

O-024-07

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2411295  
BY NICHOLAS HARPER OF RHUBARB ENTERPRISES PTY LTD  
TO REGISTER A TRADE MARK  
IN CLASSES 04, 08, 11, 18, 20, 21, 24 AND 28**

## BACKGROUND

1. On 12 December 2005, Nicholas Harper of Rhubarb Enterprises Pty Ltd, 78 Docker Street, Richmond, Victoria 3121, Australia, c/o 2A Lowther Hill, Forest Hill, London SE23 1PY applied to register trade mark no. 2411295 under the provisions of the Trade Marks Act 1994. The mark consists of the word “**relish**”, applied for in respect of the following goods:

- Class 04 Candles and wicks for lighting.
- Class 08 Cutlery.
- Class 11 Apparatus for lighting.
- Class 18 Umbrellas, handbags, rucksacks, purses.
- Class 20 Furniture, mirrors, picture frames, pillows, cushions.
- Class 21 Household or kitchen utensils and containers, glassware, porcelain and earthenware.
- Class 24 Textiles and textile goods, bed and table covers.
- Class 28 Decorations for Christmas trees.

2. An examination report detailing the examiner’s view of Rhubarb Enterprises Pty Ltd’s application was issued on 08 February 2006. In this report, the applicant’s attention was drawn to a conflicting earlier right and an objection under Section 5(2) of the Act was raised.

3. The following earlier right was identified as a citation against the applicant’s mark in both Classes 20 and 21:

UK trade mark registration no. 2394657 in the name of Relish Ireland, 99 Westlake, Londonderry, BT47 6WE, consisting of the following word-and-device mark, registered *inter alia* in respect of the goods shown below:



Class 20: Furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics.

Class 21: Household or kitchen utensils and containers (not of precious metal or coated therewith); combs and sponges; brushes (except paint brushes); brush making materials; articles for cleaning purposes; steel wool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes.

4. The examination report was issued on 08 February 2006. As a consequence, the applicant was given until 08 August 2006 in order to respond to the objection raised.

5. As no response was ever received from the applicant, the examiner issued a further letter on 25 September 2006. In this letter, the trade mark application was partially refused in respect of Classes 20 and 21, pursuant to Section 37(4) of the Trade Marks Act 1994.

6. With a request for a statement of reasons for registrar's decision having been received at the Office on 25 October 2006, I am therefore now asked under Section 76 of the Act and Rule 62(2) of the Trade Marks Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.

## **DECISION**

7. The grounds for objection to the application are under the terms of Section 5(2) of the Act. If none of the objections under this section of the Act were justified, then the final refusal of the mark under Section 37(4) of the Act should not have been issued.

### **Comparison of marks (Section 5(2))**

#### **The Law**

8. Section 5(2) of the Act reads as follows:

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

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

9. An earlier trade mark is defined in Section 6(1) where it states that:

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. I take into account the guidance provided by the European Court of Justice (ECJ) in the following cases: *Sabel BV v Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG and Adidas Benelux BV* [2000] E.T.M.R. 723.

11. It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking into account all relevant factors (*Sabel BV v Puma AG*).

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question (*Sabel BV v Puma AG*). The average consumer 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 kept in his/her mind (*Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel*).

(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*).

(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*).

(e) a global assessment of the likelihood of confusion implies some interdependence between the relevant facts, and in particular a similarity between the trade marks and between these goods or services. Accordingly, a lesser degree of similarity between these goods and services may be offset by a greater degree of similarity between the marks and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*).

(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*).

(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*).

(h) 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 (5(2)) (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*).

12. The global comparison of marks therefore means that a number of elements must be analysed before effective judgement can be made.

### **Prima facie comparison**

#### **Comparison of the marks**

13. The earlier trade mark no. 2394657 is a registered mark and is therefore deemed to be valid (Section 72 of the 1994 Trade Marks Act refers). It consists of a circular device, inside which appear the words “RELISH” and “IRELAND” arranged in a similar circular fashion. At the centre of the device is another circular element, containing an abstract line-based design. The whole device is presented in three different shades of green.

