

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2192656
BY CESARE ZANGHERI
TO REGISTER THE MARK FLAMINAIRE IN CLASSES 4, 16, 18 AND 34**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No 50847
BY FLAMAGAS SA**

TRADE MARKS ACT 1994

IN THE MATTER OF Application No 2192656

by Cesare Zangheri

to register the Mark FLAMINAIRE in Classes 4, 16, 18 and 34

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IN THE MATTER OF Opposition thereto under No 50847

by Flamagas SA

DECISION

1. On 24 March 1999 Mr Cesare Zangheri applied to register the mark FLAMINAIRE for the following specification of goods

Class 4:

Industrial oils and greases (other than edible oils and fats and essential oils); liquid gas; petrol; lubricants; fuels including motor spirit; illuminants; candles; tapers; night-lights and wicks.

Class 16:

Books; dictionaries; newspapers; comics; cartoons; periodicals; magazines; catalogues; booklets; leaflets; cards; registers; papers; cardboard; blotting papers; photocopying paper; book-binding articles; photographs; stationery; adhesive materials for office use; glues for office use; artists' supplies; painters' brushes; typewriters; punching machines for office purposes; metal clips; clip-pullers; puncher-clips; office perforators; instructional and teaching supplies; document folders; office collectors; playing cards; printing types; printing blocks or plates; stamp inking pads; stamps; stamp-holders; dating stamps; pencil sharpeners; office requisites; office materials; office seals; correcting rubbers; stationery and household adhesive tapes; paper rolls for calculating machines; pen-holders; ballpoint pens; pencils; fountain pens; chalk; letter clips.

Class 18:

Bags; handbags; suit-cases; knapsacks; brief-cases; purses; folders; skin and skin imitation document folders; gent's bags; trunks; skin; skin articles; leather and leather articles; skin and leather imitation and articles made of these materials; sun-shades; parasols; umbrellas; walking sticks; harness and other saddlery articles.

Class 34:

Unworked and worked tobacco; smokers' articles; pipes; lighters; cigarette holders;

cigar and cigarette cases; pipe stands; pipe cleaners; cigarette paper; cigarette filters; cigarettes; cigars; matches.

2. The application is numbered 2192656.

3. On 22 March 2000 Flamagas S.A. filed notice of opposition to this application. They are the registered proprietors of the following mark under No. 2008787



for a specification of goods which reads "lighters and smokers' articles". They also claim to have used the above mark and to enjoy a large reputation therein. Objection is said to arise as follows

- (i) under Section 5(2)(b) in so far as the application in suit covers identical and/or similar goods.

The opponents identify these as being the whole of the Class 34 part of the application

- (ii) under Section 5(3) in so far as dissimilar goods are concerned. The balance of the applied for specification covering Classes 4, 16 and 18 comes into this latter category.

4. The applicant filed a counterstatement denying the above grounds.

5. Both sides ask for an award of costs in their favour. Only the opponents filed evidence. Neither side has asked to be heard. Written submissions have been filed on behalf of the applicant under cover of a letter dated 13 March 2002 from Lewis & Taylor his UK Trade Mark attorneys.

6. Acting on behalf of the Registrar I give this decision on the basis of the papers filed.

7. Section 5(2)(b) 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."

8. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *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*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, 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.* 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*, paragraph 23;
- (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*, paragraph 23;
- (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*, 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*, 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*, paragraph 26;

- (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*, 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*, paragraph 29.

Distinctive character of the opponents' mark

9. In the written submissions filed on behalf of the applicant it is suggested that

"..... insofar as the Opponent's mark would be seen or pronounced as FLAMI, we contend that in relation to goods in Class 34 and in particular matches, lighters and the like the mark is inherently weak and that the Opponent's rights in the same must be interpreted restrictively. We say this since the stem 'FLAM' is closely related to 'flame' and 'flammable' and, hence, must be seen as highly meaningful in relation to the identity or purpose of such goods which is to create a flame or to make material flammable."

10. I have some sympathy with that view in so far as the earlier trade mark has the word FLAMI as one of the distinctive and dominant components. But the mark is more than simply the word FLAMI. It is that word presented in stylised lettering with the bar of the letter F and the dot of the letter i represented by twin elongated oval shapes. Additionally the letters a and m have the appearance of being incomplete. The stylisation contributes to and is part of the overall character of the mark without ever concealing the underlying word.

11. The opponents have also filed evidence under cover of a statutory declaration by Paul John Kelly, their trade mark attorney. He exhibits at PJK2 a selection of copy invoices. Only four are prior to the relevant date of 24 March 1999. Two show pound sterling sums owed amounting to just over £6000. The other two appear to be denominated in deutschmarks and amount to about DM 10,500. The invoices relate to FLAMI or FLAMMI lighters. Given the different spelling on the invoices I am not clear whether all or any of the invoices relate to the mark at issue. Nor is it possible to say whether the recipients of the invoices are UK wholesalers, retailers or distributors. The only other item of evidence in support of the claim to use is Exhibit PJK3 which is a trade brochure headed CLIPPER lighters and smoking accessories. Contained within the brochure are photographs of display packs of lighters branded CLIPPER FLAMI (stylised). A number of other marks are also in use in conjunction with the word CLIPPER. The brochure is in 3 languages including English. It is clearly, therefore intended for a number of markets. No information is given about its distribution or use in the UK.

