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Treasury Solicitor's Office
One Kemble Street,
London,
WC2B 4TS.

Wednesday, 21st September 2011

B e f o r e:
MR. GEOFFREY HOBBS QC
(Sitting as the Appointed Person)

In the Matter of the TRADE MARKS ACT 1994

- and -

In the Matter of Application No. 2525533 in the name of
by ROOTICAL DUBBER ENTERPRISES LTD. to register the trade mark
FREEITY

- and -

In the Matter of Opposition thereto under No. 99990 by Barbara
Garduno, also known as 'Nina'

- and -

An appeal to the Appointed Person from the decision of
MR. EDWARD SMITH acting on behalf of the Registrar,
dated 26th April 2011.

(Computer-aided Transcript of the Stenograph Notes by
Marten Walsh Cherer Limited, 1st Floor, Quality House,
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MR. ROWLAND BUEHRLLEN and MR. DUNCAN MORGAN (of Messrs.
Beck Greener) appeared for the Appellant/Applicant.

MS. JESSIE BOWHILL (instructed by Hogan Lovells LLP) appeared for
the Respondent/Opponent.

D E C I S I O N
(AS APPROVED BY THE APPOINTED PERSON)

1 THE APPOINTED PERSON: On 7th September 2009 Rootical Dubber
2 Enterprises Limited applied under number 2525533 to register
3 the sign FREEITY as a trade mark for use inter alia in
4 relation to "clothing, footwear, headgear" in Class 25. The
5 application was subsequently opposed by Barbara Garduno, also
6 known as "Nina", under section 5(2)(b) of the Trade Marks Act
7 1994. Ms. Garduno opposed the application in her capacity as
8 proprietor of Community trade mark number 4192944 FREE CITY
9 registered on 27th October 2006 for use inter alia in relation
10 to " clothing, footwear and headgear" in Class 25.

11 In essence, the question for determination under section
12 5(2)(b) was whether there were similarities in terms of marks
13 and goods which would combine to give rise to the existence of
14 a likelihood of confusion if the earlier mark and the later
15 sign were used concurrently in the United Kingdom in relation
16 to goods of the kind for which they were respectively
17 registered and proposed to be registered in Class 25.

18 The opposition succeeded and the application for
19 registration was refused for the reasons given by Mr. Edward
20 Smith on behalf of the Registrar of Trade Marks in a written
21 decision issued under reference BL O-139-11 on 26th April
22 2011. The hearing officer approached the assessment on the
23 basis that the applicant's mark was most likely to be
24 pronounced, hence seen and remembered, as FREE-ITEE. I agree
25 with that approach. He considered that the mark and the sign

1 were visually "highly similar" (paragraph 32) and phonetically
2 "similar to a reasonable degree" (paragraph 33) but
3 conceptually neither "dissonant" nor "alike or similar"
4 (paragraph 36).

5 With regard to the overall degree of similarity between
6 the marks, the hearing officer observed as follows:

7 "37. At this point I need to make a finding in respect
8 to 'overall impression' of the respective marks, having
9 regard to any distinctive, dominant elements. Neither
10 mark is 'complex', in terms of it having multiple
11 elements which may not have equal distinctiveness and/or
12 dominance.

13 38. The critical question in this case is whether the
14 absence of any finding, as far as conceptual similarity
15 is concerned, is sufficient to counteract the findings
16 as far as visual and phonetic similarities are
17 concerned. There is a strand of authority derived from
18 European authorities in particular, which may suggest
19 this can be the case, e.g. General Court Case T-292/01
20 Phillips-Van-Heusen Corp. v OHIM, para 54 ('Phillips').
21 That said, there is always a danger to deriving an
22 immutable legal principle from a case invariably decided
23 on its own facts and circumstances. Such cases do not
24 say, emphatically, that in all cases an absence of
25 conceptual similarity (or, as in this case, any finding
 at all) will outweigh or counteract visual and phonetic
 similarity. It may do.

19 39. In this particular case, I believe there is another
20 factor which plays a part in my overall assessment of
21 similarity of marks from the average consumer's
22 perspective, and that is that the human eye tends to see
23 what the brain expects it to see. That is to say, that
24 the word 'FREEITY' has no obvious meaning and may well,
25 as I have said, be pronounced in different ways.
 Because of its length, the possibility that it may be
 an acronym or abbreviation, let alone the one intended
 by the applicant, is remote. It is quite possible then,
 that some average consumers may well actually try to
 make some sense of it, arriving at the words
 'FREE CITY', especially if they merely glance briefly at
 the word, as, e.g. in particular, in an internet
 scenario. This factor is something recognised in the

1 authorities also, most recently in OCH-ZIFF Management
2 Europe Ltd and OZ Management LP v OCH Capital LLP and
3 others [2010] EWHC 2599 (Ch), para 120. As with the
4 Phillips case above however, I am not saying that such a
5 factor will always and inevitably take precedence over
6 other, possibly competing, factors. I am merely saying
7 that in this particular case and in my view such a
8 factor has some relevance. I have already said, for
9 example, that clothing is primarily a visual selection,
10 and that use on the internet is a factor to be
11 considered. It is also the case that the earlier mark
12 is not a single, short word of obvious meaning, but
13 rather, two words conveying slightly less clear meaning
14 when used in combination and, with the exception of the
15 absence of the letter 'c', the later mark is absolutely
16 identical in the letters used and their order.

17 40. In all the circumstances, taking the visual, aural
18 and conceptual assessments overall, I find the
19 respective marks share a high degree of similarity."

