

O-157-07

**TRADE MARKS ACT 1994
IN THE MATTER OF AN APPLICATION
BY AURIPLEX LTD
TO REGISTER A TRADE MARK NO 2402512
IN CLASS 9**

Decision and Grounds of Decision

Background

1. On the 27 September 2006, Mr Abolghasem Chizari of Auriplex Ltd of 18 Sherlock Road, Cambridge, CB3 0HR, applied under the Trade Marks Act 1994 to register the following trade marks as a series of six in Class 9. The first four marks in the series appear to be handwritten:

i Ear
i. Ear
i-Ear
IEAR







2. The goods in Class 9 for which registration is sought are:

Class 9

“Apparatus for recording, transmission or reproduction of sound”.

It became clear from a telephone conversation between the applicant and the examiner that the applicant’s intention was to apply in respect of hearing aids which are proper to Class 10. This application did not cover hearing aids when applied for and therefore, under Rule 8 of the Trade Mark Rules 2000, it is not possible to change classes because the specification filed was correct for Class 9.

3. An objection was taken against the first five marks in the series under Section 5(2) of the Act in respect of the following marks:

Number	Mark	Specifications	Proprietor
M659337		<p>Class 9 Apparatus for recording, transmission or reproduction of sound or images; sound media, image media, image-sound media, including discs, compact discs, music cassettes, recorded video tapes.</p> <p>Class 38 Telecommunications.</p>	<p>Edel Gesellschaft</p> <p>Filing date: 07.11.1995</p>
E111971		<p>Class 9 Apparatus for recording, transmission or reproduction of sound or images; sound carriers, image carriers, audio-visual carriers, including recording disks, CDs, MCs, pre-recorded video tapes.</p> <p>Class 38 Telecommunications.</p>	<p>“edel” records GmbH</p> <p>Filing date: 01.04.1996</p>

4. Community Trade Mark number 4304391 was raised against all of the marks in the series. However it has now been withdrawn and I make no further reference to it in this decision.

5. Objection was also taken against the marks under Section 41(2) of the Act because the marks do not form a series because they differ in their material particulars, rendering them visually and conceptually different from each other. The first three marks were deemed acceptable as a series of three however. The fourth, fifth and sixth marks were not found to constitute a series with each other or with the first three marks.

6. An extension of time to deal with the objections was requested and granted and as no response was received within the given time, the application was refused under Section 37(4) of the Act.

7. I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Marks Rules 2000 to state in writing the grounds of the decision and the materials used in arriving at it.

8. No evidence has been put before me, therefore no claim under Section 7 of the Act has been made.

The Law

9. 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.”

10. 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), Community trade mark or international trade mark (EC) 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,”

11. 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, *Adidas Benelux BV*.

12. 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*;

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*; 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.*;

(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 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*;

(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.*

Distinctive character of the earlier trade marks

13. It is clear from the ECJ's judgment in the case of *Sabel BV v Puma AG* that the likelihood of confusion may be increased where the earlier trade marks have a highly distinctive character.

14. The earlier trade marks are registered trade marks and are therefore deemed to be valid (Section 72 of the Act refers). The earlier trade marks do not consist solely of invented words so they cannot be accorded the very highest level of distinctive character. Both earlier trade marks are identical. They consist of a stylised version of the word "ear" with "dot" characters on either side of the letter "a", and include a device of an ear which is distinctive for the goods applied for. The word "ear" is distinctive in relation to the goods and the earlier marks are eye-catching in that the device element of an ear is prominent and distinctive. The stylised device of an ear reinforces the message sent by the word element in the mark.

15. I must of course consider both marks in their entirety and, having done so, I have concluded that these earlier trade marks possess a relatively high degree of distinctive character.

Similarity of the goods

16. Citations M659667 and E111971 are registered in respect of "Apparatus for recording, transmission or reproduction of sound or images" and these goods are identical to the goods included in the applicant's specification.

