The distinctiveness of DGL's mark is important (the evidence is strong) but, despite its strength, I do not consider that this will result in the consumer being confused. In my view, the average consumer will not make any form of connection between the two marks let alone a connection of economic origin. I cannot rule out that, at the margins, the high degree of distinctiveness may result in a small minority of consumers bringing DGL's mark to mind when they encounter RH's mark. However, this would not be the view of the average consumer, and, even if I was wrong on this, this would still not be enough for them to go on to be confused about the economic origin of the goods. **I find that the marks are not likely to be indirectly confused. The opposition under section 5(2) fails.**

Section 5(4)(a)

44. Section 5(4)(a) of the Act reads:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

45. The opponent relies on the common law tort of passing-off. Two decisions⁵ of the House of Lords clearly set out the necessary elements that need to be demonstrated. They can be summarised as: 1) goodwill, 2) misrepresentation and 3) damage. Lord Oliver summarised the position quite succinctly in the latter of these cases when he stated at page 406:

“The law of passing off can be summarised in one short general proposition--no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public

⁵ *Erven Warnick BV v J Townend & Sons (Hull) Ltd* [1980] R.P.C. 31 and *Reckitt & Colman Products Ltd v Borden Inc* [1990] R.P.C.341.

(whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff. ... Thirdly he must demonstrate that he suffers, or in a *quia timet* action that he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff.”

46. I do not intend to deal with this ground in depth. Whilst I accept that DGL have a clear and established goodwill, I have already found that the marks themselves are not similar enough to cause the consumer to be confused about the economic origin of the goods in question. That being so, I do not see how DGL can be in any better position to argue that the goods sold under RH's mark will be taken by the public to be DGL's goods. **The opposition under section 5(4) of the Act fails.**

Section 5(3)

47. Section 5(3)⁶ of the Act reads:

“5-(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

48. The scope of Section 5(3) has been considered in a number of cases notably *General Motors Corp v Yplon SA (Chevy)* [1999] ETMR 122 and [2000] RPC 572, *Premier Brands UK Limited v Typhoon Europe Limited (Typhoon)* [2000] FSR 767, *Daimler Chrysler v Alavi (Merc)* [2001] RPC 42, *C.A. Sheimer (M) Sdn Bhd's TM Application (Visa)* [2000] RPC 484, *Valucci Designs Ltd v IPC Magazines (Loaded)* O/455/00, *Mastercard International Inc and Hitachi Credit (UK) Plc* [2004] EWHC 1623 (Ch), *Electrocoin Automatics Limited and Coinworld Limited and others* [2005] FSR 7 and *Davidoff & Cie SA v Gofkid Ltd (Davidoff)* [2003] ETMR 42, *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd (Adidas-Salomon)* (C-408/01) .

49. The points that come out of these cases are as follows:

a) “Reputation” for the purposes of Section 5(3) means that the earlier trade mark is known by a significant part of the public concerned by the products and

⁶ As amended by The Trade Marks (Proof of Use, etc) Regulations 2004 (SI 2004 No. 946) giving effect to the judgments of the ECJ in *Davidoff & Cie SA and Zino Davidoff SA v Gofkid Ltd* (C- 292/00) and *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd* (C-408/01)

services covered by that trade mark (paragraph 26 of the ECJ's judgment in *Chevy*);

b) Protection is available where the respective goods or services are similar or not similar (paragraph 29 of the Advocate General's opinion in *Chevy* and *Davidoff*);

c) The provision is not intended to give marks "an unduly extensive protection" – there must be actual detriment or unfair advantage (not merely risks) which must be substantiated to the satisfaction of the national court or tribunal (paragraph 43 of the Advocate General's opinion in *Chevy* and paragraph 88 of Pumfrey J's judgment in the *Merc* case);

d) The provision is not aimed at every sign whose use may stimulate the relevant public to recall a trade mark which enjoys a reputation with them (per Neuberger J in the *Typhoon* case);

e) The stronger the earlier mark's distinctive character and reputation the easier it will be to accept that detriment has been caused to it (paragraph 30 of the ECJ's judgment in the *Chevy* case);

f) Confusion as to the trade source of the goods or services offered for sale under the later mark is not a necessary condition before there can be detriment; but is one form of detriment (paragraph 88 of Pumfrey J's judgment in the *Merc* Case);

