

O-258-10

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2504741  
BY D.C.K. CONCESSIONS LIMITED TO REGISTER A  
TRADE MARK IN CLASS 18**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 99097 BY LIFEMARQUE LIMITED**

## BACKGROUND

1. On 15 December 2008, D.C.K. Concessions Limited (DCK) applied to register the trade mark **FREEDOM** for a range of goods in class 18. Following examination, the application was accepted and published for opposition purposes on 13 February 2009 in Trade Marks Journal No.6773 for the following goods:

Articles of leather and imitations of leather; trunks and travelling bags; travel cases; luggage; suitcases; holdalls; bags; handbags; shoulder bags; toilet bags; carrier bags; rucksacks; backpacks; bumbags; sports bags; casual bags; briefcases; attaché cases; music cases; satchels; beauty cases; carriers for suits, for shirts and for dresses; tie cases; notecases; notebook holders; document cases and holders; credit card cases and holders; wallets; purses; umbrellas; parasols; belts; parts and fittings for all the aforesaid goods.

2. On 13 May 2009, Lifemarque Limited (Life) filed a notice of opposition. This consisted of grounds based upon sections 5(1) and 5(2)(a) of the Trade Marks Act 1994 (as amended) (the Act), directed, I note, against all of the goods contained in the application. Life's opposition is based upon the following trade mark:

Trade Mark	No.	Application Date	Registered	Goods
FREEDOM	CTM 3038361	6/2/2003	30/11/04	<b>18</b> - Personal child carrying devices; personal child carrying slings and rucksacks; infant and baby-carrying slings and rucksacks.

3. In their Notice of Opposition Life comment on what they consider to be the identical/similar nature of the respective parties' goods. Although given the limitation to DCK's specification (see paragraph 6 below) some of these comments are no longer relevant, in order to place Life's initial objection into context I have reproduced what I consider to be the most important parts below:

"3. Bags; shoulder bags; carrier bags; rucksacks; backpacks; casual bags of the application are identical with all of the goods of the opponent's mark at least insofar as those goods are personal child carrying devices, or slings or rucksacks that may be used for carrying children, infants or babies, and are otherwise similar to all of the goods of the opponent's mark at least insofar as they are goods of the same nature and/or intended purpose and/or method of use and/or are sold via the same distribution channels and are complementary to or in competition with each other.

4. All of the remaining goods of the application are at least similar to the goods of the opponent's mark, being goods of the same nature and/or intended purpose and/or method of use and/or are sold via the same distribution channels and complementary to or in competition with each other."

4. On 29 July 2009, DCK filed a counterstatement in which they admit that the respective trade marks are identical but deny that there is any similarity in the respective goods. As a good deal of Life's evidence-in-chief responds to comments made in the counterstatement (and as the outcome of these proceedings will turn on the similarity or otherwise in the respective parties' goods), I have reproduced here what I consider to be the most important of DCK's comments (albeit modified by me to exclude goods no longer relevant to this opposition). They say:

"5. The goods of the opponent's mark are devices specifically to carry a child, infant or baby safely either in front or behind a person using the carrying device. The nature of the goods means that they are ergonomically constructed and must be rugged and easy to clean, as well as being comfortable for the child to sit in for extended periods. Child carriers will typically incorporate a rigid frame, an anatomically shaped seat, padding, openings for example for the legs and arms of a child, as well as adjustable shoulder and waist straps and, as such, are highly specialised goods. Consumers looking to purchase a child carrier are limited to people having young children and they are likely to be particularly attentive consumers. These goods are aimed and marketed particularly at those consumers wishing to carry a child safely and comfortably while out walking, for example during a ramble or day out. When purchasing a child carrier, a consumer will be aware of the design of the carrier in terms of comfort and safety. The goods of the opponent will typically be sold in outdoors/camping shops or shops specialising in the sale of baby and child related products.

6. In contrast, the goods covered by the present application are marketed at the general public wishing to purchase an accessory and are sold in ladies clothing/accessory shops or department stores. The goods of the applicant are intended for general purpose use and are designed to hold a number of different or miscellaneous items.

