

O-075-11

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION 2485983B  
IN THE NAME OF RUSSELL BRAND  
IN RESPECT OF THE TRADE MARK**

**RUSSELL BRAND**

**AND**

**OPPOSITION THERETO (NO 98236B) BY  
RUSSELL BRANDS, LLC**

## TRADE MARKS ACT 1994

**In the matter of application 2485983B in the name of Russell Brand to register a trade mark in class 25**

**and**



**opposition thereto (no 98236B) by Russell Brand, LLC**

### The background and the pleadings

1) The above trade mark was filed by Mr Russell Brand on 25 April 2008. The trade mark was published in the Trade Marks Journal on 8 August 2008. The application was filed and published for a range of goods and services in classes 6, 9, 16, 21, 25, 28 & 41. Following the lodging of the opposition (which relates only to class 25) Mr Brand divided his application so that class 25 formed one part (with a B suffix) and the other classes formed another part. Consequently, the opposition relates only to application 2485983B.

2) Russell Brands, LLC (“RB”) opposes the registration of the above trade mark. It filed its opposition on 10 November 2008. At the time of filing its opposition the opponent was called Russell Corporation. The change of name from this to RB took place on 23 December 2008 (although the Intellectual Property Office was not formally advised until 27 August 2010). RB opposes the trade mark only in respect of the goods sought to be registered in class 25 (which are: clothing; footwear; headgear). RB bases its opposition under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). Under this ground RB relies on four trade marks of which it is the proprietor. The details of these earlier marks can be seen in the following table:

Mark details	Relevant dates	Goods/services
Community trade mark (“CTM”) 451856 for the mark:  RUSSELL ATHLETIC	<b>Filing date:</b> 22/01/1997  <b>Registration date:</b> 13/04/2006  <b>UK seniority date:</b> 28/02/1994	<b>Class 18:</b> Bags, sports bags, athletic bags.  <b>Class 25:</b> Clothing; sports clothing; tee-shirts; sweat-shirts, pants, vests, shorts; jackets; caps and socks; track suits; footwear.  <b>Class 28:</b> Bags adapted for carrying sporting articles.  <b>Class 35:</b> Services in connection with marketing bags, sports bags, athletic bags, bags adapted for

		carrying sporting articles, clothing, sports clothing, tee-shirts, sweat-shirts, pants, vests, shorts, jackets, caps and socks, track suits and footwear.
<p>CTM 3368826 for the mark:</p> 	<p><b>Filing date:</b> 25/09/2003</p> <p><b>Registration date:</b> 21/04/2005</p>	<p><b>Class 18:</b> Sports bags.</p> <p><b>Class 25:</b> Clothing; articles of sports clothing; shirts, cardigans, sweatshirts, tee shirts, jumpers; pullovers, jackets, trousers, track suits; articles of footwear; headgear.</p> <p><b>Class 28:</b> Bags adapted for carrying sporting articles.</p>
<p>CTM 5032339 for the mark:</p> 	<p><b>Filing date:</b> 21/04/2006</p> <p><b>Registration date:</b> 16/04/2007</p>	<p><b>Class 25:</b> Clothing, footwear, headgear, pants, shorts, skirts, dresses, tops, shirts, vests, jackets, coats, parkas, cardigans, sweaters, team uniforms, gloves, swimwear, underwear, socks, hats, caps</p>
<p>UK trade mark registration 1571350 for the mark:</p> <p>RUSSELL ATHLETIC</p>	<p><b>Filing date:</b> 09/05/1994</p> <p><b>Registration date:</b> 11/10/1996</p>	<p><b>Class 18:</b> Sports and athletic bags; all included in Class 18.</p> <p><b>Class 25:</b> T-shirts, sweatshirts, pants, vests, shorts, jackets, caps and socks; all included in Class 25.</p>

3) All of the above trade marks have dates of filing and/or seniority before the filing date of Mr Brand's application. They all, therefore, count as earlier marks as defined by section 6 of the Act. However, earlier marks which were registered more than five years prior to the publication of Mr Brand's application may only be relied upon to the extent to which they have been used. Of the four earlier marks only UK registration 1571350 falls into this category and is subject to the proof of use requirements; the other three earlier marks are not subject to proof of use and may, therefore, be taken into account for their specifications as registered. Earlier mark 1571350 is for the words RUSSELL ATHLETIC and it is, therefore, identical to another of its earlier marks (CTM 451856). Given this, there

is no need to consider the position on the basis of 1571350 as the same mark can already be relied upon without a need to consider the proof of use provisions.

