

O-400-13

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 2588021
BY TRIBECA LTD
TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 18:**



AND

OPPOSITION THERETO (NO 102847) BY JOULES LIMITED

The background and the pleadings

1) Tribeca Ltd (“Tribeca”) applied for the trade mark the subject of this dispute on 15 July 2011; it was subsequently published in the Trade Marks Journal on 7 October 2011. The mark and the goods for which registration is sought are:



Class 18: Articles made from leather or imitation leather; small leather goods; articles of luggage; bags; cases; attache cases; briefcases; suitcases; trunks; travelling bags; overnight bags; holdalls; handbags; shoulder bags; casual bags; rucksacks; backpacks; school bags; satchels; gym bags; tote bags; shopping bags; bags for clothing; shoe bags; beach bags; bags for strapping to the body; hip bags; pouches; purses, wallets, billfolds; card cases; pass and passport cases; key fobs; key cases, luggage tags, and coasters, all of leather or imitation leather; umbrellas.

2) The above trade mark is opposed by Joules Limited (“Joules”) under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). In respect of the first two of these grounds, a single earlier trade mark is relied upon, namely, UK registration 2507813, which was filed on 3 February 2009 and which completed its registration procedure on 4 September 2009; the mark and the goods/services for which this earlier trade mark is registered are:



Class 18: Leather and imitations of leather, and goods made of these materials and not included in other classes; hat boxes of leather or imitation leather; trunks and travelbags; umbrellas, parasols and walking sticks; bags; backpacks; briefcases; game bags; garment bags; handbags; key cases; purses; rucksacks; schoolbags; walking stick seats; walking sticks.

Class 25: Clothing, footwear and headgear; hats and hat frames; caps; belts; outerclothing and overcoats; swimwear; underwear.

Class 35: The bringing together, for the benefit of others, a variety of goods, enabling customers to conveniently view and purchase those goods in a retail clothing, footwear, headgear and accessories store; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from a clothing, footwear, headgear and accessories catalogue by mail order or by means of telecommunications.

There is no dispute that the above mark constitutes an earlier mark as defined by section 6 of the Act. Neither is it in dispute that the earlier mark is not subject to the requirement to prove genuine use; the earlier mark may be taken into account in these proceedings for all of its goods and services as registered.


3) Under section 5(4)(a) of the Act, Joules relies on the law of passing-off. However, the sign it relies upon (which it claims to have used since February 2011) is different to the trade mark detailed above, namely:



4) Tribeca filed a counterstatement denying the grounds of opposition. It denies that the marks are similar enough to cause confusion or to create a link between the marks. As part of the defence, reference is made to the earlier mark having weak distinctive character. Both sides filed evidence. A hearing took place before me on 2 August 2013 at which Tribeca was represented by Mr James St Ville, of counsel, instructed by Joshi & Welsh; Joules was represented by Mr Benet Brandreth, also of counsel, instructed by Keltie LLP.

The evidence

Joules' evidence

5) A witness statement is provided by Ms Joana Munce, a trade mark attorney at Keltie LLP. Her evidence informs the tribunal that a third parties' International registration which designated the EU (no. 1024428 for the mark: ) which Tribeca informed Joules it would rely upon (to support its claim of weak distinctiveness) is owned by a company which has no stores in the UK. A print from the trade mark owner's website is provided in support. Ms Munce also explains that she assisted Joules in the preparation of its evidence and she provides some print-outs from Joules' website which show bags/wallets etc, some of which feature one or other of the trade mark or sign it relies upon. However, as this evidence lacks date context, its probative value is limited.

