

TRADE MARKS ACT 1994

IN THE MATTER OF:

OPPOSITIONS 94205 AND 94206

IN THE NAME OF LA CHEMISE LACOSTE SA

TO TRADE MARK APPLICATIONS 2338089 AND 2354259

IN THE NAME OF BAKER STREET CLOTHING LTD

DECISION

Introduction

1. On 18 July 2003, Baker Street Clothing Ltd (*'the Applicant'*) applied under number 2338089 to register the designation **ALLIGATOR** as a trade mark for use in relation to the following goods in Class 25:

articles of sports clothing; headgear; caps and hats; scarves; beachwear and swimwear; bathrobes; articles of underclothing; socks; articles of rainwear; articles of clothing being woven or knitted; denim wear, jeans, jumpers, pullovers, sweatshirts, rugby tops, shirts, pyjamas, cardigans, fleece tops and tracksuits.

2. Under application number 2354259 filed on 23 January 2004, the Applicant also sought to register the designation **ALLIGATOR** as a trade mark for use in relation to the following services in Class 35:

the bringing together for the benefit of others, of goods, namely, articles of sports clothing, headgear, caps and hats, scarves, beachwear and swimwear, bathrobes, articles of underclothing, socks, articles of rainwear, articles of clothing being woven or knotted, denim wear, jeans, jumpers, pullovers, sweatshirts, rugby tops, shirts, pyjamas, cardigans, fleece tops and tracksuits, enabling customers to view and purchase these goods from a retail store, mail order catalogues or on-line via the Internet and Internet websites; information, advisory and consultancy services relating to the aforesaid services.

3. Both applications were opposed by La Chemise Lacoste SA (*'the Opponent'*) on 9 March 2006. In its Notices and Grounds of Opposition the Opponent raised objections to registration under Sections 5(2)(b), 5(3), 5(4)(a) and 56 of the Trade Marks Act 1994.

4. In support of its objections to registration under Sections 5(2)(b) and 5(3), the Opponent relied on the rights to which it was entitled as proprietor of the following (among other) earlier trade mark registrations:

Community Trade Mark No. 2979565



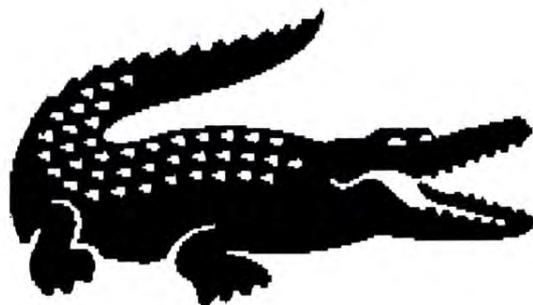
Filed: 17 December 2002

Registered: 5 April 2004

Classes: 18, 24 and 25

Class 25: Clothing, footwear, headgear

Community Trade Mark No. 2979581



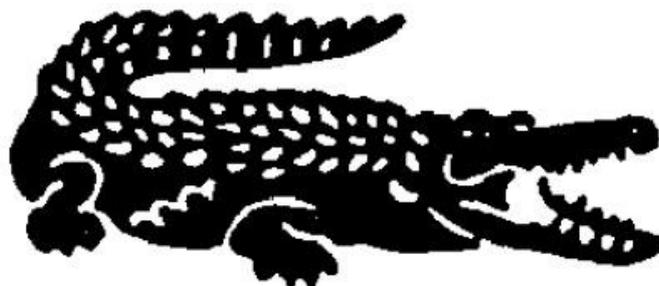
Filed: 17 December 2002

Registered: 26 May 2004

Classes: 1 to 45

Class 25: Clothing, footwear, headgear

United Kingdom Trade Mark No. 1178977



Filed: 22 July 1982

Registered: Not specified

Class 25: Articles of sports clothing, sweaters, pullovers, jackets, slacks, suits, gowns, dresses, socks being articles of clothing, stockings and articles of underclothing, stockings and articles of underclothing, but not including any of the aforesaid goods made from reptile skin or from imitation reptile skin.

5. In support of its objections to registration under Sections 5(4)(a) and 56, the Opponent relied on the rights it had acquired through use, independently of registration, by marketing clothing under and by reference to device marks identical and similar to those shown above.

The objection under Section 5(2)(b)

6. Section 5(2)(b) of the Act provides that:

A trade mark shall not be registered if because ... it is similar to an earlier trade mark and is to be registered for goods or services identical or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

7. The case law of the Court of Justice relating to the scope and effect of this objection is conveniently summarised in the following guidelines¹:

¹ The summary is taken from the decision of Mr. Allan James in Virgin Enterprises Ltd v. Bodtrade 54 (Pty) Ltd (BL O-216/09; 23 July 2009). The Judgments cited are Case C-251/91 Sabel BV v. Puma AG [1997] ECR I-6191; Case C-342/97 Lloyd Schuhfabrik Meyer & Co GmbH v. Klijsen Handel BV [1999] ECR I-3819; Case C-334/05 P Shaker di L Laudato & C SAS v. OHIM [2007] ECR I-4529; Case C-3/03 Matratzen Concord v. OHIM [2004] ECR I-3657; Case C-120/04 Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH [2005] ECR I-8551; Case C-39/97 Canon Kabushiki Kaisha v. Metro Goldwyn Mayer Inc [1998] ECR I-5507; and Case C-425/98 Marca Mode CV v. Adidas AG [2000] ECR I-4861.

(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 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 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 normally 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*, 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; *Shaker di L. Laudato & C. SAS v. OHIM*,

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

(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; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*,

(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.*,

(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*,

(i) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of [Art 5(1)(b)]; *Sabel BV v. Puma AG*,

(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; *Marca Mode CV v. Adidas AG and Adidas Benelux BV*,

(k) 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.*

The objection under Section 5(3)

8. Section 5(3) of the Act provides that:

A trade mark which ... 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 a Community trade mark or international trade mark (EC), 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.