4) Mr Brand filed a counterstatement denying the grounds of opposition. He required proof of use of RB's registrations for "all goods in class 25". This request can, though, only relate to earlier mark 1571350 which, for the reasons given in the preceding paragraph, need not be considered. It is unnecessary to consider whether proof of use has been shown.

5) Both sides filed evidence which I will summarise shortly. The matter then came to be heard before me on 7 January 2011 where RB were represented by Mr Simon Malynicz, of Counsel, instructed by JA Kemp & Co. Mr Brand did not attend the hearing neither was he represented at it.

### **The evidence**

#### **RB's evidence – witness statement of Claude Troisfontaine dated 15 June 2009**

6) Mr Troisfontaine is contracted to RB and manages the RUSSELL ATHLETIC brand throughout Europe, including the UK. The following facts emerge from his evidence:

- That the mark was first used in 1992;
- That from December 2001 until the end of 2008 the mark was used on licence by Mint Apparel Limited (Mint);
- There was a change of licensee at the end of 2008 but as this is after the relevant date this has little bearing;
- RUSSELL ATHLETIC is used upon "active wear" such as t-shirts, sweatshirts, sports jerseys, track suit tops, hooded tops, sweat pants and shorts. These types of garments can be seen in the various catalogues which are provided, most of which are undated (one is dated Fall/Winter 2007). They are said to be typical of the clothing range sold in the UK. Later evidence, along with various invoices, shows further examples of the trade mark applied to the goods and/or labels etc.
- Annual net sales (97% of which relate to the UK, the rest to the Republic of Ireland) are said to be:

YEAR	Quantity (1000 units)	Value (£million)
2005	170	1.3
2006	230	1.9
2007	330	1.7
2008	360	2.2

- Mint has 12 principal customers some of which are mail order retailers, the others high street stores. The customers include Littlewoods, Top Shop,

- Empire, Debenhams, Slaters, JD Group, River Ireland, Sports Direct, Sports World, TK Max, Mad House, JD Williams.
- Mint contributed to RB's central marketing costs to account for marketing and promotion in the UK and the Republic of Ireland. This ranged from £50,000 to £85,000 between 2005-2008. 98% of this related to the UK.
  - An example of point of sale material used to promote the goods is provided in Exhibit CT#4. This was used in Debenhams stores throughout the UK including the flagship store in Oxford Street, London. It was displayed for 4-5 months during 2006.
  - Mint also carries out its own advertising. An invoice dated 29 December 2007 for the sum of £20,500 is provided in respect of marketing consultancy services. In Exhibit CT#6 there is a photograph of a London taxi cab displaying an advertisement for RUSSELL ATHLETIC (stylized) in association with the retailer JD Sports. The advertisement was carried on 400 London taxi cabs for 1-4 months, but no date is given of this.
  - RUSSELL ATHLETIC is also promoted on the Internet, in particular at [www.russellathletic.eu](http://www.russellathletic.eu).

*RB's evidence – witness statement of Jacqui Gale dated 16 June 2009*

7) Ms Gale is “the functional director of commercial operations” of Russell Europe Limited (“RE”) who are a wholly owned subsidiary of RB and who use various marks throughout Europe (including the UK) with the consent of RB. The marks are said to include: RUSSELL COLLECTION, RUSSELL SOLUTIONS, RUSSELL WORKWEAR. The rest of Ms Gale's evidence focuses on RUSSELL COLLECTION, from which the following facts emerge:

- The mark RUSSELL COLLECTION has been used in the UK since at least as early as January 2004.
- Use is said to relate to clothing, but particularly formal shirts and blouses and knitwear. Various catalogues are provided showing such garments which feature the RUSSELL COLLECTION name (some feature the mark as per 3368826 in the neck labels of the garments and on some of the catalogues, but by no means all them). All of the other examples feature just RUSSELL COLLECTION or variations of it. None are dated, but they are said to be illustrative of the goods sold.
- UK turnover between 2006 and 2008 was at least \$12 million (2006), \$16 million (2007) and \$19 million (2008).
- Exhibit JG#2 shows labels said to be typical of the labeling used on the goods. The marks shown in these labels do not equate to any of the earlier marks. An example is depicted below:



- Promotional spend is said to be at least \$200,000 (2006), \$210,000 (2007) & \$230,000 (2008). Exhibit JG#3 shows an advertising plan from 2006 with two entries relevant to RUSSELL COLLECTION. The relevant advertisement with a logo similar to that above is provided. An advertising schedule for the end of 2006/beginning of 2007 shows that the RUSSELL COLLECTION advertisement is to be placed in *Image* and *P&P Features*. Examples of placed advertisements are also provided which appeared in *Inspired by UKL* (summer 2008) and *Printwear and Promotion* (2008/2009).
- Promotional gifts have been supplied, an example is provided in JG#4 consisting of a coaster showing the mark in a similar format to 3368826.
- The trade mark is used “throughout the United Kingdom including in particular Scotland and England”.
- The RUSSELL COLLECTION range is promoted on the Internet, particularly on [www.russelleurope.com](http://www.russelleurope.com).
- Some branding guidelines are also provided, most of which relates to the mark as depicted above rather than 3368826.

*RB's evidence – witness statement of Christopher Champion dated 16 June 2009*

8) Mr Champion is Senior Vice President, General Counsel and Secretary of RB. I do not need to summarize Mr Champion's evidence in detail, this is because he merely gives the background to the company (which has its roots in the US) and serves to corroborate the evidence of Mr Troisfontaine and Ms Gale (evidence which he says he has seen).

*Mr Brand's evidence – witness statement of Andrew Antonio dated 29 June 2010*

9) Mr Antonio is Mr Brand's business manager. He explains that the trade mark in question consists of the applicant's own personal name who he describes as being an “extremely well-known person in the United Kingdom, having attained significant success in numerous fields: comedian; actor; national newspaper columnist; author and presenter in both radio and television”. Mr Antonio then goes on to list various facts relating to Mr Brand's career. It should be noted, though, that the assessment of the likelihood of confusion must be made as of the date of application, namely 25 April 2008. This is the relevant date. Facts which are from after this date do little to assist. Some of the (pre-application) facts are:

- In the year 2000 Mr Brand made his first appearance at the Edinburgh Festival and also began presenting on the music channel MTV. This is when Mr Antonio says that Mr Brand first came to prominence.
- During 2006 Mr Brand hosted four separate television programmes (they are not specified), national radio shows (including a weekly Saturday night show on Radio 2), undertook a national stand-up comedy tour and released a DVD of his previous live stand-up tour.
- In 2007 Mr Brand hosted both the Brit Awards and Comic Relief.
- Mr Brand has received industry awards including: Time Out magazines best stand-up comedian (2006), Loaded magazines “Lafta” award for best stand-up (2006), Best Newcomer at the British Comedy Awards (2006), Best Television performer in a non-acting role awarded by the Annual Television and Radio Awards (2007), Placed 69<sup>th</sup> in Channel 4’s “100 Greatest Stand-ups” programme. Two further awards from 2008 are referred to but it is not possible to ascertain if they were awarded before the relevant date.

10) Mr Antonio then gives some DVD sales figures and audience figures which include:

- A chat show on MTV called “1 Leicester Square” from Spring 2006 - 500,000 (presumably viewing figures);
- “Russell Brand’s Got Issues” [later renamed The Russell Brand Show] a Channel 4 programme which commenced in 2007 – viewing figures are 6000,000 to 700,000;
- “Russell Brand’s Ponderland”, a comedy show on Channel 4 which commenced in October 2007 with viewing figures of 1 million. It is stated that this show was also regularly repeated on E4 and Channel 4’s “on demand” service;
- “The Russell Brand Show” on Radio 2 which commenced November 2006 – 400,000 listeners.
- “Russell Brand –Live” DVD from 2006 and “Doing Life” from 2007- approx 250,000 (presumably copies sold).

11) Mr Brand has appeared in a number of films including “St Trinians” (released 21 December 2007), and “Forgetting Sarah Marshall” (25 April 2008). Two other films are mentioned but these were released after the material date.

12) Mr Brand has written three books, two of which were published before the material date namely: Irons in the Fire (published November 2007 - 30,000 copies sold) and My Booky Wook (published November 2007, over one million copies sold).

13) Mr Antonio refers to the domain name russellbrandstore.com which was registered to Mr Brand in December 2006. This domain is linked to from Mr Brand's main homepage russellbrand.com. The store domain name is said to be used for the sale of merchandise (including DVDs, mugs and men's and women's clothing such as t-shirts) bearing the RUSSELL BRAND mark. Exhibit AA1 is a screen print from the online store showing a t-shirt featuring the name Russell Brand. It is explained that the t-shirt was for the promotion of Mr Brand's 2009 tour. Mr Antonio states that similar items were sold in relation to the previous tours in 2006 and 2007.