Similarity of the marks

17. Since the first five trade marks included in the series of this application are not identical to the earlier trade marks, the matter falls to be decided under sub-section (b) of Section 5(2) of the Act. The question, therefore, is whether the first five marks in the series of this application are so similar to the earlier trade marks that there exists a likelihood of confusion which includes the likelihood of association on the part of the public.

18. The similarity of the marks must be assessed by reference to the visual, aural and conceptual similarities of the trade marks. It is clear from the judgment of the ECJ in the case of *Sabel BV v Puma AG* that I must assess the overall impressions created by the marks bearing in mind their distinctive and dominant components.

19. The applicant's first trade mark in the series is a stylised word consisting of a lower case letter "i" followed by the word "Ear" conjoined. Despite the fact that the letters are conjoined with no spacing between them, the word "Ear" stands out as being separate due to the fact that the letter "E"

is in upper case and the other four letters are in lower case. Consequently, the eye is drawn to the word “Ear”. The applicant’s second and third marks in the series consist of the same stylised version of the mark described above but with an additional element in that the lower case letter “i” and the word “Ear” are further separated by the inclusion of a “dot” character in respect of the second mark, and a hyphen in respect of the third mark. It follows therefore that the word “Ear” stands out even further as a separate element in respect of the second and third marks in the series. Citations M659337 and E111971 are identical marks consisting of the word “ear” in lower case letters, the letters being separated by “dot” characters on either side of the letter “a”. The citations also include a distinctive device of a stylised ear which in my view re-enforces the fact that the letters “e”, “a” and “r” make up the word “ear”, despite the inclusion of the “dot” characters on either side of the letter “a”.

20. The applicant’s fourth mark in the series consists of the stylised letters “IEAR” in upper case font. In my view the word “Ear” does not stand out as having a separate identity in this mark and the combination appears more likely to be seen as a made-up word. In view of the fact that the distinctive element with regard to citation numbers M659337 and E111971 lies in the combination of the device of an ear and the stylised word “ear” with dots on either side of the letter “a”.

21. The applicant’s fifth mark in the series consists of a stylised, three dimensional lower case letter “i” appearing in red, along with the word “Ear” appearing in grey. The lower case letter “i” is presented as slightly overlapping the capital letter “E” of the word “Ear”. In addition, the letter “i” is presented at a different height to the word “Ear” which results in the bottom edge of the letter “i” being in line with the middle bar of the capital letter “E”. Presented in this way, the word Ear stands out as being a separate element to the letter “i”. Citations M659337 and E111971 are identical marks consisting of the word “ear” in lower case letters, the letters being separated by “dot” characters on either side of the letter “a”. The citations also include a distinctive device of a stylised ear which, in my view, re-enforces the fact that the letters “e”, “a” and “r” make up the word “ear”, despite the inclusion of the “dot” characters on either side of the letter “a”.

22. It is my view that the first three marks, being the handwritten marks iEar, i.Ear and i-Ear and the fifth mark being the stylised version of iEar, are clearly similar to cited registrations M659337 and E111971. In reaching this conclusion, I have taken into consideration the dominant and distinctive elements in each of the marks.

Likelihood of confusion

23. I must, of course, bear in mind that a mere possibility of confusion is not sufficient. (See e.g. *React Trade Mark* [2000] RPC 285 at page 290.) The Act requires that there must be a likelihood of confusion. I have already found the goods for which the earlier trade marks are registered to be identical to the goods applied for. It is clear that where there is a lesser degree of similarity between the trade marks this may be offset by a greater degree of similarity between the goods (and vice versa) - see *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*.

24. Furthermore, it is now well established that the matter must be determined by reference to the likely reaction of an average consumer of the goods in question, who is deemed to be reasonably

well informed, reasonably observant and circumspect. In relation to the goods in question I consider the average consumer of such goods to be the general public as well as those who would provide trade supplies. The average consumer generally relies upon the imperfect picture of the earlier trade mark that he or she has kept in his or her mind and must therefore rely upon the overall impression created by the trade marks in order to avoid confusion.