g) It is not conditional for a finding that there exists a likelihood of confusion; it is sufficient for the degree of similarity between a mark with a reputation and the applied for mark to have the effect that the relevant consumer establishes a link between the marks (paragraph 31 of the ECJ's judgment in *Adidas-Salomon*)

h) Detriment can take the form of either making the earlier mark less attractive (tarnishing) or less distinctive (blurring) (paragraph 88 of Pumfrey J's judgment in the *Merc* Case);

i) Unfair advantage can take the form of feeding on the fame of the earlier mark in order to substantially increase the marketability of the goods or services offered under the later trade mark (per G Hobbs QC in *Visa* at page 505. lines 10-17).

50. I have also taking into account the recent decision of Anna Carboni (sitting as the Appointed Person) in *Cube Publishing Ltd v. Standard Life Insurance Company* (BL O/208/08) where she reviewed the relevant legislation relating to this issue and I note the further decisions that she made reference to, notably: *L'Oreal SA v. Bellure NV* [2007] EWCA Civ 968, [2008] ETMR 1 and *Intel Corporation Inc v. CPM United Kingdom* [2007] EWCA Civ 431, [2007] ETMR 59, and also the opinion of Advocate General Sharpston in the latter of these cases (Case C-252/07, Opinion dated 26 June 2008).

Reputation

51. I have already commented in paragraph 34 about DGL's use of its mark. Given that I have found that the use of the mark is significant and that it is the market leading brand in relation to bed linen (and that this reputation also extends to other types of bedding and other textile articles such as curtaining), I have no doubt that the mark possesses the type of reputation explained by the ECJ in *Chevy*. In addition to possession of reputation, it is important that I assess the nature of the reputation as this is another important factor given that the heads of damage under section 5(3) include detrimental effects to, or the taking advantage of, its reputation; I can only make assessments of this sort if the nature of the reputation is also assessed.

52. On the basis of the evidence, DGL's DORMA trade mark is a reputable brand with a good public image. This is exemplified by its royal warrants that many consumers will see as a sign endorsing the quality of the product. Its public image is reinforced by the information in the "in-street survey", where the questions relating to whether DORMA is a "good brand" have high positive responses. The image conveyed by its reputation is not, however, characterised by any specific quality or attribute; it is, generally speaking, a well regarded brand of good quality.

The "link"

53. The ECJ's judgment in *Adidas-Salomon* highlighted that confusion is not a prerequisite for a finding under this ground, it being sufficient that the degree of similarity between the marks has the effect that the relevant consumer establishes a link between them. The link, however, appears to be more than a simple finding that the marks have some degree of similarity. At paragraph 30 of the ECJ's judgment in *Adidas-Salomon* it drew an analogy between the test to be applied here with the global appreciation test relevant to the likelihood of confusion:

"The existence of such a link must, just like a likelihood of confusion in the context of Article 5(1)(b) of the Directive, be appreciated globally, taking into account all factors relevant to the circumstances of the case (see, in respect of the likelihood of confusion, *SABEL*, paragraph 22, and *Marca Mode*, paragraph 40)."

54. Applying a global appreciation, and taking into account relevant factors such as the similarity between the signs (I have already found this to be at the lower end of the scale), the goods (identical) and the reputation/distinctiveness of the DORMA mark (present/high) I do not consider that the relevant consumer will even bring to mind one mark when the other is encountered. Without this, the relevant consumer will not establish a link between the respective marks.

55. This is, effectively, the end of it. However, in my assessment on the likelihood of confusion, I stated that I could not rule out the possibility that for a small minority of consumers DGL's mark may be brought to mind when encountering RH's mark. A possible bringing to mind by a small minority of consumers is not enough to satisfy the

relevant consumer test under section 5(3) for the establishment of a link. However, in case I have under-estimated the degree to which the respective marks may be brought to mind, and in case, on appeal, it is found that a significant part of the relevant consumer group would bring the respective marks to mind, I will consider whether this is sufficient to establish a link.

