

O-293-08

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2411144
BY CHRISTOPHER SEMMENS TO REGISTER THE
TRADE MARK Quitfix IN CLASSES 9 & 44**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 94579 BY QUIT**


BACKGROUND

1. On 16 January 2006, Christopher Semmens of Nedlands, Western Australia, applied to register the trade mark Quitfix. Following examination the application was accepted and published for opposition purposes on 19 May 2006 in Trade Marks Journal No.6633 for the following goods and services:

Class 9: Pre-recorded CDs, video tapes, laser discs, audio-cassette tapes and DVDs featuring psychological techniques for assisting individuals to achieve control over addictive habits including cigarette smoking and gambling.

Class 44: Psychological counselling for assisting individuals and groups of individuals to achieve control over addictive habits including cigarette smoking and gambling.

2. On 21 August 2006, QUIT filed a notice of opposition. This consists of grounds based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (as amended) (the Act). On their Form TM7 QUIT identify the following three trade marks as the basis of their objection under these grounds:

Trade Mark	No.	App date	Reg date	Classes
QUIT	2030796	17.8.1995	26.6.1998	9,16, 41 & 42
	2022484 (series of 2)	1.6.1995	9.8.1996	As above
QUITLINE	1564369	11.2.1994	12.1.1996	42

Full details of the basis of acceptance and the goods and/or services for which the above trade marks are registered can be found in Annex A to this decision.

3. In their statement of grounds QUIT say:

“The Opponent is the proprietor of a number of United Kingdom trade mark registrations comprising the element “QUIT” or the element “QUITLINE”....

...the Opponent, Quit, commenced use of the trade marks QUIT and QUITLINE in the United Kingdom in 1988. The Opponent has been using the trade marks QUIT and QUITLINE continuously and now operates a website www.quit.org.uk. It is submitted that the Opponent is now a well established charity in the United Kingdom and was well-known at the time of application for United Kingdom trade mark registration Nos. 2030796 and 1564369. At that time, Statutory Declarations were submitted to the effect that the trade marks QUIT and QUITLINE had become distinctive through substantial use in the United Kingdom since 1988. In this respect, the trade marks QUIT and QUITLINE have acquired a distinctive character, having been used in the United Kingdom for almost two decades. Consequently, a substantial reputation is now attached to the trade marks QUIT and QUITLINE. Moreover, it is submitted that the trade marks QUIT and QUITLINE are so well known in the United Kingdom that common law rights exist.... “

4. On 12 December 2006, Mr Semmens filed a counterstatement which consists, in essence, of a denial of the grounds on which the opposition is based. I note that in box 5 of his Form TM8 Mr Semmens indicates that he accepts QUIT's statements regarding the use made of their trade marks. I do not propose to list all of Mr Semmens comments here, but have reproduced below some extracts from his counterstatement which I think give a flavour of the basis of his defence to the opposition:

"4. In broad terms both the earlier mark [i.e. QUIT] and the new mark [i.e. Quitfix] relate to the enterprise of assisting people to become abstinent from cigarette smoking.

5. The word "quit" is integral to the lexicon of both the academic and clinical activity related to assisting people to become abstinent from cigarette smoking. The Office on Smoking and Health is a branch of the Centres for Disease Control itself a part of the United States Department of Health and Human Services. The Office has published collections of research abstracts relating to aspects of cigarette smoking including "Smoking cessation methods". Publications include "Smoking and Health Bulletin" and "Bibliography on Smoking and Health". In the publications of these documents for the years 1987; 1989; 1990 and 1991 covering abstracts of research published in the years 1985 to 1991.

6. These publications contained 250 abstracts of research on smoking cessation methods and 113 of them (45.2%) contained the word "quit". So prior to the Opponent's initial use of the "Quit" mark, and before its registration, the term "quit" was in pervasive use in the enterprise of smoking cessation.....

8. The Applicant accepts the validity of the earlier mark based on distinctiveness acquired through use.....

9. This entitlement, however, does not extend to the holding of a monopoly over all combinations and permutations of the word "quit" when applied to the area of smoking cessation practices.

21. It can be seen that while the Opponent and the Applicant are both engaged with their respective marks in the endeavour of assisting people to achieve smoking cessation, the specific nature of the goods and services favoured to achieve this are largely non-overlapping.

24....The Opponent's mark (Quit) is held to be of an exceedingly low order of distinctiveness as it has pervasive use in the literature of the undertaking as a descriptor of the activity which is at the core of its *raison d'être* – people ceasing the activity of smoking cigarettes.

31. In consideration of the likelihood of confusion between the marks "Quitline" and "Quitfix" many of the same arguments apply in regard to dissimilarity of both the marks and the respective goods and services. "Quitline" is highly descriptive of the activity covered by the mark – telephone counselling for stopping smoking....."

5. Both parties filed evidence. Neither side requested a hearing or filed written submissions.

EVIDENCE

QUIT's evidence-in-chief

6. This consists of a witness statement, dated 12 July 2007, by Stephen Crone who is the Chief Executive of QUIT. He confirms he is authorised to speak on QUIT's behalf, adding that the information in his statement comes from either his own knowledge or has been obtained from company records.

