O-288-06

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No 82349
BY HUGO BOSS TRADE MARKS MANAGEMENT GMBH & CO.KG
FOR A DECLARATION OF INVALIDITY
IN RESPECT OF TRADE MARK No 2292370B
STANDING IN THE NAME OF
DARKERTHANBLUE UK LIMITED

BACKGROUND

1) The registered proprietor has the following trade mark registered in the UK:

Mark	Number	Effective Date	Class	Specification
DARKERTHANBLUE	2292370B	08.02.02	3	Cleaning, polishing, scouring and abrasive preparations and substances; perfumery; essential oils; perfumes; eau de parfum; eau de parfum spray; eau de toilette; eau de toilette spray; body mist; massage oils; bath oils; cosmetics; cosmetic articles; make-up preparations; preparations for removing make-up; lipstick; eye shadow; eye-liner; mascara; blusher; foundation; lip-liner; nail polish; nail polish remover; facial toner; facial cleanser; facial masks; moisturiser; hand cream; night cream; non-medicated toilet and bath preparations; soap; liquid soap; toilet soap; shower gel; bath salts; bath crystals; talcum powder; skin care preparations; hair care preparations; shampoo; hair conditioner; hair lotions; hair styling mousse; hair styling gel; shaving cream; aftershave lotion and balms; sun care preparations; bleaching preparations; wax preparations; exfoliating preparations; parts and fittings for all the aforesaid goods.
			18	Leather and imitations of leather, and goods made of these materials and not included in other classes; trunks and travelling bags; umbrellas; parasols and walking sticks; suitcases; bags; sports bags; travel bags; rucksacks; haversacks; back packs; holdalls; handbags; shoulder bags; satchels; briefcases; document cases; record bags; CD bags; tape bags; minidisk bags; DVD bags; wallets; purses; key cases; key fobs; belts; umbrellas; beach umbrellas; parts and fittings for all the aforesaid goods.
			25	Clothing, footwear and headgear; outerwear; sports clothing; leisure clothing; shirts; t-shirts; sweat shirts; sweaters; jackets; dresses; skirts; trousers; jeans; tracksuits; shorts; underwear; socks; nightwear; swimwear; beachwear; hats; gloves; scarves; caps; baseball caps; visors; shoes; boots; sports shoes; trainers; sandals; slippers; parts and fittings for all the aforesaid goods.
			28	Toys, games and playthings; gymnastic and sporting articles; decorations for Christmas trees; hand-held electronic games; parts and fitting for all the aforesaid goods.

2) By an application dated 8 December 2005 Hugo Boss Trade Marks Management GmbH & Co. KG applied for a declaration of invalidity in respect of this registration. The grounds are, in summary:

a) The applicant is the proprietor of Community Trade Mark 1111590 DARK BLUE which is registered for the following goods in Class 3:

> "Toilet soaps, perfumery, essential oils, dentifrices, preparations for the cleaning and care of the skin, scalp and hair; deodorants for personal use; hair lotions and preparations for the beautification of the skin, scalp and hair (none being dark blue or for use in colouring the skin, scalp or hair)".

b) The mark in suit is similar to the applicant's earlier mark and is registered for goods in Class 3 which are identical or similar. In relation to certain goods in Class 3 the mark has therefore been registered in breach of Section 5(2)(b) of the Trade Marks Act 1994.

3) The registered proprietor filed a counterstatement denying the above grounds.

4) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. Neither side wished to be heard although both sides provided written submissions which I shall refer to as and when necessary in my decision.

APPLICANT'S EVIDENCE

5) The applicant filed a witness statement, dated 16 March 2006, by Wendy Waller the applicant's Trade Mark Attorney. She states that she carried out an internet search for fragrance retailers, and then chose fifteen of them randomly. She states that she entered each of the websites and conducted a search for DARK BLUE in their product search facilities. In ten of the searches the only products which contained the words DARK or BLUE were those of Hugo Boss, the applicant company. In the other five searches there were products which contained the words DARK or BLUE which belonged to other manufacturers but the only products which had both words were those of the applicant. Lastly, she carried out a search of the internet for "DARK BLUE fragrance" and all of the 2.7 million hits she claims relate to the applicant's product. At exhibits WLW1 & 2 she provides full copies of her searches of others websites, whilst exhibit WLW3 contains the first three pages of the total internet search.

