

O/320/12

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 2581357A
BY NICOLA FLETCHER
FOR THE TRADE MARK:**

POLITE

AND

OPPOSITION THERETO (NO 102554A) BY DE RIGO S.P.A.

The background and the pleadings

1) Application 2581357 was filed by Ms Nicola Fletcher on 6 April 2011, and published on 29 July 2011. The application was subsequently divided, and these opposition proceedings are in respect of application 2581357A. The mark and the goods for which registration is sought are as follows:

POLITE

Class 25: Clothing, footwear and head gear.

2) De Rigo S.P.A. opposes the registration of the application. Its opposition was filed on 24 October 2011 on a ground under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). One earlier mark is relied on: Community Trade Mark 8327512 which was filed on 28 May 2009 for the word mark POLICE in respect of goods in Classes 9, 18 and 25. In these opposition proceedings only the following goods are relied upon:

Class 25: Clothing (except police uniforms), footwear, headgear.

The opponent’s mark constitutes an earlier mark in accordance with section 6 of the Act, and is not subject to the proof of use conditions contained in section 6A of the Act, as its registration procedure had not been completed more than five years before the publication of Ms Fletcher’s mark.

3) Ms Fletcher filed a counterstatement denying the ground of opposition. Both parties filed written submissions. Only the opponent filed evidence. Neither party requested to be heard. I therefore give this decision after a careful review of all the papers before me.

The evidence

4) It consists of a witness statement of 28 March 2012 from Mr Michael Harry Elliot, who explains that he is a registered trade mark attorney employed by Ancient Hume Limited, which represents the opponent in these proceedings. He attaches exhibits, which he states result from his searches on the internet for the term “Polite Notice” (**Exhibits MHE1 to 3**) and from Ancient Hume’s file on the opposition, showing how the mark is used in practice and how the word POLICE appears on police uniforms (**Exhibit MHE4**):

- **Exhibit MHE1** consists of a blog posted on www.macmillanmdictionaryblog.com on 6 December 2010, which comments on notices using the term “Polite Notice”, observing, amongst other things, that they may exploit the possibility of being misread for “police notice” to lend themselves “legitimacy”.
- Similarly, **Exhibit MHE2** consists of an entry on <http://everything2.com> dated 15 March 2003. It is a short item, arguing that “Polite notice” signs are

occasionally seen in the UK bearing simple instructions such as “please drive slowly”, and that they are always blue and white. It is opined that the reason for this is that they are meant to be “taken in” as police notices and acted upon accordingly, the word “polite” looking very similar to the word “police”.

- **Exhibit MHE3** consists of:

1. a copy of a print-out from [www.rockinghorseequestrian.com/product/Polite NoticeHigh Viz Waistcoat RH4000](http://www.rockinghorseequestrian.com/product/Polite%20NoticeHigh%20Viz%20Waistcoat%20RH4000), showing an Equisafety “Polite Notice High Viz Waistcoat”, on the back of which the word POLITE has been reproduced in white block letters against a rectangular dark background frame in the manner of police signage, as shown below;



2. a thread of posts on www.horseandhound.co.uk/forums, dated 3 September 2011. One of the posts refers to this item (giving the link above), commenting that it looks very much like a police vest, and reporting some reaction from passers-by apparently reflecting this; two other posts report that drivers pass by them more slowly when they are wearing it.

- **Exhibit MHE4** contains webshots dated 23 October 2011, showing use of the word POLICE on police clothing, and how the use of the word POLITE, reproduced in white block letters against a rectangular dark background frame (possibly dark blue – the colour is not clear in the reproduction), mirrors this appearance on Equisafety products, as shown in Annex 1 and Annex 2 to this decision.

The law: section 5(2)(b)

5) Section 5(2)(b) of the Act reads:

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

(a)

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

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

6) In reaching my decision I have taken into account the guidance provided by the Court of Justice of the European Union (“CJEU”) in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Case C-3/03 Matrazen Concord GmbH v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05). In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10) Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases:

"(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, 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, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either *per se* or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) 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;

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion."

