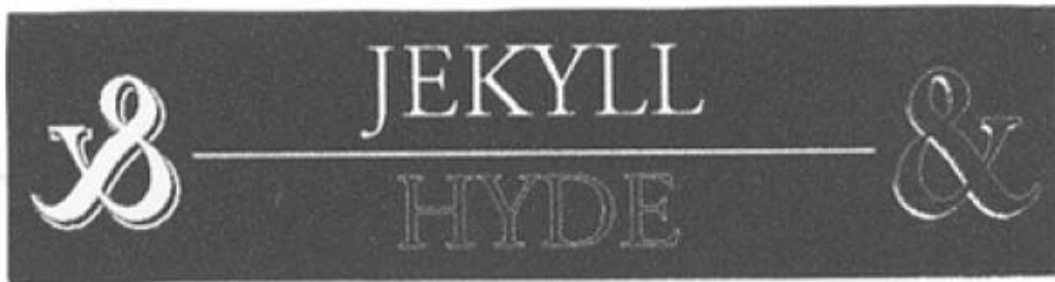


TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2540477
BY
STEPHEN JOHN SALE
TO REGISTER THE TRADE MARK**



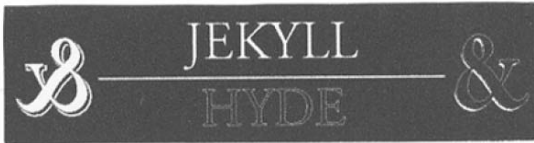
IN CLASS 25

AND

**THE OPPOSITION THERETO
UNDER NO 100655
BY
DICKENS INTERNATIONAL LIMITED**

Trade Marks Act 1994

**In the matter of application 2540477
by Stephen John Sale
to register the trade mark:**



**in class 25
and the opposition thereto
under no 100655
by Dickens International Limited**

1. On 25 February 2010, Stephen John Sale applied to register the above trade mark. The application was made for the following goods which are in class 25¹:

Clothing, footwear, headgear.

2. The application was published in the *Trade Marks Journal* on 7 May 2010. Dickens International Limited (“the opponent”) filed notice of opposition to the trade mark application, claiming that registration would be contrary to section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). Section 5(2)(b) of the Act states:

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

....

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

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

3. The opponent relies upon four earlier trade marks to oppose all the goods of the application. The details of the earlier marks, the disclaimed elements where applicable, and the goods relied upon are as follows:

¹ As per the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

(i) JEKYLL & HYDE (UK) 1425549

Disclaimer: "Registration of this mark shall give no right to the exclusive use of the word "Hyde"."

Application date: 19 May 1990

Completion of registration procedure: 18 June 1993

Class 25: Articles of clothing; all for men or boys; all included in Class 25; but not including footwear.

(ii) JEKYLL & HYDE Community Trade Mark ("CTM") 545376

Application date: 23 May 1997

Completion of registration procedure: 4 September 2001

Class 3: Cleaning, polishing, scouring and abrasive preparations; soaps; shampoos and cleaning gels; perfumery; essential oils; cosmetics; preparations for the hair and skin; lotions; dentifrices; toiletries, all for personal use.

Class 18: Luggage; bags; umbrellas; walking sticks; goods made of leather and imitations of leather not included in other classes.

Class 25: Articles of outer clothing; articles of under clothing; footwear; headgear.



(iii) (UK) 1169874

Disclaimer: "Registration of this mark shall give no right to the exclusive use, separately, of the words "Jekyll" and "Hyde"."

Application date: 15 February 1992

Date of completion of registration procedure: 23 February 1983².

² As per the notice in Journal 5725, which confirmed that, prior to June 1986, the date of the Journal in which the fact of registration was recorded in the list of trade marks registered was the actual date of registration; see the decision of Geoffrey Hobbs Q.C., as the appointed person, in *WISI* [2006] RPC 17.