6) A witness statement is also provided by Mr Marc Lombardo, Joules' financial director. His main points are as follows (I will refer, as Mr Lombardo does, to

Joules' trade mark as the "sitting hare" and the sign it relies upon under section 5(4)(a) as the "running hare"):

- Joules has been a clothing (and accessories) manufacturer since 1994.
- Joules has developed a "multi-channel" sales network selling through its own retail stores (which now stands at 60) and also through independent stockists including John Lewis and Harrods.
- The word JOULES has always been used as an indication of trade origin, but additional marks have been adopted to supplement its core brand.
- In 2008 Joules wished to adopt a logo to enhance its country/lifestyle image. A silhouette of a hare was chosen as hares are emblematic of the countryside; from the context of Mr Lombardo's evidence, it is the sitting hare which is being referred to.
- The sitting hare logo was first used in Spring 2009, initially on men's polo shirts, shirts and gilets. Mr Lombardo states that it was quickly decided to use it on a wider range of clothing and accessories. It is estimated that "today" (Mr Lombardo's evidence was given on 31 May 2012) it is used on 87% of Joules' goods (either applied directly or featured on labels).
- Between 2009 and 2011 sales per year of products bearing the sitting hare logo ranged between £28 million and £50 million. Promotion (it is stated that the sitting hare logo has featured across all marketing material) has ranged between £2.9 million and £3.6 million per year in the same period.
- In an Internet search conducted after the relevant date for the search term joules hare logo, over 1.5 million hits were revealed. The first three pages are provided, some include text referring to Joules' [sitting] hare logo.
- Joules' [sitting] hare logo has been referred to in press articles (Exhibit TJ5). The only press articles which clearly fall before the relevant date do not mention the logo.
- The running hare logo was adopted in December 2011 for certain marketing and promotional activities. It has been used on goods such as gift wrap and labels and certain clothing and lifestyle goods.

Tribeca's evidence

7) This comes from Mr Duncan Welch, a trade mark attorney at Joshi & Welch. Part of Mr Welch's evidence relates to Tribeca's claim that the earlier mark (and devices like it) have weak distinctiveness. Various exhibits are provided as follows:

- DAW 1 – This contains a “few [4] examples” of UK trade mark registrations which contain animals in shadow form. One relates to the well-known Playboy bunny (class 18), one consists of a picture of what is either a lion or a dog (classes 25 & 35), one contains a dog facing forward (class 25) and the final example contains a dog facing the side (classes 18 & 25).
- DAW 2 – This contains a “few [4] examples” of other marks in use by third parties containing lagomorphs. The examples are: prints from the website of a company called The Black Rabbit (which also depicts a leaping black rabbit) which sells children's clothes (and is in its sixth season); a print from the website of a company called Limin clothing, which features as a logo the torso of a rabbit (the website sells clothing and appears to be UK based); a print from the Café Press website of a t-shirt which is described as a Hare Tee and which features a hare on the front (this is not obviously trade mark use); a print from Amazon.co.uk of a shoulder bag featuring the Playboy bunny referred to earlier.
- DAW 3 – What appears to be a copy of the trade mark search conducted prior to the filing of the application in suit. There are around 20 trade marks which contain a rabbit or hare, sometimes with additional words, sometimes with additional animals.
- DAW 4 – This is a copy of a decision of OHIM's opposition division concerning case B901886 which involved representations of basketball players in silhouette form which, on the facts before them, the opposition division concluded were different due to the differences in pose etc. being sufficient to overcome any visual similarities that existed on a more general level.
- DAW 5 – Prints from the website of the Hare Preservation Trust which contain, unsurprisingly, pictures of hares. The trust also has a logo which features a leaping hare and merchandise which depicts this logo.

8) Mr Welch then provides information about Joules. He highlights that Joules' principal activities (as listed in Joules accounts filed at Companies House) are “design and sale of lifestyle clothing and related accessories” (2011 & 2012) and “the design and sale of lifestyle and sports clothing and related accessories (2009). The opening listing page for Joules on Companies House categorises them as “wholesale of clothing and footwear; retail of clothing in specialized store”.

