

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2069285

BY HARRODS LIMITED

5 **TO REGISTER A TRADE MARK IN CLASSES 9, 16, 38 and 41.**

DECISION AND GROUNDS OF DECISION.

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On 19th April 1996 Harrods Limited of 87-135 Brompton Road, London SW1X 7XL applied under the Trade Marks Act 1994 for registration of the trade mark LIBERTY in Classes 9, 16, 38 and 41 in respect of the following goods and services:

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Class 9. Sound recordings; video recordings; audio/visual recordings; pre-recorded magnetic tapes, discs and CD ROMs; motion picture films.

Class 16. Printed publications; books, magazines, periodicals; photographs; stationery; instructional and teaching materials.

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Class 38. Broadcasting services; film production services; transmission of data or information; satellite communications services.

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Class 41. Educational and entertainment services; production of films, television and radio programmes.

Objection was taken under Section 5(2) of the Act in respect of the following earlier trade marks:

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402712 (Class 16 of this registration only), 828662, 995278, 1104691, 1152802, 1157243, 1282965, 1344355, 1493543, 1551538 and 1563081.

Details of these trade marks are given at Annex A.

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Objection was also taken under Section 3(6) of the Act in respect of the breadth of the Class 41 specification.

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At a hearing, at which the applicants were represented by Miss Nicholls of D.Young & Co, their trade mark agents, the objection in respect of application no. 1551538 was waived as the application had been withdrawn. All the other citations were maintained against the application. However, in respect of registrations 402712 and 995278 Miss Nicholls was advised that if appropriately limited specifications were filed the objections under Section 5(2) in relation to these trade marks would be waived. Miss Nicholls advised that discussions were taking place with the proprietors of registration nos. 1282965, 1157243 and 1493453 in order to seek an accommodation. In respect of registration nos. 1344355, 1104691, 1152802 and 828662 Miss Nicholls stated that action would be instituted to seek their revocation. On the basis that the above actions were to be effected the application was suspended for 3 months.

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Subsequent to three extensions of time a facsimile transmission, dated 7 August 1998, was received by the Trade Marks Registry from the agents for the applicants. This facsimile transmission in summary stated that:

- 5 (i) Action had not been taken to revoke registration no. 1344355 owing to the position re. the other citations.
- 10 (ii) The applicants had not been able to obtain consent in respect of registration nos. 1104691, 1152802, 828662, 1157243, 1493543 and 402712. Consequent upon this the applicants requested the striking out of the goods falling in Classes 9 and 16 from the specification of the application in suit.
- 15 (iii) The applicants proposed that a specification limited to “broadcasting services; film production services; transmission of data or information; satellite communication services; entertainment services; production of films, television and radio programmes” in Classes 38 and 41.

20 I advised in a letter of 26 August 1998 that I did not consider that the proposed amendments would overcome the Section 3(6) and Section 5(2) objections and so the application was to be refused.

25 Following refusal of the application under Section 37(4) of the Act I am now asked under Section 76 of the Act and Rule 56(2) of the Trade Marks Rules 1994 to state in writing the grounds for the decision and the materials used in arriving at it.

I will first address the grounds of objection under Section 5(2) of the Act which states:

“5.-(2) A trade mark shall not be registered if because -

- 30 (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,

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

40 The term “earlier trade mark” is itself defined in Section 6 of the Act as follows:-

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

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

- (b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), or
- (c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well known trade mark.”

In considering the matter I have regard for the approach adopted by the European Court of Justice in *Sabel v Puma* 1998 RPC 199. The Court considered the meaning of Article 4(1)(b) of the Directive (EC Directive 104/89) which corresponds to Section 5(2) of the Act and stated that:

“... it is clear from the tenth recital in the preamble to the Directive that the appreciation of the likelihood of confusion ‘depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified’. The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case.

That global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The wording of Article 4(1)(b) of the Directive - ‘... there exists a likelihood of confusion on the part of the public ...’ - shows that the perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.”

