

**TRADE MARKS ACT 1994**

**IN THE MATTER OF International  
Registration No. 817517 and a request by Julia Ruhnke  
to protect a trade mark in Classes 3, 18 and 25**

**and**

**IN THE MATTER OF Opposition thereto under No. 71126  
By Queen Productions Ltd**

**BACKGROUND**

1. On 18 December 2003, Julia Ruhnke, on the basis of a German registration, requested protection in the United Kingdom under the terms of the Madrid Protocol for the mark QUEEN FOR A DAY for goods falling in classes 3, 18 and 25 of the International Classification system. The request was made in relation to:

Class 3: Soaps; perfumery, essential oils, cosmetics, hair lotions.

Class 18: Leather and imitations of leather, and goods made of these materials (included in this class); bags made of cotton and leather; animal skins, hides trunks and travelling bags; umbrellas, parasols and walking sticks.

Class 25: Clothing, footwear, headgear.

2. The United Kingdom Trade Mark 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.

On 25 June 2004, Queen Productions Limited filed notice of opposition to the conferral of protection on this international registration. The opponent is the proprietor of the following Community trade mark registrations:

<b>No.</b>	<b>Mark</b>	<b>Class</b>	<b>Specification</b>
208439	QUEEN	9	Scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of

			<p>sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus; video and/or sound recordings; films; film strips; compact discs; gramophone records; audio cassettes; computer games software.</p> <p>16 Paper, paper articles; cardboard, cardboard articles; sheet music; printed matter; periodical publications, musical greeting cards, gift token cards, greeting cards, record sleeves; bookbinding materials; photographs; stationery; adhesives for paper and stationery or for household purposes; artists' materials; paint brushes; typewriters and office requisites; instructional and teaching material; packaging materials; transfers and decalcomanias; playing cards.</p> <p>25 Articles of clothing; footwear; headgear; T-shirts, coats, jackets, anoraks, trousers, dresses, pyjamas, suits, sweat shirts.</p> <p>41 Education and entertainment; live entertainment; production of radio and television programmes; entertainment services relating to radio and television programmes; production of video and/or sound recordings, shows; production of films; television and radio entertainment; shows, theatrical stage and musical entertainment and production thereof; theatre productions; publication of books and publication of texts; rental of sound and video recordings; production and rental of video games; downloading of audio and video from the Internet, being education or entertainment services.</p>
528158	 <p>QUEEN</p>	9	<p>Scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines</p>

			and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus; video and/or sound recordings; films; film strips; compact discs; gramophone records; audio cassettes; computer games software.
		16	Paper, paper articles; cardboard, cardboard articles; sheet music; printed matter; periodical publications, musical greeting cards, gift token cards, greeting cards, record sleeves; bookbinding materials; photographs; stationery; adhesives for paper and stationery or for household purposes; artists' materials; paint brushes; typewriters and office requisites; instructional and teaching material; packaging materials; transfers and decalcomanias; playing cards.
		25	Articles of clothing; footwear; headgear; T-shirts, coats, jackets, anoraks, trousers, dresses, pyjamas, suits, sweat shirts.
		41	Education and entertainment; live entertainment; production of radio and television programmes; entertainment services relating to radio and television programmes; production of video and/or sound recordings, shows; production of films; television and radio entertainment; shows, theatrical stage and musical entertainment and production thereof; theatre productions; publication of books and publication of texts; rental of sound and video recordings; production and rental of video games; downloading of audio and video from the Internet, being education or entertainment services.

4. In its statement of case, the opponent claims that the mark applied for is similar to its own trade marks insofar as class 25 is concerned and that the holder of the international registration is seeking to register the trade mark in respect of identical goods. It says that the mark applied for “incorporates the Opponent’s Trade Mark in its entirety”, asking that the application for protection in the UK be refused under section 5(2)(b) of the United Kingdom Trade Marks Act 1994 and that it be awarded costs. The opposition is directed only at class 25 of the application.

5. The applicant international registration holder, who I will for convenience simply refer to as the applicant and to 817517 as the application, filed a counterstatement denying the above ground, asking that the opposition be dismissed and requesting a costs award.