9) Mr Welch then provides evidence in relation to the applicant's use of its mark. This can be summarised as:

- Tribeca's hare logo is used in relation to bags and leather goods. The logo is primarily used in association with the trade mark AUBREY.
- Tribeca has sold "a large number of bags" (currently just over 31,000) and marketing expenditure is around £130,000.
- Tribeca sells in stores such as John Lewis, Debenhams etc. Some prints from the website of Debenhams are provided which show various goods; when one of the products is clicked upon the product page shows the logo and the word Aubrey prominently above the product description.
- Joules also sells via John Lewis (as does Tribeca); prints of Joules products on the website of John Lewis are provided which feature the word JOULES – there is no prominent use (if there is use at all) of either of Joules' hare logos.
- Various other marketing materials are provided in relation to Tribeca's use which is consistent with what has already been detailed. The use includes use of the logo on the clasp of a bag. I note from one piece of this material the text: "a logo of a leaping hare reinforces Aubrey's English heritage inspired by the designers Home Counties childhood".

Joules' reply evidence

10) This comes, again, from Mr Lombardo. To a large extent the reply evidence seeks to deal with certain criticisms made in written submission by Tribeca. The following is noted from Mr Lombardo's evidence:

- That when Mr Lombardo referred in his first witness statement to accessories, this meant accessories such as bags (and not just accessories to be worn). He provides prints from fashion magazines and websites showing that such goods are classed as "accessories".
- That Joules' goods have been sold by reference to both hare logos (he refers back to material in his first witness statement).
- That there is a history of fashion designers applying trade marks to the chest/breast area of a garment. He provides evidence showing such use by other companies (such as Boss, Armani).
- Mr Lombardo states that is common for manufacturers of clothing to sell class 18 goods including bags. Prints of clothing brands and clothing retailers also selling bags are provided.

- A breakdown of Joules' turnover is provided showing retail sales of between £44k and £773k per year between 2007 and 2012 in relation to “bags/purses”.
- That the running hare logo was subject to a “soft launch” in August 2010 when it appeared on the front page of its Autumn/Winter website. The relevant page looks like this:

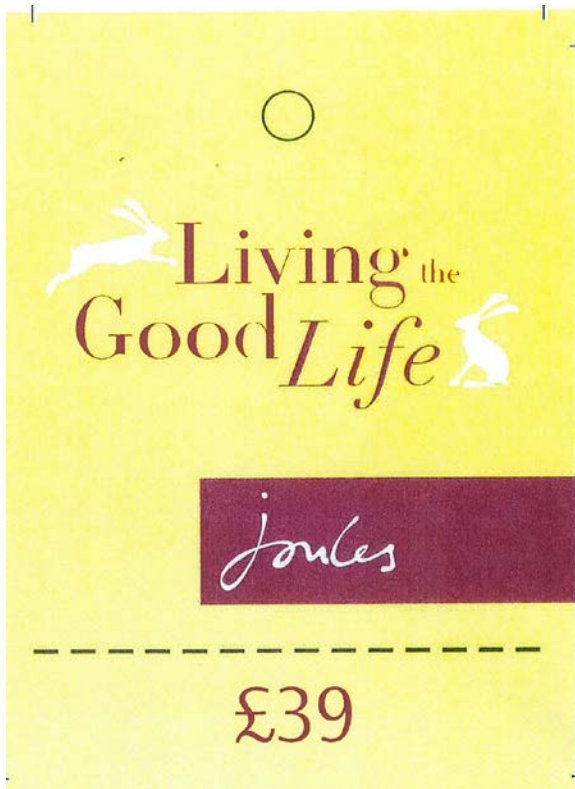


- The running hare featured in subsequent catalogues from late 2010 onwards. Examples are provided, one of which shows the following image on page two of the catalogue (page one includes the sitting hare logo):



- Catalogues are sent to between 300k and 500k customers.

