

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION No 717233
AND THE REQUEST BY INN CRYSTALVERTRIEBS GMBH
TO PROTECT A TRADE MARK IN CLASS 21**

AND

**IN THE MATTER OF OPPOSITION THERETO
BY WATERFORD WEDGWOOD PLC
UNDER No 70262**

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Background

1) On 22 June 1999, on the basis of a registration held in Germany, Forma-Kutzscher GmbH of Zwiesel, Germany requested protection in the United Kingdom of the trade mark **LISA MORI**. The registration was published with the following specification:

glassware, especially crystal and lead crystal glassware – class 21

The application in suit has an international priority date for 26 February 1999 emanating from Germany.

2) The United Kingdom Trade Marks Registry considered that the request satisfied the requirements for protection in accordance with article 3 of the Trade Marks (International Registration) Order 1996 and particulars of the international registration were published in accordance with article 10.

3) On 24 February 2000 Waterford Wedgwood Plc filed a notice of opposition to granting protection within the United Kingdom to the international registration.

4) On 31 October 2000 a change of ownership of the international registration was recorded to show the proprietor as Inn Crystal Vertriebs GmbH.

5) The opponent states that he is the registered proprietor of United Kingdom registration no 935152 of the trade mark **LISMORE** which is registered in respect of:

glassware included in class 21

6) The opponent states that the trade mark LISMORE has been used in the United Kingdom in relation to glassware from a date earlier than the priority date claimed for the application in suit. The opponent states that the respective trade marks are similar visually (by virtue of length and letter sequence) and/or phonetically . He states that the respective trade marks encompass identical goods. The opponent states that consequently the application should be refused pursuant to section 5(2)(b) of the Act. In considering this issue he states that the use and reputation of his trade mark should be taken into account.

7) The applicant filed a counterstatement in which he denies that the application in suit should be refused pursuant to section 5(2)(b) of the Act. In particular he states that LISMORE is visually, phonetically and conceptually “English” whereas LISA MORI is suggestive of the Italian language. He states that visually and conceptually LISA MORI is presented as a

personal name whilst LISMORE is not. Visually LISMORE is written as one word, whereas LISA MORI consists of two words. Phonetically LISMORE consists of two syllables whereas LISA MORI comprises four. Phonetically the strong suffix syllables unique to LISA MORI (“A” and “I”) are of equal importance as the prefixes. He states that the “A” syllable breaks up the phonetic elements “LIS” and “MOR”, and that the “I” syllable adds an unusual, and hence distinctive, strong ending to the mark LISA MORI. Phonetically the first element “LIS” is different in the respective trade marks. In LISMORE the element “LIS” is pronounced as in the English word “is”, whereas in LISA MORI, the “I” of the element “LIS” is pronounced in a more Italian way, such as “pizza”. In LISMORE the element “MOR” is pronounced as in the English word “or”, whereas in LISA MORI the element “MOR” is pronounced as in the English word “orifice”.

8) The applicant states that there is no likelihood of confusion between the trade marks. He states that in totality the respective trade marks convey different visual, phonetic and conceptual impressions. He admits that the respective trade marks encompass identical goods but denies that this is a salient point.

9) Both parties seek an award of costs.

10) Only the opponent filed evidence in the proceedings.

11) The matter came to be heard on 22 January 2002. The applicant was represented by Miss Fisher of Marks & Clerk, the opponent was represented by Mr Moody-Stuart of Counsel, instructed by D Young & Co.

Opponent’s evidence

12) The opponent’s evidence consists of witness statement dated 8 January 2002 by Redmond O’Donoghue, who is a director of the opponent.

13) Mr O’Donoghue states that the opponent is famous throughout the world for its handcrafted crystal glassware which is produced and sold under the trade mark WATERFORD. He exhibits at ROD 1 a document giving a condensed history of WATERFORD crystal. In ROD 1 only the following reference appears in relation to LISMORE:

“By 1951, Waterford Crystal was again launched on the world market with the now world-renowned LISMORE pattern leading the way.”