6. Only the opponent has filed evidence. Neither side has asked to be heard. Written submissions were also received from Forrester Ketley & Co, the opponent's professional representatives, by way of their letter of 30 October 2006.

## **THE EVIDENCE**

7. The opponent's evidence consists of a witness statement by Robert William Lee, the opponent's Company Secretary. Mr Lee, in his witness statement, says that the directors of Queen Productions Limited are the surviving members of "the well-known musical group Queen". The group was formed in the early 1970s, releasing their first album in 1973. Queen have sold, to date, in excess of 140 million records worldwide and their single, Bohemian Rhapsody, has been voted as the favourite single of all time. In relation to sales of clothing, items have been sold at concerts and also via the opponent's website. Mr Lee submits that Queen has a considerable reputation; that its trade mark is very well known; and that it has generated goodwill by virtue of sales of clothing. The exhibits below support Mr Lee's statement.

RWL1: company report and accounts

RWL2: biography of Queen, the pop/rock group

RWL3: details of the community trade marks already referred to in this decision

RWL4: net sales for Queen singles and albums for the years 1996/7 to 2004/5, excluding the USA

RWL5: articles from the Daily Mail newspaper about Queen

RWL6: merchandising pages from Queen's website in relation to sales of clothing

The written submissions of 30 October 2006 repeat the claims of reputation and likelihood of confusion with the application.

That completes my review of the evidence.

## **DECISION**

8. The sole ground of opposition is under section 5(2)(b) of the Act, which reads:

“5.—(1)...

(2) A trade mark shall not be registered with an earlier mark if because—

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

- (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.”

9. The “term earlier trade mark” is defined in section 6(1) of the Act. The community registrations, numbers 208439 and 528158, relied upon by the opponent are earlier trade marks within the meaning of the section, having respective filing/registration dates of 1 April 1996/8 May 2000 and 6 May 1997/21 March 2001. The opponent’s marks are not caught by the Trade Marks (Proof of Use, etc.) Regulations 2004 as they had not been registered for five years at the date of publication of the application.

10. There is well-established guidance from the following judgments of the European Court of Justice which I must apply – *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG and Adidas Benelux BV* [2000] E.T.M.R. 723.

11. In essence, the test under section 5(2) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. 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 differing elements, taking into account the degree of identity/similarity in the goods and how they are marketed. I must compare the marks in issue, having regard to the distinctive character of each and assuming normal and fair use of the marks across the full range of the goods within their respective specifications. I must do all of this from the standpoint of the average consumer for the goods in question.

### **Similarity of goods**

12. This opposition is directed only at class 25 of the application: “clothing, footwear, headgear”. The opponent’s earlier marks, in respect of class 25, cover “articles of clothing; footwear; headgear; T-shirts, coats, jackets, anoraks, trousers, dresses, pyjamas, suits, sweat shirts”. It is clear that, based on the notional scope of the respective specifications, identical goods are in play.

### **Similarity of marks**

13. My assessment under this heading includes the visual, aural and conceptual similarities between the marks, taking into account the dominant and distinctive elements of each, without dissecting the marks in a way which would be alien to the purchasing experience of the average consumer. That average consumer will range from the general public to the wholesaler/merchandising distributor. Purchases of clothing are likely to be made with some degree of care not least because issues of size, style, colour, price etc must be considered. Nevertheless, the consumer may not exhibit the very highest level of attention particularly if the item is a relatively low

cost or utilitarian item such as a pair of socks. The contrary may of course be the case if very expensive items are involved.

14. Visually, there are points of similarity between the marks notably the presence in all of the word “QUEEN”. In visual terms, the opponent’s word-only “QUEEN” mark (208439) is the closer of its two registrations and offers the best chance of success. I will confine my analysis therefore to the application and the word-only “QUEEN” mark, since the specification coverage for this mark is the same as for the opponent’s word and device mark. “Queen” appears at the beginning of the application and is the sole element of 208439. The aural similarities are comparable to that of the visual; the applicant’s mark is longer than the earlier trade mark, both visually and aurally, but begins with the identical element “Queen”.

15. The appearance of trade marks is particularly important in relation to clothing, which is primarily a visual purchase (see *React Trade Mark* [2000] R.P.C 285). I have already found that there is a similarity between the marks, but I do not think that similarities between “QUEEN” and the longer phrase “QUEEN FOR A DAY” can be properly assessed merely by a comparison of the word-count of the respective marks and the positioning of the point of similarity, “Queen”. I must also consider what part the conceptual significance of each of the marks plays.

