

TRADE MARKS ACT 1994
IN THE MATTER OF
APPLICATION NO.2226160A
TO REGISTER A
TRADE MARK IN CLASSES 24 & 27

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IN THE MATTER OF APPLICATION NO. 2226160A BY TIM WILMAN DESIGN STUDIOS LIMITED TO REGISTER A TRADE MARK IN CLASSES 24 & 27

10 DECISION AND GROUNDS OF DECISION

On 17th March 2000, Tim Wilman Limited of Rossendale, Lancashire, applied under the Trade Marks Act 1994 to register the mark TIM WILMAN under application no 2226160. During prosecution of the application, the applicant's trading name was changed to Tim Wilman Design Studios Limited and subsequently the application was divided into two parts. This decision is only concerned with application 2226160A in Classes 24 and 27 under which registration is sought in respect of the following goods:

20 Class 24 Textiles and textile goods not included in other classes; cloth on the roll, bed linen, table linen, upholstery fabrics, wall hangings of textile.

Class 27 Wall hangings (non-textile), floor coverings.

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

Number	Mark	Goods
30 2102114	WILMAN	CI 24: Tissues (piece goods), bed and table covers, textile articles not included in other classes. CI 27: Carpet, rugs, mats and matting; linoleums and other materials for covering existing floors; wall hangings (non-textile).
35 1284330*	WILMAN	CI 24: Tissues (piece goods), bed and table covers, textile articles not included in other classes. CI 27: Carpet, rugs, mats and matting; linoleums and other materials for covering existing floors; wall hangings (non-textile).

* Community Trade Mark registration.

45 A hearing was appointed at which the applicant was represented by Mr K Hodkinson of Marks & Clerk and the objection was maintained.

Following refusal of the application under Section 37(4) of the Act, I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Marks Rules 2000 to provide a statement of the reasons for my decision.

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

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

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

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(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

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(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,

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

Dealing firstly with the respective goods, it is immediately apparent that many of the goods contained within the specification of the application are identical to, or contained within the specifications of the earlier trade marks. Consequently, the matter hinges on the question of the similarity between the respective marks.

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Since the mark of this application is not identical to the earlier mark the matter must be decided under subsection (b) of Section 5(2). The question, therefore, is whether the mark of this application is so similar to the earlier mark that there exists a likelihood of confusion which includes the likelihood of association on the part of the public.

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At the hearing and in correspondence, Mr Hodkinson, made a number of submissions in support of the application which are summarised as follows:

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S the application is made by the successor in business to Tim Wilman, the well known designer and son of the equally well known designer John Wilman;

S no person enjoys an exclusive right to the use of the word WILMAN and each of the designers in question is entitled to use and seek to register his name;

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S no member of the relevant public will be confused between Tim Wilman and John Wilman;

S the mark ARTHOUSE BY TIM WILMAN (2246825) had been accepted and subsequently registered in Classes 24 and 27, despite the earlier registration of WILMAN;

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S TIM WILMAN is a mark which “hangs together”;

S marks such as PALOMA PICASSO had been accepted in the face of PICASSO.

These arguments did not persuade me to waive the objection.

5 In consideration of the question of likelihood of confusion, I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 2, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schufabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

10 It is clear from these cases that:-

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*, paragraph 22;
- 15 (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, paragraph 23, 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; *Lloyd Schufabrik Meyer & Co. GmbH v Klijsen Handel B.V.* paragraph 27;
- 20 (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;
- 25 (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;
- 30 (e) 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;
- 35 (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 AG*, paragraph 24;
- (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 AG*, paragraph 26;
- 40 (h) 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*, paragraph 41;
- 45 (i) 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.

5 Although the marks differ visually and aurally it is clear that conceptually they are derived from the same idea, ie, the use of a surname as a trade mark or part of a trade mark. The cited marks consist of the very rare surname WILMAN, which only has three occurrences in the BT Phone Disc for London and therefore possesses a high level of distinctiveness. Consequently marks which combine this name with a forename, such as TIM WILMAN, are also distinctive, per se.

10 Mr Hodgkinson contended that no person enjoys an exclusive right the use of the word WILMAN and no member of the public will be confused between Tim Wilman and John Wilman. The fact of the matter is that at present, John Wilman Limited, as owners of the WILMAN marks do enjoy trade mark protection in respect of that name. The public may or may not be confused between Tim Wilman and John Wilman but that is not at issue in this case. The question which has to be
15 determined is whether the association between the marks TIM WILMAN and WILMAN is to the extent that the public would think that the respective goods come from the same or economically linked undertakings. Bearing in mind that both TIM WILMAN and WILMAN have a high degree of distinctiveness, I take the view that the average consumer, with imperfect recollection and who would not normally have the opportunity to make direct comparisons between the marks, would
20 inevitably be confused as to the origin of the goods.

Mr Hodgkinson drew my attention to the registration of his client's later filed mark ARTHOUSE BY TIM WILMAN which has been registered in the same classes as the present application. I do not know the reason for that mark's acceptance but it is obviously a very different mark to
25 TIM WILMAN and its registration does not alter my view that there would be a likelihood of confusion in the present circumstances. In any event, each case must be dealt with on its own merits. Mr Justice Jacob in the British Sugar PLC and James Robertson and Sons Ltd (TREAT) decision (1996) RPC 281 said:

30 *"In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the Registrar to put the marks concerned on the Register. It has long been held that under the old act that comparison with other marks on the Register is in principle
35 irrelevant when considering a particular mark tendered for registration, see MADAME trade mark (1966 RPC 541) and the same must be true of the 1994 Act. I disregard the state of the register evidence."*

Similarly, the registration of PICASSO and PALOMA PICASSO cannot have any bearing in this
40 decision.

I therefore conclude that for the reasons stated above, the application is debarred from registration by Section 5(2)(b) of the Act because there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

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.

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Dated this 14 day of November 2001.

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Charles Hamilton
For the Registrar
the Comptroller General

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