7. The Applicant therefore submits that the goods of the opponent are of a very different nature to the goods of the application and that the goods of the opponent and the goods of the application are neither in competition with one another or complementary to one another as they are intended for very different purposes. The goods of the opponent and the application meet very different needs and are, due to their nature and intended use, constructed very differently. For these reasons, the respective trade channels and sales outlets of the goods are also different. Furthermore, due to the specialist nature of the opponent's goods, the relevant consumer i.e. buyers of child carrying devices would not expect a manufacturer of such devices to also produce a range of leather goods, luggage and travelling bags, holdalls, handbags, shoulder bags, toilet bags, carrier bags, rucksacks, backpacks, bumbags, sports bags, briefcases, attaché and music cases, satchels, beauty cases, clothing carriers, notecases, notebook and document cases and holders, credit card holders, wallets, purses, umbrellas, parasols or belts.

**8b. Toilet bags; briefcases; attaché cases; music cases; beauty cases; carriers for suits, for shirts and for dresses; tie cases; notecases; notebook holders; document cases and holders; credit card cases and holders; wallets; purses** are designed specifically to carry particular items such as clothes, sportswear and sports equipment, documents, cosmetics or money, and as such their intended purpose is different to the goods of the opponent's mark. These items are not suitable for carrying a child and are quite different in nature. Therefore they are dissimilar to the goods of the opponent's mark.

**8c. Handbags; satchels** are all small bags designed to carry personal items or documents/books. Specifically, a handbag is defined as, "a woman's small bag for holding personal items" ..and a satchel is defined as "a small bag, especially a bag for carrying schoolbooks, usually with a strap to hang over the shoulders." The nature, intended purpose, method of use and users of these goods are therefore very different to the goods of the opponent's mark.

**8d. Carrier bags** are usually made of paper or thin flexible plastic and their intended purpose is for carrying purchases or other small items. The nature of these items is therefore completely different to the child carrying devices covered by the opponent's mark.

**8e. Trunks and travelling bags; travel cases; luggage; suitcases; holdalls.** The intended purpose of these goods is to carry clothes, footwear, toiletries and other miscellaneous items while travelling. These goods will typically completely enclose their contents and protect them during travel. The method and purpose of use of these goods is therefore very different to a child carrying device.

**8h. Bags; shoulder bags...**of the application are not similar to the goods of the opponent's mark. Child carriers perform a very specific purpose, namely supporting a child to enable that child to be carried either behind or in front of a person's body. The nature and method of use of a child carrier mean that they are constructed very differently to a bag...Bags...are generally flexible, so that they may be folded for storage whereas child carriers generally contain some form of rigid frame so as to provide support for the passenger. Bags...are also designed to fully or substantially to enclose their contents, typically to protect them from exposure to rain and the like whereas child carriers are not. Furthermore, bags...are typically able to hold a variety of different items and, as such, the intended purpose, method of use and nature of these items is different to that of the goods of the opponent's mark."

5. Both parties filed evidence in the proceedings. In addition, Life filed written submissions in lieu of attendance at a hearing which I will refer to as necessary later. After a careful consideration of all the material before me, I give this decision.

6. Before considering the evidence filed and as foreshadowed above, on 22 December 2009 DCK filed a Form TM21 to amend their specification of goods to the following:

Trunks and travelling bags; travel cases; luggage; suitcases; holdalls; bags; handbags; shoulder bags; toilet bags; carrier bags; briefcases; attaché cases; music cases; satchels; beauty cases; carriers for suits, for shirts and for dresses; tie cases; notecases; notebook holders; document cases and holders; credit card cases and holders; wallets; purses; parts and fittings for all the aforesaid goods.

7. For ease of identification the following goods were deleted:

Articles of leather and imitations of leather; rucksacks; backpacks; bumbags; sports bags; casual bags; umbrellas; parasols; belts.

## **EVIDENCE**

8. DCK have admitted that the respective trade marks at issue in these proceedings are identical. Not surprisingly then both parties' evidence concentrates on the similarity or otherwise in the competing goods. While I have included background information in my evidence summary to provide context, I have concentrated on what I consider to be the main points in the evidence which go to the similarity or otherwise of the goods in Life's registration and those that remain in DCK's application.

### **Life's evidence-in-chief**

9. This consists of a witness statement, dated 2 November 2009, from Neil Butler who is Life's Finance Director, a position he has held since February 2002. Mr Butler confirms he is authorised to speak on Life's behalf and explains that the information in his statement comes from either his own knowledge or company records.