7. Mr Crone explains that the charity QUIT was established in 1926 as the National Society of Non-Smokers; the name was changed to "QUIT – The National Society of Non-Smokers" on 18 April 1989. The charity is now, he adds, a company limited by guarantee. Mr Crone states that The National Society of Non-Smokers initially existed as an anti-smoking pressure group campaigning for the rights of non-smokers, which during the 1980s began to move towards helping smokers to stop smoking; this, he explains, culminated in the change of name.

8. The charitable objectives of QUIT are, explains Mr Crone, to:

"contribute to the preservation and improvement of the health of the community, and to the physical, mental, moral and economic well-being of its people, by every available charitable means to help relieve the community, and its members individually and collectively, from the risks and other injurious consequences of tobacco smoking, including the fire risks associated with it and the dangers posed by exposure to tobacco smoke."

9. Mr Crone explains that QUIT has registered the trade marks QUIT and QUITLINE as its "house brands", and points to a number of other trade mark registrations owned by it. He adds that QUIT have also adopted a number of unregistered trade marks for short term specific campaigns which incorporate the word QUIT. He lists the following examples: The QUIT Awards, QUIT and Keep Fit, The QUIT Guide to Stopping Smoking, The QUIT Because youth programme, QUIT Weeks, Quitpacks, QUIT and Run and KEEP QUIT, and adds that QUIT has continuously adopted a strict policy of preventing non-authorised use of the trade marks QUIT and QUITLINE by third parties.

10. Mr Crone states that QUIT is funded from various sources. He explains that QUIT programmes are funded by larger charitable trusts, The Department of Health, The European Commission and events such as the London Marathon. In addition, QUIT has a trading company, QUIT Services Limited which provides a range of stop smoking services to, for example, the NHS and pharmaceutical companies. It also provides workplace programmes and training for health professionals under the trade mark QUIT Corporate Health Services. The trade marks QUIT and QUITLINE have, says Mr Crone, been in continuous use in the United Kingdom since 1988, adding that the charity has answered over 2 million calls on its QUITLINE service.

11. Mr Crone comments that the QUIT and QUITLINE trade marks are used whenever the services of QUIT are provided, adding that the trade marks are prominent in all materials promoting QUIT's services. He mentions QUIT's website www.quit.org.uk, and at exhibit SPC1 he provides a collection of promotional materials dating from 1988 in which QUIT's trade marks appear; I will comment on these documents later in this decision.

12. Mr Crone says that in addition to the trade marks QUIT and QUITLINE appearing prominently in all promotional materials used by QUIT, the charity has had extensive media coverage. He provides a list of recent articles (but not the articles themselves) all of which I note date from 2007 (i.e. after the material date in these proceedings). He adds that “QUIT materials” are widely available in doctors’ and dentists’ surgeries, pharmacies, primary care trusts, libraries and workplaces.

13. Mr Crone notes that QUIT celebrated its 80th anniversary at the House of Lords in February 2007. QUIT is, he explains, the lead agency of the European Network of Quitlines (ENQ), adding that he was presented with a World Health Organisation World No Tobacco Day Award by Caroline Flint the Minister of Public Health, which recognised the ENQ’s achievements in supporting smoking cessation in Europe.

14. The remainder of Mr Crone’s statement consists in the main of submissions rather than evidence. As such it is neither necessary nor appropriate for me to summarise it here; I will of course keep it in mind when reaching my decision. That said, I note the following comment:

“12. Although the Applicant has produced copies of publications attached to the Form TM8 and Counterstatement which make use of the word “quit”, it is clear that all of these examples of use are simply the use of the word in its normal descriptive sense and not as a trade mark. QUIT has never attempted to prevent use of the word “quit” when used as a descriptive term. However, QUIT has acted whenever the term “QUIT” is used as part of a trade mark in such a way as to undermine its exclusive rights to QUIT as a trade mark...”

Mr Semmens’ evidence-in-chief

15. This consists of a witness statement, dated 15 October 2007, from the Applicant Christopher Semmens accompanied by 8 exhibits. Mr Semmens explains that he is a clinical psychologist in private practice in Perth, Western Australia adding that since 1984, a significant component of his clinical practice has been the treatment of clients for cigarette dependence. He goes on to provide details of his academic background and approach to treatment which I have noted, but do not feel it necessary to summarise here. He states that in recent years he has put together a self-help package of the techniques that he has gathered and tested over the years, adding that the package called QUITFIX is a registered trade mark in both Australia and the United States of America. A good deal of Mr Semmens’ statement consists of argument rather than evidence. As with Mr Crone’s statement above, I do not propose to summarise these arguments here but will keep them in mind when reaching my decision.

