

O-040-07

TRADE MARKS ACT 1994
And
THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996
IN THE MATTER OF INTERNATIONAL REGISTRATION NO 832179
IN THE NAME OF QUELLE AKTIENGESELLSCHAFT

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 71182 IN THE NAME OF
REPUBLIC TECHNOLOGIES (NA) LLC

**TRADE MARKS ACT 1994 and
The Trade Marks (International Registration) Order 1996**

**IN THE MATTER OF International registration No. 832179
in the name of Quelle Aktiengesellschaft**

And

**IN THE MATTER OF opposition thereto under No 71182
in the name of Republic Technologies (NA) LLC**

BACKGROUND

1. On 12 June 2003, Quelle Aktiengesellschaft applied to extend the protection of their trade mark registered under the Madrid Protocol to the United Kingdom. The trade mark is as follows:



and is for the following specifications of goods:

- | | |
|----------|---|
| Class 04 | Industrial oils and greases; lubricants; dust-absorbing, dust wetting and dust binding agents; solid, liquid and gaseous fuels; engine fuels (as far as included in this class); illuminants; candles, wicks, lighting materials, included in this class. |
| Class 07 | Machine tools; engines (except engines for land vehicles); couplings and drive belts (except those for land vehicles); mechanically driven |

agricultural tools; agricultural machines; incubators for eggs; cleaning machines; mechanical filtering apparatus; filters as parts of machines and engines; pumps for conveying liquids, solids and air, electric or driven by petrol engines or as an attachment to hand-operated appliances or machines; electric lawnmowers, electric hooks, electric straw cutters; power generators; pressure valves, pressure controls; machines for metal, wood, plastics processing, compressors, automatic welding tools, sweepers, snow ploughs, lifting gear, sewing machines, knitting machines, dishwashers, washing machines, ironing machines, electrically driven appliances for homes and kitchens, welding machines for foils, bread and meat slicers, electric tin openers, mixers, juice extractors, electric knives, electric choppers, universal food processors, pasta machines, stirring devices, meat mincers, grain mills, coffee grinders, all-purpose cutters, presses; electrically driven tools for DIY, cutting, boring, percussiondrilling, planing, screwing, grinding and milling machines, hammer drills, drill screwdrivers, drilling and milling stations, milling and grinding motors, lathes, electric saws, rock saws, chain saws, compass saws, circular saws, circular saws benches, cutting devices and work benches adapted for use with the above-mentioned tools, electric planes, grinding tools and machines, electric and manual tackers, gas operated soldering guns, hot-adhesive guns, electric generators, power generators, paint spray devices, wallpaper removers, blowing machines, also for removing varnish, fleece separators and cutting machines, electric welding devices and machines, high-pressure cleaners, sand blasters, drill sharpeners as appliances and as an attachment for drills, hydraulic garage door openers, roll-up door motors and lift; compressors and accessories, in particular paint spray guns, spray guns, sand blasters; cable hoist and bottle lifting gear, including electric; cable winches; electric lawn trimmers, rechargeable hedge cutters, lawn scarifiers, motor scythe, cutters, shredders, mulch mowers, petrol and electric lawnmowers, lawnmowers in the form of tractors and other vehicles; mechanical lawnmowers, mechanical lawn trimmers, electric and mechanical hedge cutters; electric shears.

- Class 08 Hand-operated tools and instruments; hand-operated tools for agricultural, horticultural and forestry purposes, for machine, apparatus and vehicle construction and for the construction industry; cutlery, forks and spoons; side arms; shavers; nail cutters; dog trimmers; vices, garden hoes, electric manicure tools; hand-operated pumps for conveying liquids, solids and air.
- Class 13 Firearms; ammunition and shot; explosives; fireworks.
- Class 14 Precious metals and their alloys, as well as goods manufactured from precious metals or their alloys or plated therewith, in particular craft

objects, ornaments, tableware (except cutlery), table centrepieces, cooking pans, ashtrays, cigar and cigarette cases, cigar and cigarette holders; jewellery, decorative goods, precious stones; clocks; cases adapted to contain the above-mentioned goods.

