

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2228667
BY MR T BALL TO REGISTER A MARK IN CLASSES 18, 20, 24 AND 25**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No 51517
BY LZB PROPERTIES INC**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2228667
by Mr T Ball to Register a Mark in Classes 18, 20, 24 and 25**

and

**IN THE MATTER OF Opposition thereto under No 51517
by LZB Properties Inc**

DECISION

1. On 18 April 2000 Mr T Ball applied to register the following mark



2. The specification applied for is as follows

Class 18:

Bags.

Class 20:

Furniture (including beds and mattresses).

Class 24:

Textile and textile goods including bed and table covers.

Class 25:

Footwear, clothing, headgear.

3. The application is numbered 2228667.

4. On 5 October 2000 LZB Properties Inc filed notice of opposition to this application. They are the proprietors of the following registrations (all of which are earlier trade marks within the meaning of Section 6(1)(a)).

No.	Mark	Class	Goods
605575 (UK)	LA-Z-BOY	20	Chairs.
1500705 (UK)	LAZY BOY	20	Furniture; upholstered furniture; chairs, settees and ottomans, all being upholstered; parts and fittings for all the aforesaid goods; all included in Class 20.
40675 (CTM)	LAZY BOY	20	Furniture.
40691 (CTM)	LA-Z-BOY	20	Furniture.
40709 (CTM)	LA-Z	20	Furniture.

They object as follows:

- (i) under Section 5(2)(b) in so far as the application covers Class 20 goods.
- (ii) under Section 5(3) in so far as the application covers goods other than in Class 20. In the event the opponents' written submissions indicated that this ground was not being pursued.
- (iii) under Section 5(4)(a) in so far as the Class 20 goods are concerned based on the use of their mark LA-Z-BOY since 1981.

5. The applicant filed a counterstatement denying the above grounds.

6. Both sides ask for an award of costs in their favour.

7. Only the opponents filed evidence. Neither side has asked to be heard. Written submissions have been received on behalf of the applicant under cover of a letter dated 10 April 2002 from Appleyard Lees and on behalf of the opponents under cover of a letter dated 11 April 2002 from J A Kemp & Co. I take these submissions into account.

8. Section 5(2)(b) 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."

9. The opponents have referred me to a number of decisions of the European Court of Justice (ECJ). I take into account the guidance provided in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

10. It is clear from these cases that:-

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is

not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;

- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG*, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29."

Distinctive character of the opponents' mark

11. The opponents have filed a statutory declaration by Thomas Brown of Centurion Furniture Plc, the UK subsidiary of La-Z-Boy Inc and an affidavit by Richard G Micka, Vice President Administration of La-Z-Boy Inc. LZB Properties Inc (the opponents) is a wholly owned subsidiary of La-Z-Boy Inc. Mr Brown gives evidence of use of the opponents' marks in the UK. The main points to emerge are

- the marks have been used since at least 1992 in relation to reclining chairs and seats along with parts and fittings for such goods. Product information literature is exhibited at TB/1
- sales volumes have increased from £4.5 million (8000 units) in 1994/5 to £14 million (27,410 units) in 1999/2000.
- Mr Brown claims that these sales figures represent a significant proportion of the reclining chair market
- goods have been sold throughout the UK as evidenced by the invoices at Exhibit TB/2
- the goods have been extensively promoted in publications such as 'House Beautiful', 'Time Out Living Guide', 'Manchester United Official Magazine', 'the Guardian' and 'Radio Times' as well as large audience TV shows such as 'The Big Breakfast' and 'BBC Breakfast Show'. (Exhibit TB/3)
- advertising expenditure has risen from £26,507 in 1994/5 to £213,256 in 1999/2000.

12. Mr Micka's evidence supplements the above with information on trading in the UK prior to Centurion Furniture's involvement in 1992. He traces this trading activity back to 1979 though detailed records from this earlier period are no longer available. The applicant has filed no evidence

and has not taken issue with any of the claims made in the opponents' evidence.

13. The conclusions I draw from the evidence are that

- the opponents' trade is largely based on a single product namely a sophisticated reclining chair
- in that context I do not find it difficult to accept Mr Brown's claim that the opponents enjoy a significant market share
- the mark that is used is LA-Z-BOY. If there are uses of LAZY BOY or LA-Z they are not immediately obvious
- the mark LA-Z-BOY is likely to have a highly distinctive character in relation to reclining chairs.

Similarity of goods

14. The applicant's specification in Class 20 covers furniture at large. The opponents' CTM registrations also cover furniture. There is no doubt therefore, that identical goods are involved.

Similarity of marks

15. The opponents in their written submissions suggest that both marks convey a meaning; that the meanings have no relevance to the goods and hence are distinctive; that the respective marks suggest similar ideas and could be used interchangeably; that the first element creates visual and aural similarity and that start of the second element (BO) heightens this similarity. It is submitted that both marks are suggestive of someone who wants to laze around and that the applicant's mark will be seen as another venture by, or connected with, the 'lazy' range of furniture. They quite rightly emphasise that I must approach the matter on the assumption of notional fair use of the mark applied for.

16. The applicant submits that the opponents' mark LA-Z-BOY will be pronounced either as "elle ay" -"zed"- "boy" or "laah" -"zed" -"boy" and that as a consequence there will be no phonetic similarity with their own mark; that visually their own mark is both longer and stylised; and that there are conceptual differences as well with LA-Z-BOY/LA-Z having no understood meaning in the UK whilst LAZY BOY suggests an individual whereas their own mark refers to a general appearance or type of behaviour.

