

TRADE MARKS ACT 1994

**IN THE MATTER OF Application Nos. 2144536
And 2144538 by dELiA*s Inc to register marks**

And

**IN THE MATTER OF Consolidated opposition
There to under Nos 48567 and 48568 by Buttress BV**

D E C I S I O N

1. This is an Appeal to the Appointed Person from the Decision of Mr. David Morgan acting on behalf of the Registrar dated the 29th June 2001. The Decision was given in Opposition proceedings brought by Buttress B.V. against the registration of two marks in Class 3 by a company known as dELiA*s Inc.
2. These marks were applied for on 9th September 1997 under application Nos. 2144536 and 2144538. The marks were sought to be registered in respect of the same category of goods which were a variety of personal care goods ranging from soaps and perfumes through to anti-perspirants and toothpastes. The two marks however were different. 2144536 was in respect of a representation of the corporate name, dELiA*s and 2144538 was in respect of a less stylised version, DELIA'S.
3. The only ground of opposition relied upon by the time the matter came for a hearing was that based under section 5(2)(b) of the Trade Marks Act 1994 which provides:

*“5(2) A trade mark shall not be registered if because –
(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 mark”.

4. A number of earlier registrations were relied upon. Three were for the word DELIAL whereas another was for a stylised version in lower case “delial”. The most pertinent was 1152568, DELIAL, registered in class 3 in respect of equivalent goods to those for which registration of the trade marks opposed was sought. It was common ground that this mark was an earlier trade mark and that identical goods were involved. The only question therefore that Mr. Morgan had to decide was whether or not the trade marks applied for were sufficiently similar to the trade mark DELIAL so as to create the relevant likelihood of confusion. Mr. Morgan directed himself as to the legal approach in the following passage:

“The correct approach to the matter has been set out in a number of decisions of the European Court of Justice (ECJ) in particular Sabel BV v. Puma AG [1998] E.T.M.R. 1, Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc. [1999] E.T.M.R. 1, Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V. [2000] F.S.R. 77 and Marco Mode CV v. Adidas AG [2000] E.T.M.R. 723.

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 page 8, para 22.*
- (b) The matter must be judged through the eyes of the average consumer of the goods/services in question; Sabel BV v. Puma AG page 8, 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 Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V. page 84, 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 page 8, 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 page 8, paragraph 23;*
- (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. page 7, paragraph 17;*
- (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 page 8, 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 page 9, paragraph 26;*
- (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; Marco Mode CV v. Adidas AG page 732, paragraph 41.*
- (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. page 9 paragraph 29.*

5. Before Mr. Morgan it is apparent that the case was argued on the basis that no relevant distinction could be drawn between the two marks applied for and that therefore the comparison to be made was a straightforward comparison between the word mark DELIAL and the word mark DELIA'S.

6. Mr. Morgan concluded as follows:

13. *It is of course possible to over-analyse marks and in doing so shift the focus away from the real test which is how marks will be perceived by customers in the normal course and circumstances of trade. There are self-evidently points of similarity between the words. They have the first five letters in common but they are relatively short words where small differences are more easily noticed. More importantly one is the possessive form of a recognised female forename, the other an invented word. I cannot accept the suggestion put forward by Mr. Krause that the opponents' mark DELIAL would be seen by the average person as a variant of the female forename DELIA, and indeed there was no evidence before me to support this view. Consequently, I have difficulty in accepting that the average consumer would make any conceptual link between the two marks or that there is any real risk of aural confusion*
14. *The opponents' strongest case seems to me to be the visual similarity between the marks, accepting, as I do, that most cosmetics are purchased on the basis of visual inspection. Marks may be presented or viewed in a variety of ways and I accept the point made by Mr. Krause that on certain goods the mark would not be prominently displayed. I would hesitate to rule out entirely the possibility that a customer, perhaps viewing goods from a distance, might be mistakenly drawn to the wrong mark. However, I do not see it as being a likely rather than merely a possible occurrence. It would be a momentary confusion that would not survive the normal purchasing process where rather closer attention is likely to be paid to the brand name.*
15. *In short, given the difference between the marks and taking into account all the relevant factors, including imperfect recollection, I believe the possibility of confusion is significantly remote that it cannot be*

regarded as likelihood. The opposition under Section 5(2)(b) fails.

7. It is against this conclusion that the Opponents appeal. At the hearing before me they were represented by Mr. Krause of Haseltine Lake Trade Marks. Mr. Krause accepted that the approach to be adopted on an appeal of this nature was that indicated by Pumfrey J. in Southcone Incorporated –v- Jack Bessant & Others – trading as “Reef” dated 25th July 2001 where he concluded:

“My approach will be as follows. Findings of primary fact will not be disturbed unless the hearing officer made an error of principle or was plainly wrong on the evidence. His inferences from the primary facts may be reconsidered but weight will be given to his experience. No question of the exercise of a discretion arises. In this way, error will be corrected, but a different appreciation will not substituted for that of the hearing officer if he has arrived at his conclusion without error”.

