

O-407-11

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATIONS 2350712 AND 2371857
BY GERARD DUGDILL TO REGISTER THE TRADE MARKS**

PINK RIBBON

AND

PINK RIBBON AWARDS

IN CLASS 16

**AND IN THE MATTER OF CONSOLIDATED OPPOSITIONS
THERE TO UNDER NOS 96674 AND 98490
BY BREAKTHROUGH BREAST CANCER, BREAST CANCER CARE AND
BREAST CANCER CAMPAIGN**

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By Gerard Dugdill to register the trade marks**

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IN THE MATTER OF consolidated oppositions thereto under Nos 96674 and 98490 by Breakthrough Breast Cancer, Breast Cancer Care and Breast Cancer Campaign

BACKGROUND

1. On 3rd December 2003 Gerard Dugdill (or rather, his predecessor in title, before an assignment to Mr Dugdill in 2006) applied to register the mark PINK RIBBON in relation to goods in class 16 which, following publication of the application, reads:

Class 16

Paper; printed matter; magazines, journals, books, periodicals, medical and scientific publications; literature relating to lifestyle and women's health; all included in class 16.

2. The application was allocated number 2350712 ('712) and was published in the Trade Marks Journal on 21st December 2007. On 25th March 2008, three charities:- Breakthrough Breast Cancer, Breast Cancer Care and Breast Cancer Campaign, ('the charities') jointly opposed the application.
3. The charities opposed on the basis of sections 5(1) and 5(2)(a) of The Trade Marks Act 1994 ('the Act'), citing the earlier, divided, mark below. I should say that the grounds of opposition in relation to 2337786A are sections 5(1) and 5(2)(a), whereas the sole ground of opposition in relation to 2337786B is section 5(2)(a):

Marks. Filing and registration dates	Goods relied upon under section 5(1) and 5(2)(a)
<p>UK 2337786A ('786A)</p> <p>PINK RIBBON</p> <p>14th July 2003</p> <p>4th January 2008</p>	<p>Class 16:</p> <p>Paper, cardboard and goods made from these materials, not included in other classes; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artist' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging; printers' type; printing blocks.</p>
<p>UK 2337786B ('786B)</p> <p>PINK RIBBON</p> <p>14th July 2003</p> <p>1st July 2005</p>	<p>Class 14</p> <p>Precious metals and their alloys and goods in precious metals or coated therewith; jewellery; precious stones; horological and chronometric instruments; clocks and watches; costume jewellery.</p> <p>Class 31:</p> <p>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.</p> <p>Class 35:</p> <p>Advertising; business management; business administration; the bringing together, for the benefit of others, of a range of goods comprising printed matter, printed publications, stationery, writing instruments, jewellery and goods of precious metals, articles of clothing, agricultural, horticultural or forestry products, natural plants and flowers, perfumes and toiletries through a mail-order catalogue, or by means of a website, or by means of telecommunications, or in a retail charity store, enabling customers to conveniently view and purchase these goods.</p>

	<p>Class 36: Insurance; financial affairs; monetary affairs; real estate affairs; charitable fund-raising services; credit card services.</p> <p>Class 41: Education; providing of training; entertainment; sporting and cultural activities; educational services in relation to the alleviation of cancer; organisation of conferences and seminars in relation to the alleviation of cancer; publication of books; texts and magazines.</p> <p>Class 42: Scientific and technological services and research and design relating thereto; information and advisory services on scientific information relating to alleviation and prevention of cancer.</p> <p>Class 44: Medical services; information and advisory services on medical information relating to alleviation and prevention of cancer.</p>
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4. Mr Dugdill filed a counterstatement and the matter progressed in the normal way with evidence and submissions. The opposition was subsequently consolidated with another opposition involving the same parties, the details of which are as follows.
5. On 31st August 2004 Mr Dugdill (or rather, as with '712, his predecessor in title, before an assignment to Mr Dugdill in 2006) applied to register the mark PINK RIBBON AWARDS in relation to goods in class 16 which, following publication of this application, reads:

Class 16

Magazines and periodicals relating to lifestyle and women's health

6. The application was allocated number 2371857 ('857) and was published in the Trade Marks Journal on 19th September 2008. On 19th December 2008 the charities opposed the application. The same, divided, mark, '786A and '786B, was cited, but unlike '712, the sole ground of opposition this time was section 5(2)(b). In this regard, the charities said the respective marks were

similar, given the word 'AWARD(S)' would be likely to be perceived as descriptive as the practice of making awards of merit by, and to, magazines is widespread and known. The charities also said the goods of their '786A mark were similar, relying on all the goods of their '786A specification.