17. With the parties' submission in mind I come to my own view of the matter. I propose to consider the matter firstly on the basis of the form of the mark used by the opponents that is LA-Z-BOY. The abbreviated and hyphenated presentation must, I think, be considered to be part of the distinctive character of the opponents' mark from a visual standpoint. The applicant's mark on the other hand is also presented in a somewhat stylised 'wave' form with the repeated Zs at the end of

the mark. The marks are therefore of unequal length and overall appearance.

18. From an oral/aural standpoint the question arises as to how the opponents' mark would be pronounced. The written submissions on behalf of the applicant offer two suggestions neither of which involves pronouncing LA-Z as if it were 'lazy'. I do not think I can accept the submission that this element will be either, as it is put, 'elle ay' and 'zed' or 'laah' 'zed'. The public has been educated to the use of quirky spellings or phonetic renditions of words particularly in an advertising context. I would be surprised therefore if the average consumer did not see or render LA-Z as if it were the word lazy when it is used in conjunction with the word BOY. On that basis the marks are effectively LAZY BOY and LAZY BONES (I am assuming consumers would not attempt to refer in speech to the additional Zs of the applied for mark).

19. If I am right in these assumptions (I have no evidence of what happens in actual usage) then I would hold that both marks convey easily understood meanings and are composed of common dictionary words. Moreover LAZY BONES will be heard and understood as a well known expression in its own right. That is not to say that the common element (LA-Z/LAZY) will go unnoticed simply that this feature does not make for overall aural similarity.

20. Conceptually I again start from the proposition that the average consumer will recognise the opponents' mark for what I think it is intended to be, namely, a somewhat unusual rendering of the words LAZY BOY. The opponents may be right to suggest that there is a degree of similarity in the ideas conveyed by the marks but it falls some way short in my view of the expressions being interchangeable. 'Lazybones' is very much an informal expression for a lazy person. It carries a tone of friendly admonishment. It is different in character in my view to LAZY BOY. I do not, therefore, think the opponents' submissions as to 'analogous semantic content' should be given too much weight. Nevertheless both marks might, in context be taken as oblique and clever allusions to the comforts of the goods (furniture) and/or the characteristics of the users.

Likelihood of confusion

21. Taking all the above factors into account I find that there are certain similarities between the marks. But furniture, even relatively small items, are not usually purchased without a reasonable degree of care and attention and usually after a visual inspection of the goods including whatever brand names are being used. It is possible that a consumer encountering the applicant's mark would make a mental association with the mark in which the opponents have a reputation by virtue of the element the marks have in common. However, I am not persuaded that any such association would be of more than a superficial nature and would not lead consumers to consider that even identical goods offered under the respective marks came from the same trade source.

The opponents' other marks

22. My above considerations are based on the mark used by the opponents, that is LA-Z-BOY. They also have registrations of LAZY BOY and LA-Z. I do not need to say a great deal more about the first of these marks as for aural and conceptual purposes I have treated the LA-Z-BOY

mark as equivalent to LAZY BOY. It might be said that visually the 'normal' spelling of LAZY brings the mark LAZY BOY rather closer to the applied for mark. That may be the case but it does not benefit from the acquired reputation of LA-Z-BOY. Overall I do not think it produces a different result. The respective marks have points of visual similarity in terms of the word (LAZY) and the positioning of the word or element at the start of the marks. However the marks still consist of common dictionary words which are easily recognisable and distinguishable and in the case of the applied for mark make up a well known expression (augmented by the presentational aspects of the mark).

23. The other mark is LA-Z. Taken on its own and disassociated from any other word the potential adjectival significance and meaning may be less easily understood. It is not so far as I am aware a common misspelling or presentation of the word LAZY. It may still be read that way or as the applicants suggest simply as 'elle ay' - 'zed'. The difficulty here, I think, is that, taken out of context (by which I mean any obvious and meaningful adjectival association with a noun), I cannot be certain what the average consumer would make of the mark. To extract LAZY would, it seems to me, require the consumer to pronounce the Z in the American fashion (a long e sound) as opposed to a short e sound in the normal English rendering (ZED). In all probability different pronunciations should be allowed for.

24. Nevertheless it seems to me that even if the mark is taken at its worst as it were for the applicant and was pronounced as if it were LAZY, that word and meaning is but one aspect of the mark. The unusual presentation itself must be taken to be a feature of the mark. That is particularly the case in terms of the visual appeal of the mark. It also leads me to the clear view that there can be no likelihood of confusion with the applied for mark when all relevant considerations are factored into the equation as part of the global test. The Section 5(2)(b) ground fails.

25. The only remaining ground is under Section 5(4)(a) based on the opponents' use of the mark LA-Z-BOY in the UK since 1981 in relation to reclining chairs etc. As I have already taken this use into account in relation to the position under Section 5(2)(b) I see no need to give separate consideration to the Section 5(4)(a) ground. The opponents' use is of one of their registered marks and within the scope of the registered specification. In those circumstances no issues arise which are capable of yielding a more favourable result for the opponents under Section 5(4)(a).

26. The applicant has succeeded and is entitled to a contribution towards his costs. I order the opponents to pay the applicant £1000. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 29TH day of April 2002

M REYNOLDS
For the Registrar
the Comptroller-General