56. Whilst a mere bringing to mind would not be enough for a finding under section 5(2), such an association, taking into account the language utilised by the ECJ in *Adidas-Salomon*, would be enough for the consumer to at least establish a link between the respective marks. Therefore, if a significant part of the relevant consumer group did bring the marks to mind then this would be sufficient, in my view, for the establishment of a link on the part of the relevant consumer. Therefore, although my primary finding is still that a link will not be established by the relevant consumer then, in case I am found to be wrong on this, I will assess whether the link I have described in the preceding paragraph will lead to the heads of damage required under section 5(3).

57. In his evidence for DGL, Mr Walker finishes his evidence with the following statement:

“By adopting BELLE DORM the Applicants clearly intend to misrepresent that their goods emanate from or are associated with DGL. This will inevitably lead to damage of DGL’s business in both loss of potential sales, and damage to DGL’s reputation.”

In DGL’s statement of grounds, the claim under section 5(3) finishes with the statement:

“The word “DORM” is phonetically and visually similar to DORMA and its use by the Applicant, without due cause will take unfair advantage of or be detrimental to the distinctive character and reputation of the opponent’s Mark.”

58. Mr Walker’s comments tell me little about what head of damage is particularly relevant or why. His comments are tied more to a misrepresentation and the damage that will result. Misrepresentation is not at issue here (certainly not since my findings under sections 5(2) & 5(4) of the Act). Neither are DGL’s comments in its statement of grounds particularly helpful as it does little more than borrow the wording of the relevant legislation. No submissions have been received to shed any further light on DGL’s concern. Whilst all this is unhelpful, this does not, in itself, rule out a finding in its favour under section 5(3). I will therefore assess the various heads of damage to see if there are any obvious findings that can be made in DGL’s favour.

Heads of damage

59. In its judgment in *Sigla SA v OHIM* (Case T-215/03) the CFI set out and described the heads of damage applicable under article 8(5) of Regulation No 40/94 (section 5(3) as incorporated into the Act).

In relation to detriment to distinctive character the CFI stated:

“37. So far as concerns, first, detriment to the distinctive character of the earlier mark by the use without due cause of the mark applied for, that detriment can occur where the earlier mark is no longer capable of arousing immediate association with the goods for which it is registered and used (*SPA-FINDERS*, paragraph 34 above, paragraph 43). That risk thus refers to the ‘dilution’ or ‘gradual whittling away’ of the earlier mark through the dispersion of its identity and its hold upon the public mind (Opinion of Advocate General Jacobs in *Adidas-Salomon and Adidas-Benelux*, paragraph 36 above, point 37).”

In relation to detriment to repute the CFI stated:

39. As regards, secondly, detriment to the repute of the earlier mark by the use without due cause of the mark applied for, it must be pointed out that such detriment is made out where the goods or services covered by the mark applied for may appeal to the public’s senses in such a way that the earlier mark’s power of attraction is diminished (*SPA-FINDERS*, paragraph 34 above, paragraph 46). The risk of that detriment can, inter alia, occur where those goods or services have a characteristic or a quality which may have a negative influence on the image of an earlier mark with a reputation on account of its being identical or similar to the mark applied for.

In relation to unfair advantage being taken of the distinctive character or the repute the CFI stated:

40. Lastly, the concept of the unfair advantage taken of the distinctive character or the repute of the earlier mark by the use without due cause of the mark applied for encompasses instances where there is clear exploitation and ‘free-riding on the coat-tails’ of a famous mark or an attempt to trade upon its reputation (*SPA-FINDERS*, paragraph 34 above, paragraph 51). In other words, this concerns the risk that the image of the mark with a reputation or the characteristics which it projects are transferred to the goods covered by the mark applied for, with the result that the marketing of those goods is made easier by that association with the earlier mark with a reputation.

41. That last type of risk must be distinguished from the likelihood of confusion covered by Article 8(1)(b) of Regulation No 40/94. According to settled case-law, a likelihood of confusion is defined as the likelihood that the public might believe that the goods or services covered by the mark applied for come from the same undertaking or, as the case may be, from economically-linked undertakings (Case

T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraph 25; see also, by analogy, Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 29, and Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 17). By contrast, in cases covered by Article 8(5) of Regulation No 40/94, the relevant section of the public makes a connection, that is to say, establishes a link, between the marks at issue without, however, confusing them (see, by analogy, *Adidas-Salomon and Adidas Benelux*, paragraph 32 above, paragraph 29). Therefore, the existence of a likelihood of confusion is not a condition for the application of that provision (see, by analogy, Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 20).