### **Section 5(2)(b) of the Act**

14) Section 5(2)(b) of the Act reads:

“5.-(2) A trade mark shall not be registered if because –

(a) .....

(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.”

15) In reaching my decision I have taken into account the guidance provided by the European Court of Justice (“ECJ”) in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).

16) The existence of a likelihood of confusion must be appreciated globally, taking into account all relevant factors (*Sabel BV v Puma AG*). As well as assessing whether the respective marks and the respective goods are similar, other factors are relevant including:

The nature of the average consumer of the goods in question and the nature of his or her purchasing act. This is relevant because it is through such a person's eyes that matters must be judged (*Sabel BV v Puma AG*);

That the average consumer rarely has the chance to make direct comparisons between trade marks and must, instead, rely upon the imperfect picture of them he or she has kept in mind (*Lloyd Schuhfabrik*



*Meyer & Co. GmbH v Klijsen Handel B.V.*) This is often referred to as the concept of “imperfect recollection”;

That the degree of distinctiveness of the earlier trade mark (due either to its inherent qualities or through the use made of it) is an important factor because confusion is more likely the more distinctive the earlier trade mark is (*Sabel BV v Puma AG*);

That there is interdependency between the various factors, for example, a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the respective goods, and vice versa (*Canon Kabushiki Kaisha v Metro- Goldwyn-Mayer Inc*).

17) Mr Brand’s arguments (provided in written submissions from the firm representing him, Harrison IP) focus on what are said to be the clear visual and phonetic differences between the respective marks, and, also, the fact that the mark RUSSELL BRAND has a clear concept, namely the name of Mr Brand who is claimed to be a well-known comedian, actor and writer. Further submissions caution against accepting that the various earlier marks have an enhanced degree of distinctiveness through the use made of them. The inherent degree of distinctiveness is said not be particularly high on account of Russell being a known name in the UK.

18) RB’s arguments, as put forward by Mr Malynicz at the hearing before me, were six-fold. Although Mr Malynicz went into much more detail, the primary points were:

- i) That the goods are identical;
- ii) That the first words of each of the marks are identical and that the word RUSSELL (which is reasonably distinctive per se) plays an independent role within them all – the rule of thumb that the beginnings of marks are more important was referred to;
- iii) That there is visual, aural and conceptual identity between the RUSSELL elements;
- iv) That there is no conceptual counteraction – it was argued that at the relevant date Mr Brand’s fame was significantly less than it may be today and, furthermore, that any fame was as an actor/comedian and that in relation to clothing a connection to him may not even be made. Mr Malynicz argued that all the marks were conceptually similar because they all relate to the name RUSSELL followed by other words ATHLETIC/COLLECTION/EUROPE and BRAND.
- v) That RB’s marks have become more distinctive through their use;
- vi) That RB’s marks constitute a family of marks (see case C-236/04, P // *Ponte Finanziaria S.p.A v OHIM*);

vii) That clothing marks are often configured in different ways to indicate different product ranges (see *Jose Alejandro SL V OHIM* [2004] ETMR 15 “*Budmen*”).

19) The goods are, as Mr Malynicz argued, identical. All three of the earlier marks cover clothing items at large – this term, on its own, is wide enough to encompass all of the goods (clothing; footwear; headgear) sought to be registered by Mr Brand. Additionally, the earlier marks also cover footwear and headgear items so if there is any doubt as to whether Mr Brand’s headgear and footwear falls within the ambit of the term “clothing”, there is identity in any event. From Mr Brand’s written submissions, there is no real dispute to this. The relevance of the goods being identical relates to the interdependency principle i.e. that a greater degree of similarity (in this case identity) between the goods may have the effect of offsetting a lower degree of similarity between the marks.

20) Clothing is bought by the public at large. The average consumer is, therefore, a member of the general public. The average consumer is a notional individual. He or she is meant to represent the average person from the relevant (in this case general) public. The case-law informs me that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting goods can, however, vary depending on the particular goods in question (see, for example, the judgment of the General Court (“GC”) in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)). In my view, clothing will be purchased with a reasonable degree of care and attention. The average consumer may try the goods on and is likely to inspect them for colour, size, style etc. All of this increases the potential exposure to the trade mark. That being said, the purchase is unlikely to be a highly considered one as clothing is purchased relatively frequently and although cost can vary, it is, generally speaking, not a highly expensive purchase.

21) Although aural similarity will not be ignored completely from my analysis, I am conscious that the visual impression of the trade marks is likely to take on more significance as the purchase of clothing is normally a visual act<sup>1</sup>.

