

O/157/12

**TRADE MARKS ACT 1994**

**CONSOLIDATED PROCEEDINGS IN THE MATTER OF:**

- 1) NICHOLAS DEAKINS LIMITED'S OPPOSITION (NO 98234)  
TO A TRADE MARK APPLICATION (NO 2489547)  
BY MR JUSTIN DEAKIN TO REGISTER THE TRADE MARK:**

**DEAKIN**

**AND**

- 2) MR JUSTIN DEAKIN'S OPPOSITION (NO 98759) TO A TRADE MARK  
APPLICATION (NO 2501575) BY NICHOLAS DEAKINS LIMITED TO  
REGISTER THE TRADE MARK:**

**DEAKINS**

**AND**

- 3) NICHOLAS DEAKINS LIMITED'S OPPOSITION (NO 100434)  
TO A TRADE MARK APPLICATION (NO 2534122)  
BY MR JUSTIN DEAKIN TO REGISTER THE TRADE MARK:**

**MASTER  
DEAKIN  
SON OF MR. DEAKIN**

## **THE BACKGROUND AND THE PLEADINGS**

1) These are consolidated proceedings involving Nicholas Deakins Limited (“NDL”) on the one hand and Mr Justin Deakin on the other. Three sets of trade mark opposition proceedings have been consolidated. The applications the subject of the oppositions, together with the grounds of opposition, are:

### **Application 2489547**

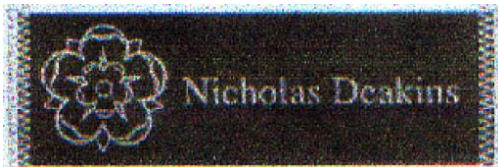
Filed on 9 June 2008 by Mr Justin Deakin.

The mark consists of the word DEAKIN and registration is sought in relation to “footwear and clothing” in class 25.

Opposed by NDL on 10 November 2008.

The grounds of opposition are under i) section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), relying on earlier trade mark 2396693, ii) section 5(3) of the Act relying on the same earlier mark, iii) section 5(4)(a) relying on the use of the signs NICHOLAS DEAKINS and DEAKINS and, iv) section 3(6) because Mr Justin Deakin (who was a founding partner in the firm that is the predecessor to NDL) was aware of NDL’s rights and, also, that the use of the applied for mark would breach the law of contract because Mr Deakin had covenanted not to use any name which is the same or might be confused with that of NDL.

Earlier mark 2396693 is depicted below together with the goods for which it is registered:



**Class 25:** Mens and ladies clothing, shirts, T-shirts, hats, gloves, socks, underwear, trousers, jeans, jackets, sweaters, jumpers, hooded tops, track tops, combat pants, shorts, swimming shorts, swimming trunks, formal shoes, casual shoes, boots, moccasins, trainers and sneakers

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### **Application 2501575**

Filed on 3 November 2008 by NDL.

The mark consists of the word DEAKINS. Registration is sought in relation to:

**Class 18:** Leather and imitations of leather and goods made of these materials (not included in other classes); bags; trunks and travelling bags; vanity cases; holdalls, back packs and rucksacks; wallets, key cases, purses and pouches; credit card cases, tote bags, bottle bags, record bags, book bags; handbags; sports bags; shopping bags; luggage and suitcases, weekend bags; jewellery rolls; attaché cases and briefcases; umbrellas, parasols and walking sticks; parts and fittings for all the aforesaid goods

**Class 25:** Clothing, footwear and headgear

**Class 35:** Retail services connected with the sale of leather and imitations of leather and goods made of these materials (not included in other classes), bags, trunks and travelling bags, vanity cases, holdalls, back packs and rucksacks, wallets, key cases, purses and pouches, credit card cases, tote bags, bottle bags, record bags, book bags, handbags, sports bags, shopping bags, luggage and suitcases, weekend bags, jewellery rolls, attaché cases and briefcases, umbrellas, parasols and walking sticks, clothing, footwear and headgear; advertising services; information relating to all these services.

Opposed by Mr Justin Deakin on 13 February 2009.