The trade mark applied for consists solely of the word “relish”.

#### **Comparison of the goods**

14. The refusal, issued on 25 September 2006, was partial by nature, and was based solely on an objection under Section 5(2) arising from the earlier mark’s specifications in Classes 20 and 21. These specifications were, in turn, only directed at the Class 20 and Class 21 specifications of the mark applied for. Therefore, for the purposes of this decision, it is only necessary to consider those potentially conflicting goods found in Classes 20 and 21.

15. In assessing the similarity of goods concerned, all the relevant factors relating to these goods should be taken into account. Such factors include *inter alia* their nature, their end users and method of use, and also whether they are in competition with each other or are complementary (See *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer*,

[1999] ETMR.1. paragraph 23). Further factors include the purpose of the goods, their origin, and their pertinent distribution channels and sales outlets.

## **Class 20**

16. As far as the conflicting Class 20 specifications are concerned, the earlier registration covers “Furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics”, whilst the mark applied for claims “Furniture, mirrors, picture frames, pillows and cushions”.

17. In respect of “furniture”, “mirrors” and “picture frames”, these terms appear in the Class 20 specifications of both the application and the earlier registration. Therefore, the applicant’s “furniture, mirrors and pictures” must be *identical* to those claimed in the earlier registration.

18. With regards to the applicant’s “pillows” and “cushions”, I note that no such terms are present within the corresponding Class 20 specification covered by the earlier registration. Therefore, I must consider factors such as those presented in paragraph 15, in order to determine the presence of any similarity between, on the one hand, the applicant’s “pillows” and “cushions” and, on the other, the Class 20 goods covered by the earlier registration.

19. Both pillows and cushions are commonly manufactured from textiles, foam, and/or down, and usually consist of a fabric outer-covering together with a soft padded filling. In respect of cushions, these are commonly sold on the basis of their visual appearance, and are purchased either in order to decoratively complement the appearance and comfort of existing furniture already owned by the customer; as actual *parts* of new furniture (being the seating cushions used, for example, in the assembly of a new armchair or sofa); or as replacement parts for older articles of furniture.

20. Whilst it is possible to purchase decorative cushions from outlets which do not simultaneously provide finished articles of furniture, it is also highly commonplace to find providers of ‘finished’ furniture who also sell furnishing accessories such as decorative cushions (as well as ‘functional’ cushions sold as replacement parts). Such retailing activities would almost certainly be the case as far as specialist furnishers are concerned, whilst in respect of larger department-type stores, both furniture and cushions would likely be sold in the same ‘home’-themed section of such outlets. Therefore, considering their nature, their intended use, their purpose, and their likely channels of trade, I find the applicant’s “cushions” (where this term refers to ‘functional’ cushions used as part of a sofa or a chair) to be *identical* to the “furniture” *at large* covered by the earlier registration. In respect of smaller, decorative-type cushions, I note that such products are not commonly referred to as “furniture” *per se*.

However, they are still manufactured primarily from fabrics; they are still designed to complement the interior décor of one's home and to provide physical comfort during use; and are also commonly sold through the same type of outlets. Furthermore, the relationship between decorative cushions and finished items of furniture such as armchairs and sofas is highly complementary to the extent that one must consider such goods to be at least highly similar. Therefore, I find the applicant's "cushions" to be either *identical* or *highly similar* to the "furniture" claimed by the earlier registration.

21. As far as the applicant's "pillows" are concerned, I note that such goods have a more specific purpose i.e. they are designed to support the head when sleeping or lying and, as such, have a function equal to or beyond that of any decorative role. Nevertheless, like some articles of furniture, they too consist largely of a fabric outer-covering with soft padded filling, designed both for comfort and also for decorative effect (e.g. as part of the interior décor of a bedroom). Furthermore, with beds being within the definition of the word "furniture" in its broadest sense (where "furniture" *at large* has been claimed in the earlier registration), I have to consider the fact that the relationship between pillows and beds is highly complementary. Both products are sold in the same type of outlets (or the same section of a larger store), both can originate from the same manufacturer and, in terms of their size and appearance, pillows can be sold on the basis of their suitability to particular styles of bed. Therefore, I must also conclude that the applicant's "pillows" are *similar* to the "furniture" covered by the earlier registration.