Mr O’Donoghue states that world wide turnover of WATERFORD glassware in 1998 was £187,136,000.

14) Mr O’Donoghue states that the trade mark LISMORE is used by the opponent as a sub-brand in relation to one of the longest established and most successful selling patterns of the WATERFORD Crystal Range. He states that the LISMORE stemware pattern was designed in 1951 and is the most popular stemware pattern ever produced. He states the LISMORE glassware was first sold in the United Kingdom in 1951. He states that a promotional campaign has been planned which will begin in the first quarter of 2001.

15) Mr O'Donoghue states that LISMORE glassware is available throughout the United Kingdom and he exhibits at ROD 3 a document listing the United Kingdom retailers of WATERFORD crystal and the LISMORE pattern. He states that the United Kingdom retailers selling LISMORE include numerous nationwide chain stores such as Debenhams, Alders, House of Fraser and John Lewis. He states that the list also includes major British companies such as British Aerospace Plc and Rolls Royce Plc and others. He states that the latter companies appear upon the list because the opponent supplies them with crystal which they use as corporate gifts.

16) Mr O'Donoghue states the sales figures for LISMORE glassware in the United Kingdom for the years 1996-2000 were as follows:

1996	£521, 180
1997	£637, 950
1998	£503, 758
1999	£482, 058
2000	£486, 967

He does not state if these figures relate to retail or wholesale prices. He states that LISMORE glassware was first sold in the United Kingdom in 1951.

17) Mr O'Donoghue exhibits at ROD 4 examples of the opponent's marketing materials. A catalogue entitled WATERFORD CRYSTAL which bears a copyright date of 1997. This includes a variety of crystalware, including the LISMORE pattern. A brochure entitled WATERFORD CRYSTAL *give the gift you love to receive*. This has a copyright date of 2000 and so emanates from after the relevant date. A further brochure entitled GIVE *the* GIFT YOU LOVE TO RECEIVE WATERFORD CRYSTAL. This brochure has a copyright date of 1999. At page 9 there is a reference to LISMORE VILLAGE, at page 14 to LISMORE CASTLE VASE, at page 18 two LISMORE vases, at page 24 to four LISMORE salad bowls, at page 26-27 to LISMORE stemware. At page 26 the following is printed:

“Waterford's Lismore pattern is probably the most popular stemware suite ever made. The classic simplicity of the shape, combined with the elegant cutting pattern has an everlasting appeal. Named after the 12th century market town in County Wexford, the Lismore pattern has captured the imagination of collectors all around the world. Lismore, is perhaps the most famous of Waterford's designs whose beauty and charm remain as wondrous in lavish settings today, as the very first time it was produced.”

At page 30 there is a table of the opponent's stemware range which includes details of the LISMORE range. At page 33 there is a reference to LISMORE on three occasions. At pages 34 and 35 there are tables of special order stemware, on each page there is a reference to LISMORE. At pages 36-39 LISMORE barware is displayed. At page 47 the LISMORE bridal knife is displayed. At page 61 LISMORE table items are displayed. At page 64 a LISMORE hurricane lamp and offset cake server are displayed. At pages 70 and 71 LISMORE chandeliers are displayed. There are nine inserts from catalogues displayed at ROD 4, these do not bear a date. These insets show examples of LISMORE stemware, vases, barware, table items, bowls, hurricane lamps, offset cake servers and chandeliers. There is exhibited a WATERFORD crystal retail price list with prices effective from 1 January 1996. This list shows 34 LISMORE items. There is an undated page displaying various items of LISMORE glassware. A further page, with a post-it attached bearing 1995, shows various

items of LISMORE stemware. It is to be noted that all the items exhibited also bear prominent reference to WATERFORD CRYSTAL.

18) Mr O'Donoghue states that the opponent does not promote/advertise separately its individual ranges but spends around £500, 000 annually on product line catalogues etc which include the LISMORE brand.