- The gift wrap depicted in his first witness statement would have wrapped goods such as bags and purses.
- That the label shown in his previous witness statement was designed in 2010, manufactured in February 2011 and in stores from April 2011. It is stated that “this swinger has since been applied to all goods sold by the opponent, including its class 18 goods”. The swinger is depicted below:



- A purchase order is provided relating to gift wrap (which features both hares and at least one other variation of hare), carrier bags (which features both hares as per the marketing material) and stickers (which seal the gift wrap, and which feature the sitting hare) which, it is stated, would have been used from the end of 2010 and would have wrapped and/or carried the goods including bags and purses.
- Similar material to the marketing material mentioned earlier which depicts both hares and which was used as point of sale material and on carrier bags in the January 2011 sales.
- Further promotional material relating to stores in Salisbury (late 2010), Olney (November 2010) and Windsor (December 2009) which feature the seated hare logo.

Section 5(2)(b) – the legislation and the leading case-law

11) Section 5(2)(b) of the Act reads:

“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.”

12) The Court of Justice of the European Union (“CJEU”) has issued a number of judgmentsⁱ which provide guiding principles relevant to this ground. In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10), Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases:

"(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."

Comparison of goods

13) When making the comparison, all relevant factors relating to the goods in the respective specifications should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23 of its 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, their intended purpose and their method of use and whether they are in competition with each other or are complementary."

14) Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

15) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 325/06* it was stated:

“It is true that goods are complementary if there is a close connection between them, in the *sense that one is indispensable or important for the use of the other in such a way that* customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P *Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

16) In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade”¹ and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning².

17) Although the earlier mark is registered for goods and services in classes 18, 25 and 35, the pleaded case relies only on the class 18 goods which cover:

Leather and imitations of leather, and goods made of these materials and not included in other classes; hat boxes of leather or imitation leather; trunks and travel bags; umbrellas, parasols and walking sticks; bags;

¹ See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

² See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

backpacks; briefcases; game bags; garment bags; handbags; key cases; purses; rucksacks; schoolbags; walking stick seats; walking sticks.

18) The following is the specification applied for. I have emboldened those goods contained within it which have a direct counterpart (or the wording equates to a direct counterpart) in the earlier mark's class 18 specification which are thus considered to be identical goods:

Articles made from leather or imitation leather; small leather goods; articles of luggage; **bags;** cases; attache cases; **briefcases;** suitcases; **trunks; travelling bags;** overnight bags; holdalls; handbags; shoulder bags; casual bags; **rucksacks; backpacks; school bags;** satchels; gym bags; tote bags; shopping bags; bags for clothing; shoe bags; beach bags; bags for strapping to the body; hip bags; pouches; **purses,** wallets, billfolds; card cases; pass and passport cases; key fobs; **key cases,** luggage tags, and coasters, all of leather or imitation leather; **umbrellas.**

19) Even though not all of the applied for specification has a direct counterpart, the earlier mark includes all goods (in class 18) made from leather or imitation leather – given that most of the applied for goods can be made of leather or imitation leather then identity exists on that basis also. Identity (or similarity) can also be found on the following basis:

Small leather goods – falls within the ambit of leather goods and is also identical to goods such as purses and key cases etc.

Articles of luggage, suitcases – falls within the ambit of travel bags (or else is similar to the highest possible degree).

Cases; attache cases not only fall within the ambit of leather goods and are thus identical, but they are also similar to a high degree to bags per se which could be similar in nature to the applied for goods; the goods are also highly similar to briefcases.

Overnight bags; bags; tote bags; shopping bags; bags for clothing; shoe bags; beach bags; bags for strapping to the body; hip bags; handbags; shoulder bags; casual bags; gym bags all fall within the ambit of bags.

Holdalls; satchels are effectively bags and are identical on that basis (or else they are similar to the highest possible degree); they are also similar to the highest possible degree to school bags, rucksacks and backpacks.

Pouches not only fall within the ambit of leather goods and are thus identical, but they are also similar to a high degree to bags per se which could be similar in nature to the applied for goods.

