

O-337-04

TRADE MARKS ACT 1994
IN THE MATTER OF INTERNATIONAL REGISTRATION NO. 782452
AND THE REQUEST BY DECATHLON
TO PROTECT THE TRADE MARK
GEOLOGIC
IN CLASSES 3, 6, 11, 12, 13, 16, 21, 24, 31 & 39

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 71009
BY M-REAL CORPORATION
PROPRIETOR OF UK TRADE REGISTRATION NUMBER 2024002
LOGIC

BACKGROUND

1) On 29 January 2002, Decathlon of 4, Boulevard de Mons, F-59650, Villeneuve D'Ascq, France on the basis of an international registration in France, requested protection in the United Kingdom of the trade mark shown below under the provisions of the Madrid Protocol.

GEOLOGIC

2) The international registration is numbered 782452 and has an international priority date claimed of 7 August 2001. Protection was sought for the following amended goods and services:

Class 3: "Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations, waxes and polishes, scouring solutions; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices, sunscreen products, shaving products; shaving soaps, scented wood, depilatory waxes, depilatories, tissues impregnated with cosmetic lotions, make-up products, shampoos for pets, creams for leather; leather bleaching products; preservatives for leather."

Class 6: "Common metals and their alloys; building materials of metal; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metal; non-electrical locksmithing articles; hardware of metal; metal pipes; safes; ores; wire for aerials; tree protectors of metal; armor plating; letter boxes; crampons of metal; stirrups of metal; nails; fences of metal; metal fittings; bolts; doors of metal; padlocks; keys; rings of metal; racks of metal; metallic barriers; barbed wires; horseshoes; weathervanes of metal; signboards of metal; wire rope; traps for animals."

Class 11: "Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes, ventilation hoods, air cooling apparatus, air-conditioning installations, refrigerating cabinets, electric pressure cookers, baby bottle warmers; kitchen ranges, freezers, hair driers; refrigerators, ornamental fountains, gas lighters, toasters, ice-making appliances, gas lamps; light bulbs and electric lamps, flashlights; sauna bath installations, electric coffee-makers, solar sensors, tanning apparatus, shower cubicles, headlights and lights for vehicles, filters for drinking water; coolers."

Class 12: "Vehicles, apparatus for locomotion by land, air or water; engines for land vehicles; air balloons; lighter-than-air balloons; airships; parachutes; inner tubes for pneumatic tires, repair outfits for inner tubes, adhesive rubber patches for repairing inner tubes; tires, non-skid devices for vehicle tires; windshields; anti-glare devices for vehicles; anti-theft devices for vehicles; head-rests for vehicle seats; covers for baby carriages; luggage carriers for vehicles; safety belts for vehicle seats; children's safety seats for vehicles; vehicle covers and saddle covers; seat covers for vehicles; ski carriers for cars,

horns; kickstands for cycles, bicycles; frames, tires, nets, brakes, handlebars, direction indicators, rims, pedals, pumps, spokes, saddles, bells, all these goods for bicycles and cycles; mudguards, tubeless tires for cycles; cycle forks; shock absorbers; bicycle racks; strollers; baby carriages; ski lifts; boats, rowing boats; sail and motor boats; fishing vessels; oars, ships' hulls; boat hooks; steering gears for ships; barges; launches; paddles for canoes; sand yachts (vehicles); jet skis; trailers (vehicles); trailer hitches for vehicles; airplanes; sleighs (vehicles); golf carts; caravans.”

Class 13: “Firearms; hunting firearms; silencers for guns; breeches of firearms; sights for firearms (other than telescopic sights); cleaning brushes for firearms; ammunition for firearms; shoulder straps for weapons; gun stocks; hammers for guns and rifles; cases for guns and rifles; cartridges; cartridge loading apparatus; cartridge cases; cartridge belts; apparatus for filling cartridge belts; shots (lead shot); explosives.”