## **Class 21**

22. Turning to Class 21, the earlier registration covers "household or kitchen utensils and containers (not of precious metal or coated therewith); combs and sponges; brushes (except paint brushes); brush making materials; articles for cleaning purposes; steel wool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes", whilst the applicant's mark claims "household or kitchen utensils and containers; glassware, porcelain and earthenware".

23. A simple comparison of these two Class 21 specifications reveals that the terms "household or kitchen utensils and containers" and "glassware, porcelain and earthenware" are common to both. Therefore, the applicant's Class 21 goods are also considered to be *identical* to those of the opponent.

## **Likelihood of confusion**

24. According to guidance laid down by the European Court of Justice, the likelihood of confusion must be assessed using a global comparison, taking into consideration all the relevant factors mentioned above. The issue at stake can, for the sake of

simplicity, be summarised by asking the following question: ‘is it reasonable to assume than an average consumer of furniture, mirrors, utensils and other home wares would believe that goods sold by the applicant under the mark applied for originated from the same source as those protected by the earlier registration?’

25. The average consumer is considered to be reasonably circumspect. However, he or she must also be understood as having an imperfect recollection of any two marks. Confusion is not likely where a shopper can stand in front of two products and measure any differences in their branding. In reality, confusion is more likely to occur where a consumer encounters one product some time after encountering the other. Therefore, one must understand that a holistic analysis occurs in the mind of the average consumer. The consumer does not disassemble marks in his or her own mind, but rather the memory of one whole sign is compared with the next. As a consequence, in situations where marks are either highly distinctive in their totality and/or contain a highly distinctive element, confusion is more likely than in those where marks are relatively weak.

26. In this comparison of signs, I find that the element common to both signs, i.e. the word “relish”, has at least a moderate level of distinctiveness for the conflicting goods in Classes 20 and 21. Defined in the New Oxford Dictionary of English (Oxford University Press 2001) as either a noun meaning “great enjoyment” or a verb meaning “to enjoy greatly”, the word has no clear descriptive meaning or significance in respect of furniture, utensils, glassware or any of the other goods in conflict. In the absence of any other material being contained within the applicant’s word-only sign, the term “relish” will obviously be the *only* element perceived and considered by the potential consumer when faced with the mark “relish”.

27. However, in respect of the earlier composite trade mark, I have to consider *all* of the elements which combine to form the sign. By doing so, I will then be able to determine which of those elements (if any) would be perceived as being dominant and/or distinctive.

28. The earlier mark is essentially constructed from three elements, namely, the word “RELISH”; the word “IRELAND”; and the circular figurative get-up. Regardless of from where it may actually originate (either in terms of manufacture or sale), any products bearing a moderately visible reference to the word “Ireland” will immediately be perceived by the consumer as originating from the country of Ireland. In respect of the earlier mark, the average consumer will therefore interpret the word “IRELAND” as a descriptive reference to geographical origin. It cannot, as a consequence, be considered to be either dominant or distinctive.

29. With regards to the circular device contained within the earlier mark, neither the shape nor the design appears to denote any characteristic of the goods it has been registered in respect of. Therefore, one can deduce that it possesses at least a normal level of distinctiveness. However, it is also the case that, in respect of marks

consisting of both word and figurative elements, it is the word elements which are often considered to be the more dominant. In this case, it is reasonable to assume that the average consumer would choose to refer to the mark by its pronounceable and communicable word elements i.e. “Relish” or “Relish Ireland”, rather than via its abstract (and therefore unpronounceable) device element. And with the word “Ireland” likely to be perceived as a reference to geographical origin, I must therefore conclude that the word “relish” is the dominant and distinctive element of the earlier mark.