42. On the basis of the foregoing, the difference between the risk of unfair advantage being taken, within the meaning of Article 8(5) of Regulation No 40/94, and the likelihood of confusion may be summarised as follows: there is a likelihood of confusion where the relevant consumer may be attracted by the product or service covered by the mark applied for by considering it to be a product or service with the same commercial origin as that covered by an earlier mark which is identical or similar to the mark applied for. By contrast, the risk that the use without due cause of the mark applied for would take unfair advantage of the distinctive character or the repute of the earlier trade mark continues to exist where the consumer, without necessarily confusing the commercial origin of the product or service in question, is attracted by the mark applied for itself and will buy the product or service covered by it on the ground that it bears that mark, which is identical or similar to an earlier mark with a reputation.

60. Detriment to distinctive character is often referred to as “dilution” (see the CFI’s statement above) which involves a process whereby, applied to the circumstances of this case, the use of RH’s mark will water down the identity of DGL’s mark with the result that the DGL’s mark is no longer capable of arousing immediate association with its goods. In my view, the link, if one does exist, will not be strong enough for such dilution to occur. Even though one mark may be brought to mind when encountering the other, it seems to me that the inherent differences between them mitigate against any impact on DGL’s mark such that it is no longer capable of arousing immediate association with its goods. The use of BELLE DORM will not, in my view, dilute or disperse DORMA’s distinctiveness; it will be just as distinctive and just as capable of pointing towards its goods as it would without RH’s use. In the absence of any evidence or further information to suggest otherwise, **my finding is that no obvious detriment will be caused to the distinctive character of DGL’s mark by the use of RH’s mark;**

61. The example of detriment to repute identified by the CFI in the above statement is perhaps the most obvious form that such detriment is likely to take. To that extent, there is nothing inherent in RH’s goods that would have an obvious negative influence on the image or reputation of DGL’s mark. Indeed, the goods in question are identical. Therefore, I cannot see how RH’s use of its mark would damage DGL’s reputation. There is an argument that there is potential for RH’s mark to be used on low quality goods and that this could, as a consequence, damage DGL’s reputation. However, this line of argument was dismissed by Lindsay J. in *e-sure Insurance Limited v Direct Line*

Insurance Plc [2007] EWHC 1557 (Ch) at paragraph 127 of his decision⁷. I also take the view that the link itself would not, in any event, be strong enough so as to cause detriment to DGL's repute. In the absence of evidence to establish detriment to repute, or submissions to highlight why, on the basis of the evidence, there is such detriment; **I find that no detriment to the repute of DGL's mark will be caused by the use of RH's mark.**

62. Finally, in relation to unfair advantage, often referred to as "free-riding", I must be satisfied, due to the link (if one exists) between the marks, that the image or reputation of DGL's mark is, effectively, transferred to RH's mark with the result that the job of marketing and selling RH's goods becomes easier. Again, I see no obvious reason why this would result. The link between the two marks is not strong enough for the reputation to be so transferred. Further, whilst I have found DGL's mark to be of a reputable nature associated with good quality, this, in itself, is not a highly unusual circumstance and given that there is nothing, other than this, that creates any particular image (for example an image of exclusiveness or luxury) in the mind of the consumer, then the allegation of unfair advantage is even less obvious. **I find that the use of RH's mark would not take unfair advantage of DGL's distinctive character or repute.**

63. Given my findings that none of the heads of damage are made out, there is no need for me to deal with the issue of due cause. Due cause is, effectively, a defence⁸ to any finding under one of the heads of damage. In these circumstances, it is not in issue.

CONCLUSION

64. All of DGL's grounds of opposition have failed. Its opposition is, therefore, rejected.

COSTS

65. RH has been successful and is entitled to a contribution towards its costs. I hereby order Dorma Group Limited to pay Richard Haworth Limited t/a Beldorm the sum of £1250. This sum is calculated as follows:

Considering notice of opposition	£200
Statement of case in reply	£300
Considering DGL's evidence	£250
Filing its own evidence	£500
Total	£1250

⁷ although his decision was the subject of appeal, the Court of Appeal did not disturb this finding

⁸ See to that effect the decision of Neuberger J. in *Premier Brands UK Ltd v Typhoon Europe Ltd* [2000] ETMR 1071

66. 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 11th day of August 2008

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