22) Given the submissions and arguments of the parties, it is useful to set out, to begin with, the dominant/distinctive/independent elements of the marks, and the concepts that underpin them. In terms of RB’s marks, it is clear that the word RUSSELL will be seen as the dominant and distinctive element in each of them. The words which are next to or underneath the word RUSSELL are COLLECTION, EUROPE and ATHLETIC which are, effectively, non-distinctive terms. The RUSSELL COLLECTION and RUSSELL EUROPE marks have other elements but, in my view, these additional elements take on a secondary significance given their relative size and the role that they play in the mark

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<sup>1</sup> See *Société provençale d’achat and de gestion (SPAG) SA v (OHIM)* Case T-57/03 and *React Trade Mark* [2000] RPC 285.

(although these elements will still be borne in mind given that they are not negligible). The word RUSSELL plays not only the distinctive and dominant role, but also an independent and distinctive role. It is not tied in concept to the word alongside or beneath it so as to form a whole phrase which could change the significance of the word RUSSELL (which remains simply as a name). In terms of it being a name this could, of course, be perceived as a forename or a surname. My own view is that the most common reaction will be that of a forename, but I accept that it could be seen either way.

23) In terms of the mark RUSSELL BRAND there are, in my view, three possible interpretations of the mark: i) the name (be it a forename or surname) RUSSELL presented alongside the word BRAND (brand in the sense of a trade mark), ii) the forename RUSSELL and the surname BRAND but with no significance to a particular person or, iii) the forename RUSSELL and the surname BRAND but with particular significance to the comedian/actor/writer Russell Brand. In terms of these three interpretations, i) would equate to the dominant and distinctive element being the name RUSSELL which would also play an independent and distinctive role in the same way as RB's earlier marks, but, in ii) and iii) the name RUSSELL, even though it is at the beginning of the mark, would not play an independent distinctive role as it is tied to the complete name RUSSELL BRAND. Neither element RUSSELL or BRAND would, in this context, dominate the other – they would have equal degrees of dominance.

24) How the mark will be perceived is a difficult question. Putting to one side, for the time being, the parties' evidence, it is a straight choice between interpretation i) and ii). The word BRAND is both a dictionary word and a surname. There is no evidence as to the popularity of the surname BRAND. There is no evidence that it is a very common surname. That being said, it does not strike me as a highly unusual surname either. However, when one places this word next to what I regard as a common forename, this is likely to create a strong bias towards the full name interpretation. This is strengthened by the fact that a trade mark, when used in the course of trade, does not normally have to announce itself as a "brand". There is no evidence to suggest otherwise. Therefore, when considering the position without regard to the evidence, this results in the average consumer perceiving the mark RUSSELL BRAND as the full name of an individual. The evidence, though, could strengthen this view (as Mr Brand submits), or work against it (as RB submits).

25) In terms of the evidence, Mr Malynicz conceded that Mr Brand may have had a degree of fame at the relevant date, but that he was not so well-known then as he may be today. It was argued that there could be many more people who have not heard of Mr Brand than those who have heard of him. It was argued that his fame could not be assumed to be known by the average consumer. Mr Brand's evidence is not as clear as it could have been. For example, the sales and audience figures are not expressed against a particular time period. To illustrate the point, Mr Brand's book was published in November

2007 (5-6 months before the relevant date of 25 April 2008) and whilst it may have sold one million copies, some of these sales may have occurred after the relevant date. This criticism can be made against other parts of the evidence. That being said, it is clear from the evidence that Mr Brand had made in impact as an entertainer by 2006 given the awards he had received (notably the best newcomer in the UK comedy awards) which was followed by further awards in 2007 (best performer in a non acting role awarded by the Annual Television and Radio Awards) and his hosting in that year of The Brits and Comic Relief. It is not the case, therefore, that he was relatively unknown at the relevant date with the sales figures etc being the result of a more recent rise to fame causing people to purchase his back catalogue products. The headline figures provided in the evidence are quite significant. Whilst it would be wrong to add them all together to come to a total person impact (some people will have bought the book and listened to Mr Brand's radio 2 show so they should not be double counted) there will be a degree of cumulative significance. Furthermore, there will also be people who will know of Mr Brand, his programmes, books, DVDs etc, even though they have not purchased them, listened to them or watched them. Mr Malynicz argued that Mr Brand's fame may be more relevant to a particular demographic. There is, though, no evidence to this effect. Mr Brand's evidence seems to cross a number of genres ranging from MTV to Radio 2 to television shows on nationally broadcast channels. The evidence paints a fairly compelling picture that the fame of Mr Brand is more wide reaching and that he is more generally known than Mr Malynicz argued. I come to the view that the average consumer in the UK will have been aware of Mr Brand's fame at the relevant date.

