

TRADE MARKS ACT 1994

**IN THE MATTER OF
APPLICATION No 2302458
BY LESLEY ANNE GALE CLARKE
TO REGISTER A TRADE MARK
IN CLASS 3**

DECISION AND GROUNDS OF DECISION

BACKGROUND

1. On 10 June 2002, Lesley Anne Gale Clarke of 130 Mount Street, London, W1Y 5HA applied to register the following series of four trade marks in Class 3:

KEEP CALM

LESLEY CLARKE

KEEP CALM

KEEP CALM

LESLEY CLARKE

KEEP CALM by LESLEY CLARKE

2. The specification of goods was as follows:

“Cleaning preparations, soaps, perfumery, essential oils, cosmetics and dentifrices; household and room fresheners, fragrances and perfumes; bath salts, beauty masks, breath freshening sprays, cosmetic kits, incense, nail care articles and preparations, potpourris; toiletries and toilet preparations; preparations for the care of the skin and the body; suntanning preparations; preparations for reinforcing and strengthening nails; preparations for use in the bath; oil, gel and foam preparations for use in the shower and the bath; preparations for toning the body, all being non-medicated; aftershaves, milks, oils, creams, gels, powders and lotions; shaving foams; toilet waters; anti-perspirants; deodorants for personal use; depilatories, cleansing masks for the face; eye make-up remover; nail polish, nail base coat, nail varnish remover, cuticle lotions, nail revitalising lotions, bronzing creams, cosmetic products for make-up, foundations, blushers, eye shadows, eye pencils and crayons, mascara, lipsticks”.

3. Objection was taken under Section 41(2) of the Act as the marks were not considered to be a series of marks as they differed from each other in their material particulars.

4. An objection was also taken under Section 3(1)(b) of the Act against the first mark of the series (“KEEP CALM”) as it was considered devoid of any distinctive character for goods that enabled a person to keep calm.

5. A hearing was held on 10 December 2002 at which the applicant was represented by Mr Matthews of Prentice & Matthews, their trade mark attorneys. At the hearing, the hearing officer, Mr Jones, confirmed that the Section 3(1) objection could be overcome by suitable limitation of the specification as follows:

“Cleaning preparations, soaps, perfumery, cosmetics and dentifrices; beauty masks, breath freshening sprays, cosmetics for inclusion in cosmetic kits, nail care articles and preparations, potpourris; suntanning preparations; preparations for reinforcing and strengthening nails; aftershaves, cleansing milk, degreasing oil, face cream, hand cream, face gel, powders, face-cleansing lotion; shaving foams; toilet waters; anti-perspirants; deodorants for personal use; depilatories, cleansing masks for the face; eye make-up remover; nail polish, nail base coat, nail varnish remover, cuticle lotions, nail revitalising lotions, bronzing creams, cosmetic products for make-up, foundations, blushers, eye shadows, eye pencils and crayons, mascara, lipsticks”.

In subsequent correspondence dated 12 December 2002 from Prentice & Matthews, it was agreed : a) to proceed in respect of the first mark only (“ KEEP CALM”) to overcome the objection under Section 41(2) of the Act, and b) to proceed for the amended specification of goods detailed above which would overcome the Section 3(1)(b) objection.

6. The application was advertised on 28 February 2003. In a letter dated 2 May 2003, Grant Spencer Caisley and Porteous (hereafter referred to as “GSCP”) filed observations relating to this application under Section 38(3) of the Act on behalf of The Virgin Cosmetics Company Limited who are the proprietors of United Kingdom registration number 2134387 for the mark “STAY CALM” which was registered on 25 September 1998 in respect of the following goods in Class 3:

“Preparations for the hair, scalp, skin and nails; soaps; non-medicated toilet preparations, toilet articles included in Class 3; cosmetics; depilatory preparations; dentifrices; fragrances, perfumes; cotton wool; sun-tanning preparations, bronzing preparations for the skin; toiletries”.

The observations were based on the fact that the words “KEEP CALM” conveyed the same meaning and were so similar that a likelihood of confusion would arise, thus failing to meet the requirements of Section 5(2) of the Act. The Registrar informed Prentice & Matthews of these observations in a letter on 19 May 2003 which included a copy of the letter from GSCP.

