

O-323-03

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2227410
BY JOANNE BAUM
TO REGISTER THE TRADE MARK:**



IN

CLASSES 41 AND 42

AND

**THE OPPOSITION THERETO
UNDER No 51425
BY TERRA NETWORKS, SA
BASED UPON THE EARLIER TRADE MARKS:**

TERRA

AND OTHERS

Trade Marks Act 1994

In the matter of application no 2224710

by Joanne Baum

to register the trade mark:



in classes 41 and 42

and

the opposition thereto

under no 51425

by Terra Networks, SA

BACKGROUND

1) On 28 March 2000 Joanne Baum applied to register the above trade mark. The application was published for opposition purposes in the "Trade Marks Journal" on 14 June 2000. Subsequent to the filing of the opposition the specification was limited to the following services:

providing of training relating to body piercing, tattooing, body painting and henna painting;

body piercing services; jewellery design services; tattoo and body art design services; tattooing, body piercing and body painting and henna painting; medical, hygiene and beauty care; advisory services relating to body piercing.

The above services are in classes 41 and 42 respectively of the International Classification of Goods and Services.

2) On 14 September 2000 Terra Networks, SA, which I will refer to as Terra, filed a notice of opposition to this application. Terra relies upon five Community trade marks and one United Kingdom trade mark. All of these are now registered trade marks. The actual trade marks upon which Terra relies are as follows (only five are reproduced as the United Kingdom registration is identical to one of the Community registrations):

TERRA



InstanTerra

EDUCATERRA

Terra claims that it has a substantial international business conducted under trade marks consisting of or containing the word TERRA. It states that the above registrations encompass *education and training* and/or *medical, hygienic and beauty care* and one registration includes *jewellery and precious metals and their alloys and goods in precious metals or coated therewith*. Terra claims that the application is similar to its trade marks consisting of or containing the word TERRA and that the goods and services referred to above are identical or similar to those encompassed by the application. Consequently, registration of the Ms Baum's trade mark would be contrary to section 5(2)(b) of the Act. Terra seeks refusal of the application and an award of costs.

3) Ms Baum filed a counterstatement in which she denies the grounds of opposition. She requests that the application proceeds to registration and seeks an award of costs.

4) Neither side filed evidence.

5) After the completion of the evidence rounds both sides were advised that it was believed that a decision could be made without recourse to a hearing. However, the sides were advised that they retained their rights to a hearing. Neither side requested a hearing, so I will make a decision after a careful study of the papers. Neither side filed written submissions.

Likelihood of confusion - section 5(2)(b) of the Act

6) According to section 5(2)(b) of the Act a trade mark shall not be registered if because

“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.”

Section 6(1)(a) of the Act defines an earlier trade mark as:

“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”

7) All of the trade marks upon which Terra relies are earlier trade marks as defined by section 6(1)(a) of the Act.

8) 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] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77.

9) No evidence has been filed by Terra to show use of its trade marks. It, consequently, cannot rely upon a family of trade marks argument, which is dependent upon use in the market place. Community trade mark registration no 1343227 is for the trade mark TERRA on its own. It includes *education and training and medical, hygienic and beauty care* in its

specification. All the other trade marks have additional matter which give rise to greater differences between them and Ms Baum's trade mark. Community trade mark registration no 1343227 also includes all the services which Terra considers clash with the services of the application with the exception of *jewellery and precious metals and their alloys and goods in precious metals or coated therewith* (class 14 goods), which are only included in the specification for Community trade mark registration no 1332691 of:



Consequently, I cannot see that Terra can be in any better position with any other of its registrations and so I will deal solely with these two registrations. In the case of 1332691, I will confine myself to considering the class 14 goods as it is only in respect of these goods that Terra is in a better position, owing to the additional device element in the relevant trade mark.

Comparison of goods

10) As stated above Terra's registrations include *education and training and medical, hygienic and beauty care*. Ms Baum's application is for the following services:

providing of training relating to body piercing, tattooing, body painting and henna painting;

body piercing services; jewellery design services; tattoo and body art design services; tattooing, body piercing and body painting and henna painting; medical, hygiene and beauty care; advisory services relating to body piercing.