9. The scope and effect of this objection was summarised by the Court of Justice in Case C-487/07 L'Oréal SA v. Bellure NV² at paragraphs [36] to [45] (with emphasis added):

36. The infringements referred to in Article 5(2) of Directive 89/104, where they occur, are the

² [2009] ECR I-5105.

consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them without confusing them. It is thus not necessary that the degree of similarity between the mark with a reputation and the sign used by the third party is such that there exists a likelihood of confusion between them on the part of the relevant section of the public. It is sufficient for the degree of similarity between the mark with a reputation and the sign to have the effect that the relevant section of the public establishes a link between the sign and the mark (see *Adidas-Salomon and Adidas Benelux*, paragraphs 29 and 31, and *adidas and adidas Benelux*, paragraph 41).

37. The existence of such a link in the mind of the public constitutes a condition which is necessary but not, of itself, sufficient to establish the existence of one of the types of injury against which Article 5(2) of Directive 89/104 ensures protection for the benefit of trade marks with a reputation (see, to that effect, *Intel Corporation*, paragraphs 31 and 32).
38. Those types of injury are, first, detriment to the distinctive character of the mark, secondly detriment to the repute of that mark and, thirdly, unfair advantage taken of the distinctive character or the repute of that mark (see, to that effect, *Intel Corporation*, paragraph 27).
39. As regards detriment to the distinctive character of the mark, also referred to as ‘dilution’, ‘whittling away’ or ‘blurring’, such detriment is caused when that mark’s ability to identify the goods or services for which it is registered is weakened, since use of an identical or similar sign by a third party leads to dispersion of the identity and hold upon the public mind of the earlier mark. That is particularly the case when the mark, which at one time aroused immediate association with the goods or services for which it is registered, is no longer capable of doing so (see, to that effect, *Intel Corporation*, paragraph 29).
40. As regards detriment to the repute of the mark, also referred to as ‘tarnishment’ or ‘degradation’, such

detriment is caused when the goods or services for which the identical or similar sign is used by the third party may be perceived by the public in such a way that the trade mark's power of attraction is reduced. The likelihood of such detriment may arise in particular from the fact that the goods or services offered by the third party possess a characteristic or a quality which is liable to have a negative impact on the image of the mark.

41. As regards the concept of 'taking unfair advantage of the distinctive character or the repute of the trade mark', also referred to as 'parasitism' or 'free-riding', that concept relates not to the detriment caused to the mark but to the advantage taken by the third party as a result of the use of the identical or similar sign. It covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation.
42. Just one of those three types of injury suffices for Article 5(2) of Directive 89/104 to apply (see, to that effect, *Intel Corporation*, paragraph 28).
43. It follows that an advantage taken by a third party of the distinctive character or the repute of the mark may be unfair, even if the use of the identical or similar sign is not detrimental either to the distinctive character or to the repute of the mark or, more generally, to its proprietor.
44. In order to determine whether the use of a sign takes unfair advantage of the distinctive character or the repute of the mark, it is necessary to undertake a global assessment, taking into account all factors relevant to the circumstances of the case, which include the strength of the mark's reputation and the degree of distinctive character of the mark, the degree of similarity between the marks at issue and the nature and degree of proximity of the goods or services concerned. As regards the strength of the reputation and the degree of distinctive character of the mark, the Court has already held that, the stronger that mark's distinctive character and reputation are,

the easier it will be to accept that detriment has been caused to it. It is also clear from the case-law that, the more immediately and strongly the mark is brought to mind by the sign, the greater the likelihood that the current or future use of the sign is taking, or will take, unfair advantage of the distinctive character or the repute of the mark or is, or will be, detrimental to them (see, to that effect, *Intel Corporation*, paragraphs 67 to 69).

45. In addition, it must be stated that any such global assessment may also take into account, where necessary, the fact that there is a likelihood of dilution or tarnishment of the mark.

10. In Case C-252/07 *Intel Corp Inc. v. CPM United Kingdom Ltd*³ at paragraph [60] the Court confirmed that *'the fact that, for the average consumer, who is reasonably well-informed and reasonably observant and circumspect, the later mark would call the earlier mark to mind is tantamount to the existence of such a link'*.

The objection under Section 5(4)(a)

11. Section 5(4)(a) of the Act provides that:

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

12. The question raised by the Opponent's objections under Section 5(4)(a) was whether normal use of the designation **ALLIGATOR** for the purpose of distinguishing goods or services of the kind specified by the Applicant would carry with it a likelihood

³ [2008] ECR I-8823.

of misrepresentation actionable at the suit of the Opponent in accordance with the law of passing off.

13. For the purpose of determining that question it would be appropriate to take account of the following observations of Lord Cranworth LC in Seixo v. Provezende⁴ (with emphasis added):

What degree of resemblance is necessary from the nature of things, is a matter incapable of definition *à priori*. All that courts of justice can do is to say that no trader can adopt a trade mark so resembling that of a rival, as that ordinary purchasers, purchasing with ordinary caution, are likely to be misled.

It would be a mistake, however, to suppose that the resemblance must be such as would deceive persons who should see the two marks placed side by side. The rule so restricted would be of no practical use.

If a purchaser looking at the article offered to him would naturally be led, from the mark impressed on it, to suppose it to be the production of the rival manufacturer, and would purchase it in that belief, the Court considers the use of such a mark to be fraudulent. But I go further. I do not consider the actual physical resemblance of the two marks to be the sole question for consideration.

If the goods of a manufacturer have, from the mark or device he has used, become known in the market by a particular name, I think that the adoption by a rival trader of any mark which will cause his goods to bear the same name in the market, may be as much a violation of the rights of that rival as the actual copy of his device. It is mainly on this ground that I have come to the conclusion that the decision of the Vice-Chancellor in the present case was correct.

⁴ (1866) LR 1 Ch. App. 192 at pp. 196, 197.

The objection under Section 56

14. Section 56 of the Act provides a remedy for the protection of ‘well-known trade marks’. It does so without providing a basis for objection to the registration of a trade mark independently of the provisions of Sections 5(1) to (4)⁵. The Opponent’s independently pleaded objections under Section 56 were unmaintainable for that reason.

