

O/634/19

TRADE MARKS ACT 1994 IN THE MATTER OF REGISTERED TRADE MARK

(SERIES OF TWO) NO 3314918 IN THE NAME OF SAM HILL




AND

IN THE MATTER OF INVALIDATION ACTION NO 502390 IN THE NAME OF
JONATHAN MARK TURNER

Background and pleadings



1. The following UK registered trade mark (No 3314918):  is in the name of Tom Hill (the Registered Proprietor). It was applied for on 1st June 2018 as a series of two and was accepted and published in the Trade Marks Journal on 17th August 2018 in respect of clothing in Class 25.
2. The Applicant for invalidation is Jonathan Mark Turner. He attacks the registration on the basis of Sections 5(1) and 5(2)(a) of the Trade Marks Act 1994 (the Act). This is on the basis of his earlier UK Trade Mark No 3266923: Equality. The goods relied upon include clothing in Class 25.
3. Mr Turner argues that the respective goods are identical or similar and that the marks are identical.
4. The Registered Proprietor filed a counterstatement denying the claims made.
5. Neither side filed written submissions and no hearing was requested and so this decision is taken following a careful perusal of the papers.

DECISION

Section 5 (1) and 5 (2)(a)

6. Section 5(1) of the Act is as follows:

Section 5(1):


- 1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

7. Section 5(2)(a) of the Act is as follows:

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

- a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the 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”.

8. It is noted that each of the respective specifications contain clothing. As such, the goods are self evidently identical. Mr Turner’s attack therefore passes this part of the test. However, both Section 5(1) and 5(2)(a) require the respective trade marks to be considered identical. If they are not, then the attacks on these grounds must fail. The trade marks are displayed below:

Equality	
Earlier trade mark	Contested trade mark

9. In assessing the trade marks above, I bear in mind the guidance in *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, where the Court of Justice of the European Union held that:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

10. Further, I take into account the ruling in *Reed Executive plc v Reed Business Information Ltd*, Court of Appeal [2004] RPC 767, where Jacob L.J. found that ‘Reed’ was not identical to ‘Reed Business Information’ even for information services. He stated that:

“40. It was over “Reed Business Information” that battle was joined. The composite is not the same as, for example, use of the word “Reed” in the sentence: “Get business information from Reed”. In the latter case the only “trade-marky” bit would be “Reed”. In the former, the name as a whole is “Reed Business Information”. The use of capital letters is of some visual significance – it conveys to the average user that “Business Information” is part of the name. If the added words had been wholly and specifically descriptive – really adding nothing at all (eg “Palmolive Soap” compared to “Palmolive”) the position might have been different. But “Business Information” is not so descriptive – it is too general for that.”

11. Bearing in mind the guidance reproduced above, it is noted that the attacked registration contains (in its series of marks) a striking and prominent device. I understand this device to represent the idea of equality between males and females, which coincides with the meaning of the word equality. However, the case law as to whether trade marks are identical is considered clear. The presence of this device clearly introduces an additional element which is not

present in the earlier trade mark. Further, it cannot be described as an insignificant difference which will go unnoticed by the average consumer (who in respect of clothing, will be the public at large). It is clear and obvious within the mark. As such, it is considered that the respective trade marks cannot be deemed to be identical in the manner envisaged by both Section 5(1) and 5(2)(a) of the Act. As such, the invalidation proceedings fail on both counts.

Final Remarks – Evidence

12. Evidence from both sides was filed during these proceedings and its contents noted. However, it is considered to have had no bearing on the relevant issue here, namely whether or not the respective trade marks are identical. For the reasons outlined above, they are clearly not identical and so the attack on the registered trade mark fails. As such, for reasons of procedural economy, I have not included a summary of the evidence.

COSTS

13. The Registered Proprietor has been successful. A Tribunal Costs Pro Forma was sent to the Registered Proprietor in which he was informed that no costs would be awarded in the event it was not returned to the Tribunal. No response was received. As such, I make no order as to costs.

Dated this 21st day of October 2019

Louise White

For the Registrar