There is no limitation to *the education and training services* of Terra's registration and so they must encompass the training services of the application. Consequently, the respective services must be identical.

11) *Medical, hygiene and beauty care* of the application must be encompassed by *medical, hygienic and beauty care* of the earlier registration and so the respective services are identical.

12) The European Court of Justice in *Canon* held in relation to the assessment of the similarity of goods and/or services, that the following factors, inter alia, should be taken into account: their nature, their end users and their method of use and whether they are in competition with each other or are complementary. Neuberger J in *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267 stated:

"I should add that I see no reason to give the word "cosmetics" and "toilet preparations" or any other word found in Schedule 4 to the Trade Mark Regulations 1994 anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context. In particular, I see no reason to give the words an unnaturally narrow meaning simply because registration under the 1994 Act bestows a monopoly on the proprietor."

I will give the words in the specifications their natural meaning, but within the context that they appear in a specification derived from the International Classification of Goods and Services. I also bear in mind the comments of Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* where he stated:

“When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all a trade mark specification is concerned with use in trade.”

I take on board the class in which the goods or services are placed is relevant in determining the nature of the goods and services (see *Altecnic Ltd's Trade Mark Application* [2002] RPC 34). In relation to the comparison of services I firmly bear in mind the comments of Jacob J in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

13) I can see no relevant connection between *jewellery design services* and the services of 1343227. However, 1332691 includes jewellery. There is no limitation to the *jewellery design services* of the application and so this term will include designing jewellery for individual customers. The customer seeking such a service will be seeking an item of jewellery, consequently he or she is the same end user as for the *jewellery* of the earlier registration. The normal result of *jewellery design services* will be the obtaining of jewellery; so the customer ends up with the same goods as covered by the earlier registration. Jewellery needs to be designed, a jewellery design service will give rise to the production of jewellery. There is, therefore, a mutually dependant and symbiotic relationship between *jewellery design services* and *jewellery* and the goods and services are complementary. In my (limited) experience, certain jewellers as well as selling “ready-to-wear” jewellery also supply “bespoke” jewellery. Consequently, the goods and services could be supplied by the same undertaking. Taking all these factors into account, I consider that *jewellery design services* and *jewellery* are highly similar.

14) I cannot see that any of the remaining services of the application would fall within the ambit of *medical and hygienic services*; nor can I see that there are any relevant coincidences between the services based upon the *Canon* criteria. The question, in my view, falls to whether the remaining services are within the ambit or are similar to *beauty care*. I have no evidence before me upon this matter so must try and make the best fist of it as I can from my own knowledge. I am aware of various establishments which supply a variety of services which include body piercing, tattooing, tanning, facials, depilation and the like. It strikes me that it would be natural to consider that the general term *beauty care* could be used to describe this conglomeration of services. I assume that those who undergo the rigours and pain of such treatments do so in the belief that they are beautifying their bodies. I am of the view that the general term *beauty care* will encompass:

body piercing services; tattoo and body art design services; tattooing, body piercing and body painting and henna painting; advisory services relating to body piercing.

If it does not encompass the above services, the respective services are so closely linked that

there must be a very high degree of similarity.

15) To sum up, the services of the application, with the exception of *jewellery design services*, are identical to the services of 1343227 and the goods of 1332691 are highly similar to *jewellery design services*.

Comparison of trade marks

16) The trade marks to be compared are:

Earlier trade marks:

Application:

TERRA

The logo for Terra-pin features a stylized circular icon on the left, followed by the text "Terra-pin" in a bold, sans-serif font. Below "Terra-pin" is the tagline "the body piercers" in a smaller, lowercase font.The logo for terra consists of the word "terra" in a lowercase, sans-serif font, followed by a square icon with rounded corners and a white square cutout in the center.

17) 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). 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). I take into account 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 BV* page 84, paragraph 27).

18) The sole area of similarity is the word TERRA. “Collins English Dictionary” (5th Ed 2000) gives twenty five definitions of the word pin. Only the third and fourth have any potential relevance in relation to the services in question in this case:

“3. an ornamental brooch, esp. a narrow one. 4. a badge worn fastened to the clothing by a pin”.

