

O-176-04

TRADE MARKS ACT 1994

AND

THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996

IN THE MATTER OF INTERNATIONAL REGISTRATION NO 726627

AND THE REQUEST TO PROTECT A TRADE MARK IN CLASS 31

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BACKGROUND

1. On 24th February 2000, the World Intellectual Property Organisation (WIPO) notified the United Kingdom of an international registration, 726627, in the name of Novartis Seeds BV, (the holder) for which protection was sought in the United Kingdom under the provisions of the Madrid Protocol. The details of the international registration are as follows:

Mark: CANTO

List of goods and services:

Class 31 Agricultural and horticultural products (not included in other classes), grains, seeds, seedling plants and other plant parts or seedlings for propagation.

International registration date: 23rd December 1999

Basic registration : Benelux 23rd December 1997, 623578

2. It was considered that the request failed to satisfy the requirements for registration in accordance with Article 3 of the Trade Marks (International Registration) Order 1996 and under Article 9(3) of that Order, Notice of Refusal was sent to the registration holder. Such a Notice of Refusal is issued in accordance with Rule 17(1) and (2) of the Common Regulations under the Madrid Protocol. It constitutes a provisional notice, subject to final confirmation, against which the holder is entitled to argue, subject to the provision of an address for service within the United Kingdom.

3. The grounds for such a refusal were under section 5(2) of the Trade Marks Act 1994.

4. Attorneys based in the UK were subsequently appointed by the holder to contest the provisional refusal. In a letter dated 18th October 2000, they agreed to limit the specification in class 31 to: Flower seeds; but not including seeds for human consumption.

5. It is this restricted specification which will form the basis of this statement of grounds. The examiner then agreed to waive two of the citations raised under section 5(2) because the goods of

the restricted registration in suit were sufficiently dissimilar from those of the cited marks to avoid likelihood of confusion.

6. However, the examiner maintained objection in relation to E997411.

Details of this mark are as follows:

Mark: ERIC CANTONA CANTO

Date filed: 20th November 1998

Goods and services:

Class 3

Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.

Class 8

Hand tools and implements (hand operated); cutlery; side arms; razors.

Class 9

Scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images, smart cards, cards with microprocessors, magnetic cards, magnetic identity cards, video games cartridges, video cassettes; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus

Class 12

Vehicles; apparatus for locomotion by land, air or water.

Class 14

Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments.

Class 16

Paper; cardboard; cardboard articles; printed matter; newspapers; books; manuals; promotional pamphlets; brochures; printed publications of all kinds in all forms; magazines

(periodicals); paintings (pictures) and engravings, wrapping paper; bags and sheets of paper or plastic, for packaging; shields [paper seals]; signboards of paper or cardboard, labels, not of textile, flags (of paper); posters; postcards, transfers; drawings; pictures; photo-engravings; paper or cardboard tapes for recording computer programs; instructional or teaching material in the form of games (except apparatus) namely books, printed matter, playing cards; printers' type; printing blocks.

Class 18

Leather and imitations of leather, and goods made of these materials and not included in other classes, namely key cases, briefcases, pocket wallets, purses, not of precious metal ; handbags, school bags and school satchels, tool bags of leather (empty), rucksacks, bags for climbers, bags for campers, beach bags, travelling bags, garment bags for travel ; boxes of leather or leather board; leather thongs, leather straps; collars for animals, covers for animals, leather leashes, muzzles, leather trimmings for furniture.

Class 20

Furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics.

Class 24

Textiles and textile goods, not included in other classes, namely upholstery fabrics, bath linen (except clothing), bed linen, household linen, table linen, diapered linen, lingerie fabric, bedding; bed and table covers.

Class 25

Clothing, namely sports jerseys, swimsuits, beach clothes, bathing trunks, dressing gowns, saris, bath robes, bandanas, boas, stoles, headscarves, scarves, headbands, stockings, bibs of paper, bibs, not of paper, braces, collar protectors, camisoles, hoods, belts, shawls, dressing gowns, sweaters, pinafores, socks, sock suspenders, shirts, short-sleeved shirts, collars, slippers, ready-made clothing, trousers, suits, aprons, ear muffs, neckties, clothing of leather and imitations of leather, footwear uppers, shirt yokes, clothing of fur, gabardines, corsets, gloves, mittens, waistcoats, pull-overs, knitwear, tails, T-shirts, waterproof clothing, coats, parkas, pelerines, pelisses, stuff jackets, jackets, legwarmers, skirts; fancy dress costumes, underwear, underclothing, underpants, bodies, brassieres, pants, knickers, corselets, pyjamas, dressing gowns, footwear, boots, half-boots, lace boots, slippers, football boots, beach shoes, footwear for sports, studs for boots for sports, espadrilles, galoshes, slippers, sandals, ski boots, shoes; headgear, hats, bathing caps, skull caps, berets, caps.