8. Mr. Krause’s primary submission before me was that although Mr. Morgan had directed himself correctly as to the approach, he did not follow that approach when analysing the two marks. In particular he drew my attention to consideration (e) referred to by Mr. Morgan namely:

(e) the lesser degree of similarity between the marks may be off set by a greater degree of similarity between the goods, and vice versa.

9. He contended that although Mr. Morgan had noted that the goods were identical he had failed to take that aspect into account when assessing whether the degree of visual similarity between the marks was likely to lead to confusion. Mr. Krause further criticised the hearing officer on the basis that although he had appreciated that the first five letters of the two marks were identical and that the marks were relatively short words, he had failed to take into account that there were in fact only six letters in the mark and that the focus of attention of any observer would be upon the beginning

of the word rather than the ending. The similarity would thus be readily apparent whereas the difference might be overlooked.

10. Mr. Krause also reminded me of the necessity to take into account the imperfect recollection of the average consumer who is unlikely to see the goods side by side and again criticised Mr. Morgan for not focusing on this.
11. Ms. Thomas-Peter of Wildbore & Gibbons, who appeared for the Applicants, submitted that Mr. Morgan did take the correct approach, that he directed himself correctly as to law and that his conclusion was fully consistent with the reaction of an informed and fairly discerning consumer who was the correct addressee. She contended that the doctrine of imperfect recollection should not be carried too far and submitted that the average consumer would perceive a relatively short mark, such as the ones in question here, as a whole and would readily perceive differences regardless whether they were at the beginning or the end of the mark.
12. During the course of the hearing I raised the question whether the parties were correct in inviting Mr. Morgan to consider the two trade marks applied for together. They plainly are not the same. The stylised mark in the form of the corporate name is significantly more distinctive than the upper case DELIA'S. Neither party however was keen to rely on this distinction and it is plain that the hearing officer did not. I have been troubled as to whether this was correct. It appears from Mr. Morgan's decision that he was in fact making a comparison between the upper case mark, DELIA'S, and the earlier mark, DELIAL. I propose therefore to consider first the correctness of this decision.
13. Mr. Krause accepts that Mr. Morgan did not err in stating the legal approach. His objection is a more intangible one, namely, that he failed to apply the directions he gave himself. I accept that if an appellate tribunal were to be satisfied that this had indeed occurred, then the hearing officer would have fallen into the sort of error that the appellate tribunal could and should review. On the other hand it is very easy to criticise any decision which, in the final event, is a value judgment, on the basis that the Judge has not followed the correct approach. There is a very narrow line between a valid

14. In the present case I have concluded that Mr. Krause's submission falls on the wrong side of the line. I believe that he is inviting me to reconsider the statutory question without having first properly identified an error of principle in Mr. Morgan's approach. An analysis of Mr. Krause's arguments has satisfied me that he is, in truth, suggesting that another reasoning hearing officer might have come to a different conclusion. A hearing officer might have placed greater weight on the shortness of the mark and upon the fact that the differences occurred at the end of the mark. Mr. Morgan was however alert to the fact that these were short words and concluded that there was greater weight in the present case in the submission that smaller differences will be more easily noticed in short words. That was a conclusion that was open to him. Equally he cautioned himself about the possibility of over-analysing the marks and so shift the focus away from the correct test. Again this was perfectly proper. He was unable to accept Mr. Krause's suggestion that the Opponent's mark, DELIAL, would be seen by the average person as a variant of the female forename Delia. Again this was conclusion which was open to him on the facts of this case. Finally his judgment that any potential mistake was merely possible and not likely, in that it would be only a momentary, is again, in my judgment a conclusion which was open to him.
15. For all these reasons I have been unable to identify any error of principle on the part of Mr. Morgan such that this tribunal should review his decision.
16. This conclusion is sufficient to dispose of this appeal. However, as indicated above, I have my concerns that the approach of the hearing officer in treating the two mark applied for together was an error. Had I reached the conclusion that his decision in relation to the more general mark, DELIA'S, was open to review, I should have reviewed both marks separately. The more stylised mark, dELiA*s is to my mind significantly different both from the mark DELIA'S and from the mark DELIAL that separate consideration should have been given to it.

17. In the event however I am satisfied that this appeal should fail in toto. It will therefore be dismissed and I order the opponents to pay the applicants a further sum of £770 as a contribution to the applicants' costs of this appeal to be paid on the same terms as those ordered by Mr. Morgan.

Simon Thorley Q.C.
23rd April 2002