7. As regards '786B, they said, again, the word AWARD(S) would be likely to be perceived as descriptive. However, they did not rely upon the goods of their '786B mark, only the services in classes 35, 36, 41 and 42.
8. Again, Mr Dugdill filed a counterstatement and the matter progressed to the normal evidence and submissions rounds, being later consolidated with the earlier opposition.
9. At this point it would be customary for me to summarise the evidence filed by the parties. In this case I do not consider it necessary as the evidence filed by both parties is largely unnecessary, being either in the form of submission and critique, or supplying me with material which, strictly speaking, need not have been put in formal evidence. I say 'largely' as this is not entirely the case, and consequently I shall refer to the relevant parts of the parties' evidence in due course, and only wherever there is material evidence of fact.
10. No hearing was requested by either party and so this decision is taken from a careful reading of the papers on file, including submissions.

DECISION

Preliminary issues

(i) Estoppel or other reliance on earlier proceedings

11. Before proceeding to my decision, I should mention, by way of background, that much of the parties' arguments and submissions are directed to an earlier decision of the registry involving the same parties and, in particular, the charities' earlier mark '786A ('the earlier proceedings').
12. '786A had been opposed by Mr Dugdill on the basis of section 3(6) and 5(4)(a) of the Act. Mr Dugdill was, in part, successful, both in relation to his claim under section 5(4)(a) and 3(6). In his decision in the earlier proceedings, BL O-328-07 dated 6th November 2007, the hearing officer agreed with Mr Dugdill that he had a goodwill at the material date under the sign 'PINK RIBBON', but in relation only to magazines. As a consequence the terms 'printed matter and printed publications' were removed from the charities' application in class 16. Specifically, the hearing officer said at paras 57 and 58:

“57.....On the other hand the applicants do not concede the position in relation to the balance of the goods in the specification which for the record are:

“Paper, cardboard and goods made from these materials, not included in other classes; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artist materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging; printers’ type; printing blocks.”

58. Although these goods appear in the same Class of the international classification system they are generally [sic] same way removed from magazines and printed matter. The opponent’s trade is a very narrowly directed one. I can see no reason why, given the accepted allusive nature of the sign PINK RIBBON in the charity field, the opponent’s goodwill should be taken to extend to the areas of trade represented by the balance of the Class 16 specification. The result is that the opposition succeeds in relation to printed matter and printed publications but fails in relation to the remaining class 16 goods.”

13. This decision was not appealed by either party. The parties are, however, divided as to what effect these comments should have on this decision. In fact, Mr Dugdill goes further, and says the decision in the earlier proceedings creates an ‘estoppel’, preventing the charities from later contending the goods are identical or even similar (para 4 of Mr Dugdill’s letter dated 3rd April 2009).

14. Oppositions before the registry do not, as a rule, give rise to either cause of action or issue estoppels. As regards the former, there is doubt that an application for registration or a related opposition represents a ‘cause of action’ in the first place. As regards the latter, the co-existence in the legislation *both* of opposition and invalidity proceedings indicates that the principle of *res judicata* does not apply to give *finality* to the determination of the issue of registrability in an opposition. Thus, there can be no issue estoppel either. As to, finally, the question of any possible ‘abuse of process’, since the legislation does not preclude an unsuccessful opponent from returning to seek a declaration of invalidity, the circumstances would need to be ‘unusual’ to justify holding that a party who did take advantage of the second opportunity provided by the legislation was abusing the process.¹

15. All of the above assumes, in the first place, the registry has actually given an express ‘ruling’ on the matter that is raised a second time, in connection either with registry or court proceedings. In this case, there is, in any event, no express finding by the hearing officer to the effect that the goods and

¹ This whole paragraph is based on the findings in *Special Effects Ltd v L’Oreal SA* [2007] EWCA Civ 1

services of Mr Dugdill's applications are dissimilar, or otherwise not similar, to those remaining goods of the charities' application.