10. Mr Butler explains that Life's core business is the design and supply of a range of branded products to UK retailers and distributors elsewhere in the world. He adds that a common feature of these products is that they are of benefit for use in travel and outdoor activities, although none are designed exclusively for such uses and most have a wide range of domestic applications.

11. He states that Life's products include: travelling bags, luggage, holdalls, bags, shoulder bags, toilet bags, carrier bags, rucksacks, backpacks, bumbags, sports bags, casual bags, notecases, notebook holders, document cases and holders, wallets, umbrellas, belts and belt packs. He adds that for many years Life have also promoted a variety of personal child carrying devices and personal child carrying rucksacks under a number of trade marks including FREEDOM and LITTLELIFE.

12. Mr Butler then turns his attention to the comments in DCK's counterstatement. In response to their comment that the average consumer would not expect a manufacturer of Life's goods to also produce the goods of DCK, he provides at exhibit NB1 a copy of

Life's Price List from spring/summer 2010. I note that this list includes references to a wide range of goods including Bags and Luggage, Washgear, On the Move, Security, and Child Carriers. While the goods sold under the first four headings appear to be sold under the trade mark LIFEVENTURE (+ device), some of the goods also appear to be sold under trade marks of their own for example, "Altai 60+15 Travel Pack (Brown)", "Kohima 65 Large Wheelie Bag (Green)", "Dakar 20 Daysack (Green)". Other goods sold under the LIFEVENTURE (+ device) trade mark are described generically e.g. "Wash bag - Small (Black & Blue)", "Pocket Wallet (Black & Orange)", "Multi-Document Case (Black & Orange)" "Digital Hard Case – Large (Black & Orange)." The child carrier which appears to be sold under the LittleLife (+ device) trade mark is described as "Freedom Child Carrier (Green/Charcoal)" and carries a trade price (excluding VAT) of £67.63 and an average selling price (including VAT) of £139.99.

13. Mr Butler states that Life's products are sold and promoted in more than 500 retail outlets and by on-line retailers throughout the United Kingdom. He explains that many of these retailers such as Mothercare, Wiggle (an online retailer of cycles), TK Maxx and John Lewis sell a range of the goods in DCK's application alongside child carrying devices. In support he provides as exhibit NB2 pages downloaded from [www.mothercare.com](http://www.mothercare.com) on 23 October 2009, [www.wiggle.co.uk](http://www.wiggle.co.uk) on 2 November 2009 and [www.johnlewis.com](http://www.johnlewis.com) also on 23 October 2009. Of these pages he says:

"a. Pages from the website of Mothercare...showing a range of child carrying devices as well as bags, backpacks, purses and umbrellas being offered for sale by the same retailer."

b. Pages from the website of Wiggle...showing a range of LITTLELIFE daysack bags and child carrying devices, including the FREEDOM child carrier as well as courier bags, rucksacks, travel bags and waist bags being offered by the same retailer.

c. Pages from the website of John Lewis....showing a range of LITTLELIFE daysack bags and child carrying devices, including the FREEDOM back carrier, as well as a broad range of backpacks, school bags, sports bags, hampers, handbags and travel bags being offered for sale by the same retailer."

On the basis of this evidence Mr Butler concludes that the respective trade channels and sales outlets of the competing goods are the same.

14. Insofar as DCK claim that child carriers will typically incorporate a rigid frame, Mr Butler says that this is not correct. He explains that Life used to sell a front child carrier (the FREEDOM Front Carrier) that had no rigid frame and adds that this is still available through some outlets. In support he provides at exhibit NB3 a page downloaded from the website [www.aktive8.com](http://www.aktive8.com) on 29 October 2009 in which the Freedom Front Carrier is shown. In addition, he points out that that the "carrying slings" mentioned in Life's registration do not have a frame. He concludes that:

“Contrary to DCK’s claims, none of these features of construction differentiate child carrying devices from the various types of bag included in the goods of the application as these construction features may apply to any of those products.”

