

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2242346
BY MANCHESTER UNITED PLC TO REGISTER
A SERIES OF THREE MARKS IN
CLASSES 16, 18 AND 25**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No 52297 BY RANDOM HOUSE INC**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No. 2242346
by Manchester United Plc to register a series of
three marks in Classes 16, 18 and 25**

AND

**IN THE MATTER OF Opposition thereto under
No. 52297 by Random House Inc**


DECISION

1. On 11 August 2000 Manchester United Plc applied to register the following series of three marks



for the specifications of goods which appears in the Annex to this decision. The application is numbered 2242346.

2. On 20 March 2001 Random House Inc filed notice of opposition to this application. They are proprietors of the following marks:

No	Mark	Class	Specification
1011117		16	Books, printed matter and printed publications

3. They object in the following terms and on the following basis:

"The mark the subject of trade mark application No 2242346 VINTAGE REDS is similar to the Registrations which are earlier trade marks within the meaning of Section 6(1) of the Trade Marks Act 1994, and is to be registered for goods both identical and similar in Class 16 to those in respect of which the earlier trade marks are protected. For the clarification of doubt, opposition is only filed in respect of Class 16 and not in respect of Classes 18 or 25. As a result, there exists a likelihood of confusion on the part of the public which includes the likelihood of association with the earlier trade marks. In particular, the goods "books and printed matter" are considered identical to the goods in respect of which the earlier trade marks are registered and the goods "newspapers, magazines and periodical publications, photographs, stationery, instructional teaching materials, manuals, writing or drawing books and pads, playing cards, address books, holders, booklets, book markers and book ends, catalogues, maps" are considered to be similar goods to books insofar as these are usual items in relation to which a book imprint can be used which would sell through the same channels of trade and to the same end consumers. Refusal of the application is therefore sought under Section 5(2)(b) of the Trade Marks Act 1994."

4. The applicant filed a counterstatement denying the above ground and adding:

"The relief sought by the Applicants is registration of application No 2242346 save of course for the deletion of "books", which was actioned by the filing of a Form TM21 on the 26th April 2001¹. It should be further noted that the filing of this Form TM21 requesting the deletion of "books" from the Class 16 specification was in direct response to the Opponents request, which would have amicably settled this matter, but the Opponents have nonetheless pursued the matter. The Applicants therefore request that costs be awarded in their favour in these proceedings."

5. Both sides ask for an award of costs in their favour.

6. Neither side has filed evidence and neither side has asked to be heard. In line with current practice the Registry wrote to the parties indicating that it was considered a decision could be reached on the basis of the material filed but reminding them of their right to a hearing and offering to appoint such a hearing. In the alternative the parties were invited to file written submissions. In the event the parties have neither requested a hearing or filed written submissions. Acting on behalf of the Registrar and after a careful study of the papers I give this decision.

¹ The deletion is reflected in the specification given in the Annex

Section 5(2)(b) reads:

"5.-(2) A trade mark shall not be registered 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 mark 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."

7. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer 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*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, 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.* 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*, paragraph 23;
- (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*, paragraph 23;
- (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-Mayer Inc*, 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*, 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*, paragraph 26;
- (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*, 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-Mayer Inc*, paragraph 29.

8. The opponents have two registrations which are earlier trade marks within the meaning of Section 6(1) of the Act. No 1011117 has a slightly broader specification of goods but the mark itself contains a strong device element in addition to the word VINTAGE. No 1256466 is for the word VINTAGE solus and appears to offer the opponents a somewhat stronger case.

9. The applicants for their part point out that they have deleted 'books' from their specification and thus consider they have removed the most obvious area of potential conflict. However their specification still covers printed matter at large, a general term which must include books (see *Minerva Trade mark* [2000 FSR 734]). The specification also covers various sub-species of books such as writing or drawing books. I, therefore, consider that identical goods are involved. Other goods may be similar but I differ from the opponents as to the extent to which this is likely to be the case. I do not for present purposes need to consider the issue of precisely which goods would be similar at this point. Having identified that some goods at least in the applicants' specification are identical to the opponents' 'books' I propose to go on and consider the marks themselves.

10. The marks at issue are VINTAGE and VINTAGE REDS. No evidence of use of the earlier trade mark has been placed before me so the opponents cannot claim any enhanced degree of distinctive character for their earlier trade mark. I must nevertheless form a view as to its inherent attributes.

11. VINTAGE is a dictionary word with a well known meaning. The exclusion from the opponents' goods specification of "any such books relating to wines or to cars" recognises that the word carries a particular and direct descriptive significance in relation to books on these subjects. Beyond that it might be said that the word VINTAGE may lend itself more widely to use in describing or alluding to objects of a particular period or age. In other contexts the word would command a higher degree of distinctive character. All of this suggests that there may be no single measure of the distinctiveness of the mark in relation to books. Much will depend on the subject matter in respect of which it is used.

12. The applicants' mark is VINTAGE REDS. The word VINTAGE is used adjectivally to qualify the word REDS. The latter needs no explanation but I will consider the combination when I come on to conceptual comparison of the respective marks below.