Wallets, billfolds not only fall within the ambit of leather goods and are thus identical, but they are also similar to a high degree to purses.

Card cases; pass and passport cases not only fall within the ambit of leather goods and are thus identical, but they are also similar to a reasonable degree to key cases (as they are of a similar nature, sold as small items of leather goods) and to bags (which could be small in nature for carrying small items such as cards, passports and passes).

Key fobs are effectively the same as key cases and are identical on that basis (or else they are similar to the highest possible degree).

Luggage tags, and coasters, all of leather or imitation leather, not only fall within the ambit of leather/imitation leather goods and are thus identical, but they are also similar to a reasonable degree to travel bags and trunks on a complementary basis.

The average consumer

20) The average consumer is deemed to be reasonably observant and circumspect. However, the degree of care and attention the average consumer uses when selecting goods and services can vary, depending on what is involved (see, for example, the judgment of the General Court in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)).

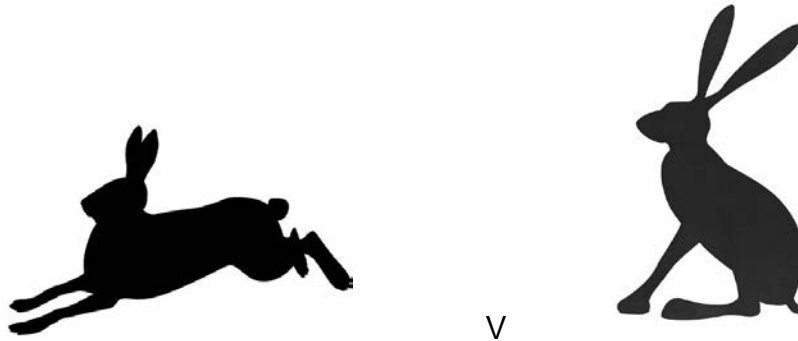
21) The conflict involves, in the main, goods which can loosely be described as fashion accessories and other items of leather goods. The goods are “consumed” by members of the general public. The goods may be tried on (bags being slipped over the shoulder for example) and are likely to be inspected for colour, size, style, fitness for purpose etc. All of this increases the potential exposure to the trade mark. That being said, the purchase of the goods in question is unlikely to be a highly considered process as they are purchased reasonably frequently (although they are not daily or even weekly purchases) and, although cost can vary, they are not, generally speaking, a highly expensive purchase. I consider the purchasing process to be a normal, reasonably considered one, no higher or lower than the norm.

22) In terms of how the goods will be selected, this will normally be via self-selection from a rail or shelf (or the online equivalents) or perhaps chosen from catalogues/brochures. This suggests a process of visual selection, a view which has been expressed in previous cases³; although this case was clothing orientated, I see no reason why the principles would not extend to the goods under consideration here. Despite the importance of the visual aspects of the marks, aural similarity (if there is any) will not, however, be ignored.

³ See, e.g. *New Look Ltd v OHIM* – Joined cases T-117/03 to T-119/03 and T-171/03 (GC)

Comparison of the marks

23) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the marks must be assessed by reference to their overall impressions, bearing in mind their distinctive and dominant components. The marks to be compared are:



24) Each mark has only one component to consider. In terms of visual similarity, Mr St Ville's submissions were highly detailed in terms of the differences that exist between the two devices; the following is taken from his skeleton argument:

"The overall visual impression given by the marks is substantially different:

- (i) The seated Hare is stationary and upright, with attention drawn to its elongated ears, long front leg, realistic tail and taught sense of poised attention. It is shown sitting to attention in perfect profile.
- (ii) The Leaping Cottontail Device conveys a different overall impression. It is a plump bubby rabbit with short ears and fluffy cottontail which is leaping in flight. It depicts a dynamic posture which conveys a sense of movement and escape."