16. Insofar as the similarity of his application and QUIT’s trade marks are concerned, in paragraph 11 of his statement Mr Semmens says:

“The former mark has no inherent capacity for distinguishing the goods and services of its owner; it is merely descriptive. Any distinctiveness that the mark “QUIT” may have acquired through usage can not alter the fact that there is every likelihood that anyone involved in the provision of goods and services of the nature of “assisting people to cease cigarette smoking” would use the word “quit” in the course of trade in those goods and services....”

17. Exhibit CGS4 consists of copies of the Smoking and Health Bulletin for the periods January-February 1987, March-April 1987 and September-October 1987. This document, explains Mr Semmens, is published by the Office on Smoking and Health which is a branch of the Centres for Disease Control which itself is a part of the U.S. Department of Health and Human Services. The exhibit also includes copies of the Bibliography on Smoking and Health issued by the same organisation for the years 1989, 1990 and 1991. As I mentioned in paragraph 4 above, Mr Semmens notes in his counterstatement that:

“These publications contained 250 abstracts of research on smoking cessation methods and 113 of them (45.2%) contained the word “quit”. So prior to the Opponent’s initial use of the “quit” mark, and before its registration, the term “quit” was in pervasive use in the enterprise of smoking cessation.....”

QUIT’s evidence-in-reply

18. This consists of a witness statement, dated 12 June 2008, from Nicola Shackleton who is a Director and trade mark attorney at Page White & Farrer, QUIT’s professional representatives in these proceedings. Ms Shackleton confirms that she is authorised to speak on QUIT’s behalf and that her statement contains matters within her own knowledge.

19. The majority of Ms Shackleton’s statement consists of arguments in response to the evidence of Mr Semmens rather than evidence; I will not summarise these arguments here but will keep them in mind when reaching my decision. That said, I note that at paragraph 4 of her statement Mr Shackleton says:

“The Applicant has identified.....further examples of the word “quit” being used in its normal descriptive sense. Such examples of use do not detract from the ability of the trade mark QUIT to identify the goods and services of the Opponent. As was pointed out...the Opponent has never claimed to have exclusive rights in the word “quit” when used descriptively...”

20. That concludes my summary of the evidence filed in these proceedings, insofar as I consider it necessary.

DECISION

21. The grounds of opposition are based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Act. Section 5(2)(b) of the Act reads as follows:

“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.”

An earlier trade mark is defined in section 6 of the Act, 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 or international trade mark (EC) 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,”

22. I note that on their Form TM7 QUIT identified three trade marks for the purposes of their claims under sections 5(2)(b), 5(3) and 5(4)(a) of the Act and these appear in paragraph 2 above. However, in paragraph 1 of the Statement of Grounds which accompanied the Form TM7 they say:

“The Opponent is the proprietor of a number of United Kingdom trade mark registrations comprising the element “QUIT” or the element “QUITLINE”. In this respect, reference should now be made to Exhibit 1 which contains details of six of the most pertinent United Kingdom trade mark registrations”.

23. Exhibit 1 consists of the three registrations mentioned in paragraph 2, together with the following:

Trade Mark	No.	App date	Reg date	Classes
 Pregnancy Quitline	2184533	16.12.1998	25.6.1999	Goods & services as 2030796
Quitter of  the Year QUIT	2200068	11.6.1999	12.11.1999	Counselling services; telephone counselling services; medical care; individually tailored smoking cessation programmes; smoking cessation therapy services.
ASIAN QUITLINE	2207656	3.9.1999	3.3.2000	Goods & services as 2030796

24. I also note that in paragraph 4 of his statement Mr Crone refers to registration No. 2030788 which is for the following trade mark:



which was applied for in classes 9, 16, 41 and 42 on 17 August 1995, and which was registered on 19 July 1996. As none of these “additional” trade marks were identified on the Form TM7 (and for which, for example, no statements of use were provided or made

the subject of an amendment request), QUIT are not, in my view, entitled to rely on these “additional” trade marks in these proceedings. I should also mention that in his statement Mr Crone refers to a “..family of trade marks..” (paragraph 10) and “..other QUIT- prefix trade marks..” (paragraph 12). Given my decision above, the only trade marks QUIT are entitled to rely upon in these proceedings, in my view, are those identified in paragraph 2 above.

25. The three registered trade marks shown in paragraph 2 all have application dates prior to that of the application for registration; as such they clearly qualify as earlier trade marks under the above provisions. The application for registration was published for opposition purposes on 19 May 2006 and, as a result, all of QUIT’s earlier trade marks are subject, in principle, to The Trade Marks (Proof of Use, etc) Regulations 2004. However as I mentioned above, in box 5 of his Form TM8 and counterstatement Mr Semmens indicated that he accepted QUIT’s statements regarding the use made of their trade marks. Consequently, I will proceed on the basis that QUIT’s trade marks have been used on the goods and services for which use has been claimed by them i.e. all the goods and services for which the trade marks stand registered.

26. In reaching a decision I have taken into account the guidance provided by the European Court of Justice (“ECJ”) in a number of judgments germane to this issue, notably in: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [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 + Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).

