

O-489-19

**TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO 3277453
BY HEAPHY'S OF WARWICK LLP
TO REGISTER**



The image shows two versions of the word 'Heaphys' in a highly decorative, cursive script. The first version is a solid black outline, and the second version is a hollow outline. Both versions feature a long, sweeping tail that curves under the main body of the word.

(SERIES OF TWO MARKS)

**AS TRADE MARKS
IN CLASSES 35, 40 & 45
AND OPPOSITION THERETO (UNDER NO. 60000824)
BY
DCH FORMAL HIRE LIMITED**

Background & Pleadings

1. Heaphy's of Warwick LLP ('the applicant') applied for the trade marks outlined on the title page as a series of two marks on 15 December 2017. The marks were published in the Trade Marks Journal on 19 January 2018 in classes 35, 40 and 45. The services will be set out later in this decision.

2. DCH Formal Hire Limited (the opponent') opposes the application under section 5(1) of the Trade Marks Act 1994 ('the Act) on the basis of its earlier UK trade mark set out below.

UK TM No. 2511249	Goods & services relied on:
HEAPHYS	Class 25: Articles of clothing for men and for boys.
Filing date: 16 March 2009	Class 40: Tailoring services.
Registration date: 14 August 2009	

3. Although the application was initially opposed under the Fast Track procedures, it was converted to a standard opposition on 28 June 2018.

4. The opponent's above trade mark has a filing date that is earlier than the filing date of the application and, therefore, it is an earlier mark, in accordance with Section 6 of the Act. As the registration procedure was completed more than 5 years prior to the publication date of the contested application, it is subject to the proof of use conditions, as per section 6A of the Act. The opponent made a statement of use in respect of all the goods and services it relies on.

5. The applicant filed a counterstatement in which it denied the ground of opposition and stated that both the applicant and opponent have parallel rights to the mark and put the opponent to proof of use of the earlier mark.

6. During the proceedings the opponent has represented themselves and the applicant has been represented by Christopher Tillbrook of the Intellectual Property Shop Limited.

7. Both the opponent and the applicant filed evidence. No written submissions were filed, and no hearing was requested. I make this decision from the material before me.

Approach

8. During the proceedings the opponent was asked twice by the Tribunal to reconsider its grounds of opposition in official letters dated 20 March 2018 and 28 June 2018. The opponent did not choose to make any amendments, so I will be deciding this matter on section 5(1) grounds only. I propose to consider the identity of the marks and the goods and services in the first instance. If they are not found to be identical then there is no need for me to consider the parties evidence as it does not put them in any stronger a position.


Sections 5(1)

9. Section 5(1) of the Act reads as follows:

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

Identity of the marks

10. The marks to be compared are:

Opponent's mark	Applicant's marks
HEAPHYS	

11. I am guided on the matter of identity from *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, in which the Court of Justice of the European Union (CJEU) held that:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

12. Clearly the applicant’s series of marks are stylised and contain additional elements such as a more ornamented letter H and a swirl underneath the word which are not present in the opponent’s registered mark. As the guidance above states the differences must be ‘so insignificant that they may go unnoticed’. I do not find the differences between the marks in this case are insignificant. The differences are visually impactful and noticeable to the average consumer. On that basis I do not find that the marks are identical.

13. Having found that the applicant’s marks and the earlier mark relied on by the opponent are not identical, that is the end of the matter, since section 5(1) of the Act requires the marks to be identical in accordance with the case law I have identified above. However, for the sake of completeness, I will go on to consider the goods and services at issue in this case.

Identity of the goods & services

14. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“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”.

15. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (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.

16. I am also guided by the guidance given in *Kurt Hesse v OHIM*, Case C-50/15 P, in which the CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court (GC) stated that “complementary” means:

“...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”.

17. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

18. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. sitting as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘similar’ to goods are not clear cut.”