Outcome in the Registry

15. The oppositions succeeded under Section 5(2)(b) of the Act, on the basis of the earlier trade mark registrations identified in paragraph [4] above, for the reasons given by Mr. David Landau in a written decision issued on behalf of the Registrar of Trade Marks under reference BL O-047-09 on 20 February 2009. The Applicant was ordered to pay £2,300 to the Opponent as a contribution towards its costs of the proceedings in the Registry.

16. The Hearing Officer did not separately assess the Opponent’s objections under Sections 5(3) and 5(4)(a) of the Act: ‘... *I cannot see that Lacoste’s position can be any better under section 5(4)(a) of the Act than it is under section 5(2)(b) of the Act. ... If I am wrong in relation to my findings under section 5(2)(b) then I cannot see that Lacoste can succeed under section 5(3)*’. He thus appears to have decided that on applying the relevant legal criteria to the Opponent’s objections, the outcome of the oppositions would,

⁵ Melly’s Trade Mark Application (FIANNA FAIL and FINE GAEL Trade Marks) [2008] RPC 20, p.454 at paras. 26 to 29; EXPOSURE Trade Mark (BL O-107-08; 9 April 2008) at para. 5; see also the decision of the Second Board of Appeal at OHIM in Case R 1399/2007-2 Nova Hotels Ltd v. VRL International Ltd (27 June 2008) at paras. 13 and 17.

for better or worse, be the same under Section 5(3) and Section 5(4)(a) as under Section 5(2)(b).

17. That calls for comment. The question whether there are similarities between two marks is not the same as the question whether the similarities between them are sufficient to justify a refusal of registration under Section 5(2)(b), Section 5(3) or Section 5(4)(a) of the Act. Each of these provisions imposes particular criteria for determining whether the marks in issue are too close to co-exist legitimately in the marketplace, as indicated above. The Opponent's objections under Section 5(2)(b) were narrower in scope than its objections under Section 5(3)⁶ and they were not necessarily exhaustive of the objections which could be pursued by reference to the rather less technical approach to protection adopted by Lord Cranworth LC in Seixo v. Provezende (above) under Section 5(4)(a). This was anything but a clear cut case on similarity of marks. It was necessary for a correct evaluation of the Opponent's objections to deal with each of them separately on their own merits.

18. I am left with the impression that the Hearing Officer declined to evaluate the objections separately because he thought the resemblance between the marks in issue could be placed on one side or the other of a single dividing line for the purpose of dealing with all three bases of objection collectively. I regard that as an error of approach. It did not allow for the possibility that the resemblance between the marks in issue might be sufficient to satisfy the requirements for objection under Section 5(3) or Section

⁶ Case C-487/07 L'Oréal SA v Bellure NV (above) paragraph [34] together with paragraph [59].

5(4)(a) without also being sufficient to satisfy the requirements for objection under Section 5(2)(b).

19. However, there is no application before me to reopen the oppositions on that ground. The Opponent decided to confine its case on appeal to enforcement of its objections under Section 5(2)(b).⁷ I am therefore not required to consider whether the oppositions might have succeeded on either of the alternative bases of objection under Section 5(3) or Section 5(4)(a).

The Hearing Officer's findings

20. The Hearing Officer's findings, as summarised by me, were as follows:

- (1) The Class 25 goods in issue are identical, and the Class 35 services in issue are to a high degree similar, to the Class 25 goods for which the Opponent's earlier trade marks are registered (paragraphs [3], [15] and [16]).
- (2) The marks protected by the Opponent's earlier trade mark registrations have been used extensively in relation to clothing and they had a reputation allied to '*an enormous degree of distinctiveness*' acquired through use prior to the date of the opposed applications for registration (paragraphs [7], [15] and [16]).
- (3) '*The evidence shows, in relation to reputation, that the crocodilian device is linked inextricably with the Lacoste name. Where the average, relevant consumer knows*

⁷ Transcript, pp. 7, 8.

the crocodilian device, that consumer will link it with the name of Lacoste and vice versa' (paragraph [8]).

(4) *'The reputation of the devices is tied inextricably with the name Lacoste. So those seeing the crocodilian are likely to think of Lacoste and those seeing Lacoste are likely to think of the crocodilian. This relationship strengthens and increases the reputation of the devices and strengthens and increases the reputation of the word, one feeds the other'* (paragraph [15]).

(5) The evidence did not establish that the Opponent's crocodilian marks would be seen as a crocodile rather than an alligator by the relevant average consumer, whether or not (s)he was aware of the marks: *'Consequently I come to the conclusion that there will be some who would describe the device as a crocodile and some who will describe the device as an alligator'* (paragraph [9]).

(6) Although the Opponent's case rested on the premise that consumers would convert its marks into words for the purpose of referring to them, there was no evidence that the average consumer went about his or her business referring to the alligator or the crocodile marks, nor of any reason why (s)he should: *'I do not consider that it can be accepted that it can be considered the norm for the average, relevant consumer to refer to the devices of Lacoste orally'* (paragraph 15).

(7) Despite the lack of visual similarity and the absence of any case for aural similarity between the marks in issue *'the scales are weighted towards Lacoste and ... the average relevant consumer will believe that goods and services sold*

under the respective trade marks emanate from the same or an economically linked undertaking' (paragraph 16).

21. It is clear that the Hearing Officer based his finding of a likelihood of confusion upon the presumed existence of a conceptual link between the Applicant's and the Opponent's marks in the mind of the relevant average consumer. I say 'in the mind' of the relevant average consumer in view of his findings noted at point (6). These exclude the possibility of aural similarity. I say 'presumed' in view of what he said in the following paragraph of his decision:

14) I have to decide if the average, relevant consumer on seeing the crocodilian devices will convert the images into words, will not just perceive the images but will convert them into the symbol representing the image; so making a conceptual link between the goods of Lacoste and the goods of Baker Street. If I see the picture of a crocodilian I do not convert it into its symbolic representation; all this tells me is how my brain deals with images. However, I do not doubt that others will convert the image into a word and store it in the memory as a word as well as an image. If I saw the word ALLIGATOR on clothing I would make no association with Lacoste's crocodilian devices: the word and the image are distinct in my mind. Others, however, may convert the devices into the word ALLIGATOR, this will be held in the memory and act as a hook for the memory; it will give rise to conceptual identity. I am fortified in my view as to how others may process the devices in their brains by the ex parte examinations; where two different examiners raised Lacoste's crocodilian devices as citations against the word ALLIGATOR; whether the raising of the citations was correct is not of importance, what is of importance is how they processed the images.