19) Mr O'Donoghue exhibits at ROD 5 the result of a search provided by the opponent's trade mark agents relating to United Kingdom trade mark records for LIS prefixed trade marks in class 21. He states that this search shows that the only LIS prefixed trade marks in the relevant class which relate to glassware are those of the opponent and the application in suit.

20) Mr O'Donoghue states that the opponent's main concern is the similarity of the respective trade marks in relation to their written form and pronunciation. He states that given that LISMORE is a world renowned crystal stemware pattern and that the application in suit encompasses identical goods obvious confusion and misrecollection could occur amongst customers. He states that in addition consideration should be given to the way that the respective trade marks might be pronounced by persons of varying ethnic origins/ regional dialects etc, in such cases any differences between the trade marks may be less apparent.

Decision

Grounds of opposition

21) The ground of opposition is under section 5(2)(b) of the Trade Marks Act 1994. The relevant provisions read as follows:

section 5:

(2) 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.

The term 'earlier trade mark' is defined in section 6 of the Act as follows:

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

(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.

Likelihood of confusion

22) In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723. It is clear from these cases that:-

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

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG* 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 Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* 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 BV v. Puma AG* 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 BV v. Puma AG* 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 Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* 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 BV v. Puma AG* 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 BV v. Puma AG* 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 CV v. Adidas AG* 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 Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 9 paragraph 29.

Comparison of goods

23) Both parties accept that the respective goods encompass identical goods. I will, therefore, say no more about this matter.

Comparison of signs

24) The trade marks to be compared are as follows:

Earlier registration:

LISMORE

Application in suit:

LISA MORI

25) Mr Moody-Stuart submitted that the basic principles in consideration of the issue of likelihood of confusion were not in dispute.

26) Mr Moody-Stuart commented that the respective signs should be considered by their overall impression rather than trying to dissect them excessively. This is an approach which I consider sensible. It is also an approach that is in line with the case law of the European Court of Justice. Mr Moody-Stuart stated that the respective signs commenced with the same three letters and both included the letters “MOR” in the same order. He accepted that the application in suit consists of two words. He submitted, however, taking into account the overall impression, and what the purchaser would retain in his memory, that the respective signs are visually very similar. Miss Fisher’s main submission in relation to visual similarity was that the earlier registration consists of one word whilst the application in suit consists of two words. A matter that in many circumstances would not be of great import, however, owing to the conceptual association of the application in suit (see below) it does seem relevant to me in the instant case.

27) Mr Moody-Stuart submitted that in considering aural similarity one should adopt “a fair and reasonable use” approach, however in adopting this approach it was necessary to consider all possible reasonable pronunciations. I consider that this is a practical and sensible approach. Mr Moody-Stuart submitted that the first vowel of LISMORE could be pronounced as a standard “i” sound or as an “ee” sound. On this basis the vowel sounds would respectively be as in “it” and in “meat”. I was not, and am not, convinced by this argument. I consider that, owing to the following letters, the public are likely to pronounce the first vowel as in “list”. I also consider that in the application in suit, as LISA is a well known female forename, the “i” sound in LISA will be pronounced as an “ee” sound. Consequently, I do not consider that the first vowels of each trade mark in “normal and fair use” will have the same sound. In relation to the first syllable of LISMORE Mr Moody-Stuart argued that the “s” sound could be pronounced as an “s”, as a highly sibilant “s” – as if it were a double “s” or as a “z” sound. He submitted that the “s” in LISA could also be pronounced in any of these three manners. Miss Fisher in her submissions submitted that the “s” sound in LISMORE would be pronounced as a soft sound as in “Lisbon”. The latter argument I do not find convincing. My own immediate way of pronunciation was with a sibilant “s” sound rather than with a “z” sound. I am equally unconvinced with Mr Moody-Stuart’s argument that the “s” in LISA would be pronounced as a single “s”. Owing to the vowel following the “s” I consider that the natural form of pronunciation is to say the “s” in “LIS” but also to add it to the beginning of the “a” also. I do concur, however, with Mr Moody-Stuart’s argument that the “s” could have a “z” sound; although again I believe that it will act as a double consonant. Mr Moody-Stuart submitted that the “MOR” sound in both trade marks would be pronounced in the same way, I cannot see how he could be other than correct in this submission. He conceded that the final “e” of the earlier sign would be silent. Mr Moody-Stuart also submitted that the “i” in the application in suit could be pronounced as an “ee” sound or as an “i” sound as in “eye”.

