

O-080-14

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2580252

BY

KBS BULLDOG DRUMMOND LIMITED

TO REGISTER THE TRADE MARK

BULLDOG DRUMMOND

IN CLASSES 3, 9, 14, 16, 18, 25, 28, 34, 38

AND

THE OPPOSITION THERETO

UNDER NO 102811

BY

ROLLINS BULLDOG TOOLS LIMITED

BACKGROUND

1. On 5 May 2011, KBS Bulldog Drummond Limited (the applicant) applied to register the above trade mark in classes 3, 9, 14, 16, 18, 25, 28, 34 and 38 of the Nice Classification system.¹

2. Following publication of the application, on 23 September 2011, Rollins Bulldog Tools Limited (the opponent) filed notice of opposition against the application. The opposition relates to the following goods:

Class 9

Apparatus for recording, transmission or reproduction of sound or images; eyeglasses and sunglasses; cases for eyeglasses and sunglasses; electronic publications; downloadable electronic publications; equipment for audio and/or video recording and/or reproduction; software downloadable from the Internet in the form of greetings cards or greetings messages; electronic greetings messages and digital greetings messages; electronic greetings cards ; digital greetings cards.

Class 16

Printed matter and printed publications; books, magazines, newsletters, leaflets and brochures; colouring books, children's activity books; stationery, writing paper, envelopes, notebooks, address books, albums, diaries, note cards, greeting cards, trading cards; lithographs; writing and drawing instruments, pens, pencils, and cases therefor, erasers, crayons, markers, coloured pencils, painting sets, chalk and chalkboards; modelling materials; decals, heat transfers; posters; mounted and/or unmounted photographs; book covers, book marks, calendars, gift wrapping paper; paper party decorations, paper napkins, paper doilies, paper place mats, crepe paper, invitations, paper table cloths, paper cake decorations; printed transfers for embroidery or fabric appliques; printed patterns for costumes, pyjamas, sweatshirts and t-shirts; booklets sold with audio tapes as a unit; money clips; desk sets comprising of leather blotter holders and leather holders for pens, paper, ink bottles and documents; all the aforesaid goods relating to the fictional character Bulldog Drummond, none relating to the garden, horticultural or contractor industries.

Class 18

Leather and imitation leather and goods made of these materials not included in other classes; briefcases; trunks; umbrellas; parasols; walking sticks; travelling bags; wallets; suitcases; attaché cases; vanity cases; suit bags; rucksacks; purses; travelling bags; handbags; luggage; all the aforesaid goods relating to the fictional character Bulldog Drummond, none relating to the garden, horticultural or contractor industries.

Class 25

Clothing; articles of outer clothing and underclothing; infants and children's clothing; sweatshirts; T-shirts; tracksuits; polo shirts; sports clothing; weather resistant apparel; rainwear, waterproof clothing; leisure wear; shirts, coats, jackets, trousers; jeans; vests, shorts; skirts, blouses; overcoats; sweaters, pullovers, cardigans; ties, belts; head wear; caps; hats; socks; gloves; footwear;

¹ *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).*

shoes, boots; boots for sports; swimming costumes; scarves; all the aforesaid goods relating to the fictional character Bulldog Drummond, none of the aforesaid goods for use within the garden, horticultural or contractor industries.

3. The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 (the Act). The opponent relies upon United Kingdom trade mark registration no 2517987:

Mark details and relevant dates	Goods relied upon
<p>Mark: BULLDOG</p> <p>Filed: 11 June 2009</p> <p>Registered: 10 September 2010</p>	<p>Class 9 Articles of protective and safety clothing; headgear; hard hats; gloves; footwear; waterproof clothing; protective glasses, goggles and face masks; all the aforesaid goods for use within the garden, horticultural and contractor industry; sun glasses; radios.</p> <p>Class 16 Printed matter, newspapers, periodical publications, magazines, books, photographs, pictures, prints, stationery, posters, greeting cards, postcards, notepads, address books, scrapbooks, folders, catalogues, calendars, photographs albums, diaries, coupons, vouchers, gift bags, carrier bags, wrapping and packaging materials; instructional and teaching material.</p> <p>Class 18 Articles made from leather or imitation leather; articles of luggage; bags, holdalls, satchels, sports bags, backpacks, handbags, pocket wallets, purses, spectacle cases, passport holders, document holders, luggage tags; belts; umbrellas and parasols.</p> <p>Class 25 Articles of clothing; footwear; headgear; trousers, shirts, sweatshirts, t-shirts, overalls, Wellington boots; all the aforesaid goods for use within the garden, horticultural and contractor industry.</p>

4. In its statement of grounds the opponent states:

“The opposed mark is confusingly similar to the Opponent’s trade mark as it includes the whole of the opponent’s Bulldog mark as a prefix. Furthermore, the opposed mark covers identical or similar goods to those protected by the Opponent’s earlier mark in classes 9, 16, 18 and 25 of the register.”

