

TRADE MARKS ACT 1994

In the matter of application no.2119687
by Peintures du Lauragaise SA
to register a Trade Mark in Class 2




TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION TO REGISTER TRADE MARK NO 2119687 IN CLASS 3 IN THE NAME OF PEINTURES DU LAURAGAISE SA

On 3 January 1997, Peintures du Lauragaise SA 13 Chemin de la Chasse, 31773, Colomiers, France, applied under the Trade Marks Act 1994 to register the trade mark LAURA in respect of:

Coverings, coatings, varnishes lacquers, paints, tints and dyes for industrial, craft and artistic purposes.

Objection was taken under paragraph 5(2) of the Act in respect of the following marks:

Number	Mark	Class	Goods
1116577		2	Paints
1231142		2	Paints, varnishes (other than insulating varnish), lacquers
1231150	LAURA ASHLEY	2	Paints, varnishes (other than insulating varnish), lacquers
1231159		2	Paints

Mark number 1231150 was also applied for and accepted in Classes 3,11,16,18,19,20,21,24,25,26 and 27 although these classes are not considered to be in conflict.

At a hearing at which the applicants were represented by Mr Martin Krause of Haseltine Lake Trademarks, their trade mark agents. The objections under Section 5(2) were maintained and following refusal of the application under Section 37(4) of the Act, I am now asked under Section 76 of the Act and Rule 56(2) of the Trade Marks Rules 1994 to state in writing the grounds of decision and the materials used in arriving at it.

No evidence of use has been put before me. I have, therefore, only the prima facie case to consider.

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 trade 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 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

Dealing first with the respective goods, it is immediately apparent that the goods contained within the specification of the application are identical to, or contained within the broader specification of the earlier application. Mr Krause did not argue this point but directed his submissions towards the differences in the marks. Consequently, the matter hinges on the question of the similarity between the respective marks.

The earlier marks numbered 1116577 and 1231159 contain the words "LAURA ASHLEY" in a plain type and in lower case, with the device of a branch with flowers, and contained within an oval border. These marks contain matter other than the words "LAURA ASHLEY" and while it is a generally accepted that marks should be compared as a whole, when referring to a mark which comprises words with other pictorial matter it is the words that will be used to refer to the mark. The earlier marks numbered 1231142 and 1231150 are for the words "LAURA ASHLEY" in plain type and in upper case.

Since the mark of this application is not identical to the cited registered mark the matter falls to be decided under sub-section (b) of Section 5(2). The question, therefore, is whether the word "LAURA" is so similar to the words "LAURA ASHLEY" that there exists a likelihood of confusion which includes the likelihood of association on the part of the public.

When spoken or placed side by side the differences in the marks are plain to see. The earlier marks are made up of the two words "LAURA" and "ASHLEY" and form the full name of an individual, whereas the mark applied for is composed of one word, "LAURA". It is also possible to see that they share a common element in the word "LAURA". However, it is not likely that marks will viewed in this way.

To my knowledge traders in the type of goods covered by the respective marks occasionally use their surname as a badge of origin. It is not common for full names and even less common for female names to be so used. To that extent, I take the view that the words “LAURA ASHLEY” will have fixed themselves in the recollection of the public.

In the Sabel v Puma trade mark case (C-251/95), The European Court Of Justice stated:

22. “...In that respect, it is clear from the tenth recital in the preamble to the Directive that the appreciation of the likelihood of confusion “depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified”. The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case.
23. The global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The wording of Article 4(1)(b) of the Directive-”...there exists a likelihood of confusion on the part of the public...”- shows that the perception of marks in the minds of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.
24. In that perspective, the more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that the two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either *per se* or because of the reputation it enjoys with the public.

The judgement links the question of a likelihood of confusion to two factors; the conceptual similarity, and whether the earlier mark has a particularly distinctive character, either *per se*, or by reputation. The earlier marks and the mark applied for are names, and are, or include the same female forename and I would take this as constituting a “conceptual” similarity. At the hearing Mr Krause acknowledged that the mark LAURA ASHLEY is a famous trade mark and I take this as an acceptance that it enjoys a reputation with the public. I take the view that being a mark with a strong reputation the public when seeing the word “LAURA” used in connection with the goods covered by the mark applied for will associate this with the mark already known to them in the sense that they will regard the applicants' mark as a shortened or updated version of the earlier mark and will mistakenly assume some connection in trade. Having concluded that there is a likelihood of confusion, I determine that the application is debarred from registration by Section 5(2) of the Act.

In this decision I have considered all the documents filed by the applicant and all the arguments submitted to me in relation to this application and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Section 5(2) of the Act.

Dated this 4 day of November 1998.

MIKE FOLEY
For the Registrar
The Comptroller General