

TRADE MARKS ACT 1994

**IN THE MATTER OF
APPLICATION No. 2372398
BY DR SIMON J MOORE AND DR TIMOTHY RUMNEY
TO REGISTER A TRADE MARK
IN CLASS 44**

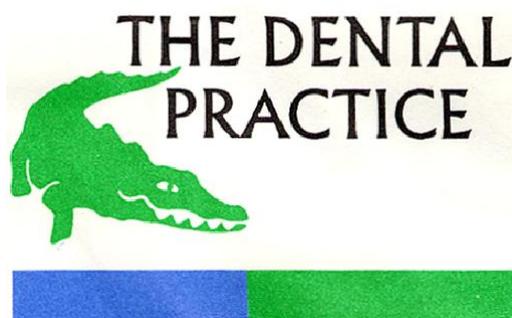
**AND IN THE MATTER OF
OPPOSITION No. 93180
BY LA CHEMISE LACOSTE (SA)**

**AND IN THE MATTTTER OF AN APPEAL
TO THE APPOINTED PERSON
BY THE OPPONENT
AGAINST A DECISION OF MS A CORBETT
DATED 24 MAY 2007**

DECISION

Introduction

1. On 8 September 2004, Dr. Simon J. Moore and Dr. Timothy Rumney applied to register the mark set out below for dentistry services in Class 44.



- The words in the mark are in black and white. The reptilian device is shown in green and white above the blue portion of a blue and green underlining bar. The application is for registration of the mark in colour (rule 5, Trade Marks Rules 2000).
2. The mark was opposed by La Chemise Lacoste (SA) on grounds raised under sections 5(2)(b), 5(3), 5(4)(a) and 56 of the Trade Marks Act 1994. In support of its opposition the opponent relied on a number of Community and United Kingdom registrations and unregistered marks, which all concern crocodile devices.
 3. Both sides filed evidence and written submissions but neither requested a hearing. Ms. Ann Corbett, the Hearing Officer acting for the Registrar, dismissed the opposition in a written decision dated 24 May 2007 (BL O/138/07).
 4. On 21 June 2007, the opponent filed notice of appeal to an Appointed Person under section 76 of the Act. At the hearing of the appeal the opponent was represented by

Mr. Roger Grimshaw of Mewburn Ellis LLP. Mr. Gareth Jenkins of Marks & Clerk appeared for the applicants via teleconference. Mr. Grimshaw confirmed to me that the opponent's appeal is solely against the Hearing Officer's decision under section 5(2)(b).

Section 5(2)(b) of the Trade Marks Act 1994

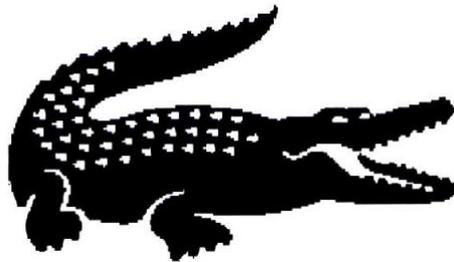
5. Section 5(2)(b) provides as follows:

“5. -(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.”

6. For the purposes of section 5(2)(b), the opponent relied on Community trade mark number 2979581, which consists of the following device:



CTM 2979581 has a filing date of 17 December 2002 (i.e., qualifies as an earlier trade mark under section 6(1)(a) of the Act) and is registered in all 45 International classes except Class 8.

7. The Hearing Officer limited her evaluation under section 5(2)(b) to Class 44 finding that the applicants' dentistry services fell within the opponent's wider specification for medical services (*GALILEO Trade Mark* [2005] RPC 569). There is no appeal against that part of her decision.

8. Further no objection is taken to the Hearing Officer instructing herself with reference to the Registrar's standard summary of the guidance provided by the Court of Justice of the European Communities in Case C-251/95 *Sabel BV v. Puma AG* [1997] ECR I-6191, Case C-39/97 *Canon Kabushiki Kaisha v. Metro-Goldwyn-Meyer Inc* [1998] ECR-I-5507, Case C-342/97 *Lloyd Schuhfabrik Meyer & Co GmbH v. Klijsen Handel BV* [1999] ECR I-3819 and Case C-425/98 *Marca Mode CV v. Adidas AG* [2000] ECR I-4881.

Similarity of marks

9. Essentially, the opponent takes issue with the Hearing Officer's comparison of the marks contained in paragraphs 42 – 50 of her decision:

“42. The earlier mark consists of a device of what seems to me to be a type of reptile and is said by the opponent to be a crocodile. It is presented right side-on, with two of its feet visible, its long snout wide open, with its two eyes visible on the top of its head and its long tail curled sharply towards the left side of its

body. There are lighter areas shown along the back of the creature which have the effect of suggesting it to have a somewhat knobby surface.