It is clear from all these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all the relevant factors: *Sabel BV v. Puma AG*, paragraph 22;

(b) the matter must be judged through the eyes of the average consumer of the good/services in question; *Sabel BV v. Puma AG*, paragraph 23, who is deemed to be reasonably well informed and 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) when considering composite marks, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element; *Shaker di L. Laudato & Co. Sas* (C-334/05), paragraph 42;

(f) an element of a mark may play an independent distinctive role within it without necessarily constituting the dominant element; *Medion AG V Thomson multimedia Sales Germany & Austria GmbH*, paragraph 30;

(g) 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;

(h) 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;

(i) 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;

(j) 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 + Adidas Benelux BV*, paragraph 41;

(k) 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.

The average consumer and the nature of the purchasing decision

27. As the case law above indicates, it is necessary for me to determine who is the average consumer for the goods and services at issue and then to establish the manner in which the goods and services are likely to be purchased by the average consumer in the course of trade. In my view the average consumer for the goods and services at issue in these proceedings is likely to be (in the main) an adult member of the general public who wants to stop smoking.

28. Given the subject matter to which the goods and services relate, their potential cost and the importance of giving oneself the best prospect of success, the average consumer is likely, in my view, to pay a relatively high degree of attention when selecting the goods and services at issue. They are likely, prior to committing to a particular course of treatment, to research the options available to identify the one or ones that are best suited to them. The extent of this research will vary from person to person, but is likely to be of a reasonable level in most cases. It is likely to include, for example, reviewing appropriate documentation and testimonials (both in hard copy and on-line), together with discussions with (and potentially recommendations from) for example, family members, friends, medical practitioners and helplines.

29. Once a treatment plan has been selected, the goods (e.g. DVDs, CDs etc) and services (e.g. counselling) required to support the chosen plan are likely to be selected in the main by self selection in either a retail setting, by mail order, on-line or by telephone. While the average consumer is likely to rely on the visual, oral and conceptual elements of the trade marks when making his selection, in my view, the visual and conceptual elements are likely to dominate; that said, the aural element is

also important given the potential significance of personal recommendations and the use of helplines.

Comparison of goods and services

30. In these proceedings QUIT can rely on the three trade marks mentioned in paragraph 2 above. Although both parties' use their trade marks in the context of goods and services designed to help others to stop smoking, Mr Semmens' application is not, I note, limited solely to smoking but includes the phrase "... addictive habits including cigarette smoking and gambling". It seems to me that if QUIT fail in relation to the element of the specifications which relates to the cessation of smoking, they are unlikely to be in any better position in relation to the other element of the specifications which refers to other addictive habits. For the sake of convenience, the respective parties goods and services are reproduced below:

Mr Semmens' goods and services	QUIT's goods and services
<p>9 - Pre-recorded CDs, video tapes, laser discs, audio-cassette tapes and DVDs featuring psychological techniques for assisting individuals to achieve control over addictive habits including cigarette smoking and gambling.</p> <p>44 - Psychological counselling for assisting individuals and groups of individuals to achieve control over addictive habits including cigarette smoking and gambling.</p>	<p>No. 2030796</p> <p>9 - Audio and video tapes; all relating to the cessation of smoking.</p> <p>16 - Books and printed matter; all relating to the cessation of smoking.</p> <p>41 - Education and training services; all relating to the cessation of smoking.</p> <p>42 - Counselling services, telephone counselling services, medical care; all relating to the cessation of smoking; individually tailored cessation smoking programmes; anti-smoking therapy services.</p> <p>No. 2022484</p> <p>9 - Audio and video tapes.</p> <p>16 - Books and printed matter.</p> <p>41 - Education and training, all relating to the cessation of smoking.</p> <p>42 - Counselling services; telephone counselling services; medical care; individually tailored smoking cessation programmes; smoking cessation therapy services.</p> <p>No. 1564369</p> <p>42 Smoking cessation counselling</p>

	services; telephone smoking cessation counselling services; all included in Class 42.
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31. It is, I think, self evident that insofar as smoking cessation is concerned, the “pre-recorded CDs, video tapes, laser discs, audio-cassette tapes and DVDs...including cigarette smoking..” in class 9 and “psychological counselling...including cigarette smoking...” in class 44 of Mr Semmens’ application are either identical or highly similar to the “audio and video tapes; all relating to the cessation of smoking” in class 9 and “counselling services... all relating to the cessation of smoking” in class 42 of QUIT’s registration No. 2030796.

32. Insofar as QUIT’s registration No. 2022484 is concerned, and bearing in mind that the goods in classes 9 and the services in class 42 of this registration are unlimited, all of Mr Semmens’ goods and services are, in my view, either identical or highly similar to QUIT’s goods and services in these classes. Finally, in relation to QUIT’s registration No.1564369, the services in this class are (insofar as they relate to smoking) either identical or highly similar to Mr Semmens’ services in class 44 and, in my view, are services which would be considered complementary to his goods in class 9.

Comparison of trade marks

33. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant, who perceives trade marks as a whole and does not pause to analyse their various details; in addition, he rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has kept in his mind. In approaching the comparison, it is important for me to identify what I consider to be the distinctive and dominant components of the respective parties’ trade marks.