5. Following an eighteen month cooling off period, the applicant filed a counterstatement on 30 May 2013. It denies the grounds on which the opposition is based and requests the opponent provide proof of use of its mark. It states:

“(5) The Applicant makes no admission as to the validity of the Opponent’s registration and puts the Opponent to strict proof that the Registration...has been put to genuine use in the United Kingdom.

(6) The Applicant denies that the mark in suit is similar to the prior UK Registration...whether as alleged by the Opponent, or at all, and the Opponent is put to strict proof of the claims made.

(7) The Applicant denies that the goods specified in the application in suit are identical or similar to the goods specified in the United Kingdom Trade Mark Registration...whether as alleged by the Opponent, or at all, and the Opponent is put to strict proof of the claims made.

*...
(9) The Applicant will bring evidence to show that the Opponent does not have exclusive rights to the word BULLDOG in relation to the allegedly conflicting goods in the UK marketplace.²”*

6. Neither party filed evidence, though the opponent filed submissions during the period allowed for evidence. I will refer to these as necessary below. A hearing took place on 16 January 2014, at the Registry in Newport. The applicant did not attend. The opponent was represented by Mr Sandiford of Sandiford Tennant LLP.

DECISION

7. Section 5(2)(b) of the Act states:

“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, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

8. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.-(1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or 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.

² *This evidence has not been submitted in these proceedings.*

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

9. The opponent's mark is an earlier mark. Despite the applicant requesting the opponent prove use of it, the earlier mark is not subject to proof of use because, at the date of publication of the application, it had not been registered for five years.³

Section 5(2)(b) case law

10. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the Court of Justice of the European Union (CJEU) cases mentioned) on the basis indicated below:

The CJEU cases

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 B.V.* [2000] F.S.R. 77; *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723; *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-6/01; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04; *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P.

The principles

“(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, 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, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks

³ See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004: SI 2004/946) which came into force on 5th May 2004.

bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) 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;

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

The average consumer and the nature of the purchasing act

11. In accordance with the above cited case law, I must determine who the average consumer is and also identify the nature of the purchasing process. The average consumer is reasonably well informed and reasonably circumspect and observant but with a level of attention likely to vary according to the category of goods. The attention paid is likely to vary depending on price and, to some extent, the nature of the goods and the frequency of the purchase.

12. The average consumer of the goods at issue will be a member of the general public or a business/professional. The purchase is likely to be primarily visual as it is likely to be made from a website, catalogue, or directly from a shelf. The specifications of goods cover a wide range of products which vary in price and frequency of purchase. Consequently, the level of attention paid is likely to vary.

13. In respect of the goods in class 25, in considering the level of attention that will be paid to such a purchase and the nature of the purchasing act, I am mindful of the

decision of the General Court (GC) in *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs) Joined cases T-117/03 to T-119/03 and T-171/03*, in which it commented:

"43. It should be noted in this regard that the average consumer's level of attention may vary according to the category of goods or services in question (see, by analogy, Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26). As OHIM rightly pointed out, an applicant cannot simply assert that in a particular sector the consumer is particularly attentive to trademarks without supporting that claim with facts or evidence. As regards the clothing sector, the Court finds that it comprises goods which vary widely in quality and price. Whilst it is possible that the consumer is more attentive to the choice of mark where he or she buys a particularly expensive item of clothing, such an approach on the part of the consumer cannot be presumed without evidence with regard to all goods in that sector. It follows that that argument must be rejected.

...
53. Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion."

14. As to the level of attention paid by the average consumer, in *Adelphoi Limited v DC Comics (a general partnership)*⁴ Professor Annand, sitting as the appointed person stated:

"21. As for the services, e.g., broadcasting, whilst I agree with Mr. Malynicz that the average consumer would include business consumers or professionals as well as the general public, the likelihood of confusion must be assessed in relation to the part of the public whose attention is lower (see e.g., Case T-448/11, *Golden Balls Ltd v. OHIM*, 16 September 2013, para. 26), although in any event, the Hearing Officer relied on an average consumer (reasonably well informed and reasonably circumspect and observant) paying an average level of attention (para. 41)."

15. The goods in class 9 may be bought by members of the general public or professionals. The level of attention paid to all of these goods is likely to be at least reasonable. The electronic/digital greetings will need to send the correct message to the right person. Electronic publications will need to be the correct titles covering suitable subject matter. Eyeglasses will require the correct prescription (where appropriate) and at the very least, consideration will be made of frame size, colour and shape. Apparatus for recording, transmission or reproduction of sound may be

⁴ *BL O/440/13*

expensive and will be considered to the extent that they need to be in a compatible format. Audio/visual quality may also be a consideration.