The grounds of opposition are under i) section 5(2)(b) of the Act, relying on earlier trade mark 2489547 for the mark DEAKIN (this is the mark subject to the previously detailed opposition) and, also, 2443925<sup>1</sup> which is for the mark:

JUSTIN  
DEAKIN

and is registered in respect of clothing, footwear and headgear, ii) section 5(4)(a), relying on the use of the signs DEAKIN and JUSTIN DEAKIN and, iii) section 3(6) because NDL is attempting to move away from its name of NICHOLAS DEAKINS in order to progressively use a mark similar to those of Mr Deakin for the purposes of taking advantage of his reputation as a footwear designer.

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**Application 2534122**

Filed on 11 December 2009 by Mr Justin Deakin.

Registration is sought in relation to “clothing, footwear & headgear” in class 25 for the mark:

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<sup>1</sup> This registration was the subject of invalidation proceedings instigated by NDL, but NDL withdrew its claim.

Opposed by NDL on 21 April 2010.

The grounds of opposition are under i) section 5(2)(b) of the Act, relying on earlier trade marks 2396693, 2501575 (the subject of the previously detailed opposition) and 2501576 (which consists of the words NICHOLAS DEAKINS and which is registered for goods including clothing, footwear and headgear), ii) section 5(4)(a) relying on the use of the signs NICHOLAS DEAKINS and DEAKINS and, iii) section 3(6), for the same reasons as its opposition against application 2589547.

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2) Counterstatements and evidence were filed in relation to the oppositions. Both parties attended a hearing before me at which Mr Deakin was represented by Mr Roland Buehrlen of Beck Greener and NDL by Mr Alan Fiddes of Urquhart-Dykes & Lord. As can be seen, there are a number of overlapping grounds and issues. However, section 5(2)(b) runs through all of the oppositions. I will, therefore, determine the section 5(2)(b) claims in the first instance and only move on to the other grounds if it is necessary to do so. I will touch upon the evidence shortly, but rather than provide a detailed evidence summary I will, instead, simply draw from the evidence to the extent relevant to the grounds being considered.

**SECTION 5(2)(B)**

3) Section 5(2)(b) of the Act reads:

“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.”

4) When considering matters under this ground, I have borne in mind the leading guidance from the Court of Justice of the European Union (“CJEU”) in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Case C-3/03 Matrazen Concord GmbH*

*v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05). In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10) Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases:

"(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, 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, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either *per se* or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) 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;

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion."

5) As the various conflicts involve trade marks incorporating names, it is useful to bear in mind what the CJEU stated in *Harman International Industries, Inc v OHIM* (C-51/09 P) ("*Harman*"):

"34. However, in paragraphs 30 and 31 of *Medion*, the Court held that, beyond the usual case where the average consumer perceives a mark as a whole, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element. In such a case, the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue come, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.

35. In the present case, having repeated all of the rules set out in paragraphs 30 to 33 of this judgment, the General Court held essentially, in its assessment of the conceptual similarity of the marks at issue, first, that, as consumers in part of the European Union generally attribute greater distinctiveness to the surname than to the forename in word signs, the component 'Becker' in the mark applied for was likely to have attributed to it a stronger distinctive character than the component 'Barbara'; second, that the fact that Ms Becker is famous in Germany had no effect on the similarity of the marks at issue since they refer to the same surname and the component 'Barbara' is merely a forename and, third, that the component 'Becker' retained an independent distinctive role in the composite mark because it would be perceived as a surname.

36. Although it is possible that, in a part of the European Union, surnames have, as a general rule, a more distinctive character than forenames, it is appropriate, however, to take account of factors specific to the case and, in particular, the fact that the surname concerned is unusual or, on the contrary, very common, which is likely to have an effect on that distinctive character. That is true of the surname 'Becker' which the Board of Appeal noted is common.

37. Account must also be taken of whether the person who requests that his first name and surname, taken together, be registered as a trade mark is well known, since that factor may obviously influence the perception of the mark by the relevant public.

38. Furthermore, it must be held that, in a composite mark, a surname does not retain an independent distinctive role in every case solely because it will be perceived as a surname. The finding with respect to such a role may be based only on an examination of all the relevant factors of each case.

