

O-138-07

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 2372398 IN THE NAME OF  
DR SIMON J MOORE AND DR TIMOTHY RUMNEY

AND

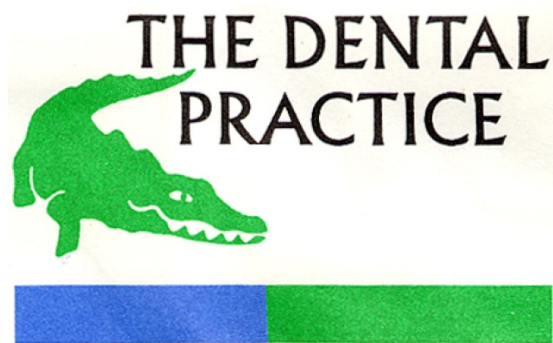
IN THE MATTER OF OPPOSITION THERETO UNDER NO. 93180 BY  
LA CHEMISE LACOSTE (SA)

## TRADE MARKS ACT 1994

IN THE MATTER OF application  
No. 2372398 in the name of  
Dr Simon J Moore and Dr Timothy Rumney  
and in the matter of opposition thereto under  
No. 93180 by La Chemise Lacoste (SA)

### **Background**

1. Application No. 2372398 stands in the names of Dr Simon J Moore and Dr Timothy Rumney and has a filing date of 8 September 2004. The application seeks registration of the following mark:



in respect of: *Dentistry Services* in Class 44.

2. Following publication of the application, notice of opposition was filed on behalf of La Chemise Lacoste (SA). The grounds of opposition are, in summary:

- Under section 5(2)(b) of the Act based on community trade mark No. 2979581
- Under section 5(3) of the Act based on community trade mark Nos. 2979581 and 2979565 and UK trade mark Nos. 1328764, 1452623, 1524917 and 1178977
- Under section 5(4)(a) of the Act
- Under section 56 of the Act

3. The applicants filed a Form TM8 and counter-statement essentially denying the grounds of opposition.

4. Both parties filed evidence. Neither requested to be heard but both filed written submissions in lieu of a hearing. After a careful study of all the relevant papers, I give this decision.

### **Opponent's evidence**

5. A witness statement of Christian London is dated 13 October 2005. Mr London is the Legal Director of the opponent company, a position he has held since 1982. Mr London confirms that the facts in his statement come from his company's books and

records or from his own knowledge and that he is authorised to act on behalf of his company.

6. Mr London states that his company has used a trade mark consisting of a crocodile since at least as early as 1933. At XX1 he exhibits a brief history of his company's activities in relation to the use of what he calls the "crocodile logo". I note that the papers appear to bear a number of trade marks.

7. Mr London states that his company enjoys a massive reputation and goodwill in its marks which have been used in relation to a wide range of goods and services in the UK and worldwide. He provides the following details of turnover in Euros for sales relating to the UK:

	2000	2001	2002	2003	2004
Clothing	27,077,190	29,305,628	32,517,775	30,436,800	34,000,000
Leather goods	125,342	88,782	144,401	327,448	1,000,000
Shoes	28,594,438	24,599,500	23,816,800	20,000,000	26,144,200
Eyewear	2,732,804	1,847,666	1,754,535	1,448,514	2,216,566
Perfume	70,000	302,250	6,000,000	11,000,000	6,500,000
Belts	15,939	18,441	24,405	37,982	54,995
Household Linen	n/a	32,000	19,086	20,000	150,000
Watches	294,552	525,014	750,087	792,000	1,406,897
Total	58,910,266(sic)	56,719,280(sic)	65,027,089	64,062,744	71,472,657(sic)

8. Mr London does not break these figures down in any way and I proceed on the basis on that these are figures relating to sales under all of his company's trade marks. He does not explain how much of the figures given for 2004 relate to a period before the relevant date in these proceedings. I also note that the totals given for 2000, 2001 and 2004 are very slightly inaccurate although I do not think anything rests on it.

9. Mr London states that worldwide sales in 2002 of products bearing his company's trade marks amounted to over 1 billion Euros relating to some 42 million individual items. He says the company was active in 110 countries by 2004 and has registered its trade marks in over 200 countries. He exhibits a list of these countries at XX4

10. Mr London states that his company widely promotes its trade marks in all types of media including magazines, tv, posters and billboards. At XX5, XX6 and XX7 he exhibits examples of advertising and promotional material from the UK and elsewhere. No evidence is given to show the advertising spend in the UK nor e.g. to the medium used nor geographic or demographic extent of any such advertising.

11. Mr London states that his company uses its marks in relation to a wide variety of goods and services (though he gives no further details) and uses them to promote and sponsor events in the UK and around the world, particularly in relation to the game of tennis. At XX8 and XX9 he exhibits material relating to his company's sponsorship of various tennis, golf and yachting events. No explanation is given as to where these events took place.

12. Mr London states that his company has seven retail outlets in the UK and at XX10 exhibits photographs showing the exterior of these outlets. As of December 2004 the company also owned 799 boutiques worldwide and at XX11 he exhibits details of these.

13. Finally, at XX12, Mr London exhibits photographs of what he calls high profile individuals wearing the opponent's apparel. These photographs are not dated.

14. There is also a witness statement of Roger Grimshaw dated 14 October 2005. Mr Grimshaw is a trade mark attorney with Mewburn Ellis LLP, the opponent's trade mark representatives in these proceedings.