Consequently, the word pin can refer to jewellery and so the consideration of the similarity of the signs in relation to *jewellery design services* will need to take into account this matter. However, only the terra and device trade mark is of relevance in relation to *jewellery design services*. I am not aware that pin, in respect of the other services, has any direct meaning in relation to the services. Although certain of the services might pin metal to the body this is a somewhat distant allusion.

19) I will deal with the word only trade mark TERRA first. Terra, owing to the additional device element of the other trade mark, can only possibly be in a better position in relation to the other trade mark in so far as it relates to *jewellery*. I will deal with this trade mark in relation to the *jewellery design services* of the application discretely and later.

20) Terrapin is a well known English word for a type of reptile which is similar, at least in looks, to turtles and tortoises. I do not see that the hyphen will change the conceptual meaning of the trade mark of Ms Baum. Terra will, for many, mean earth as in the phrase terra firma. Consequently, the two trade marks have different conceptual associations. It is not just that there is an absence of conceptual similarity but there is a clear and definite conceptual dissonance. There is obvious conceptual dissimilarity.

21) The trade mark of the application includes a device element, of some size, the word pin and the word “the body piercers”. In the context of certain of the services “the body piercers” will be acting as a descriptor and so will have little effect upon the comparison of signs. However, there are clear visual differences between the trade marks, differences which are reinforced by the conceptual differences which cannot be divorced from the visual comparison, the mind does not compartmentalise in its perception of stimuli. I consider that visually the respective trade marks are not similar.

22) The word pin has a strong and definite sound. It is not something that will tail away after the enunciation of the word terra. In oral use the mind is likely also to make a firm association with the word terrapin and so lessen any chance of confusion. I consider that the respective trade marks are not phonetically similar.

23) I conclude, inevitably, from the above that the respective trade marks are not similar.

24) I now return to:



and *jewellery* and *jewellery design services*. The issue boils down to whether the average consumer is likely to see Ms Baum’s trade mark as indicating pins designed by Terra. The services of Ms Baum are not the goods, so there is not a direct connection with pins. There is no evidence to suggest that it is normal for jewellery designers to specialise in pins; it would, anyway, strike me as somewhat unlikely. Pin is not a word that, in my experience, is commonly used in English to describe items of jewellery. Brooches are usually described as brooches, not as pins. It is possible that pin is used as a synonym for badge. However, although I have come across this use in French I have never come across it in English. Again, there is no evidence to tell me what the situation is. I have to rely on my own experience. Even if pin is used to mean badge I do not consider that this is of importance, as badges would not normally be described as jewellery. I consider that even in relation to *jewellery design services* the average consumer is going to see Ms Baum’s mark as meaning the reptile and not as relating to pins designed by Terra. Consequently, Terra is on no better a footing in relation to 1332691 and the *jewellery design services* of the application than in relation to 1343227 and the other services of the application. Phonetically the position must be as for 1343227. Visually, owing to the presence of the device, Terra is in a worse position than for 1343227.

Consequently, the trade mark the subject of 1332691 is not similar to Ms Baum's trade mark.

Conclusion

25) For there to be a likelihood of confusion trade marks have to be similar. If they are not similar it does not matter how distinctive the earlier trade mark(s) is or how close the goods and/or services are. Confusion arises because of the similarity of signs, where a later trade mark captures the distinctive characteristics of an earlier one. **In this case I have found that the signs are not similar and so the claim that there is a likelihood of confusion must be dismissed.** I have considered the potential effects of imperfect recollection and the nature of the respective goods and services. Owing to the strong conceptual differences between the trade marks and the visual and phonetic differences, I cannot see that just because the average consumer will seldom have the chance to directly compare the trade marks that he or she will mistake them. The services of the application will normally take some time in being supplied and the consumer is likely to take some care in their purchase. He or she is likely to be circumspect as to whom he allows to practice upon his or her body. *Jewellery design services* are likely to require consultation and some time in discussion. I am of the view that the nature of the services further militates against confusion arising.

26) Ms Baum having been successful is entitled to a contribution towards her costs. I order Terra Networks, SA to pay Joanne Baum the sum of £500. 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 23rd day of October 2003

**David Landau
For the Registrar
the Comptroller-General**