Again I am not convinced by this submission. The argument in relation to the latter case would seem to fly in the face of normal English pronunciation. Mr Moody-Stuart argued that the “a” in LISA is not dominant when the trade mark LISA MORI is spoken as a whole. He submitted that bearing in mind the possible pronunciations of the two trade marks that they were aurally similar.

28) In her submissions Miss Fisher commented that the earlier registration was one word whilst the application in suit was two words. She commented that LISMORE had two syllables whilst LISA MORI had four. She submitted that the “i” in LISMORE would be pronounced as the “i” in “Elizabeth” and that LISA had a hard “s” sound. Miss Fisher submitted that MORI would call to mind the polling organisation and be pronounced in that fashion.

29) As Mr Moody-Stuart indicated this is a difficult area to decide upon absent of expert evidence in relation to pronunciation. I have tried to be careful in considering the potential pronunciations and not to fall into error by assessing them simply on my own “gut feeling” and turning the consideration into one of pure subjectivism. I have tried eschewing considering that I am the personification of the average consumer. In considering the two trade marks I consider it is unproductive to consider each allomorph in isolation; the sound of the allomorphs will be dependant upon what comes after and before or indeed upon nothing coming after or before. Taking into account all the submissions made to me I consider that the possible pronunciations of the respective trade marks could be seen as follows:

LISMORE: lismor
lizmor

LISA MORI leessa moree
leezza moree

30) I do not agree with Mr Moody-Stuart’s argument that the “a” in LISA would be elided into the end of the trade mark and would not be a dominant element. I consider that the emphasis in LISA falls upon the letter “a”. In consideration of the respective signs it is necessary to take into account the well known premise of *Tripcastroid* 42 RPC 264 at page 279 that in assessing similarity the beginnings of words are more important than the ends. This decision reflects the way people speak and hear and so is as relevant under the new act as under the old. It is also the position that OHIM follows, for instance in decision no 1126/2000 – Official Journal 10/2000 at page 1506.

31) I consider that “lismor” is closer to “leessa moree” and “lizmor” is closer to “leezza moree”. Here I am just commenting on their relative closeness and not if they are indeed per se close and/or similar phonetically. I have come to the conclusion that there is a degree of phonetic similarity between the respective signs. If the matter rested solely on the issue of phonetic similarity the opponent would be in a reasonable position. However, as both parties agreed the issue relates to an overall comparison of the trade marks, and requires a global appreciation of them.

32) In relation to the issue of conceptual similarity the parties were at some distance. Miss Fisher argued that the application in suit would be seen as an Italian sounding full name and the earlier registration as a Celtic sounding place name. Mr Moody-Stuart did not seem to contest that LISA would be seen as a forename but did dispute that MORI would necessarily