15. Mr Grimshaw's witness statement introduces the following exhibits:

- RSG1: copies of evidential material filed in relation to earlier opposition proceedings
- RSG2: a copy of the decision in relation to those earlier opposition proceedings
- RSG3: a copy of a decision reached by the Office for Harmonization in the Internal Market in separate opposition proceedings

16. At RSG4, Mr Grimshaw exhibits the results of a search of the Marquesa database for marks on the UK, CTM or Madrid registers which contain alligators, caymans or crocodiles. I have no explanation of the intended purpose of this exhibit in relation to the issues involved in these proceedings but I take it to be no more than state of the register evidence. State of the register evidence may indicate what exists on the register but it shows nothing about what might be happening in the marketplace. In *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281 Jacob J said:

“ In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the Registrar to put the marks concerned on the Register. It has long been held under the old Act that comparison with other marks on the Register is in principle irrelevant when considering a particular mark tendered for registration, see *MADAME Trade Mark* (1966 RPC 541) and the same must be true of the 1994 Act. I disregard the state of the register evidence.”

17. I disregard this exhibit.

### **Applicant's evidence**

18. This consists of a witness statement by Simon John Moore and Timothy John Rumney (“the applicants”). The applicants comment on the similarity or otherwise of the respective marks and exhibit, at TDP1 a copy of their trade mark device as applied for. I do not intend to summarise these comments but will take them into account as appropriate.

19. Messrs Moore and Rumney state that images of crocodiles or alligators are commonplace and exhibit at TDP2 a variety of internet printouts bearing such images. The printouts bear the date 25 April 2006, therefore after the relevant date, and they do not provide any indication of how or on what goods or services, if any, they may be used. Messrs Moor and Rumney state their belief that it is unreasonable for a single company to expect to have sole and exclusive use of such images. At TDP3 they exhibit an example of use of a crocodile in relation to another company in the dental field. The exhibit appears to me to be a copy of an advertisement though neither its source nor date of publication is given.

20. Messrs Moore and Rumney deny they are in any way in competition with or purporting to be the opponent company. They point out that the application in suit is for a mark which consists of words as well as a device and there is no intention to mislead.

21. The applicants state that they have used their mark on stationery and promotional advertising in relation to their provision of dental care and treatment services since it was designed in 1991. They have used it since that time, have had no opposition to that usage and are not aware of there ever having been any incidents of confusion with the opponent. They state the respective marks are unlikely to be confused because of the differences in the marks, particularly the inclusion of the words “The Dental Practice” appearing in the mark of the application. At TDP4 they exhibit a copy of a letter from the designer of their mark. They also exhibit:

TDP5-newspaper advertisement dating from 1992;  
TDP6-newspaper article dating from 1992;  
TDP7-examples of internal practice stationery.

22. In relation to the evidence filed by the opponent, Messrs Moore and Rumney state that it contains no references that any professional dental health care services are provided under the opponent’s marks. Whilst they accept that people will associate the opponent’s use of its marks in relation to clothing, fashion and sport, they dispute that it would be associated with dental care.

23. At TDP8 they exhibit a printout from the BBC News website giving details of a case involving a trade mark dispute in China published in March 2004. I am not provided with any explanation as to any possible relevance of this case to these proceedings.

### **Opponent’s evidence in reply**

24. This takes the form of a further witness statement of Roger Grimshaw and is dated 8 August 2006. Mr Grimshaw responds to the applicants’ comments on the similarity or otherwise of the respective marks and the goods and/or services covered by those marks. Again, I do not intend to summarise those comments but will take them into account as appropriate.

25. Mr Grimshaw introduces a number of exhibits as follows:

RSG5- printouts from various internet sites intending to show that beauty salons offer teeth whitening services;  
RSG6- printouts from independent oral health charity relating to teeth whitening;  
RSG7-printouts from the British Dental Association website;  
RSG8-printouts from the websites of medical service providers;  
RSG9-printouts from the websites of toothpaste companies.

26. All of these printouts appear to have been printed in August 2006, almost two years after the relevant date in these proceedings.

27. That completes my review of the evidence filed in these proceedings.

## **Decision**

### **The objection under Section 5(2)(b)**

28. I deal firstly, with the ground of opposition based on Section 5(2)(b) of the Act which states:

“ 5.-(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.”

29. The term “earlier trade mark” is defined in section 6 of the Act as follows:

“6.-(1) In this Act an “earlier trade mark” means-

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,”

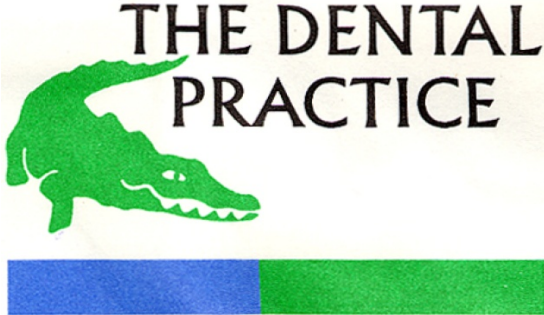
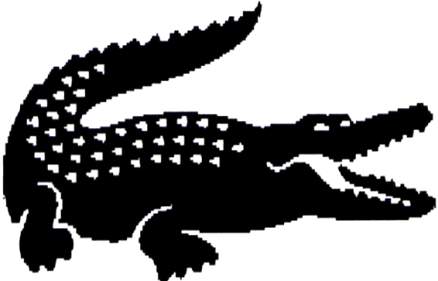
30. The opponent’s registration is an earlier trade mark within the definition of Section 6 of the Act.