Class 25: *Articles of clothing for men and boys, but not including footwear.*

(iv) JEKYLL & HYDE (CTM) 2944551

Application date: 18 November 2002

Completion of registration procedure: 10 September 2004

Class 09: *Spectacles, spectacle frames, spectacle cases; sunglasses.*

Class 14: *Watches, clocks; jewellery.*

4. The opponent's trade marks all completed their registration procedure more than five years before the date on which Mr Sale's application was published (7 May 2010). They are all therefore earlier trade marks which are subject to the proof of use provisions³. The opponent has made a statement of use in its notice of opposition in respect of all the goods it relies upon. It has also said the following in its accompanying statement of case:

"It is understood that there has been a period of non-use in respect of these Trade Mark Registrations, however, it is understood that preparations are already well underway in respect of new lines bearing these Trade Marks, and evidence of those preparations will be filed in due course."

5. The opponent claims that there would be a likelihood of confusion based upon the similarity of the marks and that the goods in class 25 are identical and those in classes 3, 9, 14 and 18 are similar in that they are fashion accessories or natural extensions in trade. Mr Sale filed a counterstatement, putting the opponent to proof of use specifically in relation to men's clothing. Mr Sale claims that JEKYLL & HYDE has not been in use in the "public retail clothing sector or related clothing sectors" for over a decade. Mr Sale says that his application is a "rejuvenation and modernisation" of the name JEKYLL & HYDE and that there will be no confusion as the earlier marks are not in use. Furthermore, Mr Sale claims that the opponent had no intention to bring the "name" back into the public domain until he made his application. He would not have made the application if the opponent was trading using the mark(s). It is a "dead name". Mr Sale states that he delayed filing his notice of defence for as long as possible to see if the opponent "would have committed themselves to putting the name out in the public domain, but nothing is there, and therefore they have no grounds to oppose my application on the basis of intent, to now do something".

6. Both sides filed evidence. Neither side asked for a hearing or filed written submissions in lieu of a hearing, both being content for a decision to be made

³ See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

from the papers on file. In making my decision, I have taken into account the evidence and the contents of the opponent's statement of case and Mr Sale's counterstatement.

Proof of use dates

7. The relevant period is the five year period ending on the date of publication of the application, namely 8 May 2005 to 7 May 2010. As Mr Sale has put the opponent to proof of use of its marks for men's clothing, the onus is on the opponent, under section 100 of the Act⁴, to show genuine use of its marks during this period on men's clothing or, alternatively, that there are proper reasons for non-use of the marks during this period.

The opponent's evidence

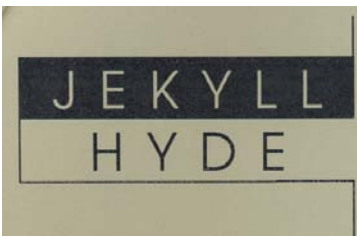
8. This comprises a witness statement, dated 13 December 2010, and exhibits from Ellis Franks of Ellis Franks Limited. Mr Franks states that he was employed by the opponent as the manager of its clothing division for thirty years, from around 1980. He states that his knowledge is either his own or is from the records of his company, or from the records of the opponent, to which he states he has full access.

9. Mr Franks states that the mark JEKYLL & HYDE has been used by the opponent in the UK since 1990 "for many years" in several different formats in respect of a wide range of articles of clothing. He also states that, towards the end of 2006, the opponent ceased use of the mark JEKYLL & HYDE in the UK due to a reorganisation of brands within the opponent's business. He is unable to provide turnover figures between 1990 to the end of 2006 because the opponent "was a multi-brand business, and figures for the individual brands were not retained separately from overall business turnover figures [...] I confirm that turnover of clothing products sold under the JEKYLL & HYDE trade mark formed a large portion of the turnover of Dickens International Limited during that time". In relation to the stated use of the mark between 1990 and 2006, Mr Franks exhibits the following items:

- A product sheet (exhibit EF1) dating back to Spring 1996 said to demonstrate use of the mark JEKYLL & HYDE on a variety of styles of clothing articles. The 'styles' are named after Italian cities and the sheet is headed "COLOURS FOR JEKYLL & HYDE SPRING 96". There are no pictures.
- A number of design drawings (exhibit EF2) of T-shirts on pages with the same Italian place names as in the 1996 product sheet. The mark which

⁴ "If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it."

appears both on the pages and the drawings of the T-shirts, in the neck and at the hem, is



These drawings are undated; however, Mr Franks states:

“I confirm that according to the records of Dickens International Limited these designs were created in the early 1990s and JEKYLL & HYDE clothing products were available for sale in the UK from that time until 2006”.