25) Mr Brandreth considered the above to represent a far too detailed level of analysis, an analysis that would not be adopted by the average consumer. He considered the marks to be highly visually similar on account of (taken from his skeleton argument):

"visually both depict hares and do so in the same way, by silhouette, with an essentially realistic (as opposed to stylistic) depiction of the hare shown at the same level of detail and in the same style. The only difference is that one is in motion and the other at rest."

26) There are some clear similarities in that both marks are of a rabbit or a hare, both are facing to the left, both are in silhouette form and both are realistic looking. There are also differences, the most obvious being that one animal is sitting, the other moving, and that one has longer ears than the other. The differences in the tail and size of rear legs are, in my view, less significant as such differences are minor. I consider that this equates to a reasonable, but not high, level of visual similarity.

27) From a conceptual perspective, Mr St Ville accepted that there was some conceptual similarity at the general level on the basis that rabbits and hares (which he considered Tribeca's and Joules' marks to be respectively) came from the same family of animals. Mr Brandreth argued that both animals were hares which meant that conceptual similarity was much higher. It is difficult to come to a clear view on whether the average consumer will see rabbits or hares. I would expect a fairly mixed reaction in that those average consumers who are aware of the exact anatomical differences between rabbits and hares may regard both animals as hares whereas others will see two rabbits. Mr St Ville's assessment is a third option, but, in any event, there is still some conceptual similarity. From an aural perspective, neither mark has verbal elements. It is of course possible that some consumers will attempt to articulate the mark on the basis of the concept I have outlined which I will bear in mind, however, this factor is unlikely to be the most telling as it is the visual impact of the marks which will take on primary significance.

Distinctiveness of the earlier mark

28) The more distinctive the earlier mark, the greater the likelihood of confusion. The same can, potentially, operate in reverse. Distinctiveness can come from the mark's inherent characteristics or from the use that has been made of it. From an inherent point of view, the image of a hare is neither descriptive nor suggestive of any form of characteristic of the goods. There is a mild evocation of the countryside, an evocation which it appears both parties had in mind when its marks were designed, but as presented, the earlier mark strikes me as a sign perfectly capable of performing the essential distinguishing function. Evidence has been presented to suggest that distinctive character is weak. However, the evidence does not establish that this is the case. All it really shows, as Mr Brandreth suggests, is that animal devices make popular trade marks. All things considered, the earlier mark has an average (not high) degree of distinctiveness.

29) The earlier mark has, though, also been used. However, there are some key factors which, whilst none mean that a reputation could not arise, nevertheless push (to varying degrees) against the existence of a reputation. Firstly, the earlier mark is a secondary sign with the word JOULES performing the core trade mark function of the business; secondly, by the relevant date the earlier mark had only been in use for a little over two years. Furthermore, the primary usage appears to be on clothing items. The whole picture must though be considered. Having

assessed the evidence, I come to the view that whilst the earlier mark may have a reputation for clothing products, it will have less significance, given the combination of the three factors mentioned in this paragraph, in relation to leather goods in class 18 (even though I accept that some use has been made as identified in both of Mr Lombardo's witness statements). The consequence of this is that the earlier mark's distinctiveness, in so far as class 18 goods is concerned, has not been enhanced to any material extent.

Likelihood of confusion

30) The factors assessed have a degree of interdependency. A global assessment of them must be made when determining whether there exists a likelihood of confusion. There is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

31) The factors assessed so far are borne in mind and added to the mix. Reference was made by Mr St Ville to the absence of any confusion thus far. This, however, is not surprising given that any parallel trade has been relatively limited (as far as one can tell from the evidence) and, furthermore, both parties use its mark together with a primary mark (JOULES/AUBREY) thus limiting the potential for confusion to arise. Reference was also made to Joules not doing anything to establish that confusion is likely, however, this takes the matter no further forward. It is a matter for the tribunal to decide whether there is a likelihood of confusion on the basis of the facts and the evidence before it. Also lacking in pertinence is Mr Brandreth's comment that because Joules uses other hare imagery as part of its business then this increases the likelihood of confusion. This is virtually akin to a family of marks argument (although Mr Brandreth did not quite put it like that) on the basis of additional marks that have not been pleaded; this claim is rejected.