The average consumer

7) According to the case-law, the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting goods or service providers can, however, vary depending on what is involved (see, for example, the judgment of the General Court ("GC") in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)). The average consumer for clothing, footwear and head gear will consist of the general public. Although the goods may vary in price, consumers will often try them on to check the fit. They will examine them from the point of view of personal taste and suitability for purpose, and the appearance of the articles will normally be an important consideration for them. They will therefore pay a reasonable degree of attention (but no higher or lower than the norm) when selecting clothes, and the selection process will normally be a predominantly visual one, although aural similarity will not be ignored in my analysis.

Comparison of the goods

8) Save for the exclusion of police uniforms from clothing in the specification of the opponent's mark (which is not of practical significance in this case), the goods relied on by the opponent are identical with those sought by Ms Fletcher.

The distinctiveness of the earlier mark

9) The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark (based either on inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). Except for police uniforms (which have been excluded from the specification for obvious reasons), the word POLICE is not descriptive or allusive in any way of the clothing, footwear or headgear covered by the opponent's mark. As such it enjoys a reasonable degree of distinctiveness in respect of those goods. No use of the earlier mark has been filed, so there is no enhancement of this reasonable degree of distinctiveness.

Notional and fair use

10) I have to consider the fair and notional use of the marks. Ms Fletcher's mark is represented in black and white (white on a rectangular black background), without an indication that the black and white colouring is a feature of the mark. Notional and fair use would, therefore, include white letters against a blue background; the opponent's mark may also include such notional and fair use.

11) The opponent has submitted evidence intended to show how the mark is used by Equisafety Ltd. No evidence has been submitted to specify the precise relationship between Ms Fletcher and Equisafety Ltd. However, in her application for the mark Ms Fletcher enters "Equisafety" under her own name, gives the same address as that shown for Equisafety Ltd in the documents in **Exhibit MHE4**, and enters "Equisafety Ltd" under "Your reference". There is therefore clearly a close relationship from which it can be inferred that use of the mark by Equisafety is approved by Ms Fletcher.

12) The opponent submits that such use mimics the way in which the word POLICE is used on some items of police clothing in this country, as demonstrated by the illustrations in **Exhibit MHE4** (reproduced in Annexes 1 and 2 to this decision). With regard to whether such use should count as notional and fair use of Ms Fletcher's mark I note the following:

In *Premier Brands v Typhoon* [2000] FSR 767 (at page 779) Neuberger J observed:

"In my judgment, in the absence of argument or evidence to the contrary, the way in which the proprietor actually uses the mark can be said, at the very least prima facie, to be the paradigm case of its use in a normal and fair manner".

In *OPEN COUNTRY* (2000 RPC 477) page 482, lines 1-7, Aldous L.J. said:

"The test laid down in Smith Hayden, adapted in accordance with the speech of Lord Upjohn in BALI, is the test applicable whether the applicant has or has not used his trade mark. However, no court would be astute to believe that the way that an applicant has used his trade mark was not a normal and fair way to use it, unless the applicant submitted that it was not. It does not follow that the way that the applicant has used his trade mark is the only normal and fair manner. However in many cases actual use by an applicant can be used to make the comparison".

13) As already stated, the use of the applied for mark in white on a dark blue rectangular background may be a notional and fair use to be considered. In terms of the other forms of use, the sign appears as one of a number of other characteristic features – the other words and lettering on the garments, their cut, their high-visibility yellow colouring, the use of distinctive chequered marking, etc. – which, taken together, create an overall impression of similarity with the reflective waistcoats, jackets, etc. used by the police. To my mind, this complex form of use goes beyond the realms of what ought to reasonably be considered as notional and fair use of the applied for mark; the form of use may not even be regarded as trade mark use – this exemplifies the problem. I will not include in the comparison of marks anything other

than the mark applied for, used in white letters on a dark, possibly blue, background. Nevertheless, I find that the evidence does establish that in terms of the notional and fair use of the mark which is the subject of the opposition, whether it is reproduced in white on a dark background as applied for, or white on a blue background, it is intended to mimic the type of signage used by the police force.

Comparison of the marks

14) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the marks must be assessed by reference to their overall impressions, bearing in mind their distinctive and dominant components. The marks to be compared are:

The opponent’s mark	Ms Fletcher’s mark
POLICE	

15) The opponent’s Mark consists exclusively of the word POLICE which, as the sole component of the mark, constitutes its dominant and distinctive element. Ms Fletcher’s mark consists of the word POLITE, shown in white in block capitals against a plain dark background. The dominant and distinctive component of the mark is clearly the word POLITE.