REGISTERED PROPRIETOR'S EVIDENCE

6) The registered proprietor filed a witness statement, dated 28 April 2006, by Donald Gordon Turner the registered proprietor's Trade Mark Attorney. He states that at exhibit DGT1 he provides extracts from the Internet showing use of the term "Darker than blue". He states:

> "The term "darker than blue" has been used in the American Deep South to describe "black" people. The term is now often used in connection with "black

music". The song entitled "We The People Who Are Darker Than Blue" by Curtis Mayfield is particularly well-known."

7) Exhibit DGT1 contains a Curtis Mayfield song list available for download with the song that Mr Turner mentioned listed. Two different record albums featuring a variety of singers also carry the titles "Darker than Blue: Soul form Jamdown" and "Darker than Blue: Vol. 1". At exhibit DGT2 Mr Turner provides a collection of printouts from the ebay website showing use of a number of trade marks which feature the word BLUE in relation to fragrances. These include, inter alia, "Deep Blue", "Light Blue", Umbro Blue", "Polo Blue", "Gap Blue", "Blue Jeans" and "Blue Harbour". He claims that these show that the word BLUE is a common element in trade marks identifying men's toiletries, and that consumers are accustomed to distinguishing marks which include the word BLUE. At exhibit DGT3 he provides a copy of the Registry examination report which does not cite the applicant's mark. Lastly, at exhibit DGT4 he provides definitions of the words BLUE and DARK from The Concise Oxford Dictionary although he does not comment on their significance. The initial parts of these read as follows:

> **BLUE**: ● "adj. (Bluer, bluest) 1 of a colour intermediate between green and violet, as the sky or sea on a sunny day.►(of a cat, fox, or rabbit) having fur of a smoky grey colour. 2 *informal* Melancholy, sad, or depressed. 3 informal (of a film, joke or story) with sexual or pornographic content. 4 *Brit, informal* Politically conservative. 5 (of a ski run) of the second-lowest level of difficulty. ●**n** 1 blue colour pigment or material
> ►(**the blue**) *poetic literary* the sky or sea, or the unknown ►another term for BLUING."
>
> DARK: ●"adj. 1 with little or no light. 2 of a deep or sombre colour. ►(of skin, hair or eyes) brown or black. ►(of a person) having such skin, hair or eyes. 3 mysterious: *a dark secret.* ►(**darkest**) *humorous* (of a region) most remote, inaccessible, or uncivilised. ►*archaic*. Ignorant. 4 charcterized [sic] by unhappiness or unpleasantness: *the dark days of the war*. >(of an expression) angry. >evil: sinister: *dark deeds*. ●**n** 1 (**the dark**) the absence of light. > a dark colour or shade. 2 nightfall."

8) That concludes my review of the evidence. I now turn to the decision.

DECISION

9) The request for the declaration of invalidity is made under the provisions of Section 47(2)(a) of the Act. The relevant part of which states:

> "47 (2) The registration of a trade mark may be declared invalid on the ground -
>
> (a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or
>
> (b) …….

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration."

10) The action is brought under section 5(2)(b) which states:

"5.-(2) A trade mark shall not be registered if because -

(a)....

(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."

11) An "earlier trade mark" is defined in section 6, the relevant part of 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."

12) The applicant is the proprietor of CTM 1111590 which has an effective date of 15 October 1998 and is clearly an earlier trade mark.

13) In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 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 Benelux 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*;

(b) the matter must be judged through the eyes of the average consumer, of the goods / services in question; *Sabel BV v Puma AG*, 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;*

(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*;

(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*;

(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.*;

(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*;

(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*;

(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 Benelux AG*;

(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.*

14) In essence the test under section 5(2)(b) is whether there are similarities in marks and goods 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, the category of goods in question and how they are marketed. Furthermore, I must compare the registered proprietor's mark and the mark relied upon by the applicant on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods covered within the respective specifications.

15) The effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act was considered by David Kitchin Q.C. sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchin concluded at paragraph 17 of his decision:

"The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently

by Jacob L.J. in *Reed Executive & Ors v Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case."

16) The applicant makes no comment on sales under the mark and therefore cannot benefit from any reputation. I also have to consider whether the mark upon which the applicant is relying has a particularly distinctive character arising from the inherent characteristics of the mark. The applicant's mark is DARK BLUE and is registered for what could broadly be termed perfumes and cosmetics. Whilst I am aware of the limitation on the applicant's products ie "(none being dark blue or for use in colouring the skin, scalp or hair)", such limitations do not travel into the marketplace. To my mind the applicant's mark must be regarded as having a low level of inherent distinctiveness.

17) I now turn to the comparison of the specifications of the two parties and take into account the factors referred to in the opinion of the Advocate General in *Canon*; [1999] ETMR 1. 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, intended purpose and their method of use and whether they are in competition with each other or are complementary."

