

O-223-04

IN THE MATTER OF APPLICATION NO. 2220509 IN THE NAME OF
CHARALAMBOUS PORTELLI

AND IN THE MATTER OF OPPOSITION NO. 80367 THERETO BY
KONINKLIKE PHILIPS ELECTRONICS NV

DECISION

Introduction

1. On 28 January 2000 Charalambous Portelli applied to register the mark PHILOS in respect of the following specification of goods:

Communications apparatus and instruments; telephone networks, mobile telephones, telephone handsets; satellite communication apparatus and instruments; broadcasting apparatus and instruments; tracking, monitoring and locating apparatus and instruments; apparatus for accessing and using the Internet and other databases; computer hardware, firmware and software; components, parts and fittings for all the aforesaid goods, all being in Class 9.

The application was subsequently opposed by Koninklijke Philips Electronics NV under sections 1(1), 3(6), 5(2)(b) and 5(3) of the Trade Marks Act 1994. In a decision dated 15 December 2003 Mr Reynolds acting on behalf of the Registrar rejected each of these grounds and dismissed the opposition. The opponent now appeals against the decision so far as it rejected the ground of opposition under section 5(2)(b). Neither the opponent nor the applicant wished to make oral representations, and accordingly I am determining the case on the basis of the opponent's written representations in accordance with rule 65(3)(a) of the Trade Marks Rules 2000 as amended by the Trade Marks (Amendment) Rules 2004.

Section 5(2)(b)

2. Section 5(2)(b) provides:

A trade mark shall not be registered if because ... 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 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 hearing officer's decision

3. Although the opponent pleaded a number of earlier marks, the hearing officer concluded that its best case under section 5(2)(b) was that based upon UK Registered Trade Mark No. 927851 PHILIPS registered in respect of a long list of goods in Class 9. On a comparison between the goods specified in the application and various goods in the '851 specification, he concluded that the former were either identical or closely similar to the latter.
4. As to the identity of the relevant average consumer, the hearing officer considered that the range of goods applied for was such that there was not a single class of consumers, but a range of consumers varying from sophisticated business or commercial users to the general public, but that even in the latter case the goods would be purchased with some care.
5. As to the distinctive character of the respective marks, he concluded that PHILOS was a mark which had a reasonably high degree of distinctive character since the majority of consumers would view it as an invented or unusual word or name, while PHILIPS was a household name in the field of consumer electronic goods and household appliances despite being a common surname and also had an enhanced reputation in the business communications field.

6. So far as the question of similarity between the respective marks was concerned, the hearing officer took the view that in the present case an important factor was that the opponent's mark would be recognised as being a common surname whereas the applicant's mark would be taken to be a invented or meaningless word, and therefore conceptually the marks were quite distinct. Regarding visual similarity, he noted that the two marks shared the first four letters and the final S, and therefore there was some superficial visual similarity, but concluded that the average consumer would not dissect the marks in that way and would not notice the points of similarity without also apprehending that the opponent's mark was a common surname whilst the applicant's mark was not. As to aural similarity, he concluded that there was a range of possible pronunciations of PHILOS, but that if it was pronounced with a short "I" and an emphasis on the first syllable the first syllable would sound the same as the first syllable in PHILIPS.
7. The hearing officer's conclusion was that the visual and aural points of similarity were outweighed by the different significations of the words, and that even allowing for use of the respective marks on identical or similar goods, imperfect recollection and the reputation of the opponent's mark there was no likelihood of confusion.

Standard of review

8. This appeal is a review of the hearing officer's decision. The hearing officer's decision with regard to section 5(2)(b) involved a multi-factorial assessment of the kind to which the approach set out by Robert Walker LJ in *REEF TM* [2002] EWCA Civ 763, [2003] RPC 5 at [28] applies:

In such circumstances an appellate court should in my view show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle.

The opponent's submissions on appeal

9. In its statement of case in support of the appeal the opponent accepts the hearing officer's view that its best case was that based on '851 and agrees with his assessment of the similarity of goods. It also agrees with his assessment that the relevant consumers of at least some of the goods in issue are the general public.
10. The first point in the hearing officer's reasoning with which the opponent takes issue is his finding with regard to the reputation enjoyed by the PHILIPS mark. I do not understand the opponent's complaint in this regard, since the hearing officer's finding appears to me to be entirely favourable to the opponent.
11. The opponent's main contention is that the hearing officer wrongly assessed the degree of similarity between the respective marks, and that the degree of visual and aural similarity is such that he should have concluded that there was a likelihood of confusion, particularly once the similarity of goods and the reputation enjoyed by PHILIPS were taken into account. In support of this contention the opponent seeks to draw a contrast between the hearing officer's decision in the present case and the decisions in three other oppositions, O/115/00, O/424/00 and O/237/03. The opponent does not, however, identify any error of law or principle on the part of the hearing officer. The nearest it gets to this is to fasten on to a comment made by the hearing officer that surnames have traditionally been treated somewhat differently to other words, but even here the opponent concedes that this is "probably true to some extent". In reality, the opponent is simply asking me to take a different view from the hearing officer. As *REEF TM* and the cases cited therein make abundantly clear, this is not a proper basis for an appeal. Moreover, the opponent's reliance upon the decisions in other oppositions is misconceived: they merely represent attempts by hearing officers to apply the same principles to different facts.
12. The opponent also makes certain minor criticisms of other aspects of the decision, but these do not appear to me to add anything to the points I have already considered.

13. Overall, I am satisfied that the hearing officer approached the matter correctly and reached a decision which was, to put it at its lowest, a tenable decision to reach.

Conclusion

14. Accordingly the appeal is dismissed. The applicant has not requested an award of costs, and indeed has taken no part in the appeal proceedings. Accordingly I make no order as to costs.

28 July 2004

RICHARD ARNOLD QC

E.K. Hanson of Philips Electronics (UK) Ltd acted for the opponent.