

BEFORE:

MR S THORLEY QC

IN THE MATTER OF TRADE MARKS ACT 1994

AND

**IN THE MATTER OF APPLICATION NO 2108583
OF GREENE TWEED OF DELAWARE INC
AND FOR REGISTRATION OF THE MARK ENER-CAP**

**APPEAL OF APPLICANT FROM THE DECISION OF
MS V DOUGLAS DATED 18TH APRIL 1998**

MR T Z GOLD appeared on behalf of the Appellants

MR A JAMES appeared on behalf of the Patent Office

D E C I S I O N

Mr Thorley: This is an appeal to the Appointed Person from a decision of Virginia Douglas, the officer acting for the Registrar, dated 1 April 1998.

In that decision, she refused application number 2108583 for the mark “ENER-CAP” in Class 17 in respect of “Seals; non-metallic hydraulic seals; joint packings.” The refusal was based upon the provisions of Section 5(2)(b) of the Trade Marks Act 1994, which provides that:

“A trade mark shall not be registered if because

(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.”

Two earlier registrations were relied upon: “EnerRing”, No 1121398, registered in Class 17 in respect of “Sealing rings included in Class 17”; and “EnerSeal”, No 1121399, registered in Class 17 for “Seals included in Class 17.”

It was not disputed before the Hearing Officer or before me that there is a conflict of goods so that the sole question to be decided is whether the mark “ENER-CAP” is so similar to either the mark “EnerRing” or the mark “EnerSeal” as to lead to the requisite confusion.

The Hearing Officer decided that there was such a likelihood of confusion. She summarised her views in the following words: “In these circumstances I believe that anyone encountering the mark ENER-CAP used on seals and the mark EnerRing used on sealing rings might well be confused as to the origin of the respective goods. The fact that both marks comprise two elements which are separated, in one case by a hyphen, in the other case by use of an upper case letter in the middle of the mark, increases the similarity of the marks and thus the danger of confusion. I do not think the fact that ENER-CAP is presented in upper case type and

EnerRing in upper and lower case in any way lessens this danger.

“Exactly the same considerations apply to comparisons of ENER-CAP, used on seals, and EnerSeal used on seals.”

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Mr Gold, who has appeared on behalf of the applicants, Greene Tweed of Delaware Inc., has challenged that conclusion. He submits that it is a very narrow point and I do not think Mr James, who appeared for the Registrar, dissented from that. It is, however, in my judgement, a very narrow point that is not without its difficulty. I propose to consider first the correct approach in law under Section 5(2)(b) in the circumstances of this case.

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Both Mr Gold and Mr James drew my attention to the decision of the European Court of Justice in Sabel BV v Puma AG which considered the nature of the confusion that is necessary in order to raise a proper objection under Section 5(2)(b). Although I gave guidelines, it did not assist greatly as to the criteria that are to be applied in reaching the relevant conclusion.

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In this case, however, both parties were agreed was that the approach I should adopt was that of the old law of comparison under Section 12 of the 1938 Act, there being no suggestion that any of the marks in question and any form of reputation. The difficult question of law, therefore, as to the extent that reputation can be taken into account in making the assessment under Section 5(2), as opposed to Section 5(4), does not arise in this case.

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Before considering the arguments that were put before me, I think it is helpful to remind myself of the way in which the rules on comparison have developed over the years, and particularly the language of Parker J in the application by Pianotist Co Ltd [1906] 23 RPC 774, 777:

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“You must take the two words. You must judge of them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In

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fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks.”

5 Mr Gold has particularly emphasised in this case the nature of the goods and the kind of customer who would be likely to be any more intelligent than the average purchaser of goods in a supermarket, he did suggest that such purchasers would be likely to know the market they were dealing in and would make a more thorough investigation of the goods and would not buy solely upon the trade mark. I think this is a valid point but it must not be taken too far.

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I am concerned that accepting an argument of that nature, in the breadth in which he expressed it, could lead one to lose sight of the comparison that has to be made. I think it is helpful, when considering that comparison, to remember the words of Farwell J in

ERECTIKO [1935] 52 RPC 136, 151 (which was cited by the Hearing Officer): “I do not

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think it is right to take a part of the word and compare it with a part of the other word; one word must be considered as a whole and compared with the other word as a whole ... I think it is a dangerous method to adopt to divide the word up and seek to distinguish a portion of it from a portion of the other word”. It is also helpful to consider the comments of Harman LJ

in the case of Accutron [1966] RPC 152, 157 where he cited the well-known words of

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Evershed J in Smith & Hayden Co’s Application [1964] 63 RPC 97, 102: “When all is said, the question is in truth, as observed by Lord Justice Luxmoore and the House of Lords in the ARISTOC case, one of first impression, on which no doubt different minds may reach different conclusions. It is not profitable in such a case to indulge in a minute analysis of letters and syllables, a process indeed notoriously productive of confusion in regard to words.”

