

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 2177602
BY THE UNIVERSITY OF NORTHUMBRIA AT NEWCASTLE
TO REGISTER A TRADE MARK
IN CLASSES 14, 16, 25 & 28

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 90449
BY SEAHORSE HOLDINGS LIMITED.

BACKGROUND

1) On 18 September 1998, the University of Northumbria at Newcastle of Ellison Terrace, Newcastle-upon-Tyne, NE1 8ST, applied under the Trade Marks Act 1994 for registration of the following trade mark:



2) In respect of the following goods:

In Class 14: “Jewellery; horological and chronometric instruments; wrist watches.”

In Class 16: “Printed matter; stationery; artists materials; office requisites; pens; pencils; rulers; erasers; paperweights; paper knives; prints; diaries; greeting cards; carrier bags.”

In Class 25: “Clothing; footwear; headgear; leisurewear; T-shirts; sweatshirts; ties; sports caps; scarves.”

In Class 28: “Games and playthings; toys.”

3) On the 3 October 2001 Seahorse Holdings Limited of 20 St James’s Place, London, SW1A 1NN filed notice of opposition, subsequently amended, to the application. The amended grounds of opposition are in summary:

a) The opponent is the proprietor of four UK Trade Marks and two Community Trade Marks as detailed in Annex A for the word SEAHORSE or a Seahorse device.

b) The opponent and its predecessors in business have made substantial use of their SEAHORSE and Seahorse device marks in the UK since 1986 in relation to, inter alia,

the goods in Classes 16 and 25 and have gained a considerable reputation in such goods sold under these marks in the UK.

c) The applicant's registration in respect of goods in Classes 14 and 28 are not opposed. Nor are the following goods in Class 16: "Stationery; artists materials; office requisites; pens; pencils; rulers; erasers; paperweights; paper knives; carrier bags." Only the Class 25 specification and the following goods in Class 16: "printed matter; prints; diaries; greetings cards" are opposed under Sections 5(1),5(2)(a), 5(2)(b) and 5(4) of the Trade Marks Act 1994.

4) The applicant subsequently filed a counterstatement accepting that the opponent is the proprietor of the registrations claimed but denying the opponent's other claims.

5) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. Neither side wished to be heard.

OPPONENT'S EVIDENCE

6) The opponent filed a witness statement, dated 17 May 2002, by Peter Wykeham-Martin the General Manager of The Royal Ocean Racing Club (RORC) and a Director of Seahorse Holdings Limited (SHL). He states that he has access to the records of both organisations. He provides a potted history of the RORC stating that the seahorse emblem was first used in 1925 and modified to include a naval crown device in 1931 when the club was granted a Royal Warrant. He states that the device has always been referred to as "seahorse", and that in 1986 the RORC formed SHL to manage its trading affairs.

7) Mr Wykeham-Martin states that since 1971 the "Seahorse" International Sailing magazine has been published or commissioned by the RORC and subsequently by SHL. The ethos of the RORC is to encourage non-members to participate in ocean racing and approximately 80% of the 20,000 current subscribers to each monthly edition of "Seahorse" magazine are non-members. The device has been used on all publications issued by the RORC since its inception and the word "Seahorse" has been used on the monthly magazine since 1971. Until 1974 the monthly magazine was only distributed to the membership (2,700 in 1973). After this date the magazine was put on general sale at newsstands and by subscription. In 1973 approximately 32,000 copies of the magazine were distributed, by 2001 the circulation had grown to approximately 240,000. Examples of publications issued by the RORC are provided at exhibit A, these are titled "Manual of weather at sea", "Safety and survival at sea", and the "Seahorse International Sailing" magazine. All these publications have the full name of the RORC and also the Seahorse device on their front covers. There are also printed pages regarding safety and rules which have the device and full name of the RORC at the top of each page.

8) At exhibit B extracts, including the front cover, from the book "The Royal Ocean Racing Club : The first 75 years" are provided. This was published in 2000 and the front cover and other pages show use of the seahorse device over the years of the club's existence.

9) Mr Wykeham-Martin states that "In respect of clothing, the "Seahorse" device has been the

only externally visible mark appearing on garments”. At exhibit C he provides an extract from the RORC 2002 race programme which has, at page 8, a range of accessories and insignia which bear the seahorse device. Although precise figures are not available he estimates from the royalties paid that the value of sales to non-members for the period 1997-2002 to be approximately £50,000 per annum. He states that he is unaware of any other use of a seahorse device or of the word “Seahorse” in the UK in respect of printed publications or clothing.