13. Turning to the comparison of marks I will deal with visual aspects first. Clearly there must be an element of similarity as the whole of the opponents' mark is contained within the applicants' mark as a separate word. It is also the first element of that mark. On the other hand the applied for mark consists of two words and the presence of the word REDS is unlikely to be overlooked. VINTAGE is a qualifying word and therefore subordinate in effect if not position to the noun. Having a common element is not the same as being similar. Taken as wholes I do not consider the respective marks to be visually similar.

14. The same is true in relation to aural usage. This is not a case where slurring of syllables or mishearing is likely to play a part. The applicants' mark would be articulated in its totality and obviate any risk of aural similarity beyond the word that is common to both marks.

15. Conceptually much depends on what the public makes of the marks. The opponents' mark is easily understood. It is a dictionary word. It may be used as a noun or an adjective. It is, one might say, undemanding in terms of yielding a meaning.

16. Two possibilities present themselves in relation to the applicants' mark and I must allow for both. The first is that the underlying goods will be directed at individuals who will recognise what is (I assume) an intended reference to the Manchester United colours and team nickname. But I bear in mind that there is no restriction to the applicants' specification which has the effect of limiting the subject matter or target audience in this way. It is possible therefore that some members of the public to whom the mark/goods may be exposed will fail to make any connection with the Manchester United football club/team. In that case the mark might either bring to mind vintage wines or carry no obvious significance at all. To the extent that the mark may bring to mind wines or be taken as a reference to the club it has a meaning which goes beyond the word VINTAGE used on its own. If on the other hand no obvious meaning is conveyed or discerned the mark becomes a quite unusual collocation of the word VINTAGE used with the plural form of the word signifying a colour or perhaps (less likely) communists. However no matter what view is taken of the mark I cannot see that it assists the opponents in the sense that it establishes conceptual similarity.

17. In summary having regard to visual, aural and conceptual considerations and making due allowance for the fact that there is some at least identity of goods I have come to the view that there is no likelihood of confusion. I have also considered whether the public might nevertheless have reason to think that goods offered under the mark came from the same or an economically linked undertaking. But again I have come to the view that this is unlikely to be the case. Accordingly the opposition fails.

18. The applicants are entitled to a contribution towards their costs. I order the opponents to pay them the sum of £500. 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 5th day of February 2002

M REYNOLDS
For the Registrar
the Comptroller-General

Specification of the applied for mark:

Class 16

Printed matter; newspapers; magazines and periodical publications; photographs; programme binders and binding material; stationery; instructional teaching materials; manuals; writing or drawing books and pads; playing cards; birthday cards and cards; greeting cards; postcards; tickets; timetables; note pads and note books; photo engravings, photograph albums and albums; address books; cheque book holders; almanacs; holders, cases and boxes for pens; blotters and jotters; pens and pencils; pencil and pen holders; wooden pen sets; paper, cardboard and articles made from these materials; erasers and erasing products; pencil sharpeners; rulers; books and booklets; book markers and book ends; posters; letter trays; calendars; paper weights and paper clips; gift bags and bags for packaging; gift wrap; gift tags and packaging paper; envelopes, folders, labels, seals, blackboards and scrap books; height charts and charts; carrier bags and garbage bags; prints and pictures; ink and ink wells; paper knives; poster magazines; signs and advertisement boards, paper and cardboard; adhesive tapes and dispensers; office requisites and diaries; hat boxes; pads of paper; stickers and stencils; beer mats; paper and cardboard coasters; catalogues; decalcomanias; confetti; transfers and diagrams; drawing instruments and materials; paint boxes and brushes; patterns and embroidery design; engravings and etchings; paper towels and handkerchiefs; paper flags; toilet paper; maps; paper and cardboard place mats; graphic prints, representations and reproductions; lithographs and lithographic works of art; portraits; paper table cloths and napkins; prints.

Class 18

Articles included in Class 18 made of leather or of imitation leather; suitcases, trunks and travelling bags; school bags and satchels; back packs and beach bags; umbrellas and umbrella covers; duffel bags, boot bags, holdalls, wallets and bags; belts; key cases and cases; purses; boxes; pouches; credit card holders; wallets incorporating cheque book holders; walking canes and sticks; attache cases and brief cases; bands and straps of leather; leather shoe and boot linings; collars and covers for animals; leather trimmings; laces, leads and leashes; parts and fittings for all the aforesaid goods.

Class 25

Articles of outer clothing; articles of sports clothing; leisurewear; articles of underclothing; lingerie; hosiery; footwear being articles of clothing; headgear (for wear); shirts; boots; underwear; coats; overalls; collar protectors and collars; ear muffs; football boots and shoes; fittings of metal for boots and shoes; shorts; T-shirts; socks; sweaters; caps; hats; scarves; jackets; dressing gowns; pyjamas; sandals; slippers; footwear; boxer shorts; beach clothes and shoes; baby boots; diapers and bibs; romper suits; baby pants and sleep suits; dungarees; braces; belts and berets; wrist bands; track suits; ties; cravats; aprons; bathrobes; bathing caps and suits; bathing trunks; galoshes; garters; gloves and mittens; headbands; boots; jackets; jerseys; jumpers and knitwear; leggings; clothes linings; parkas; shawls; singlets; skirts; vests; visors; waistcoats; waterproof clothing.