15. Mr Butler says that DCK are wrong when they claim that the intended purpose of the competing goods are different i.e. that the goods contained in their application are designed to hold a number of miscellaneous items. The same is, he says, true of many child carrying devices which also double as bags. Most child carriers are, he explains, designed with substantial storage capacity and this is specifically promoted as a feature by Life and other suppliers of these products. In support he provides at exhibit NB4 pages taken from Life’s LittleLife 2010 catalogue in which he identifies that (a) the VOYAGER S2 child carrier features a detachable daysack in addition to built-in storage products and a total of 26 litres of storage capacity, and (b) the current FREEDOM child carrier has storage pockets offering a 25 litre capacity. Exhibit NB5 is in the same vein and consists of pages downloaded on 28 October 2009 from the website [www.littleadventureshop.co.uk](http://www.littleadventureshop.co.uk) which contains references to (a) the Bushbaby Elite Baby Carrier which features a detachable bag and built-in storage bags and pockets, (b) the Vaude Butterfly Comfort Baby Carrier which features a zipped storage compartment, and (c) The Deuter Kid Comfort II Child Carrier with storage capacity of 18 litres.

16. Mr Butler provides exhibits NB6 and NB7 in relation to the material from which the competing goods can be made and their relative cost. While it is fair to say these exhibits were filed primarily to show that Life’s goods may be made from or incorporate leather, and that the cost of goods such as handbags, wallets and briefcases (which are traditionally made of leather) can be less expensive than the cost of a child carrier, they confirm what one would expect i.e. that the cost of the competing goods (whether made from leather or not) are likely to vary.

17. Mr Butler notes by reference to exhibit NB9 which consists of extracts taken from the Collins on-line dictionary on 28 October 2009, that “backpack” is defined as: “n a rucksack” and that the same source defines “rucksack” as: “n (Brit Austral S African) a large bag with two straps carried on the back, from German.”

18. Mr Butler concludes his statement in the following terms:

“As indicated above, none of the characteristics of purpose, construction, flexibility, presence or absence of a rigid frame, substantial enclosure of contents or ability to hold a variety of different items differentiates the Opponent’s goods from bags, shoulder bags, rucksacks or backpacks. Any child carrier, bag, shoulder bag, rucksack or backpack may or may not be of flexible construction, have a rigid frame, be able to substantially enclose contents and hold a variety of different items...”

## **DCK's evidence-in-chief**

19. This consists of a witness statement, dated 20 December 2009, from Ian Byrne DCK's Finance Director, a position he has held since 1997. Mr Byrne confirms he is authorised to speak on DCK's behalf and explains that the information in his statement comes from either his own knowledge or company records. Having explained that DCK filed a Form TM21 to amend their specification of goods, he says of the comparison between the goods which remain in DCK's application and those of Life:

"4. In my opinion, there is a fundamental difference between the goods now covered by [the application] and those covered by the opponent's earlier mark. Whilst the opponent may try and argue that their goods are more akin to rucksacks and backpacks their goods are in fact "child carriers" (as referred to in their price list and in their catalogue) or "baby carriers" (as described by Mothercare on their website) or even "baby back carriers" (as described by John Lewis on their website). These goods are clearly distinguishable from the goods covered by [the application] by the relevant consumer due to their very different uses. The relevant consumer would not expect a bag manufacturer to also produce a range of baby or child carriers.

5. Whilst the opponent has pointed out that shops such as John Lewis sell both bags and baby carriers, in the actual shops, these goods would be located in completely different parts of the shop, with "bags" being sold in either the "bag/purse department" or the "luggage department" and "baby carriers" being sold in the "Baby/children's department". Therefore, the two different types of goods would not be physically close to one another within the shop and the relevant consumer would not expect to find or look for baby carriers in either the luggage or bag department because their main intended uses are so different."

## **Life's evidence-in-reply**

20. This consists of a further witness statement, dated 3 March 2010, from Mr Butler. Mr Butler states that contrary to Mr Byrne's comments in his paragraph 5 above, personal child carrying devices are routinely promoted by retailers under the same category as "luggage", "bags", "packs", "backpacks" and "rucksacks". In support, he provides as exhibit NB11 pages from the following websites all of which appear to have been downloaded on 2 March 2010:

- a. A page from [www.ellis-brigham.com](http://www.ellis-brigham.com) in which "Packs", "Rucksacks", "Child Carriers" and "Luggage" are offered for sale in the same section of the online shop.
- b. Pages from [www.snowandrock.com](http://www.snowandrock.com) in which "Rucksacks" and "Child Carriers" are offered under the "Bags" section of the online shop.



