

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK Application

Nº: 2100208 to register trade marks in the name of EMA Srl

AND IN THE MATTER OF Opposition

Nº: 46215 by the Pod Trademarks Partnership.

Decision

The applicants, EMA Srl (2 Via S Maria, 63044 Comunanza (AP), Italy), applied on 15th May 1996 to register a series of three marks:



(The first mark is limited to the colours blue and orange - TOD'S and COMPETITION are in blue, with the latter against an orange background; the second two marks are in black and white. Nothing turns on this). The marks are registered for: 'Articles of clothing; footwear; headgear; parts and fittings, all included in Class 25, for any of the aforesaid goods.'

The application is opposed by William John Dickinson, Anthony Frederick Richardson, Simon Dickie and Gary Thorneycroft, known collectively as the Pod Trademarks Partnership. They cite a number a registrations incorporating the name POD, alone, and with various devices (see ANNEX). The grounds, under the 1994 Act, are based on ss 5(2), 5(4)(a) and 3(6).

The applicants deny the grounds and both parties ask for their costs. A Hearing took place on 11 September 2000, with Ms Wallace of Lloyd Wise Tregear appearing for the applicants, and Ms Leno of Messrs. Forrester Ketley & Co. appearing or the opponents.

The Evidence

In their Counterstatement, the applicants question the ownership of the marks cited by the opponents. In their evidence - which amounts to the Declaration of Mr William John Richardson (a Partner in the Pods Trademarks Partnership) - the opponents provide evidence of assignment of the all the marks shown in the ANNEX except for N^{os} 2019052 and 2021290. However, these are recorded as being in the ownership of the Pod Trademarks Partnership, i.e., the opponents. I do not believe there is any significant issues here. I also note that mark N^{os} 1110282, 1113187 and 1114467 have expired, though this does not affect my decision one way or another.

On trade of products under the opponents' mark Mr Dickinson refers to sales from 1977 onwards (through licensees). The following facts emerge from the evidence:

- ! revenue figures are given from 1994 up to and including 1996.
- ! Exhibits WJD5 and WJD6 contains copies of labelling material; other promotional material is mostly undated; I note that one document has the date March 1995; another January 1995.
- ! There are references to use of the mark in the 1970s. However, there is nothing substantive on the nature and extent of this use and I can give it little weight.
- ! the material shown in the Exhibits concerns shoes only.

The applicants' evidence contains a number of Declarations by Dr Stefano Sincini, the applicants' General Manager. The key points, in my view, are as follows.

- ! The applicants are also the proprietors of two other registrations. These are of a device mark incorporating the words J P TODS, a crest (apparently a 'lions heads' device) and embossed by the words HAND MADE ENTIRELY BY EXPERT SHOEMAKERS and carry registration N^{os}. 1421038 and 1421039 for the goods 'Perfumes included in Class 3' and 'Shirts, sweaters, jackets, trousers, shoes; all included in Class 25', respectively.
- ! This mark is shown, and a mark that is identical, but contains the words TODS, as used on clothing, footwear and other items. Much of this material is undated. That that is, is after the relevant date.
- ! Trade in the UK - in what the applicants call a 'high quality product' - is claimed since 1985, while turnover figures are provided from that date until 1992. In 1985 it was £25,522, rising to approximately £116,000 by 1992. As these are 'whole-sale' prices; a mark up of 100% is suggested. Data thereafter is in Italian Lira. In 1995 and 1996 it was approximately £65K and £200K (assuming 3000 Lira = £).
- ! Most of the applicants' material is undated. However, there is an article from VOGUE magazine, dated August 1995, which refers to 'Tods'.

The Decision

At the beginning of the Hearing, Ms Leno stated that the opponents would not be arguing the bad faith point. The first of the opponents' remaining grounds is under s 5(2)(b). This states:

'(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.'

The opponents are the owners of earlier marks under the Act, by virtue of their earlier registrations, and s 6(1)(a).

In approaching this matter, I have taken into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199 at 224, *Canon v MGM* [1999] ETMR 1 and *Lloyd Schufabrik Meyer & Co GmbH v Klijsen Handel BV* [1999] ETMR 690 at 698. It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer, of the goods/services in question, 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;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(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;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

(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.

The opponents' best case is, I believe on mark N^o 1157848, i.e. the word mark POD. The other marks contain excess matter, and if the opponents can't succeed on the word mark, I do not believe they will succeed with the others. Also, the goods at issue are identical, since the applicants' specification under their mark includes footwear and thus subsumes the opponents' goods. This I compare with the applicants' word mark, TOD'S COMPETITION.

