

O-010-16

In the Matter of THE UK TRADE MARKS ACT 1994

- and -

**In the Matter of UK Trade Mark Registration No. 3003096 in the name of
THE ROYAL ACADEMY OF ARTS**

- and -

In the Matter of Opposition No. 401111 by ERREA SPORT S.P.A.

**Appeal to the Appointed Person from the decision of Ms. Beverley Hedley acting on
behalf of the Registrar, the Comptroller-General, dated 23rd January 2015.**

DECISION of the Appointed Person

MR. IAIN PURVIS QC:

1. This is an Appeal from a decision of the Hearing Officer, Ms Beverley Hedley, in Opposition proceedings. The trade mark is applied for by the Royal Academy of Arts, the well-known institution based in Burlington House, Piccadilly. It comprises the letters RA written in capitals as follows:

RA

2. The Application is made for a wide variety of goods and services in classes 3, 9, 14, 16, 18, 20, 21, 24, 25, 27, 28, 30, 34, 35, 36, 39, 40, 41 and 43. There is no point in setting these out in this decision since nothing turns on the details of the goods and services in question.
3. The Opponent, Errea Sport S.p.A, opposes the mark under s5(2)(b) of the Trade Marks Act 1994, though only in relation to the goods and services in classes 9, 14, 16, 18, 24, 25, 28 and 41. Before the Hearing Officer the Opponent relied on three of its earlier marks, but only one is still pursued in this appeal, namely CTM 007076862 ('the earlier mark'). This is for the following device:



4. The earlier mark is also registered for a wide range of goods and services, in this case in classes 3, 9, 14, 16, 18, 25, 28, 35 and 41. There is no dispute between the parties that the Hearing Officer was right to proceed on the basis that all the contested goods and services of the mark applied for are either identical or at least highly similar to equivalent goods and services for which the earlier mark is registered.
5. The Hearing Officer rejected the Opposition in its entirety.

6. In the course of a detailed and careful Decision, the Hearing Officer:
- (a) Set out the basic principles to be applied when determining whether there was a likelihood of confusion between two marks, by reference to the familiar list of points approved by the Court of Appeal in Specsavers v Asda Stores Limited [2012] EWCA Civ 24 (paragraphs 6-7 of the Decision);
 - (b) Compared the goods and services in question, concluding, as I have noted, that they could all be regarded as identical or at least highly similar (paragraph 8);
 - (c) Analysed the average consumer as being the general public, whose presumed level of attention would vary depending on the nature of the goods and services. For some of the goods, for example pens and pencils, the level of attention would be likely to be quite low (paragraphs 9-10);
 - (d) Identified the purchasing act as being primarily visual in relation to all the goods and services, but noted that aural considerations could not be disregarded as they played a part in the selection process (for example where goods such as jewellery were requested over the counter, or where oral recommendations were made) (paragraph 11);
 - (e) Compared the marks, concluding that they were aurally identical (the applicant having conceded that the opponent's mark would be vocalised as 'RA'), but not visually similar (the one mark being simply the letters RA presented in a bold and standard font, and the other being those letters highly stylised and surrounded by a stylised border). Conceptually she

concluded that the position was neutral since neither mark had any particular meaning (as the Opponent had accepted), and the mere presence of two letters did not evoke any immediately graspable concept (paragraph 18);

(f) Identified the distinctive character of the earlier mark. She considered that it was reasonably high in distinctiveness, but that this was attributable to the particular graphic presentation of the letters, not the letters themselves. The distinctive character did not therefore serve to increase the likelihood of confusion, since it was not attributable to an aspect of the earlier mark which was present in the mark applied for. In this respect she cited and applied some dicta from a decision of mine, Kurt Geiger v A-List Corporate Limited BL O-075-13 at 38-39. Those dicta were not challenged in this appeal. (paragraphs 19-21);

7. In paragraph 23 of the Decision, the Hearing Officer turned to the question of likelihood of confusion, bearing all these findings and considerations in mind and reminding herself of (i) the interdependency principle, whereby a lesser degree of similarity between the goods or services may be offset by a greater similarity between the marks, and vice versa; (ii) the factor of imperfect recollection, whereby consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture they have kept in their minds; (iii) the principle that the more distinctive the earlier mark the greater the likelihood of confusion.
8. In paragraph 25 she concluded as follows:

'Although the marks are aurally identical, and the goods and services are either identical or highly similar, both of which are factors weighing in the opponent's favour, there is one factor in particular which weighs strongly against the opponent, namely, my finding that the marks are not visually similar. This is of particular importance in the global assessment of the likelihood of confusion given that the purchasing act is likely to be primarily visual for all of the goods or services in issue. [here she interposed a footnote to the decision of the General Court in New Look v OHIM T-117/03 in which they noted that the visual, oral and conceptual similarities did not always carry the same weight: for example where goods were sold primarily visually, then visual similarity would be more important]. Furthermore, although I have found that the earlier mark is possessed of a reasonably high degree of distinctive character, this is attributable to the heavy stylisation of the mark, rather than to the letters within the mark per se; there is no such stylisation or similar stylisation in the contested mark. Bearing all this in mind, I come to the conclusion that, notwithstanding that for certain of the goods at issue the level of attention is likely to be low there is no likelihood of confusion, either directly or indirectly, in respect of any of the goods or services at issue.'