7. The application was subsequently opposed by The Virgin Cosmetics Company Limited on 28 May 2003 and the Registrar informed GSCP that matters regarding the observation would be suspended to await the outcome of these opposition proceedings. In a letter of 26 November 2003, Mr Bowen (Assistant Principal Hearing Officer) wrote to Prentice & Matthews informing them that he would serve the Form TM8 and Counterstatement on the opponents and that the opposition proceedings would be stayed

for the case to be remitted back to the examination division for further consideration, but this course of action was unacceptable to Prentice & Matthews. However, in a hearing before Mrs Corbett on 29 January 2004 where Prentice & Matthews represented the applicant, it was decided that the opposition would be stayed to allow the post advertisement observations to be dealt with.

8. The Registrar then wrote to Prentice & Matthews on 4 February 2004 confirming that the application was accepted in error as registration of the mark would be contrary to Section 5(2)(b) of the Act due to the existence of earlier registered trade mark no. 2134387 for the mark "STAY CALM". The objection under Section 5(2)(b) was maintained and Notice of Refusal was issued on 19 April 2004.

9. I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Marks Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.

10. No evidence has been put before me, therefore no claim under Section 7 of the Act has been made.

DECISION

The Law

11. Section 5(2)(b) of the Act reads as follows:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

12. An earlier trade mark is defined in Section 6(1). The relevant part states:

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

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

13. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro Goldwyn Mayer Inc* [1999] E.T.M.R. 1. *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723.

It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG*;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*; who is deemed to be reasonably well informed and reasonably circumspect and observant – but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*;
- (g) 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*;
- (h) 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*.

Similarity of the goods

14. The applicant's mark "KEEP CALM" has been published in Class 3 for a range of goods which are in clear conflict with the goods contained within the specification of the earlier registered trade mark "STAY CALM". The specification of the earlier mark contains "*preparations for the hair, scalp, skin and nails; soaps; non-medicated toilet*

preparations, toilet articles included in Class 3; cosmetics; depilatory preparations; dentifrices; fragrances, perfumes; cotton wool; sun-tanning preparations, bronzing preparations for the skin; toiletries". These terms cover both identical and similar goods to those contained within the specification of the applicant's trade mark.

Similarity of the marks

15. As the trade mark of this application is not identical to the earlier trade mark, the matter falls to be decided under sub-section (b) of Section 5(2) of the Act. The question is therefore whether the mark of this application is so similar to the earlier trade mark that there exists a likelihood of confusion which includes the likelihood of association on the part of the public.

16. The similarity of the marks must be assessed by reference to the visual, aural and conceptual similarities of the trade marks. It is clear from the judgment of the ECJ in the case of *Sabel BV v. Puma AG* that I must assess the overall impressions created by the marks, bearing in mind their distinctive and dominant components.

17. The applicant's trade mark is the words "KEEP CALM" whereas the earlier trade mark is for the words "STAY CALM", the difference between them being that the earlier trade mark contains the word "STAY" in place of the word "KEEP" in the applicant's trade mark. At this stage, I consider it useful to note the following dictionary references of the words "STAY" and "KEEP" from Collins English Dictionary (5th Edition pub. 2000) which state:

"KEEP (sense 4) – to remain or cause to remain in a specified state or condition eg, keep the dog quiet";

"STAY (sense 1) – to continue or remain in a certain place, position etc eg, to stay outside".

I therefore consider the phrases "KEEP CALM" and "STAY CALM" convey the same meaning, as the words "KEEP" and "STAY" are interchangeable. Whilst there is some degree of visual or aural similarity, the conceptual similarity, when taking into account the aforementioned dictionary definitions and the common occurrence of the word "CALM" in both marks, is in my view clear.

Likelihood of confusion

18. I must of course bear in mind that a mere possibility of confusion is not sufficient (see eg *React Trade Mark* [2000] RPC 285 at page 290). The Act requires that there must be a likelihood of confusion. I have already found the goods to contain both identical and similar goods.

19. Furthermore, it is now well established that the matter must be determined by reference to the likely reaction of an average consumer of the goods in question, who is

deemed to be reasonably well informed, reasonably observant and circumspect. The average consumer generally relies upon the imperfect picture of the earlier trade mark that they have kept in their mind and must therefore rely upon the overall impression created by the trade marks in order to avoid confusion. In this instance, I consider that the similarity in conceptual identity of the marks due to their visual and aural resemblance, combined with the identical and/or similar nature of the goods, is sufficient to give rise to a likelihood of confusion within the meaning of Section 5(2)(b) of the Act.

CONCLUSION

20. In this decision, I have considered all of the documents filed by the applicant and all of the arguments submitted to me in relation to this application and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Section 5(2) of the Act.

Dated this 24th day of August 2004

**G HICKS
For the Registrar
The Comptroller-General**