16. The issue before the hearing officer was the extent to which Mr Dugdill's prior rights, in relation only to magazines, should impinge upon or succeed in relation to the goods then claimed by the charities. The hearing officer concluded Mr Dugdill had prior rights in a 'narrow field of activity', and as a consequence he removed 'printed matter and printed publications' from the charities' specification.
17. The hearing officer does not provide any rationale for his opinion that certain goods were 'some way removed' from printed matter and publications, and presumably he had no argument before him in relation to this question. He simply had to decide what terms to remove from the charities' specification, given Mr Dugdill's prior rights in magazines.
18. The task and nature of the question before me are different. I have to decide from a notional and objective perspective, and assuming fair use of the respective marks on the goods and services of the respective specifications, whether there is a likelihood of confusion. This is a recognised multifactoral assessment involving many factors, only one of which is similarity of goods or services. As a notional assessment, it is not relevant, for example, that Mr Dugdill's magazine is, in fact, a 'glossy lifestyle' magazine. The specifications before me do not contain the words, 'glossy, lifestyle magazines', and it is only what is specified that matters.
19. In summary, on this matter, I will of course, give due regard to the opinion of the hearing officer that he believes the remaining goods of the charities' specification to be 'some way removed' from the prior rights established by Mr Dugdill. In doing so however, I must stress, again, I am not bound by that opinion, and neither am I otherwise even obliged to factor in that opinion into my own analysis.
20. I will, as a consequence, approach the question of similarity of goods and services afresh, in the context of my overall assessment of likelihood of confusion.
21. Finally on this question, and at a more general level, I should stress that the fact that the hearing officer found that Mr Dugdill had prior rights in relation to magazines, and these were successfully relied upon against the charities' application in the earlier proceedings, expressly does *not* give grounds, or any presumption, to find that Mr Dugdill is entitled to his own registration in relation to the scope and extent (ie the goods for which he was found to have had a protectable goodwill) of those prior rights. As a general principle, signs for which a protectable goodwill arises are not, thereby, necessarily entitled to registration.

(ii) Reliance on withdrawal of '944 by opponents

22. The second of my preliminary points deals with Mr Dugdill's reliance upon the withdrawal of another application 2471944 ('944), filed on 9th November 2007 by the charities for the words 'PINK RIBBON' in respect of "printed matter and printed publications, and all other goods in this class" in class 16. This application was subsequently (voluntarily) abandoned by the charities. Mr Dugdill says this application and subsequent abandonment, "helped show there are rights separately residing in printed matter and printed publications which, as per the previous decision, the opponent ultimately accepted it did not possess" (para 13 of his second witness statement dated 16th May 2011). For their part, the charities contend that the abandonment of this application in no way prejudices these proceedings and its filing in the first place was undertaken immediately following the decision in the earlier proceedings, "so as to provide the charities with a back up position while they were considering the decision in the earlier opposition." (para 12 of Linda Harland's witness statement dated 27th August 2009).

23. This application was filed by the charities, purely as a contingency following the decision in the earlier proceedings. As such, its filing and subsequent abandonment have absolutely no effect on my decision in these proceedings.

(iii) Amendment by applicant of specification of '857 during examination

24. Finally, the third of my preliminary points deals with the claim by the charities that Mr Dugdill's '857 application was amended during its examination phase in the registry to remove certain terms, these being, "paper, printed matter, journals, books, medical and scientific publications and literature" all in class 16, and "entertainment services, organisation of competitions, organisation of awards ceremonies and shows, presentation and live broadcast events, event and party planning" all in class 41. It is likely, say the charities, under the practice at the time, that such goods and services had been removed by Mr Dugdill at the request of the registry on the basis they were considered similar to the goods of the charities' own mark. That being the case, the charities say such a rationale can be applied in these proceedings.

25. As to how or why the specification was restricted, voluntarily or otherwise, is also going to have no effect on these proceedings. The deliberations and findings involved in the ex parte administrative examination of cases is not binding on me, or even persuasive. It would appear, in any event, that part at least of the restriction offered (or allowed) by Mr Dugdill was occasioned not because of findings of similarity, but because, in the ex parte hearing officer's mind, he considered the mark 'PINK RIBBON AWARDS' to be prima facie non-distinctive for certain goods in class 16 and services in class 41, a finding which of course has nothing to do with similarity of goods and services.