26) This is not the end of the matter because there is what Mr Malynicz described at the hearing as "noise" in the message. This noise could be two-fold, firstly that because Mr Brand is known as a comedian/presenter, the average consumer encountering the words RUSSELL BRAND in relation to clothing will not make any link with Mr Brand. In other words, the name is outside its normal context. The second aspect relates to the claimed enhanced distinctiveness of RB's mark and its use of a number of marks which have the name RUSSELL as a dominant, distinctive and independent element. In relation to the first argument, I do not consider that this creates any significant noise in the message – this is because the natural viewing of the mark would, in any event, be that of a full name and if this is the natural perception then it is likely that the average consumer will perceive the reference to Mr Brand, even though he may have no real link with clothing.

27) In terms of the second argument, whilst it is clear that RB has used its RUSSELL ATHLETIC mark, I am far from satisfied that the evidence establishes that its inherent degree of distinctiveness has been enhanced to any significant extent. This, in turn, means that there will be no skewing of the conceptual meaning of RUSSELL BRAND as I have assessed. Mr Troistonfaine's evidence (which relates primarily to RUSSELL ATHLETIC) shows unit sales of around 100,000 to 200,000. Whilst this is a not an insignificant amount of sales, I agree

with Mr Brand's submission that without context it is difficult to ascertain what this represents in the clothing market. Advertising and promotion is said to have taken place but the only forms mentioned relates to the placing of advertisements on the side of London taxi cabs for a period of time (co-promoted with a retailer's name) and, also, promotion in certain department stores. Whilst some members of the clothing buying public will have encountered the RUSSELL ATHLETIC mark, the use presented in the evidence does not strike me as the sort of use that would have had any real impact on the average consumer in the UK. For the record though, I should add here that from an inherent point of view the earlier mark has a reasonable degree of inherent distinctive character, but it is not highly distinctive.

28) In relation to the other earlier marks, this is covered primarily in the evidence of Ms Gale. There are, though, a number of problems with the evidence presented. Firstly, although the sales figures indicate that the turnover in relation to the use which Ms Gale is referring to is higher than for RUSSELL ATHLETIC, there is no evidence as to the unit sales made. It is not clear what price the various items are so unit sales cannot be extrapolated. This repeats the market context problem. Another problem relates to the actual marks the use of which Ms Gale is commenting upon. The primary use, the use which Ms Gale describes as representative, is of labels as per paragraph 7 above. The marks in these labels are not the subject of RB's earlier marks. Whilst some of the exhibits show items of clothing which contain a neck label corresponding to CTM 3368826 and that some of the catalogues also show this mark, the degree to which this mark has been used, particularly bearing in mind Ms Gale's explanation as to the marks used, is not at all clear. I certainly cannot infer that the mark has been used in respect of all of the clothing sold. Finally, the goods on which the mark has been used is more akin to formal wear, the type of clothing worn in offices etc. The advertising material demonstrates this further with such material being placed in publications aimed at the workwear/corporate market rather than the general clothing market. This is the sense that one takes from the evidence – if this is not the case and some wider form of use exists then it is not borne out by the evidence. Not only does this reduce any significance in terms of having an enhanced degree of distinctiveness with the average consumer in the UK, but it also diminishes the relevance of the family of marks argument. If one mark relates to active wear sold through particular outlets and the other mark is used in relation to work/corporate wear sold through different types of outlets and advertised to a different market then whilst there may be a degree of overlap so that some consumers may have encountered both, it cannot be inferred that the average consumer in the UK, from who's perspective the matter must be assessed, will be aware of any overlapping use.

29) Taking the above observations into account, my finding is that the trade mark RUSSELL BRAND will be perceived by the average consumer, after factoring in the evidence of both parties, as the full name of Mr Brand, the well-known entertainer. Even if I am wrong on that then I still consider, based on the

totality of the evidence filed, that the mark will, in any event, be perceived as the forename RUSSELL and the surname BRAND.

30) In terms of the mark comparison, this is to be undertaken with reference to the above findings. I consider RB's best case to be in relation to the mark RUSSELL ATHLETIC given that its other earlier marks contain further elements which create greater differences as a whole. For ease of reference, the marks are replicated below.