34. In my view, it is registration Nos. 2030796 and 1564369 for the trade marks QUIT and QUITLINE that offer QUIT the best prospect of success in these proceedings, and it is on these trade marks that I shall focus; if QUIT fail in relation to these trade marks, they are, in my view, in no better position in relation to registration No. 2022484 which I note also contains a device element. However, I must first deal with what I consider to be the distinctive and dominant components of the respective trade marks, because it is the distinctiveness or otherwise of QUIT’s earlier trade marks which is at the heart of this dispute.

35. QUIT’s earlier trade marks are for the word QUIT and QUITLINE presented in block capital letters. QUIT is the only element of registration No. 2030796 so no question of dominance arises. Insofar as registration No. 1564369 is concerned, this consists of two well known English words QUIT and LINE conjoined. Given its positioning as the first element of the trade mark, the word QUIT has a degree of dominance. Appearing after the word QUIT the word LINE is less dominant and is likely (as QUIT intend) to be seen by the average consumer as a descriptive reference to a help line.

36. Mr Semmen’s trade mark consists of the two words Quit and fix conjoined with the letter Q presented in upper case and the remaining characters in lower case. Occurring as it does as the first element of Mr Semmens’ trade mark the word Quit is also likely to have a degree of dominance. However, unlike the word LINE appearing in QUIT’s trade

mark, the meaning the word “fix” will convey to the average consumer is, in my view, uncertain. As Mr Semmens says in his counterstatement:

““Quitfix”...is [a] creative, innovative and original...that is a play on words and cleverly implies the utilisation of two and possibly three distinct meanings of the element “fix”. The mark indirectly alludes to the efficiency and effectiveness of the techniques that are presented in the goods and services that relate to the mark. The word play is that the mark conjures up the notion of “quick-fix” a common colloquial expression for “fast and effective”. The second meaning of “fix” relates to: “a dose of something habitually consumed, viewed, etc especially when conceived of as addictive (Macquarie Dictionary)”.

37. The words QUIT and LINE are both very well known English words which in my view require no further explanation. When they were applied for in 1994 and 1995, the trade marks QUIT and QUITLINE were, in the Trade Marks Registry’s view, prima facie descriptive of the goods and services for which registration was sought. I note that in paragraph 8 of his counterstatement Mr Semmens accepts the validity of the QUIT trade mark, although in paragraph 24 he comments on what he considers to be the trade marks’ “..exceedingly low order of distinctiveness”. Of the trade mark QUITLINE, Mr Semmens says:

““Quitline” is highly descriptive of the activity covered by the mark – telephone counselling services for stopping smoking..”

38. This view appears to gain some support from Mr Crone’s own evidence where he refers to the “European Network of Quitlines” which appears to me at least to be using the word “Quitlines” in a descriptive context.

39. However, as pointed out in QUIT’s Notice of Opposition, both trade marks were accepted by the Trade Marks Registry on the basis that the use made of them had rendered them distinctive of the goods and services of QUIT. Given the provisions of section 72 of the Act, and as neither of these registrations are subject to any post registration attacks on their validity, I must proceed on the basis that both trade marks are distinctive for the goods and services for which they are registered; an approach approved of by the Appointed Person Mr Richard Arnold QC in *Republic Technologies (NA) LLC v Quelle Aktiengesellschaft* (BL O/254/07) when he said:

“17. I would add that, as the opponent accepts, the hearing officer correctly proceeded on the basis that the opponent’s mark is presumed to be validly registered and therefore must be assumed to possess or have acquired at least the minimum degree of distinctiveness required to justify registration in the absence of any attack on the validity of the registration. I consider that I was mistaken to hold the contrary in *Oska’s Ltd’s Trade Mark Application* [2005] RPC 20 at [39].”

40. That said, I also note that QUIT accept that in the context of the goods and services at issue in these proceedings the word quit is capable of being used descriptively.

41. Consisting as it does solely of the word QUIT, this must be the distinctive and dominant element of registration No. 2030796. Insofar as the QUITLINE trade mark is concerned, although the word QUIT constitutes the first element, given its aptness for use in relation to the goods and services at issue, this trade mark’s distinctiveness can

only lie, in my view, in the conjoining of the word QUIT to the word LINE (which itself appears to be an apt word for use in the context of helplines) and in the presentation of the trade mark in block capital letters. As for Mr Semmens' trade mark, once again this has the word Quit as the first element. However, given my comments above in relation to the aptness for use of the word quit, the distinctive character in this trade mark must lie in the lexical invention created by the conjoining of the words Quit and fix.