26. Having disposed of these preliminary matters I can now proceed to my substantive decision.

‘712

27. The opposition is founded upon sections 5(1) and 5(2)(a) of the Act which read:

5. - (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 because –

(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)

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

28. The earlier trade marks in this case qualify as earlier trade marks with a filing date before the date of application. Moreover, neither are subject to proof of use provisions as their dates of registration are within the relevant 5 year period prior to the date of publication of the application. It is clear that the charities’ best case lies in their 786A mark as that has goods in class 16 and so I intend to focus on that earlier mark first.

29. Furthermore, as the charities note in their submissions they must be presumed to be validly registered in accordance with section 72 of the Act, there being no outstanding proceedings in respect of either earlier mark.

Comparison of marks

30. It is beyond dispute that the respective marks are identical.

Comparison of goods

31. In assessing the similarity of the goods, it is necessary to apply the approach advocated by case law and to take account of all the relevant factors relating to the goods in the respective specifications. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at para 23 of the judgment:

'In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature and their method of use and whether they are in competition with each other or are complementary.'

32. Other factors have been identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281, such as the nature of the users and the channels of trade.
33. It is important to recognise that even though the factual evidence on similarity is non-existent, I nevertheless have the statements of case, submissions and am able to draw upon commonly known facts. Mr Geoffrey Hobbs QC sitting as the Appointed Person said in *Raleigh International trade mark* [2001] R.P.C. 11, at para 20, that such evidence will be required if the goods or services specified in the opposed application for registration are not identical or self-evidently similar to those for which the earlier trade mark is registered. But where there is self-evident similarity, and especially in relation to everyday items, evidence may not be necessary. He also stated that the tribunal may, in an appropriate case, consider the question of similarity from the viewpoint of the notional member of the relevant purchasing public.
34. I should also mention a further case in terms of the application of legal principle, and that is the European Court of First Instance ('CFI') (now the General Court) decision in *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) ("Meric")* Case T-133/05, where, at para 29, it is stated:
- "In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42)."
35. The respective goods to be considered are as follows:

Charities' goods (' 786A)	Mr Dugdill's goods
<p>Class 16:</p> <p>Paper, cardboard and goods made from these materials, not included in other classes; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artist' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging; printers' type; printing blocks.</p>	<p>Class 16</p> <p>Paper; printed matter; magazines, journals, books, periodicals, medical and scientific publications; literature relating to lifestyle and women's health; all included in Class 16.</p>

36. 'Paper' is self evidently identical.

37. The charities have "instructional and teaching material (except apparatus)", and this term will clearly cover, in my view, "journals", "periodicals" and "medical and scientific publications", all of which have a primarily teaching and instructional nature and intended purpose. In my view these respective goods are identical.

38. The broader terms: 'printed matter', 'magazines', 'books' and 'literature relating to lifestyle and women's health' may have a nature and intended purpose beyond that of teaching or instructional, and, for example, be intended primarily for amusement or entertainment. It is true then that instructional and teaching material may be distributed through specialist publishers and suppliers, whereas printed matter intended for pure entertainment being available through high street retailers such as, eg W H SMITH or WATERSTONES. However, that is not to say that such distribution channels are mutually exclusive necessarily, since W H SMITH and WATERSTONES also handle teaching and instructional materials.

39. Case law such as *Meric*, referred to above and, eg *Galileo* (BL O-269-04), a decision of the Appointed Person, is clear that it is not necessary that the specifications of the respective marks 'co-extend', and it is sufficient for a finding of identity that they 'overlap'. That is to say, for example, that a term used in the specification of the earlier mark is covered by a broader, 'portmanteau' term in the later application, (and vice versa); this is the case here. The charities' more limited term "instructional and teaching material" is caught within the broader terms 'printed matter', 'magazines', 'journals' ,

books, periodicals and medical and scientific publications, all of which can comprise instructional and teaching material and, accordingly I find to be identical to the charities' term 'instructional and teaching material'. That said, I am not convinced the 'overlap' principle is applicable in respect of a much narrower term, as in 'literature relating to lifestyle and women's health'. which, given its normal, everyday meaning would not necessarily, and at first sight, be considered to be 'instructional and teaching material'. Having said that, such literature can be in the form of 'instructional and teaching material', and moreover can be sold in the same outlets such as, eg WATERSTONES or WH SMITHS as above, and on that basis I find that 'literature relating to lifestyle and women's health' is similar to 'instructional and teaching material'. So, to conclude, and applying the relevant case law, I find also that the remaining goods specified by Mr Dugdill are either identical or similar to "instructional and teaching material (excluding apparatus)", covered in the charities' specification.

