

O-051-14

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK REGISTRATION NO. 2642900
IN THE NAME OF
GEOFFREY GAZZARD
IN RESPECT OF THE TRADE MARK**

tuffer

AND

**AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO
UNDER NO 500026 BY
DART INDUSTRIES INC.**

Background

1. Trade mark no. 2642900 shown on the cover page of this decision stands registered in the name of Mr Geoffrey Gazzard. It was applied for on 20 November 2012 (claiming an international priority date of 1 November 2012 from Australia) and completed its registration procedure on 1 March 2013. It is registered for the following goods in class 21:

Drinking vessels/tumblers.

2. On 3 May 2013, Dart Industries Inc. ("the applicant") filed an application to have this trade mark declared invalid under the provisions of sections 47(2)(a) and section 5(2)(b) of the Trade Marks Act 1994 ("the Act") which state:

"47(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."

And:

"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, or

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

3. The application is directed against all of the goods in Mr Gazzard's registration. Although the applicant relies upon all of the goods and services in the following registration, only those in class 21 are relevant i.e.

Trade mark	No.	Application Date	Registration Date	Class 21:
TUPPER	CTM 7335813	23.10.2008	26.03.2010	Household or kitchen utensils (included in class 21), particularly graters, cork screws, bottle-openers, garlic presses, fruit presses; containers

				for household and kitchen use, including covers for those containers; tableware; cookware or bakeware; combs and brushes; glassware, porcelain and earthenware (not included in other classes); tumblers; bottles, particularly drink and juice bottles.
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4. 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,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

5. The applicant’s mark qualifies as an earlier trade mark under the above provisions. Given the interplay between the date of the application for invalidation i.e. 3 May 2013 and the date the earlier mark completed its registration procedure i.e. 26 March 2010, it is not necessary, as per section 47(2)(A)(a) of the Act, for the applicant to show genuine use of the goods upon which it relies.

6. Mr Gazzard filed a counterstatement in which the basis of the invalidation is denied.

7. Only the applicant filed evidence. Whilst both parties filed written submissions during the evidence rounds, neither party asked to be heard nor did they file written submissions in lieu of attendance at a hearing. I will bear the submissions in mind and refer to them as necessary below.

The applicant’s evidence

8. This consists of a witness statement from Ms Jane More O’Ferrall, a trade mark attorney at Haseltine Lake, the applicant’s professional representatives. Exhibits JMOF1 and JMOF2 consist of extracts obtained from www.ancestry.co.uk and www.ancestry.com on 30 August 2013, which, says Ms More O’Ferrall, shows that “both of the marks consist of English surnames, albeit not common...”

DECISION

Section 5(2)(b) – case law

9. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* -BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the CJEU cases mentioned) on the basis indicated below:

The CJEU cases

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 B.V. [2000] F.S.R. 77; Marca Mode CV v Adidas AG & Adidas Benelux BV [2000] E.T.M.R. 723; Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-6/01; Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH C-120/04; Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P.

The principles

“(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade

mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) 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;

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

The average consumer and the nature of the purchasing process

10. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and then to determine the manner in which these goods will be selected by the average consumer in the course of trade. The average consumer of the goods at issue is a member of the general public who will select the goods by primarily visual means from the shelf of a retail outlet on the high street or from the pages of a catalogue or website. Whilst aural considerations may play a part in the selection process, they will, in my view, feature to a much lesser extent. In relation to the degree of care taking during the selection process of the goods at issue, Mr Gazzard states:

“11...These goods are used on a daily basis by the average consumer in their home or office and are sat on their table or desk for most of the day and night filled with drink and ready to consume. Therefore, average consumers spend some time considering their purchase of “drinking vessels” and “tumblers” so that they fit in with their home or office and are aesthetically appealing. As such the average consumer pays a high level of attention to the purchase of such goods.”

In relation to the same issue, the applicant states:

“...In all cases, however, the person choosing, ordering or purchasing the goods at issue will be exercising a relatively low degree of care and attention since the items being purchased are not highly costly, are non-technical, and no particular knowledge or training is required to for the purchaser to be in a position to make a choice of product. The attention of the average consumer for the goods will be low to moderate at most.”

11. Whilst the cost of the goods at issue can vary, the applicant's position is, in my view, far more realistic. Considered overall, I think the average consumer will pay (at best) a moderate degree of attention to the selection of the goods at issue.

Comparison of goods

12. In reaching a conclusion, I will keep in mind the decision of the General Court in *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05 i.e.

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

13. As the term “tumblers” appearing in the earlier mark is identical to the term “tumblers” in the registration, and as the term “drinking vessels” in the registration would include “tumblers” in the earlier mark, the goods are identical either literally or on the principles outlined in *Merici*.

Comparison of trade marks

14. The marks to be compared are: **TUPPER** v **tuffer**.

15. The average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as wholes 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 reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant components of the respective trade marks and, with that conclusion in mind, I must then go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

Distinctive and dominant elements

16. As both marks consist of single words presented in upper/lower case and as no part of either mark is highlighted or emphasised in any way, there are, in my view, no distinctive and dominant elements; the distinctiveness of each mark lies in its totality.

Visual similarity

17. In his submissions, Mr Gazzard states that visually the dominant and distinctive part of the competing marks is the double letters “PP” and “ff” as:

“7...the eye is automatically drawn to these double letters as they are much less common in English words as compared to TU and ER either side.”