- Class 15 Musical instruments.
- Class 16 Paper, card and goods from paper and card, namely paper towels, serviettes, filter paper, paper handkerchiefs, toilet paper, disposable nappies, packaging containers, packaging bags; printed products; bookbinding articles, namely bookbinding yarn, linen and other textile materials for bookbinding; photographs; stationery; photo albums; adhesives for paper and stationery or for domestic purposes, including craft; self-adhesive tapes for paper and stationery or domestic purposes; artists' supplies, namely drawing, painting and modelling goods; paint brushes; typewriters and office supplies, namely non-electrical office tools; addressing machines, franking machines, letter openers, writing pads, punches, staplers, staples, typewriter ribbons, correcting fluids for office purposes, stamps, ink pads, stamp ink, inks for writing and drawing, indian ink; teaching aids (except apparatus) in the form of printed products, games, animal and plant specimens, geological models, globes, drawing instruments for blackboards; plastics packaging material, namely sleeves, bags and foils; printers' type; printing blocks.
- Class 20 Furniture, camping furniture, bedding, mattresses, pillows, sleeping bags for camping purposes; mirrors, frames, goods made of wood or wood substitute materials, namely profile strips for picture framing, curtain rails, dowels, boxes, transport pallets, barrels, containers, chests, workbenches, tanks, taps for casks, tool handles, yarn reels, clothes hangers, works of art, boxes; goods made of plastics, namely transport pallets, barrels, containers, chests, tanks, rivets, screws, pins, nameplates, furniture, window and door fittings, curtain rails and hooks, internal venetian blinds, garment covers, clothes hangers, bottle caps, letter boxes, not made of metal or masonry; goods made from cork, reed, rush, cane, horn, bone, ivory, whalebone, tortoiseshell, amber, mother-of-pearl and meerschaum; filing cabinets, letter racks.
- Class 21 Containers for home and kitchen (not made of precious metal or plated therewith); small hand-operated tools for home and kitchen, appliances for body beauty care, included in this class, electric combs and toothbrushes, water apparatus for cleaning teeth and gums; lawn sprinklers, combs and sponges; brushes (except paintbrushes); brush-making materials; cleaning materials; steelwool; raw or partly processed glass (except structural glass); goods made from glass, porcelain and crockery for home and

kitchen, works of art made from glass, porcelain and crockery; cooking pans and buckets made of sheet metal, aluminium, plastics or other materials; laundry pegs.

Class 24 Woven textiles and textile goods, namely textile goods, curtains, roller blinds, domestic linen, table linen and bed linen; bed covers and tablecloths; mosquito nets.

Class 28 Games, toys, including, electronic games, gym and sports apparatus; skis, ski bindings, ski sticks, ski edges, ski skins, skiing, tennis and angling gear; game balls; dumb-bells, punch balls, discuses, javelins; tennis racquets, cricket bats, golf and hockey sticks; roller and ice skates; table tennis tables; Christmas tree decorations; bags especially designed for sports equipment, included in this class; playing cards.

Class 34 Tobacco, smoking articles, namely tobacco pouches, cigar and cigarette holders, cigar and cigarette cases, ashtrays, all the above goods not made from precious metals, their alloys or being plated therewith, pipe stands, pipe cleaners, cigar trimmers, pipes, lighters, pocket devices for rolling cigarettes, cigarette papers, filters and sleeves, matches.

2. On 28 February 2005, Republic Technologies (NA) LLC, filed notice of opposition against Class 34 of this designation, the grounds being in summary:

1. Under Section 5(2)(b) because the mark applied for is similar to the opponents' earlier marks and in respect of Class 34 of the application, is sought to be registered in respect of goods that are either identical or similar to those for which the earlier mark is registered, such that there exists a likelihood of confusion.

2. Under Section 5(4)(a) by virtue of the law of passing off.

3. Details of the earlier Community Trade Mark, No. E2037000 relied upon by the opponents can be found as an annex to this decision.