40. For the avoidance of any doubt I would also find that 'goods made from paper' in the charities' specification are identical to all the goods specified by Mr Dugdill. Whilst it is conceivable that 'goods made from paper' would also include plain paper items such as certain items of stationery and so forth, without any printed content, it is established, as I have said, that the respective terms need not be co-extensive, and goods made from paper plainly includes printed content as well. In this regard, all the items specified by Mr Dugdill can, and most usually are, literally, made from paper. At this point it is appropriate to acknowledge that the broad interpretation I give to 'goods made from paper' is, on the face of it, at odds with the implicit approach taken by the hearing officer in the earlier proceedings, but I have already explained the, essentially, non-binding nature of his decision and the different nature of the question before me. If I am wrong about this, I would nonetheless find that the goods in Mr Dugdill's specification are nonetheless similar to 'goods made from paper' as, even if I were to take a narrow view of what 'goods made from paper' comprise, in terms say, just of stationery 'type' items, these are nonetheless sold alongside the categories of printed material covered by Mr Dugdill. That is to say, in a retail outlet such as W H Smith, and even in large supermarkets such as ASDA, SAINBURY'S or TESCO, it is common to see stationery items alongside books and magazines. This factor, along with the natures of the respective products, renders, them similar at the very least if not, as I have primarily found, identical.

41. These findings inevitably lead me to the conclusion that the opposition against the '712 mark is entirely successful under section 5(1) of the Act, relying upon the earlier mark, '786A. I have no need, then, to consider the alternative ground under section 5(2)(a) in relation to '786A, or indeed the alternative ground under section 5(2)(a) in relation to '786B.

'857

42. This application is for the mark PINK RIBBON AWARDS. The opposition is brought under the sole ground of section 5(2)(b) of the Act, which reads

“(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.”

43. This mark is, self-evidently, not identical to the earlier mark PINK RIBBON, and this is why the ground of opposition under section 5(2)(b) applies. I will consider this ground in relation to the earlier mark '786A first, as the specification of this mark is, at least, in the same class as '857, and is thus likely to present the charities with their best case.

Comparison of the goods

44. The respective goods are as follows:

Charities' goods (' 786A)	Mr Dugdill's goods
<p>Class 16: Paper, cardboard and goods made from these materials, not included in other classes; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artist' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging; printers' type; printing blocks.</p>	<p>Class 16 Magazines and periodicals relating to lifestyle and women's health</p>

45. Consistent with my findings in paras 37-40 above, I find the respective goods, that is to say, “instructional and teaching materials (except apparatus)” and “goods made from paper” to be identical or similar to Mr Dugdill’s goods.

The average consumer and nature of the purchase

46. Further, in my analysis of likelihood of confusion I need to assess exactly who the average consumer is in respect of the parties’ goods and the levels of attentiveness in the purchase of those goods. The average consumer for both parties’ goods will be, broadly speaking, the general public. In relation to Mr Dugdill’s goods, the predominant audience and consumer will be women. That same group will also be consumers for the charities’ goods and thus the two will overlap substantially. I appreciate of course that some of the charities’ goods will also be bought by men, businesses, schools or other educational establishments, but the general public are consumers and hence there is some overlap in the identities of the average consumer.

47. The nature of the respective purchases will not be of the highest level of circumspection, as for example, the purchase of a car or high value piece of jewellery may be. Nevertheless the average consumer will at least be averagely circumspect in their selection process. I will factor these observations into my assessment below.

Comparison of marks

48. The respective marks to be considered are as follows:

The charities’ mark	Mr Dugdill’s mark
PINK RIBBON	PINK RIBBON AWARDS

49. The case law makes it clear I must undertake a full comparison (taking account of visual, phonetic and conceptual similarities and dissimilarities), from the perspective of the average consumer. Both marks need to be considered in their totalities and the overall impression conveyed, taking account , if appropriate, of distinctive and dominant elements.

50. Visually, the charities’ mark comprises the two, recognisable, words ‘PINK’ and ‘RIBBON’ in that order. These words are shared by Mr Dugdill’s mark in the same order but his mark has the additional word ‘AWARDS’ at the end. Taking the similarities and dissimilarities into account I find the marks to be visually similar at least to a relatively high degree.