be seen as a surname and certainly contested that LISMORE would be seen as a place name. LISMORE I know from the evidence is a town in County Wexford (see paragraph 17 above). Before reading the evidence I felt that LISMORE had the “flavour” of a place name. However, as Mr Moody-Stuart correctly pointed out I could not base my consideration of this point on such a subjective basis. I have nothing before me to indicate that the public would see LISMORE as a place name, and certainly nothing that would indicate that average members of the public in the United Kingdom would be aware that it is a town in the Republic of Ireland. Consequently, I consider that I cannot presume that it would be seen as a place name and as suggested by Mr Moody-Stuart I will consider it solely as if it were an invented word. In relation to Mr Moody-Stuart’s arguments as to whether LISA MORI would be seen as a full name I have greater difficulty. No one disputed that LISA is a well known female forename. I consider that the natural, and I would say automatic, reaction of seeing the forename LISA followed by MORI is to view the whole as a full name. It does not strike me that this is dependent on whether MORI is a surname. People are used to forenames being followed by surnames and there is such a variety of surnames that they do not need to recognise the word following a forename as a surname to make the assumption that it is a surname. I, therefore, concur with Miss Fisher’s view that the application in suit will have the conceptual association of being a full name. Consequently I believe that the earlier registration will be seen as an invented word, “a fantasy mark”, and that the application in suit will be seen as a full name. There is, therefore, a conceptual distance between the respective trade marks. Although not as great as there would have been if I could have accepted that LISMORE would be seen as a place name. An invented word of its nature does not have a conceptual association and so its position in a comparison of conceptual association is neutral. It simply does not have the conceptual association of the other trade mark, rather than having a different conceptual association.

Conclusion

33) In his submissions Mr Moody-Stuart did not rely upon the state of the register evidence, I believe correctly.

34) The opponent adduced evidence to substantiate a claim to a reputation in LISMORE.

In *Sabel BV v. Puma AG* [1998] R.P.C. 199 the European Court of Justice held that

“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 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 judgement does not state that one can add additionally to the already particularly distinctive; it uses “either” and “or”. Under *Sabel* where a trade mark is particularly distinctive the reputation is not going to add anything to the consideration of likelihood of confusion. Reputation can make a mark distinctive where it is was not before. Where a trade mark is particularly distinctive the reputation is not going to add anything to the equation. It strikes me that this interpretation is semantically correct as well as being logical. If the trade mark does not have a particularly distinctive character the public will differentiate between it

and other trade marks by small differences. However, where the trade mark without nurture is not particularly distinctive it can develop and obtain a particularly distinctive character owing to its reputation. Consequently the natural reaction to focus on small differences falls away as the public see the trade mark, through its reputation, as a distinctive trade mark of the proprietor. Reputation can lead the public to see a trade mark as an indicator of the goods or services of one proprietor and one proprietor only despite a limited inherent distinctiveness; reputation can bring the trade mark, which before use only whispers its name, to shout “I am the goods of this particular proprietor”. The reputation is the alchemist that turns base metal into gold. A particularly distinctive trade mark is already gold, it does not need the alchemist’s art. This is the position as I see it in *Sabel*.

35) However, in *Canon* the European Court of Justice whilst approving the above finding from *Sabel* found that reputation could have a wider effect upon the global appreciation. The court stated that:

“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”.

This finding links the issue of reputation to similarity of goods or services. It allows reputation to expand the potential parameters of what can constitute similar goods or services. In the instant case everyone accepts that identical goods are involved. Consequently *Canon* is not of relevance in relation to the issue of reputation. There is no issue in relation to the similarity of the goods.

36) I asked Mr Moody-Stuart if the opponent’s trade mark was prima facie distinctive how reputation would assist him. Mr Moody-Stuart stated that he considered the opponent’s trade mark is inherently distinctive. He agreed that he could accede to my view that reputation in the instant case would not assist the opponent if I treated the evidence filed as neutral, in that it did not shift the case against the opponent. I agreed that this would be my position. However, Mr Moody-Stuart did not abandon the claim to reputation. That was left on the table; quite correctly I believe as the position of reputation is contingent upon whether I find the trade mark to be particularly distinctive. Mr Moody-Stuart made submissions to substantiate the opponent’s claim to a reputation.

37) As I have said above if a trade mark is already particularly distinctive, and there is not an issue as to similarity of goods as per *Canon*, reputation cannot aid it. Some trade marks will already be close to being particularly distinctive and others a very long way from this. The former will require less nurturing than the latter. Consequently it would seem logical that one has to take a relative approach to the issue. The amount of reputation that one trade mark may require to become particularly distinctive will depend on how little distinctiveness it had in the beginning.

