

O-045-17

IN THE MATTER OF THE TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL TRADE MARKS NUMBERS 1,201,181 AND
1,201,182

AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF BEVERLEY
HEDLEY DATED 16TH JUNE 2016 (O/290/16)

DECISION

Introduction

1. This is an appeal from the decision of Beverley Hedley, for the Registrar, dated 16th June 2016 in which she dismissed the opposition of GRE Grand River Enterprises Deutschland GmbH to Philip Morris Brands Sarl's request for protection of their international marks numbers 1,201,181 and 1,201,182. The Opposition was based on s 5(2)(b) of the Trade Marks Act 1994. GRE appeals.
2. Philip Morris's request for protection was for the marks MARK 10 and MARKTEN in class 34 in relation to:
Class 34: Tobacco, raw or manufactured; tobacco products, including cigars, cigarettes, cigarillos, tobacco for roll-your-own cigarettes, pipe tobacco, chewing tobacco, snuff tobacco, kretek; snus; tobacco substitutes (not for medical purposes); smokers' articles, including cigarette paper and tubes, cigarette filters, tobacco tins, cigarette cases and ashtrays, pipes, pocket apparatus for rolling cigarettes, lighters; matches; electronic apparatus for tobacco, particularly electronic cigarettes, tobacco products and tobacco substitutes; electric vapor generators for tobacco, tobacco products and tobacco substitutes; heating apparatus for the preparation for consumption and the consumption of tobacco and tobacco products; electric heating apparatus for the preparation for consumption and the consumption of tobacco and tobacco products.
3. GRE is the registered proprietor of European Trade Mark No 9,148,628 for the mark MARK ADAMS NO 1 in class 34 in relation to:
Class 34: Unprocessed tobacco, processed tobacco and tobacco products, included in class 34, in particular cigarettes, cigars, cigarillos, fine cut tobacco, pipe tobacco, chewing tobacco, snuff, cigarettes containing tobacco substitutes, not for medical purposes; smokers' articles, in particular tobacco tins, cigarette cases, cigarette holders, ashtrays (all the aforesaid goods not of precious metal or coated therewith), cigarette papers, cigarette tubing, cigarette filters, smoking pipes, pocket apparatus for rolling cigarettes, lighters, included in class 34; matches; cigarette cases of precious metal; cases (cigarette -), of precious metal; cigarette holders of precious metal; cigar cases of precious metal and wood; boxes (cigar -), of precious metal; cigar holders of precious metal.

Approach to appeal

4. In *Talk for Writing* (O/17/17), Daniel Alexander QC, sitting as the Appointed Person, reviewed the developments in the case law on the standard of review for trade mark appeals since *Reef TM* [2002] EWCA Civ 763, [2003] RPC 5. He considered, in particular, whether the Supreme Court's decision in *Re S* [2013] UKSC 33 has affected that approach. He concluded it has not and the standard remains essentially what it was before. He also made another important observation at paragraph 51:

the case law drew attention to the fact that [the] decision under appeal clearly had to be wrong and not merely one which the appellate tribunal would not have taken on a topic where reasonable people could differ.

5. I entirely endorse Mr Alexander's conclusions and will take them into account for the purpose of this appeal.

Hearing Officer's decision

6. The Hearing Officer's decision adopted the usual approach. She concluded that most of the goods in the PRE's specification were identical to goods in Philip Morris's specification and where they were not (for example "electronic apparatus for tobacco") they were highly similar (Decision, paragraphs 15 to 20). She identified the average consumer as the smoking portion of the general public (Decision, paragraph 22) and she made certain observations about the channel of trade for these goods (and the restrictions imposed by regulation) (Decision, paragraphs 22 to 24).
7. The Hearing Officer went on to compare Philip Morris's first mark MARKTEN with that of GRE, MARK ADAMS NO 1. She concluded that there was a very low degree of visual similarity (Decision, paragraph 31). She went on to find that the aural similarity between the marks was low (Decision, paragraph 33). She also compared Philip Morris's second mark MARK 10 with MARK ADAMS NO 1. Once again, she found there was a very low degree of visual similarity (Decision, paragraph 40) and she concluded the aural similarity to be very low or low (Decision, paragraph 41). In the hearing of this appeal, GRE accepted that none of these findings was open to challenge.
8. After setting out the parties' submissions, the Hearing Officer considered the conceptual similarity between the first mark (MARKTEN) and GRE's mark (MARK ADAMS NO 1) at paragraphs 34 to 36 of her Decision:

...I see no reason why the word MARK in the opponent's mark would be perceived as an abbreviation for the word 'trade mark'. As the applicant points out, it is followed by a common surname, ADAMS, thereby leading the consumer to perceive the word MARK as a forename. As to the NO 1 element, this will be perceived as meaning number one. The opponent's mark, as a whole, will therefore be perceived as a full personal name (MARK ADAMS) followed by number 1 (NO 1).

35) Whilst the applicant appears to agree with the opponent that its mark may be perceived as the two words "mark" and "ten" conjoined, it also submits that it may be perceived as a single word. My own view is that the latter scenario is more likely. However, I will consider both possibilities. In the event the mark is perceived as a single word, it is one with which the consumer is unlikely to be familiar, portraying no concept at all (I do not consider that the Dutch

meaning of ‘market’ will be apparent to the average UK consumer). On that basis, there is no conceptual similarity between the marks.