APPLICANT’S EVIDENCE

10) The applicant filed a statement, dated 21 August 2002, by Patricia Ann McCrory the Sales and Systems Manager for the applicant company. She describes the applicant’s mark as “a stylised representation of a seahorse, having what could be described as a human facial expression”. She also refers to the hearing officer’s report, provided at exhibit PAM1, in which the hearing officer waived the objection based on the opponent’s mark E156000. The report states:

“Mr Vinsome argued, as he had in correspondence, that nobody had a monopoly in sea horse devices in Class 16 and he produced some examples of this. I felt most were clearly distinguishable from this application either visually or orally. On that basis I waived E158000 [*sic*] (the coronet and the curl of the tail were distinguishing features).”

11) Ms McCrory claims that the opponent’s mark incorporates, as a result of a Royal warrant, a naval Crown device. She claims that the coronet is a prominent feature of the opponent’s trade mark as it indicates a connection between the opponent and its Royal warrant. She also states that “seahorses have for many years been associated with the City of Newcastle upon Tyne”. At exhibit PAM2 she provides extracts from the website of the Lord Mayor of Newcastle upon Tyne. These pages show the City’s coat of arms which has a red shield with three silver castles depicted upon it. Above this is a fifteenth century style helmet, with a wreath of red and white leaves stands a silver castle. Atop the castle is a golden lion holding the golden staff of St. George’s pennon. The supporters are two mythical sea horses shaded in green with gold manes, fins and tails. Below all this is the motto “Fortiter Defendit Triumphans”. The coat of arms appears on a number of pages in a variety of guises such as chains of office, on swords etc. MS McCrory states that representations of seahorses appear at many locations throughout Newcastle Upon Tyne.

12) At exhibit PAM4 Ms McCrory provides an extract from the website for Newcastle United Football Club, which shows the club badge. This has, amongst other things, two seahorses. This exhibit also has pages offering merchandising which bears the club badge. The club badge is shown to be a registered trade mark by exhibit PAM5. Ms McCrory therefore claims that the opponent’s comments claiming to be the only user of a seahorse device or the word “seahorse” cannot be correct.

13) At exhibit PAM6 Ms McCrory provides copies of the University’s UK trade mark registration 2053532 which relates to the University’s coat of arms which is registered for various goods in Class 25. The coat of arms is based upon the coat of arms for Newcastle upon Tyne and includes a pair of seahorses. She states that:

“A high percentage of students attending the University either come from, or otherwise have connections with, the North East of England. It is the University’s intention only to sell goods bearing the trade mark in shops on the University’s campus in Newcastle, or at its campus in Carlisle, Cumbria, some 70 miles from Newcastle. It is inconceivable that persons buying goods under the trade mark would not be in some way connected with the University (either as students or relatives of students). I therefore believe that persons purchasing goods under the trade mark would without exception associate the seahorse of the trade mark with the City of Newcastle upon Tyne.”

14) Regarding the opponent’s evidence Ms McCrory points out that all the opponent’s use relates to a seahorse and crown device, and that the total sales of clothing luggage and accessories are not confined to the UK. Lastly she states that the use of a seahorse by Newcastle United Football Club would far outweigh any use by the opponent.

OPPONENT’S EVIDENCE IN REPLY

15) The opponent filed a second statement by Peter Wykeham-Martin, dated 30 October 2002. He comments that an ordinary consumer would refer to the applicant’s mark as “seahorse” and is therefore “merely a graphic representation” of his company’s marks for the word “Seahorse” and “Sea Horse”. He also states his belief that the average consumer would regard his company’s device as a “seahorse”. He points out that this is how it has been referred to for over 70 years. He comments that the other trade marks shown in the applicant’s evidence consist of more than a depiction of a seahorse.

16) Lastly, Mr Wykeham-Martin comments that if the applicant had sought registration of a coat of arms containing seahorses or seahorses accompanied by words identifying the University then his company would have had no objection to the registration. In seeking to register a seahorse device (simpliciter) the applicant’s mark would be associated or confused with his company’s trade marks.

17) That concludes my review of the evidence.

