

O/154/03

TRADE MARKS ACT 1994

IN THE MATTER of Application No. 2214352
by Michael Evangelus Clarke
(trading as Michael Van Clarke)
to Register a Trade Mark
in Classes 3 and 42

AND

IN THE MATTER of Opposition thereto under No. 50917
by Nicholas Andrew Clarke, Lesley Anne Gale Clarke
& Kasmare Limited

DECISION

Introduction

1. On the 15th of November 1999 Michael Evangelus Clarke (“the Applicant”) applied to register the mark MICHAEL VAN CLARKE GREAT HAIR DAYS for the following specification of goods and services:

Class 3 – hair and hair treatment products.

Class 42 – hairdressing and hair care services.
2. On the 17th of April 2000 opposition to the application was filed by Nicholas Andrew Clarke, Lesley Anne Gale Clarke and Kasmare Limited (“the Opponents”).
3. The Opponents raised three grounds of opposition. First, they contended the application was made contrary to section 3(6) of the Trade Marks Act 1994

("the Act"). The application in the present case was made in the name of Michael Van Clarke rather than the full name of the Applicant, Michael Evangelus Clarke. It followed, the Opponents contended, that there was no such person as Michael Van Clarke, that there had been no valid statement under section 32(2) that the Applicant had used the mark or had a bona fide intention of so doing, and accordingly the application must be considered to have been made in bad faith under section 3(6).

4. Secondly, it was contended that registration of the mark applied for would be contrary to section 5(2)(b) of the Act in the light of the earlier registration by the Opponents of a number of trade marks, including registration No. 2120261 for the words NICKY CLARKE.
5. Thirdly, it was contended that registration would be contrary to section 5(4)(a) of the Act in the light of the use by the Opponents of the marks CLARKE and NICKY CLARKE.
6. In a written decision dated the 12th of November 2002, Mr M. Reynolds, the Hearing Officer acting for the Registrar, dismissed the opposition. On the 5th of December 2002 the Opponents gave Notice of Appeal to an Appointed Person under section 76(2) of the Act. On the appeal the Opponents were represented by Mr Matthews of Prentice & Matthews. The Applicant did not appear and indicated by letter from his agents, Wildbore & Gibbons, that he supported the decision of the Hearing Officer in full.

The Appeal

7. The Opponents did not dispute that I should adopt the approach explained by the Court of Appeal in *Reef Trade Mark* [2003] RPC5. The appeal is by way of review of the decision of the Hearing Officer. I should show a real reluctance, but not the very highest degree of reluctance, to interfere with the decision of the Hearing Officer in the absence of a distinct and material error of principle.

Bad Faith

8. The essential facts relating to this ground of opposition may be summarised as follows. The application was originally filed in the name of Michael Van Clarke, the name under which the Applicant has traded for a number of years. The Applicant's full name is, however, Michael Evangelus Clarke. Since the filing of the opposition, steps have been taken to change the name of the Applicant to reflect his full name by filing a Form TM21. As a result, the name of the Applicant has now been amended.
9. The Opponents contended that there was no such person as Michael Van Clarke and that there is no provision in the Act permitting the substitution of one applicant for another. Accordingly, it was submitted, the original applicant had not used and had no bona fide intention of using the mark and the application must have been made in bad faith.
10. The Hearing Officer rejected this submission. I believe he was right to do so. Section 32 of the Act provides:

- “(2) *The application shall contain:-*
- (a) *the request for registration of a trade mark,*
 - (b) *the name and address of the applicant,*
 - (c) *a statement of the goods or services in relation to which it is sought to register the trade mark, and*
 - (d) *a representation of the trade mark.”*

11. A name is a word or set of words by which someone is known. The purpose of section 32(2)(b) is to provide sufficient information to identify the applicant and his address. As noted by the Hearing Officer, a similar provision is contained in Article 26 of the Community Trade Mark Regulation which provides that an application for a Community Trade Mark must contain “*information identifying the applicant*”.

12. In the present case I believe it is wrong to suggest that the original named applicant “Michael Van Clarke” did not exist. On the contrary, the person identified by that name plainly did exist and had traded under that name for some time. It is the name by which the Applicant was and remains generally known. There can be no doubt that the name and address information supplied on the original application identified the Applicant and him alone.