38) Adopting this relative approach I run into a problem in the instant case. If the opponent’s trade mark is already particularly distinctive the alchemist has no art to perform. The reputation is important in its effect, not for itself. I consider (see below) that the opponent’s trade mark is particularly distinctive prima facie. Consequently I have no relative level of reputation to consider. In case I am wrong in my view of the opponent’s trade mark being particularly distinctive, I will consider the evidence but can only then hypothesise on what the

effect that evidence would have if the trade mark was not particularly distinctive.

39) The evidence shows, I believe, use of the trade mark LISMORE over a lengthy period of time. It shows use in tandem with the house mark WATERFORD, the various evidence adduced into the proceedings always has a clear indication that the goods are those of WATERFORD. However, it is not uncommon for a sub-brand to be used in conjunction with a house mark and for the sub-brand to have a stand alone validity. One only has to think of goods such as confectionery and cars to know that this holds good. LISMORE is regularly described in the evidence as a pattern, as the applicant points out. However, LISMORE is also used with a ® sign, indicating trade mark usage. I believe that the public are aware of the meaning of this symbol and are likely to see it as a trade mark. In the catalogues pictures of the relevant goods are headed as LISMORE, without indication that this describes a particular pattern. I consider such use trade mark usage. That LISMORE is used in relation to a particular design does not stop it acting as a trade mark. Just as the name of a car acts as an indicator of its design, features etc as well as a trade mark. In relation to the effects of use of the trade mark Miss Fisher referred me to *Premier Brands U.K. Ltd v Typhoon Europe Ltd* [2000] FSR 767 and *Lloyd*. She submitted that the issue of whether LISMORE has acquired extra distinctiveness depends essentially on the evidence. Not a view with which I could imagine anyone disagreeing.

40) The evidence of the opponent indicates a long usage of his trade mark. However, I consider that it is necessary to consider the nature of the goods upon which it is used. To have a reputation it must be recalled and remembered by the public. I consider that crystalware, and the evidence shows use on crystalware and not on glassware at large, is an intermittent purchase. One does not regularly purchase these goods. It is quite likely that when one purchases the goods one is swayed by the house mark, as an indicator of quality and possibly vicarious kudos. However, in purchasing a particular range one is purchasing because of the design and function. These are the aspects that one is looking at. It is possible that in the shop one would not even be aware of the sub-brand. Once bought there is unlikely to be any post purchase reinforcement of the trade mark. What I mean by this is that for many goods when one uses them one is confronted with the trade mark again, whether it be chocolate or a computer. The trade mark presents itself each time the goods are used. (Or the goods are a regular purchase and so the regularity of the purchase reinforces the trade mark.) However, with crystalware one is not so confronted. If the trade mark is on crystalware it is likely to be etched into the base and not readily visible. I think in this context that even if one were aware of the sub-brand at the time of purchase it is likely to be soon forgotten. All that would remain in the memory is the name of the house mark. It could also be many years before one purchases further crystalware and so that there is no reinforcement from regular purchasing. I also note that all the evidence of ROD 4 is material that is likely to be for those who are interested in purchasing; have made the decision to make the intermittent purchase. It is not evidence that puts the trade mark before the public on a regular basis; as with television and magazine advertisements. Part of the public will be the specialised and limited public who retail the goods, but who in purchasing will be making very informed and careful decisions. This public may well be aware of the trade mark owing to their specialised knowledge. However, the major public will be the public at large. Those who purchase crystalware for themselves or for presents. Amongst this public the evidence does not convince me that the trade mark enjoys a reputation. I noted at the hearing that the opponent had failed to adduce into proceedings goods upon which the trade mark is used. Consequently, I can only rely upon my own experience of crystalware and the exhibits, the latter does not show use of the trade mark upon the actual goods. It may very well be upon the goods but I cannot see this

and I do not know how it is shown upon the goods. If it is on the goods and etched into the base the trade mark will not readily present itself. I also take into account that there will be a section of the public who will collect a particular range of crystalware; who wish to own a co-ordinated range of crystalware. Persons who may wish to buy further items in the design identified by the trade mark LISMORE. These persons are likely to be keep in mind the LISMORE trade mark and identify goods by this trade mark in future purchases. However, I have nothing before me to indicate how many purchases are repeat purchases of LISMORE goods and so I do not consider that this adds greatly to the opponent's claim to reputation.