16. The opponent’s mark consists solely of the word “QUEEN”, meaning a female monarch. The opponent has submitted evidence to show that there is also a music band of considerable fame which bears the word as its name. It submits that the mark has an enhanced level of distinctiveness because of that fame. However, the evidence is wholly unconvincing when it comes to establishing that either of the earlier trade marks has acquired any enhanced distinctive character through use (other than in relation to the status of the band). No turnover figures are given in relation to the trade in clothing and the single exhibit (RWL6) that may be said to support the claim is after the relevant date. However, as a mark applied to clothing, it is inherently distinctive to a relatively high degree (save, perhaps, for fancy-dress outfits). The concept of the mark for clothing is overwhelmingly fanciful: a female monarch.

17. This brings me to the concept of the applicant’s mark. “QUEEN FOR A DAY” carries with it the suggestion that the wearer can feel special in some way, for the time that the garment is worn. It does so by reference to a female sovereign. Two related notions are thus embedded in the mark. Different conceptual considerations can play an important part in serving to distinguish between marks (see paragraph 54 of the CFI’s judgment in *Phillips-Van Heusen Corp v Pash Textilvertrieb und Einzelhandel GmbH*, Case T-292/01). The ECJ has also held that where conceptual dissimilarities are being relied on to counteract visual and/or aural similarities, it is necessary for one of the signs to have a clear and specific meaning so that the public is capable of grasping it immediately, Case C-361/04P *Ruiz Picasso and Others v OHIM* [2006] ECR I-0000, paragraph 20.

18. The fact that the applied for mark conveys a message about how the wearer might feel rather than purely being a reference to a female monarch suggests that there is a degree of conceptual dissimilarity between the rival marks. The question is what the effect of conceptual considerations has on the overall similarity between the marks.

19. My concern is that the conceptual difference in suggesting how the purchaser/wearer will feel is reinforcing, rather than distinguishing from, the association with royalty. The circumstances are therefore rather different to those pertaining in the above-mentioned cases or O/339/04 where the marks Cardinal and Cardinal Place were held to have different significations, one being ecclesiastical and the other locational. Furthermore, consumers are not generally credited with pausing to analyse marks or engage in the thought processes that might be necessary for subtle conceptual differences to be decisive in this case. I find the respective marks to be similar though admittedly not to the highest extent.

### **Likelihood of confusion**

20. I think it unlikely that the marks would be directly confused with one another. However, according to the jurisprudence cited above, I must also have regard to a scenario where, although the marks are not mistaken directly, there is a belief or an expectation upon the part of the average consumer that the goods bearing the individual marks emanate from a single undertaking because there are points of similarity which lead to association. If the association between the marks causes the public wrongly to 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*, paragraph 29.

21. Having regard to the identity of the goods, the distinctive character of the word/element QUEEN, the fact that both marks convey messages that focus on the idea of the female sovereign, I find that there is a likelihood of confusion within the meaning of Section 5(2)(b). The opposition succeeds in relation to class 25. The international registration for protection will therefore become protected in the United Kingdom for classes 3 and 18, but not for class 25.

### **Costs**

22. The opponent is entitled to a contribution towards its costs. I note that the opponent's written submissions request that my costs award reflect the fact that the applicant asked for the proceedings to move to the evidence stage and put the opponent to proof of its claims. The applicant also sought an extension of time for filing evidence but ultimately did not file any.

23. As regards the first of these claims, it was up to the opponent to decide what evidence it considered it needed to file. Its statement of grounds made no claim in relation to use. The opponent took the decision to file the evidence it did. In the event that evidence has played little part in these proceedings. So far as the extension of time issue is concerned it is understood that no objection to the extension was made at the time and that the proceedings were subsequently suspended to allow time for settlement negotiations. I do not consider the applicant's behaviour on either account to have been unreasonable such that it merits a costs award in favour of the opponent.

24. I order the applicant to pay the opponent the sum of £1000. 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 8th day of January 2007**

**M REYNOLDS  
For the Registrar  
the Comptroller-General**