13. I was referred by the Opponents to two authorities. First, I was taken to *Aurora Trade Mark*, a decision of the Registrar dated the 19th of March 1999. In that case an opposition failed on the basis that the named opponent, Aura Light AB, did not exist at the time of filing of the opposition or at any time thereafter. The Registrar declined to allow the substitution of one opponent for another and dismissed the opposition. In the second case, *Clintec Benelux SA v Cernitin SA*, a decision of Mr G. Hobbs Q.C. sitting as the Appointed

Person, dated the 29th of October 2001, Mr Hobbs noted that the counter-statement in an application to revoke a trade mark for non use had not been filed by the proprietor because the proprietor, a company, had ceased to exist and the company filing the counter-statement had taken no steps to register itself as the proprietor. These authorities do not assist the Opponents because in each case it was clear the relevant party did not exist at the appropriate time. In the present case, however, Michael Evangelus Clarke did indeed exist and the name filed on the original application form properly identified him.

Section 5(2)

14. In addressing the objection under section 5(2) of the Act the Hearing Officer concluded that the goods and services of the application were either identical to or very closely similar to the goods and services of the Opponents' earlier trade mark. After reviewing the evidence he also concluded that the mark NICKY CLARKE could be said to have a high degree of distinctive character as a result of the extensive use made of it by the Opponents. He then turned to consider the similarity of the marks and the likelihood of confusion. He said:

“60. The guidance from *Sabel v Puma* is that marks must be assessed by reference to their distinctive and dominant components. Both marks consist of full names (setting aside the VAN/VANGELIS/EVANGELUS point for present purposes). What are the memorable features of the names and where does the distinctive character lie? Individuals are usually identified by their full names not least because any particular forename or surname is more often than not shared with others. It is the name as a whole that is likely to identify the individual. That might suggest that, as a general rule, where full names function as trade marks, the distinctive character must always be in the totality. That would also be consistent with one of the other principles from *Sabel v Puma* that consumers perceive marks as a whole and do not proceed to analyse details.

61. Attractive though that proposition might seem it is not a complete answer to how name marks should be approached. The distinctive and dominant elements of marks/names must also be considered. Unusual forenames (such as Madonna) or surnames (Solzhenitsyn, say) may attract particular attention and be the element of a full name that achieves particular recognition. How do the names NICKY CLARKE and MICHAEL VAN CLARKE stand? In posing that question I have not lost sight of the fact that the applied for mark also has the words GREAT HAIR DAYS but it is, I think, common ground that the opposition will succeed or fail primarily on the basis of the names themselves.

62. Mr Matthews acknowledged that CLARKE was a very common surname. There is nothing in the opponents' evidence to suggest that it has been highlighted or received particular recognition within the context of the name NICKY CLARKE. The exhibits to Mr Kaba's declaration consistently show use of the full name. Equally the forename NICKY is not so unusual that it is likely to attract particular attention leading to it being a dominant element within the totality of the mark. I, therefore, conclude that the distinctive character of the opponents' mark, both on the basis of the inherent qualities of the component elements and as a result of use, lies in the full name.

63. The position is somewhat different in the case of the applicant's mark. I accept that MICHAEL is a common forename and CLARKE a common surname. The second element VAN, whether or not its significance is known, does in my judgment add a somewhat unusual and memorable feature to the mark. Customers are, I assume, unlikely to be aware of its derivation in the applicant's full forename. In those circumstances it may well be seen as either an unusual forename in its own right or an unusual collocation of common English names and the element 'Van' as commonly used in conjunction with Dutch surnames (meaning 'of'). Either way it makes for a somewhat unusual totality.

64. I am required to consider the marks from the point of view of visual, aural and conceptual considerations. In all these respects the only point of similarity between the marks is the surname itself. Given that it is an extremely common one and is used here with quite different forenames I find that there is a very low degree of overall similarity. The opponents suggested in their statement of grounds that "the name Michael is often shortened to Micky in the same way that Nicholas is to Nicky ..." There is however nothing in the applicant's evidence of use to suggest that he has ever

used anything other than the full name Michael. I do not think this point assists the opponents.