DECISION

18) I turn first to the grounds of opposition based upon Sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994, which read:

“5.-(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(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 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.”

19) An earlier trade mark is defined in Section 6, 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 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,”

20) The opponent’s four UK Trade Marks and two Community Trade Mark detailed at Annex A are all plainly “earlier trade marks”. In my view the opponent’s strongest case is under its Community Trade mark number 156000 “seahorse device”.

21) Clearly the opponent’s mark is not identical to the applicant’s mark. The opposition based upon Sections 5(1) and 5(2)(a) therefore fail.

22) In determining the question under section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [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* [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 224;
- (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 224, 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 224;
- (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 224;

- (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 132, 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 224;
- (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 224;
- (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* 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 133 paragraph 29.

23) In essence the test under Section 5(2) is whether there are similarities in marks and goods and/or services which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgements of the European Court of Justice mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods and/or services, the category of goods and/or services in question and how they are marketed. Furthermore, I must compare the mark applied for and the opponent's registrations on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods and services covered within the respective specifications.

Similarity of goods and services

24) The opposition is in relation to some of the applicant's goods in Class 16 and to the whole of the Class 25 specification. The relevant specifications of the two parties are as follows:

Applicant's Specification	Opponent's specification
Class 16: Printed Matter; prints; diaries; greetings cards.	Class 16: Books relating to sailing, the weather at sea, safety at sea and survival at sea; newspapers, periodicals and magazines all relating to ocean racing.

Class 25: Clothing; footwear; headgear; leisurewear; T-shirts; sweatshirts; ties; sports caps; scarves.	Class 25: Clothing, headgear and footwear.
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25) In order to assess the similarity of the goods and services, I note the factors set out by Mr Justice Jacob in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 at page 296. Adapted to the instant case, it can be stated as:

- a) the uses of the respective goods;
- b) the users of the respective goods;
- c) the physical nature of the goods;
- d) the trade channels through which the goods reach the market;
- e) in the case of self-serve consumer items, where in practice they are respectively found or likely to be found on the same or different shelves; and
- f) the extent to which the respective goods are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods in the same or different sectors.

26) These factors were referred to in the opinion of the Advocate General in *Canon*; page 127, paragraphs 45-48. In its judgement, the ECJ stated at paragraph 23:

“23. In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their end users and their method of use and whether they are in competition with each other or are complementary.”

27) Neither party provided submissions or evidence regarding the similarity or otherwise of the goods, I must therefore consider the matter in the light of my own experience. The opponent’s goods in Class 16 have a “maritime” theme which is not specifically included in the applicant’s goods. However, nor is it excluded and the applicant’s “printed matter” would encompass the opponent’s entire specification. With regard to the remainder of the applicant’s Class 16 specification (prints, diaries and greetings cards) the uses of these goods differs from those of the opponent’s specification. The users of the opponent’s goods would be users of the applicant’s goods. Both specifications relate to printed matter, and the trade channels would be similar. Diaries and prints are often to be found on sale alongside books, magazines, periodicals and newspapers. However, greetings cards are frequently sold in separate establishments. The Class 16 specifications of the two parties, with the exception of greetings

cards, must therefore be regarded as similar.

28) Considering the Class 25 specifications it is clear that the opponent's specification encompasses the whole of the applicant's specification. The goods in Class 25 must be considered as identical.

Distinctive character of the opponent's mark

29) The distinctive character of an earlier trade mark is a factor to be borne in mind in coming to a view on the likelihood of confusion (*Sabel v Puma*, paragraph 24). That distinctive character can arise from the inherent nature of the mark or be acquired through use.



30) The opponent's mark consists of a seahorse device which has an anchor at the end of its tail and a coronet above its head. The opponent has filed evidence of use of the mark, presumably to establish an enhanced degree of distinctive character for their mark. In *Duonebs* Trade Mark BL O/048/01, Mr Thorley QC, sitting as the Appointed Person, said in relation to this point:

“In my judgement, I believe what the ECJ had in mind was the sort of mark which by reason of extensive trade had become something of a household name so that the propensity of the public to associate other less similar marks with that mark would be enhanced. I do not believe that the ECJ was seeking to introduce into every comparison required by Section 5(2), a consideration of the reputation of a particular existing trade mark.”