20 His assessment of the likelihood of confusion led him to
21 uphold the opposition on the following basis:

22 "44. At this point I need to remind myself of my various
23 findings and bring them together in a global assessment
24 taking into account the doctrine of imperfect
25 recollection, namely that consumers rarely have the
26 opportunity to compare marks side by side.

27 45. I have found that the respective goods are
28 identical. I have found the earlier marks to be
29 distinctive on a moderate level. I have made
30 observations on the respective average consumers, namely
31 that they are also identical and I have found the
32 purchasing process to involve considered purchasing,
33 based predominantly upon visual inspection but not
34 ignoring aural and conceptual factors. Finally, I have
35 found the respective marks to share a high degree of
36 similarity. Needless to say that in making a global
37 assessment, it is not a 'tick box' exercise, whereby if
38 I find more factors in Ms. Garduno's favour, she wins.
39 All factors must be weighed in the evaluation of
40 likelihood of confusion.

41 46. Nonetheless, in all the circumstances I find there
42 is a likelihood of confusion in this case and the
43 opposition is successful in its entirety."

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The applicant for registration was ordered to pay £1,200 to the opponent as a contribution towards her costs of the proceedings in the registry.

The applicant appealed to an appointed person under section 76 of the 1994 Act contending in substance that the hearing officer's decision was vitiated by his failure to recognise and accept that FREE CITY and FREEITY are visually, phonetically and conceptually dissimilar to a high degree as a result of FREEITY being a single, meaningless, invented word which lacks the capacity to convey any connotations identical or similar to those conveyed by the linguistically meaningful words FREE CITY. This contention was developed in argument at the hearing before me. The argument was supported by reference to a number of decisions of the supervising courts in Luxembourg, in which it was held that the visual and aural similarities between the marks in issue in those cases were insufficient to give rise to the existence of a likelihood of confusion due to the degree of conceptual dissimilarity between them. The opponent maintained that the hearing officer's determination was correct for the reasons he gave.

I can begin with two observations which I believe to be uncontroversial. First, it is well-established that the decision taker must give as much or as little significance to the visual, aural and conceptual differences and similarities

1 between the marks in issue as an average consumer of the
2 relevant goods would have attached to them at the date of the
3 opposed application for registration. Second, it is equally
4 well-established that conceptual similarity may diminish the
5 significance of visual and aural differences and that visual
6 and aural similarities may pale into insignificance as a
7 result of conceptual dissimilarity.

8 In the case law, to which I was referred it is pointed
9 out that conceptual dissimilarity can exist either as a result
10 of the marks in issue having clearly different and distinct
11 meanings or as a result of one of them having a clear and
12 distinct meaning and the other of them being clearly and
13 contrastingly meaningless. I see nothing particularly
14 surprising in that approach to the notion of conceptual
15 dissimilarity, however, it does not exclude the possibility
16 that a likelihood of confusion may be found to exist upon the
17 basis which the hearing officer appears to have regarded as
18 decisive in the present case.

19 As I interpret the observations made in paragraph 39 of
20 his decision, in the context of the decision as a whole, his
21 conclusion as to the existence of a likelihood of confusion
22 was based upon a finding that FREEITY was liable to be seen,
23 heard and conceptualised by the relevant average consumer as a
24 misspelling of FREE CITY. It follows, in my view, that the
25 questions raised by the present appeal are: whether it was

1 open to the hearing officer to make that finding and, if so,
2 whether it is a finding on the basis of which he could
3 properly have come to the conclusion he did with regard to the
4 existence of a likelihood of confusion.

5 I am satisfied that there is enough visual, aural and
6 conceptual similarity between the words FREEITY and FREE CITY
7 to lead to the former being perceived as a misspelling of
8 FREE CITY among consumers of the relevant kind who either knew
9 or had heard of the use of the latter. I think that is liable
10 to occur as a result of the degree to which the marks rhyme
11 and chime with one another around and about the element "FREE"
12 and the natural tendency of the human mind to make sense of
13 words (in this case FREEITY) which seem to correspond largely
14 but not entirely with more meaningful words (in this case
15 FREE CITY). However, the question of whether the perception
16 of misspelling would be conducive to the existence of a
17 likelihood of confusion is more debatable.

18 As the hearing officer noted in his summary of the
19 applicable legal principles in paragraph 26 of his decision,
20 mere association, in the sense that the later mark brings the
21 earlier mark to mind, is not sufficient to substantiate an
22 objection under section 5(2)(b), but if the association
23 between the marks causes the public to wrongly believe that
24 the respective goods come from the same or economically linked
25 undertakings, there is a likelihood of confusion within the

1 scope of that objection.

2 The proposition that relevant consumers are liable to
3 think of FREEITY as a misspelling of FREE CITY undoubtedly
4 envisages the making of an association or link between the two
5 signs. It is an association or link which tends to result in
6 a bracketing together of the signs with an attendant potential
7 for the synchronisation of identities in a manner which could
8 quite easily give rise to the kind of conflict at which
9 sections 5(3) and 10(3) of the Act are directed, but that does
10 not necessarily carry with it the risk of a likelihood of
11 confusion.

12 The hearing officer's reasoning in relation to this
13 aspect of the assessment is very thin. He was evidently
14 satisfied on the basis of a global appreciation of all the
15 factors he had identified that the objection to registration
16 was made out. I have hesitated over this aspect of the case.
17 In the end, I have come to the view that he can be taken to
18 have made his decision with proper regard for the legal
19 principles to which he had referred and that the association
20 or link he was envisaging was therefore one which was liable
21 to result in a mixing or switching of identities in a context
22 and manner giving rise to the existence of a likelihood of
23 confusion.

24 I am not prepared to say that this was a decision which
25 was not open to him, even though his reasons for reaching it