42. Having determined what I consider to be the distinctive and dominant elements of the respective trade marks, I will now compare them with these considerations in mind. The respective trade marks are as follows:

Mr Semmens' trade mark	QUIT's trade marks
Quitfix	<p data-bbox="807 598 991 631">No. 2030796</p> <p data-bbox="807 667 884 701">QUIT</p> <p data-bbox="807 736 991 770">No. 1564369</p> <p data-bbox="807 806 954 840">QUITLINE</p>

Visual similarity

43. The parties trade marks are as described above. Mr Semmens' trade mark consists of seven letters and QUIT's of four and eight letters respectively. The word quit forms the first part of Mr Semmens' trade mark, the totality of registration No. 2030796, and the first element of registration No. 1564369. Notwithstanding the differences between the word "fix" appearing in Mr Semmens' trade mark and the word "LINE" appearing in QUIT's, there is still, in my view, a reasonable degree of visual similarity between Mr Semmens' trade mark and both of QUIT's registrations.

Aural similarity

44. Mr Semmens' trade mark consists of two syllables. QUIT's registrations consist of a single syllable word QUIT and of two syllables in the trade mark QUIT LINE. Once again as the word quit is the first element of both parties' trade marks, there is, in my view, a reasonable degree of aural similarity between Mr Semmens' trade mark and both of QUIT's registrations.

Conceptual similarity

45. Conceptually (to some extent at least) both parties' trade marks converge on the word quit. This is the only element present in registration No. 2030796 so the conceptual message this trade mark sends is unambiguous. Insofar as registration No. 1564369 is concerned, I agree with Mr Semmens that the conceptual message this trade mark is likely to convey to the average consumer is of a helpline which will help one to quit. Mr Semmens' trade mark also contains the word Quit but in combination with the word fix. While the shared element i.e. quit, is likely to prompt similar conceptual associations in the mind of the average consumer, as I mentioned above, I am uncertain how the average consumer will approach the word fix appearing in Mr Semmens' trade mark and of the conceptual message (if any) it is likely to convey to

them. Mr Semmens' view of the word fix appearing in his trade mark is reproduced at paragraph 36 above.

46. It may well be that the average consumer will recognise the word play Mr Semmens suggests and see his trade mark as a play on the words quick fix, or interpret fix in the alternative manner he indicates. More likely, in my view, is that the average consumer will simply see Quitfix as a quirky combination that alludes in a vague and not immediately decipherable way to goods and services aimed at the cessation of addictive habits. Bearing all these considerations in mind, there is, in my view, only a modest degree of conceptual similarity between the respective parties' trade marks.

Likelihood of confusion

47. When determining whether there is a likelihood of confusion, a number of factors need to be considered. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the goods and vice versa. It is also necessary for me to consider the distinctive character of the earlier trade marks as the more distinctive the earlier trade marks (either inherently or as a result of any use that has been made of it) the greater the likelihood of confusion; I must also keep in mind the average consumer for the goods and services and the nature of the purchasing decision. The distinctive character of the earlier trade marks must be appraised by reference to the goods and services for which they are registered and also by reference to the way they will be perceived by the average consumer.

48. I have summarised QUIT's evidence above, which on my reading of Mr Semmens' evidence stands substantially unchallenged. In summary, QUIT first made use of their QUIT and QUITLINE trade marks in 1988 and, to the date of Mr Crone's statement (July 2007), have answered over two million calls on their QUITLINE service. They applied to register the trade mark QUITLINE in 1994 and QUIT in 1995 and, despite initial objections being raised to the applications, QUIT satisfied the Trade Marks Registry that, for the goods and services for which they now stand registered, the trade marks had, as a result of the use made of them, become associated exclusively with QUIT. QUIT programmes are funded, I note, by, for example, larger charitable trusts, The Department of Health and the European Commission and QUIT have a trading company, QUIT Services Limited, which provides services to the National Health Service and corporate customers such as pharmaceutical companies. The QUIT and QUITLINE trade marks are used, explains Mr Crone, whenever the services are provided and QUIT materials can be found in doctors' and dentists' surgeries, pharmacies, primary care trusts, libraries and workplaces; I also note that QUIT celebrated its 80th anniversary in 2007.

49. The documents provided as exhibit SPC1 show that QUIT have made use of inter alia, their trade marks QUIT and QUITLINE in relation to the vast majority of the goods and services for which they stand registered. However (not surprisingly) the words quit, quitting etc. are also used in a number of the documents provided by them in a purely descriptive fashion, some examples of which are as follows:

"Helping smokers to quit";

"If you want to find out more about quitting";

“Why is it difficult to quit?”;

“What do I gain from quitting?”

“How to quit”.

50. Another example is the cover of one document (which I note is after the material date in these proceedings) which can be seen in Annex B to this decision. Whilst I note Ms Shackleton’s comments to the effect that, notwithstanding the use of the word quit in a descriptive context, the word QUIT can still function as a trade mark denoting the goods and services of QUIT. This distinction may be lost when the average consumer is faced with the type of use shown in this Annex i.e. the distinction between the use of the word QUIT as a trade mark in:

“THE NEW
2007
QUIT GUIDE
TO
STOPPING SMOKING”,

and what may be considered to be the descriptive use of the word QUIT in the phrase:

“SO YOU WANT TO QUIT?”.