Class 16: “Paper, cardboard, cardboard packing; paper bags, sachets and sheets for packaging; printed matter, bookbinding material; photographs, printing blocks; stationery, adhesives for stationery or household purposes, artists' supplies, paintbrushes, typewriters and office requisites (except furniture), instructional or teaching material (except apparatus); pens; pen cases; penholders; plastic bags, sachets and sheets for packaging; printing type; binders, albums, books, almanacs, brochures, writing or drawing books, catalogs, calendars, posters, geographical maps, newspapers; printed publications; decals, wrapping paper, signboards of paper or cardboard; postcards; none of the aforesaid goods relating to geology.”

Class 21: “Household or kitchen utensils and containers (neither of precious metal nor coated therewith); combs and sponges, brushes (except paintbrushes); brooms; buckets; brush-making materials, cleaning materials, kitchen utensils and utensils for dishes not of precious metals; thermally-insulated containers for food and beverages, drinking flasks for travellers, non-electrical portable ice boxes, tableware not of precious metal, picnic baskets (including dishes); corkscrews, bottle openers, metal boxes for dispensing paper towels, paper or cellulose cups, paper or cellulose plates, soap and toilet paper dispensers; drying racks for washing, garbage cans; cosmetic utensils, fitted vanity cases; drinking troughs; feeding troughs; bowls; litter trays for animals; mangers for animals; cages for animals; combs and brushes for horses; toiletry sponges for horses; brush-making materials; boot jacks; brushes for footwear.”

Class 24: “Textile fabrics, adhesive fabric for application by heat; bed linen, sheets, pillow shams, bed covers, bath linen (except clothing); towels; table linen, tablecloths, oilcloths (tablecloths); dish towels; sleeping bags (sheeting); household linen, cleaning cloths; cushion covers; travel rugs.”

Class 31: “Agricultural, horticultural and forestry products, neither prepared, nor transformed; plant seeds; fresh fruit and vegetables; algae for consumption; almonds; peanuts (fruits); natural seeds, plants and flowers; animal feed; products for animal litter; malt, live bait for fishing; live animals;

strengthening animal forage; edible chews for animals; fodder; additives to fodder, not for medical purposes.”

Class 39: “Travel, sightseeing tour and excursion organization; escorting of travellers; tourist bureau agencies (except for reserving hotels or boarding houses); none of the aforesaid services relating to geology.”

3) The United Kingdom Trade Marks Registry considered that the request satisfied the requirements for protection in accordance with Article 3 of the Trade Marks (International Registration) Order 1996 and particulars of the international registration were published in accordance with Article 10.

4) On 27 May 2003 UK Paper plc of Mill Way, Sittingbourne, Kent, ME10 3ET filed notice of opposition to the conferring of protection on this international registration based on their proprietorship of the UK trade mark shown below.

Mark	Number	Effective Date	Class	Specification
LOGIC	2024002	15.06.95	16	Paper

5) The grounds of opposition are in summary:

- a) The opponent states that the prominent part of the mark in suit is the word LOGIC. It claims that the prefix GEO is non-distinctive. The opponent believes that the marks of the two parties are confusingly similar and that the goods are similar (precisely which goods is not specified). As such the application offends against Section 5(2)(b) of the Trade Marks Act 1994.
- b) The opponent states that it has been manufacturing paper under its mark for a number of years and as a result of use in the UK has acquired a substantive goodwill. Therefore, use of the mark in suit would offend against Section 5(4)(a) of the Trade Marks Act 1994.
- c) The opponent’s trade mark predates the mark in suit and is therefore an earlier trade mark within the meaning of Section 6(1)(a) of the Trade Marks Act 1994

6) The International Registration holders (who, for convenience, I shall hereafter refer to as the applicant) subsequently filed a counterstatement denying the above grounds.

7) The opponent changed from UK Paper plc to M-real Corporation following assignment of UK Trade Mark No.2024002 on 31 December 2003.

8) Both sides ask for an award of costs. Only the opponent filed evidence. Neither side wished to be heard although the applicant did provide written submissions. I shall refer to these submissions as relevant in my decision.