43. In their written submissions, the applicants claim that “crocodile/alligator images are in widespread usage” and is used by others in the dental services field. The suggestion I take from this is that devices of such creatures are of low distinctive character. I am not convinced that the average consumer would want to share the characteristics of reptiles but to the extent that they are known for having many functional, perhaps even efficient, teeth, the use of a reptile has what may be considered desirable associations with dental services. But the evidence filed falls far short of establishing that use of such a device is common in the trade, particularly at the relevant date.

44. I find that the earlier mark has a reasonable degree of inherent distinctive character. There is no evidence before me establishing that the opponent has used its mark in relation to either the wider term “medical services” or the more limited “dental services” and therefore I cannot say that it has added to its inherent distinctive character through use.

45. The mark applied for is a composite mark consisting of the words THE DENTAL PRACTICE where the words THE DENTAL appear above the word PRACTICE. To the left of these words is the somewhat smaller device of what again seems to me to be a reptile. Its mouth is shut though there is a suggestion of it having pointed teeth. The creature is viewed from the front/right side with just one eye visible. Again it shows what appear to be two feet and its tail also tends towards the left side and at right angles to its body. Extending underneath the full width of both the word and the device elements is a thick line border.

46. Whilst the effect of the device elements in the applicant’s mark cannot be discounted, they are plainly subsidiary to words THE DENTAL PRACTICE. It is often said that in the case of composite trade marks “words speak louder than devices”. That, in my opinion, is the case here.

47. The respective marks have a degree of visual similarity because they both show a reptilian device but that is the extent of the similarities. Each creature has clear and marked differences in presentation and the applicant’s mark contains the other elements which will not be overlooked. The applicants submit that the words THE DENTAL PRACTICE are distinctive because of the use of the definitive article THE rather than an indefinite article A. That appears to me to be a somewhat semantic argument. Conceptually, I find the marks to be very different. The applicant’s mark is bound to bring to mind a practice dealing with dentistry. The earlier mark brings to mind a reptile.

48. I have reached the clear view that even considered in relation to identical goods [sic - services], there is no likelihood of confusion between the respective marks. The visual, aural and conceptual differences between the two marks outweigh the similarities. In reaching this conclusion, I have taken into account the possibility of confusion arising from imperfect recollection. Dental services are highly personal in nature, and often require significant discussion regarding suitable care and treatment which is provided by qualified practitioners. I consider that the average consumer will generally take great care in trying to find and then choose a suitable practitioner whether the treatment sought is medical or cosmetic.

49. Nor do I consider that the average consumer who is aware of the differences between the respective marks would be confused through association. I do not consider the presence of a reptile in each mark to be

sufficiently distinctive to drive the average consumer to the expectation that any two marks containing such a device must identify goods originating from the same undertaking.

50. The ground of opposition under section 5(2)(b) based on the opponent's earlier mark No. 2979581 therefore fails."

Arguments on appeal

10. The opponent argues that in comparing the marks, the Hearing Officer: (a) attributed too much importance to the words THE DENTAL PRACTICE in the mark applied for; and (b) unduly emphasised differences rather than similarities between the respective reptiles. Additionally, the opponent says that the Hearing Officer failed to take into account the interdependency of similarity in marks and services and, or the reputation of the earlier mark on the market.
11. The root of error according to the opponent is the Hearing Officer's observation that the device elements in the applicants' mark were "plainly subsidiary" to the words (paragraph 46). The opponent contends that the phrase THE DENTAL PRACTICE is descriptive and non-distinctive for dental services and would have no trade mark significance for average consumers (agreed to be the general public). Only the similar reptile logos in each mark would be seen as indicators of origin.
12. Mr. Grimshaw referred me to a number of cases in support of his proposition that the words element in the applicants' mark was irrelevant because it comprised non-trade mark matter. Coincidentally the first two cases concerned representations of kangaroos. In Case R 657/2002-1 *Pakke-Trans A/S*, 16 July 2003, the comparison was between earlier CTM and Benelux registrations for kangaroo devices and a CTM application for a composite mark containing a kangaroo device and the words PAKKE-TRANS below. The respective transport etc. services were identical and PAKKE-TRANS is an abbreviation for "parcel transport" in Danish. Mr. Grimshaw relied particularly on paragraph 28 of the decision where with regard to the visual comparison the Board said:

"Although the word combination in the mark applied for cannot be ignored ... it is the representation of the kangaroo which is the dominant element in both marks."

And in relation to the conceptual comparison, paragraph 32:

"Although the applicant endeavours to limit the influence of the device in favour of the word combination 'PAKKE-TRANS' in the Board's estimation it is the device, which is not only the dominant, but also the distinctive element of the mark applied for."