51. Aurally, the charities' mark will be pronounced 'P-INK RIB-ON' and Mr Dugdill's 'P-INK RIB-ON A-WARDS'. Again, taking the similarities and dissimilarities into account I find the respective marks to be aurally similar at least to a relatively high degree.
52. Conceptually, both marks share the recognisable words, 'PINK' and 'RIBBON', in that order, and that will be the overriding 'concept' or idea evoked by both marks, namely that of 'pink ribbon'. The word AWARDS in Mr Dugdill's mark, as a matter of pure linguistics, is conditioned and qualified by the words that precede it, and thus it is the concept of PINK RIBBON that serves in both parties' marks to create, as I have noted, the overriding concept. But because Mr Dugdill's mark also has the word 'AWARDS', I am unable, as a result, to say the marks are conceptually identical, but they are nevertheless similar to a high degree.

Distinctive and dominant elements

53. Neither mark has a stand out dominant (meaning, visually outstanding) feature. Rather, they will each be appreciated instantly as a whole. I need, however, to bring my individual findings above into a finding of overall similarity of marks, to include, if necessary, an analysis of any distinctive elements. In my analysis of conceptual similarity I said it was the shared concept of 'PINK RIBBON' which created the common, 'overriding' concept behind both marks. In this regard, I do not believe that the word 'AWARDS' in Mr Dugdill's mark varies, undermines or otherwise detracts from that underlying 'concept'.
54. At this point I understand Mr Dugdill to accept that there is natural 'linkage' in the average consumer's mind as between magazines in general and awards they may sponsor or otherwise become involved in. The charities draw attention, for example, to the counterstatement by Mr Dugdill in relation to this application where he says, at para 3, that, "The PINK RIBBON awards have been developed as an additional concept by the magazine from 2004, to award achievement in beating breast cancer." Furthermore, at para 7 Mr Dugdill says, " The word "Awards"..... refers to the awards scheme run by the magazine. *As the opponent says, it is natural for magazines to run awards schemes.*" (my emphasis). To further reinforce this connection, Exhibit GRD8 to Mr Dugdill's witness statement dated 16th May 2011, comprises material illustrating the connection between his own magazine and the awards with which it is associated.
55. Given Mr Dugdill's stated, general position on the connection between magazines and awards, I believe that, notwithstanding his mark is not in respect of awards ceremonies *per se*, it is entirely reasonable to conclude the word 'awards' in relation to magazines would be seen by the average consumer as a descriptive component, without distinctive impact apart from

the words which precede it. That is to say, it would be a 'natural extension' of a magazine's primary function; a means of generating further goodwill and publicity, and in overall consequence, as far as the average consumer is concerned, the word 'awards' would thus, as the charities say, possess only descriptive value. Thus the core distinctive component of the later mark is the words 'PINK RIBBON'.

56. An assessment of the distinctive components is necessary in reaching a conclusion on the overall similarity of marks. Based on that assessment and the assessments in relation to visual, aural and conceptual similarities above, I find that, overall, the respective marks are similar to a high degree. This must be the case where the marks share the same predominant, distinctive component, PINK RIBBON, and only differ with the additional word, AWARDS, in the later mark. This finding will be factored into my global assessment of likelihood of confusion below.

Distinctiveness of the earlier mark

57. Before proceeding to bring all my findings together in an overall global assessment, I need to make an assessment of the distinctiveness of the earlier mark which will also feature in my overall global assessment below. As both parties appreciate, this exercise is one of '*grading*' the earlier mark in terms of its distinctiveness. An invented word having no derivation from known words is, in its inherent characteristics, very high on the scale of distinctiveness, KODAK of course being the prime example. At the other end of the spectrum, known words having laudatory or descriptive meaning will be low on the scale of distinctiveness.

58. The words 'PINK RIBBON' in relation to both parties' goods must rank as being, *prima facie*, high on the scale of distinctiveness. That is to say that in and of themselves they say nothing obviously laudatory or plausibly descriptive in relation to those goods and on that basis alone the *inherent* distinctiveness of the earlier mark is high.

59. Whatever the level of inherent distinctiveness however, Mr Dugdill asks me to attribute a low level of distinctive character to the words 'PINK RIBBON', given what he terms 'widespread' and 'generic' use of those words by a large number of charities in the UK (para 6 of his letter dated 3rd April 2009). I note further that some apparent support for Mr Dugdill's contention may be found in the ex-parte hearing officer's views recorded at para 25 above, but, as I have said, such views are not binding on me, or even persuasive.