I also have regard to the approach adopted by the European Court of Justice in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc.* (Case C-39/97) (as yet unreported) which also dealt with the interpretation of Article 4(1)(b) of the Directive. The Court in considering the relationship between the nature of the trade mark and the similarity of the goods stated:

A global assessment of the likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between these goods or services. Accordingly, a lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the marks, and vice versa. The interdependence of these factors is expressly mentioned in the tenth recital of the preamble to the Directive, which states that it is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion, the appreciation of which depends, in particular, on the recognition of the trade mark on the market and the degree of similarity between the mark and the sign and between the goods or services identified.

and

5 It follows that, for the purposes of Article 4(1)(b) of the Directive, registration of a trade mark may have to be refused, despite a lesser degree of similarity between the goods or services covered, where the marks are very similar and the earlier mark, in particular its reputation, is highly distinctive.

Finally the court gave the following judgement on the interpretation of Article 4(1)(b):

10 “On a proper construction of Article 4(1)(b) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks, the distinctive character of the earlier trade mark, and in particular its reputation, must be taken into account when determining whether the similarity between the goods or services covered by the two trade marks is sufficient to give rise to the likelihood of confusion.

15 There may be a likelihood of confusion within the meaning of Article 4(1)(b) of Directive 89/104 even where the public perception is that the goods or services have different places of production. By contrast, there can be no such likelihood where it does not appear that the public could believe that the goods or services come from the same undertaking or, 20 as the case may be, from economically-linked undertakings.”

Guidance on how comparison between respective goods and/or services should be made is also to be found in the Treat case¹. Jacob J says, at page 296 line 25:

25 “I think the sort of considerations the court must have in mind are similar to those arising under the old Act in relation to goods of the same description. I do not say this because I believe there is any intention to take over the conception directly. There plainly is not. But the purpose of the conception in the old Act was to prevent marks from conflicting not only for their respective actual goods but for a penumbra also. And the purpose of 30 similar goods in the Directive and Act is to provide protection and separation for a similar sort of penumbra. Thus I think the following factors must be relevant in considering whether there is or is not similarity:

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- (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;
 - 40 (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 in supermarkets and in particular whether they are, or

¹British Sugar PLC v James Robertson & Sons Ltd [1996] RPC 281

are likely to be, found on the same or different shelves;

- 5 (f) The extent to which the respective good 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 of industry, put the good or services in the same or different sectors.

10 This is rather an elaboration on the old judicial test for goods of the same description. It seeks to take account of present day marketing methods. I do not see any reason in principle why, in some cases, goods should not be similar to services (a service of repair might well be similar to the goods repaired, for instance). I do not pretend that this list can provide other than general guidance. The fact is that the Directive and hence our Act have introduced an area of uncertainty into the scope of registration which in many cases can only be resolved by litigation.”

15 As a result of the removal of the Class 9 and 16 goods from the specification of the application and the amendment of the services encompassed by Classes 38 and 41 I consider that only the following trade mark registrations should be maintained under Section 5(2) of the Act as citations against the application: 828662, 1104691, 1152802 and 1344355.

20 I will deal with the issue of whether the above trade marks are confusingly similar to the trade mark in suit. In the cases of registration number 1344355 the trade marks are identical. In the cases of registration nos. 828662, 1104691 and 1152802 the trade marks consist essentially of the word LIBERTY and the device of the top portion of the Statue of Liberty. Taking into account the visual, aural and conceptual similarity of the trade marks in question and the overall impression given by the trade marks in question, in particular their distinctive and dominant components, I have no doubt that the latter three trade marks are confusingly similar with the trade mark in suit. They will all be referred to as Liberty trade marks in ordering or purchasing goods or services. It is common place for a device to be added to a word trade mark to embellish it, the absence of the device will not usually lead to the potential purchaser assuming that the trade mark is the property of another party.

30 The Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer decision requires me to consider the degree of similarity between the trade marks in question; a lesser degree of similarity between the goods and/or services may be offset by a greater degree of similarity between the marks, and vice versa. In this case I consider that all the remaining citations have a great degree of similarity, indeed one of the trade marks is identical. Consequent upon this there is less need for a close degree of similarity between the goods and services before one could fairly conclude that there is a likelihood of confusion.

40 For convenience and clarity I will deal with the clash in respect of the remaining services encompassed by the specification of the application in suit by class.

45 Class 38. The services encompassed by this class are: broadcasting services; transmission of data or information; satellite communication services.

5 (“Film production services” have been included in the specification by the agent for the applicants, however, such services are appropriate to Class 41).

