

O-291-03

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK REGISTRATION NO. 2279983  
IN THE NAME OF HLH LLC**

**AND**

**IN THE MATTER OF APPLICATION FOR A  
DECLARATION OF INVALIDITY NO. 81174  
THERE TO BY JOH. WILH. VON EICKEN GMBH**

**IN THE MATTER OF** trade mark registration No. 2279983  
in the name of HLH LLC

**AND**

**IN THE MATTER OF** application for a Declaration of Invalidity  
No. 81174 thereto by Joh. Wilh. Von Eicken GmbH

## **BACKGROUND**

1. The trade mark “BARTON” has been registered since 08 February 2002 under number 2279983 and stands in the name of HLH LLC. It is registered in respect of:

Class 34:  
Cigarettes.

2. On 07 February 2003, Joh. Wilh. Von Eicken GmbH filed an application for a declaration of invalidity of the registration. The action was filed on Form TM26(I) together with the appropriate fee. The statement of case accompanying the application set out the grounds of action, which are as follows:

- Under sections 47(2)(a) and 5(2)(b) of the Act as the applicant claims that use of the registrant’s mark is likely to cause confusion on the part of the public, which includes the likelihood of association with the applicant’s earlier trade marks.

The applicant gave details of its earlier protected international trade mark in the statement of case, this was listed as “BURTON”, which has been protected in the UK under number M731243 and stands in the name of Joh. Wilh. Von Eicken GmbH. It is protected in respect of:

Class 34:  
Tobacco, tobacco products, in particular cigars, cigarettes, smoking tobacco, snuff, chewing tobacco; smoker's articles included in this class.

3. On 13 February 2003 a copy of the application for invalidation and the statement of grounds were sent to the address for service recorded on the register. The registered proprietor did not file a counter-statement to defend his registration. The consequences of failure to defend the registration were set out in the letter dated 13 February 2003, namely that the application for declaration of invalidity could be granted in whole or in part.

4. It does not however follow that the uncontested nature of this action will automatically mean success for the applicant for invalidity and failure for the registered proprietor. The onus in these circumstances is on the applicant for invalidity to prove why it is that the registration should be declared invalid.

5. I am mindful of the decision in the *Firetrace Case* (BL 0/278/01) where the Hearing Officer stated:

“It is not sufficient to simply allege that a registration offends either Section 46 or 47 of the Act without doing more to prove that the allegation has substance. That said, when an application for revocation (other than non-use) or invalidation is made and the registered proprietors choose not to respond to such a request, I do not think that it is necessary for the applicants in those circumstances to have to fully substantiate their allegations beyond providing evidence which supports a prima facie case.”

6. The reason that the Hearing Officer arrived at this view is the statutory presumption in Section 72 of the Act which states:

“In all legal proceedings.....the registration of a person as proprietor of a trade mark shall be prima facie evidence of the validity of the original registration and of any subsequent assignment or other transaction of it.”

7. With this in mind, on 31 March 2003, the Registrar wrote to the applicant’s representative inviting him to file any evidence or make any submission which he felt would support his client’s application to, at the least, establish a prima facie case. He was also invited to state whether he wished to be heard or would accept a decision from the papers filed.

8. On 16 April 2003 the applicant for invalidity provided a submission giving their opinion of the case against the registered proprietor. They also stated that they were content for the decision to be taken on the basis of the papers filed.

9. The submission argued that their international registration was filed at WIPO on 17 March 2000 and was registered as protected in the UK on 12 June 2001, and therefore qualified as an earlier trade mark under section 6(1)(a) of the Act. They went on to argue that the criteria for the assessment of similarity, as defined by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, were met in this case. In their assessment of the similarity they addressed the visual, phonetic and conceptual similarity of the marks, which differ only in their second letter, and the similarity of the goods.

10. Acting on behalf of the Registrar and after a careful study of the papers before me I give the following decision.

## DECISION

11. The applicant claims that the registration should be declared invalid as per section 47 of the Act on the basis of the provisions of section 5(2)(b). The relevant parts of the Act are as follows:

“47. - (1) . . . .

(2) The registration of a trade mark may be declared invalid on the ground-

- (a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or
- (b) . . . .

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.”

“5. - (1) . . . .

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

- (a) . . . ., or
- (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.”

12. In dealing with section 5(2) and in my consideration of a likelihood of confusion or deception I take into account the guidance provided by the ECJ in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [2000] 45 FSR 77 and *Marca Mode CV v Adidas AG* [2000] ETMR 723, in particular, that the likelihood of confusion must be appreciated globally and take into account all relevant factors.

13. The applicant’s mark is “BURTON” and that of the registered proprietor is “BARTON”.

14. The marks differ only in as far as the second characters are different, in one it is a letter U and in the other a letter A, and as such they are regarded as visually similar. From the phonetic perspective vowels, which these letters are, are a voiced speech sound whose articulation is characterised by the absence of friction-causing obstruction in the vocal tract, allowing the breath stream free passage. The timbre of a vowel is chiefly determined by the position of the tongue and the lips and, in particular when slurred as part of a longer word, can be less distinctive. Therefore from the phonetic point of view these marks are regarded as similar also. Both marks are relatively common surnames,

BARTON appears over 250 times in the London directory and BURTON over 400 times, and as such there is a conceptual similarity between the marks. The goods covered by the registration in suit are identical to some of the goods covered by the applicant's registration.

15. I have found that there is a degree of visual, aural and conceptual similarity between the registered proprietor's and applicant's marks. Given the nature of the goods, the visual and aural perspectives will be the primary points of reference as they will be chosen by the eye and ear with little consideration of conceptual issues. I have also found the respective goods to be identical. I consider that this, when taken with the high degree of similarity between the marks themselves, will lead to a likelihood of confusion. The application for a declaration of invalidity consequently succeeds.

16. Taking the above findings into account I declare the registered proprietor's registration to be invalid. I direct that it be removed from the register and in accordance with Section 47(6) of the Act the registration is deemed never to have been made.

17. As to costs, the applicant has been successful, and I order HLH LLC to pay them £600. 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 19<sup>TH</sup> day of September 2003**

**Graham Attfield  
For the Registrar  
the Comptroller General**