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Harman LJ went on to say, at 158: “The Registrar came to the conclusion, as a matter of first impression, that the applicants failed to discharge the onus upon them to establish that there was not a danger of deception and confusion, and he came to his decision accordingly. I can see no reason to upset that decision, nor may I say did the learned judge below. It was said

that this was an attempt to monopolise a natural word, that is to say, the word ‘accurate’, and

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that what the objectors are attempting to do here was put by Lord Cozens-Hardy in the PERFECTION case in these words: ‘Wealthy traders are habitually eager to enclose part

of the great common of the English language and to exclude the general public of the present day and of the future from access to enclosure’.”

5 I cite those passages because, to my mind, they are warnings that must be taken into account when making the association under Section 5(2)(b) with two marks that do both consist of syllables which are of a descriptive nature. The prefix “Ener-“ is, I think, accepted to be at least conceptually indicative of energy, and obviously caps and seals and rings have their ordinary natural meaning. I think, therefore, one does here have to take heed of the warning of looking at the marks as a whole. I believe that any purchaser of goods with a name like
10 “ENER-CAP” or “EnerRing” or “EnerSeal” would have regard to the mark as a whole. Therefore, I am not prepared to take too far in this case the suggestion that I should have regard to the possibility of the intellectual approach of any potential purchaser of these products. I accept it may be a correct approach in some cases, but I am not in this case persuaded that it should affect my judgment.

15 The authorities make it plain that this must be a matter of first impression, looking at the mark as a whole. Happily, the authorities accept that reasonable people may differ, because in this case, having heard the arguments of both parties, I have come to the conclusion that, although the marks obviously have similarities, these are not so similar as to be likely to lead to the relevant conclusion. It is always difficult to express in words why one does not feel that
20 confusion will arise or why it will arise. That is why I think, helpfully, the authorities have said it is a matter of first impression. I obviously give great weight to the reasoning of the Hearing Officer in reaching the contrary conclusion but I think, with respect, she may have fallen into error, although having directed herself to have regard to the marks as wholes, in considering
25 the separate integers and, in particular, placing emphasis on the initial syllables “Ener-“. It may simply be that this is a case where reasonable people have differed.

I also have not been way swayed in reaching this conclusion by the fact that another Hearing Officer has apparently accepted for registration the mark ENER-LIP and did not take
30 objection under Section 5(2)(b). I do not think it is proper for any Hearing Officer to have their judgment swayed by the previous approach of another Hearing Officer and I can well see

that, in cases such as this, which I do regard as a borderline case, different decisions will occur. However, I do believe that the differences, visually and phonetically, are plainly differences that are significant.

5 The Hearing Officer was constrained to reach the conclusion she did by consideration of conceptual similarity. Conceptual similarity is of course relevant, but it must be similarity which is going to give rise to the necessary likelihood of confusion. I accept the similarity, but I do not accept that it is sufficient similarity to give rise to the likelihood of confusion.

10 For these reasons, I would allow this appeal and direct that the mark be accepted for registration. I would like, however, before parting from the case, to make two observations.

First of all, plainly, this decision for registration leaves open the possibility of opposition under Section 38 rectification under Section 47 by the owners of the marks in question, should they
15 be minded to disagree with my conclusion. In any such opposition or rectification, the question of any reputation, as to which we have no information, can be raised. Secondly, at the end of the Hearing Officer's decision, she appear to me to have reinforced her conclusion on confusion by a consideration that the two marks "EnerRing" and "EnerSeal" would be seen as a family of marks. I have not heard argument as to the relevance of that, but prima facie I
20 do not believe it is relevant to an enquiry under Section 5(2)(b), although it may of course be relevant to an argument under 5(4).

For all the reasons given, I will allow this appeal. What do we do with costs?

25 Mr James: As you know, the Registrar does not normally ask for his costs, so necessarily we would resist it.

Mr Thorley: The Registrar does not expect to pay them.

30 Mr Gold: I know that is the custom and practice, to which I am happy to accede.

Mr Thorley: There will be no order as to costs.

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