OPPONENT'S EVIDENCE

9) The opponent filed a witness statement, dated 1 March 2004, by David Scudder the Company Secretary of M-real New Thames Ltd, the UK subsidiary of M-real Corporation.

10) Mr Scudder states that his company's mark has been used continuously in the UK since 1995 in relation to paper. He provides the following figures for sales in the UK, exports from the UK and promotions:

Year	UK Sales £million	UK Sales tonnes	Exports £million	Exports tonnes	Promotions £
2000	12.7	18,500	11.4	20,850	150,000
2001	11.9	16,890	9.3	14,930	150,000
2002	8.5	12,300	5.6	9,150	200,000
2003	5.4	8,200	4.1	6,980	100,000

11) Mr Scudder states that the promotions took the form of sending product swatches to all UK stockists and merchants, advertisements in *Print World* and *Print Weekly* magazines, use of the company website and promotional gifts.

12) Mr Scudder provides exhibits which show the following:

DS2: a sample of packaging used in the UK which shows the word LOGIC clearly printed across the packaging of a ream of paper.

DS3: Pictures of some promotional items such as rulers, notepads, pens, T-shirts, hats, mugs etc all of which have the word LOGIC printed upon them.

DS4: Print outs from the website, dated February 2004, which feature prominent use of the word LOGIC.

13) That concludes my review of the evidence. I now turn to the decision.

DECISION

14) I shall first consider the ground of opposition under Section 5(2)(b) which 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.”

15) An “earlier trade mark” is defined in Section 6, the relevant parts of which state:

“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,”

16) The opponent is relying on UK Trade Mark No 2024002 “LOGIC” registered with effect from 15 June 1995, which is plainly an “earlier trade mark”.

17) In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel Bv v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer 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* page 224;
- (b) the matter must be judged through the eyes of the average consumer, of the goods / services in question; *Sabel Bv v Puma AG* page 224, 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.* page 84, paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel Bv v Puma AG* page 224;
- (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* page 224;
- (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-Meyer Inc.* page 7 paragraph 17;
- (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* page 8, paragraph 24;
- (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* page 224;

(h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG* page 732, paragraph 41;

(i) 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-Meyer Inc.* page 9, paragraph 29.

18) In essence the test under Section 5(2) is whether there are similarities in marks and goods and/or services which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgements of the European Court of Justice mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods and/or services, the category of goods and/or services in question and how they are marketed. Furthermore, I must compare the mark applied for and the opponent's registration on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods and services covered within the respective specifications.

19) I shall first consider the goods of the two parties. I take note of the factors set out by Mr Justice Jacob in *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281 at page 296. Adapted to the instant case, it can be stated as:

- a) the uses of the respective goods or services;
- b) the users of the respective goods or services;
- c) the physical nature of the goods or services;
- d) the trade channels through which the goods or services reach the market;
- e) in the case of self-serve consumer items, where in practice they are respectively found or likely to be found on the same or different shelves; and
- f) the extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods or services, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

20) These factors were referred to in the opinion of the Advocate General in *Canon*; page 127, paragraphs 45-48. In its judgement, the ECJ stated at paragraph 23:

“23. In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature,

their end users and their method of use and whether they are in competition with each other or are complementary.”

21) The opponent did not specify which goods or services it considered similar. With such an unfocussed attack I must consider all the goods and services included in the applicant’s specification. The applicant’s specification is set out in full earlier in this decision. The opponent’s mark is registered for “Paper”. Clearly, the applicant’s goods and services in Classes 3, 6, 11, 12, 13, 21, 24, 31 and 39 are not in any way similar to the goods of the opponent. This leaves the goods in Class 16. For ease of reference I shall reproduce the applicant’s Class 16 specification below:

Class 16: “Paper, cardboard, cardboard packing; paper bags, sachets and sheets for packaging; printed matter, bookbinding material; photographs, printing blocks; stationery, adhesives for stationery or household purposes, artists' supplies, paintbrushes, typewriters and office requisites (except furniture), instructional or teaching material (except apparatus); pens; pen cases; penholders; plastic bags, sachets and sheets for packaging; printing type; binders, albums, books, almanacs, brochures, writing or drawing books, catalogs, calendars, posters, geographical maps, newspapers; printed publications; decals, wrapping paper, signboards of paper or cardboard; postcards; none of the aforesaid goods relating to geology.”