51. Bearing in mind the aptness of the word quit for descriptive use in relation to the contested goods and services, the question I need to answer is: how distinctive are QUIT’s earlier registrations? I must keep in mind that both trade marks benefit from the presumption of validity provided by section 72 of the Act and I must, of course, also take into account the use that QUIT have made of their trade marks since 1988, which is likely to have improved their distinctive character to some extent. However, having done so, it appears to me that while the words QUIT and QUITLINE may now exclusively denote the goods and services of QUIT, given the aptness for use of the word quit and Quitline by others (as demonstrated by, inter alia, QUIT’s own evidence) the level of protection these earlier trade marks enjoy must, in my view, be limited. In short, I think QUIT’s earlier trade marks are deserving of only a minimal level of protection.

52. In summary, I have concluded that: (i) in relation to the cessation of smoking the goods and services at issue in these proceedings are identical or highly similar, (ii) the average consumer is likely to conduct research prior to and then pay a relatively high degree of attention to his purchase, (iii) there is a reasonable degree of visual and aural similarity and a modest degree of conceptual similarity between the respective trade marks, and (iv) that the use QUIT have made of their earlier trade marks is likely to have improved their distinctive character to some extent. I have also concluded, given the nature of the goods and services at issue and the traits of the average consumer when purchasing such goods and services, that the visual and conceptual elements of the comparison are likely to be the most important, but have also noted that the aural element of the comparison must be kept in mind.

53. I must now apply the global approach advocated to these findings. Having done so, and notwithstanding the identity in the goods and services, and the levels of visual, aural and conceptual similarity identified between the respective trade marks, there is,

in my view, no likelihood of confusion. I reach this conclusion because any similarity between the trade marks of QUIT (whether considered individually or collectively) and that of Mr Semmens, stems from the use of the word quit which, in my view, (and which QUIT appear to accept) is an apt word for descriptive use in the context of goods and services relating to the cessation of smoking. While QUIT's use of their QUIT and QUITLINE trade marks may have improved their distinctive character to some extent, this does not, in my view, extend their rights in their QUIT and QUITLINE trade marks to the point where they can prevent Mr Semmens from using the word Quit in his trade mark in a manner which is unlikely to confuse the average consumer either directly or indirectly i.e. that one trade mark will be mistaken for the other or to suggest an economic link between the undertakings.

As a consequence of these conclusions, the opposition based on section 5(2)(b) fails.

54. The remaining objections are based on sections 5(3) and 5(4)(a) of the Act. Section 5(3) reads as follows:

“5-(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

(Section 5(3) has been amended by The Trade Marks (Proof of Use, etc) Regulations 2004 (SI 2004 No. 946) giving effect to the judgments of the ECJ in *Davidoff & Cie SA and Zino Davidoff SA v Gofkid Ltd* (C- 292/00) and *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd* (C-408/01)).

55. The scope of Section 5(3) has been considered in a number of cases notably *General Motors Corp v Yplon SA (Chevy)* [1999] ETMR 122 and [2000] RPC 572, *Premier Brands UK Limited v Typhoon Europe Limited (Typhoon)* [2000] FSR 767, *Daimler Chrysler v Alavi (Merc)* [2001] RPC 42, C.A. *Sheimer (M) Sdn Bhd's TM Application (Visa)* [2000] RPC 484, *Valucci Designs Ltd v IPC Magazines (Loaded)* O/455/00, *Mastercard International Inc and Hitachi Credit (UK) Plc* [2004] EWHC 1623 (Ch), *Electrocoin Automatics Limited and Coinworld Limited and others* [2005] FSR 7 and *Davidoff & Cie SA v Gofkid Ltd (Davidoff)* [2003] ETMR 42, *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd (Adidas-Salomon)* (C-408/01) .

The points that come out of these cases are as follows:

a) “Reputation” for the purposes of Section 5(3) means that the earlier trade mark is known by a significant part of the public concerned by the products and services covered by that trade mark (paragraph 26 of the ECJ's judgment in *Chevy*);

- b) Protection is available where the respective goods or services are similar or not similar (paragraph 29 of the Advocate General's opinion in *Chevy and Davidoff*);
- c) The provision is not intended to give marks "an unduly extensive protection" – there must be actual detriment or unfair advantage (not merely risks) which must be substantiated to the satisfaction of the national court or tribunal (paragraph 43 of the Advocate General's opinion in *Chevy* and paragraph 88 of Pumfrey J's judgment in the *Merc* case);
- d) The provision is not aimed at every sign whose use may stimulate the relevant public to recall a trade mark which enjoys a reputation with them (per Neuberger J in the *Typhoon* case);
- e) The stronger the earlier mark's distinctive character and reputation the easier it will be to accept that detriment has been caused to it (paragraph 30 of the ECJ's judgment in the *Chevy* case);
- f) Confusion as to the trade source of the goods or services offered for sale under the later mark is not a necessary condition before there can be detriment; but is one form of detriment (paragraph 88 of Pumfrey J's judgment in the *Merc* Case);
- g) It is not conditional for a finding that there exists a likelihood of confusion; it is sufficient for the degree of similarity between a mark with a reputation and the applied for mark to have the effect that the relevant consumer establishes a link between the marks (paragraph 31 of the ECJ's judgment in *Adidas-Salomon*)
- h) Detriment can take the form of either making the earlier mark less attractive (tarnishing) or less distinctive (blurring) (paragraph 88 of Pumfrey J's judgment in the *Merc* Case);
- i) Unfair advantage can take the form of feeding on the fame of the earlier mark in order to substantially increase the marketability of the goods or services offered under the later trade mark (per G Hobbs QC in *Visa* at page 505. lines 10-17).