18) The application for invalidity relates to only part of the registered proprietor's Class 3 specification. For ease of reference, I show below the applicant's Class 3 specification and the registered proprietor's Class 3 goods which are under attack:

Registered Proprietor's specification	Applicant's specification
Perfumery; essential oils; perfumes; eau de parfum; eau de parfum spray; eau de toilette; eau de toilette spray; body mist; massage oils; bath oils; cosmetics; cosmetic articles; make-up preparations; preparations for removing make-up; lipstick; eye shadow; eye-liner; mascara; blusher; foundation; lip-liner; nail polish; nail polish remover; facial toner; facial cleanser; facial masks; moisturiser; hand cream; night cream; non-medicated toilet and bath preparations; soap; liquid soap; toilet soap; shower gel; bath salts; bath crystals; talcum powder; skin care preparations; hair care preparations; shampoo; hair conditioner; hair lotions; hair styling mousse; hair styling gel; shaving cream; aftershave lotion and balms; sun care preparations;	Toilet soaps, perfumery, essential oils, dentifrices, preparations for the cleaning and care of the skin, scalp and hair; deodorants for personal use; hair lotions and preparations for the beautification of the skin, scalp and hair (none being dark blue or for use in colouring the skin, scalp or hair).

bleaching preparations; wax preparations; exfoliating preparations; parts and fittings for all the aforesaid goods.	

19) To my mind there is a clear overlap in many parts of the specifications, with much being identical and the rest reasonably similar. The registered proprietor's submissions are silent on this issue. For the purposes of the comparison I shall regard the goods as identical as this provides the applicant with its strongest case.

20) The average consumer for these types of products must be seen as being the average UK citizen, and I accept that these types of goods can be relatively inexpensive everyday items, although some, particularly perfumes are very expensive. However, given the emphasis placed on hair/skin type and allergies I do not think that these types of products are purchased without some care, although I must allow for the doctrine of imperfect recollection.

21) I now turn to compare the marks of the two parties, which are DARK BLUE and DARKERTHANBLUE. The registered proprietor contends that the marks are different visually as their mark is longer than the applicant's and contains the word THAN in the middle. They contend that phonetically the presence of the word THAN produces a different sound when the word is pronounced. They also contend that conceptually the marks are different as their mark has a meaning relating to "black" people as set out in their evidence. They also point out that the word BLUE is in common use for cosmetics and toiletries, although their evidence refers only to fragrances for men. Lastly, they point out that the applicant's mark has a low degree of distinctiveness, referring to the *Medion AG v Thomson Mutimedia Sales* case C 120/04, and claiming that their mark has distinctive character whereas the applicant's mark does not.

22) There are obvious similarities both visually and phonetically between the marks. Both contain the words DARK and BLUE but whereas the applicant's mark consists solely of the two words the registered proprietor's mark adds the letters ER to the initial word DARK and also the word THAN before ending with the word BLUE. Although written without gaps the mark will be seen and pronounced as though the words were separate. The registered proprietor's mark is significantly longer than the applicant's mark and this would be reflected in pronunciation. The applicant contends that the registered proprietor's mark will be seen as an extension to the DARK BLUE range. However, to my mind this would only work if the mark was "darker than dark blue". The applicant also contends that phonetically the word THAN is "buried in the mark as a whole and may not be appreciated by the consumer". Again, I do not agree. The difference to the ear is marked if only due to the additional matter that cannot be slurred or choked out of existence. Four syllables to two is a considerable change.

23) Conceptually, the applicant's mark will be viewed as a reference to the colour, also known as Oxford Blue whereas the registered proprietor's mark does not convey the same message. Although the colour reference is clear it is not referring to the colour blue but something which is not blue as it is darker. Although the registered proprietor has attempted to make a case that it would be seen as a reference to "black" people it has shown only use of the term in the United States of America. Whilst I

accept that, usually, whatever is current in the USA eventually comes into use in the UK, this term does not yet seem to have made its way across the "pond".

24) Taking all of the above into consideration and even allowing for the goods being identical, I believe that the differences in the marks outweighs any similarities such that there is no likelihood of confusion or a likelihood of association on the part of the public. I do not deny that the mark may bring to mind the applicant's mark but that is not sufficient for a finding in the applicant's favour under this ground of invalidity.

25) As the registered proprietor was successful it is entitled to a contribution towards its costs. I order the applicant to pay the registered proprietor the sum of £1000. 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 12th day of October 2006

George W Salthouse
For the Registrar,
the Comptroller-General