16) Visually, the words of the two marks are of the same length, their beginnings are the same, and they end with the same letter. However, the penultimate letters (C and T), are different and bear no real resemblance to each other. A further visual difference consists of the “negative” presentation of the word POLITE in white against a dark background, but I do not consider that this not uncommon manner of presentation provides a significant distinguishing feature. The opponent’s mark, as stated earlier, could also notionally be used in the same way. I conclude that there is a reasonable degree of visual similarity between the marks.

17) From an aural perspective, the opponent’s mark will be pronounced PO-LEECE; Ms Fletcher’s mark will be pronounced PO-LITE. They begin with the same sound, but end quite differently. There is only a low degree of aural similarity.

18) There is an obvious and pronounced conceptual difference between the words POLICE and POLITE. The conceptual hooks to which these two words give rise will be quite different. Even if the average consumer perceives the presentation of Ms Fletcher’s mark as being evocative of the type of presentation used by the police force, the concept that will be packed away for recall will be the word POLITE. There is clear conceptual dissimilarity between the marks.

Likelihood of confusion

19) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17); a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific

formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer, and determining whether they are likely to be confused.

20) I have found the goods specified in the application to be identical to goods covered by the earlier mark. I have found the earlier mark to possess a reasonable degree of inherent distinctive character. I have found the marks to have a reasonable degree of visual similarity, a low degree of aural similarity, but to be conceptually different. The CJEU has held that conceptual differences may sometimes counteract visual and aural similarities¹. This is not always the case². Nevertheless, I consider the strength of the conceptual difference to have significant capacity to do so in this case.

21) In its submissions the opponent invited me to find that in a trade mark context the average consumer would be susceptible to the same confusion as that attributed, for example, to the motorists and passers-by mentioned in its evidence. As I explained earlier, I cannot include the effect of the mark being combined with other signage reinforcing the link to the word POLICE, such as the word NOTICE or blue and white chequered lines. I therefore do not include in the comparison of marks anything other than the mark applied for, used in white letters on a dark, possibly blue, background. Some may find this evocative of the kind of presentation used by the police. However, the average consumer is aware that police forces in this country do not sell or trade mark their own clothing ranges (as the opponent also observed in its submissions). Furthermore, in the nature of things, a passer-by, particularly one driving a car, is hardly going to adopt the same level of appreciation and consideration as the average consumer selecting clothing products. Bearing in mind my assessment of the purchasing process, the average consumer, and the degree of care and attention s/he may be expected to use, I am not persuaded that an average consumer will misread or misrecall Ms Fletcher's trade mark as the word POLICE, or vice versa. An average consumer who was not put in mind of the police sign would be no more likely to misread the word.

22) Bearing all this in mind, allowing for imperfect recollection, and having regard to the interdependency principle, I do not consider there is a likelihood that the average consumer will confuse the marks. Accordingly, **the opposition fails.**

Costs

23) Ms Fletcher has been successful and is entitled to a contribution towards her costs. I hereby order De Rigo S.P.A. to pay Ms Nicola Fletcher the sum of £700. This sum is calculated as follows:

<i>Preparing a statement and considering the other side's statement</i>	£200
<i>Considering evidence submitted by De Rigo S.P.A.</i>	£200 ³
<i>Written submissions</i>	£300

¹ The *Picasso Estate v OHIM* – C-361/04 P

² *Nokia Oyj v OHIM* – T-460/07

³ This is below the scale minimum, but reflects the fact that the Applicant did not file evidence herself.

24) 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 the 23rd of August 2012

**Martin Boyle
For the Registrar,
The Comptroller-General**

ANNEX 1



**POLITE SUMMER
360 REFLECTIVE
WRAP AROUND RUG**

£38.99



**POLITE
REFLECTIVE HAT
BAND**

£10.99



**POLITE SADDLE
CLOTH**

£40.00



**LED POLITE BODY
HARNESS**

£24.99



**POLITE
REFLECTIVE
WAISTCOAT**

£24.99



**POLITE ASPEY
JACKET**

£69.99



**POLITE QUILTED
GILLET**

£31.99



**POLITE
REFLECTIVE LEG
BOOTS**

£11.99



ANNEX 2