4. The applicants filed a Counterstatement in which they assert that TOP is a laudatory term and that the subject trade marks are only registrable on the basis of their stylisation. They otherwise deny the grounds on which the opposition is based.

5. Both sides request that costs be awarded in their favour.

6. Only the opponents filed evidence in these proceedings which insofar as it is relevant I have summarised below. Neither side took up the offer of an oral hearing, the opponents' instead electing to file written submissions in lieu of a hearing. After a careful study of the evidence and submissions I now go on to give my decision.

Opponents' evidence

7. This consists of a Witness Statement dated 23 January 2006, from Wendy Waller, a Trade Mark Paralegal with D Young & Co, the opponents' representatives in these proceedings.

8. Ms Waller recounts her investigations into trade marks which consist of or contain the word TOP that are in use in the UK in relation to tobacco, smoking articles, cigars and related goods. Exhibit WW1 consists of a copy of an email exchange with Ian Howell of the Tobacco Manufacturing Association and current price lists from the Association's three principal member companies, namely, British American Tobacco, Gallaher Ltd, and Imperial Tobacco. Exhibit WW2 consists of the results of a search of the website www.tobaccoonline.co.uk, extracted on 18 January 2006. Ms Waller highlights that the UK site did not reveal any cigarettes for sale under brands consisting of, or containing TOP, but that the results obtained on the same date from the corresponding US site shown as Exhibit WW3 lists varieties of the opponents' "TOP TOCCO" cigarettes. Ms Waller also includes a print of the first page of results produced by the Google search engine, which shows several results for the website shown as "www.tobaccoonline.co.uk Top Sellers"

9. Ms Waller concludes by referring to a search of a website www.roll-ups.co.uk which sells hand rolling tobacco and "associated paraphernalia and accessories" in the UK. The results of the search, which are shown as Exhibit WW4, were printed on 18 January 2006, and detail "TOP King Size cigarette papers" and "TOP rolling paper". Ms Waller mentions that the only "hit" for the word TOP is a reference to the opponents' goods. There is no evidence that this site can or has received orders from the UK.

10. That concludes my review of the evidence insofar as it is relevant to these proceedings.

Decision

11. Turning first to the ground of opposition based on Section 5(2)(b). That section reads as follows:

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

(a)

(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.”

12. An earlier trade mark is defined in Section 6 of the Act as follows:

“6.- (1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

13. In my consideration of a likelihood of confusion or deception I take into account the guidance provided by the European Court of Justice (ECJ) in *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 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [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*,
- (b) the matter must be judged through the eyes of the average consumer of 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) 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*,
- (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*,
- (g) 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*,
- (h) 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*,
- (i) 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*,
- (j) 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*.

14. Accordingly, I must consider the matter through the eyes of the average consumer of the goods in question, assuming them to be reasonably well informed, circumspect and observant, and on the basis that they will make comparisons of marks based upon an imperfect recollection kept in their mind, not by an analysis of its component parts, but as whole against whole. This must be balanced against the fact that in a comparison of trade marks it is inevitable that reference will be made to the elements of which the marks are composed. Whilst this approach is consistent with the case law which requires that consideration be given to the distinctiveness and dominance of the component parts, it must be the marks as a whole that are compared.

15. The opponents rely on an earlier Community Trade Mark registration for the word TOP. The applicants' mark consists of the words TOP HOME. It is self-evident that these marks are not identical, but also that they have the word "TOP" in common, and if only to that extent there must be a degree of similarity in appearance and sound. The applicants' mark has the two words elided in the form of a cross. When viewing this mark the consumer's first point of reference

will be the word on the horizontal plane, and then the one running vertically, in other words, as TOP HOME, which means that the similarity between the marks exists in the first, and arguably by its positioning, the most dominant element of the applicants' mark. Apart from the word TOP the respective marks have no other features in common, and on a comparison absent of any other factors, the word elements TOP and TOP HOME are clearly not similar in look or sound.