5 I consider that the above services are similar to the goods encompassed by registration no. 1344355. It is common for suppliers of telecommunication services to also supply the hardware for utilisation of the services, the customer would make a natural association between, for instance, a telephone and a telephone service, provided under the same or closely similar trade marks. Broadcasting services are further away from the goods encompassed by registration no. 1344355 and I do not consider that there is a clash of these services with the goods encompassed by registration no.1344355.

10 Consequently Section 5(2) of the Act, owing to prior registration no. 1344355, debars the application in suit from being registered in respect of the services encompassed by Class 38 with the exception of broadcasting services (but see below re. broadcasting services).

15 I now turn to Class 41. The amended services in respect of this class are as follows:

20 Class 41. Film production services; entertainment services; production of films, television and radio programmes.

I consider that the above services and broadcasting services in Class 38 are similar services to the goods or services encompassed by registration nos. 828662, 1104691 and 1152802.

25 The three remaining citations, registration nos. 828662, 1104691 and 1152802 are all in the name of Capitol Records, Inc.. They encompass a broad spectrum of media for bearing recordings, both sound and video. The respective users of these goods and those of the services in Class 41 (and broadcasting) of the application in suit are likely to be the same, i.e people seeking entertainment, the use is also the same, entertainment. To give a concrete example, the goods encompassed by the above citations could be a video recording of a concert or play, the services encompassed by the applicant could be the production of such a video, the making of the video available for broadcast, the actual production of the performance or the broadcasting of the performance. I also take into account the degree of similarity between the cited registrations in the name of Capitol Records, Inc. and the trade mark in suit. I consider that there is a high degree of similarity, a degree that would lead a customer to associate the services of the trade mark in suit with those encompassed by the goods encompassed by the registrations in the name of Capitol Records, Inc.. The objection under Section 5(2) of the Act in respect of registration nos. 828662, 1104691 and 1152802 is therefore a bar to the registration of the application in suit.

40 In considering the above I take into account Article 13 of EC Directive 104/89 which states:

45 “Where grounds for refusal of registration or for revocation or invalidity of a trade mark exist in respect of only some of the goods or services for which that trade mark has been applied for or registered, refusal of registration or revocation or invalidity shall cover those goods or services only.”

In the current application the grounds for refusal under Section 5(2) of the Act relate to all the services encompassed by the specifications as amended for Classes 38 and 41.

Finally I turn to the objection to the application under Section 3(6) of the Act. Section 3(6) states:

5 “A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

This objection has been raised and maintained in relation to the breadth of the specification in Class 41.

10 On the application form for registration the agent has signed a declaration that “the trade mark is being used by the applicant, or with his or her consent, in relation to the goods or services stated, or there is a bona fide intention that it will be so used.” In the amended specification it is stated that the applicant will be using the trade mark in relation to entertainment services at large. Such a specification is so wide that the Registrar has made it a matter of practice that the term would not be accepted without supporting evidence or a declaration. In Chapter 5 of the Work Manual the following is stated:

15 “Class 41. Wide claims should be justified..... Providing the type of entertainment is specified e.g. “Live entertainment” or “Musical entertainment” no objection should arise.

20 In this case the type of entertainment has not been specified; the claim is for entertainment services at large. Such a specification encompasses everything from a clown for a children’s party to an amusement park to a chamber concert. No justification for this breadth of services has been put forward and without such justification I do not consider that it is reasonable to accept it. I find it difficult to envisage that even the largest of companies would be likely to supply all entertainment services.

25 Consequent upon the above I determine that this application is debarred from registration under Section 3(6) of the Act in respect of the statement made about the intention to provide entertainment services in Class 41.

30 In this decision I have considered all the documents filed by the applicant and all the arguments submitted to me in relation to this application and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Sections 5(2) and Section 3(6) of the Act.

Dated this 13 day of November 1998

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D.W.LANDAU
For the Registrar
The Comptroller General

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TRADE MARKS CITED AGAINST APPLICATION NO.2069285 UNDER SECTION 5(2) OF THE TRADE MARKS ACT 1994.

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NUMBER AND TRADE MARK.