Likelihood of Confusion

65. The likelihood of confusion must be appreciated globally taking all relevant factors into account. In *Raleigh International Trade Mark* [2001] RPC 202 Geoffrey Hobbs QC, sitting as the Appointed Person, said:

“Similarities between marks cannot eliminate differences between goods or services; and similarities between goods and services cannot eliminate differences between marks. So the purpose of the assessment under Section 5(2) must be to determine the net effect of the given similarities and differences.”

66. No instances of confusion have been brought to my attention (save for the one example which the applicant cites of a competition winner being misdirected by the competition organisers). That is despite both parties having salons in the same area of London (W1). I understand from the evidence that the brothers target a somewhat different client base though as Mr March pointed out Michael Van Clarke, like his brother, has attracted a number of well known personalities. Other factors too may come into play – Mr Matthews mentioned relative cost as a possible differentiating factor (though neither party, it seems to me, is selling on price). Even so, given the physical proximity of the respective salons, it seems to me that instances of confusion might have been expected to arise if they were going to.

67. However, accepting that the absence of instances of confusion is rarely conclusive in its own right, I must come to my own view of the matter. I have little hesitation in concluding that the net effect of the above considerations is that, even allowing for the fact that the respective marks will be used on identical goods and services, the net effect is that there is no likelihood of confusion. The opposition, therefore, fails under Section 5(2)(b).”

15. The Opponents criticised the reasoning of the Hearing Officer in two respects. First of all it was contended that the Hearing Officer failed to have sufficient regard to the distinctive nature of the element CLARKE and attached undue weight to the fact that it is a surname.

16. I am unable to accept this criticism of the reasoning of the Hearing Officer. It is clear from the decision in *Sabel v Puma* [1997] E.C.R. I-6191 that the likelihood of confusion must be appreciated globally, taking account of all relevant factors and that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by them bearing in mind their distinctive and dominant components. The Opponents acknowledged before the Hearing Officer that CLARKE was a very common surname. Moreover, as found by the Hearing Officer, there was nothing in the Opponents' evidence to suggest that the element CLARKE had been highlighted or received particular recognition within the context of the mark NICKY CLARKE. I believe the Hearing Officer was entirely justified in coming to the conclusion that the distinctive character of the Opponents' mark, both on the basis the inherent qualities of the component elements and its use, lay in the full name.

17. Secondly, it was contended that the Hearing Officer did not make due allowance for the possibility of imperfect recollection. It is true that the Hearing Officer does not expressly refer to the possibility of imperfect recollection in the paragraphs of his decision which I have set out above. Nevertheless, earlier in his decision he set out the relevant applicable principles from which it is apparent that he had in mind that the matter must be judged through the eyes of the average consumer 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. Further, I believe the

Hearing Officer set out in an amply detailed way his reasoning in coming to the conclusion that there was no real likelihood of confusion. He also took account of the fact that despite a period of side by side trade no instances of confusion had come to light. In my judgment the Hearing Officer came to the right conclusion.

Section 5(4)

18. The Opponents advanced the same criticisms of the decision of the Hearing Officer under section 5(4) of the Act. The position under section 5(4) is the same as that under section 5(2) save in one respect. The Opponents claimed that the mark CLARKE was eligible for protection in its own right and that the Opponents were known by reference to that word alone. That claim was not accepted by the Applicant. After careful consideration of the evidence, the Hearing Officer found no evidence that there had been any promotion of the mark CLARKE alone and that the products and services of the Opponents were invariably referred to by the name NICKY CLARKE. Accordingly the Hearing Officer rejected the opposition under section 5(4) for the same reasons that he rejected the opposition under section 5(2). In the result the criticisms made of the Hearing Officer's decision under section 5(4) must be rejected for the reasons that I have set forth above in considering the objection under section 5(2).

Conclusion

19. This appeal must be dismissed. The Hearing Officer ordered the Opponents to pay the Applicant the sum of £1,000 by way of a contribution to his costs.

Although the Applicant did not appear before me, he has requested an award of additional costs in the amount of £450, being the additional costs incurred in considering the Opponents' Notice of Appeal and taking legal advice in relation to it. I have come to the conclusion that it would be right to award to the Applicant the sum of £150 by way of additional costs in addition to the award of £1,000 made by the Hearing Officer, such sum to be paid on a like basis to that which he ordered.

David Kitchin QC

9th June 2003