16. As I have said, if only by virtue of the fact that TOP is likely to be taken as the first element seen and enunciated, it is the most prominent element of the applicants' mark. However, the applicants assert that the word TOP is a laudatory term for which no person should be granted a monopoly, and that both of the subject trade marks are only registrable because of their stylisation. In his submissions Mr Pennant quite correctly drew my attention to Section 72 of the Trade Marks Act stating that the opponents' earlier rights should be presumed, *prima facie*, to be evidence of its validity. In support of their contention that TOP is devoid of distinctive character, the applicants point to the disclaimer of the word TOP that has been entered on the earlier mark No.1290435 that is the subject of separate opposition proceedings. This consists of a composite mark of what appears to be a "spinning top" containing the word TOP stylized in a similar fashion to the CTM mark relied upon in these proceedings, also registered in respect of goods in Class 34. They also refer to paragraph 49.10 of the Registry Work Manual relating to Examination Practice which reads as follows:

"49.10 Disclaimers

Where the only component of the earlier trade mark which could be regarded as creating a similarity with a later trade mark is the subject of a disclaimer to any exclusive right, the examiner will not consider the marks to be similar enough to create a likelihood of confusion.

The Registrar will treat a disclaimer as an admission that the disclaimed component of the earlier mark is not, by itself, distinctive of the proprietor's goods and/or services. In that case, its presence in another party's trade mark cannot give rise to a likelihood of confusion. The disclaimed component(s) of the earlier trade mark may still contribute towards the grounds for refusal under Section 5(2) of the Act where there are other similarities between the respective trade marks. An applicant's offer to disclaim exclusive rights to a component of his (later) trade mark will not assist in overcoming a valid Section 5 objection because an admission made by the applicant cannot, of itself, be deemed to affect the scope of protection of the earlier trade mark. Of course, if the applicant can show that the feature shared by the marks is in fact non-distinctive, the citation will be reviewed."

17. This is, of course, an extract from a publication that acts as a "guide" rather than a statement of hard and fast legal principles. It is also possible that the relevant considerations may have changed in the period between 1989 when the earlier mark containing the disclaimer was accepted and the filing of the application that is the subject of these proceedings. But more importantly, there is no disclaimer entered in relation to the earlier mark that the opponents rely

upon in these proceedings. Accordingly, I must look at the issue without any regard to the fact that the opponents have previously agreed to enter a disclaimer of an element of the mark in suit.

18. TOP is an ordinary word with a meaning that in all probability will be known to any person with knowledge of the English language. Whilst it can denote the highest or uppermost part of something, or specific items such as a type of spinning toy or an article of clothing, it is also commonly used to describe, amongst other things, tangibles and intangibles that are the “best”, be it in terms of sales, quality of manufacture, performance, value or whatever. There may be goods or services where this reference will not be apt for such use but I struggle to come up with an instance.

19. In its guidance the Registry Work Manual cites the words TOP VALUE as an example of a mark that is excluded from registration by Section 3(1)(c) of the Act because it consists exclusively of a sign which may serve, in trade, to designate value for money –“This is a top value product.”. I accept that for the word TOP to be wholly meaningful it has to be used with another word that defines in what way the product or service excels, as in the example quoted, but as was stated in the appeal to the Appointed Person in the *Where all your favourites come together* case (BL 0/573/01), it is important to take account of distinctions between a trade mark and a description of the goods arising from the omission of words or components that would be necessary for the sign to work as a description. To me it is quite clear that the word TOP *solus* is capable of functioning as a stand-alone statement of pre-eminence and consists exclusively of a sign or an indication that may serve, in trade, to designate a characteristic of the goods for which registration is sought. It is capable of being used by other economic operators to describe a characteristic of their goods, and whilst it may have other meanings besides the laudatory, that one of the meanings of the mark designates a characteristic of the goods renders it devoid of distinctive character. (C-191/01 P *Doublemint*).

20. The word HOME in the applicants’ mark is also capable of being an indication of a characteristic of goods such as furniture and curtains that are often referred to as “home furnishings”. In respect of such goods the words TOP and HOME will have little or no distinctive character, be it individually or in combination, and it is the “surplus” created by the stylization that carries the mark to distinctiveness. However, in respect of the goods covered by Class 34 of the application which are the focus of the opponents’ objection, the word HOME has no relevance that I am aware of, and as a whole the mark TOP HOME is meaningless.