16. In respect of the safety clothing and apparatus in class 9, a higher level of attention is likely to be paid due to the nature of the goods and the fact that they are being purchased to ensure personal safety and reduce the risk of injury. The opponent's goods in class 9 are limited to 'use within the garden, horticultural and contractor industry', and will consequently require a higher level of attention to be paid as they are being purchased, for the most part, for use in industry for the reasons outlined above.

17. For the majority of goods in class 16, the purchaser is likely to be a member of the general public. However, instructional and teaching materials may also be purchased by a professional teacher/trainer. The level of attention paid to the majority of the goods in class 16 will be fairly low, e.g. envelopes, crayons. For instructional and teaching materials it is likely to be higher as the purchaser will want to ensure, inter alia, that the subject matter, age range, outcomes are suitable.

18. In respect of the goods in classes 18 and 25 the purchase is likely to be made by a member of the general public. The level of attention paid is likely to be reasonable to the extent that they will wish to select, inter alia, the correct colour, size, material.

19. The opponent's goods in class 25 are limited to 'use within the garden, horticultural and contractor industry', and will consequently require a higher level of attention to be paid.

Comparison of goods

20. The goods to be compared are as follows:

The opponent's goods	The applicant's goods
<p>Class 9 Articles of protective and safety clothing; headgear; hard hats; gloves; footwear; waterproof clothing; protective glasses, goggles and face masks; all the aforesaid goods for use within the garden, horticultural and contractor industry; sun glasses; radios.</p> <p>Class 16 Printed matter, newspapers, periodical publications, magazines, books, photographs, pictures, prints, stationery, posters, greeting cards, postcards, notepads, address books,</p>	<p>Class 9 Apparatus for recording, transmission or reproduction of sound or images; eyeglasses and sunglasses; cases for eyeglasses and sunglasses; electronic publications; downloadable electronic publications; equipment for audio and/or video recording and/or reproduction; software downloadable from the Internet in the form of greetings cards or greetings messages; electronic greetings messages and digital greetings messages; electronic greetings cards ; digital greetings cards.</p> <p>Class 16 Printed matter and printed publications; books, magazines, newsletters, leaflets and brochures; colouring books, children's activity books; stationery, writing paper,</p>

scrapbooks, folders, catalogues, calendars, photographs albums, diaries, coupons, vouchers, gift bags, carrier bags, wrapping and packaging materials; instructional and teaching material.

Class 18

Articles made from leather or imitation leather; articles of luggage; bags, holdalls, satchels, sports bags, backpacks, handbags, pocket wallets, purses, spectacle cases, passport holders, document holders, luggage tags; belts; umbrellas and parasols.

Class 25

Articles of clothing; footwear; headgear; trousers, shirts, sweatshirts, t-shirts, overalls, Wellington boots; all the aforesaid goods for use within the garden, horticultural and contractor industry.

envelopes, notebooks, address books, albums, diaries, note cards, greeting cards, trading cards; lithographs; writing and drawing instruments, pens, pencils, and cases therefor, erasers, crayons, markers, coloured pencils, painting sets, chalk and chalkboards; modelling materials; decals, heat transfers; posters; mounted and/or unmounted photographs; book covers, book marks, calendars, gift wrapping paper; paper party decorations, paper napkins, paper doilies, paper place mats, crepe paper, invitations, paper table cloths, paper cake decorations; printed transfers for embroidery or fabric appliques; printed patterns for costumes, pyjamas, sweatshirts and t-shirts; booklets sold with audio tapes as a unit; money clips; desk sets comprising of leather blotter holders and leather holders for pens, paper, ink bottles and documents; all the aforesaid goods relating to the fictional character Bulldog Drummond, none relating to the garden, horticultural or contractor industries.

Class 18

Leather and imitation leather and goods made of these materials not included in other classes; briefcases; trunks; umbrellas; parasols; walking sticks; travelling bags; wallets; suitcases; attaché cases; vanity cases; suit bags; rucksacks; purses; travelling bags; handbags; luggage; all the aforesaid goods relating to the fictional character Bulldog Drummond, none relating to the garden, horticultural or contractor industries.

Class 25

Clothing; articles of outer clothing and underclothing; infants and children's clothing; sweatshirts; T-shirts; tracksuits; polo shirts; sports clothing; weather resistant apparel; rainwear, waterproof clothing; leisure wear; shirts, coats, jackets, trousers; jeans; vests, shorts; skirts, blouses; overcoats; sweaters, pullovers, cardigans; ties, belts; head wear; caps; hats; socks; gloves; footwear; shoes, boots; boots for sports; swimming costumes; scarves; all the aforesaid goods relating to the fictional character Bulldog Drummond, none of the aforesaid goods

	for use within the garden, horticultural or contractor industries.
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21. In its counterstatement the applicant submits:

“The Applicant denies that the goods specified in the application in suit are identical or similar to the goods specified in the United Kingdom Trade Mark Registration.”

