

**TRADE MARKS ACT 1938**

**IN THE MATTER OF TRADE MARK Application**

**Nos: 1501029 and 1501030 to register trade marks in the name of EMA Srl**

**AND IN THE MATTER OF Opposition**

**Nos: 45820 and 45822 by  
The Pod Trademarks Partnership.**

1. On 11<sup>th</sup> September 2000 I heard an opposition by The Pod Trademarks Partnership to an application by EMA srl to register the trade mark:



2. At the hearing the applicants were represented by Ms. S Wallace of Lloyd Wise Tregear; the opponents by Ms. S Leno of Forrester Ketley & Co.

3. For the reasons I gave at the hearing, and which are recorded in the attached approved transcript, I decided that the opposition failed.

4. I heard submissions on costs at the hearing, and I do not see any reason to depart from the usual scale. I order the Opponents to pay the Applicants the sum of £1270. This sum is 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 21<sup>st</sup> day of September 2000**

**Dr W J Trott  
For the Registrar  
The Comptroller General**

1 DECISION

2 The applicants in this matter are an Italian firm, EMA Srl (2 Via S Maria, 63044 Comunanza  
3 (AP), Italy), who applied on 18<sup>th</sup> May 1992 to register a mark, which I will call TODS, but is a  
4 device mark incorporating a crest (apparently a 'lions heads' device) and embossed by the  
5 words HAND MADE ENTIRELY BY EXPERT SHOEMAKERS.

6 There were originally two applications. The first, N<sup>o</sup>. 1501029, was for the goods: 'Leather,  
7 animal skins, imitations of leather or of animal skins; articles made from the aforesaid goods;  
8 purses, handbags, cases, briefcases, bags and wallets; portfolios; key-holders and key-cases;  
9 straps, trunks, suitcases and articles of luggage; all included in Class 18.'. The other  
10 application, N<sup>o</sup>. 1501030, was for: 'Articles of clothing; dresses; suits; jackets, jeans, pants,  
11 trousers, slacks, footwear, belts; clothing made of leather or of imitation leather; all included  
12 in Class 25.'

13 These two applications are opposed by the Pod Trademarks Partnership, which consists of  
14 William John Dickinson, Anthony Frederick Richardson, Simon Dickie and Gary  
15 Thorneycroft. They cite a number a registrations, which I will attach in an Annex to this  
16 Decision. The grounds are based on ss 11 and 12, and s 17, where the Registrar was asked to  
17 exercise her discretion in refusing the applications. The applicants deny the grounds and I  
18 have noted that both parties ask for their costs.

19 This opposition began life as two separate oppositions (under N<sup>os</sup>. 45820 and 45822) and has  
20 now been consolidated. I should also say that the 1938 Act has been replaced by the 1994  
21 Act, but this decision is taken under the former on the basis of transitional provisions in the  
22 latter.

1     The Evidence

2     I do not intend to summarise the evidence as it will become obvious later that it does not  
3     affect my decision one way or another.

4     In passing, of the material submitted by the opponents, the only user, as Ms Wallace pointed  
5     out, I have been able to observe is on shoes. The mark actually used appears to be different to  
6     those cited in the Annex and includes the word ‘original’, but does use the word POD from  
7     registration N<sup>o</sup> 1157849.

8     The opponents claim use from 1977 onwards, but I can see little or no material evidence of  
9     that and that use is denied by the applicants in their statement of grounds. I also note that the  
10    applicants’ evidence of use, which they claim from 1985, is pretty thin as well, though some  
11    revenue figures are reproduced. I note it is not denied by the opponents. However, I do not  
12    think this case turns on priority of user.

13    The Decision

14    I believe that this matter can be dealt with by a consideration of s 12 alone, which states:

15    ‘12.-(1) Subject to the provisions of subsection (2) of this section no trade mark shall be registered in  
16    respective of any goods or description of goods that is identical with or nearly resembles a mark  
17    belonging to a different proprietor and already on the register in respect of-

- 1 (a) the same goods,
- 2 (b) the same description of goods, or
- 3 (c) services or a description of services which are associated with those goods or goods of that
- 4 description.’

5 There is a reference to a near resemblance, which is clarified by Section 68 of the Act as

6 ‘..references to a resemblance so near as to be likely to deceive or cause confusion’.

7 Ms Leno pointed out that in opposition proceedings it is normal to apply the following test,

8 from the *Smith Hayden & Co Ltd’s Application* (1946) 63 RPC 101 as adapted by Lord Upjohn

9 in *Bali Trade Mark* [1969] 14 RPC 496. In this instance, the test reads as:

10 **(Under s 12(1))**‘Assuming user by the opponents of their PODS marks in a normal and fair

11 manner for any of the goods covered by the registration of that mark, is the tribunal satisfied

12 that there will be no reasonable likelihood of deception among a number of persons if the

13 applicants use their TODS plus device mark normally and fairly in respect of any goods

14 covered by their proposed registration?’

15 I make no apology for also quoting *Pianotist Co Ltd’s application* (1906) 23 RPC 774, at

16 page 777:

1 'You must take the two words. You must judge of them both by their look and by their  
2 sound. You must consider the goods to which they are to be applied. You must consider the  
3 nature and kind of customer who would be likely to buy those goods. In fact, you must  
4 consider all the surrounding circumstances; and you must further consider what is likely to  
5 happen if each of these trade marks is used in a normal way as a trade mark for the goods of  
6 the respective owners of the marks. If, considering all those circumstances, you come to the  
7 conclusion that there will be a confusion - that is to say - not necessarily that one will be  
8 injured and the other will gain illicit benefit, but that there will be a confusion in the mind of  
9 the public, which will lead to confusion in the goods - then you may refuse the registration, or  
10 rather you must refuse the registration in that case.'