13. Mr. Grimshaw's second authority was a decision of the UK Registrar issued under reference number, BL O/025/98. The earlier mark was a kangaroo device with the word "KangaROOS" below. The applicant's mark was also a kangaroo device but in an elliptical shape with the word "CLASSIC" written above. The respective goods were in Class 25. With reference to the word element CLASSIC the Hearing Officer observed (page 10):

"It seems to me that more descriptive or non-distinctive a particular word or device is, the less likely that element is to contribute to the overall character of the mark".

And further:

“It [CLASSIC] also has the consequential effect of focussing attention on the device element of the applicants’ mark namely the silhouetted kangaroo contained within the elliptical shape.”

I noted at the hearing that when this case was heard the Registry was still applying the *Pianotist* test ((1906) 23 RPC 774) under the old law.

14. As further examples of cases in which devices spoke louder than words, Mr. Grimshaw referred me to BL O/274/01 and BL O/124/98. In the first example, the earlier mark comprised jigsaw pieces and the later mark, jigsaw pieces together with the word CONNECTOLOGY. The second mark concerned two EE back to front devices but the mark applied for had the words ELIZABETH EMANUEL written underneath. Mr. Grimshaw emphasised that the respective marks in each case were found to conflict under section 5(2) even though the word elements were distinctive.

15. On the question of distinctive character, Mr. Grimshaw referred me to the following passage in the judgment of Mr. Geoffrey Hobbs Q.C. sitting as the Appointed Person in “*Cycling IS ...*” *Trade Mark Applications* [2002] RPC 729 at paragraph 57:

“The question whether a particular sign possesses a distinctive character cannot be considered in the abstract... It must be considered in relation to the goods or services for which registration has been requested... In order to be registrable in that connection the sign in question must possess enough of a distinctive character to be regarded as an indication of trade origin by the relevant class of persons or at least a significant proportion thereof...”

And Joined Cases C-53/01 – C-55/01 *Linde* [2003] ECR I-3161, paragraph 41:

“In addition, a trade mark’s distinctiveness must be assessed by reference to, first, the goods or services in respect of which registration is sought and, second, the perception of the relevant persons, namely the consumers of the goods or services.”

16. Mr. Grimshaw further relied on Mr. Hobbs’ observations at paragraph 53 of *Cycling .../IS* (which needs to be read with paragraph 52):

“52. In paragraph 30 of its judgment in *Canon*, the ECJ held that there can be no likelihood of confusion of the kind rendered actionable by the Directive where it does not appear that the public could believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings.

53. It thus appears to be legitimate, when assessing whether a sign is sufficiently distinctive to qualify for registration, to consider whether it can indeed be presumed that independent use of the same sign by different suppliers of goods or services of the kind specified in the application for registration would be likely to cause the relevant class of persons or at least a significant proportion thereof, to believe that the goods or services on offer to them came from the same undertaking or economically-linked undertakings.”

17. Lastly, I was directed to decision UK Registrar in BL O/362/06, which is said to represent the current practice on composite marks. The mark in suit comprised a device of an elephant enclosed in a circular shape with the words BRAND PROTECT alongside. The mark was opposed inter alia under section 3(1)(b) and (c) of the Act on the ground that the mark was descriptive of and non-distinctive for the services applied for, which included brand protection. The Hearing Officer dismissed both objections. In response to an argument that the elephant device was purely decorative, the Hearing Officer said (paragraph 23):

“Whilst the consumer will regard the words and figurative elements of the mark as a composite whole, the figurative element is a clear and distinct part of the mark, and in its relative size and positioning is at least as prominent as the word elements ... In my view the figurative element is a distinctive part of the mark and contributes in the creation of something that has a distinctive whole ...”

18. In conclusion on the first ground, the opponent says that THE DENTAL PRACTICE is wholly descriptive in relation to the claimed services, is not inherently registrable and should have been ignored (or at least regarded as silent) in the comparison of marks.
19. Moving on to the second ground, Mr. Grimshaw says that the Hearing Officer was wrong to suggest that the only similarity in the marks was that both showed a reptilian device. He took me to three similarities that he believed were significant. Both marks show a reptile logo: (a) presented right side/front right side on; (b) with two feet visible; and (c) a tail curled to the left side of the reptile’s body.
20. Mr. Jenkins in response:
 - (a) sought to distinguish, e.g., *PAKKE-TRANS* and *CLASSIC* on the basis that the word elements in those cases were independent, or appeared separately from device elements in the marks. In contrast, in the applicants’ mark the device element was intertwined with the words and with the border;
 - (b) emphasised that the applicants’ mark must be considered as a whole. The question was not whether THE DENTAL PRACTICE was registrable as a trade mark;
 - (c) observed that the relied on similarities between the reptile logos were as a result of the reptile in each case being displayed in natural pose.