31. In determining the question under Section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R 77 and *Marca Mode CV v Adidas AG and Adidas Benelux B.V.* [2000] E.T.M.R.723. It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors: *Sabel BV v Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question: *Sabel BV v Puma AG*, paragraph 23, 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 he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen B.V.* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details: *Sabel BV v Puma AG*, paragraph 23;
- (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; *Sabel BV v Puma AG*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki v Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (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; *Sabel BV v Puma AG*, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*, paragraph 26;
- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG*, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, paragraph 29.

32. In essence the test under Section 5(2) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements and taking into account the degree of similarity in the goods and/or services, the category of goods and/or services in question and how they are marketed.

33. For ease of reference I set out the respective marks below:

Applicant's trade mark	Opponent's trade mark
	
<p>Class 44: Dentistry services</p>	<p>Class 1: Chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry; unprocessed artificial resins, unprocessed plastics; manures; fire extinguishing compositions; tempering and soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives used in industry.</p> <p>Class 2: Paints, varnishes (except for insulating varnishes), lacquers (paints); preservatives against rust and against deterioration of wood; colorants; mordants (not for metals or for seeds); raw natural resins; metals in foil and powder form for painters, decorators, printers and artists.</p> <p>Class 3: Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; leather bleaching preparations, shoe polish, shoe cream, creams for leather, polish and wax for cobblers; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.</p> <p>Class 4: Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; candles, wicks (lighting).</p>