10. Mr Franks further confirms that products bearing the JEKYLL & HYDE trade mark were produced and sold to UK retailers during the period from the early 1990s to 2006. The products were available from a large variety of retail outlets during that period, including small Manchester outlets and large national outlets such as C&A.

11. After the opponent ceased use of JEKYLL & HYDE, Mr Franks left the opponent’s employment and set up his own company, Ellis Franks Limited, which was incorporated on 12 October 2010, having previously been incorporated as Ellis Franks Consultancy Limited on 17 November 2009. Mr Franks states that in May 2010 (the month during which the opposed application was published), the opponent commenced preparations for the relaunch of the JEKYLL & HYDE range of clothing products. Exhibit EF4 shows drawings of shirts with the following mark:



The copyright dating is June 2010. Mr Franks, rather confusingly, then states that the initial preparations for the products and designs commenced “well before that date in May 2010.”

12. Mr Franks obtained a licence from the opponent on 1 October 2010 to use the mark JEKYLL & HYDE on clothing in the UK. His company had been “making significant preparations to bring the mark JEKYLL & HYDE back into use in the UK retail market” based on the designs referred to in paragraph 11 above. Mr Franks exhibits letter-headed company notepaper which shows the same form of JEKYLL & HYDE as in paragraph 11 above (i.e. with the crossed swords). Mr Franks had £15,000 worth of orders at the date of his witness statement for JEKYLL & HYDE products.

Mr Sale’s evidence

13. Mr Sale’s witness statement consists of submissions in reply to the evidence filed by the opponent. As it contains no actual statements of fact, I will not record the contents of the witness statement here, but will, of course, bear them in mind in reaching my decision.

Decision

Proof of use

14. Section 6(A) Act states:

“(1) This section applies where—

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if—

- (a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

- (4) For these purposes—
- (a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and
 - (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.
- (5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.
- (6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.
- (7) Nothing in this section affects—
- (a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4)(relative grounds of refusal on the basis of an earlier right), or
 - (b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

15. As stated earlier, to rely upon its earlier trade marks, the opponent has to prove that it has made genuine use of the marks, or that there are proper reasons for non-use, in the relevant period. The relevant period is 8 May 2005 to 7 May 2010.

16. Ms Anna Carboni, sitting as the appointed person in, *PASTICCERIA E CONFETTERIA SANT AMBROEUS S.R.L. v G&D RESTAURANT ASSOCIATES LIMITED*, case BL O-371-09, summarised a set of principles from the following leading Court of Justice of the European Union (‘CJEU’) genuine use cases: *Ansul BV v AjaxBrandbeveiliging BV*, Case C-40/01, [2003] ETMR 85 (“ECJ”); *La Mer Technology Inc v Laboratoires Goemar SA*, Case C-259/02, [2004] FSR 38 (ECJ); and *Silberquelle GmbH v Maselli-Strickmode GmbH* Case C-495/07, [2009] ETMR. I gratefully adopt her summary:

“(1) Genuine use means actual use of the mark by the proprietor or a third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely “token”, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] - [23].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25].”

17. An initial consideration relates to the marks themselves. Neither party has distinguished between the four earlier marks relied upon, both simply calling them the JEKYLL & HYDE marks. Three of the earlier marks (UK 1425549, CTM

545376 and CTM2944551) are word-only JEKYLL & HYDE marks, whilst UK 1169874 is a composite word and device mark:



None of the exhibits show this mark and, in fact, none of the exhibits show use of the words JEKYLL & HYDE with the separating ampersand. However, for reasons which will become clear, I will turn first to the question of whether the evidence meets the genuine use or the proper reasons for non-use tests.

18. In relation to proper reasons for non-use, Mr Franks has stated that the opponent ceased use of the JEKYLL & HYDE mark at the end of 2006. The explanation for this is that the opponent reorganised its brands. The CJEU, in *Häupl v Lidl Stiftung & Co KG* Case C-246/05 [2007] E.T.M.R. 61, gave consideration to the significance of the word 'proper' in the phrase 'proper reasons for non-use'. It concluded that having reasons is not enough: they must be 'proper' reasons.