41) Miss Fisher attacked the evidence of the opponent. She submitted that WATERFORD and LISMORE are inextricably linked in their use and that LISMORE designates one of a number of patterns and designs of the WATERFORD range. She submitted that without WATERFORD the sub-brand LISMORE would struggle to stand independently in the market place. She stated that there is no evidence that LISMORE goods have been sold without the support of the opponent's house mark. Miss Fisher stated that the onus is upon the opponent to demonstrate that his sub-brand enjoys a reputation. She asserted that the opponent has made little or no attempt to promote LISMORE as a trade mark or badge of origin of his goods. Miss Fisher commented upon the sales figures, particularly in view of the expense of the individual items. The general tenor of Miss Fisher submissions is that the turnover in respect of the goods sold under LISMORE is very limited. I do not know if the turnover figures are limited in respect of crystalware. I have nothing to compare them with. The opponent has not furnished figures to give an indication of the market share that this particular brand enjoys. Absolute figures, as adduced, tell me very little. They need to be tested against the market. I, for the reasons given above, consider that the opponent makes genuine trade mark use of LISMORE. I am not convinced by Miss Fisher's arguments that it falls into the limping trade mark character, even though it always sails under the colours of WATERFORD; just as an Escort always sails under the colours of Ford. In many of the examples of use it is used without reference to the house mark, even though within the catalogue of WATERFORD. However, I have reached the same conclusion as Miss Fisher in relation to the claim for a reputation, if not necessarily for the same reasons. My conclusion has been reached on the basis that the evidence does not show me what percentage of the market LISMORE goods enjoy. The promotion of the goods, as exhibited, is in a limited sphere; through the use of catalogues. There is no evidence exhibited to show how the trade mark is applied to the actual goods. The nature of the goods is such that I believe that once they have been purchased they will normally not be returned to their packaging. Consequently from the evidence before me I cannot see that there would be any post-purchase reinforcement of knowledge of the trade mark. The evidence before me demonstrates quite clearly that the opponent has used LISMORE for a long period of time but use is not the same as reputation; regardless of the length of use.

42) Consequently I would hold that if the opponent had needed to pray in aid to a reputation that his evidence would not convince me that he could do so, regardless of the amount of reputation that would be required relative to the inherent distinctiveness of the trade mark

43) Miss Fisher asserted that the LISMORE design is now in the public domain, as if this a damning point. The applicant has adduced no evidence in support of this. There is no proof that there is one design, the design could have varied over the years. However, even if it is the case that the actual design is in the public domain I do not see that it assists the applicant. It confuses the design with the name of the design. Even if the opponent no longer has exclusive rights in the design it does not follow that he has no rights in the name he uses for the design.

This is a trade mark matter rather than a design issue. That a third party may copy the design does not mean that he can also appropriate the trade mark also. Miss Fisher asserted that LISMORE is a generic term for glassware which may be used by third parties. In relation to the legal issues which arise from this she referred me to *Bach and Bach Flower Remedies Trade Marks* [2000] RPC 513. However, to seek assistance from *Bach* the applicant would have to show that LISMORE has indeed become a generic term. He has adduced no such evidence. This is mere assertion without a shred of supportive evidence. If the applicant wished to run this argument he should have adduced evidence into the proceedings in relation to this assertion. In the absence of any evidence to support the assertion of the applicant I dismiss the claim that LISMORE is a generic term.