Decision

21. There is a difference between descriptiveness and similarity. European trade marks law recognises that a trade mark may contain descriptive and, or non-distinctive elements (Case C-363/99 *Koninklijke KPN Nederland NV v. Benelux-Merkenbureau* [2004] ECR I-1619, paragraphs 96 and 99, Case C-265/00 *Campina Melkunie v. Benelux-Merkenbureau* [2004] ECR I-1699, paragraphs 37 and 40, Case C-329/02 P *SAT.1 SatellitenFernsehen GmbH v. OHIM* [2004] ECR I-8317, paragraph 28, Case C-273/05 P *OHIM V. Celltech*, 19 April 2007, paragraphs 76 – 80 and recently Case T-105/06 *InterVideo Inc v. OHIM*, 17 October 2007, paragraph 33).
22. Therefore, in determining a conflict under section 5(2)(b), the degree of similarity must be assessed by comparing the respective marks overall, Case C-120/04 *Medion AG v. Thomson multimedia Sales Germany & Austria GmbH* [2005] ECR I-8551, paragraph 29:

“In the context of consideration of likelihood of confusion, assessment of the similarity between two marks means more than taking one component of a composite trade mark and comparing it with another mark. On the contrary, 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 may not in certain circumstances, be dominated by one or more of its components (see *Matratzen Concord*, paragraph 32)”.
23. The degree of similarity is not made less or more by the distinctive character of elements in a mark (Case C-235/05 P *L’Oréal SA v. OHIM* [2006] ECR I-57, paragraphs 39 and 42 – 46). All the elements of a mark must be taken into account

unless they are merely negligible (Case C-334/05 P *OHIM v. Shaker di L. Laudato & C. Sas*, 12 June 2007, paragraph 42, Case C-193/06 P *Société des Produits Nestlé SA v. OHIM*, 20 September 2007, paragraph 44). Further, even though a composite mark is visual in nature, examination must extend to its phonetic and conceptual as well as visual features (*Shaker di L. Laudato*, paragraphs 39 – 40).

24. The distinctive character of a trade mark overall may, however, affect its scope of protection, i.e., the likelihood of confusion (Case C-251/95 *Sabel BV v. Puma AG* [1997] ECR I-6191, paragraph 24, Case C-39/97 *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1998] ECR I-5507, paragraph 18, Case C-342/97 *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel BV* [1999] ECR I-3830, paragraph 20).
25. I would agree that the words THE DENTAL PRACTICE are on their own descriptive of the services applied for. Generally speaking the public will not consider such an element to be dominant (see, e.g., Case T-129/01 *José Alejandro SL v. OHIM* [2003] ECR II-2251, paragraphs 52 - 53). But that is not necessarily the case (Case C-3/03 P *Matratzen Concord GmbH v. OHIM* [2004] ECR I-3657, paragraphs 34 – 35, Case T-288/03 *TeleTech Holdings Inc v. OHIM* [2005] ECR II-1767, paragraph 86).
26. The Hearing Officer considered the various elements making up the applicants' mark noting their relative sizes and arrangements. She concluded that the device elements would play a subsidiary role in the public perception to the words. Contrary to the opponent's submissions, the Hearing Officer did not disregard similar features possessed by the respective reptilian devices. However, she observed that there were clear differences between them including that the reptile in the applicants' mark was facing to the front/right, had just one eye and its mouth was closed. Visually, aurally and conceptually there were differences between the respective marks overall that would be apparent to the average consumer of dentistry services. In my judgment that was a determination that the Hearing Officer was entitled to reach.
27. The opponent additionally contends that the Hearing Officer failed to take into account the principle of interdependence, i.e., that a lesser degree of similarity between the marks can be offset by a greater degree of similarity between the services (*Lloyd*, paragraph 20). I do not accept that criticism. It is clear from paragraph 48 of the decision that the Hearing Officer had in mind the identity of the services when determining the likelihood of confusion.
28. Finally, the Hearing Officer is criticised for ignoring the reputation of the earlier trade mark. The Hearing Officer's unchallenged findings were: (i) the evidence did not make clear to which of several trade marks sales figures etc. related; (ii) the opponent's earlier trade mark had not been used in relation to medical (or dentistry) services. In those circumstances it is unsurprising that the Hearing Officer decided that the opponent was not entitled to an enhanced penumbra of protection for CTM 2979581.

Conclusion

29. In the result the appeal fails. The Hearing Officer ordered the opponent to pay the applicants the sum of £1000 as a contribution towards their costs of the opposition. I shall order the opponent to pay the additional sum of £450 as a contribution towards their costs of the appeal.

Professor Ruth Annand, 12 December 2007