22. This is clearly not the case as the parties’ specifications contain a number of identical terms including, inter alia, printed matter in class 16 and clothing in class 25.

23. The opponent has provided a list of the applicant’s goods which it believes to be identical or similar to those in its own specification and provided further detail at the hearing. I will refer to them as necessary below.

24. In comparing the goods, I bear in mind the following guidance provided by the General Court (GC) in *Gérard Meric v OHIM*, Case T-133/05:

“29. ...goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

25. Factors which may be considered include the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)*⁵ (hereafter *Treat*) for assessing similarity between goods and services:

- (a) the respective *uses* of the respective goods or services;
- (b) the respective *users* of the respective goods or services;
- (c) the physical nature of the goods or acts of service;
- (d) the respective trade channels through which the goods or services reach the market;
- (e) in the case of self-serve consumer items, where in practice they are found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) the extent to which the respective goods or services are competitive, taking into account how goods/services are classified in trade.

⁵[1996] R.P.C. 281

26. I also bear in mind the decision in *El Corte Inglés v OHIM Case T-420/03*, in which the court commented:

“96...goods or services which are complementary are those where there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for the production of those goods or provision of those services lies with the same undertaking (*Case T-169/03 Sergio Rossi v OHIM-Sissi Rossi* [2005] ECR II-685)”

27. I also bear in mind the comments of Daniel Alexander, sitting as the Appointed Person, in *LOVE*⁶ when he said:

“18... the purpose of the test, taken as a whole, is to determine similarity of the respective goods in the specific context of trade mark law. It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

28. Where appropriate I will, for the purposes of comparison, group related goods together in accordance with the decision in *Separode Trade Mark*⁷:

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

29. With regard to interpreting terms in specifications, I will bear in mind the guidance provided in *Treat*:

In “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”. Words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning.”

30. And in *YouView TV Ltd v Total Ltd* when⁸ Floyd J said:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at

⁶ *BL O/255/13*

⁷ *BL O-399-10*

⁸ [2012] *EWHC 3158 (Ch)* at [12]

[47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

Class 9

31. Both parties' specifications include the identical term, 'sunglasses'. The application includes apparatus for recording, transmission or reproduction of sound and equipment for audio recording and/or reproduction. The opponent has a registration which includes radios which are for transmission or reproduction of sound. In my experience, digital radios may also include the ability to record to media card or installed hard drive. Consequently, in accordance with the principles in *Meric*, these are identical goods.

32. The application includes eyeglasses and cases for eyeglasses and sunglasses in class 9; the opponent's specification includes sunglasses. Both types of goods can be sold with or without a prescription and will be bought by members of the general public in order to assist sight, or as a fashion item, or both. In the case of sunglasses they are also purchased to shield the wearer's eyes from the sun. They are likely to be sold in similar areas of the same outlets. In my experience it is not uncommon to buy eyeglasses and change the lenses in order to convert the frames into prescription sunglasses. In addition there are several ranges of glasses which react to light and darken the lenses to become sunglasses. All of these goods may be bought from department stores, specialist stores such as opticians, or online or from a catalogue. The goods are not in competition and are not complementary. Taking all of these factors into account, I find these goods to be highly similar.

33. Cases for eyeglasses and sunglasses will be bought by those purchasing eyeglasses or sunglasses and are used to protect the glasses from damage. They will be displayed in similar areas to the glasses themselves and, in my experience, are often provided by the same undertaking as the glasses themselves. They have a degree of complementarity, to the extent that one would not buy a case for eyeglasses or sunglasses without having the eyeglasses or sunglasses to put in it. The goods are not in competition. Taking these factors into account, there is a reasonable degree of similarity between sunglasses and the cases to store them in.

34. The application includes electronic publications and downloadable electronic publications. The opponent's specification includes printed matter, which includes printed publications. The applicant's goods in class 9 are the electronic equivalent of the printed goods in class 16. They may be used by a member of the general public, for recreational or educational purposes, to provide information or entertainment. They may be complementary as, in my experience; printed material is often supported by a website or other online information sources. They may also be in competition as it is not unusual to be able to buy such material in paper form or

download an electronic version to a computer or other device. They may be available through the same online retailer, where they will be side by side, or through their own specialist retailer either on the high street, through a catalogue or from a website. I find these goods to be highly similar.

35. The application contains electronic greetings messages and digital greetings messages, electronic greetings cards, digital greetings cards and software downloadable from the Internet in the form of greetings cards or greetings messages, in class 9. The opponent's specification includes greetings cards in class 16. The users of the goods are members of the general public. The goods are used to send a greeting/message to someone. The applicant's greeting messages are provided digitally while the opponent's greetings cards in class 16 will be in paper form. The goods are not complementary but may be in competition, as the sender may opt for an electronic or a printed card to get its message to the recipient. I find these goods to be highly similar.