	<p>Class 5: Pharmaceutical and veterinary preparations; sanitary preparations for medicine and personal hygiene; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings (except instruments); material for stopping teeth, dental wax; disinfectants for medical or sanitary purposes (other than soaps); preparations for destroying vermin; fungicides, herbicides.</p> <p>Class 6: Common metals and their alloys; metal building materials; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metal; ironmongery, non-electric; small items of metal hardware; metal pipes; safes; ores; non-luminous metal advertising boards and signboards for shops.</p> <p>Class 7: Machine tools; motors and engines (except for land vehicles); machine coupling (non electric) and transmission components (except for land vehicles), agricultural instruments other than hand operated; incubators for eggs.</p> <p>Class 9: Scientific (other than for medical purposes), nautical, surveying, photographic, cinematographic, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; optical apparatus and instruments, namely sunglasses, sports goggles, optical spectacles, spectacle frames, chains and cords for spectacles, spectacle cases, spectacle lenses, optical lenses, contact lenses, contact lens cases, contact lenses, optical binoculars; apparatus for recording, transmission or reproduction of sound or images; magnetic data-carriers, recording discs;</p>
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	<p>automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment; computers; fire-extinguishing apparatus; luminous advertising boards and signboards for shops.</p> <p>Class 10: Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopedic articles; suture materials.</p> <p>Class 11: Apparatus for lighting, heating, steam generating, cooking, drying, ventilating, water supply and sanitary purposes.</p> <p>Class 12: Vehicles; apparatus for locomotion by land, air or water.</p> <p>Class 13: Firearms; ammunition and projectiles; explosives; fireworks.</p> <p>Class 14: Precious metals and their alloys other than for dental purposes; jewellery, precious stones; horological and chronometric instruments, namely watches, wrist watches, clocks, electric clocks, alarm clocks, clock cases, watch cases, watch straps, watch chains, watch crystals, stopwatches, clock hands, pendulums, dials, cases and casings for watchmaking.</p> <p>Class 15: Musical instruments.</p> <p>Class 16: Paper and cardboard (untreated, semi-finished or for stationery or printing); printed matter; bookbinding material; photographs; stationery; posters, scrapbooks, almanacs, water colours, prints, drawings, atlases, pads (stationery), newspapers, lithographs,</p>
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	<p>books, bags for packaging of paper or of plastics materials, bookends, bookmarks, drawing pads, brochures, blotters, notebooks, calendars, catalogues, directories, bindings, cheque holders, cabinets for stationery, packaging paper, envelopes, desk blotters, ink, inkwells, charcoal pencils, pencils, pencil holders, pencil leads, pens, balls for ball-point pens, nibs, penholders, drawing pens, nibs, pencases, stands for pens and pencils; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); printers' type; printing blocks.</p> <p>Class 17: Rubber, gutta-percha, gum, asbestos, mica; plastics in extruded form for use in manufacture; packing, stopping and insulating materials; flexible pipes, not of metal.</p> <p>Class 18: Leather and imitations of leather; articles of leather and imitations of leather, namely: luggage (except sacks made of textile materials for packaging and sacks for the transport and warehousing of goods in bulk), travel bags, sports bags (except fitted bags designed to hold particular sporting articles), leather goods, vanity cases (not fitted), toilet bags (empty), hand bags, beach bags, rucksacks, briefcases, satchels, wallets, card cases, purses, coin purses (not of precious metal), pouches designed to be attached to belts, pouches; skins; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harnesses and saddlery.</p> <p>Class 19: Building materials (non-metallic); non-metallic rigid pipes for building; asphalt, pitch and bitumen; non-metallic transportable buildings; monuments, not</p>
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	<p>of metal; advertisement boards and non-luminous, non-metallic signs.</p> <p>Class 20: Furniture, mirrors, picture frames, works of art 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.</p> <p>Class 21: Non-electric household or kitchen utensils and containers (not of precious metals or coated therewith); combs and sponges; brushes (other than paint brushes), brushes for footwear, wax-polishing appliances (non-electric) for footwear, shoe trees, shoe horns, boot jacks; toilet essentials and utensils, namely hair brushes, toilet brushes, toothbrushes, combs and comb cases, sponges, perfume vaporisers, powder compacts, not of precious metal, powder puffs, soap boxes, soap holders, eyebrow brushes, shaving brushes and shaving brush holders; brush-making materials; materials for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building) tableware of glass, porcelain or earthenware.</p> <p>Class 22: Cords (not of rubber or for rackets or musical instruments), string, fishing nets, nets for camouflage, tents, awnings (safety awnings or pushchair covers), sails (rigging), padding and stuffing materials (except of rubber and plastic); raw fibrous textile materials.</p> <p>Class 23: Yarns and threads, for textile use.</p> <p>Class 24: Fabrics for textile use; household linen; bed linen, namely sheets, fitted sheets, pillows, pillow cases, bolster covers, bed covers, bedspreads, duvets, duvet</p>
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	<p>covers, eiderdowns, duvet covers and all coordinated accessories; curtains made of textiles, cushion covers; table linen, namely textile table cloths, textile table napkins, textile table mats; bath linen, namely washing mitts, textile face towels, textile bath towels, textile beach towels.</p> <p>Class 25: Clothing, footwear, headgear.</p> <p>Class 26: Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; shoe fasteners, shoelaces, eyelets for shoes, shoe ornaments (not of precious metals); artificial flowers.</p> <p>Class 27: Carpets, rugs, mats and matting, linoleum, other materials for covering existing floors (except tile floorings and paints); wall hangings (non-textile)</p> <p>Class 28: Toys, games and playthings; gymnastic and sporting articles (except clothing, footwear and matting), balls for games, tennis balls, tennis ball dispensers, rackets, ropes and guts for rackets, tennis nets, table tennis tables and nets, cricket bags, golf gloves, golf sticks and clubs, golf bags with or without wheels, hockey sticks, balls for games, baseball gloves, bows for archery, fencing weapons, fencing gloves and masks; decorations for Christmas trees.</p> <p>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.</p> <p>Class 30: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread,</p>
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	<p>pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.</p> <p>Class 31: Agricultural, horticultural and forestry products (neither prepared, nor processed); grains (seeds); live animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals, malt.</p> <p>Class 32: Beers; mineral and aerated waters; non-alcoholic beverages and preparations for making beverages (except coffee, tea or cocoa-based beverages and milk beverages); fruit drinks and fruit juices; syrups and other preparations for making beverages.</p> <p>Class 33: Alcoholic beverages (except beers).</p> <p>Class 34: Tobacco; smokers' articles not of precious metals; matches.</p> <p>Class 35: Publicity; multimedia advertising; rental of advertising space; dissemination of advertisements; dissemination of advertising matter via the national and international communications network (Internet); dissemination of advertising matter; rental of advertising material; rental of advertising space on computer networks; publication of films and publicity texts; advertising mail; organization of exhibitions for commercial or advertising purposes; advertising management; updating of advertising material; professional business consultancy; business organisation and management consultancy; advertising consultancy; operating a commercial or advertising database; management of computer files; data entry and data processing; running a</p>
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	<p>web portal, namely providing advertising and commercial information; business or promotion services; providing commercial information via a database, online "marketplace" allowing website visitors to sell goods and advertise services and buy goods and select service providers; provision of space on web sites for advertising goods and services; business management; business administration; office functions; commercial sponsorship and patronage.</p> <p>Class 36: Insurance underwriting; financial affairs; monetary affairs; real-estate affairs.</p> <p>Class 37: Construction; repair; installation services.</p> <p>Class 38: Telecommunications; services for a telecommunications network; communication by data transmission; communications by electronic means; national and transnational communications services; communications by and/or between computers and computer terminals; communications between computer terminals; communications on national or worldwide computer networks (Internet); computer-aided transmission of messages and images; computer-aided transmission of information; sending and receiving messages and images via external (Internet) and internal (intranet) computer networks, sending information by data transmission; sending information via electronic communications networks accessible using an access code for commercial transactions; sending information contained in databases by electronic means, in particular via electronic communications networks (such as the Internet) or via private or restricted access communications networks (such</p>
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	<p>as intranets), sending messages; electronic and computer mail; exchange of computerised documents; electronic exchange of information; providing access to the national and international communications network (the Internet); sending information contained in an Internet site or Internet portal; press and information agencies.</p> <p>Class 39: Transport; packaging and storage of goods; travel arrangement.</p> <p>Class 40: Material processing.</p> <p>Class 41: Providing of education; training; entertainment; sporting and cultural activities; organization of sports competitions; sporting and educational sponsorship and patronage; providing sports facilities; providing golf facilities; rental of tennis courts; rental of sports equipment (except vehicles); providing on-line electronic publications, organising sporting events on-line via the Internet, games offered on-line via a computer network; television and radio entertainment; publication of books and journals; electronic publication of books and periodicals online; film production.</p> <p>Class 42: Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computers and computer software; legal or licensing services; design, development and installation of computer networks; providing of an e-commerce platform on the Internet; providing webspace on the internet; design, development and installation of software and programs designed to search for, select and/or store information available on the Internet or other networks; computer programming; leasing of access time to a</p>
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	<p>computer data base server centre; leasing access time for commercial transactions via electronic communications networks; styling and dress designing; fashion information.</p> <p>Class 43: Services for providing food and drink, namely bars, cafés, cafeterias, snack-bars, catering; temporary accommodation; providing campsite facilities, holiday homes, childcare facilities, guest house and hotel reservations.</p> <p>Class 44: Medical services; veterinary services; hygienic and beauty care for human beings, namely beauty salons, hairdressing salons, manicure services, massage; hygiene and beauty care for animals; agriculture, horticulture and forestry services.</p> <p>Class 45: Personal and social services rendered by others to meet the needs of individuals; security services for the protection of property and individuals; clothing rental, rental of evening wear and outfits.</p>
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### **Comparison of the respective goods and services**

34. The opponent's earlier mark is registered in respect of all but one of the 45 classes set out in the International Classification of Goods and Services for the Purposes of the Registration of Marks (the Nice Classification). That being so, the opponent's registration covers an extremely wide range of goods and services. The application seeks registration in a single class and for specific services.