In point of fact there was no evidence of anyone other than the two Trade Marks Registry examiners having made the presumed conceptual link. They will have done so in the

performance of their duty to search for and cite earlier trade marks that might be thought to stand in the way of later applications for registration. Their mindset in that connection is one of comparing and contrasting trade marks. It is not the mindset of an ordinary consumer interested in acquiring goods or services under normal trading conditions.

The Appeal

22. The Applicant appealed to an Appointed Person under Section 76 of the 1994 Act contending, in substance, that the differences between the marks in issue were sufficient to enable them to be used concurrently in relation to goods and services of the kind in issue without giving rise to the existence of a likelihood of confusion.

23. At my request, the parties and the Registrar made written and oral submissions directed to the following question: what are the criteria for determining whether a verbal denomination so nearly resembles the graphic representation of a non-verbal mark as to be liable to trespass upon the inherent/acquired distinctiveness of the latter?

24. I understood the Applicant to contend as follows: (1) real as opposed to theoretical resemblance depends upon the existence of a propensity for each of the marks in question to remind people of the other; (2) even then the word mark will only be liable to trespass upon the inherent/acquired distinctiveness of the non-verbal mark if the link established by the reminder is sufficiently direct to result in the former being coupled with the latter in the minds of people exposed to the use of both in circumstances of the kind arising for consideration in the case at hand; and (3) even that will not be sufficient to substantiate an

objection to registration under Section 5(2)(b) of the Act in the absence of any resulting likelihood of confusion, as the case law of the Court of Justice has clearly confirmed.

25. I understood the Respondent to contend as follows: (1) a word mark is liable to trespass upon the inherent/acquired distinctiveness of a non-verbal mark if the relevant average consumer would regard each of them as an expression of the other; (2) that remains true even if there are various different word marks which the relevant average consumer would be liable to regard as expressions of the non-verbal mark; and (3) if the relevant average consumer would believe or assume that the word mark(s) and the non-verbal mark were linked consistently with the well-established practice among traders of using brand names which describe their logos, there would be a likelihood of confusion sufficient to substantiate an objection under Section 5(2)(b) of the Act within the parameters set by the existing case law of Court of Justice.

26. On behalf of the Registrar it was submitted:

- (1) As a matter of law, a word mark may constitute a similar mark to a picture mark which is likely to be re-produced, in the course of trade, as a spoken word corresponding to that word mark.
- (2) That appears to follow from the well established case law of the Court of Justice which requires trade marks to be compared by reference to their visual, aural and conceptual similarities, and that it is not necessary for marks to be similar under all three heads in order for there to be sufficient similarity between them to give rise to the existence of a likelihood of confusion.
- (3) The General Court proceeded consistently with that approach in Case T-389/03 Dainichiseika Colour & Chemicals Mfg. Co. Ltd v. OHIM (see particularly paragraphs 75-94) in which a picture mark featuring a pelican-like bird was held to be similar overall to a

word mark consisting predominantly of the word Pelikan. The Court appears to have held at paragraphs [79], [80], [88] and [94] that there could be a sufficient degree of aural similarity between a picture mark and a word mark where one of the two possible verbal expressions of the picture mark corresponds with that of the word mark, and a sufficiently large proportion of the public are liable to verbally express the picture mark using that word.

- (4) The critical question is whether and how to establish the aural and conceptual identity of a picture mark. Many picture marks could be given an aural identity if one set about doing so. That would be the wrong approach. The correct approach is to consider whether a relevant average consumer would naturally be liable to express the picture mark in words during the course of the relevant trade.
- (5) There are at least two factors which should be taken into account when making the assessment. Firstly, whether the subject matter represented in the picture corresponds to a well known being or thing for which a name (or names) readily springs to mind. Secondly, the ease with which the picture mark can be translated into a word or words.
- (6) Generally speaking, the more complex the subject of the picture, the less likely it is that consumers will attempt to give the mark oral expression. For example, a picture of a red bull may be expressed as the words 'red bull', whereas a picture of a monkey playing a piano in a saloon is unlikely to be expressed as words (although it may still make a strong conceptual impression).
- (7) It is relevant to consider whether average consumers would be likely to express the picture mark using the same or different words. The greater the ambiguity about that because the subject matter of the picture could just as easily and naturally be described using various alternative words, or the subject matter could just as easily be seen as one thing or another, the less weight that can be placed on the aural similarity between just one verbal expression of the picture mark and that of the word mark.

- (8) It matters for the purpose of assessing the likelihood of confusion arising from relevant aural and conceptual similarities between word and picture marks whether the (or one of the two) aural and conceptual identities of the picture mark would be identical, or merely similar, to the word mark. If to a substantial proportion of the relevant public the marks would sound identical, a lesser overall degree of similarity between the respective marks may still be sufficient to cause a likelihood of confusion.

27. There is substance in all of the submissions that were addressed to me. I am indebted to the parties and the Registrar for the assistance they have given me in relation to the question of similarity between marks which is central to the outcome of this appeal.

28. A number of decided cases were drawn to my attention and I propose to comment in relation to several of them before turning to my determination of the appeal.

The RED STAR case

29. In La Société Anonyme des Verreries de L'Etoile's Trade Mark⁸ the Court of Appeal held that the word mark **RED STAR BRAND** so nearly resembled a non-verbal mark in the form of a star registered in black-and-white as to be calculated to deceive people in the market for goods of the kind in which the parties to the proceedings were trading (window glass and plate glass). It was taken to be obvious, on the basis that the proprietors of the non-verbal mark were free to use it in any colour including red, that they could prevent La Société Anonyme des Verreries de L'Etoile from subsequently using or registering a device mark in the form of a red star.