56. I must also take into account the recent decision of Anna Carboni (sitting as the Appointed Person) in *Cube Publishing Ltd v. Standard Life Insurance Company* (BL O/208/08) where she reviewed the relevant legislation relating to this issue and I note the further decisions that she made reference to, notably: *L'Oreal SA v. Bellure NV* [2007] EWCA Civ 968, [2008] ETMR 1 and *Intel Corporation Inc v. CPM United Kingdom* [2007] EWCA Civ 431, [2007] ETMR 59, and also the opinion of Advocate General Sharpston in the latter of these cases (Case C-252/07, Opinion dated 26 June 2008).

57. Section 5(4)(a) of the Act reads:

"A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

- (a) by virtue of any rule of law (in particular, the law of passing

off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

58. Mr Geoffrey Hobbs QC, sitting as the Appointed Person set out a summary of the elements of an action for passing off in his decision in the *Wild Child* Trade Mark case [1998] RPC 455. Mr Hobbs summarised the requirements as follows:

“(1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.”

59. The objections under section 5(3) and 5(4)(a) of the Act can, I think, be dealt with fairly briefly. I shall assume that QUIT have the necessary reputation (for 5(3)) and goodwill (for 5(4)(a)) to found objections based on these grounds. Even if that is the case, given what I consider to be (and which the evidence shows) is the aptness for use of the word quit in the context of the goods and services at issue in these proceedings, the average consumer would not, in my view, make the “link” necessary for the adverse consequences envisaged by section 5(3) of the Act to be engaged. For the same reasons, Mr Semmens’ trade mark would not, in my view, constitute a misrepresentation, without which damage to QUIT would not ensue. **Without the presence of these elements the objections based on sections 5(3) and 5(4)(a) of the Act cannot succeed and are dismissed accordingly.**

COSTS

60. The Opposition has failed on all grounds and Mr Semmens is entitled to a contribution towards his costs. I award costs on the following basis:

Considering Notice of Opposition and accompanying statement: £130

Statement of case in reply: £200

Preparing and filing evidence: £330

Considering QUIT’s evidence: £150

Total - £810

61. It should be noted that in this breakdown of costs, the sums awarded represent no more than two thirds of what I may otherwise have awarded. This reflects the fact that the applicant has not had legal representation in these proceedings. The Civil Procedure Rules state at Part 48.6:

“48.6-(1) This Rule applies where the court orders (whether by summary

assessment or detailed assessment) that costs of a litigant in person are to be paid by any other person.

(2) The costs allowed under this Rule must not exceed, except in the case of a disbursement, two-thirds of the amount which would have been allowed if the litigant in person had been represented by a legal representative.”

62. I order QUIT to pay to Mr Semmens the sum of £810. 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 24 day of October 2008

**C J BOWEN
For the Registrar
The Comptroller-General**

ANNEX A

Trade Mark: QUIT
No: 2030796
Application date: 17.8.1995
Registration date: 26.6.1998

Goods & services:

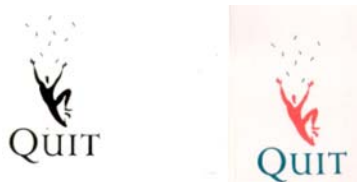
Class 9 Audio and video tapes; all relating to the cessation of smoking.
Class 16: Books and printed matter; all relating to the cessation of smoking.
Class 41: Education and training services; all relating to the cessation of smoking.
Class 42: Counselling services, telephone counselling services, medical care; all relating to the cessation of smoking; individually tailored cessation smoking programmes; anti-smoking therapy services.

Basis of Acceptance:

Proceeding because of distinctiveness acquired through use.

Honest concurrent use with Registration No. 1432152 (5865,1673) and 1561787 (6055,7931).

Trade Mark:



No: 2022484 (series of 2)

The second mark in the series is limited to the colours blue, red and white.

Application date: 1.6.1995
Registration date 9.8.1996

Goods & services:

Class 9: Audio and video tapes.
Class 16: Books and printed matter.

Class 41: Education and training, all relating to the cessation of smoking.

Class 42: Counselling services; telephone counselling services; medical care; individually tailored smoking cessation programmes; smoking cessation therapy services.

Trade Mark: QUITLINE

No: 1564369

Application date: 11.2.1994

Registration date: 12.1.1996

Services:

Class 42: Smoking cessation counselling services; telephone smoking cessation counselling services; all included in Class 42.

Basis of Acceptance:

Advertised before acceptance.