35. The opponent's notice of opposition does not limit the ground of opposition in terms of the goods and services of its earlier registration on which it relies nor does it explain the opponent's position as to where, how or why the services covered by application in suit are considered to be identical or similar to those covered by the earlier mark. For this reason I do not intend to undertake a forensic analysis of each of the goods and services. A straight comparison shows that for the most part, most of the goods and services covered by the opponent's registration are in no way similar to the services for which registration is sought.

36. In its written submissions, the opponent makes reference to comments made in the registrar's preliminary indication regarding the respective goods and services. I have not read the preliminary indication and have no intention of so doing. A preliminary indication is no more than an opinion of a senior hearing officer and is made absent evidence and submission from the parties. It has no force in law. I have to consider the issues before me on the basis of the relevant law, taking into account the evidence and submissions which have been filed. Having done so, I will reach my own conclusion and provide an explanation of my reasoning behind that conclusion.

37. It seems to me that the opponent's strongest position lies with the services of the earlier mark as registered in class 44. The services to be compared are as follows:

**Applicant's specification**

Dentistry services

**Opponent's specification**

Medical services; veterinary services; hygienic and beauty care for human beings, namely beauty salons, hairdressing salons, manicure services, massage; hygiene and beauty care for animals; agriculture, horticulture and forestry services.

38. In relation to the comparison of services I bear in mind the comments of Jacob J in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

39. The opponent's specification covers a wide range of services. Some, (i.e. agriculture, horticulture and forestry services) are clearly not similar to the services for which the applicants seek registration. The opponent puts forward an argument that beauty salons, being providers of hygienic and beauty care services, also provide cosmetic dentistry services. Such evidence as has been provided does not persuade me in this regard and the evidence does not go to the relevant date in these proceedings. In my opinion, the services covered by the opponent's registration most worthy of further consideration are *medical services*.

40. In *Galileo Trade Mark O/269/04*, Professor Annand, sitting as the Appointed Person, stated:

“I believe that overlapping specifications satisfy the test for identical goods or services in Section 5(1) of the TMA. There is no necessity for such specifications to co-extend”.

41. The same must be true when considering whether services are identical or similar for the purposes of section 5(2)(b). In making my comparison, I have to consider the notional scope of services of the respective marks; I cannot be restricted to the actual use which the opponent may have made of its mark. Whilst dentistry is a discipline

dealing with maladies or deficiencies of the gums and teeth, it is a branch of medical science which forms a sub-category of the broader term medical services. I find therefore that the services in question are identical.

### **Comparison of the respective marks**

42. The earlier mark consists of a device of what seems to me to be a type of reptile and is said by the opponent to be a crocodile. It is presented right side-on, with two of its feet visible, its long snout wide open, with its two eyes visible on the top of its head and its long tail curled sharply towards the left side of its body. There are lighter areas shown along the back of the creature which have the effect of suggesting it to have a somewhat knobbly surface.

43. In their written submissions, the applicants claim that “crocodile/alligator images are in widespread usage” and is used by others in the dental services field. The suggestion I take from this is that devices of such creatures are of low distinctive character. I am not convinced that the average consumer would want to share the characteristics of reptiles but to the extent that they are known for having many functional, perhaps even efficient, teeth, the use of a reptile has what may be considered desirable associations with dental services. But the evidence filed falls far short of establishing that use of such a device is common in the trade, particularly at the relevant date.

44. I find that the earlier mark has a reasonable degree of inherent distinctive character. There is no evidence before me establishing that the opponent has used its mark in relation to either the wider term “medical services” or the more limited “dental services” and therefore I cannot say that it has added to its inherent distinctive character through use.

45. The mark applied for is a composite mark consisting of the words THE DENTAL PRACTICE where the words THE DENTAL appear above the word PRACTICE. To the left of these words is the somewhat smaller device of what again seems to me to be a reptile. Its mouth is shut though there is a suggestion of it having pointed teeth. The creature is viewed from the front/right side with just one eye visible. Again it shows what appear to be two feet and its tail also tends towards the left side and at right angles to its body. Extending underneath the full width of both the word and the device elements is a thick line border.

46. Whilst the effect of the device elements in the applicant’s mark cannot be discounted, they are plainly subsidiary to words THE DENTAL PRACTICE. It is often said that in the case of composite trade marks “words speak louder than devices”. That, in my opinion, is the case here.

47. The respective marks have a degree of visual similarity because they both show a reptilian device but that is the extent of the similarities. Each creature has clear and marked differences in presentation and the applicant’s mark contains the other elements which will not be overlooked. The applicants submit that the words THE DENTAL PRACTICE are distinctive because of the use of the definite article THE

rather than an indefinite article A. That appears to me to be a somewhat semantic argument. Conceptually, I find the marks to be very different. The applicant's mark is bound to bring to mind a practice dealing with dentistry. The earlier mark brings to mind a reptile.

