O-179-06

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 2369217 TO REGISTER A TRADE MARK IN CLASS 14 and 25

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BACKGROUND

1. On the 28th July 2004 M3dia Products Ltd, of Intouch House, Riverside Drive, Clekheaton, Bradford, BD19 4DH, applied to register the following mark:

and the word 'moodies' presented in a similar font,

in respect of:

> Class 14: Articles of jewellery, articles of jewellery with precious stones, articles of jewellery with ornamental stones, artificial jewellery, bands for watches, bangles, bracelets, brooches, charms, faces for watches, fashion jewellery, finger rings, fobs for keys, jewellery in form of beads, jewellery made of crystal, jewellery made of plastic, jewellery made of semi precious materials, key charms (trinkets or fobs), necklaces, personal jewellery, rings (jewellery), straps for wrist watches, watches.
>
> Class 25: Clothing, footwear, headgear.

2. On the 30th July 2004 the applicant was contacted by telephone and informed that his application did not constitute a 'series' of marks. The mark MOODIES (stylised) was deleted from the application and the case proceeded for the single mark 'MOODY LITTLE MADAMS' shown above.

3. An examination report was issued on the 18th November 2004 in which objection was taken under Section 5(2) of the Act in respect of the following registered marks:-

Registration 2178509

LITTLE MADAM

in the name of Broadstreet Global Activities GmbH in respect of

Class 25: Clothing; footwear; headgear.

4. On the 8th April 2005 Mr McGowan (the applicant) called the registry to discuss his application. The examiner who dealt with this query issued an official letter on that day. The letter stated that the examiner was satisfied that the Section 5(2) objection was valid and granted additional time for Mr McGowan to seek legal advice.

5. Briffa Intellectual Property and Information Technology Lawyers then wrote to the registry on Mr McGowan's behalf on the 7th June 2005. It was argued that case law (Sabel BV v Puma AG [1998] RPC 199) stated that a global comparison of the marks MOODY LITTLE MADAMS and LITTLE MADAM is required. They stated that Mr McGowan's mark was visually, aurally and conceptually distinct from the earlier registration. Moreover the additional concept of 'moodiness' in the applicant's mark further distances them.

6. An official letter from the registry was sent on the 15th June 2005. The examiner maintained the objection and suggested that the case proceeded to a hearing.

7. Mr McGowan replied in writing on the 30th June 2005 re-stating the view that the term 'moody' in his mark imparted a conceptual difference which had not been given sufficient weight during the discussion.

8. On the 12th July an official letter was sent to Mr McGowan maintaining the objection. Mr McGowan was offered a hearing or refusal.

9. On the 22 July 2005 Mr McGowan wrote to the registry bringing his letter of the 30th of June to the office's attention. He went on to state that 'I will if I need take my application to a hearing but I maintain that my application has been misinterpreted and should not need to be taken to a hearing.'

10. On the 2 August an examiner wrote to Mr McGowan pointing out that a response to his letter of the 30th June had been sent. The letter stated that the objection appeared (in the examiner's opinion) well founded. In the letter the examiner stated that he would pass the file on for a hearing to be arranged.

11. A hearing was held on the 29th November 2005. At the hearing Mr McGowan brought exhibits of his mark and showed examples of T shirts and clothing that would have the mark applied to it. He stressed the fact that the mark would be used in the context of clothing aimed at children aged nine and upwards. He argued that in reality these factors, coupled with the inherent difference created by the presence of the word 'moody' with regards his own application were sufficient to avoid confusion. Mr McGowan's submissions were rejected because it was felt that, notwithstanding the points made by Mr McGowan, there was too great a similarity between the marks in relation to clothing.

12. On the 21st December 2005, having received no further correspondence from the Agent, the application was refused under Section 37(4) of the Trade Marks Act. Mr McGowan requested a formal statement on February 1st 2006. I am now asked under Section 76 if the Trade Marks Act (1994) and Rule 62(2) of the Trade Marks Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it. In the event that my decision is not appealed, the application can proceed in Class 14.

DECISION

Comparison of marks (Section 5(2))

The Law

13. **Section 5(2)** of the Act 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."

