

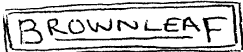
TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION 2205533 BY FREEMANS PLC TO REGISTER A TRADE MARK IN CLASS 25

DECISION AND GROUNDS OF DECISION

On 11 August 1999 Freemans Plc of 139 Clapham Road, London, SW99 0HR applied under the Trade Marks Act 1994 for registration of the mark BLUE LEAF in respect of: "Clothing and footwear" in Class 25.

Objection was taken to the mark under Section 5(2) of the Act in respect of the following mark:

Number	Mark	Class	Specification
			
2049467		25	Articles of outerclothing.

At the hearing, at which the applicants were represented by Mr Groom of Trade Mark Owners Association Limited, their trade mark agents, the objection was maintained.

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 of the Trade Marks Rules 1994 to state in writing the grounds of my decision and the materials used in arriving at it.

No evidence has been put before me. I have, therefore, only the prima facie case to consider.

Section 5(2) of the Act reads as follows:-

- 5.-(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) 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.

Dealing firstly with the respective goods, it is immediately apparent that many of the goods

contained within the specification of the application are identical to, or contained within the specification of the earlier trade mark. Consequently, the matter hinges on the question of the similarity between the respective marks.

Since the mark of this application is not identical to the earlier mark the matter must be decided under sub-section (b) of Section 5(2). The question, therefore, is whether the mark of this application is so similar to the earlier mark that there exists a likelihood of confusion which includes the likelihood of association on the part of the public.

In the Sabel v Puma trade mark case (C-251/95), 1998 RPC 199 at page 223 lines 52-54 and page 224 lines 1-23 The European Court of Justice stated:

“..... In that respect, 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- “..... shows that the perception of marks in the minds 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.

In that perspective, the more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that the two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either *per se* or because of the reputation it enjoys with the public”.

The mark applied for is in plain upper-case letters with no stylisation. Registration 2049467 is for the words BROWNLEAF but this mark contains additional features. Although all letters are presented in plain upper-case letters the initial and final letters are approximately twice the size of the other letters. The smaller central letters are underlined and the whole mark is enclosed in a double lined rectangular border.

In my view the earlier registration is a distinctive mark for the goods for which it is registered. However, I take the view that this stylisation is no more than embellishment and the mark would be viewed as and referred to as a “BROWN LEAF” mark.

It is my view that one mark is similar to another if an element (or something very similar to that element) of the earlier mark is included in the later mark with the result that the relevant public are likely to assume that the marks are associated and that the respective goods originate from the same source.

I have also born in mind the view expressed by Sir Wilfred Greene M.R. in the Saville Perfumery Limited versus June Perfect Limited case (1941) at page 162 lines 1-9 when he said:

“In the present case, for example, the evidence makes it clear that traders who have to deal with a very large number of marks used in the trade in which they are interested, do not, in practice, and indeed cannot be expected to, carry in their heads the details of any particular mark, while the class of the customer among the public which buys the goods does not interest itself in such details. In such cases the mark comes to be remembered by some feature in it which strikes the eye and fixes itself in the recollection. Such a feature is referred to as the distinguishing feature, sometimes as the essential feature of the mark”.

And at lines 18-20 when he said:

“Now the question of resemblance and the likelihood of deception are to be considered by reference not only to the whole mark, but also to its distinguishing or essential features, if any”.

Although many of the goods covered by these specifications may be relatively expensive it is also a fact that many will be inexpensive and it is reasonable to assume that members of the public will purchase such goods with little in the way of thought or consideration. Detailed examination of the trade marks involved is, in my view, unlikely to be a determining factor in any decision to purchase such goods. I am also aware that such goods are purchased with a degree of regularity. Older, worn clothing, requires replacement as do goods purchased for wear by children who will outgrow such goods with a requirement for further purchases to be made.

I also bear in mind the remarks in the AQUAMATIC/WATERMATIC trade mark infringement case (1958 RPC 387) page 390 lines 37-44:

“In this day and age every child must know that “aqua” has something to do with water. So the real point the Plaintiff makes there is that the idea underlying these two words is the same, and applying ordinary tests he would say that a purchaser with a memory but, as Lord Russell pointed out in the Coca Cola case, a person with average memory but with his usual imperfections, might, on making a second purchase, easily confuse “Watermatic” with “Aquamatic”, both bringing the same idea to mind.”

The essential message from both of these marks is that they tell you the colour of a leaf. At the hearing, Mr Groom argued that because members of the public regularly see or come into contact with leaves coloured brown, but they do not do so with leaves coloured blue, they would immediately be able to distinguish the two marks and that no confusion would arise. Whilst plants with blue leaves exist and others have leaves which, although not actually blue in colour are referred to as blue leaves, I accept that such plants are relatively rare in the United Kingdom. However, I do not accept that Mr Groom’s argument is particularly relevant. Both marks bring to mind the idea of a coloured leaf. Prospective purchasers of these goods may not have the opportunity to purchase at leisure and will not necessarily study the marks in any detail. With imperfect recollection I am of the view that such purchasers might easily be confused as to the origin of the respective goods. I therefore conclude that the application is

debarred from registration by Section 5(2) of the Act.

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 is debarred from registration under Section 5(2) of the Act.

Dated this 25 Day of July 2000.

**A J PIKE
For the Registrar
The Comptroller General**