Class 28

Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees.

Class 29

Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, milk and milk products; edible oils and fats.

Class 30

Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder, salt mustard; vinegar, sauces (condiments); spices; ice.

Class 31

Agricultural, horticultural and forestry products and grains not included in other classes; live animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals, malt.

Class 32

Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.

Class 33

Alcoholic beverages (except beers).

Class 34

Tobacco; smokers' articles; matches.

Class 35

Advertising; consultancy and advisory services for business organisation and management; business consultancy; outdoor advertising, distribution of samples, publicity material and prospectuses, including for mail order sales, cross-border or otherwise; services of a franchiser, namely business and industrial management assistance; providing of an administration data bank; commercial information advice; commercial promotion of all kinds and in particular by the provision of privileged user cards; organisation, promotion and advertising of all types and on any media, including for mail order sales, cross-border or otherwise; retrieval, formatting, compilation and processing of data and more generally recording, transcription, transmission and systematisation of written communications and sound and/or visual recordings; subscriptions to printed matter, subscriptions to all information media, text media and sound and/or image media, in particular in the form of publications, electronic or otherwise, digital publications, audio-visual products or

multimedia products, computerised formatting of text and/or images, still or moving, and/or of sound (whether or not musical), whether or not for interactive use, on corresponding media (audionumeric compact discs, audionumeric video discs); document reproduction; direct mail advertising and rental of all publicity and commercial presentation material (tracts, prospectuses, printed matter, samples); computerised file management, advertising and business management relating to data communications services, computer compilation and formatting, digitalisation of text and/or images, still or moving, and/or of sound (whether or not musical).

Class 38

Communication services and in particular news and information agencies; radio broadcasting, communications by telephone and by telegrams, data communication and all types of remote processing, videotex and in particular on computer terminals, peripherals or electronic and/or digital equipment; including videophone and video conferencing; sending of telegrams and messages; television and more generally multimedia broadcasting, computerisation of text and/or of still or moving images and/or of sound (whether or not musical), whether or not for interactive use; radio or television and more generally audiovisual and multimedia broadcasting (computerisation of text and/or of still or moving images and/or of sound, whether or not musical), whether or not for interactive use, telex services, telegrams; teleprinting, data transmission network information services; data transmission for obtaining information contained in data banks; all communications and telecommunications services for public information; communications on computer networks in general; communication services in the audio-visual, video and multimedia field; transmission of information contained in data banks; rental of computing, remote processing and data transmission apparatus and instruments.

Class 41

Communication services and in particular news and information agencies; radio broadcasting, communications by telephone and by telegrams, data communication and all types of remote processing, videotex and in particular on computer terminals, peripherals or electronic and/or digital equipment; including videophone and video conferencing; sending of telegrams and messages; television and more generally multimedia broadcasting, computerisation of text and/or of still or moving images and/or of sound (whether or not musical), whether or not for interactive use; radio or television and more generally audiovisual and multimedia broadcasting (computerisation of text and/or of still or moving images and/or of sound, whether or not musical), whether or not for interactive use, telex services, telegrams; teleprinting, data transmission network information services; data transmission for obtaining information contained in data banks; all communications and telecommunications services for public information; communications on computer networks in general; communication services in the audio-visual, video and multimedia field; transmission of information contained in data banks; rental of computing, remote processing and data transmission apparatus and instruments.

Class 42

professional consultancy and construction drafting, non-business; legal consultancy; organisation of exhibitions, fairs and showrooms; personal letter writing; services provided by a franchiser, namely transfer (provision) of know-how, licensing, copyright management, construction, realisation and development of data banks and databases; programming of electronic apparatus and instruments, computers, remote processing and data communication systems, multi-media equipment, programming of multi-media materials; editing of written texts; writing of reports; translations; printing; filming on video; management of exhibition facilities; rental of apparatus and instruments for the use of multimedia products.

7. In an undated letter, the examiner considered that the mark >CANTO= was a >strong= mark for the goods of the designation. This being the case:

A.any prospective purchaser of goods sold under the respective banners ERIC CANTONA CANTO and CANTO would believe that the goods emanated from the same proprietor. Eric Cantona merely being the house mark.@

Reference in support of this contention was made to *Bulova Accutron* [1969] RPC 102.

8. However, E 997411 was at that time (October 2000) the subject of an opposition before the Community Trade Mark Office (OAMI). In such circumstances, assuming that the OAMI registration was the only barrier to protection in the UK of the subject registration, it is practice to suspend the subject registration until such time as it is clear precisely for what goods or services the OAMI mark is to be registered, if at all. The attorneys agreed to suspension whilst progress of the OAMI application was tracked by the examiner.