11 Ms Leno very succinctly clarified this as a reference to eye, mouth and ear, that is, to visual,  
12 oral and aural aspects of the marks, coupled with the characteristics of the goods. She also  
13 said, and I agree, that the opponents' best case is with mark N<sup>o</sup> 1157848, i.e. the word mark  
14 POD. The other marks contain excess matter, and if the opponents can't succeed on the word  
15 mark, I do not believe they will succeed with the others. Also, the goods at issue are identical,  
16 since the applicants' specification under mark N<sup>o</sup> 1501029 include footwear, and thus  
17 subsumes the opponents' goods.

18 If I am to begin my comparison I would like to do so first by saying that I note in the  
19 applicants' mark there is excess matter. However, again I agree with the opponent that the  
20 dominating feature is the word TODS. If I compare that with the opponent's mark, as was  
21 pointed out, the only difference is the initial letter and the final 'S'. These may seem like small  
22 differences but I must judge the marks by their look and their sound.

1 I am inclined to agree with many of the statements Mrs. Leno made in her process of  
2 comparing the marks. Unfortunately for the opponents I do not agree with her conclusion. I  
3 do accept that the 'S' is less significant than the 'P' because it would be taken, in my view, as  
4 a possessive. But I think any similarity is overwhelmed by the presence of the 'T' and the 'P'  
5 at the beginning of the words.

6 It is generally accepted that the initial part of a word is of importance in pronunciation, that is,  
7 the initial syllable. I could quote *LONDON LUBRICANTS (1920) LIMITED'S*  
8 *APPLICATION* (1925) 42 RPC 264 here. That case refers, I realize, to the first syllable in a  
9 word and these words are one syllable, but I think the point is still valid. I believe that where  
10 there is a difference such as a 'T' and a 'P' sound - 'ta' and 'pa' - as was pointed out by Ms  
11 Wallace - in a very small word, this is a significant difference. In my view it is quite an  
12 enormous difference in a small word, and makes confusion very unlikely.

13 We also heard about the meanings of these words. I note that POD has a well-known  
14 dictionary definition. I am inclined to disagree, despite the evidence cited from the dictionary,  
15 about the meaning of TODS. To me it is much more likely for people - I think the vast  
16 majority would do this - to take it as a name more than a word that has meaning. Having said  
17 that, I do not think that helps the opponents' case. The fact that POD has a clear meaning, in  
18 my view, would be much more likely to mitigate against the likelihood of confusion.

19 In the light of this, even taking account of imperfect recollection, as I have said, I do not  
20 believe that confusion is possible. If I add on top of this the fact that there is excess matter in

1 the applicants' mark - the lion's head device and the words HAND MADE ENTIRELY BY  
2 EXPERT SHOEMAKERS I think that will reduce the likelihood of confusion even further.

3 *Pianotist* also says I have to consider the goods to which the marks were applied and the  
4 nature and kind of customer. Shoes are not cheap items. They are in most cases fashion  
5 driven and I cannot believe that consumers would not purchase them without taking care.  
6 This is not a classic 'bag of sweets' case. If the name of the product was a factor during  
7 purchase, as it is particularly so with certain items of footwear, then I think the difference  
8 would be even more evident, and would further mitigate against any likelihood of confusion.

9 As I have come to that view I think that takes care of the grounds under section 11 as well.  
10 The opposition has failed, and I see no reason to exercise the Registrar's discretion in this  
11 case. I am ready to take submissions on costs.

12 MS. LENO. I do not have a great deal to say about costs except for the fact that I had hoped  
13 that we could avoid the need for the hearings and if it is possible therefore to minimize the  
14 opponents' cost then that will be appreciated because they have been put to the cost of my  
15 preparing and attending the hearings today.

16 MRS. WALLACE: I endorse Mrs. Leno's request because I feel that my client's conduct has  
17 not been what it might be. We had hoped to avoid this hearing as well. I will not be applying  
18 for excessive cost in any way.

1 THE HEARING OFFICER: I am going to reserve judgment on costs at the moment. I do  
2 take on board what you have just said. They certainly will not be in excess of the normal  
3 scale. Are you suggesting that you would like them even less than the normal scale?

4 MRS. WALLACE: No. We are not going to make a case for anything extra in any way.

5 THE HEARING OFFICER: I will reserve judgement on the costs for the moment. That  
6 ends the hearing.

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## ANNEX

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Mark	Number	Date	Goods
MR. POD	1082075	08.08.1977	Class 25: 'Footwear being articles of clothing.'
 POD	1084790	07.10.1977	
MR POD	1110282	28.02.1979 (Expired 29.02.2000)	Class 25: 'Articles of clothing for children; articles of outer clothing for men and women.'
 POD	1110283	28.02.1979	Class 25: 'Articles of clothing for children, articles of outer clothing for men and women.'
	1113187	24.04.1979 (Expired 25.04.2000)	Class 25: 'Articles of clothing for children; articles of outer-clothing for men and women.'
	1114467	17.05.1979 (Expired 18.05.2000)	Class 25: 'Footwear being articles of clothing.'
POD	1157848	16.07.1981	Class 25: 'Footwear being articles of clothing; articles of outer clothing for men and women; articles of clothing for children.'

	1157849	16.07.1981	Class 25: 'Footwear being articles of clothing; articles of outer clothing for men and women; articles of clothing for children.'
	1408617	19.12.1989	Class 25: 'Footwear being articles of clothing; articles of outer clothing for men and women; articles of clothing for children.'
	2019052	27.04.1995	Class 25: 'Boots, shoes and articles of footwear and components thereof; articles of outer clothing for men and women; articles of clothing for children.'
	2021290	23.05.1995	Class 18: 'Rucksacks; haversacks; travelling bags; leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks; umbrellas; parasols and walking sticks.'