36. The application includes apparatus for recording, transmission or reproduction images and equipment for video recording and/or reproduction. The opponent's registration includes radios. Both may be purchased by members of the general public for entertainment or information purposes. It is difficult to separate audio and visual apparatus as many devices record/transmit both audio and visual material; such is the symbiotic relationship between them. They are likely to be manufactured by the same or similar undertakings and are likely to reach the end user by the same or similar trade channels. They are likely to be displayed close to each other, especially when one considers that audio/visual is a category of goods in its own right. The goods are not in competition, though may have a degree of complementarity. Taking all of these factors into account, I find there to be a moderate degree of similarity between these goods.

Class 16

37. Printed matter, books, magazines, stationery, address books, albums and diaries, posters, photographs and calendars are all identical terms contained in both parties' specifications and so are identical goods. Notebooks are identical to notepads, being a different word for the same article.

38. Printed publications, newsletters, leaflets and brochures, colouring books, children's activity books, trading cards, lithographs, book covers, book marks and invitations are all included within the opponent's term 'printed matter' and are therefore identical goods. In the absence of submissions from the parties to the contrary, and taking account of the relevant case law which I have outlined above, the term 'printed patterns for costumes, pyjamas, sweatshirts and t-shirts' also falls within the term printed matter and is therefore an identical term.

39. Writing paper, envelopes, note cards, writing and drawing instruments, pens, pencils, and cases therefor, erasers, crayons, markers, coloured pencils, painting sets, crêpe paper, desk sets comprising leather blotter holders and leather holders for pens, paper, ink bottles and documents and money clips (of the type found in class 16) are all included within the opponent's term, 'stationery', and are therefore identical goods.

40. Gift wrapping paper in the applicant's specification is included within the opponent's term, 'wrapping and packaging materials'. Consequently, these are identical goods.

41. Chalk and chalk boards in the applicant's specification are included within the opponent's 'teaching materials'. Consequently, these are identical goods.

42. Booklets sold with audio tapes as a unit in class 16 are first and foremost, booklets, which fall within the opponent's specification, 'printed matter'. The fact that an audio tape may be included with the booklet does not alter the primary nature of the goods, which are booklets. Accordingly, these are identical goods.

43. 'Modelling materials' covers a broad range of goods. At the hearing the opponent's representative concluded that these goods are similar to teaching materials. 'Teaching materials' is also a broad category of goods which may include materials for teaching art and design, which in turn may include sculpture/modeling instruction. Accordingly, I find there to be a degree of similarity between these goods, but it is no more than moderate at its highest point.

44. Printed transfers for embroidery or fabric appliqués, decals and heat transfers are all goods which may be printed on a range of materials and will be used (for the most part) for decorative purposes. They differ from printed matter to the extent that this range of goods are principally paper goods which will be read by the average consumer. The trade channels for these goods are different and even when they are sold within the same store or on the same website, they are likely to be in very different areas. Printed matter is likely to be displayed with stationery or books and information, whereas printed transfers for embroidery or fabric appliqués, decals and heat transfers are likely to be in a craft or hobby area. The goods are neither complementary, nor in completion and are dissimilar goods.

45. Paper party decorations, and paper cake decorations will be used by members of the general public as part as a celebration. Paper napkins, paper doilies, paper place mats, paper table cloths may also be used as part of a celebration or to prepare a table/during a meal. In my view these goods are not included within any of the goods in class 16 of the opponent's earlier mark. Even though it is likely that they will be printed, not all printed items will fall within the term 'printed matter'. Having considered the nature of the goods, their intended purpose, their method of use and whether they are in competition with each other or are complementary, I can find no meaningful areas in which the competing goods coincide. These are dissimilar goods.

Class 18

46. Leather and imitation leather and goods made of these materials not included in other classes, umbrellas, parasols, wallets, purses, handbags and luggage are all terms which are included in both parties' specifications and are identical. Rucksacks are identical to backpacks, being a different word for the same article.

47. Travelling bags and suit bags are included within the opponent's term, 'bags', and are also items of luggage which fall within the term 'luggage' in the specification of the opponent's earlier mark. Suitcases and trunks also fall under the term 'luggage' as do attaché cases and vanity cases. Briefcases may be made of leather or imitation leather (as can most of the other goods) and can also be included under the broad term 'bags'. All of these goods are identical to the opponent's goods in class 18.

48. The application includes the term 'walking sticks'. The opponent has a range of bags and travelling bags/luggage as well as smaller goods such as wallets and purses in its class 18 specification. Having considered the nature of these goods, their intended purpose, their method of use and whether they are in competition with each other or are complementary, I can find no meaningful areas in which these competing goods coincide.

