

O-178-07

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2401080  
BY GOOSE DESIGN LIMITED TO REGISTER THE  
TRADE MARK VERT IN CLASS 25**

**AND**

**IN THE MATTER OF OPPOSITION NO 94187  
BY VERTU LIMITED**

## **TRADE MARKS ACT 1994**

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by Goose Design Limited to register the Trade Mark  
VERT in Class 25**

**And**

**IN THE MATTER OF Opposition No 94187 by  
VERTU LIMITED**

### **BACKGROUND**

1. On 8 September 2005 Goose Design Limited applied to register the trade mark VERT for “clothing, footwear and headgear” in Class 25. The mark is presented as follows but nothing appears to turn on the form of presentation. For convenience I propose to simply refer to it as VERT:



The image shows the word "Vert" in a large, bold, black, sans-serif font. The letters are thick and closely spaced, with a slightly irregular, hand-drawn appearance. The 'V' is particularly prominent, with a sharp point and a wide base. The 'e' is a simple, rounded shape, and the 'r' and 't' are also bold and blocky.

2. On 2 March 2006 Vertu Limited filed notice of opposition citing a single ground under Section 5(2)(b) of the Act based on Community Trade Mark registration No 2486603. The mark was placed on the register on 27 February 2004 and so is not subject to the requirement to show proof of use . The registration now stands in the name of Nokia Corporation. It covers a number of classes. It will be sufficient to record for current purposes that it includes “clothing, footwear, headgear” in Class 25.

3. The opponent seeks refusal of the application.

4. The applicant filed a counterstatement which in terms denies the ground of opposition.

5. The parties have included submissions in the statement of grounds and counterstatement. I bear these in mind and will take them into account at the appropriate point below.

6. Only the opponent has filed evidence. Neither side has asked to be heard. Written submissions (additional to those contained in the statement of grounds) have been received from Walker Morris on behalf of the opponent.

## Opponent's evidence

7. This consists of a witness statement by Katherine Cullen of Walker Morris, the opponent's registered trade mark attorney. In addition to further submissions Ms Cullen exhibits a number of pieces of documentary evidence. The first, Exhibit KC1, is an extract from Collins Concise Dictionary intended to demonstrate that the earlier trade mark has no significance in relation to clothing and has a high level of distinctiveness in relation to such goods. The remaining exhibits KC2 to 6 have been filed to show that VERTU is associated with Nokia in particular as a mobile phone brand. Material is filed to show that mobile phone providers register their marks in other Classes and that consumers show their allegiance by purchasing associated merchandise such as clothing.

## The Law

8. Section 5(2)(b) reads:

“(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.”

9. An objection under Section 5(2)(b) requires me to consider whether there are similarities in the marks and similarities in the goods and services that cumulatively, lead to a likelihood of confusion. For the benefit of the applicant who is not professionally represented in these proceedings I will set out the leading guidance from the European Court of Justice contained in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C.117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG and Adidas Benelux BV* [2000] E.T.M.R. 723.

10. 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*, 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 & C. 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 and Adidas Benelux BV* 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.

### **The parties' submissions**

11. The opponent has referred me to relevant case law and submits that the respective marks are visually and phonetically very similar with the applied for mark being wholly contained within the earlier registration. The opponent also says that the prefix of words are generally given more weight. In this case the only difference is a single letter at the end of the marks. In the opponent's view the respective marks cannot be distinguished conceptually as neither yields a clear meaning. One mark may be considered to be a product extension of the other (particularly if heard to mean VERT TOO). Finally, the opponent reminds me that due allowance must be made for imperfect recollection (see point (b) on the above list).

12. The applicant, for its part, points to the different number of characters in the respective marks and the unusual U suffix. Phonetically, it is submitted that VERTU is a two syllable word with a different rhythm and stress pattern.

13. The applicant (a Mr Philip Dickinson is behind the applicant company) says “In a test I called the VERTU office in the UK and enquired about VERT telephones they immediately corrected me and pronounced the two syllable word VERTU”. The effect of imperfect recollection is rejected.

14. The applicant contests the opponent’s claim that VERT has no meaning in the English language. On the contrary, it is submitted that “VERT has several meanings in English. The meaning I am applying to this word is derived from the extreme sports world”. The applicant also disputes the opponent’s claim in relation to product extension.

### **Comparison of goods**

15. This requires no analysis. The respective specifications are cast in identical terms.

### **Comparison of marks**

16. Visually, the applied for mark and earlier trade mark are of four and five letters respectively. It is self evident that the applied for mark employs the same four letters of the earlier trade mark in the same order. The applicant has challenged the opponent’s submission that the first element of marks is generally held to be the most important in terms of impact on consumers. The point found expression in *Tripcastroid* 42 R.P.C. 264 where it was held that “ ..... the tendency of persons using the English language to show the termination of words also has the effect necessarily that the beginning of words is accentuated in comparison, and in my judgment, the first syllable of a word is, as a rule, far the most important for the purpose of distinction”. Although that was a case under the preceding law it is, of course, not dealing with a point of law as such but a matter of human behaviour, that is to say how the public approaches words.