48. I have reached the clear view that even considered in relation to identical goods, there is no likelihood of confusion between the respective marks. The visual, aural and conceptual differences between the two marks outweigh the similarities. In reaching this conclusion, I have taken into account the possibility of confusion arising from imperfect recollection. Dental services are highly personal in nature, and often require significant discussion regarding suitable care and treatment which is provided by qualified practitioners. I consider that the average consumer will generally take great care in trying to find and then choose a suitable practitioner whether the treatment sought is medical or cosmetic.

49. Nor do I consider that the average consumer who is aware of the differences between the respective marks would be confused through association. I do not consider the presence of a reptile in each mark to be sufficiently distinctive to drive the average consumer to the expectation that any two marks containing such a device must identify goods originating from the same undertaking.

50. The ground of opposition under section 5(2)(b) based on the opponent's earlier mark No. 2979581 therefore fails.

### **The objection under Section 5(3)**

51. As a result of Regulation 7 of the Trade Marks (Proof of Use etc.) Regulations 2004, Section 5(3) now reads:

“5.-(3) A trade mark which

(a) is identical with or similar to an earlier trade mark,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community Trade Mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

52. The opponent's objections under this head are based on six earlier trade marks, representations of which are set out in the Annex to this decision. In line with my previous comments, I do not consider the opponent's Community Trade Mark No. 2979581 to be similar to that of the applicants and therefore in respect of this mark, the opposition under section 5(3) falls at the first hurdle. I therefore go on to consider the position in respect of the five other marks relied upon by the opponent.

53. In order to succeed in respect of any mark relied on under this ground, the opponent must establish that it has a sufficient reputation.

54. Guidance on assessing whether the reputation requirement has been met was given in *General Motors Corporation v Yplon SA* Case C-375/97, where it was stated:

“23, In so far as Article 5(2) of the Directive (is concerned)...it is only where there is sufficient degree knowledge of that mark that the public, when confronted by the later trade mark, may possibly make an association between the two trade marks, even when used for non-similar products or services, and that the earlier trade mark may consequently be damaged.”

and:

“26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.”

55. Clearly the opponent is a large and successful company. It has significant levels of sales in the UK, primarily of clothing. But the evidence shows it to use a number of trade marks which include various crocodile devices many of which are used in conjunction with the word LACOSTE. The six earlier marks the opponent relies upon differ from each other. No evidence is filed as to the market share the opponent had either at the relevant date or within any given period under each or any mark. The sales figures provided are not, as I indicated earlier, apportioned to any individual trade mark relied upon. In short, the evidence does not establish that any of the individual trade marks relied on by the opponent has acquired independent recognition and reputation with consumers. The opposition brought under section 5(3) fails in respect of each of the marks relied upon and I do not go on to consider in any detail whether the respective marks are identical or similar. That said, for the benefit of any appellate tribunal, I would indicate that I do not consider any of the marks relied on by the opponent to be similar to the applicant's mark.

#### **The objection under Section 5(4)(a)**

56. Objection under this ground is based on four earlier marks, signs or rights and again I have set these out in the attached Annex to this decision. Section 5(4)(a) states:

“5. (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 an unregistered trade mark or other sign used in the course of trade, or...
- (b) ...”

57. A helpful summary of the elements of an action for passing off can be found in Halsbury's Laws of England 4<sup>th</sup> Edition Vol.48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v Borden Inc* [1990]RPC 3341 and *Erven Warnik BV v J Townend & Sons (Hull) Ltd* [1979] AC 731 is (with footnotes omitted) as follows:

The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

- (1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and,
- (3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of "passing off", and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.

Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that;

To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

- (a) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and
- (b) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

Whilst it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

58. I have already concluded that the respective marks are not similar. Whilst the opponent company may have a reputation in relation to the manufacture and sale of clothing, the evidence does not establish a reputation in respect of any particular trade mark it might use. The applicant provides dental services. Dental services are so different to clothing that in considering the likelihood of potential purchasers being deceived into believing that the services of the applicant are from or connected in some way with the opponent, I come to the conclusion that the average consumer of the goods and services in question, who is reasonably well informed and reasonably observant and circumspect, would not make that mistake. In my view the opponent has not substantiated its case and the ground of opposition under section 5(4)(a) fails.

### **Objection under Section 56**

59. The Act, as amended by the Patents and Trade Marks (World Trade Organisation) Regulations SI 1999/1899, provides as follows:

“56.-(1) References in this Act to a trade mark which is entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark are to a mark which is well-known in the United Kingdom as being the mark of a person who -

- (a) is a national of a Convention country, or
- (b) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country,

whether or not that person carries on business, or has any goodwill, in the United Kingdom.

References to the proprietor of such a mark shall be construed accordingly.

(2) The proprietor of a trade mark which is entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark is entitled to restrain by injunction the use in the United Kingdom of a trade mark which, or the essential part of which, is identical or similar to his mark,

in relation to identical or similar goods or services, where the use is likely to cause confusion.

This right is subject to section 48 (effect of acquiescence by proprietor of earlier trade mark).

(3) Nothing in subsection (2) affects the continuation of any *bona fide* use of a trade mark begun before the commencement of this section.”

60. Well known marks are brought within the compass of the term “earlier trade mark” by virtue of Section 6(1)(c) of the Act.

61. A person claiming protection under Section 56 does not have to carry on business here or have any goodwill in this country. There is nonetheless a requirement that the mark in question is “well-known in the United Kingdom ...”(Section 56(1)).