⁸ (1894) 11 RPC 142 (CA).

30. The evidence before the Court showed that La Société Anonyme des Verreries de L'Etoile (in English 'The Star Glassworks Company') claimed distinctiveness for the denomination **RED STAR BRAND** on the strength of long standing and large scale use of the device of a red star in relation to its goods.⁹ In that regard, Kay LJ spoke in terms of the company '*finding they are unable to register a picture of a red star, they try to escape the Act of Parliament by registering the words Red Star*'.¹⁰ The words were found to be equivalent to the picture for the purposes of the objection to registration. Lindley LJ said¹¹:

Now it does seem a little startling that if they cannot register a simple red star they should be enabled to register the description of that very same thing in words, that is to say, that although they cannot appeal to the eye they may appeal to the ear. I cannot say that is right ... Two marks may be calculated to deceive either by appealing to the eye or to the ear, or one appealing to the eye and one appealing to the ear. Finding that the [earlier trade mark proprietors'] glass is sold as 'Star glass' or 'Star brand' and bearing in mind that the star may be in any colour, I cannot see that 'red star brand' is not calculated to deceive.

Kay LJ and A.L. Smith LJ agreed.

31. The observations of Lindley LJ reflect the approach to protection adopted by Lord Cranworth LC in Seixo v. Provezende (above). They were made in circumstances where it was not only clear that the word mark **RED STAR BRAND** was the functional equivalent of an established device mark in the form of a red star, but also regarded as obvious that the use of that device would trespass upon the inherent and acquired

⁹ at pp.143, 144.

¹⁰ at p.147, see also the observations of Stirling J. at first instance: (1893) 10 RPC 436 at p.440, lines 24 to 48.

¹¹ at pp.145, 146.

distinctiveness of the earlier trade mark proprietors' device mark in the form of a star registered in black-and-white. Both factors were, in my view, important to the reasoning of the Court of Appeal in that case.

32. A note of caution is required in relation to the way in which colour was addressed. The case was decided at a time when trade marks had to be distinctive independently of colour in order to be protectable by registration.¹² Section 67 of the Patents, Designs and Trade Marks Act 1883 (as amended) provided that:

A trade mark may be registered in any colour or colours and such registration shall (subject to the provisions of this Act) confer on the registered owner the exclusive right to use the same in that or any other colour or colours.

The effect of treating colour as both optional and variable was to give trade marks registered in colour '*the same advantages as registration in black-and-white*'¹³. In circumstances where it was considered '*obvious that colour is, as I have said, treated as an accident*',¹⁴ it could safely be said that registration (whether in black-and-white or in colour) afforded protection in all colours if not limited to particular colours. Which was indeed the approach adopted by the Court of Appeal in the **RED STAR** case.

33. Although Section 10 of the Trade Marks Act 1905 subsequently removed the requirement for a trade mark to be distinctive independently of colour, it adhered to the position that registration (whether in black-and-white or in colour) afforded protection in all colours if not limited to particular colours:

¹² In re Hanson's Trade Mark (1887) 37 Ch. D 112.

¹³ Sebastian The Law of Trade Marks 5th Edn. (1911) pp.602, 603.

¹⁴ In re Hanson's Trade Mark (above) at p.117 per Kay J.

A trade mark may be limited in whole or in part to one or more specified colours, and in such case the fact that it is so limited shall be taken into consideration by any tribunal having to decide on the distinctive character of such trade mark. If and so far as a trade mark is registered without limitation of colour it shall be deemed to be registered for all colours.

Section 10 was re-enacted as Section 16 of the Trade Marks Act 1938. However, Section 16 was not carried forward into the Trade Marks Act 1994. There is no legislative basis in the 1994 Act for requiring trade marks to be distinctive independently of colour; or for treating colour as '*an accident*' in the case of trade marks registered in colour; or for deeming trade marks registered without limitation of colour to be registered for all colours. In short, the consequences of registering trade marks in black-and-white and in colour are not the same now as they were when the **RED STAR** case was decided.

34. For the reasons I gave in the light of the case law I identified in paragraphs [8] to [10] of my decision in Mary Quant Cosmetics Japan Ltd v. Able C&C Co. Ltd¹⁵, I think it is necessary under the law as it now stands to proceed on the following basis. The registered representation of a trade mark is definitive as to the identity of the protected mark, with that being taken to consist only of the particular features which have actually been recorded in the register. The registration may show:

- (1) that the protected mark has been registered subject to a limitation or disclaimer making the use of particular colouring indispensable, in which case the absence of such colouring will prevent a finding of identity or similarity;

¹⁵ BL O-246-08 (22 August 2008).

- (2) that the protected mark has been registered in colour without any limitation or disclaimer confining it to the particular colouring recorded in the register, in which case the use of other colouring or no colouring will be sufficient to prevent a finding of identity but may not be sufficient to prevent a finding of similarity; or
- (3) that the protected trade mark has simply been registered in black-and-white, in which case colouring is optional hence inessential and therefore not a factor which permits or prevents a finding of identity or similarity relative to the mark as registered.

In effect, colouring is in the same degree (ir)relevant to a finding of identity or similarity as it is (im)material to the distinctiveness of the trade mark as registered. Registration in black-and-white provides protection unrelated to colour. Protection related to colour is the corollary of registration in colour. As the General Court has confirmed: *‘The presence of colours in the marks applied for essentially loses any significance for the comparison with the earlier mark because the earlier mark is a black-and-white image’*¹⁶.

35. The adoption of the above approach in the Whirlpool case at first instance¹⁷ does not appear to have been questioned on appeal to the Court of Appeal.¹⁸ It would result in the issue for consideration in the **RED STAR** case now being paraphrased as whether the word mark **RED STAR BRAND** was objectionably similar to the black-and-white device of a star registered for protection regardless of colour. It may be that the decision of the Court of Appeal in 1894 was broadly directed to the protection of the black-and-white

¹⁶ Joined Cases T-81/03, T-82/03 and T-103/03 Mast-Jägermeister AG v. OHIM [2006] ECR II-5409 at paragraph [104].