44) As I have stated above I consider that the issue of reputation would only be of assistance to the opponent if his trade mark were not particularly distinctive. I have dismissed that argument of the opponent that it is generic. In my summary of the evidence I have quoted a piece from ROD 4 which identifies LISMORE as a market town in County Wexford, it is probably for this reason that the registration was advertised before acceptance. I have no evidence before me which indicates that LISMORE has a reputation for glassware; I have no evidence before me as to the fame or otherwise of the town. I need to consider whether the average consumer would be likely to see LISMORE as being a geographical location. I was not aware of the existence of the town, which could be owing to purblind ignorance. However, I have nothing before me which indicates that many other people would be aware of it. The applicant could have adduced evidence in relation to his point. In *Lloyd* the European Court of Justice stated:

“In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgement of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).”

I consider the LISMORE has a great capacity to identify the goods for which it is registered and without the succour of reputation can readily distinguish the goods for which it is registered from the goods of other undertakings. Consequently I find that LISMORE is a particularly distinctive trade mark and enjoys the subsequent protection of one. Taking into account my comments above re particular distinctiveness and distinctiveness acquired through reputation as being alternatives I do not consider that anything turns upon my finding that the opponent has failed to prove a reputation in respect of his trade mark.

45) In considering the issue of likelihood of confusion a variety of factors are relevant in the instant case, which for convenience I list below:

- interdependency principle – as the respective goods are identical less similarity between the signs could lead to the likelihood of confusion
- distinctiveness of the earlier trade mark – absent of reputation I have decided that the earlier registration is particularly distinctive.

- imperfect recollection – the public seldom compare trade marks side by side.
- the purchasing decision and action. Owing to the nature of the purchasing decision, which is very much dictated by design and purpose, the visual impact in the instant case is of great importance. I consider that the respective trade marks will be considered visually primarily, oral usage will be of secondary importance. I consider that in relation to this issue of visual identification there are strong parallels with *React trade mark* [2000] RPC 285, even though that case dealt with clothing.

46) I, of course, as per the judgements of the European Court of Justice have to consider the respective trade marks globally and so need to take into account all relevant factors that could lead to a likelihood of confusion or otherwise. Also as per the judgements of the European Court of Justice I need to consider the trade marks in their entirety. The public do not dissect trade marks, they consider them in their entirety. I also need to take into account that the average consumer is deemed to be reasonably well informed, observant and circumspect. I also bear in mind that I am concerned with normal and fair usage of the earlier trade mark as per *React*, which includes all items of glassware – not just the crystalware to which the evidence relates. Consequently the goods could be of very limited cost.

47) It is, of course, also the case for me to find that there is a likelihood of confusion that the respective signs have to be similar. This is what the Directive states and it is what is pointed out in *Sabel*:

“it is to be remembered that Article 4(1)(b) of the Directive is designed to apply only if by reason of the identity or similarity both of the marks and of the goods or services which they designate, “there exists a likelihood of confusion on the part of the public”.”

48) In considering the issues before me I have borne in mind especially the following from *Sabel* :

“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.”

49) Viewing the respective trade marks, taking into account imperfect recollection and that the respective trade marks may well be seen at very different times, I believe that the conceptual and visual differences of the respective trade marks will be very obvious and militate against any confusion arising from the phonetic similarities. I believe that the perception in the mind of the average consumer will be very different for each of the trade marks. (I take into account that in *Lloyds* it was held that phonetic similarity alone could give rise to a likelihood of confusion.) Although there are phonetic similarities the respective trade marks are not phonetically identical. The global appreciation takes into account how the trade marks are likely to be used in relation to the goods. I also consider that the nature of the goods is such that it is unlikely that they will normally be ordered by the average consumer by phone; the nature of the goods is such that they need to be viewed whether directly or by means of a catalogue.

50) In the instant case I have had some difficulty in reaching a decision as to whether there is a likelihood of confusion. I have hesitated in coming to a conclusion. However, in the end I have come to the conclusion that there is not a likelihood of confusion.

51) The applicant is entitled to a contribution towards his costs and I therefore order the opponent to pay him the sum of £435 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 08 day of February 2002

**D.W.Landau
For the Registrar
The Comptroller General**