36) I will now consider the position in the event the mark is perceived as the two words MARK and TEN conjoined. One potential meaning of MARK is, as the opponent states, a common forename. However, I am not persuaded that this is how the consumer will perceive the word MARK in the context of the applicant’s mark as a whole. There is nothing, such as a common surname following the word MARK or a possessive ‘s’, to lead the consumer to construe it as a person’s name. To my mind, the word MARK portrays no clear meaning in the applicant’s mark and when combined with the word TEN, the meaning of the mark as a whole is also unclear (aside from the fact that it makes reference to the numeral 10). Bearing these conclusions in mind, I find that, if there is any conceptual similarity between the marks, this stems solely from both making a reference to a numeral but this factor alone is far from sufficient to deem the marks conceptually similar. Taking account, in particular, of the opponent’s mark sending a clear conceptual message of a personal name which is absent from the applicant’s mark, the respective marks are not conceptually similar overall.

9. In relation to the second mark (MARK 10), the Hearing Officer said the considerations in paragraph 36 equally applied and the marks were not conceptually similar overall (Decision, paragraph 41).
10. GRE’s sole criticism of the Hearing Officer’s decision is that no properly directed tribunal could find that the conceptual similarity is nil. In his oral submission, Mr Chapple confirmed that his case is that the Hearing Officer’s decision must be read to mean that there was zero conceptual similarity and not that the similarity is at the bottom of the scale.

Conceptual similarity

11. While in semiotics it might be arguable that two marks must have some degree of conceptual similarity, in trade mark law it is common – almost routine – to say two marks have no conceptual similarity. For example, such a finding of the General Court was upheld by the Court of Justice in C-234/06 *Il Ponte Finanziaria* [2007] ECR I-7367 at paragraph 49 and domestically, a finding of the Registry was upheld by Ruth Annand, sitting as the Appointed Person, in *Kath Kidston* (O/404/14), paragraphs 26 to 29.
12. Indeed, as I noted in *CALEDONIAN* (O/382/16) at paragraph 33:

Hearing Officers routinely use phrases like “high degree” or “low degree” of similarity, but these phrases cannot be treated as quasi-numerical scales where a certain number of points equals a likelihood of confusion. They are indicators to readers of the decision (including appellate courts and tribunals) what the Hearing Officer thought of the similarity of the relevant mark or goods so as to help explain their reasoning and no more. Indeed, the value judgment involved in assessing similarity means that the borderline between what a person might describe as, for example, similar to a very high degree and similar to a high degree will vary between Hearing Officers. However, as these words are guides to the reasoning of the Hearing Officer, rather than a precise scale, this does not matter.
13. Thus, when a Hearing Officer uses the phrase “no conceptual similarity” it is not to be read as it might be in semiotics, but rather as an indicator that a finding has been made

that the conceptual relationship between the marks is too remote to be legally significant.

14. GRE's submissions on appeal is that "when the word MARK is identical in the two respective cases and is the first element of the trade mark....[there] must be some sort of conceptual similarity.... also both of them have numbers or have a mark and then with a number afterwards."
15. This submission seems to negate the assessment of conceptual similarity. Where two word components in two different marks are the same (or two figurative components of the respective marks identical), this similarity will be identified and assessed in the visual comparison. The purpose of the conceptual comparison arises because the same word can have quite different meanings when the context changes. The word MARK is a perfect example of this fact. It can, amongst other things, be a name (such as Mark Adams), a score (a mark of 5 out of ten), a blemish (there is a mark on the dress), a product number (the Mark IV tank used in the First World War), a point on the ground (take your mark), a biblical reference (Mark 10:1, albeit this is indirectly related to the name), or it can be an abbreviation of trade mark. In each case the context of its use conveys very different meanings.
16. Accordingly, the Hearing Officer had to consider what the conceptual meaning of the word would be in combination with the remainder of the mark and the goods in question. She considered GRE's mark MARK ADAMS NO 1 and concluded that the relevant public would see it as a name (MARK ADAMS) followed by a number (Decision, paragraph 34). This finding is entirely proper and accords with my own reading of the mark.
17. The Hearing Officer concluded that the mark MARKTEN would portray no conceptual meaning at all to British consumers (as the general public would not be aware of its meaning in Dutch) (Decision, paragraph 35). As a matter of trade mark law, I can see no problem with this finding of fact and absolutely no grounds to disturb it.
18. In relation to MARK TEN (MARKTEN as two words) and MARK 10, she undertook a slightly more detailed analysis. The Hearing Officer concluded that in these marks the word MARK would not be seen as a forename (Decision, paragraph 36). Once more this finding is entirely proper. She goes on to say that the combination of MARK with TEN (or 10) conveys no clear meaning (Decision, paragraph 36). While the examples I have given above suggest that some consumers might attach some conceptual message to MARK TEN (such as biblical references, tanks or other products) it is also perfectly clear that others will not. Therefore, it is reasonable to find, as that Hearing Officer did, that the marks convey no clear conceptual message to the relevant public.
19. The Hearing Officer also considered the fact that both marks included a numeral, but she concluded this was not enough on its own to make the marks conceptually similar (Decision, paragraph 36). This finding is once more entirely proper.

20. The Hearing Officer concluded her assessment of conceptual similarity by comparing a mark with a clear conceptual message (MARK ADAMS NO 1) with marks which she found to have no clear conceptual message (MARKTEN and MARK 10) and said there was no conceptual similarity. Considering her earlier findings this conclusion was inevitable.
21. Accordingly, I dismiss the appeal and uphold the Hearing Officer's Decision. I order the Appellant (GRE) to pay £1,000 to the Respondent (Philip Morris) towards the costs of this appeal.

PHILLIP JOHNSON

THE APPOINTED PERSON

27th January 2017

For Appellant (GRE Grand River Enterprises): Malcolm Chapple

For the Respondent (Philip Morris Brands): Patricia Collis