The applicants sought to convince me of the importance of the second word in their mark, while the opponents sought to emphasise the importance of the first. They were of the view that COMPETITION would be seen as a descriptive word for clothing (for example, for clothing used in sporting activities), thus emphasising the relative importance of TOD'S.

It does seem clear that to succeed on this ground, the opponents must subjugate the importance of the descriptive word COMPETITION and concentrate on the word TOD'S. But even if I do this, I must come to the conclusion that the required confusion is unlikely.

Comparing this with the opponents' mark, these words differ only by the initial letters and by the final apostrophe S. These may seem like small differences, but I must judge the marks by sight and sound. The presence of the 'S' is both a visual and aural difference. But as it the possessive it is a less significant difference than the 'T' and the 'P'.

It is generally accepted that first syllable is important in pronunciation. In *LONDON LUBRICANTS (1920) LIMITED'S APPLICATION (1925)* 42 RPC 264 at page 279 it was stated:

'But the tendency of persons using the English language to slur the termination of words also has the effect necessarily that the beginning of words is accentuated in comparison, and, in my judgment, the first syllable of a word is, as a rule, far the most important for the purpose of distinction.'

This word consists of one syllable only, and I think it unlikely that the it would be mispronounced for this reason. The difference of the first letter - coupled with the fact that the sounds of 'T' and 'P' are clearly distinguishable - is an enormous difference in a small word.

I also note that the word POD has a well known dictionary meaning - generally referring to something that encloses something. (It could be some vague allusion to shoes, but this is not relevant here). TOD'S does not, in my view, have any such common meaning. It may be taken as a name, that is all.

In the light of these considerations - even taking account of the imperfect picture the average consumer possesses - I do not believe that confusion is possible.

In coming to this view, I have not lost sight of the fact that there is use of the word COMPETITION in the applicants' mark - which will reduce further the likelihood of confusion. The ground under s 5(2)(b) fails.

This, in my view, rather decides the matter for s 5(4) as well. This states:

'(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 a unregistered trade mark or other sign used in the course of trade..'

Following the principals established in *Wild Child Trade Mark* [1998] 14 RPC 455, to achieve their objective, the opponents need to show that at the relevant date (15th May 1996): (i) they had acquired goodwill under their mark, (ii) that use of the mark would amount to a misrepresentation likely to lead to confusion as to the origin of their goods; and (iii) that such confusion is likely to cause real damage to their goodwill.





On the evidence I have seen, I would struggle to conclude that the opponents had any protectable goodwill in their mark for clothing in general and even for footwear in particular. But were I to conclude that they did, I do not believe, following my finding above, that the necessary misrepresentation would occur. On top of this, from the evidence, both parties rely on their name to sell their products and, as shoes are not cheap items, and for the most part are fashion driven, I cannot believe that most consumers would not consider them carefully before purchase, making misrepresentation very unlikely. This ground also fails and the opposition fails as well.



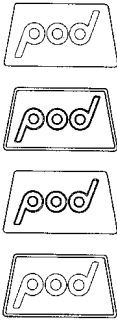

The applicants are entitled to an award of costs. I order the opponents to pay them £635. This sum is to be paid within seven days the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 21st Day of September 2000.

**Dr W J Trott
Principal Hearing Officer
For the Registrar, the Comptroller General**

ANNEX

Mark	Number	Date	Goods
MR. POD	1082075	08.08.1977	
 POD	1084790	07.10.1977	Class 25: 'Footwear being articles of clothing.'
MR POD	1110282	28.02.1979 (Expired 29.02.2000)	Class 25: 'Articles of clothing for children; articles of outer clothing for men and women.'
 POD	1110283	28.02.1979	Class 25: 'Articles of clothing for children, articles of outer clothing for men and women.'
	1113187	24.04.1979 (Expired 25.04.2000)	Class 25: 'Articles of clothing for children; articles of outer-clothing for men and women.'
	1114467	17.05.1979 (Expired 18.05.2000)	Class 25: 'Footwear being articles of clothing.'
POD	1157848	16.07.1981	Class 25: 'Footwear being articles of clothing; articles of outer clothing for men and women; articles of clothing for children.'

	1157849	16.07.1981	Class 25: 'Footwear being articles of clothing; articles of outer clothing for men and women; articles of clothing for children.'
	1408617	19.12.1989	Class 25: 'Footwear being articles of clothing; articles of outer clothing for men and women; articles of clothing for children.'
	2019052	27.04.1995	Class 25: 'Boots, shoes and articles of footwear and components thereof; articles of outer clothing for men and women; articles of clothing for children.'
	2021290	23.05.1995	Class 18: 'Rucksacks; haversacks; travelling bags; leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks; umbrellas; parasols and walking sticks.'