39. Moreover, as the Advocate General pointed out in essence, in point 59 of his Opinion, the grounds relied on by the General Court in order to conclude that the marks at issue are conceptually similar, if they were held to be consistent with Article 8(1)(b) of Regulation No 40/94, would result in acknowledging that any surname which constitutes an earlier mark could be effectively relied on to oppose registration of a mark composed of a first name and that surname, even though, for example, the surname was common or the addition of the first name would have an effect, from a conceptual point of view, on the perception by the relevant public of the composite mark.”

### **The average consumer**

6) The case-law informs me that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting goods or services can, however, vary depending on what is involved (see, for example, the judgment of the General Court (“GC”) in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)).

7) All of the conflicts involve, in the main, clothing products. Such goods are “consumed” by members of the general public. The goods may be tried on and are likely to be inspected for colour, size, style etc. All of this increases the potential exposure to the trade mark. That being said, the purchase of clothing is unlikely to be a highly considered process as it is purchased relatively frequently and, although cost can vary, it is not, generally speaking, a highly expensive purchase. The purchasing process is, therefore, a normal, reasonably considered one, no higher or lower than the norm. It should also be noted that the purchase of clothing is predominantly a visual act<sup>2</sup>, although, aural similarity should not be ignored completely.

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<sup>2</sup> See, e.g. *New Look Ltd v OHIM* – Joined cases T-117/03 to T-119/03 and T-171/03 (GC)

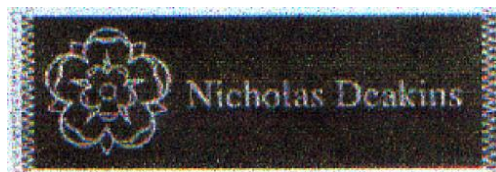
## The relevance of the evidence

8) Much of the evidence relates to the relationship that Mr Deakin had with the partnership that was the predecessor in title to NDL. I can see no significance in such evidence in terms of whether there exists a likelihood of confusion. Both parties also provided evidence in an attempt to demonstrate that there exists a protectable goodwill in respect of the various signs they rely upon. One potential form of relevance to this evidence under section 5(2)(b) could be whether there is any parallel trade which could be indicative of whether there is, or is not, likely to be confusion. However, Mr Deakin's use, for example, relates more to the use of his name as a designer and less to the use of his marks in relation to goods. This should not be taken as an indication that I have ruled out (or in) that either party has a protectable goodwill in relation to the signs they rely upon under section 5(4)(a) of the Act (if it is necessary to do so, I will return to the issue of goodwill later) but, in terms of the relevance of the evidence under section 5(2)(b), I am far from satisfied that the nature of the use the parties have put forward replicates, to any material extent, the notional conflicts that are before the tribunal. It should also be noted that references to what both representatives referred to as "honest concurrent use" have no real significance beyond the indicative parallel use I have referred to (indicative use which I found not to exist); see the decision of Ms Anna Carboni (sitting as the Appointed Person) in *Muddies* (BL O/211/09). The evidence, therefore, has no significance here. The only other potential relevance would be whether any of the marks have an enhanced level of distinctiveness through use; I will comment on this on a case by case basis. I will now consider each conflict in turn.

## The opposition to application 2489547

9) The respective marks are:

**DEAKIN** v



10) When making a comparison, it is to be noted that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the marks must be assessed by reference to their overall impressions, bearing in mind their distinctive and dominant components. In terms of Mr Deakin's DEAKIN mark, it has only one element, the word DEAKIN itself. In terms of NDL's mark, this consists of the words NICHOLAS DEAKINS (in title case) and a flower device. Both the word element and the device element make a roughly equal contribution to the overall impression of the mark, contributions that are independent from each other. The Nicholas Deakins element is dominated more by Deakins than by Nicholas. I say this because whilst Nicholas Deakins will be perceived as a full



personal name (notwithstanding the fact that Nicholas is a surname in its own right), I come to the view, on account of the levels of relative unusualness, that Deakins will be seen as the more dominant component; my own experience tells me that Nicholas is a fairly common forename whereas Deakins is not a common surname. I note Mr Buehrlen's reference to the fame of Justin Deakin and that the CJEU had confirmed in the *Harman* case that:

“37. Account must also be taken of whether the person who requests that his first name and surname, taken together, be registered as a trade mark is well known, since that factor may obviously influence the perception of the mark by the relevant public.”