I disagree. Both marks consist of six letters. The first two and last two letters i.e. TU/tu and ER/er are (save for the case in which they are presented which does not assist Mr Gazzard) identical and appear in the same order. Although the third and fourth letters of each mark differ i.e. PP v ff, the visual similarity between these elements (particularly where they appear in the middle of each mark) results, in the applicant’s view, in: “at least a moderate degree of visual similarity” between them; I agree with the applicant’s assessment.

Aural similarity

18. In relation to the aural comparison, both marks consist of two syllables. The applicant states that:

“The double consonants in both of the marks make a soft sound. The overall sounds of the two marks, when spoken, is rather closely similar.”

Mr Gazzard states:

8. “Phonetically, [his] mark would be pronounced with the elongated, sharp and loud sounding double “ff” in the middle of the softer and shorter “tu” and “er” either side of it. Conversely, [the applicant’s mark] would be pronounced with an elongated sharp and loud sounding double “PP” in the middle of the softer and shorter “TU” and “ER” either side of it...”

19. The beginnings and endings of each mark will (even on Mr Gazzard’s analysis) be pronounced in the same way. The difference in the sounds created by the double letters “PP” and “ff in the middle of each mark will, in my view, be negligible. The competing marks are aurally similar to a relatively high degree.

Conceptual similarity

20. Finally, insofar as the conceptual comparison is concerned, the applicant states:

“Both of the marks consist of English surnames, albeit not common. If the relevant consumers are not aware that both of these marks are surnames, then the likelihood is that both of these marks will be perceived as invented words. The marks are not likely to be differentiated on a conceptual basis.”

Mr Gazzard states:

“9. On a conceptual level the applicant contention that both marks are English surnames, and would be recognised as such, is refuted in its entirety. As shown [in exhibit JMOF1) of the applicant’s submissions TUPPER “is predominantly a Rhineland surname” and the census records show that it is so uncommon in the UK that it’s presence is insignificant. The average consumer would not perceive TUPPER to be a surname and would not attach

any other conceptual meaning to the word. Judging by the insignificant proportion of the UK population named “tuffer” from exhibit JMOF2...the average consumer would not interpret “tuffer” as a surname. However, the term “tuffer” immediately and directly brings to mind the word “TOUGHER” and so the clear concept of strength and resilience. Therefore, the marks are conceptually dissimilar.”

21. I agree with Mr Gazzard that the evidence provided by the applicant falls a long way short of establishing that either mark would be interpreted by the average consumer as a surname. In my view, the applicant’s mark is more likely to be seen as an invented word. However, I agree with Mr Gazzard that his tuffer mark will be construed by the average consumer as an indirect reference to the word TOUGHER and will, as a consequence, evoke the concepts mentioned above. As a consequence, Mr Gazzard’s mark will, as he argues, create an identifiable concept in the mind of the average consumer whereas the applicant’s mark will create none.

Distinctive character of the earlier trade mark

22. I must now assess the distinctive character of the earlier mark. The distinctive character of a trade mark can be appraised only, first, by reference to the goods for which it is registered and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

23. As the applicant has not filed any evidence of the use it may have made of its mark, I have only its inherent characteristics to consider. Consisting of a word which, as far as I am aware, neither describes nor is non-distinctive for the goods upon which the applicant relies in these proceedings, the applicant’s TUPPER mark is, in my view, possessed of a fairly high degree of inherent distinctive character.

Likelihood of confusion

24. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. 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 respective goods and vice versa. As I mentioned above, it is also necessary for me to factor in the distinctive character of the earlier mark as the more distinctive this mark is the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision I concluded that:

- The average consumer of the goods at issue is a member of the general public who will select the goods by predominantly visual means and will pay (at best) a moderate degree of attention during the selection process;
- The competing goods are identical;
- There are no dominant elements in either parties' mark; the distinctiveness of each lying in the totality;
- The competing marks are visually similar to a moderate degree and aurally similar to a relatively high degree;
- Whilst Mr Gazzard's mark will create a concrete conceptual picture in the average consumer's mind, the applicant's mark will create none;
- The earlier mark is possessed of a fairly high degree of inherent distinctive character.

25. In reaching a conclusion on the likelihood of confusion, I note that in *The Picasso Estate v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* – Case C-361/04, the CJEU said:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

26. However, I also note that in *Nokia Oyj, v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* – Case T-460/07 the GC said:

“66. Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established (see, to that effect, Case C-16/06 P *Éditions Albert René* [2008] ECR I-0000, paragraph 98).”

27. I begin by reminding myself that the goods at issue are identical and that the average consumer will pay (at best) only a moderate degree of attention during the selection process. However, the importance of the visual aspect of the competing marks to the selection process, together with the very clear and specific conceptual meaning that will be conveyed to the average consumer by Mr Gazzard's mark, is, to use the above wording, sufficient, in my view, to counteract the visual and aural similarity I have identified above. There is, in my view, no likelihood that the competing marks will be confused either directly (i.e. mistaken for one another) nor is there a likelihood that the average consumer will assume the goods come from undertakings which are economically linked (i.e. there will be no indirect confusion).

Conclusion

28. The application to invalidate Mr Gazzard's registration fails.

Costs

29. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using the TPN mentioned as a guide, I award costs to Mr Gazzard on the following basis:

Preparing a statement and considering the applicant's statement: £200

Considering and commenting on the applicant's evidence and submissions: £500

30. I order Dart Industries Inc. to pay Geoffrey Gazzard the sum of **£700**. 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 30th day of January 2014

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