

BEFORE:

**MR SIMON THORLEY QC
IN THE MATTER OF THE TRADE MARKS ACT 1994**

AND

**IN THE MATTER OF APPLICATION NO 2205533
BY FREEMANS PLC TO REGISTER A TRADE MARK IN CLASS 25**

AND

**IN THE MATTER OF AN APPEAL FROM THE
DECISION OF MR A J PIKE DATED 25 JULY 2000**

**MR J GROOM (of Trade Mark Owners Association Ltd)
appeared on behalf of the Applicant**

**MR D MORGAN (Principal Hearing Officer)
appeared as the Registrar's Representative**

D E C I S I O N

MR THORLEY: This is an appeal to the appointed person from a decision of Mr Pike, acting for the Registrar, dated 25th July 2000. It arises in the course of an application by Freemans Plc for registration of the mark BLUE LEAF in respect of clothing and footwear in Class 25. Objection was taken to the mark under Section 5(2) of the Act by reason of the prior registration of trade mark No 2049467 in Class 25 in respect of articles of outer clothing of a mark consisting of BROWNLEAF, underlined and contained in a rectangular outline. There was no dispute before me, or indeed I believe before Mr Pike, that the proper comparison was between the words BLUE LEAF and BROWNLEAF, with no particular emphasis being placed upon the stylisation attached to the BROWNLEAF mark.

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The Hearing Officer, in my opinion, correctly directed himself as to the law. He recited the **Sabel v Puma** case. In particular, he reminded himself “that global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components”.

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He went on as follows: “The mark applied for is in plain upper-case letters with no stylisation. Registration 2049467 is for the words BROWNLEAF but this mark contains additional features. Although all letters are presented in plain upper-case letters the initial and final letters are approximately twice the size of the other letters. The smaller central letters are underlined and the whole mark is enclosed in a doubled lined rectangular border.

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“In my view the earlier registration is a distinctive mark for the goods for which it is registered. However, I take the view that this stylisation is no more than embellishment and the mark would be viewed as and referred to as a ‘BROWN LEAF’ mark.”

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As I have indicated, there was no dispute as to this. He went on: “It is my view that one mark is similar to another if an element (or something very similar to that element) of the earlier marks is included in the later mark with the result that the relevant public are likely to assume that the marks are associated and that the respective goods originate from the same source.”

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That is accepted to be the correct test. He then reminded himself of the views expressed by Sir Wilfred Greene MR. In **Saville Perfumery Limited v June Perfect Limited** [1941] RPC 162, and also bore in mind the remarks in the **AQUAMATIC/WATERMATIC** case [1958] RPC 387 at 390 about the idea of the mark bringing the same idea to mind.

5 He then concluded as follows: “The essential message from both of these marks is that they tell you the colour of a leaf. At the hearing, Mr Groom argued that because members of the public regularly see or come into contact with leaves coloured brown, but they do not do so with leaves coloured blue, they would immediately be able to distinguish the two marks and that no confusion would arise. Whilst plants with blue leaves exist and others have leaves
10 which, although not actually blue in colour are referred to as blue leaves, I accept that such plants are relatively rare in the United Kingdom. However, I do not accept that Mr Groom’s argument is particularly relevant. Both marks bring to mind the idea of a coloured leaf. Prospective purchasers of these goods may not have the opportunity to purchase at leisure and will not necessarily study the marks in any details. With imperfect recollection I am of the
15 view that such purchasers might easily be confused as to the origin of the respective goods.”

Mr Groom challenged that conclusion, primarily as regards the imperfect recollection that the Hearing Officer attributed to the notional average purchaser. The nub of Mr Groom’s
20 argument was that although he accepted that the marks bring to mind the idea of a coloured leaf, he contended that they brought to mind the idea of different coloured leaves.

The public are conditioned to identify differences between colours in all walks of life. Historically the Red Rose and the White Rose have been clearly distinctive of different allegiances. We have surnominal use of colours; Green, Black, Brown and White; Mr
25 Greenless and Mr Brownless.

I believe there is great substance in Mr Groom’s contention that the two marks, taken side by side, do not merely bring to mind the idea of a coloured leaf but of a coloured leaf of a particular colour. This is particularly so when a brown leaf does occur frequently in nature -
30 during the whole year in the case of trees such as copper beeches, and certainly in the autumn

in the case of all deciduous trees.

The Hearing Officer, however, took into account (quite correctly) imperfect recollection. As was pointed out in the **Lloyd Schuhfabrik** case in the European Court of Justice, a consumer rarely has the opportunity to make direct comparison. Mr Morgan, before me, reinforced that
5 and drew attention to the fact that not only were the marks both referring to leaves, but that the initial letter 'B' occurred in both. I accept that there are cases where the initial letter may be of great importance, but where the initial letter is one relating to two very familiar and distinct words - brown and blue - I do not see that any great weight can be attached to the initial letter.

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The question is whether I am satisfied that the public, on seeing BLUE LEAF, would be confused into considering that such goods were from the same origin as those marks BROWNLEAF, which hypothetically they will have seen before. I am unable to accept that the average consumer, to whom reference must be made, would make such an association.

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Anybody calling to mind a brown leaf would, I think, focus upon the colour, recall the colour and would see a distinction between that colour and the BLUE LEAF marked on the product in front of him.

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I have therefore come to the conclusion that the decision of the Hearing Officer was in error and that this appeal should be allowed. The normal rule is no order as to costs.

MR GROOM: I agree.

MR MORGAN: Fine.

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MR THORLEY: Thank you.