

TRADE MARKS ACT 1994

IN THE MATTER OF AN APPLICATION BY BEN JAMES TO  
REGISTER TRADE MARK NO. 2306188 IN CLASSES 9 AND 25

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**DECISION**

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**Introduction**

1. On the 24<sup>th</sup> July 2002 Mr. Ben James (“the Applicant”) applied to register the trade mark set out below:

*Ben James*

in respect of the following goods:

Class 9 :       Optical contact lenses, spectacles and sunglasses.

Class 25:       Clothing, footwear, headgear.

2. Objection was taken under section 5(2) of the Trade Marks Act 1994 (“the Act”) on the basis of the following two earlier registrations of the trade mark BENJAMIN JAMES:  
  
UK Trade Mark No. 2161756 registered in respect of ties, but not including knitted ties.  
  
Community Trade Mark No. 885913 registered in respect of articles of clothing; articles of men’s clothing, ties, cravats, cummerbunds and waistcoats; scarves.

3. The matter came on for hearing before Mr. Pike, the Hearing Officer acting for the Registrar. By a written decision dated the 31<sup>st</sup> March 2003, he noted there was no conflict in respect of the application in Class 9, but upheld the objection in relation to the application in respect of Class 25. It is against that decision that the Applicant appeals.

### **The Appeal**

4. Upon the hearing of the appeal the Applicant appeared in person. Mr. Morgan appeared on behalf of the Registrar.
5. In the recent case of *Dyson Ltd's Trade Mark* [2003] EWHC 1062, Patten J. considered the correct approach to appeals from decisions of the Registrar in *ex parte* proceedings concerning section 3 of the Act. He said, at paragraph 14:

"... it seems to me that most (if not all) of the points which are likely to arise on a s.3 appeal will be capable of being raised and adjudicated upon in the context of an appeal by way of review. This is the accepted form of appeal from an *inter partes* hearing and it adequately recognises and respects the expertise of, and the procedures adopted by, the hearing officer. For these reasons I do not accept that Art. 6 compels the Court to conduct a re-hearing in the case of any appeal from an *ex parte* decision. The power is there and may be exercised in the rare cases when it is necessary in order to allow justice to be done. But in an ordinary case (of which this is one) a review should be the norm, and an appeal of this kind will enable any sustainable challenge to the hearing officer's treatment of the evidence to be adequately dealt with."

I believe that Patten J's reasoning applies equally to appeals to an Appointed Person and to *ex parte* decisions in respect of objections taken under section 5

of the Act. Accordingly such appeals should be by way of review, save where it is necessary to conduct a rehearing in order to allow justice to be done.

6. In the present case the Hearing Officer considered the objection under section 5(2) in a conventional manner. First of all he set out aspects of the guidance provided by the European Court of Justice in *Sabel BV v. Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v. Metro Goldwyn-Mayer Inc* [1999] ETMR 1; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel BV* [2000] FSR 77 and *Marca Mode CV v. Adidas AG* [2000] ETMR 723. The Hearing Officer had no evidence before him and so he then proceeded to consider the respective goods and marks in issue in order to determine whether or not, in his view, there existed a likelihood of confusion on the part of the public. I do not believe there is any aspect of the case or of the decision of the Hearing Officer which makes it necessary for me to conduct the appeal by way of rehearing in order to allow justice to be done. Therefore, the appeal must be by way of review.

7. The Applicant submitted that the Hearing Officer fell into error in a number of respects. First, he submitted that the Hearing Officer failed to take due account of the fact that the mark applied for is clearly stylised and comprises the word BEN rather than the word BENJAMIN. He submitted that it is the visual impact of the mark which is important in considering the goods in issue and that the mark the subject of the application has a “youthful” image whereas the earlier trade marks have a much more “formal” image.

8. I accept that Mr. James has fairly identified differences between the marks in issue. Nevertheless, it is important to have in mind that this tribunal must consider the overall impressions created by the marks, bearing in mind their distinctive and dominant components. I believe that the overall impression created by each of the marks is extremely similar. They both consist of a forename and surname. The surname is in each case identical. The forename is one case BENJAMIN and in the other case BEN, the latter being a well known shortened form of the former. Moreover, albeit that the Applicant's mark is written in a stylised form, it is not one which is particularly unusual. Accordingly, I believe that conceptually and visually the marks are very similar. Moreover, when the marks are considered aurally, the particular script in which the Applicant's mark is written ceases to be a relevant distinction.
9. Secondly, the Applicant submitted that the goods and targeted markets in issue were different. I am unable to accept this submission. The earlier trade mark No. 885913 is registered in respect of articles of clothing. The mark the subject of the application is sought to be registered in respect of "clothing, footwear, headgear". The goods are therefore identical. As to the target markets, this tribunal must consider any normal and fair use of the earlier trade marks and any normal and fair use of the mark applied for. That clearly includes clothing sold into the same markets.
10. Finally, the Applicant referred to a number of examples of similar trade marks which he had extracted from the database on the Patent Office website. He

suggested that these illustrated that the practice of the Registrar was to allow registration of marks which were at least as similar to those in issue in these proceedings. He also referred to two famous people, Michael Jackson and David Beckham and suggested that they would never be confused with “Mike” Jackson or “Dave” Beckham respectively.

11. In my judgment such arguments do not assist to resolve the issue in the present case. The Hearing Officer had to determine whether or not, in the light of the fact the goods in issue were identical, the similarity of the marks was such that there existed a likelihood of confusion on the part of the public. He had to consider that matter through the eyes of the average consumer of the goods in question. I do not believe that the presence of other marks on the Register, which may or may not have been used, assists in determining how the average consumer would perceive the marks in issue. Similarly I do not believe it assists to refer in general terms to well known personalities such as Michael Jackson and David Beckham and consider hypothetical situations which may or may not result in confusion. The likelihood of confusion must be appreciated globally by taking account of all relevant factors in the particular case in issue. They are likely to vary from case to case. For example, there can be no doubt that Michael Jackson and David Beckham have international reputations. By contrast, there is no suggestion that the marks in issue have acquired any enhanced distinctiveness through use.

12. The Hearing Officer correctly directed himself as to the relevant considerations in assessing the likelihood of confusion; he identified the

visual, aural and conceptual similarities of the marks while recognising the differences between them. He came to the conclusion that, bearing in mind imperfect recollection, such consumers would be likely to confuse the marks, or assume that they were variant marks used by the same undertaking. I believe that Hearing Officer came to the correct conclusion. I have been unable to detect any error in his approach or in his assessment of the marks in issue. Accordingly the appeal must be dismissed. I direct that the case be remitted to the Registrar in order that the appropriate steps may be taken to allow the application to proceed in relation to the goods in Class 9.

David Kitchin QC

1<sup>st</sup> October 2003