

TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION No 2230645  
BY FOSTER'S EUROPE PTY LIMITED  
TO REGISTER A TRADE MARK  
THE CITY, THE REEF, THE ROCK  
IN CLASSES 25, 32 & 42

AND IN THE MATTER OF OPPOSITION THERETO  
UNDER NUMBER 51473  
BY LA CITY

## BACKGROUND

1) On 27 April 2000, Foster's Europe Pty Limited of Level 5, 77 Southbank Boulevard, Southbank, Victoria 3006, Australia applied under the Trade Marks Act 1994 for registration of the mark THE CITY, THE REEF, THE ROCK in respect of the following goods and services:

In Class 25: "Clothing, footwear, headgear."

In Class 32: "Non alcoholic drinks in Class 32: beers."

In Class 42: "Providing of food and drink: catering and bar services: temporary accommodation."

2) On the 28 September 2000 La City of 50, Avenue du President Wilson, La Plaine Saint Denis, F93214, France filed notice of opposition to the application. The grounds of opposition are in summary:

a) The opponent is the proprietor of International Registration No. 662602 LA CITY claiming a priority date of the 24<sup>th</sup> April 1996 in Classes 18 and 25, the Class 25 specification reading "Clothing, shoes, headwear". The mark in suit is confusingly similar to the opponent's trade mark and is to be registered for identical goods in Class 25. The mark applied for therefore offends against Section 5(2) of the Trade Marks Act 1994.

b) The words LA CITY appear first in the mark in suit and therefore tend to draw the consumer's attention. The addition of the French definite article LA in the earlier mark LA CITY and the English definite article in THE CITY does not take away the individuality and focus of the word CITY within each mark. Furthermore, it is to be emphasised that the word "THE" is the well-known translation of the French word "LA". Consequently, the term THE CITY in the mark in suit is the literal translation of the earlier mark LA CITY.

3) The applicant subsequently filed a counterstatement denying the opponent's claims.

5) Neither side filed evidence in these proceedings. Both sides ask for an award of costs. The matter came to be heard on 21 August 2002 when the applicant was represented by Mr Stobbs of Messrs Boulton Wade Tennant. The opponent was not represented.

## DECISION

6) The only ground of opposition is under section 5(2)(b) which 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.”

7) An earlier trade mark is defined in Section 6, 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 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,

8) In determining the question under section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *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. 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* page 224;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG* page 224, 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.* page 84, 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* page 224;
- (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* page 224;

- (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* page 132, 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* page 224;
- (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* page 224;
- (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* page 732, 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* page 133 paragraph 29.

8) At the hearing Mr Stobbs accepted that the opponent had an earlier trade mark.

9) The opposition relates only to the applicant's Class 25 specification. The applicant's specification is for "Clothing, footwear, headgear". Whilst the opponent's Class 25 specification is for "Clothing, shoes, headwear". At the hearing Mr Stobbs agreed that the Class 25 goods of the two parties are similar. I regard the goods as being identical and shall base the global assessment on this basis.

10) It is clear from the above cases that in the overall assessment of a likelihood of confusion, the similarity of goods is but one aspect. Due regard should be given to the closeness of the respective marks, the reputation the earlier mark enjoys in respect of the services for which it is registered, and any other relevant factors.

11) I will now consider the visual, aural and conceptual similarities between the trade marks by reference to the overall impression created by the marks but taking into account their distinctive and dominant components. The question must be assessed through the eyes of the average consumer taking into account the fact that the average consumer rarely has an opportunity to make a direct comparison between the trade marks; so called imperfect recollection.

12) Visually, although they share a common element, the marks are quite different. The opponent's mark is significantly shorter than the applicant's mark. The opponent contends that the first word of its mark "LA" is a well known French word meaning "THE" and would be seen as such, therefore it is postulated, the beginning of the applicant's mark is identical to the opponent's mark.

13) It is possible that the opponent's mark may be seen as a combination of a French adverb with an English noun, and that the French adverb may be recognised as the French equivalent of the English word "The". This does not mean that marks are visually similar.

14) Phonetically the marks are different although they share a common element.

15) Conceptually the marks again share an element but are, in my view, different. I accept that the average consumer may recognise the first word of the opponent's mark as being the French equivalent of "The". However, the combination of a French adverb and an English noun is not common in the UK, although clearly it is not unique, La Weekend springs to mind. Further, the applicant's mark conjures up three distinct images, none of which has an obvious French connection.

16) The opponent also claims that the first word of both marks does not "take away the individuality and focus of the word CITY within each mark". I do not accept that the focus in the applicant's mark would be simply on the second of six words.

17) Items of clothing are not, I would suggest, chosen without some consideration. The average consumer of such products would, in my opinion, exercise some care in the selection. In *REACT (1999) 15 RPC 529* the Hearing Officer held the following:

"I am therefore prepared to accept that a majority of the public rely *primarily* on visual means to identify the trade origin of clothing, although I would not go so far as to say that aural means of identification are not relied upon."

18) Ordinarily I would also consider whether the opponent's mark has a particularly distinctive character either arising from the inherent characteristics of the mark or because of the use made of it. However, no evidence has been filed. In such circumstances the opponent's marks cannot be regarded as enjoying an above average reputation at the relevant date, but it is an inherently strong mark. I must also take into account the dictum of imperfect recollection.

19) With all of this in mind I come to the conclusion that when all factors are considered, that there was no likelihood of confusion at 27 April 2000. Consequently, the opposition under Section 5(2)(b) fails.

20) The opposition having failed the applicant is entitled to a contribution towards costs. I order the opponent to pay the applicant the sum of £1000. This sum 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 14<sup>TH</sup> day of October 2002

George W Salthouse  
For the Registrar  
The Comptroller General