¹⁷ Whirlpool Corporation v. Kenwood Ltd [2008] EWHC 1930 (Ch); [2009] RPC 22 at paragraphs [8], [9].

¹⁸ Whirlpool Corporation v. Kenwood Ltd [2009] EWCA Civ. 753; [2010] RPC 2.

device regardless of colour, in the sense that it was a matter of no consequence whether the opposed word mark was **GREEN STAR BRAND**, **BLUE STAR BRAND**, **WHITE STAR BRAND** or **RED STAR BRAND** for the purposes of the test for deceptive resemblance. However, I think that in terms of the 1994 Act, the decision sits more easily within Section 5(4)(a) than Section 5(2)(b).

The GOLDEN FAN case

36. John Dewhurst & Sons Ltd's Trade Mark Application¹⁹ took the reasoning of the **RED STAR** case a step further. A trade mark containing Burmese words written in Burmese characters was held to be unregistrable in the United Kingdom on the basis that the words in question were the Burmese equivalent of '**THE GOLDEN FAN BRAND**'. That designation was considered to be deceptive by reason, in particular, of its propensity to trespass upon the inherent and acquired distinctiveness of a non-verbal mark containing a graphic representation of a fan registered in black-and-white.

37. The earlier trade mark had been used commercially with the fan coloured gold. It had not been used (and there was no intention that it should be used) in connection with any trading activities in or extending to Burma. However, that made no difference to the fate of the application for registration. Lindley LJ said²⁰:

I think that it does not matter what the language is, nor what the hieroglyphics are, if the meaning of the hieroglyphics or the meaning of the foreign language is a mere verbal description of a mark already on the Register. If you have got a mark on the Register, applicable to cotton goods, of a

¹⁹ (1896) 13 RPC 288 (CA).

²⁰ at p.295.

golden fan, you cannot have another mark called a “Golden Fan” in any language or in any hieroglyphics. That appears to me to be the real broad ground upon which we ought to decide this case.

Lopes LJ and Kay LJ delivered judgments to the same effect.

38. In finding that there was sufficient similarity between the Burmese words and the picture of a fan registered in black-and-white to render the Burmese words deceptive, the Court of Appeal adopted an approach to assessment which cannot reliably be transposed into the harmonised law of trade marks in the European Union. Colour is now addressed from a different perspective, as noted in paragraph [34] above. In addition, the nineteenth century view that *‘where any English word would be rejected as not entitled to registration, no person ought to be permitted to register its translation into any other language’*²¹ relatively quickly gave way to the twentieth century view that foreign words were registrable if they were capable of functioning satisfactorily as trade marks in the context of trading activities in or extending to the United Kingdom²² and the latter view continues to govern the question whether foreign words are registrable as trade marks for use in this country in the twenty-first century.²³

²¹ see paragraph 26 of the Herschell Committee Report (The Report dated March 16, 1888 of the Departmental Committee appointed by the Board of Trade on February 24, 1887 to inquire into the duties, organisation and arrangements of the Patent Office under the Patents, Designs and Trade Marks Act 1883 so far as relates to trade marks and designs).

²² EL CANAL DE LAS ESTRELLAS Trade Mark [2000] RPC 291 at pp.294, 295.

²³ Case C-421/04 Matratzen Concord AG v. Hukla Germany SA [2006] ECR I-2303 at paras. [22] to [32]; Di Gio’ Srl’s Trade Mark [2006] RPC17.

The PELICAN case

39. In Dainichiseika²⁴ the General Court upheld a decision of the Second Board of Appeal at the Community Trade Marks Office to the effect that it was difficult to avoid the perception of a pelican on seeing the following mark:



and that this would give rise to the existence of a likelihood of confusion in the event of concurrent use of the following mark:



in relation to identical and similar goods in Classes 1, 2 and 17.

40. The General Court considered that the marks shown above *'have a low degree of visual similarity, are conceptually identical and phonetically identical or very similar'*.²⁵

With regard to conceptual identity, it was taken to be obvious that the marks in issue would be perceived and remembered as 'pelican' marks.²⁶ The finding of phonetic

²⁴ Case T-389/03 Dainichiseika Colour & Chemicals Mfg. Co. Ltd v. OHIM [2008] ECR 00000.

²⁵ paragraph [96].

²⁶ paragraphs [79] to [81], [90] and [91].

resemblance was made on the basis that a substantial number of relevant consumers would refer to the non-verbal device mark by using the word in their native language corresponding to the term ‘pelican’.²⁷ It was emphasised that this was not a case of mere association between two trade marks as a result of their analogous semantic content:

.... the similarities between the signs at issue in the present case are numerous and go beyond mere concordance of elements which are derived from nature and, therefore, not very fanciful. It must be borne in mind, in particular, that the signs all contain the image of the same bird (a pelican) and that, both in the mark applied for and the earlier trade marks, that pelican is shown in left profile, as a white silhouette with a black outline, inside a circle, sitting on a white base with a black outline...²⁸

41. The Judgment is of interest for present purposes because it confirms that due weight must be given to the way in which a non-verbal mark is likely (if it is likely) to be vocalised by the relevant average consumer for the purpose of distinguishing the trade mark proprietor’s goods or services from those of other suppliers. The General Court treated the likely vocalisation as an attribute of, not a substitute for, the non-verbal mark in issue. It did not elaborate on the criteria to be used for the purpose of deciding whether there is a relevant likelihood of vocalisation. It did not decide that words must always or necessarily be regarded as linked by similarity to graphic representations they might possibly be used to identify or describe.

²⁷ paragraphs [88], [93] and [94].

²⁸ paragraph [105].

The SEAGULL Case

42. I was shown a decision of the Trademark Trial and Appeal Board of the US Patent and Trademark Office: In re Abercrombie & Fitch Trading Co.²⁹ The text supplied to me carries the caveat: *'This disposition is not citable as precedent of the TTAB'*. I assume this is because the determination was thought to involve nothing more than the application of established principles to uncomplicated facts in an orthodox manner.