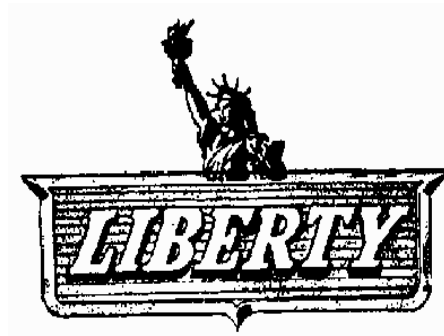
402712 LIBERTY

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SPECIFICATION: Class 16: Bookcovers, all being made of linen or hemp or having linen or hemp as their predominating material.

828662

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SPECIFICATION: Class 9: Sound records; sound-recording and sound-reproducing apparatus and instruments, and parts thereof

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995278 LIBERTY

SPECIFICATION: Class 16: Document binders, storage drawers, document holders and containers, all included in Class 16, for filing purposes; shelving units (being office requisites other than furniture) for the stacking of storage drawers, and containers, but not including any of the aforesaid goods being in the nature of boxes

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1104691

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SPECIFICATION: Class 9: Discs, tapes and wires, all for or bearing sound recordings or sound and video recordings; apparatus and instruments, all for recording and reproducing sound, or sound and video; and parts and fittings included in Class 9 for all the aforesaid goods.

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1152802



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SPECIFICATION: Class 9: Video discs and video tapes.

1157243 **LIBERTY**

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SPECIFICATION: Class 16: Writing materials, writing cases, writing implements; blotters, blotting pads and stapling machines, all being articles of stationery; telephone indexes, books; wrapping and packaging materials, all included in Class 16; holders, ink wells, clipboards, letter racks and lining paper for drawers, all for desks.

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1282965 **LIBERTY**

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SPECIFICATION: Class 35: Accounting, book-keeping, advertising, publicity, public relations and market research services, demonstration of goods; distribution of samples; auctioneering, import-export agency, offset printing, document reproduction (photocopying or microfilming) and window dressing services; television and radio advertising; all included in Class 35.

1344355 **LIBERTY**

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SPECIFICATION: Class 9: Telecommunications apparatus and instruments; parts and fittings for all the aforesaid goods; all included in Class 9.

1493543 **LIBERTY**

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SPECIFICATION: Class 16: Writing materials, writing cases, writing implements, writing paper and envelopes, post cards, greetings cards, christmas cards, note cards, calenders; notebooks, desk pads; telephone indexes, books, address books, photograph albums, appointment books, cheque books, recipe books; blotters, blotting pads; stapling machines, all being articles of stationery; wrapping and packaging materials; holders, ink wells, clipboards, letter racks and lining paper for drawers, all for desks; bathroom tissue; paper place mats, paper napkins; table linens made of paper, table mats made of paper, table cloths made of paper; artists materials; all included in Class 16.

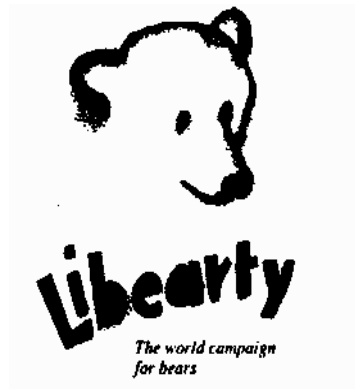
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1551538 **LIBERTY**
LIBERTY COMMUNICATIONS

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SPECIFICATION: Class 38: Telecommunications services; telephone, telex and facsimile transmission services; data and video communications; and all services in Class 38.

1563081



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SPECIFICATION: Class 16: Albums; announcement cards; bookends; booklets, bookmarkers, books; boxes of cardboard or paper; calendars; cardboard articles, playing cards; catalogues; charts; cards; coasters of paper; drawing instruments, drawing pads, drawing pens; envelopes; fountain pens; globes; greetings cards; handkerchiefs of paper; paper knives; magazines and periodicals; maps; printed matter; modelling clay; modelling materials; newsletters; notebooks; packing paper; paint boxes; pamphlets; paper weights; pen cases; pencils, pens; photograph stands; photographs; packages; placards of card paper or cardboard; place mats of paper; postcards; posters; prints; rubber erasers; rulers; scrap books; seal stamps; stands for pens and pencils; stencils; stickers; teaching materials in the form of games, teaching materials; tear off calendars; terrestrial globes; toy theatres made of paper, all for sale in sets; towels of paper; stationery; transparencies; wrapping paper; all included in Class 16; but not including document holders and containers or any goods of the same description as these excluded goods.