RB's mark	Mr Brand's mark
<b>RUSSELL ATHLETIC</b>	<b>RUSSELL BRAND</b>

31) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account any distinctive and dominant components.

32) Any visual and aural similarity resides in the common presence of the word RUSSELL. It is the dominant and distinctive element in RB's mark and it plays an independent role within it. The word RUSSELL in Mr Brand's mark is one of two elements with an equal degree of dominance and distinctiveness, but it does not play an independent role. Weighing all of this, it is considered that there is some visual and aural similarity, be it of neither a high nor a low degree.

33) I have already discussed the issue of conceptual meanings. It is clear from the case-law<sup>2</sup> that a conceptual difference has the potential to counteract, to a degree, visual and aural similarities. The concepts here are of a name RUSSELL (most likely to be perceived as a forename but possibly as a surname) together with an essentially non-distinctive word (ATHLETIC), against a person's full name with RUSSELL as the forename, but with that full name being perceived as the name of a well-known person. RB's best case must lie with the perception of RUSSELL in its mark being a forename (otherwise RUSSELL is a forename in Mr Brand's mark but a surname in RB's mark). To that extent, whilst it is true that there is a degree of conceptual similarity in that both marks make reference to the forename RUSSELL, it is considered that such a similarity is not highly significant on account of Mr Brand's mark pointing not only to a person's full name, but also to the full name of a well-known person. Furthermore, RUSSELL

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<sup>2</sup> This is highlighted in numerous judgments of the GC and the ECJ including *Ruiz Picasso v OHIM* [2006] ECR I-643; [2006] E.T.M.R. 29.

does not play an independent role in Mr Brand's mark. All of this appears consistent with what the ECJ found (albeit the conflict there concerned a full name and a surname) in Case C-51/09 P, *Barbara Becker*, where it stated:

*"Findings of the Court*

30 Since the appellant has criticised the General Court for incorrectly applying Article 8(1)(b) of Regulation No 40/94, it should be recalled that, according to that provision, upon opposition by the proprietor of an earlier trade mark, the trade mark applied for is not to be registered if, because of its identity with or similarity to the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks, there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected.

31 In that regard, it is settled case-law that the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically linked undertakings, constitutes a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see Case C-334/05 P *OHIM v Shaker* [2007] ECR I-4529, paragraph 33, and judgment of 20 September 2007 in Case C-193/06 P *Nestlé v OHIM*, paragraph 32; and, to that effect, with respect to First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 29, Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 17, and *Medion*, paragraph 26).

32 The existence of a likelihood of confusion on the part of the public must be appreciated globally, taking into account all factors relevant to the circumstances of the case (see, to that effect, Case C- 251/95 *SABEL* [1997] ECR I-6191, paragraph 22; *Lloyd Schuhfabrik Meyer*, paragraph 18; *Medion*, paragraph 27; *OHIM v Shaker*, paragraph 34; and *Nestlé v OHIM*, paragraph 33).

33 It is also settled case-law that the global appreciation of the likelihood of confusion, in relation to the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The perception of the marks by the average consumer of the goods or services in question plays a decisive role in the global appreciation of that likelihood of confusion. In this regard, the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (see, to that effect, *SABEL*, paragraph 23; *Lloyd Schuhfabrik Meyer*, paragraph 25; *Medion*, paragraph 28; *OHIM v Shaker*, paragraph 35; and *Nestlé v OHIM*, paragraph 34).

34 However, in paragraphs 30 and 31 of *Medion*, the Court held that, beyond the usual case where the average consumer perceives a mark as a whole, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element. In such a case, the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue come, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.

35 In the present case, having repeated all of the rules set out in paragraphs 30 to 33 of this judgment, the General Court held essentially, in its assessment of the conceptual similarity of the marks at issue, first, that, as consumers in part of the European Union generally attribute greater distinctiveness to the surname than to the forename in word signs, the component 'Becker' in the mark applied for was likely to have attributed to it a stronger distinctive character than the component 'Barbara'; second, that the fact that Ms Becker is famous in Germany had no effect on the similarity of the marks at issue since they refer to the same surname and the component 'Barbara' is merely a forename and, third, that the component 'Becker' retained an independent distinctive role in the composite mark because it would be perceived as a surname.

36 Although it is possible that, in a part of the European Union, surnames have, as a general rule, a more distinctive character than forenames, it is appropriate, however, to take account of factors specific to the case and, in particular, the fact that the surname concerned is unusual or, on the contrary, very common, which is likely to have an effect on that distinctive character. That is true of the surname 'Becker' which the Board of Appeal noted is common.