43. The TTAB upheld the refusal of an application to register a grey, yellow and white representation of a seagull on the ground that it would be likely to cause confusion or to cause mistake or to deceive in the event that it was used concurrently with the word mark **SEAGULL** previously registered for use in relation to identical and similar goods in the clothing sector. It appears that *'under the doctrine of legal equivalents a pictorial representation and its literal equivalent may be found to be confusingly similar. This doctrine is based on a recognition that a pictorial depiction and equivalent wording are likely to impress the same mental image on purchasers'*.³⁰ The applicant for registration contended that consumers would simply look upon its trade mark as a design mark and not be prone to 'translate' it into the word **SEAGULL**. However, that argument was rejected on the ground that the lifelike and immediately recognisable nature of the design mark would result in 'translation' sufficient to establish legal equivalence between the marks in issue. The TTAB observed:

²⁹ US Trade Mark Application No. 76516814, Administrative Trademark Judges Hohein, Hairston and Cataldo (28 June 2006)

³⁰ p.5

Contrary to the applicant's contention that, for instance, "[c]onsumers do not view the Lacoste alligator design and say 'I am buying an alligator shirt'" it is common knowledge that shirts bearing such a design are typically referred to and known as "alligator" shirts. In the same manner, purchasers of applicant's goods would be inclined to refer to its various items of apparel as "seagull" shirts, etc.

44. It seems that the US doctrine of legal equivalents provides for the graphic representation of a non-verbal mark and a word which describes it to be given the same significance in determining the existence of a likelihood of confusion.³¹ However, I think that substantially more by way of evaluation is required for the purpose of determining the existence of a likelihood of confusion in accordance with the case law of the Court of Justice (see paragraph [7] above). That is because the distinctiveness of a word mark is not necessarily invoked by a graphic representation of something it could be used to describe; and the distinctiveness of a non-verbal mark is not necessarily invoked by a word that could be used to describe it. If the later mark does not trespass on the inherent/acquired distinctiveness of the earlier mark, it ought to be accepted that they can be used concurrently without giving rise to the existence of a likelihood of confusion.

45. I should add that in contradistinction to the TTAB's view of the position in the United States, there is no basis for holding either by reference to the evidence on file in the present case or as a matter of common knowledge, that shirts bearing the Lacoste device mark are typically referred to and known as 'alligator' shirts in the United Kingdom.

³¹ as the TTAB itself observed in In re Rolf Nilsson AB 230 USPQ 141 (1986).

Decision

46. I do not doubt that word marks and non-verbal marks can be relevantly and objectionably similar to one another for the purposes of the harmonised law of trade marks in the European Union. The correct approach is to assess the effect of the difference between the two modes of expression as part of the process of global appreciation required by the case law of the Court of Justice. Which is not to say that the difference should be treated as a matter of little significance or low importance in that connection.

47. It is well-established that the decision taker must give as much or as little significance to the visual, aural and conceptual differences and similarities between the marks in issue as an average consumer of the relevant goods or services would have attached to them at the date of the request for protection. It is equally well-established that conceptual similarity may diminish the significance of visual and aural differences and that visual and aural similarities may pale into insignificance as a result of conceptual dissimilarity. However, these considerations do not entitle the proprietor of a trade mark to object to the use of any and all thematically similar marks. A concept is not a sign capable of being protected by registration as a trade mark.³² The rights conferred by registration are centred on the registered representation of the protected mark. They do not enable the concept(s) of a mark to be protected without regard to the distinctive character of the mark as registered. I regard that as a point of particular importance in the present case.

³² Case C-321/03 Dyson Ltd v. Registrar of Trade Marks [2007] ECR I-687 at paragraphs [27] to [40].

48. The Applicant's and the Respondent's marks are linkable on the basis that the Respondent's marks emblematically represent a reptile of (or practically indistinguishable from) the type to which the Applicant's word mark refers. If that is the way they were likely to be perceived and remembered by the relevant average consumer, it would be correct to say that the visual dissimilarity between the marks was moderated by a degree of conceptual similarity. Otherwise not.

49. It is a matter for careful consideration whether a particular word has the power to trigger perceptions and recollections of a particular image. I do not think that a finding of conceptual similarity can realistically be based on a thought process that would not naturally occur to the relevant average consumer. The suggested similarity would then be of negligible significance for the purposes of the required assessment.³³ In that connection I would emphasise that people do not normally construe trade marks or engage in extended thought processes for the purposes of pairing and matching them. It should not be supposed that consumers are actively considering how images might be developed or appropriated for use as siblings of word marks or vice versa. The Hearing Officer confirmed his own perceptions to the effect that: *'If I see the picture of a crocodilian I do not convert it into its symbolic representation; all this tells me is how my brain deals with images....If I saw the word ALLIGATOR on clothing I would make no association with Lacoste's crocodilian devices; the word and the image are distinct in my mind'* (paragraph 14). I do not think his perceptions were atypical or that the evidence on file was sufficient to establish any significant likelihood of consumers reacting differently either in relation to the picture or the word.

³³ cf. Case C-334/05P Shaker di L Laudato & C SAS [2007] ECR I-4529 at paragraph [42].

50. The Hearing Officer found (and I agree) that the images of the Respondent's marks and the name **LACOSTE** were inextricably linked. I think so much so, that for the purpose of individualising the images by name the designation most likely to be mentally and vocally applied to them was **LACOSTE**. To the extent that the designation **ALLIGATOR/CROCODILE** was mentally or vocally applied to them, it would be for the purpose of alluding generally to the type of reptile they represented. Moreover, free-standing use of the Applicant's word mark **ALLIGATOR** would naturally be perceived and remembered as an allusion to alligators in general. Pairing and matching it with the particular images of the Respondent's marks, in circumstances where they had come to be firmly associated and identified with the name **LACOSTE**, looks to me like a process of analysis and approximation that the relevant average consumer would not naturally be concerned to engage in. The fact, as found by the Hearing Officer, that the Respondent's marks would not normally be referred to orally can be regarded as a symptom of that.