- c. A page from [www.nevisport.com](http://www.nevisport.com) showing “Child carriers and Cots” being offered for sale alongside a range of “Backpacks”, “Daypacks and Urban Bags”, “Shoulder Bags, Waist Packs”, “Travel Luggage & Duffels”, “Travel and Utility Wallets” and “Dry Bags & Rain Covers” in the “Backpacks, Luggage” section of the online shop.
- d. A page from [www.v12outdoor.com](http://www.v12outdoor.com) in which “Kiddy Carriers” are sold alongside “Climbing Packs”, “Daypacks/Walking Packs”, bags for “Travel & Business” in the “Rucksacks” section of the online shop.
- e. A page from [www.cotswoldoutdoor.com](http://www.cotswoldoutdoor.com) in which “Baby Carriers” are offered for sale alongside, inter alia, “Bumbags”, “Daypacks”, “Duffles & Bags”, “Rucksacks”, “Travel Packs”, “Wheeled Luggage” and “Women’s Daypacks/Rucksacks” in the “Backpacks & Rucksacks” section of the online shop.

21. As further evidence that retailers do display bags and baby carriers close to each other in the same part of the shop, Mr Butler provides as exhibit NB12 three photographs taken at (a) Ellis Brigham in London, (b) Summit Outdoor Leisure in Portishead, and (c) Taunton Leisure in Bedminster. While Mr Butler does not say when the pictures were taken, given that they have been filed to counter comments made by Mr Byrne in DCK’s evidence in chief, I presume that like most if not all of Life’s evidence they are from after the material date in these proceedings. That said, I note that Mr Butler says that these photographs show:

- (a) “child carriers displayed beneath duffle and shoulder bags and alongside other bags and backpacks of various descriptions”;
- (b) “child carriers displayed beneath and near to various types of bags and backpack”;
- (c) “child carriers displayed next to bags of various types located on the adjacent display.”

22. Mr Butler states that once again contrary to the comments in Mr Byrne’s statement many suppliers of bags of various types also supply child carriers under the same brand. In support, he provides as exhibit NB13 pages from the following websites all of which were downloaded on either 2 or 3 March 2010:

- a. A page from [www.deutergb.co.uk](http://www.deutergb.co.uk) in which a range of child carriers, backpacks together with what appears to be a more general purpose bag are being promoted under the Deuter brand.
- b. Pages from [www.vaude.com](http://www.vaude.com) in which a range of child carriers, backpacks and more general purpose bags are being promoted under the Vaude brand.

- c. A page from [www.bush-baby.com](http://www.bush-baby.com) in which a range of child carriers and daysacks are being promoted under the bush baby brand.
- d. Pages from [www.outdooraction.co.uk](http://www.outdooraction.co.uk) and [www.karrimor.com](http://www.karrimor.com) in which a child carrier and a range of backpacks are being promoted under the Karrimor brand.
- e. A page from [www.cotswoldoutdoor.com](http://www.cotswoldoutdoor.com) in which a child carrier and a rucksack are being promoted under the Macpac brand.
- f. A page from [www.kelty.com](http://www.kelty.com) in which it appears that a range of child carriers and backpacks are promoted under the Kelty brand.
- g. A page from [www.bagsdirect.com](http://www.bagsdirect.com) in which a holdall, clutch bag, messenger bag and baby carrier are promoted under the Samsonite brand.

23. Based on this evidence Mr Butler says:

“In light of this fact, the relevant consumer would consider it likely that a bag manufacturer also produces baby or child carriers.”

24. That concludes my summary of the evidence to the extent that I consider it necessary.

## **DECISION**

25. The opposition is based upon sections 5(1) and 5(2)(a) of the Act which read as follows:

“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)...

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

26. 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.”

27. In these proceedings Life is relying on the registered trade mark shown in paragraph 2 above which has an application date prior to that of the application for registration; as such, it qualifies as an earlier trade mark under the above provisions. The application for registration was published for opposition purposes on 13 February 2009 and Life’s earlier trade mark was registered on 30 November 2004. As Life’s earlier trade mark had not been registered for five years at the point at which DCK’s application was published, it is not subject to The Trade Marks (Proof of Use, etc) Regulations 2004.

### **Comparison of trade marks**

28. DCK admit that the respective trade marks are identical; I agree and shall proceed on that basis.

### **The average consumer and the purchasing act**

29. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods; I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. The goods at issue in these proceedings are (insofar as DCK’s application is concerned) bags of one sort or another, credit card cases and holders, wallets and purses. The specification of Life’s registered trade mark is shown above and should, in my view, be construed as:

Personal child carrying devices; personal child carrying slings and (personal child) carrying rucksacks; infant and baby-carrying slings and (infant and baby carrying) rucksacks

30. This appears to be consistent with Mr Butler’s view of the matter (see for example the quotation at paragraph 40 below). As both parties’ goods are everyday consumer items that will be bought by the public at large, they then are the average consumer for such goods.