21. Turning now to the matter of the stylization referred to by the applicants as being the basis on which the respective marks acquire their distinctive character. The respective marks do not just consist of words in a plain font; they have both been subjected to varying degrees of stylization, but not to the extent that they would no longer be recognized as the words. Whilst I accept that the consumer may well never encounter marks side by side, for the purposes of this comparison I consider it useful to look at the respective marks in this way:



22. The stylization of the lettering in the opponents' mark has some impact on its appearance, but this is minimal and to my mind adds nothing of significance; it is a TOP mark. As I have said, when viewing the applicants' mark the natural inclination of the eye is to go to the word placed in the horizontal, for this is the usual way in which words are written. That TOP is represented in a slightly larger font than HOME adds to its visual significance, but the unusual manner in which the two words converge on the letter "O" has a significant impact on the eye. As I have already said, when considered in relation to the goods in Class 34, and absent any other factors such as stylization, the words TOP and TOP HOME are visually, aurally and conceptually dissimilar; the stylization only serves to add to the visual, and to a lesser extent, conceptual differences.

23. Taking all of these factors into account and comparing the marks as a whole, it is clear to me that the respective marks are not similar in appearance, sound or in the idea or message that they convey.

24. The word TOP is an ordinary English word that I have already said is capable of serving as a laudatory statement that describes some aspect of the goods at issue. This is how I believe the public would perceive a trade mark consisting of this word, be it on its own or in conjunction with some other descriptive term. Consequently it must be regarded as having a low level of distinctiveness. Where a trade mark is comprised of ordinary words that have a descriptive relevance for the goods for which it is used, another mark can have a higher degree of convergence (visual, aural, conceptual) before there will be a finding that they are similar; the more direct the description, the closer the marks can be. As Millet L.J. stated in *The European Limited v The Economist Newspaper Limited* [1998] ETMR 307 at page 314:

"Where descriptive words are included in a registered trade mark, the courts have always (and rightly) been exceedingly wary of granting a monopoly in their use."

25. The opponents have not provided any evidence that they have used their earlier mark, let alone that they have used it to an extent that it has gained any enhancement to its distinctive character by virtue of its exposure in trade. For the same reason I cannot take them to have built any reputation in the mark.

26. Both the opponents' and the applicants' specification mention "tobacco" so there is clear identity in respect of this item. The opponents' specification goes on to list the general description "smokers articles" followed by examples of, but not limited to the type of goods covered by this term. To my mind these are clearly identical to the "pocket devices for rolling cigarettes, cigarette papers, filters and sleeves" contained within the applicants' specification. The remaining goods of the application, namely "smoking articles" which have been further defined as being "tobacco pouches, cigar and cigarette holders, cigar and cigarette cases, ashtrays, pipe stands, pipe cleaners, cigar trimmers, pipes, lighters and matches" are all for or used by "smokers" and come within the general description of "smokers' articles" in the opponents' specification. Accordingly all of the goods of Class 34 of the application are identical to those covered by the opponents' earlier mark.

27. Neither the opponents' nor the applicants' specifications contain any qualification or restriction that would serve to move them into separate markets. Both notionally contain goods from the simple to the sophisticated, cheap to the expensive, and go into the same area of trade. I must therefore proceed on the basis that the respective goods are capable of ranging from the type purchased by the public at large with minimal care and attention, to those used by the discerning and knowledgeable who will make a deliberate and informed purchase.

28. The circumstances in which the relevant goods and trade marks are encountered by the consumer, particularly at the point at which the purchase is made is an important consideration, but the matter must be assessed by applying all relevant factors. I have no evidence as to how the trade classifies tobacco products and other articles used by smokers, or whether it would be usual for a manufacturer of tobacco products to also be involved in a trade in smokers' articles. It is clear that some articles used by smokers, such as cigarette holders, cigarette rolling machines and cigar cutters are items which complement the use of tobacco and tobacco products. Notionally, the channels of trade, the means by which they reach the point of sale, retail circumstances and the "relevant" consumers of the respective goods are also the same.