19. The evidence shows that the cessation of use of JEKYLL & HYDE was a conscious decision on the part of the opponent and was entirely within its control. It follows that there were no "obstacles having a sufficiently direct relationship with a trade mark making its use impossible or unreasonable" which arose "independently of the will of the proprietor" and therefore no proper reasons for non-use.

20. The first piece of dated evidence is the product sheet from Spring 1996, which does not show the marks or the products but which includes a list of products named after Italian cities. The corresponding Italian cities appear next to design drawings of T-shirts in the undated exhibit EF2. Mr Franks states that "these designs were created in the early 1990s and JEKYLL & HYDE clothing products were available for sale in the UK from that time until 2006". This is not the same thing as saying that the products listed in the Spring 1996 product sheet were available for sale until 2006. It would be unusual for the same clothing items, with the same Italian city names, still to be available for sale ten years after 1996. What Mr Franks has stated is that JEKYLL & HYDE clothing was available for sale from the early 1990s until 2006, but there is nothing to support this statement. There are no turnover figures, broken down or otherwise, no invoices, catalogues, sample clothing items or order forms. Mr Sale points out that there is no evidence directly from the opponent. This, of itself, is not fatal given that Mr Franks appears to have been so closely involved with the

opponent's business; however, with such scant evidence having been filed, the lack of corroborative evidence from the opponent is a further problem.

21. In *Laboratoire De La Mer Trade Marks* [2002] FSR 51, Jacob J said:

“9 In the present cases, use was not proved well. Those concerned with proof of use should read their proposed evidence with a critical eye – to ensure that use is actually proved – and for the goods or services of the mark in question. All the t's should be crossed and all the i's dotted.”

The onus is on the opponent to make good its statements of use; if there has been use, the opponent should be able to demonstrate the use. Bearing in mind the relevant period compared to when cessation occurred, the only use I can bear in mind is between 8 May 2005 and the end of 2006 (when the opponent ceased use of the mark). There is nothing to show actual use of JEKYLL & HYDE (in any form) during this period. There are no pieces of evidence which can be cross-referenced to build up a picture of a business engaged in real commercial exploitation of its marks in the men's clothing market, aimed at creating or maintaining a share of that market, during the relevant period.

22. Added to these problems are the fact that the only exhibit which shows any clothing is EF2 for the drawings of mens' T-shirts and that the marks differ from their registered forms. However, I do not need to examine either the issue of variant marks or what would be a fair specification because I have come to the conclusion that the opponent has not satisfied the tests that there has been genuine use of any JEKYLL & HYDE marks within the relevant five year period on men's clothing, for which Mr Sale has requested proof of use.

23. The consequence of this is that the opponent has failed to meet the use conditions set out in section 6A(3) of the Act in respect of the goods for which Mr Sale requested proof of use. The request for proof of use was entered on his notice of defence (Form TM8) as “CAT 25 MENS CLOTHING”. The effect of the proof of use request being limited to men's clothing is that although the opponent cannot rely upon its earlier marks for men's clothing, it is, however, entitled to rely upon its earlier marks for goods other than men's clothing. With this in mind, I turn to the section 5(2)(b) ground of opposition.

Section 5(2)(b)

24. The leading authorities which guide me in this ground are from the Court of Justice of the European Union (CJEU): *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 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, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks*

and Designs) (OHIM) C-334/05 P (LIMONCELLO). It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

e) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

f) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*.

(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) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(j) 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*,

(k) 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 and Adidas Benelux BV*,

(l) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*

25. The opponent's strongest case lies with its CTM 545376 for the mark JEKYLL & HYDE because it is a word-only mark, it includes class 25 goods without limitation⁵, and it is not subject to any of the disclaimers applicable to the earlier UK marks. If the opponent cannot succeed under this earlier mark, it will be in no better a position in relation to its other marks. I will therefore confine my analysis to this earlier CTM against Mr Sale's application.