31. The evidence provided by Life confirms my own experience of how these type of goods will be purchased i.e. their selection is most likely (initially at least) to consist of a

visual act made on the basis of self selection in either a retail environment, from a catalogue or on-line; the comments of the Appointed Person in *React Trade Mark* [2000] RPC 285 (albeit in relation to items of clothing) are relevant here. Whilst this is likely, in my view, to be the principal means by which the goods are selected, I do not rule out that as orders may also be placed by telephone, aural considerations will play a part in the selection process.

32. There are (as DCK's specification demonstrates) many different types of bags; bags which in turn are used for a wide variety of different purposes. A brief review of DCK's specification mentions general purpose bags, luggage and holdalls, as well as bags whose specific purpose ranges from carrying toiletries, sheet music or clothing. DCK's specification also includes a range of well known items such as wallets, purses and credit card holders. Life's specification is more limited relating as it does to a range of child carrying devices.

33. As the evidence demonstrates the cost of the various goods is likely to vary from quite modest sums to many hundreds of pounds. When selecting the goods in DCK's application the average consumer is likely, in my view, to be conscious of, inter alia, its cost, its design, its material, its size, its colour and ultimately if it is suitable for the purpose for which they intend to use it. While similar considerations are also likely to apply to the selection of Life's goods, I think the average consumer will also be conscious of, inter alia, the product's suitability for the size of child to be carried, the product's safety features and how comfortable the product is when worn both for the wearer and (insofar as it was possible to discern) for the passenger. All of these factors point, in my view, to the average consumer paying a reasonable level of attention when selecting DCK's goods and, if anything, a somewhat higher level of attention when selecting the goods of Life.

**Comparison of goods**

34. The goods to be compared are as follows:

<b>DCK's goods</b>	<b>Life's goods</b>
Trunks and travelling bags; travel cases; luggage; suitcases; holdalls; bags; handbags; shoulder bags; toilet bags; carrier bags; briefcases; attaché cases; music cases; satchels; beauty cases; carriers for suits, for shirts and for dresses; tie cases; notecases; notebook holders; document cases and holders; credit card cases and holders; wallets; purses; parts and fittings for all the aforesaid	Personal child carrying devices; personal child carrying slings and rucksacks; infant and baby-carrying slings and rucksacks

35. The leading authorities on how to determine similarity between goods and services are considered to be *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C.

117 and *British Sugar Plc v James Robertson & Sons Ltd (Treat)* [1996] R.P.C. 281. In the first of these cases the ECJ accepted that all relevant factors should be taken into account including the nature of the goods/services, their intended purpose, their method of use and whether they are in competition with each other or are complementary. The criteria identified in the *Treat* case were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market.
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services 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 or services in the same or different sectors.

36. Insofar as complementary goods and services are concerned, I will keep in mind the comments of the Court of First Instance (now the General Court) in Case T-420/03 – *El Corte Inglés v OHIM- Abril Sanchez and Ricote Sauger* (Boomerang TV). The court said at paragraph 96:

“96.....Goods or services which are complementary are those where there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for the production of those goods or provision of those services lies with the same undertaking (Case T14 169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, and judgment of 15 March 2006 in Case T-31/04 *Eurodrive Services and Distribution v OHIM – Gomez Frias* (euroMASTER), not published in the ECR, paragraph, paragraph 35.”

37. Whilst I noted in my evidence summary that all of Life's evidence was from after the material date in these proceedings, I also note that DCK did not take issue with this aspect of Life's evidence. Given the relative proximity of the dates of the documents in Life's exhibits to the date of DCK's application (most are from October 2009 to March 2010 whereas DCK's application was filed in December 2008), I intend to proceed on the basis that the state of the relevant market was likely to be much the same prior to the material date as it was after it (there is certainly no evidence or submissions to the

contrary). For the sake of completeness, I should also say that the vast majority of Life's evidence clearly relates to the position in the United Kingdom.