62. Kerly’s Law of Trade Marks and Trade Names (Fourteenth Edition) at 14-215 indicates that:

“It is to be expected that,..... the provision will be construed as a matter of ordinary language so to require that the mark is well-established amongst, and familiar to, the interested public and so, in short, that the mark is famous. The original wording of the Paris Convention contemplates the use of the mark by the proprietor and by the other party in relation to “goods”. TRIPS provides that Article 6*bis* of the Paris Convention shall apply, *mutatis mutandis*, to services. In any event the 1994 Act is not so limited, providing as it does its own definition of a well-known trade mark and the extent of the right in respect of goods or services where the use is likely to cause confusion.”  
(Footnotes omitted)

63. The goods in respect of which well known mark status is claimed are said to be “a wide variety of high quality goods centred on the clothing trade but extending widely over almost all areas of commerce including in particular: clothing, footwear, headgear, leather goods, sports equipment, bags, umbrellas, cosmetics, eyewear, watches and perfumery”.

64. Earlier in this decision, I accepted that the opponent is a large and successful company with significant sales in the UK. But the evidence shows sales in fairly limited areas of trade and falls well short of persuading me that any of the individual marks the opponent relies on is widely known to relevant consumer groups in this country as a result of advertising, awareness campaigns or other such promotional mechanisms. Therefore, the well-known mark claim does not get off the ground.

### **Costs**

65. The opposition as a whole has failed and the applicants are entitled to a contribution towards costs. The applicants have not been professionally represented in these proceedings and is, in effect, in the position of a litigant in person. It is appropriate to reflect this in the award of costs on the basis of Simon Thorley QC’s observations in *Adrenalin Trade Mark* O/040/02 where he said:



“It is correct to point out that the Registrar’s practice on costs does not specifically relate to litigants in person but in my judgement it could not be that a litigant in person before the Trade Mark Registry could be placed in any more favourable position than a litigant in person before the High Court as governed by the CPR. The correct approach to making an award of costs in the case of a litigant in person is considered in CPR Part 48.6.”

66. Part 48.6 of the Civil Procedure Rules referred to in the above passage provides as follows:

“48.6 – (1) This rule applies where the court orders (whether by summary assessment or detailed assessment) that costs of a litigant in person are to be paid by any other person.

(2) The costs allowed under this Rule must not exceed, except in the case of a disbursement, two-thirds of the amount which would have been allowed if the litigant in person had been represented by a legal representative.”

67. I therefore award costs on the following basis:

Considering Form TM7	£300
Filing Form TM8	£200
Filing of evidence	£500
Considering applicant’s evidence	£250
Written submissions	£250
Total	£1500

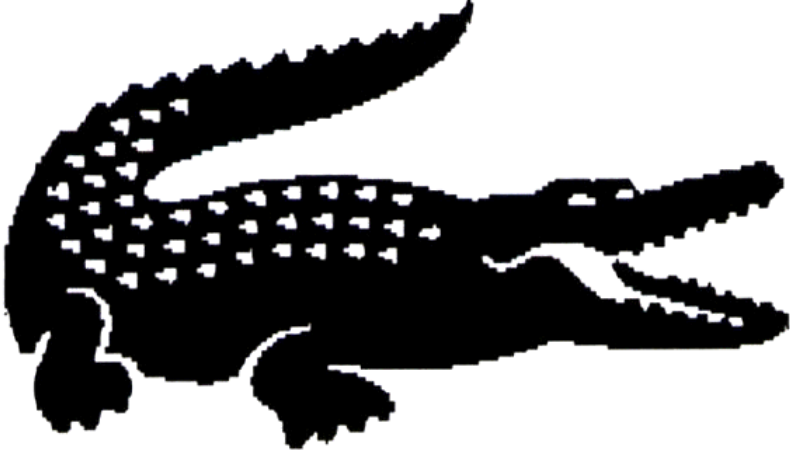
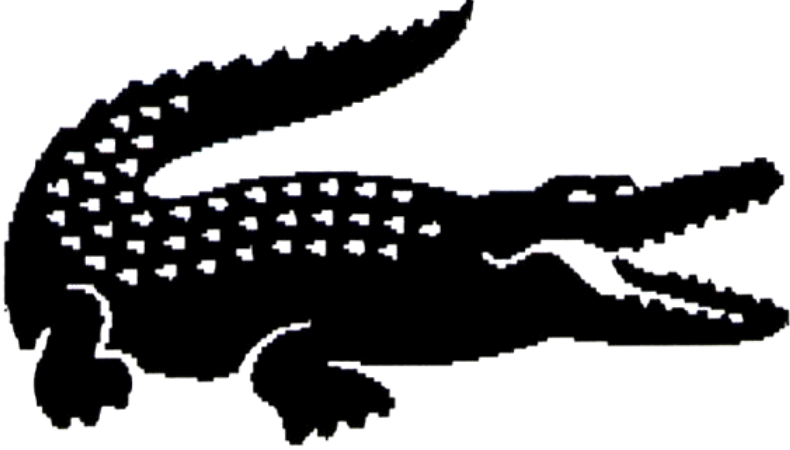
68. Bearing in mind the two thirds rule set out above, I order the opponent to pay the applicant the sum of £1000. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 24th day of May 2007**