29. Because of age restrictions on the purchase of tobacco products such goods are, in most retail circumstances, displayed side by side behind a counter, and obtained on request from a sales assistant. Whilst this gives the aural similarity of marks a greater significance, the visual appearance is also relevant when it comes to selecting the item from the display. It is of course possible to obtain cigarettes by self-selection, in particular from vending machines where the visual similarity of marks will be of sole importance. I do not discount the fact that where imperfect recollection comes into play, the conceptual similarity of marks will be an influence regardless of how or where they are purchased.

30. The remaining non-tobacco goods covered by the opponents' specification, and some products such as tobacco pouches, pipe-stands, holders, pipes and cigar trimmers contained within the application are closely related to tobacco. I have no personal knowledge of the trade in cigarette papers, filters and cigarette rolling machines other than to say that I have never encountered them on the shelves of general retailers and can only assume that if such goods are available for sale they are with the tobacco products. They may be on display for self-selection

in specialist retailers such as tobacconists; I do not know and there is no evidence to assist me. This being the case I must assume that they are capable of being obtained by self-selection and also on request, and that all factors that contribute in the assessment of the similarity of marks carry equal weight. Where stocked, the remaining non-tobacco goods contained within the applicants' specification, namely "ashtrays, cigar and cigarette cases, pipe-cleaners, lighters and matches" may be displayed by product type on shelves for self-selection, or behind a counter for purchase by enquiry.

31. In his submissions Mr Pennant referred me to *Medion AG v Thomson* case C-120/04. Whilst I acknowledge the guidance provided, I do not consider that the facts of this case to be the same. The applicants' mark is not a juxtaposition of a company name, it is a combination of two ordinary English descriptive words, one of which happens to be the same word that forms part of the opponents' mark. The applicants' mark does not incorporate the opponents' mark in its entirety; the stylized form in which the opponents' word stands has not been adopted, far from it. As I have already said, the word element of the opponents' mark is laudatory, and whilst I do not dispute that it is a valid earlier mark, there is some question as to whether its distinctiveness resides in the stylized combination; I do not consider that it can reside in the word alone. The element from the opponents' mark that has been incorporated into the applicants' mark does not retain an independent distinctive role; it is part of a composite whole. I accept that a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods (*Canon*), but this does not extend to mean that marks that are dissimilar can become similar by there being a complete identity in the goods; the starting point is that the marks must be similar. In this case they are not so.

32. Taking all of the factors into account and adopting the "global" approach required by *Sabel*, I have no doubt in my mind that even allowing for the identity/similarity in the respective goods and corresponding trade circumstances, the differences in the marks are such that the public familiar with the opponents' mark, on seeing the applicants' mark being used in relation to the same or similar goods, will not be led into believing that they come from the undertaking that they already know, or one that is in some way linked. **There is no likelihood of confusion and the ground under Section 5(2)(b) fails.**

33. This leaves the ground under Section 5(4)(a). That section reads as follows:

"5(4).- A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) ...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the

proprietor of an “earlier right” in relation to the trade mark.”

34. Mr Geoffrey Hobbs QC sitting as the Appointed Person in the *Wild Child* case [1998] RPC 455 set out a summary of the elements of an action for passing off as follows:

“(1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.”

35. Section 5(4)(a) of the Act offers protection to the goodwill and reputation built up by a trader through the use of a sign. I have already highlighted that the opponents have not provided any evidence that the mark has been used, or that they have established a reputation within the United Kingdom. Consequently, I do not see how they can expect to succeed in an action reliant on them proving the existence of goodwill. The objection under Section 5(4)(a) must fail.

36. The opposition having failed, the applicants are entitled to an award of costs. I order the opponents to pay the applicants the sum of £850 as a contribution towards their costs. This 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 2nd day of February 2007

**Mike Foley
for the Registrar
the Comptroller General**