22) No evidence was provided regarding users, uses, trade channels etc so I must make the best I can out of the situation. Utilising the factors outlined in paragraph 19 it seems clear to me that the users of such goods are relatively similar. The actual uses do vary but have, in the broadest sense, a similarity. Whilst the physical nature of the goods varies considerably the trade channels are likely to be similar and the goods would find themselves alongside each other in a good stationery shop. I therefore conclude that the applicant’s goods in Class 16 are similar to the opponent’s goods, the rest of the applicant’s specification is dissimilar to that of the opponent.

23) Turning to the marks of the two parties, the opponent claims that the applicant’s mark will be confused with its own as the initial part of the mark GEO will be ignored as it is non-distinctive and the prominent part of the applicant’s mark is the word LOGIC which is identical to its own mark.

24) I do not agree with this contention. It is well established that the average consumer does not analyse a mark and break it down into parts, they regard the whole of the mark. In this case both marks are dictionary words. The applicant’s mark is the adjective form of the word “geology” and would, I believe, be recognised as such. Equally the opponent’s mark would be seen for what it is, a common word used to describe reasoning. The fact that the applicant’s mark contains the opponent’s mark in its entirety would not, in this case, lead to any likelihood of confusion. The marks are clearly not similar.

25) I also have to consider whether the opponent’s mark has a particularly distinctive character either arising from the inherent characteristics of the mark or because of the use made of it. Although a dictionary word the opponent’s mark is not descriptive in relation to paper and so has a degree of inherent distinctiveness. The opponent claims that it has a considerable reputation in its mark in the UK in respect of paper.

26) However, most of the evidence filed was of little assistance in establishing such a reputation as it is either undated or dated after the relevant date. The opponent filed turnover and volume figures but did not provide any evidence to put these figures into context such as the size of the market or its market share. The opponent did not file evidence from the trade or any independent witnesses as to its reputation. Taking all this into account I cannot accept, on the basis of the evidence filed, the opponent's contention that they have a substantial reputation in the mark in the UK.

27) Carrying out a global assessment and taking into account imperfect recollection I consider that there is no likelihood of confusion between the opponent's mark and the mark in suit even if used on identical goods. The opposition based upon Section 5(2)(b) fails.

28) Lastly, I consider the ground of opposition under section 5(4)(a) which reads:

“5.(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

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

29) In relation to passing off the opponent needs to establish that at the relevant date, 29 January 2002, it enjoyed goodwill/reputation.

30) In *South Cone Inc. v. Jack Bessant, Dominic Greensmith, Kenwy House, Gary Stringer (a partnership)* [2002] RPC 19 Pumrey J. in considering an appeal from a decision of the Registrar to reject an opposition under Section 5(4)(a) said:

“There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under Section 11 of the 1938 Act (see *Smith Hayden (OVAX)* [1946] 63 RPC 97 as qualified by *BALI* [1969] RPC 472). Thus, the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date.”

31) This cannot be interpreted in a prescriptive fashion. There will be occasions when the evidence does not fall within the above parameters but still establishes goodwill for passing off purposes - see the decision of Professor Annand, sitting as the Appointed Person, in *Loaded* BL 0/191/02.

32) Earlier in this decision I found that use of the mark in suit, actual or on a fair and notional basis would not result in confusion with the opponent's mark. Accordingly, it seems to me that the necessary misrepresentation required by the tort of passing off will not occur. The opposition under Section 5(4)(a) of the Act must fail.

33) The opposition having failed I order the opponent to pay the applicant the sum of £500. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful

Dated this 10th day of November 2004

George W Salthouse
For the Registrar,
the Comptroller-General