30. According to the case law, three criteria must be given due consideration as part of the global comparison of marks, namely a visual comparison, an aural comparison, and a conceptual comparison. Considered in a quantitative sense, the earlier mark contains two visual elements clearly not found in the applicant’s mark, i.e. the word “IRELAND” and the figurative device. However, via the reasoning presented in paragraphs 27 and 28, the Registrar has already determined that the word “relish” must be considered its dominant and distinctive element. Therefore, irrespective of the other visual elements contained within the earlier mark, the potential consumer’s attention is likely to be drawn towards the word “relish” as it appears in the composite sign. This being the case, and with the applicant’s mark consisting solely of the word “relish”, I must conclude that a moderate degree of visual similarity exists between the two signs.

31. Aurally, the applicant’s mark would be referred to by the word “relish”, whilst the earlier mark would be referred to as either “relish Ireland” or, on the basis that the word “Ireland” is perceived as a mere geographical indicator and is not, therefore, ‘required’ in order to signify trade origin, simply as “relish”. Either way, the word “relish” is common to, and prominent within, both of the signs. Therefore, clear aural similarity is found to exist.

32. Conceptually, it is possible to consider that the earlier mark may be perceived according to its employment of *both* of the words “relish” and “Ireland”. Although not, in my opinion, immediately obvious, the relevant consumer may seek to make sense of these two words in combination, and perceive the earlier mark’s word elements as an invitation or reference to “relish Ireland” (in the sense of an invitation for one to ‘enjoy’ Ireland). However, I have already stated that, in the context of the mark as a whole, I do not consider it likely that the words “relish” and “Ireland” will be granted equal status as indicators of origin. The consumer’s tendency to perceive the word “Ireland” as a simple indicator of geographical origin would, in my opinion, have the effect of raising the prominence and distinctiveness of the word “relish” to the point where it would be perceived and conceptualised in isolation. Therefore, I am not convinced that the earlier mark creates an idea sufficiently distinct to that of the applicant’s mark so as to negate any possibility of confusion. Both marks present the word “relish” as their most dominant and distinctive element, and both will therefore convey similar meanings based upon the relevant consumer’s understanding of what that word means (as defined in paragraph 25). As a consequence, conceptual similarity is found to exist.

33. Having considered the three different types of comparisons as listed in paragraph 29, I have firstly found a moderate level of visual similarity between the two marks on the basis that, whilst the earlier registered mark contains additional figurative and word elements, both contain and present the word “relish” as their most dominant and distinctive element. Secondly, in respect of the marks’ aural characteristics, I have concluded that neither of the earlier mark’s additional elements (i.e. the figurative device and the geographical indicator “Ireland”) are likely to be pronounced by the consumer, resulting in very strong phonetic similarity borne out of phonetic reference to the common word “relish”. Finally, in respect of a conceptual comparison, the same consideration of dominant and distinctive elements has to result in a similar conclusion i.e. that the signs are conceptually similar. Having reached these conclusions, I must then incorporate them into a global comparison taking into consideration the degree of similarity or dissimilarity which has been identified between the relevant goods.

#### **Decision regarding Section 5(2)**

34. Overall, there appears to be sufficient similarity between cited Registration No. 2394657 and the applicant’s trade mark to justify objection under Section 5(2) of the Act. Both marks share the same dominant and distinctive features, whilst it has been identified that the goods applied for in Class 20 and 21 are either similar or identical to those claimed by the earlier registered mark in the corresponding classes.

35. I therefore conclude that, in respect of the applicant’s goods claimed in Classes 20 and 21, there is a likelihood of confusion sufficient to warrant an objection under Section 5(2) of the Act.

#### **Overall conclusion**

36. The application in Classes 20 and 21 is not registrable because it is debarred from registration by Section 5(2).

**Dated this 17th day of January 2007**

**Nathan Abraham  
For the Registrar  
The Comptroller-General**