

TRADE MARKS ACT 1994

**IN THE MATTER OF Application N^o: 2156933
by Eurodream Limited to register a Trade Mark and**

**IN THE MATTER OF Opposition N^o: 50183
by Bellini Warenvertriebsgesellschaft mbH.**

1. Eurodream Limited of 255/259 Commercial Road London E1 2BT applied on 30th January 1998 for the mark CLOSER in respect of 'Clothing' in Class 25.
2. The mark is opposed by Bellini Warenvertriebsgesellschaft mbH, based on a likelihood of confusion under s. 5(2), because they are the register proprietors of:

UK registration N^o: 1164159 CLOSED, applied for on 5th November 1981, for:

'Jackets, trousers, shorts, bathing suits, shirts, blouses, hats, shoes, stockings, windcheaters, coats, scarves, ski-pants, boots, jumpers, skirts, slacks, suits, sweaters, articles of underclothing; jeans, swimwear, socks, belts and headgear, all being articles of clothing', (Class 25),

and of the Community Trade Mark N^o: 298406, also for CLOSED, applied for on 15th October 1997 for:

'Dresses of skins and hides; clothing for men, women and children, shirts, blouses, skirts, jackets, trousers, shorts, vests, jumpers, pyjamas, shoes, socks, sports jerseys, corsets, suspender belts, pants, combinations, slippers, hats, collar protectors; scarves, ties, waterproof clothing, topcoats, coats, swimming costumes, sports suits, anoraks, salopettes, belts; jackets; trousers, skirts, combinations; brassieres; jeans; shorts; swimming costumes, shirts, jumpers (shirt fronts); sports jerseys; jumpers; hats; socks; stockings; shoes in general, anoraks; topcoats; waterproof clothing; coats; sportswear, scarves, hosiery; salopettes, neckties.'

They also claim a substantial reputation in the UK under their mark, and say they would be entitled to prevent use of the applicants' mark by virtue of the law of passing off under s. 5(4)(a).

3. The applicants deny the grounds and both parties ask for their costs. The matter was heard on 14th June 2001, where the opponents were represented by Dr Colley of Counsel, instructed by Lewis & Taylor; the applicants did not attend.
4. Nor did they enclose any evidence. The opponents' evidence subsists only in the one Statutory Declaration by Mr Gunther W Giers, their managing director, and the four Exhibits attached thereto.
5. Obviously, evidence of use of the mark in the UK is very relevant to proving passing off. However, there appears to me to be no material evidence that supports this ground. The Exhibits are either after the relevant date, undated or presented without a context allowing me to assess their worth. For examples, see the invoices in Exhibit GWG2 and the material in Exhibit GWG3. At best, I might regard this material as 'illustrative' of the opponents products.

6. However, there is unchallenged evidence provided by Mr Giers himself (which I am not going to reproduce here - see paragraphs 5 to 10 of his Declaration). In my view, Mr Giers' evidence is enough to launch a more than presentable case under passing off. However, it is usually the case that if s. 5(2)(b) grounds are argued and the opponents cannot win under these, they are unlikely to be able to win under passing off either and, if they do win there, there is nothing to be gained by consideration of passing off in any event. In view of this, I am going to consider the s. 5(2) ground only. S. 5(2)(b) states:

'(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.'

7. Under s. 6(1) the opponents have two 'earlier marks' for the purposes of s 5(2) (see ss. 6(a) and (b)).
8. Guidance on this provision has been provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] ETMR. 1, *Lloyd Schufabrik Meyer & Co GmbH v Klijsen Handel BV* [2000] FSR 77 and *Marca Mode CV v Adidas AG* [2000] ETMR 723. It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors (*Sabel* page 224);

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question (*Sabel* page 224), 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 (*Lloyd* page 84, paragraph 27).

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Sabel* page 224);

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components (*Sabel* page 224);

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa (*Canon* page 7, paragraph 17);

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it (*Sabel* page 8, paragraph 24);

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2) (*Sabel* page 224);

(h) further, 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 (*Marca Mode* page 732, paragraph 41);

(i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section (*Canon* page 9, paragraph 29).

9. Against the background of the case law, there is little doubt in my mind that there is a likelihood of confusion between the two marks at issue, and for the following reasons.
10. First, the goods are identical or similar. The applicants' specification is very wide, and subsumes much of the opponents' specification. This prompts the effect of point (e) above.
11. Next, CLOSED is distinctive mark for the goods at issue (see point (f) above, and despite the suggestion of an allusive pun, as indicated below). In terms of the 'use that has been made of it' I would not go as far as to say it was 'highly' distinctive - certainly the evidence does not show this and Dr Colley agreed: he stated at the hearing that this was not a mark of the same order as, say, LEVI. However, in his view, there has been protracted use and promotion of the mark, and this is a factor that increases the likelihood of confusion, particularly when coupled with its inherently distinctive character.
12. In terms of the visual, aural and conceptual similarity, the applicants' strongest case is perhaps that based on the visual similarities: there is one letter different between them - the final 'd' and the final 'r'. On visual perusal they are very similar. And this observation is a heavy weighting factor in favour of finding confusion between the marks - clothing is typically chosen by consumers by sight.
13. Arguably aurally, however, the similarities are less apparent. The applicants' mark as two syllables; the opponents' one. Nevertheless, as Dr Colley pointed out, it was accepted under the old law - and no less so under the new - that, in terms of confusion based on pronunciation, the first syllable is the usually the most significant - see *London Lubricants (1920) Limited's Application* (1925) 42 RPC 264 at page 279, lines 36-40, where it is stated:

'..the tendency of persons using the English language to slur the termination of words also has the effect necessarily that the beginning of words is accentuated in comparison, and, in my judgment, the first syllable of a word is, as a rule, far the most important for the purpose of distinction.'
14. Finally, though conceptual similarity might be advanced as being the opponents weakest of the three, Dr Colley argued that both marks share an allusive pun on CLOSE and 'clothes'. I suggested that the applicants' mark indicated 'intimacy' and that of the opponents', if it indicated anything, 'inaccessibility,' and thus something exclusive, and therefore desirable (there is support for this in Exhibit WG3 where the strap-line 'Welcome to the CLOSED society' is employed). Against this, Dr Colley suggested the common theme between the two words was one of 'proximity', i.e. as in 'closer' and the close association found within a closed club.

15. I felt at this stage the discussion had become rather to far removed from the likely investment that the average consumer would make in deliberating on such connotations of the word. Rather, it seems to me that, in the context of point (b) above - the imperfect picture - the average consumer will likely be confused. Of course this is not a 'bag of sweets' case - consumers may take more time pondering purchases of clothing than they would with other, cheaper and less fashion driven products - however, set against a background of imperfect recollection - where the average consumer is neither to careful or to careless (*DaimlerChrysler AG v Alvi* [2001] All ER (D), paragraph 80) - and the importance of visual presentation in the choice of clothing - it seems to me that the case under 5(2)(b) is made out.
16. Dwelling, for a moment, on the issue of visual confusion, Dr Colley cited the type of confusion relied on by a less than scrupulous trader deliberately misspelling a famous brand name. Of course, he was not suggesting any such intention on behalf of the applicant - the opponents' mark was not a famous brand in the UK at the relevant date in any case - rather his point relates to the mechanism by which confusion might occur, and I think there is force in this submission.
17. In terms of costs, the opponents have won and should receive a contribution. I set this at £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 19 Day of June 2001.

**Dr W J Trott
Principal Hearing Officer
For the Registrar, the Comptroller General**