14. An earlier trade mark is defined in Section 6(1) which states:

> "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,"

15. I take into account the guidance provided by the European Court of Justice (ECJ) in the following cases: *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 BV*. [2000] F.S.R. 77

16. It is clear from these cases that:

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

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*. The average consumer 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 kept in his/her mind. *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV;*

(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;*

(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;*

(e) A global assessment of the likelihood of confusion implies some interdependence between the relevant facts, and in particular a similarity between the trade marks and between these goods or services. Accordingly, a lesser degree of similarity between these goods and services may be offset by a greater degree of similarity between the marks and vice versa. *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc;*

(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;*

(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;*

(h) 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.*

17. The global comparison of marks therefore means that a number of elements must be analysed before effective judgement can be made.

Prima Facie Comparison

Comparison of marks

18. The earlier trade mark 2178509 is a registered mark and is therefore deemed to be valid (Section 72 of the 1994 Trade Marks Act refers). The earlier mark consists of the words LITTLE MADAM. This compares with the applicant's mark, which consists of the words MOODY LITTLE MADAMS in a stylised form. The mark applied for is purple in colour.

Comparison of goods

19. Citation 2178509 covers 'Clothing; footwear; headgear.' These goods clash with the applicant's class 25 specification for 'clothing, footwear, headgear.'

Likelihood of confusion

20. According to the guidance laid down by the European Court of Justice, the likelihood of confusion must be assessed using a global comparison, taking into consideration all the relevant factors mentioned above. The issue at stake can, for the sake of simplicity, be summarised as follows: 'is it reasonable to assume that an average consumer of clothing would believe that goods sold by the applicant under the mark applied for originated from the same source as those protected by the earlier registration?'

21. The average consumer is considered to be reasonably circumspect; however, he or she must be understood as having an imperfect recollection of any two marks. Confusion is not likely where a shopper can stand in front of two products and measure the differences in their branding. Confusion occurs when a consumer encounters one product some time after the other. Here we must understand that a holistic analysis occurs in the mind of the average consumer. The consumer does not disassemble marks in their mind; the memory of one whole is compared with the next. In situations where marks are highly distinctive, or contain a highly distinctive element, confusion is more likely than in those where marks are relatively weak.

22. In this situation the registered mark has a high level of distinctiveness. Broadly speaking the term 'LITTLE MADAM' conveys a strong conceptual image which would, I believe be easily recognised by children and their parents. The applicant's mark consists of the term MOODY LITTLE MADAMS. It seems to me likely that the average consumer would presume that goods produced by the owners of the latter mark came from the same economic undertaking as the former. To my mind the term 'Moody' does not serve to differentiate between the marks, it merely creates a subsidiary concept within the concept of the LITTLE MADAM mark. It seems to me that the average consumer would see MOODY LITTLE MADAMS as a subset of the LITTLE MADAM mark.

23. According to the case law, three criteria must be given due consideration as part of the global comparison of marks in cases such as this. The visual similarity between these marks appears significant. The terms Little Madam and Little Madams are very similar and occur in both marks. The prominence in both marks of these words means that visual confusion is likely. Whilst I acknowledge the term MOODY appears at the beginning of the applicant's mark and take account of the stylisation of the applicant's mark, I remain of the opinion that the marks are visually similar.

24. Aurally, I believe there is similarity. Earlier registration 2178509 will be referred to as a Little Madam mark. The Moody Little Madams mark is clearly not identical to the earlier mark, but the aural similarity between the terms Little Madam and Little Madams is strong and is not overridden by the term 'Moody'.

25. Conceptually, I do not believe the term MOODY creates a sufficiently distinct idea so as to negate the possibility of confusion. It seems to me that LITTLE MADAMS and MOODY LITTLE MADAMS when considered in use in relation to articles of clothing are likely to be seen by the relevant public as conceptually very close.

Decision regarding section 5(2)

26. Overall there appears to be sufficient similarity between cited mark 2178509 and the applicant's mark to justify objection under Section 5(2) of the Act. Both marks share the same dominant and distinctive features and would be applied to identical goods.

27. I conclude that, in respect of the goods in Class 25, there is a likelihood of confusion sufficient to warrant an objection under Section 5(2) of the Act.

Overall conclusion

28. The application in Class 25 is not registrable because it is debarred from registration by section 5(2).

Dated this 23rd day of June 2006

Dan Anthony
For the Registrar
The Comptroller-General