51. For these reasons I would think that the Applicant's and the Respondent's marks were not linkable by any conceptual similarity of which the relevant average consumer was likely to take cognisance. In case I am wrong in that view, I will go on to consider the position on the basis that the visual dissimilarity between the marks was moderated in the mind of the relevant average consumer by perceptions and recollections of conceptual similarity relating to alligators/crocodiles.

52. A somewhat similar situation was considered by the General Court in the **SHARK** case³⁴. An application to register the word mark **HAI** as a Community trade mark for use

³⁴ Case T-33/03 Osotspa Co. Ltd v. OHIM [2005] ECR II-763.

inter alia in relation to goods in Class 32 was opposed on the basis that it would give rise to the existence of a likelihood of confusion if it was used concurrently with the following earlier trade mark registered at the Community level for use in relation to identical goods in Class 32:



The word for 'shark' is **HAI** in German and Finnish, **HAAI** in Dutch and **HAJ** in Danish and Swedish. It was accepted that people who speak those languages would probably understand both **SHARK** and **HAI** as meaning shark.³⁵

53. The Court considered that the marks were clearly distinguished by their graphic representation because only the earlier trade mark appeared in figurative form³⁶. Aurally there was no similarity³⁷, presumably because it was considered unlikely that the earlier trade mark would be vocalised by means of the words **HAI**, **HAAI** or **HAJ**. However, there was some conceptual similarity dependent on prior translation of the accessible and clear verbal connotation of the earlier trade mark into the word **HAI**.³⁸

54. The earlier trade mark was found to be striking and attention grabbing, easily committed to memory and possessed of a relatively high degree of distinctive character.³⁹

³⁵ paragraph [51].

³⁶ paragraphs [49] and [53].

³⁷ paragraphs [50] and [53].

³⁸ paragraphs [51] and [53].

³⁹ paragraphs [60] and [61].

In answer to the question whether conceptual similarity alone, which depended on prior translation, was sufficient to give rise to the existence of a likelihood of confusion, the Court decided⁴⁰:

...the significant visual and aural differences between the marks in question are such as to cancel out, to a large extent, their conceptual similarity which depends on prior translation. The degree of conceptual similarity between two marks is of less importance where the relevant public, at the time of purchase, is called on to see and pronounce the name of the mark.

55. I fully appreciate that every case must, in the ultimate analysis, depend on its own facts. However, I do not find in the Judgment of the General Court in the **SHARK** case any substantial support for the view that a device mark and a word which describes it should be given the same significance in determining the existence of a likelihood of confusion. On the contrary, it was not sufficient to establish a likelihood of confusion that the concept of the earlier trade mark was easily and obviously translatable into the word mark of the later application for registration. The rejection of the opposition appears to me to have been a consequence of the gap in perception between the word mark as an allusion to sharks in general and the distinctiveness of the striking and attention grabbing device mark. The individuality of the earlier trade mark largely resided in the artistry of the graphic representation, which the word mark **HAI** was substantially inadequate to convey to the mind of the relevant average consumer. The outcome of the case might well have been different if it had been established to the satisfaction of the Court that the word mark **HAI** had the power to trigger perceptions and recollections of the imagery of the earlier trade mark with the same degree of spontaneity

⁴⁰ paragraph [64].

and specificity as (say) the words **MONA LISA** in relation to the imagery of the specified portrait; or **EIFFEL TOWER** in relation to imagery of the specified structure; or **STARS-AND-STRIPES** in relation to a basic image of the American national flag; and so on.

56. The evidence on file in the present case does not establish that the Applicant's word mark **ALLIGATOR** had the power to trigger perceptions and recollections of the distinctively depicted imagery of any of the Respondent's earlier trade marks with that or a comparable degree of spontaneity and specificity. The Opponent could have adduced objective evidence in support of its position on that important issue, if it had wished and been able to do so. Although the Hearing Officer was prepared to rule in its favour without such evidence, his finding of the existence of a likelihood of confusion was based on an approach to assessment which provided for the images of the Respondent's marks and the Applicant's word mark **ALLIGATOR** to be given the same significance because *'there will be some who would describe the device as a crocodile and some who will describe the device as an alligator'*,⁴¹ and for those who *'may convert the devices into the word ALLIGATOR, this will be held in the memory and act as a hook for the memory: it will give rise to conceptual identity'*.⁴² For the reasons I have endeavoured to explain above, I consider that substantially more was required by way of evaluation for the purpose of determining the existence of a likelihood of confusion in accordance with the case law of the Court of Justice. In the absence of any objective evidence of the kind I have referred to, I can see no basis for regarding the Applicant's and the Respondent's marks as sufficiently similar to result in anything more than a loose, general and non-

⁴¹ paragraphs [9] and [13].

⁴² paragraph [14].

confusing association between them. The factors mentioned in paragraph [50] above point to that conclusion, even if they do not point to the absence of appreciable conceptual similarity. Either way, the Respondent's objections to registration fell short of the requirements established by the case law relating to Section 5(2)(b) and I am satisfied that the Hearing Officer should have rejected them on fuller assessment of the position.

Conclusion

57. The appeal is allowed. The Hearing Officer's decision and order as to costs are set aside. The oppositions stand dismissed. Having regard to the time and effort that seems likely to have been expended upon the preparation and presentation of the case for the Applicant, and proceeding in accordance with the approach normally applied in relation to awards of costs in the context of appeals to this tribunal⁴³, I think it would be appropriate to require the Respondent to pay the Applicant £4,850 by way of contribution to its costs of the oppositions at first instance and on appeal. The Respondent is directed to pay that sum to the Applicant within 21 days of the date of this decision.

Geoffrey Hobbs QC

16 September 2010

Mr. Ian Morris of Kuit Steinart Levy LLP appeared on behalf of the Applicant.

Mr. Roger Grimshaw of Mewburn Ellis LLP appeared on behalf of the Respondent.

Mr. Allan James appeared on behalf of the Registrar.

⁴³ See CLUB SAIL Trade Mark BL O-155-10 (6 May 2010) at paragraphs [12] to [17].