60. Mr Dugdill says, by way of background, that in the earlier proceedings the charities contended that the 'PINK RIBBON', as a symbol of breast cancer awareness, was launched in the USA in 1991 and has been used widely in the UK by breast cancer charities since the mid -1990's. The charities were,

by 1999, already using the concept of a pink ribbon to promote breast cancer awareness. Given this background of 'widespread and generic' use in connection with breast cancer awareness by a number of charities, Mr Dugdill says it cannot be contended that the earlier mark in this case is, in any way, possessed of high distinctive character.

61. In a normal case, significant use by the opponent of an earlier mark can sometimes be said to have resulted in enhanced distinctiveness, especially of a mark with a low degree of inherent distinctive character. In this case, however, the claim by Mr Dugdill is that use by many charities and concerns has *reduced* the distinctiveness of the words 'PINK RIBBON'. Such use has, in effect, assumed almost a generic level.

62. In my opinion the words 'PINK RIBBON', as well as the recognised device, not the subject of these proceedings of course, have become almost 'emblematic' in the cause of breast cancer awareness as far as the average consumer is concerned. However, being 'emblematic' does not in this case, equate to 'reduced distinctiveness', still less, genericism. On the contrary, as far as the average consumer is concerned they are not necessarily aware that several concerns are using the words and symbol, still less, who those concerns may be; what matters to them is the immediate association between the cause of tackling breast cancer and words and symbol. In my opinion, the inherently high distinctiveness of the words PINK RIBBON is not diminished by the 'widespread' use made of them by breast cancer charities. I would add that, even if Mr Dugdill were correct that the earlier mark only has weak distinctiveness, it is well established that such a finding would not, of itself, preclude a finding of likelihood of confusion, bearing in mind all the *other* factors in the global assessment.²

63. As far then, as my assessment of distinctiveness is concerned I am not persuaded that the level of inherently high distinctiveness I gave to the earlier mark is affected by so-called widespread or generic use by others. On that basis, I find then that the earlier mark has an inherently high level of distinctiveness for the goods at issue in Class 16, unaffected by so called 'widespread' use by others.

Likelihood of confusion

64. In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the Court of Justice of the European Union ("CJEU") in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723,

² See eg *Air Products and Chemicals v OHIM* - T- 305/06 to T-307/06 (GC) –in particular paras59 and 60.

Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P* (LIMONCELLO). It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, 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 of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;
- (f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either *per se* or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) 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;

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.

Conclusion

65. At this point I need to bring my findings together in an overall global assessment of likelihood of confusion. I have found the respective marks to be similar to a high degree. I have found the respective goods to be identical, or similar. I have found the earlier mark to be inherently highly distinctive, and I have made observations on the identities of the respective average consumers and the nature of the purchase.

66. Bearing in mind all these findings I find that there is a likelihood of confusion in relation to the charities' earlier '786A mark and the opposition accordingly succeeds in its entirety under section 5(2)(b).

67. In the circumstances I have not found it necessary to separately consider, the claim under section 5(2)(b) in relation to the charities' earlier '786B mark.

Costs

68. The charities have been totally successful in the consolidated oppositions. Accordingly, they are entitled to a contribution towards their costs. I do not understand the charities to seek an award off the normal scale although they ask that the preliminary indication in their favour be taken into account in any award. Mr Dugdill says, in response, the preliminary indication was purely 'administrative', and notes that whilst a preliminary indication was given in opposition 96674 (his mark 'PINK RIBBON'), no such indication was given in relation to opposition 98490 ('PINK RIBBON AWARDS') on the stated basis that the positions of the parties are, "so evenly balanced that it would be inappropriate to issue a preliminary indication".

69. In the circumstances I do not propose to uplift my award as a consequence of the preliminary indication, and instead I intend to follow the normal scale. Accordingly, I award the charities the sum of £1600 as a contribution towards their cost of the proceedings. The sum is calculated as follows:

1. Statutory opposition fees (x2) - £400
2. Filing statements of case and considering counterstatements – (x2) - £400

3. Filing evidence and considering other parties' evidence (x2, prior to consolidation) - £ 300
4. Filing submissions - £500

Total £1600

70. I order Mr Gerard Dugdill to pay Breakthrough Breast Cancer, Breast Cancer Care and Breast Cancer Campaign the sum of £1600. The sum should 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 21 day of November 2011

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

