

## TRADE MARKS ACT 1994

### IN THE MATTER OF AN APPLICATION BY BEN JAMES TO REGISTER TRADE MARK NO 2306188 IN CLASSES 9 AND 25

#### BACKGROUND

1. On 24 July 2002 Mr Ben James of 9A Copleston Road, London, SE15 4AN applied under the Trade Marks Act 1994 for registration of the trade mark:

*Ben James* |

in respect of:

Class 9            Optical contact lenses, spectacles and sunglasses.

Class 25           Clothing, Footwear, Headgear.

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

NUMBER	MARK	GOODS	DATE
2161756	BENJAMIN JAMES	Ties, but not including knitted ties.	20.03.2003
885913 w	BENJAMIN JAMES	Articles of clothing; articles of mens clothing; ties, cravats, cummerbunds and waistcoats; scarves.	22.07.1998

w Community Trade Mark Registration

3. A hearing was held on 29 January 2003 at which the applicant appeared in person. At the hearing the objection under Section 5(2) of the Act was maintained and Notice of Final Refusal was issued on 13 February 2003. I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Marks Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.

4. No evidence has been put before me, therefore no claim under Section 7 of the Act has been made.

## DECISION

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

*“5.-(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.”*

6. An earlier trade mark is defined in Section 6(1) which states:

*“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,”*

7. 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] E.T.M.R. 1, *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 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 224;
- (h) 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.

### **Distinctive character of the earlier trade marks**

8. It is clear from the ECJ's judgment in the case of *Sabel BV v Puma AG* that the likelihood of confusion may be increased where the earlier trade mark has a highly distinctive character.
9. The earlier trade marks are registered trade marks and are therefore deemed to be valid (Section 72 of the Act refers). Both of these marks are for the words BENJAMIN JAMES which, when presented in combination, form a full name ie a forename and surname. In Practice Amendment Circular (PAC) 6/00 the Registrar set out guidelines for the examination of Surnames, Forenames and Full Names. For ease of reference a copy is attached at Annex A. I note the guidance provided at paragraph 20 which states:

#### **“Full names - surnames with forename(s)**

20. Full names have, by their nature, a greater capacity to distinguish the goods/services of one undertaking than a surname per se. The Registrar takes the view that, unless the full name is extremely common, eg JOHN SMITH *and* the number of traders involved in the relevant market is large, eg clothing, the average consumer is likely to expect the goods/services provided under the name to originate from the same undertaking. Such marks will therefore usually be accepted *prima facie*.”
10. Although both of the earlier trade marks are registered for clothing I do not consider the full name BENJAMIN JAMES to be “*extremely common*” to the extent that it possesses no

distinctive character. In my view both earlier trade marks possess a low but sufficient level of distinctive character per se.

### **Similarity of the goods**

11. The applicant has applied for registration of his trade mark in Classes 9 and 25. There is no conflict with the applicant's goods in class 9 and consequently there is no objection in this class. As far as the applicant's application in class 25 is concerned the specification applied for is:

*“Clothing, footwear, headgear.”*

12. It is clear from the applicant's specification in Class 25 that there is a direct conflict with the goods contained within the specifications of both of the earlier trade marks as the goods in question are identical.

### **Similarity of the marks**

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

14. The similarity of the marks must be assessed by reference to the visual, aural and conceptual similarities of the trade marks. It is clear from the judgment of the ECJ in the case of *Sabel BV v Puma AG* that I must assess the overall impressions created by the marks bearing in mind their distinctive and dominant components.

15. Both of the earlier trade marks are for the words BENJAMIN JAMES which is presented in plain capital letters as a full name. The applicant's mark is the words BEN JAMES. It is not in plain letters but is presented in a cursive script. However, the word BEN is a common abbreviation for the word BENJAMIN and would be identified as such by the average consumer of the goods in question. I consider the trade marks at issue to be very similar.