Class 25

49. The opponent's goods in class 25 include the broad terms 'Articles of clothing, footwear and headgear'. The applicant's class 25 specification includes the terms 'clothing', 'footwear' and 'head wear' which are clearly identical. The remaining goods are all items of clothing, footwear or headgear, which in accordance with *Meric* are included within the broad terms and are therefore identical.

Comparison of marks

50. The marks to be compared are as follows:

The opponent's mark	The applicant's mark
BULLDOG	BULLDOG DRUMMOND

51. In making a comparison between the marks, I must consider the respective marks' visual, aural and conceptual similarities with reference to the overall impressions created by them, bearing in mind their distinctive and dominant components⁹, but without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

52. The opponent's mark consists of the single word BULLDOG in block capitals. No part of the word is stylised or emphasised in any way. Consequently, the distinctiveness lies in the mark as a whole.

⁹ *Sabel v Puma AG, para.23*

53. The applicant's mark consists of the two words BULLDOG and DRUMMOND in block capitals. No part of either word is stylised or emphasised in any way. The first word refers to a breed of dog, the second may be seen as a surname, the name of a particular bulldog or an invented word. Each part of the mark is a distinctive component and each has equal dominance.

Visual and aural similarities

54. In respect of the visual similarities the opponent submits:

"...The Applicant's sign is prefixed by the whole of the Opponent's mark. It is accepted principle that the beginning of marks are generally considered the most memorable in the minds of consumers when calling trade marks to mind. In the present case, what consumers are likely to remember when recalling both trade marks to mind is the word "Bulldog". The Applicant's and Opponent's marks are therefore visually similar."

55. In respect of any aural similarity the opponent submits:

"Aurally, the Applicant's and Opponent's marks coincide in the word "Bulldog" and differ in the remaining part "Drummond" which is of surnominal connotation. The marks therefore coincide in the first word of each mark. The marks are therefore aurally highly similar."

56. Both marks contain the word 'BULLDOG'. It is the first word of the applicant's mark and the totality of the opponent's mark. The application also includes the additional word 'DRUMMOND'. Taking all of these factors into account, I find these marks share a moderate degree of visual and aural similarity.

Conceptual similarities

57. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.¹⁰ The assessment must be made from the point of view of the average consumer.

58. The average consumer cannot be assumed to know the meaning of everything. In the *Chorkee* case (BL O-048-08), Anna Carboni, sitting as the Appointed Person, stated in relation to the word CHEROKEE:

"36...By accepting this as fact, without evidence, the Hearing Officer was effectively taking judicial notice of the position. Judicial notice may be taken of facts that are too notorious to be the subject of serious dispute. But care has to be taken not to assume that one's own personal experience, knowledge and assumptions are more widespread than they are."

¹⁰ *This is highlighted in numerous judgments of the GC and the CJEU including Ruiz Picasso v OHIM [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.*

37. I have no problem with the idea that judicial notice should be taken of the fact that the Cherokee Nation is a Native American tribe. This is a matter that can easily be established from an encyclopedia or internet reference sites to which it is proper to refer. But I do not think that it is right to take judicial notice of the fact that the average consumer of clothing in the United Kingdom would be aware of this. I am far from satisfied that this is the case. No doubt, some people are aware that CHEROKEE is the name of a native American tribe (the Hearing Officer and myself included), but that is not sufficient to impute such knowledge to the average consumer of clothing (or casual clothing in the case of UK TM no. 1270418). The Cherokee Nation is not a common subject of news items; it is not, as far as I am aware, a common topic of study in schools in the United Kingdom; and I would need evidence to convince me, contrary to my own experience, that films and television shows about native Americans (which would have to mention the Cherokee by name to be relevant) have been the staple diet of either children or adults during the last couple of decades.”

59. Similarly in this case, I am aware that ‘BULLDOG DRUMMOND’ may refer to the post WW1 adventure hero. The character had its high point in the 1920s and has not been published for some years, the author having died in the 1930s. In the absence of any evidence from the parties to the contrary, I am not able to take judicial notice of the fact that the average consumer for the goods at issue would know this.

60. The opponent’s mark creates the conceptual impression of the well known breed of dog, the bulldog. The applicant’s mark begins with the same word, bulldog, which will create the same conceptual impression. Particularly as, in this case, the second word in the mark, Drummond, appears to either indicate the name of a particular bulldog or be unrelated to the first word, being seen as a surname or an invented word. Taking all of these factors into account there is a moderate degree of conceptual similarity between the marks.

Distinctive character of the earlier mark

61. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been used as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger Joined Cases C-108/97 and C-109/97* [1999] ETMR 585.