9. The Grounds of Appeal raise essentially a single point on which the Hearing Officer is said to have erred. The Appellant notes that at the start of paragraph 18 of her Decision, the Hearing Officer noted the admission by the Applicant that the earlier mark would be understood as consisting of the letters RA. It then says as follows (paragraph 8 of the Grounds of Appeal):

‘However, despite this assessment as to an acknowledgement that both marks are for the letters ‘RA’, the Hearing Officer concludes that the marks are ‘not visually similar’ because of the stylisation of the Opponent’s RA mark. We say that the marks must be considered, on an overall visual comparison, at least visually similar to a low degree, but not that there is no similarity at all. We say that the Hearing Officer has come to the wrong conclusion on this point.’

In paragraph 12 of the Grounds, having noted that the Hearing Officer (in paragraph 25 of the Decision) characterised her finding that the marks were ‘not visually similar’ as a factor ‘which weighs strongly against the opponent’, the Appellant says as follows:

‘Because the Hearing Officer has found no visual similarities between the respective ‘RA’ marks, we say that the Hearing Officer has come to the wrong conclusion on the point relating to an assessment as to the likelihood of confusion...If the Hearing Officer had also found visual similarities between the respective ‘RA’ marks, even if of a low degree, then the likelihood of confusion assessment would have been easier to determine, in the Opponent’s favour, in our view.’

10. Mr Stobbs, who appeared for the Appellant at the hearing, contended that it was irrational for the Hearing Officer to hold that there was no visual similarity between the two marks when one comprised the letters RA and the other would be understood as conveying the idea of the letters RA, albeit in a highly stylised way. She was obliged, in his submission, to find at least a ‘low degree’ of similarity. This, he contended, was a sufficient error of principle to undermine the Decision.

11. I do not accept this. First of all, it seems to me to be a matter of semantics rather than substance. There is no doubt that the Hearing Officer was proceeding on the basis that the average consumer would understand the letters RA to be conveyed by the earlier mark. Indeed she makes the point herself on more than one occasion. When she states that there is no visual similarity between the marks, she cannot therefore be taken to have forgotten this point. Similarly, she cannot be taken to have forgotten it when considering the overall ‘global’ question of whether the average consumer is likely to be confused.
12. Secondly, the difference between ‘no visual similarity’ and ‘a low degree of visual similarity’ is not only impossible to define but quite subjective. It is hard to imagine a case in which the spread of reasonable opinions about visual similarity could not cover both of these characterisations. This is not, therefore, fertile ground upon which to base an alleged error of principle.
13. Thirdly, I do not have any difficulty with the notion (which Mr Stobbs appeared to be contending was illogical) that two representations of the same thing may have no visual similarity. In the world of art, the visual representation of a horse in Picasso’s Guernica has little or nothing in common with the visual representation of a horse in one of George Stubbs’ portraits. I do not think it unreasonable to say that they have no visual similarity, whilst having some limited conceptual similarity (they are both paintings of horses).
14. I therefore do not consider that the Hearing Officer’s Decision is undermined by the alleged error of principle identified in the Grounds of Appeal.

15. I should add that Mr Stobbs argued a different point at the hearing, namely that even if there was no error of principle, the Hearing Officer was still ‘plainly wrong’ (using the Reef test for an arguable basis of appeal from a multi-factorial decision of this kind) because she had reached a conclusion which no reasonable tribunal could have reached on the facts. So far as this is concerned, it seems to me that it is not in principle open to an Appellant to run such an argument on appeal when it has not been foreshadowed in the Grounds of Appeal. It involves a wholesale re-arguing of the case, rather than simply the analysis of a single alleged error of law, and it would be unfair to the Respondent to permit it to be run without notice. I should also say that Mr Stobbs did not make an application to amend his Grounds of Appeal, so I do not have to consider whether to allow the point to be argued. However, having heard Mr Stobbs’ arguments on the point, I am not satisfied that they have any merit in any event. In essence his argument was that there was bound to be a likelihood of confusion in this case because of the aural ‘identity’ between the marks (if one tried to ask for goods using an aural version of the earlier mark, one would ask for ‘RA’ goods, just as one would ask for the applicant’s goods). This argument seems to me to fly in the face of the necessary ‘global’ assessment, bearing in mind the visual, conceptual and aural similarities, which the tribunal must carry out. Particularly in the case of an earlier mark which is a heavily stylised device mark, taking the aural similarities alone tends to ignore the real substance and distinctive character of the mark and is likely to lead to an erroneous result.

16. I therefore reject the Appeal and uphold the Decision of the Hearing Officer permitting the mark to proceed to grant. I will award the Applicant £1000 towards its costs of this Appeal.

IAIN PURVIS QC

THE APPOINTED PERSON

4 JANUARY 2016.