

TRADE MARKS ACT 1994

**IN THE MATTER OF AN APPLICATION
NO. 2235245 BY CHRISTOPHER PAUL SAUNDERS
AND DAVID PAUL HOUSE AS TRUSTEES OF A PARTNERSHIP
T/A CITYDRINKER.CO.UK**

AND

**IN THE MATTER OF OPPOSITION
NO. 52043 THERETO BY LA CITY**

TRADE MARKS ACT 1994

IN THE MATTER OF an
application No. 2235245
by Christopher Paul Saunders
and David Paul House as
trustees of a partnership
T/A Citydrinker.co.uk and
in the matter of opposition No.
52043 thereto by LA CITY

Background

1. On 7 June 2000 C P Saunders and G French as trustees of a partnership t/a Citydrinker.co.uk applied to register the following as a series of 2 marks:



2. The application was filed for goods and services in classes 9, 16, 25, 35, 38, 41 and 42. The applicant claims the colours yellow, green, red, blue, white, grey and black as an element of the first mark in the series.

3. The application was subsequently assigned to Christopher Paul Saunders and David Paul House as trustees of a partnership t/a City Drinker.co.uk and currently stands in that name.

4. On 23 January 2001, LA CITY filed notice of opposition to the application. The ground of opposition is, in summary:

- Under Section 5(2)(b) in that the trade mark is confusingly similar to the opponent's earlier trade mark and is to be registered for goods identical to those for which the earlier mark is protected.

5. The opponent's claim is based on International Registration No.735151 for the trade mark LA CITY for goods in classes 3,9,14,18 and 25. The opposition is lodged against the application only in respect of classes 9 and 25.

6. The applicant subsequently filed a counterstatement essentially denying the opponent's claim.

7. Neither side filed evidence in these proceedings and both sides ask for an award of costs.

8. In line with current practice, the Registry reviewed the case and wrote to the parties to advise that it was not considered necessary to hold a hearing in order for the opposition to be determined. The parties were, however, reminded of their right to be heard or to file written submissions in lieu of a hearing. No request for a hearing has been received. Only the applicant filed written submissions. After a careful study of all the papers, I now give this decision.

Decision

9. The only ground of opposition is under Section 5(2)(b) which states:

- “5.- (1)
- (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.”

The term “earlier trade mark” is defined in section 6 of the Act as follows:

- “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.”

10. The mark on which the opponent relies is an earlier trade mark within the definition of section 6 of the Act. In determining the question under section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel 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*, 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 he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen 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 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.

11. Under section 5(2) the test is a composite one, involving a global appreciation taking into account a number of factors. With these comments in mind, I go on to consider the applicant's case under section 5(2)(b).

12. For ease of reference I set out the respective marks and, insofar as they are relevant, the specifications of goods:

Applicant's trade mark No. 2235245



Class 9: Videos, CD ROMs, tapes, cassettes; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; data processing equipment and computers; computer software; computer hardware; mouse mats; electronic and electromechanical peripheral apparatus, all for use with computers; computer networks; computer access networks; computer programs; servers, network interface modules, switches, routers, hubs, disc controllers, computer systems, operating systems, file systems, graphical user interfaces, application programs; digital networks for the transport and manipulation of program material; publications in electronic format; microprocessors; central processing units; circuit boards; computer displays; computer monitors; video monitors; projectors; integrated circuits; microelectronics programming

devices; storage and network controllers and devices; data recorded magnetically, electronically or optically; instructional material relating to computers and to data, all recorded magnetically, optically or electronically; magnetic, optical and electronic data recording materials; parts and fittings for the aforesaid goods.

Class 25: Clothing, footwear, headgear.

Opponent's trade mark No. 735151

LA CITY

Class 9: Scientific (other than medical), nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (inspection), life-saving and teaching apparatus and instruments; apparatus and instruments for conveying, distributing, transforming, storing, regulating or controlling electric current; electric flat irons, apparatus for recording, transmitting and reproducing sound or images; video recorders; magnetic recording media; magnetic cards; compact disks (audio and video), optical disks, optical compact disks and sound recording disks; CD-ROMs and CD-Is; magnetic and optical data media; optical character readers; software (recorded programs); data processing and computer apparatus; modems; automatic vending machines and mechanisms for coin-operated apparatus; cash registers; calculating machines; data processing equipment and computers; computer peripheral devices; fire extinguishers; none being for use with boilers and not including any such goods relating to typefaces and fonts.

Class 25: Clothing, underwear, sportswear other than for diving, belts, gloves, footwear, headgear.

13. The applicant's goods are identical to those covered within the specification of goods of the opponent's earlier mark.

14. The opponent's mark consists of two words; the word LA (which the opponent says is the French definite article being the equivalent of the English word "The") and the English word CITY. The mark is distinctive, the distinctive character of the mark residing in the combination of the French definite article with the English word CITY. The word CITY is a very common word. Although it does not appear to be descriptive of any of the goods in question, it is not the sort of distinctive word that when used in combination with other elements will inevitably drive the average consumer to conclude that its inclusion in marks that are noticeably different overall is a sign that those marks are being used by undertakings with an economic connection.

15. The applicant's mark consists of a number of elements. There is the word CITY written in upper and lower case and placed alongside a device of a labelled bottle out of the neck of which its contents are bubbling. These two elements are superimposed on a light-coloured circular background. Positioned underneath these elements, the mark also contains the word DRINKER in larger, uppercase and shadowed font and the words

CITYDRINKER.CO.UK in smaller, lowercase, standard typeface. All of these various elements are set on a dark rectangular background. The first mark in the series is also subject to a colour claim as set out earlier in this decision.

16. Whilst both marks contain the word CITY, that, I believe is the only similarity between them. The overall impressions created by the two marks are very different and I find that the two marks are dissimilar, visually, orally and conceptually.

17. The opponent's mark is an inherently distinctive mark. The opponent has not filed any evidence of use of his mark and therefore I am unable to say whether it had acquired an enhanced reputation at the relevant date of 7 June 2000. Taking all factors into account, I consider that there was no likelihood of confusion at the relevant date even in respect of identical goods. Consequently, the opposition under S5(2)(b) fails.

18. The opposition having failed, the applicant is entitled to a contribution towards costs. I order the opponent to pay the applicant the sum of £500. 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 10 day of January 2003

Ann Corbett

For the Registrar
The Comptroller-General