9. On 23rd September 2003, the examiner wrote to the attorneys of record, noting that opposition proceedings against E 997411 had concluded and the mark had been registered in respect of the goods and services listed above in para 6. The examiner gave the attorneys until 23rd December 2003 in which to indicate how they wished to proceed.

10. No response by that deadline was made by the attorneys. On 23rd January 2004, in accordance with established practice a letter was duly sent to the attorneys saying that they had been notified of the provisional refusal back in April 2000 and that it had been maintained. Should they wish to appeal against the refusal a Form TM5 and fee should be filed before 23rd February 2004, whereupon the registry would supply a statement of grounds setting out our reasons in full. If no such Form was received, WIPO would be notified of final refusal.

11. On 17th February 2004, a Form TM5 with fee was filed by Syngenta Participations AG, through their UK based attorneys. Syngenta said that they were in the process of assigning the registration from their legacy company Novartis Seeds AG to themselves. A request to register this change in ownership had been made to WIPO.

12. On receipt of the Form TM5, I am required to set out the reasons for refusal of protection in the United Kingdom.

DECISION

The law

13. Sections 5(2) of the Act reads:

5.C(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if becauseC

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

(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.

14. Community trade mark E997411 has a filing date of 20th November 1998 and is thus an earlier trade mark for the purposes of section 5(2).

15. I take into account the well established guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] ETMR 1, *Canon Kabushiki Kaisha v MGM Inc* [1999] RPC 117, and *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [2000] FSR 77.

The goods

16. E997411 is registered in class 31 for the following goods:

Agricultural, horticultural and forestry products and grains not included in other classes; live animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals, malt.

17. The specification of the registration in suit is:

Flower seeds; but not including seeds for human consumption.

18. As the specification of the earlier trade mark contains the general term 'seeds' in class 31, it must be concluded that a sub category 'flower seeds, not for human consumption' is contained within the general term 'seeds'. Thus the goods are identical for the purposes of our comparison under section 5(2)- accordingly section 5(2)(b) applies.

The marks and assessment of likelihood of confusion

19. The earlier trade mark ERIC CANTONA CANTO contains the word »CANTO«, but this of itself is not necessarily decisive. The question is : would the average consumer for the relevant goods be likely to confuse the origin of goods sold under the mark CANTO with those sold under the mark ERIC CANTONA CANTO ?

20. In correspondence, the examiner cited the case of *Bulova Accutron* [1969] RPC 102 (»BULOVA«) and it is worthwhile considering the application of that case to the case before me - accepting as I do that the case has application. I should also say that I know of no authority whereby the principle set out in BULOVA has been varied or abandoned altogether.

21. In that case, it was held that there was a likelihood of confusion between the marks BULOVA ACCUTRON and ACCURIST. The opponents owned ACCURIST, an invented word which had, in an earlier decision, been held to lead to a likelihood of confusion with the mark ACCUTRON. Taking account of imperfect recollection, it was held that the average consumer was apt to regard the word BULOVA, when combined with ACCUTRON, as either a »house«-mark or another trade mark.

22. Applying the BULOVA principle to this case, I believe that the sign ERIC CANTONA (being the name of a well known footballer) would be seen by the average consumer as the »house«-mark element of the trade mark. The secondary sign »CANTO« would operate as a secondary indicator of origin. Given that the average consumer would see ERIC CANTONA CANTO as *two separately identifiable trade mark elements*, I can come to no other conclusion than the one arrived at in the BULOVA case. In fact in this case, the likelihood of confusion is even more pronounced: the secondary element CANTO in ERIC CANTONA CANTO is identical to CANTO solus.

23. I would simply add that just as it cannot be right that by adding a »house«-mark to an already registered trade mark the likelihood of confusion is avoided, likewise it must be the case that seeking registration of a »secondary«-trade mark without a house mark avoids likelihood of confusion. Of course , this is not to say that such an act was done wilfully, merely that due protection should be given by the registrar to all the dominant and distinctive elements of an earlier mark.

24. No submission to the contrary has been put to me. I am left therefore to apply, as the examiner did, the BULOVA view, which in my view is wholly consistent with the principles subsequently set out in the various ECJ cases referred to in paragraph 15 above.

25. In this decision I have considered all the documents filed by the holder and all the arguments submitted to me in relation to this international registration and, for the reasons given, it is refused under the terms of Articles 3, 9(3) and 11(5) of the Trade Marks (International Registration) Order 1996 (as amended) because it fails to qualify under section 5(2)(b) of the Act.

Dated this 16th day of June 2004

**Edward Smith.
For the Registrar
the Comptroller-General.**