32) When weighing the respective factors, I must also bear in mind the concept of imperfect recollection. This is important because the degree to which the average consumer can fix a particular image and to accurately recall it has limitations. One does not have a photographic memory. Bearing this in mind, I consider that there is a likelihood of confusion on the basis that the marks may be misremembered/misrecalled for each other. **There is a likelihood of confusion in relation to all of the applied for goods.**

Other grounds of opposition

33) The section 5(3) ground is based upon the same earlier mark as per section 5(2). Having already found that the earlier mark gives rise to a likelihood of confusion, I do not consider it necessary to probe the ground under section 5(3) of the Act. However, as the earlier sign relied upon under section 5(4)(a) differs from the earlier mark under section 5(2)/5(3), I will give my views on this further ground of opposition.

34) Section 5(4)(a) constitutes a ground of opposition in circumstances where the use of the mark applied for 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..”

35) The elements of passing-off (often referred to as the classic trinity) can be summarised as: 1) goodwill, 2) misrepresentation and 3) damage. In *Reckitt & Colman Products Ltd v Borden Inc* [1990] R.P.C.341, Lord Oliver summarised the position thus:

“The law of passing off can be summarised in one short general proposition - no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff...Thirdly he must demonstrate that he suffers, or in a quia timet action that he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff.”

36) The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at 223 as:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom.”

37) To qualify for protection under the law of passing-off, any goodwill must be of more than a trivial nature⁴. However, being a small player does not prevent the law of passing-off from being relied upon⁵.

38) The test for misrepresentation was explained in *Reckitt & Colman Products Ltd v Borden Inc* thus:

“Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff”

39) In my view the claim under section 5(4)(a) is bound to fail. I say so for the following reasons. Whilst Joules’ business would clearly have possessed a protectable goodwill at the relevant date of 15 July 2011, the degree to which that goodwill was associated with the running hare is extremely limited. There was a soft launch in August 2010 with more use then coming from December 2010 onwards. Although it is not impossible for Joules’ goodwill to have become associated with the running hare logo in the short time period involved, further aspects have limited its capacity to do so. This includes the fact that the running hare logo is at best a third level sign (JOULES and the sitting hare logo come before it), and that some of the use of the running hare (on gift wrap for example) will be perceived more as decorative use than a form of use to indicate to consumers the trade origin of the goods. The net effect of all this results in the sign in question lacking any real significance or impact on the minds of Joules’ customers. Whilst some examples of use are better than others, the picture, overall, is that the use made of the running hare logo is insignificant. In short, there was no relevant goodwill by the relevant date associated with the running hare logo that will give rise to any form of misrepresentation. **The ground under section 5(4)(a) is dismissed.**

Costs

40) Joules having been successful is entitled to a contribution towards its costs. I reduce the costs, though, given that Joules failed under section 5(4)(a) of the Act which represented a different evidential basis. My assessment of costs is as follows:

Preparing a statement and considering other side’s statement:	£150
Filing evidence and considering the other side’s evidence:	£350
Attending the hearing:	£300
Opposition fee:	£200

⁴ *Hart v Relentless Records* [2002] EWHC 1984

⁵ See, for instance, *Stannard v Reay* [1967] FSR 140, *Teleworks v Telework Group* [2002] RPC 27 and *Stacey v 2020 Communications* [1991] FSR 49

Total:

£1000

41) Tribeca Ltd is to pay Joules Limited 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 4th day of October 2013

**Oliver Morris
For the Registrar,
The Comptroller-General**

ⁱ The leading judgments are: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, Case C-3/03 *Matrazen Concord GmbH v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).