38. In their counterstatement DCK argue, inter alia, that the competing goods are: (i) of a very different nature, (ii) are neither in competition with or complementary to one another, (iii) meet very different needs, (iv) are constructed differently, (v) have different trade channels and sales outlets and (vi) would not be manufactured by the same entities.

39. Life sought to address these points in their evidence. In reaching a conclusion on the similarity in the competing goods, I will keep in mind the considerations mentioned in the *Canon* case and the criteria identified in the *Treat* case (many of which are the same). In their counterstatement and written submissions respectively the parties have drawn my attention to two decisions of The Office For Harmonization in the Internal Market (OHIM) dated 23 July 2007 (Opposition No. B716987) and 12 September 2007 (Opposition No. B992893) which deal with, inter alia, the similarity in the goods at issue. Not surprisingly, each decision supports their own view of the matter. While I agree with Life that I am not bound by decisions taken at OHIM, as the Appointed Person Professor Annand pointed out in BL O-217-10 neither should I ignore them if the same facts are involved. However, as OHIM appear to have arrived at different decisions in quite similar circumstances, neither decision assists me greatly and I propose to reach my own view of the matter.

40. I should however start by dealing with the evidence provided by Life at exhibit NB9 which consists of the extracts from the Collins on-line dictionary indicating that a "backpack" is defined as a "rucksack" and a "rucksack" is defined as "a large bag with two straps carried on the back." In his evidence Mr Butler says of these entries:

“..which confirms that the child, infant and baby-carrying rucksacks of the opponent's goods are also bags and thus identical to the "bags" of the application.”

41. While I am conscious of the comments in *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267 to the effect that words appearing in specifications should not be given an unnaturally narrow meaning, I am equally conscious of the comments of Jacob J (again from *Treat*) when he said that in construing words in specifications:

“one is concerned with how the product is, as a practical matter, regarded for the purposes of trade.”

42. In those circumstances and notwithstanding the dictionary definitions provided, I do not think that the average consumer would describe any of the child carrying devices in Life's registration as bags, and I intend to conduct my further analysis of the competing goods with that conclusion in mind.

**(a) The uses/intended purpose of the respective goods**

43. At a high level of generality both sets of goods are used to allow the average consumer to carry something. Insofar as Life's goods are concerned their principal use is for carrying a child, infant or baby, whereas DCK's goods are of a more general nature and will be used to carry the sort of items identified by them in paragraphs 8b-h of their counterstatement (paragraph 4 above refers). While Life have provided evidence at exhibits NB4 and NB5 which indicates that child carrying devices also have storage capacity (and on occasion a detachable bag) and that these are the sort of features which are specifically promoted by both them and other suppliers of the goods, it appears to me that when considered from the average consumer's perspective the intended purpose of Life's goods are quite different to those goods which remain in DCK's application.

**(b) The respective users of the respective goods**

44. While the users of both parties' goods will at a very high level of generality be the same i.e. a member of the public, that is, in my view, an unrealistically broad view of the matter. Rather, the user of the goods will be circumscribed by the use to which the goods are put. On this basis, the needs of an average consumer wishing to purchase a music case would be quite different to the needs of an average consumer wishing to purchase, for example, a carrier for clothing or a device for carrying a child.

**(c) The physical nature of the goods**

45. In their counterstatement DCK comment on what they consider to be the different construction of the goods pointing in particular to the ergonomic construction, rigid frame, shaped seat and openings for the arms and legs inherent in Life's goods, which are not present in their own goods. In response, Life point out that their registration includes "slings" which do not have a rigid frame, and at exhibit NB3 they provide an example of their own front child carrier as an example. From the evidence provided, it appears that the method of construction and materials from which a child carrier are made are likely to be similar to some of the goods in DCK's application.

**(d) The respective trade channels through which the goods reach the market**

46. It is, I think, fair to say that it is in response to DCK's comments regarding the manufactures of the competing goods, the trade channels and sales outlets through which the goods reach the market that Life have filed the bulk of their evidence. Life's evidence indicates that not only they (exhibit NB1) but other manufacturers of child carrying devices also produce a range of bags which are sold under the same brand (exhibit NB13). While Life have shown (not surprisingly in my view) that some retailers sell both parties' goods, they have also filed evidence (exhibits NB11 and NB12) which indicates that Life's goods are promoted by retailers under the same categories as some of DCK's goods and that in certain circumstances they may appear next to one another in shops.