11) I have taken the claimed fame of Mr Deakin into account, but I do not consider that the perception of the UK average consumer will be altered. This is for a number of reasons. Firstly, whilst the use put forward demonstrates that Mr Deakin has been engaged as a designer by a number of companies, the use of his name in relation to the finished clothing products (including footwear) lacks detail; it is certainly not sufficient to demonstrate that he is well known as per the *Harman* case. Secondly, the *Harman* case relates to the fame of the person requesting his/her first name and surname be registered whereas in this case Mr Deakin is requesting registration simply of DEAKIN per se. There is, therefore, greater doubt as to whether the claimed fame of Mr Deakin attaches to DEAKIN per se. Mr Buehrlen also referred to the following extract from *Harman*:

“39. Moreover, as the Advocate General pointed out in essence, in point 59 of his Opinion, the grounds relied on by the General Court in order to conclude that the marks at issue are conceptually similar, if they were held to be consistent with Article 8(1)(b) of Regulation No 40/94, would result in acknowledging that any surname which constitutes an earlier mark could be effectively relied on to oppose registration of a mark composed of a first name and that surname, even though, for example, the surname was common or the addition of the first name would have an effect, from a conceptual point of view, on the perception by the relevant public of the composite mark.”

12) The above has been borne in mind, but each case turns on its facts including the assessment of the commonness/unusualness of the components that make up the marks under consideration. The above extract does not set out a rule that surnames cannot cause confusion with full names (or vice versa). I should also add one further point in that both sides have made references to the own name defence. Much of the submissions related to the other grounds but I should say, for clarity, that the own name provisions have no part to play in whether there exists a likelihood of confusion. The own name provisions are a defence to infringement, they do not entitle registration of a mark which may otherwise cause confusion.

13) In terms of the visual and aural comparison, DEAKIN and DEAKINS are very similar, which provides a certain degree of similarity between the marks as a whole. The differences (the device element and the word NICHOLAS) need to be factored in to that. Having done so, this results, in my view, in there being a moderate degree of visual and aural similarity. In terms of concept, although DEAKIN and DEAKINS do not strike me as common surnames, the conceptual significance will still be surnominal. To that extent, there is some conceptual similarity because both marks refer to a person with extremely similar surnames (Deakin/Deakins); the concept is not, though, identical because one of the marks also indicates that such a person goes by the forename NICHOLAS. The net effect of all this is that there is neither a high nor low degree of overall similarity, the degree falling midway between the two extremes.

14) Moving on to the goods, Mr Deakin seeks registration in relation to footwear and clothing. NDL's mark is registered in respect of:

“Mens and ladies clothing, shirts, T-shirts, hats, gloves, socks, underwear, trousers, jeans, jackets, sweaters, jumpers, hooded tops, track tops, combat pants, shorts, swimming shorts, swimming trunks, formal shoes, casual shoes, boots, moccasins, trainers and sneakers”

15) If a term clearly falls within the ambit of a term in a competing specification then identical goods must be considered to be in play (*Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-133/05*). This is the case here, even though Mr Deakin's terms are, theoretically, the wider and could, potentially, include goods which are not identical. For the time being, the goods should be considered identical.

16) The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark (based either on inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). In terms of the earlier mark's inherent qualities then, as a whole (with its device element borne in mind), it is, at the least, reasonably distinctive. I would make this finding even if the device were not there as although names are often used in trade then, as indicated earlier, DEAKINS does not strike me as a particularly common surname, so the name as a whole has at least a reasonable degree of distinctive character. In terms of whether the mark's distinctiveness is enhanced, it is clear that the earlier mark in question is the one which has been used most often by NDL. Most of the use has been in relation to footwear. However, whilst the turnover figures provided are not insignificant, they do not strike me as obviously representing a level of use that would be known by a significant proportion of the general public. I bear in mind that some advertising has taken place in FHM and Arena magazines, and also some sponsorship activities (e.g. with the Leeds Rhinos rugby team). Whilst I accept that a mark need not be a household name to benefit from an enhanced level of distinctiveness, the use put forward does not clearly demonstrate that the level of

distinctiveness has been enhanced. There is no evidence as to the mark's share of the market or public recognition. It is a used mark but not one whose distinctiveness is enhanced.