19. However, on the basis of the European courts’ judgments in *Sanco SA v OHIM*¹, and *Assembled Investments (Proprietary) Ltd v. OHIM*,² upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd*³, Mr Hobbs concluded that:

i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently

¹ Case C-411/13P

² Case T-105/05, at paragraphs [30] to [35] of the judgment

³ Case C-398/07P

pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

20. The goods and services to be compared are:

Opponent's goods and services	Applicant's services
Class 25: Articles of clothing for men and for boys.	Class 35: Retail Services in relation to Clothing, Footwear, Headgear, Bags and Clothing Accessories; Online Retail Services in relation to Clothing, Footwear, Headgear, Bags and Clothing Accessories; Mail Order Retail Services in relation to Clothing, Footwear, Headgear, Bags and Clothing Accessories; Business Management connected with the Sale of Clothing, Footwear, Headgear, Clothing

	Accessories, Trunks and Travelling Bags
Class 40: Tailoring services.	Class 40: Tailoring Services; Custom Tailoring; Clothing Alterations.
	Class 45: Rental of clothing, footwear, headgear and accessories; Hire of clothing.

21. The opponent's class 25 specification comprises *articles of clothing for men and for boys*. The application includes *Retail services in relation to clothing, online Retail Services in relation to Clothing, Mail Order Retail Services in relation to Clothing*. In order for the average consumer to purchase clothing they must interact with a clothing retailer, for the most part either online or in physical premises. In my view, it is not uncommon for a brand of clothing to be retailed through a store of the same name and I find that the complementarity in this case is sufficiently pronounced that the average consumer is likely to believe that clothing itself and the retail of clothing are likely to be provided by the same commercial undertaking. I find that there is a relevant complementary relationship between the applicant's goods and the opponent's services resulting in at least a low degree of similarity between them.

22. I find that the term *Business Management connected with the Sale of Clothing* is neither similar or complementary to the opponent's class 25 goods. In my view business management relates to the mechanics of how and in what way goods are sold rather than to the retail of the goods themselves which is a step removed from the complementarity I have already identified between the respective goods and services.

23. In terms of the comparison between opponent's goods in relation to the applicant's services in class 45 of *Rental of clothing and hire of clothing*, I am guided by the points contained in paragraph 15. There may be some limited crossover between the 'users' of male clothing and those who use rental and hire services. It is likely that those seeking to use the services will be interacting with the service provider online or in physical premises so there may be some overlap in trade

channels. The nature of hire and rental services are such that the goods being rented or hired are generally more specialist or goods that are used less frequently so do not warrant purchase. In my view an average consumer is likely to believe that clothing and the rental and hire of same would be provided by the same commercial undertaking to a lesser degree than would be the case for retail services. Nevertheless, I find there is some complementary relationship between the opponent's goods and the applicant's services resulting a very low degree of similarity between them.

24. In relation to class 40, the opponent's *tailoring services* are clearly identical to the applicant's *tailoring services* and also to *custom tailoring*. In my view the opponent's services are also highly similar to the applicant's *clothing alterations* services.

25. In conclusion, I find only some of the services in class 40 can be considered as identical, the remaining goods and services are either complementary or dissimilar. This is not sufficient to satisfy the criteria under section 5(1) which states that the goods and services of the application must be identical to the goods and services of the earlier mark.

Outcome

26. As the marks are not identical, then the opposition fails under section 5(1). Subject to any appeal against this decision, the application can proceed to registration.

Costs

27. As the applicant has been successful, it is entitled to a contribution towards the costs incurred in these proceedings. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. Using the guidance in TPN2/2016, I make the following award:

£200 Considering of the Notice of Opposition and preparing a counterstatement
£500 Preparing evidence
£700 Total

28. I order DCH Formal Hire Limited to pay Heaphy's of Warwick LLP the sum of £700. This sum is to be paid within 14 days of the expiry of the appeal period or within 14 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 21st day of August 2019

June Ralph

For the Registrar,

The Comptroller General