62. I have no evidence to consider in this case so need only consider the inherent distinctive character of the earlier mark. BULLDOG is a well known word in the English language. It is not descriptive or allusive of the goods. As a consequence the mark enjoys a good degree of inherent distinctive character.

Likelihood of confusion

63. In assessing the likelihood of confusion, I must adopt the global approach

advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind.¹¹ I must also keep in mind the average consumer for the goods, the nature of the purchasing process and have regard to the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa.

64. I have found the marks to be moderately similar, visually, aurally and conceptually. I have found the earlier mark to have a good level of inherent distinctive character.

65. In *Aldi GmbH & Co KG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-505/11* the GC stated:

“91 In addition, the Opposition Division considered that the goods at issue were identical, as was recalled in the contested decision, without the Board of Appeal’s taking a final decision in that regard (see paragraph 40 et seq. above). That implies, in accordance with the case-law cited at paragraph 23 of the present judgment, that, if there is to be no likelihood of confusion, the degree of difference between the marks at issue must be high (see, to that effect, judgment of 29 January 2013 in Case T-283/11 *Fon Wireless v OHIM – nfon (nfon)*, not published in the ECR, paragraph 69).”

66. I have found most of the applicant’s goods to be identical, some to be similar and some to be dissimilar to the opponent’s goods. In the case of dissimilar goods it is a sine qua non that there cannot be a likelihood of confusion. I have identified the average consumer, namely a member of the general public, and have concluded that the level of attention paid to the purchase will vary according to the nature of the goods. The opponent’s goods in classes 9 and 25 are limited to ‘use within the garden, horticultural and contractor industry’, and will consequently require a higher level of attention to be paid.

67. In reaching a decision on the likelihood of confusion I am mindful of the guidance on how to approach issues of similarity involving composite signs which can be found in the CJEU’s judgment in *Medion AG v Thomson multimedia Sales Germany & Austria GmbH*, Case C-120/04 where it was held that:

“29. In the context of consideration of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see *Matratzen Concord*, paragraph 32).

¹¹ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

30. However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, 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.

31. 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 derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.

32. The finding that there is a likelihood of confusion should not be subject to the condition that the overall impression produced by the composite sign be dominated by the part of it which is represented by the earlier mark.

33. If such a condition were imposed, the owner of the earlier mark would be deprived of the exclusive right conferred by Article 5(1) of the directive even where the mark retained an independent distinctive role in the composite sign but that role was not dominant.”

68. In *Aveda Corporation v Dabur India Limited*¹²Arnold J held:

“47. In my view the principle which I have attempted to articulate in paragraph 45 above is capable of applying where the consumer perceives one of the constituent parts to have significance independently of the whole, but is mistaken as to that significance. Thus in *BULOVA ACCUTRON* the earlier trade mark was *ACCURIST* and the composite sign was *BULOVA ACCUTRON*. Stamp J held that consumers familiar with the trade mark would be likely to be confused by the composite sign because they would perceive *ACCUTRON* to have significance independently of the whole and would confuse it with *ACCURIST*.

48. On that basis, I consider that the hearing officer failed correctly to apply *Medion v Thomson*. He failed to ask himself whether the average consumer would perceive *UVEDA* to have significance independently of *DABUR UVEDA* as a whole and whether that would lead to a likelihood of confusion.”

69. The word *BULLDOG* is the totality of the opponent’s mark and the first word of the applicant’s mark. There is a general rule, clear from decisions such as joined cases T-183/02 and T-184/027¹³, that the first parts of words (and consequently, first words of marks) catch the attention of consumers. However, it is also clear that each case must be decided on its merits considering the marks as wholes. In this case the

¹²[2013] EWHC 589 (Ch)

¹³ *El Corte Inglés v OHIM – González Cabello and Iberia Líneas Aéreas de España (MUNDICOR)* [2004] ECR II – 965, paragraph 81

word BULLDOG has significance independently of BULLDOG DRUMMOND as a whole. It is a clearly understood word at the start of the mark which gives the average consumer a clear picture in their mind. The word DRUMMOND is more ambiguous and may be considered a surname, a nickname or the name of a specific dog, but none of these detract from the core message which is that of a BULLDOG.

70. I am mindful of the decision in *Medion* which makes clear that a finding of a likelihood of confusion should not depend upon the overall impression of the composite mark being dominated by the part which is identical to the earlier mark. *Medion* recognises that the overall impression in a case such as this may lead the public to believe that the goods derive, at the very least, from companies which are economically linked. In my view that is the case here, even where the goods share a reasonable degree of similarity rather than a higher degree of similarity or identity; the nature of the common element BULLDOG gives rise to indirect confusion where the average consumer will believe the respective goods originate from the same or a linked undertaking.