12. This evidence taken as a whole is slight and cannot conceivably support the opponents' claim to any enhanced degree of distinctive character for their earlier trade mark.

Similarity of goods

13. To the extent that lighters and smokers' articles appear in both parties' specification of goods I consider that identical goods are involved. The applicant's specification contains a number of other items in Class 34 over and above lighters and smokers' articles. The opponents contend that they are all similar. No argument has been provided either for or against that proposition. I am prepared to accept that the term smokers' articles may include some of the paraphernalia of smoking and that even if that is not the case items such as 'pipes', 'cigarette holders', 'cigar and cigarette cases', 'pipe stands', 'pipe cleaners', 'cigarette paper', 'cigarette filters' and 'matches' are likely to be similar having regard to the criteria set down in the CANON and TREAT cases, [1999] ETMR1 and [1996] RPC 281 respectively. I am less persuaded that 'unworked and worked tobacco', 'cigarettes' and 'cigars' can be said to be similar on the basis of the above criteria.

Similarity of marks

14. I am required to consider the matter from a visual, aural and conceptual standpoint taking account of the distinctive and dominant components of the marks. The matter is to be judged through the eyes of the average consumer (essentially smokers) but making due allowance for imperfect recollection and sequential rather than concurrent encounters with the marks.

15. The applied for mark has a clear point of visual similarity with the earlier trade mark to the extent that the first and most prominent element of FLAMINAIRE contains one of the distinctive and dominant components of the earlier trade mark. But even allowing for imperfect recollection the visual similarity between the marks is limited in scope. The greater length of the applied for mark and the stylisation of the earlier trade mark combine to reduce visual similarity to a relatively low level.

16. Nevertheless it is doubtful whether the stylisation of the earlier trade mark is such that customers would attempt to order goods by reference to the way the word FLAMI is presented. More likely they would simply ask for or choose goods by reference to the underlying word. Aurally, therefore, the applied for mark is more likely to capture one of the main features (in my view the dominant one) of the opponents' mark. Even so the additional syllable on the mark applied for reduces the likelihood of direct confusion. I will return to indirect confusion/association below.

17. Conceptually it would not be surprising if customers considered that the respective marks contained a reference to flame, flammable etc as the applicant suggests. To that extent there is an element of conceptual similarity between the marks but it is partially offset by the fact that it is an allusive element given the nature of the goods (particularly lighters, matches etc).

Likelihood of confusion

18. Taking all the above factors into account and applying a global test there is only a very weak case for finding that there is a likelihood of direct confusion in the sense that one mark will be mistaken for the other. The real issue, it seems to me, is whether there is a likelihood of confusion arising from the presence of FLAMI in both marks (albeit stylised in one). In

particular if an association is made would it be inconsequential in the sense that customers encountering the applicant's mark would be put in mind of the opponents' mark but without considering that goods offered under those marks came from the same trade source. Alternatively would customers consider, despite noting the differences between the marks, that the underlying goods (which may be identical or closely similar) came from the same or economically linked undertakings within the meaning of the CANON test. The question I have asked myself is whether customers would be likely to think that the applied for mark represented a variant form or development of the mark belonging to the opponents which they had previously encountered. That is, I think, a finely balanced argument and it is not without hesitation, therefore, that I have concluded that there is a likelihood of confusion arising from an origin association being made between the marks at least in so far as identical and closely similar goods are concerned.

19. The Section 5(2)(b) case is only based on the Class 34 part of the specification, I find that the opponents have made out their case against all goods in Class 34 other than "Unworked and worked tobacco, cigarettes and cigars".

20. The Section 5(3) case is brought against the balance of the specification applied for. Section 5(3) reads

"5.-(3) A trade mark which -

- (a) is identical with or similar to an earlier trade mark, and
- (b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark."

21. Section 5(3) extends a wider penumbra of protection to marks that enjoy a reputation. Guidance on the nature and extent of that reputation was provided by the European Court of Justice in *General Motors Corporation v Yplon SA* [1999] ETMR 950 to the effect that

"26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it."

22. The opponents' evidence (as outlined above) falls a long way short of establishing that their earlier mark is known by a significant part of the public concerned by the goods

concerned. Nor has any explanation been offered as to why the opponents would suffer any of the adverse consequences envisaged by Section 5(3) if the applied for mark was to be registered in respect of dissimilar goods. I dismiss this ground.

23. The application will be allowed to proceed to registration if, within 28 days of the end of the appeal period, the applicant files a Form 21 restricting their specification to the goods of Classes 4, 16 and 18 as applied for along with "unworked and worked tobacco; cigarettes and cigars" in Class 34. If the applicant does not file a Form TM21 restricting his specification in the above manner the application will be refused in its entirety.

24. The opponents have been successful in relation to part of the Class 34 specification but unsuccessful as regards the other classes and certain goods within Class 34. In these circumstances it seems to me that the applicant is entitled to consider that he has been largely successful and to receive an award of costs reflecting this fact. Accordingly I order the opponents to pay the applicant the sum of £300. 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 2ND day of April 2002

M REYNOLDS
For the Registrar
the Comptroller-General