37 Account must also be taken of whether the person who requests that his first name and surname, taken together, be registered as a trade mark is well known, since that factor may obviously influence the perception of the mark by the relevant public.

38 Furthermore, it must be held that, in a composite mark, a surname does not retain an independent distinctive role in every case solely because it will be perceived as a surname. The finding with respect to such a role may be based only on an examination of all the relevant factors of each case.

39 Moreover, as the Advocate General pointed out in essence, in point 59 of his Opinion, the grounds relied on by the General Court in order to



conclude that the marks at issue are conceptually similar, if they were held to be consistent with Article 8(1)(b) of Regulation No 40/94, would result in acknowledging that any surname which constitutes an earlier mark could be effectively relied on to oppose registration of a mark composed of a first name and that surname, even though, for example, the surname was common or the addition of the first name would have an effect, from a conceptual point of view, on the perception by the relevant public of the composite mark.

40 It follows from all the foregoing that the General Court erred in law in basing its assessment of the conceptual similarity of the marks on general considerations taken from the case-law without analysing all the relevant factors specific to the case, in disregard of the requirement of an overall assessment of the likelihood of confusion, taking account of all factors relevant to the circumstances of the case, and based on the overall impression produced by the marks at issue.”

Even if I am wrong on my primary finding that Mr Brand was well-known at the material date, some of the factors (full name concept and no independence of RUSSELL) still apply.

34) It is clear that the factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17) and that a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

35) In terms of the relevant factors, the goods are identical. This is an important point as Mr Malynicz submitted on behalf of RB. The earlier mark has a reasonable degree of distinctiveness, but its use is not enhanced to any real extent. I do not consider that the claim to a family of mark improves RB's position for the reasons given in paragraph 28 above. The average consumer will pay a reasonable degree of care and attention to the goods that they are choosing. I must also bear in mind the concept of imperfect recollection. Weighing all the relevant factors, together with the degree of similarity between the marks and their conceptual significances, I come to the view that there is no likelihood of direct confusion. The average consumer will recall and take into account that one mark is for a person's full name (be it Mr Brand or a notional individual with this name) and the other mark is simply a person's forename (the forename perspective, as stated earlier, puts RB in its strongest position) together with a word indicating the type of clothing (athletic) being provided. In relation to whether there is a likelihood of indirect confusion (whereby the consumer will believe that the goods being offered under the respective marks are the

responsibility of the same or an economically linked undertaking<sup>3</sup>) then if the average consumer perceives RUSSELL BRAND as a reference to Mr Brand then I do not see why the average consumer would understand the respective marks to be the responsibility of the same or related undertaking. It is too big a step to consider that such an assumption will be made by the average consumer. Even if RUSSELL BRAND is taken to be a notional individual then, again, I do not see why the average consumer would put the common presence of the forename RUSSELL down to economic connection. Names, at the end of the day, fulfill a purpose of distinguishing. One of the purposes of a surname could be said to differentiate between persons with the same forename. Any similarity will likely be put down to a coincidental use of the common name Russell and that Russell Brand is not necessarily the same Russell being referred to in the Russell Athletic mark. The way I have expressed this relates to the use of names rather than trade marks, but extended to the question before me, the same eventuality will, in my view, follow in that the average consumer will not believe that the RUSSELL BRAND trade mark comes from the same or a related undertaking as the RUSSELL ATHLETIC trade mark (or vice versa). The reference to the *Budmen* case is noted, but the facts here, together with the conceptual significance of the mark RUSSELL BRAND, militates against the average consumer believing that the mark is a new range from the company responsible for RUSSELL ATHLETIC. There is no likelihood of indirect confusion. The opposition fails.

### **Costs**

36) Mr Brand has been successful and is entitled to a contribution towards his costs. A claim was made by Mr Brand's attorney for costs in excess of the usual scale because they were not copied in to RB's request for a hearing. I have considered this, but I do not see why this would have increased Mr Brand's costs so as to justify a greater contribution. I will award costs from the usual scale. I hereby order Russell Brands Inc to pay Mr Russell Brand the sum of £1500. This sum is calculated as follows:

Preparing a statement and considering the other side's statement  
£500

Filing evidence and considering RB's evidence  
£600

Preparing written submissions  
£400

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<sup>3</sup> This is a relevant form of confusion – see *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*.

37) The above sum should 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 25 day of February 2011**

**Oliver Morris  
For the Registrar,  
The Comptroller-General**