CONCLUSION

71. The opposition succeeds under section 5(2)(b) of the Act for all of the goods opposed in class 9 and all of the goods applied for in class 25.

72. The opposition succeeds under section 5(2)(b) of the Act for all of the goods applied for in class 16, with the exception of paper party decorations, paper cake decorations, paper napkins, paper doilies, paper place mats and paper table cloths; printed transfers for embroidery or fabric appliqués, decals and heat transfers and all of the goods applied for in class 18, with the exception of walking sticks.

73. The application may proceed to registration in respect of the following goods and services:

Class 3

Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery; essential oils; toiletries; creams and lotions; hair lotions; shampoo; dentifrices; deodorants; cosmetics; cosmetic brushes and applicators; aftershave preparations and colognes; non-medicated preparations for the bath and shower, body care preparations, skin care preparations, nail care preparations and accessories, false nails; room fragrances, incense; decorative transfers for cosmetic purposes; baby creams, lotions, cleaning and care preparations for leather and leather goods.

Class 9

Photographic, cinematographic, magnetic data carriers, recording discs; games (apparatus adapted for use with television receivers; computer mice, mousemats; mobile phone accessories; computer software; computer software supplied from the Internet; software including games downloaded in electronic form from the Internet for use on computers, telephones, mobile telephones, PDA's and electronic diaries; downloadable software; digital music downloadable from the Internet; videos; mini disks; MP3s, JPEGs, MPEGs, CD's; DVD's; audio tapes, video tapes; software including games downloaded or transmitted via

WAP, infrared or other wireless protocols in electronic form for use on computers, telephones, mobile telephones, PDA's; computer apparatus; electronic games and amusement apparatus; telecommunication apparatus; discs and other media bearing audio and/or video recordings; electronic cards; MP3's, JPEGs and MPEGs being electronic messages, downloadable ringtones; downloadable telephone ringtones; downloadable telephone logos and games; cellular telecommunications apparatus and instruments; digital telecommunications apparatus and instruments; mobile phone accessories; carriers adapted for mobile phones; cases adapted for mobile phones; holders adapted for mobile phones; mobile phones; parts and fittings for all of the aforesaid goods; all the aforesaid goods relating to the fictional character Bulldog Drummond, none of the aforesaid goods for use within the garden, horticultural or contractor industries; none of the aforesaid goods being radios or for use as radios.

Class 14

Precious metals and their alloys and goods in precious metals or coated therewith, precious stones; semi-precious stones; horological and chronometric instruments; watches; clocks; gold and silverware; boxes and cases made of precious metal; jewellery, imitation jewellery; head jewellery; costume jewellery; buckles for watchstraps, cufflinks, tie pins; silver ornaments, anklets; parts and fittings for all the aforesaid goods.

Class 16

Paper party decorations, paper cake decorations, paper napkins, paper doilies, paper place mats and paper table cloths, printed transfers for embroidery or fabric appliqués, decals and heat transfers.

Class 18

Walking sticks

Class 28

Toys, games and playthings; playing cards; sporting articles; decorations for Christmas trees; paper party favours; paper hats; golf bags.

Class 34

Cigarettes, tobacco and tobacco products, smokers' articles and requisites; lighters; matches; ashtrays; cigarette holders; cigarette cases; cigar cutters; all the aforesaid goods relating to the fictional character Bulldog Drummond.

Class 38

Telecommunications services; chat room services; providing Internet chat rooms; broadcasting services; broadcasting services via television, satellite, radio, wireless and/or a global computer network, or by digital distribution technologies including IPTV and podcasting; operating of web logs (blogs); analogue transmission services; digital transmission services; digital distribution services; interactive television services; information, advice, and consultancy services relating to all the aforesaid.

Costs

74. The opponent has largely succeeded and is entitled to an award of costs in its favour. At the hearing the opponent's representative asked that I take into account the fact that the applicant requested a hearing in this case and then declined to

attend. Mr Sandiford submitted that this resulted in unnecessary additional cost to his client.

75. The applicant, having requested a hearing, sent an email confirming it would not be attending at 9.08am on 14 January 2014, two days before the hearing. The email was copied to the opponent. The applicant should have considered whether attendance was necessary prior to making the request. However, the opponent would have had to prepare submissions in any case.

76. In addition, on becoming aware of the non-attendance of the applicant, the opponent could have requested a hearing be held by telephone or may have requested the decision be made from the papers. Accordingly, I will not take this matter into account in making an award for costs. I make the award on the following basis:

Preparing a statement and considering the other side's statement:	£200
Official fee:	£200
Preparation for and attending a hearing:	£500
Total	£900

77. I order KBS Bulldog Drummond Limited to pay Rollins Bulldog Tools Limited the sum of £900. 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 18th February 2014

**Ms AI Skilton
For the Registrar,
the Comptroller General**