### **Likelihood of confusion**

16. In correspondence prior to the hearing, and at the hearing itself, Mr James made the following points:

- 1 The earlier trade marks are presented in plain upper case letters whereas the applicant's mark is presented in a stylised manner which he referred to as *“sentence casing”*.
- 2 The trade marks at issue are used in completely separate markets.
- 3 The marks in conflict conjure up completely different images.

- 4 The forename BEN would never be extended to BENJAMIN.
- 5 The forename BENJAMIN may be shortened to BENGY or BENJIE as alternatives to it being shortened to BEN.

17. Firstly it is evident that the earlier trade marks and the applicant's mark are different. Although the word JAMES is common to all of the marks in question the earlier trade marks preface it with the forename BENJAMIN whereas the applicant's mark prefaces it with the forename BEN. Additionally the marks in conflict are presented differently. However, there is no evidence to support the claim that the trade marks in conflict are used in separate markets or that they portray different images to the relevant consumer of these goods who, in respect of these goods, I consider to be the general public. Indeed, I must consider normal and fair use of the marks across the markets for the goods listed in the application. Furthermore I note that there is no evidence to support the claim that the forename BEN would never be extended to BENJAMIN or vice versa. It may well be the case that the applicant has no intention of ever extending the word BEN in his trade mark to the full forename BENJAMIN but the average consumers of the goods in question are likely to imperfectly recollect one mark for the other, or wrongly assume that one mark has been updated, or assume that the two marks are variant marks used by the same undertaking. I am also unaware of any intention the proprietor of the earlier trade marks may have to shorten the forename in either of his marks to BEN. Mr James referred me to two famous people, Michael Jackson and David Beckham and claimed that their forenames would never be shortened to Dave or Mike. This may well be true but both Michael Jackson and David Beckham are individuals with international reputations which extend far beyond their immediate area of fame and therefore this cannot affect my decision regarding this application. Mr James has reminded me that the forename BENJAMIN may also be shortened to BENGY or BENJIE but in my view by far the commonest shortening of the forename BENJAMIN is to BEN.

18. I take the view that the relevant consumer of the goods in question would identify both trade marks as representations of a full name. Again, I accept that there are differences between them but the differences in presentation are slight and BEN is, in my view, the commonest way of shortening the forename BENJAMIN.

19. I must, of course, bear in mind that a mere possibility of confusion is not sufficient. (See eg *React* Trade Mark [2000] RPC 285 at page 290). The Act requires that there must be a likelihood of confusion. I have already found the goods in Class 25 to be identical. It is clear that where there is a lesser degree of similarity between the trade marks this may be offset by a greater degree of similarity between the services ( and vice versa) - see *Lloyd Schuhfabrik Meyer & CO GmbH v Klijsen Handel BV*.

20. Furthermore it is now well established that the matter must be determined by reference to the likely reaction of an average consumer of the services in question, who is deemed to be reasonably well informed, reasonably observant and circumspect. The average consumer generally relies upon the imperfect picture of the earlier trade mark that he or she has kept in his or her mind and must therefore rely upon the overall impression created by the trade marks in order to avoid confusion. In this case I believe the identity of the goods in Class 25 coupled with the relatively high degree of distinctive character of the marks and the similarity between

them, is sufficient to give rise to a likelihood of confusion within the meaning of Section 5(2)(b) of the Act.

21. I therefore conclude that there is a likelihood of confusion which includes the likelihood of association. In reaching this conclusion I bear in mind that it is sufficient if an average consumer encountering the respective marks would assume that the marks identify a single undertaking or undertakings with an economic connection.

## **CONCLUSION**

22. In this decision I have considered all of the documents filed by the applicants and all of the arguments submitted to me in relation to this application and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Section 5(2) of the Act.

**Dated this 31<sup>ST</sup> day of March 2003**

**A J PIKE  
For the Registrar  
The Comptroller General**

**Annex in paper copy only**

## ANNEX A