Comparison of goods

26. In comparing the respective specifications, all relevant factors should be considered, as per *Canon* where the CJEU stated at paragraph 23 of its judgment:

“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 intended purpose and their method of use and whether they are in competition with each other or are complementary.”

A further factor to bear in mind is that if goods fall within the ambit of terms within the competing specification, they are considered to be identical, as stated in *Gérard Meric v Office for Harmonization in the Internal Market (OHIM)* case T-133/05, where the General Court (“GC”) stated, at paragraph 29:

⁵ Class 3: *Cleaning, polishing, scouring and abrasive preparations; soaps; shampoos and cleaning gels; perfumery; essential oils; cosmetics; preparations for the hair and skin; lotions; dentifrices; toiletries, all for personal use.*

Class 18: *Luggage; bags; umbrellas; walking sticks; goods made of leather and imitations of leather not included in other classes.*

Class 25: *Articles of outer clothing; articles of under clothing; footwear; headgear.*

“In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedral v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

Although the opponent is not entitled to rely upon *men’s clothing* as a result of my findings on the proof of use issue, men’s clothing is a subset of the opponent’s wider specification in class 25 of *articles of outer clothing; articles of under clothing; footwear; headgear*. The effect of this is that the opponent is entitled to rely upon outer clothing, under clothing, footwear and headgear other than for men. Expressing this positively, the opponent can rely upon its earlier mark for outer clothing, under clothing, all for ladies and children; footwear and headgear. These goods are covered by Mr Sale’s specification for *clothing, footwear, headgear*. Applying the logic of the *Gérard Meric* case referred to above, the opponent’s goods are included in the more general category of Mr Sale’s goods and therefore they are considered to be identical. **Mr Sale’s goods are identical to the opponent’s goods.**

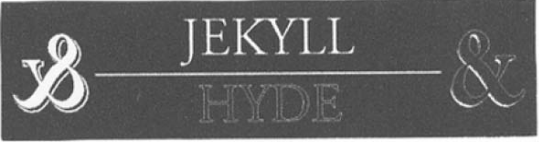
Average consumer and the purchasing process

27. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect, but his or her level of attention is likely to vary according to the category of goods. The average consumer for clothing is the general public. A reasonable level of attention (no higher or lower than the norm) will be paid to the purchase of clothing. The purchasing of clothing will be primarily visual, but oral use of the mark may also play a part.

Comparison of trade marks

28. The authorities direct that, in making a comparison between the marks, I must have regard to each mark’s visual, aural and conceptual characteristics. I have to decide which, if any, of their components I consider to be distinctive and dominant, without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

29. The marks to be compared are:

Opponent's mark	Mr Sale's application
JEKYLL & HYDE	

30. The distinctive and dominant components of the opponent's mark are the words JEKYLL and HYDE. With the ampersand, they form a well-known phrase (I say more about this below). These words are also central to Mr Sale's mark. Although he has made more of a feature of the ampersand symbol in his mark, it is still the words that play the key role in the mark. JEKYLL is represented more clearly than HYDE, but the two words will be seen as a single phrase owing to it being well-known. The two marks share the same distinctive and dominant elements.

31. Mr Sale's mark is presented on a solid rectangular background which is absent from the opponent's mark. However, its visual significance is that it is merely a background and so does not play much of a part in separating the marks visually from one another. The words are spelt the same way in both marks, although they are represented on different lines in Mr Sale's mark. The ampersand devices make a difference visually between the marks as in Mr Sale's mark they are not positioned so as to be read with the words. This makes for a degree of difference visually between the marks. There is, however, still a good degree of visual similarity between the marks in view of the other similarities I have mentioned. Aurally, they are very similar as the words JEKYLL and HYDE will be said in that order in both marks and, owing to the phrase being well known, are likely to be said with an 'and' between them (articulating the ampersand in the opponent's mark).

32. The opponent submits that both marks refer to the literary character created by Robert Louis Stevenson, depicting a tale of split personality (Dr Jekyll and Mr Hyde). I doubt whether Mr Stevenson's involvement in the creation of a well-known phrase is widely known, but I do consider that, to the average member of the public, the phrase JEKYLL AND HYDE means a person with split or dual personality traits (particularly lighter and darker sides). Conceptually, both marks are entirely composed of this meaning: they are conceptually identical.