17. Nevertheless, it must be said that the considerable visual similarities between the marks are in part offset by the final U in the earlier trade mark. As the applicant points out it is by no means a common ending and from the point of view of visual and phonetic comparison it seems to me that the average consumer is unlikely to miss this element or to fail to pronounce it. It is not the sort of vowel that would be slurred at the end of a word. To that extent the *Tripcastroid* guidance must be treated with caution in the circumstances of this case.

18. Turning to conceptual considerations, neither side has suggested that the word VERTU will have any ready significance for consumers in this country. A few people with the necessary linguistic skills may recognise it as the French word meaning virtue. But the parties have, rightly in my view, not sought to suggest that the average consumer in the UK who encounters the word used in relation to clothing, footwear or headgear would look for that meaning. It would simply be seen as an invented word.

19. The parties differ as to the significance of the applied for mark, VERT. The opponent says it has no meaning in the English language. The applicant says it has several meanings but does not explain that claim. The counterstatement suggests one

meaning that is said to be derived from the extreme sports world. No evidence is supplied to support this claim. It may be that what is being suggested is that it is an abbreviation for 'vertical'. But the point is simply not explained. There is in any case no evidence that consumers at large would grasp any such intended reference. It is important also to note that the goods in issue are not restricted in any way or said to be directed at participants in extreme sports. The average consumer, therefore, must be taken to be the public at large. I have little doubt that, for this audience, VERT would be seen as an invented word.

20. Single letter differences, particularly in short words, can have a decisive effect in differentiating visually and conceptually where known words are concerned. On the other hand where the consumer is unable to 'interpret' the words, small differences may not be sufficient for differentiation purposes. I find that VERT and VERTU have a high degree of visual similarity, a lower level of phonetic similarity and are neutral in terms of their conceptual impact. In overall terms that points to a reasonable but not the highest degree of similarity.

### **Distinctive character of the earlier trade mark**

21. This is point (f) above. It is generally held that invented words have a high degree of distinctive character being towards the upper end of the scale which has words that are descriptive of the goods or services in issue towards the bottom. I am not aware that VERTU has any meaning in relation to clothing, footwear and headgear. I treat it as a word with a reasonably high degree of distinctive character.

### **The average consumer**

22. This is the public at large with the characteristics identified in points (b) and (c) above. The only other point I need to add is that the European Court has held (see, for instance, *Windsurfing Chiemsee v Huber* [1999] E.T.M.R. 585) that the relative importance of visual, aural and conceptual similarity must be evaluated according to the category of goods or services in question and the circumstances in which they are marketed. In that respect it was held in *React Trade Mark* [2000] R.P.C. 285 that:

“The Hearing Officer was prepared of his own experience to hold that the initial selection of goods would be made by eye, and I believe this is correct. I must therefore, in taking into account the likelihood of aural confusion, bear in mind the fact that the primary use of the trade marks in the purchasing of clothes is a visual act.”

23. Accordingly, visual considerations are rather more important than aural ones having regard to the way in which consumers meet trade marks in the context of selecting and purchasing clothing.

### **The likelihood of confusion**

24. This is a matter of global appreciation (point (a) above). The test is whether having regard to the identical nature of the goods and the similarities (and differences) in the marks the average consumer is likely to be confused. The confusion does not have to be direct in the sense that one mark is mistaken for the other. It is enough if

the similarities are such that consumers would think the goods sold under the respective marks emanated from the same trade source or from economically linked undertakings. This is sometimes referred to as indirect confusion. It can arise, for instance, where consumers would think that one mark was likely to represent a development in trade for which purpose the proprietor was using an adaptation or variation of an existing brand or operating through a related company. However, if the association that is made is a mere bringing to mind without either direct or indirect confusion of the sort referred to above then an opponent will not be successful under Section 5(2).

25. Bearing in mind the distinctive character of the earlier trade mark, the similarities between the respective marks and the identical nature of the goods I consider that there is a likelihood of confusion. Imperfect recollection (see (b) above) is of particular concern where invented words are concerned. When due allowance is made for the fact that consumers are rarely in the position of being able to make a side by side comparison of marks then there is strong likelihood of origin confusion in the circumstances of this case because consumers would think that they had imperfectly recollected one of the marks. Even if I am wrong in that I would find that consumers encountering the mark VERT would be likely to think that it was a variation of the mark VERTU or from an undertaking connected with the promoter of the VERTU brand. In short, the opposition succeeds under Section 5(2)(b).

26. The opponent has been successful and is entitled to a contribution toward its costs. I order the applicant to pay the opponent the sum of **£800**. 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 22nd day of June 2007**

**M REYNOLDS**  
**For the Registrar**  
**The Comptroller-General**