31) The magazine is said to have a circulation of 240,000 copies per annum, whilst the approximate turnover figure for clothing and accessories is £50,000. The mark is also used on nautical books. None of the figures have been put into context. I am not persuaded that the opponent's mark can be said to have acquired an enhanced degree of distinctive character in this country. Although the mark does possess a reasonably high degree of inherent distinctive character.

Similarity of marks

32) The marks of the two parties are as follows:

Applicant's mark	Opponent's Mark
	

33) Visually the device marks have differences. The applicant's seahorse has what has been described as a "human expression", whereas the opponent's mark has clearly a more equine head. The opponent's mark also has a crown or coronet above it and an anchor or cross at the end of its tail. However, the overwhelming impression provided by both parties marks is that of a seahorse.

34) Phonetically the marks would in my opinion both be described as "seahorse" devices. The differences would not be, initially, commented upon.

35) Conceptually, both marks convey the same message. The applicant's mark is slightly stylised to give it a "cute" image, whereas the opponent's mark hints at "power and authority" with the crown element. Overall both are relatively accurate representations of a seahorse.

Likelihood of confusion

36) Items of clothing are, I would suggest, chosen with some consideration. The average consumer of such products would, in my opinion, exercise some care in the selection. In *REACT* [1999] 15 RPC 529 the Hearing Officer held the following:

"I am therefore prepared to accept that a majority of the public rely *primarily* on visual means to identify the trade origin of clothing, although I would not go so far as to say that aural means of identification are not relied upon."

37) Whilst "printed matter; prints; diaries; greetings cards." in Class 16 may not receive the same level of attention as items of clothing, the average consumer would still be reasonably circumspect and observant.

38) The applicant has claimed that seahorses have been associated with the City of Newcastle for many years, and provided evidence of use by various institutions and clubs. However, the use shown was of coats of arms or crests in which seahorses were not the dominant feature. Whether the use shown related to use as a trade mark was also questionable. However, this issue would not affect the outcome of the present opposition.

39) With all of this in mind I come to the conclusion that when all factors are considered, that there was a likelihood of confusion at 18 September 1998 in relation to the opposed goods in Classes 16 and 25 with the exception of "greetings cards" in Class 16.. Consequently, the opposition under Section 5(2)(b) succeeds, other than in respect of "greetings cards".

40) Given the above finding I do not need to consider the ground of opposition under Section 5(4).

41) The application will be allowed to proceed to registration if, within one month of the end of the appeal period for this decision, the applicant's file a TM21 amending their registration as follows:

Class 14: "Jewellery; horological and chronometric instruments; wrist watches."

Class 16: “Stationery; artists materials; office requisites; pens; pencils; rulers; erasers; paperweights; paper knives; carrier bags; greetings cards.”

Class 28: “Games and playthings; toys.”

42) If the applicant does not file a TM21 restricting the specification as set out above the application will be refused in its entirety.



Conclusion and costs


43) The opposition having been successful against virtually all of the goods opposed, the opponent is entitled to a contribution towards costs. I order the applicant to pay the opponent the sum of £535. This sum 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 17 day of February 2003

George W Salthouse
For the Registrar
The Comptroller General

ANNEX A

UK TRADE MARKS	Number	Effective Date	Class	Specification
SEAHORSE	1249827	06.09.85	25	Articles of outer clothing and socks, all included in Class 25.
	1264103	04.04.86	25	Articles of outer clothing; socks (for wear); T-shirts; all included in Class 25.
	1308265	24.04.87	16	Newspapers, periodicals and magazines, all relating to ocean racing and included in Class 16.
SEAHORSE	1308266	24.04.87	16	Newspapers, periodicals and magazines, all relating to ocean racing and included in Class 16.

COMMUNITY TRADE MARKS	Number	Effective Date	Class	Specification
SEAHORSE	155945	01.04.96	16	Books relating to sailing, the weather at sea, safety at sea, and survival at sea; newspapers, periodicals and magazines all relating to ocean racing.
			18	Articles of leather or imitation leather, travelling bags and travelling luggage.
			25	Clothing, headgear and footwear.
	156000	01.04.96	12	Sailing boats and sailing yachts; parts for all the aforesaid goods; but not including outboard or other marine motors.
			16	Books relating to sailing, the weather at sea, safety at sea, and survival at sea; newspapers, periodicals and magazines all relating to ocean racing.
			25	Clothing, headgear and footwear.