33. Overall, the marks are highly similar.

Distinctiveness of the earlier mark

33. It is necessary to consider the distinctive character of the earlier mark because the more distinctive it is, either by inherent nature or by use (nurture) the greater the likelihood of confusion⁶. The distinctive character of a trade mark must be assessed by reference to the goods or services in respect of which registration is sought and by reference to the way it is perceived by the relevant public⁷. Although the opponent has filed evidence, I have been unable to find that any of its earlier marks have been used. This means that the opponent is not able to rely upon its evidence for a claim to the mark having enhanced distinctive character through use and so I have only its inherent distinctive character to consider. Although JEKYLL & HYDE has a meaning, it is not a meaning which is in any way allusive or descriptive of the goods. It is a mark with a high level of distinctive character.

Likelihood of confusion

34. In deciding whether there is a likelihood of confusion between the marks, I must weigh the various factors I have identified and also bear in mind the principle of interdependency, whereby a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon*). I bear in mind the whole mark comparison, the dominant and distinctive elements within the marks and I guard against dissecting the marks so as to distort the average consumer's perception of them; the average consumer perceives trade marks as wholes and rarely has the opportunity to compare marks side by side, relying instead upon the imperfect picture he has of them in his mind. As explained above, I have found that the respective goods are identical because the opponent can rely upon its goods in class 25 for which it was not required to prove use. Both marks share the same dominant, highly distinctive component, the meaning of which is notorious and capable of immediate grasp by the average consumer. The conceptual hook in the average consumer's mind will be the same: the marks will be remembered as JEKYLL & HYDE and there will be a likelihood of confusion. Even if I am wrong about that, it is common in the clothing sector for undertakings to use variant marks with a common theme for ranges of clothing. If the average consumer is not directly confused between the parties' marks, the common JEKYLL & HYDE theme in the marks will cause the average consumer to expect the undertaking responsible for each mark to be economically connected. This is a likelihood of confusion in the sense of association within the meaning of section 5(2)(b) (as per point (l) of paragraph 24 above).

⁶ *Sabel BV v Puma AG* [1998] RPC 199.

⁷ *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

35. It is implicit in the wording of Mr Sale's counterstatement that he does not dispute the similarity between the marks because he says:

"3, I wish to make it clear there is no attempt to disguise the aspect of the name or the representation of the design of the logo...this is merely a rejuvenation and modernisation with the emphasis on the (&), ultimately.

4, There can be no confusion to the public as there is nothing out there to confuse the use of this application on mens clothing, and I strongly believe there has been no intention to bring the name back into the public domain by the opposition until my application.

5, I would not have made such an application if the opposition were trading with the name, none of the categories they keep registering are being manufactured and sold to the public, its basically a dead name they are trying to cling onto."

However, because Mr Sale only required the opponent to prove use of its marks upon men's clothing, the opponent was entitled to rely upon the other goods for which its marks were registered, notably class 25 goods other than men's clothing. The decision is made upon the basis of the goods which survived the proof of use test. The likelihood of confusion in relation to those surviving goods is assessed on the basis of notional and fair use, not actual use of the goods (clothing other than for men). The opponent did not have to prove entitlement to rely upon these goods because Mr Sale did not ask it to do so. Mr Sale is therefore faced with highly similar earlier marks, for identical goods, for which I have found there to be a likelihood of confusion. The inevitable conclusion is that **the opposition succeeds against all of Mr Sale's goods.**

Costs

36. The opponent has been successful and is entitled to a contribution towards its costs, based upon the scale in Tribunal Practice Notice 4/2007. In relation to the proof of use evidence, I will offset the opponent's total award because the evidence was so poor and Mr Sale was put to the trouble of having to reply to it.

Preparing a statement and considering Mr Sale's counterstatement	£200
Opposition fee	£200
Offset	-£100
Total:	£300

37. I order Stephen John Sale to pay Dickens International Limited the sum of £300. This sum is to be paid within fourteen 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 4th day of October 2011

**Judi Pike
For the Registrar,
the Comptroller-General**