**(f) The extent to which the respective goods are competitive.**

47. In my view it cannot be realistically argued that any of DCK's goods compete with Life's goods. The average consumer would not, for example, consider buying a holdall or shoulder bag instead of a child carrier or vice versa.

**(g) Are the goods complementary?**

48. The case law indicates that for goods to be considered complementary they must be:

“..indispensable or important for the use of the other in such a way that customers may think that the responsibility for the production of those goods or provision of those services lies with the same undertaking.”

49. While I accept that the competing goods may be provided as part of a co-ordinated range this is not enough to make them complementary. I can see no symbiotic relationship between any of the competing goods in the terms described by the General Court.

50. In reaching a conclusion on the overall similarity in the goods and having rejected Life's identity argument based on their backpack/rucksack/bag analysis, it is now necessary for me to weigh up all of my conclusions reached above. Following the amendment to DCK's specification Life were, in my view, somewhat optimistic in maintaining that the goods in their registration were similar to all of those which remained in DCK's application. For example, I find it hard to envisage any meaningful degree of similarity between Life's goods and, for example, music and tie cases in DCK's application. That said, I accept that there is some similarity in the physical nature of some of the competing goods and in the companies that produce them, and also in the trade channels and sales outlets through which Life's goods and some of DCK's goods may reach the market. However, notwithstanding these similarities the users and importantly the use to which the competing goods are put are (on the basis I have described above) likely to be quite different and the respective goods neither competitive with nor complementary to one another. While there are similarities in the areas I have identified, these similarities are, in my view, much less important than the significantly different purpose to which the competing goods will be put. In summary, if there is any meaningful similarity at all between Life's goods and those of DCK it must be at a low level.

**Distinctive character of Life's earlier trade mark**

51. I must now assess the distinctive character of Life's earlier trade mark. Although Life filed evidence in these proceedings, this evidence was primarily directed at establishing what they consider to be the similarity in the respective parties' goods. No evidence has been filed to explain when they began using their FREEDOM trade mark, nor have any



turnover or promotional spend figures been provided. In those circumstances I can only consider the trade mark's inherent characteristics. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of 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. I note that that The Oxford Dictionary of English (revised edition), 2005 defines Freedom as inter alia:

“the state of being unrestricted and able to move easily: the shorts have a side split for freedom of movement.”

52. Bearing that definition in mind in the context of the goods for which Life's trade mark is registered e.g. child carrying devices of one sort or another, the word FREEDOM is likely, in my view, to be seen by the average consumer as an allusion (and a none too subtle one at that), to a potential characteristic or benefit of the goods i.e. they will allow the user freedom of movement. In those circumstances Life's trade mark is, in my view, possessed of only a very limited degree of inherent distinctive character.

### **Identical trade marks and goods/ Likelihood of confusion**

53. Having rejected Life's argument regarding the identical nature of its goods to some of DCK's goods, it follows that Life's ground of opposition based on section 5(1) of the Act must fail. However, my finding that there is a low level of similarity between Life's goods and some of the goods in DCK's application, means that I must now go on and consider the likelihood of confusion under section 5(2)(a) of the Act. 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. I must also keep in mind the distinctive character of Life's trade mark, as the more distinctive it is the greater the likelihood of confusion. I must also consider the average consumer for the goods, the nature of the purchasing process and remember the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them they have retained in their mind.

54. The trade marks at issue are identical but there is only a low level of similarity in respect of some of the competing goods. In addition, the word FREEDOM is a common English word whose meaning will be well known to the average consumer, and which in relation to Life's goods has only a very limited degree of inherent distinctive character. Bearing that in mind, together with what I consider to be the significantly different uses to which the competing goods will be put, combined with what will be (at the very least)

the reasonable level of care taken by the average consumer when selecting the goods, I do not believe (despite the fact that the trade marks are identical) that the average consumer will assume that the goods of DCK are those of Life or come from an undertaking linked to Life. Consequently, the opposition based on section 5(2)(a) of the Act also fails as does the totality of the opposition.

### **Costs**

55. As DCK have been successful they are entitled to a contribution towards their costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, I award costs to DCK on the following basis:

Preparing a statement and considering the other side's statement:	£400
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Preparing evidence and considering and commenting on the other side's evidence:	£600
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<b>Total:</b>	<b>£1000</b>
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56. I order Lifemarque Limited to pay to D.C.K. Concessions Limited the sum of £1000. 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 23 day of July 2010**

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