25. I must of course consider the likelihood of confusion by reference to the visual, aural and conceptual points of similarity. In my view the weight to be attached to all aspects of confusion is significant. The similarities between the marks and the identical goods which are in conflict are likely to lead to both visual and aural confusion. I have found that all marks in conflict possess a relatively high degree of distinctive character and this is a factor that I have borne in mind in concluding that there are also conceptual similarities between the marks.

26. In this case I believe the identical goods that I have identified coupled with the relatively high degree of distinctive character of the marks and the similarity between them, is sufficient to give rise to a likelihood of confusion within the meaning of Section 5(2)(b) of the Act.

27. I therefore conclude that there is a likelihood of confusion which includes the likelihood of association. In reaching this conclusion I bear in mind that it is sufficient if an average consumer encountering the respective marks would assume that the marks identify a single undertaking or undertakings with an economic connection.

Application for a series of marks under Section 41(2)

The Law

28. Section 41(2) of the Act reads as follows:

“41.-(2) A series of trade marks means a number of trade marks which resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark.”

29. In order to satisfy the requirements of Section 41(2) of the Act, all six marks must, while differing from one another, differ only in respect of matter of a non-distinctive character which does not substantially affect the identity of each mark, that is to say it's identity with each and every other mark in the group propounded as a series.

Series considerations

30. In consideration of the requirements of Section 41(2) and taking into account guidance provided in LOGICA PLC (BL Number O/068/03), 5th March 2003 where Professor Ruth Annand as the Appointed Person stated that Section 41(2) of the Act contains the following three conditions:

“First, on the positive side, Section 41(2) requires the trade marks for which series registration is sought to resemble each other in their material particulars. Second and third, the negative aspects are that any differences in the trade marks must not comprise matter, which when considered:

a) as a separate element of the trade mark would be regarded as having distinctive character;

and

b) in the context of the trade mark as a whole, substantially affects the identity of the trade mark.”

31. The first mark consisting of the stylised “i” and the word “Ear” conjoined, the second mark consisting of the stylised “i”, the word “Ear” and the “dot” character; and the third mark consisting of the stylised combination “i” the word “Ear” and the hyphen are considered to be a series of three. Neither the addition of the dot character nor the hyphen, both being non-distinctive matter, substantially affects the identity of the second or third trade mark as a whole.

32. The fourth mark consisting of the stylised upper case letters “IEAR” does not in my view give the same impression as the first three marks, nor does it give the same impression as the fifth and sixth mark. The combination appears as an invented word and the fact that the letters are all in upper case does not draw one’s attention to the word “Ear” as is the case with regards to the first, second, third, fifth and sixth. Presenting the word in upper case font substantially changes the identity of the mark as a whole and therefore it does not form a series with any of the others.

33. The fifth mark in the series appears visually more striking and three dimensional than the first, second and third marks. It consists of a stylised letter “i” coloured red along with the word “Ear” being coloured grey and positioned slightly behind and below the letter “i”. In my view the addition of the colour red and the stylisation of the fifth mark renders it more distinctive than the first three marks and therefore it does not constitute a series with the first, second and third marks. Due to the further differences it therefore follows that the fifth mark does not constitute a series with the fourth or sixth mark either.

34. The sixth mark consists of the fifth mark as described above but in addition contains separate distinctive elements in the form of a distinctive device of an ear along with a highly distinctive invented word “Auriplex”. In the context of the trade mark as a whole, these additional elements substantially affect the identity of the trade mark and as such the sixth mark does not constitute a series with any of the other marks.

Conclusion

35. In this decision I have considered all of the documents filed by the applicant and all of the arguments submitted to me in relation to this application and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Section 5(2) and Section 41(2) of the Act.

36. It should be noted that the Applicant has filed a new UK application, number 2440183, for a similar series of seven marks in Class 10 in respect of “Hearing aids for the deaf”. This application has subsequently been accepted and published.

Dated this day 6th of June 2007

**KAREN STEPHENS
For the Registrar
The Comptroller-General**