**Ann Corbett  
For the Registrar  
The Comptroller-General**

**Annex:**

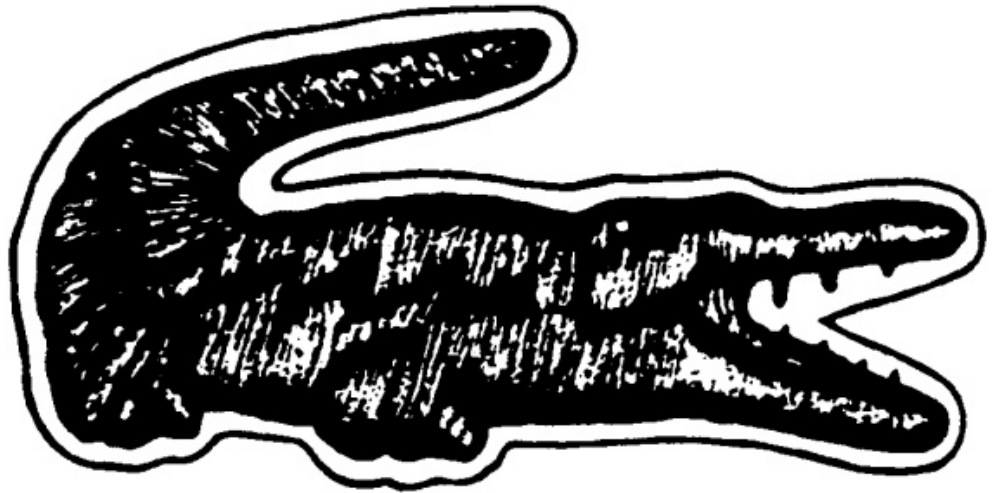
**Marks relied on by the Opponent**

<b>Section 5(2)(b)</b>	
<b>2979581</b>	
<b>Section 5(3)</b>	
<b>2979581</b>	

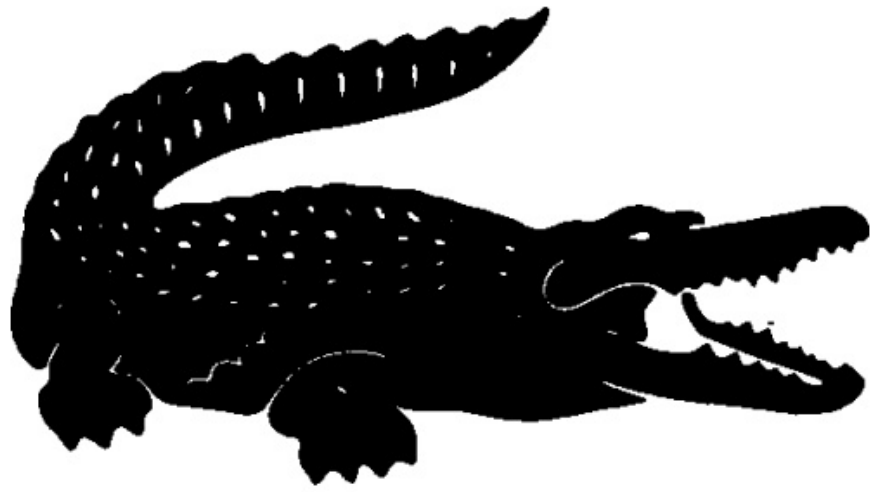
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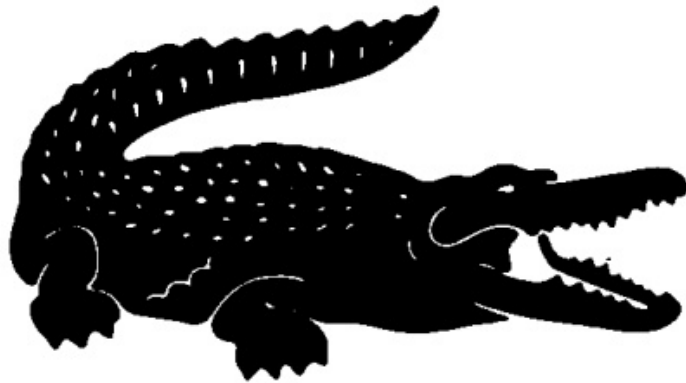
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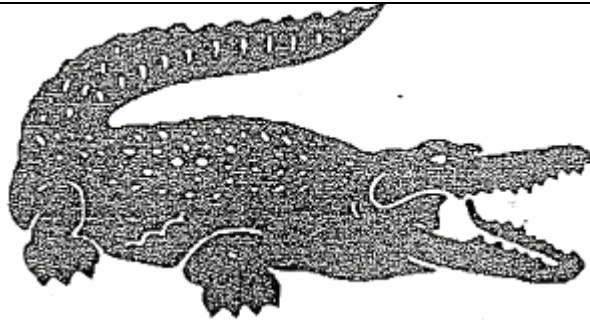


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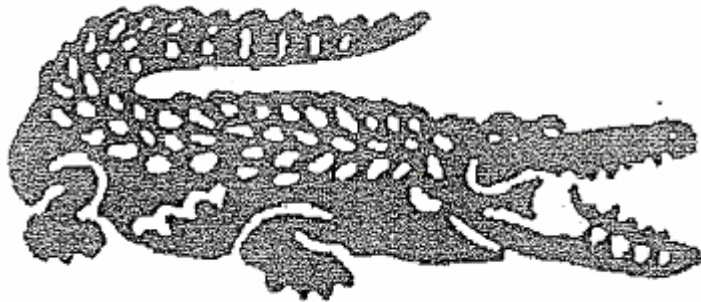


Section  
5(4)(a)

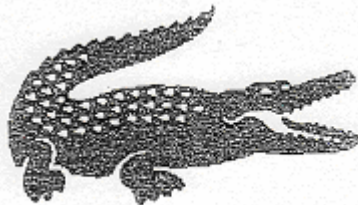
Mark 1



Mark 2



Mark 3



**Mark 4**