17) That then leads to whether the factors I have assessed combine to create a likelihood of confusion. The factors have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17) and a global assessment of them must be made when determining the matter (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. Confusion may be direct i.e. confusing one trade mark for the other or, alternatively, indirect, whereby the average consumer considers that the goods marketed under the respective trade marks emanate from the same or an economically linked undertaking. In my view, the identity of the goods, together with the reasonable degree of distinctiveness of the earlier mark means that the degree of similarity between the marks is enough for confusion to be likely. Whilst the degree of similarity is only at a mid-level, it is enough, particularly given that the surname DEAKINS is not, in my experience, a common one, for confusion to arise. The consumer will assume that the DEAKIN/DEAKINS in question is a reference to the same person or company, even though the forename is not specified in the applied for mark. The differences between DEAKIN and DEAKINS is something that is likely to be lost through imperfect recollection. I have borne in mind the whole mark comparison and that, in addition to the words, the earlier mark has a device, but I do not consider the difference this creates to be such to avoid a likelihood of confusion, particularly indirect confusion as described earlier. **My finding is that there is a likelihood of confusion. The opposition to the registration of Mr Deakin's mark is upheld.** It should be noted that the finding of goods identity was based on the principle set out in *Gerard Meric* but that, potentially, non-identical goods may also be included in the applied for specification. However, Mr Deakin has put forward no fall-back specification and, given his evidence, the likely use of the mark would fall squarely within what the earlier mark is registered for. In such circumstances, it is not appropriate to countenance revised specifications.

### The opposition to application 2501575

18) Two earlier marks were relied upon under section 5(2)(b), however, the first (application 2489547) can no longer be relied upon given my finding in the preceding paragraph. The other mark relied upon is registration 2443925. The respective marks are, therefore:

DEAKINS v JUSTIN DEAKIN

19) Given my findings and rationale in relation to the section 5(2)(b) ground I have already assessed, much of the same applies here. In terms of the goods, and looking firstly at the goods sought to be registered in class 25 (I will come back to the goods and services in class 18 & 35), both the earlier mark and the applied for mark have specifications worded in an identical manner (clothing, footwear, headgear) so the goods are self-evidently identical. In terms of the mark comparison then, by parity of reasoning with my earlier findings, the marks have a slightly above mid-level point of similarity. There is slightly more similarity here than in the first opposition because the earlier mark relied upon does not have a device element and, also, DEAKIN is given slightly greater prominence than the word JUSTIN, so, the respective marks in this opposition have a higher degree of similarity to each other than those in the previous opposition. That being said, it is still not of a high degree of similarity. The same findings apply in relation to the enhanced distinctiveness of the earlier mark JUSTIN DEAKIN. Mr Deakins' evidence does not establish any form of reputation in relation to the mark JUSTIN DEAKIN in respect of clothing. Whilst he is a designer, his name is not often used in direct association with the goods and, even if I am wrong on this interpretation, the level of use is sporadic and not obviously significant. Weighing all these factors, then, again, and for similar reasons expressed earlier, there is also a likelihood of confusion in relation to this application at least in terms of class 25.

20) In relation to the goods/services sought to be registered in classes 18 and 35, these read:

**Class 18:** Leather and imitations of leather and goods made of these materials (not included in other classes); bags; trunks and travelling bags; vanity cases; holdalls, back packs and rucksacks; wallets, key cases, purses and pouches; credit card cases, tote bags, bottle bags, record bags, book bags; handbags; sports bags; shopping bags; luggage and suitcases, weekend bags; jewellery rolls; attaché cases and briefcases; umbrellas, parasols and walking sticks; parts and fittings for all the aforesaid goods

**Class 35:** Retail services connected with the sale of leather and imitations of leather and goods made of these materials (not included in other classes), bags, trunks and travelling bags, vanity cases, holdalls, back packs and rucksacks, wallets, key cases, purses and pouches, credit card cases, tote bags, bottle bags, record bags, book bags, handbags, sports bags, shopping bags, luggage and suitcases, weekend bags, jewellery rolls, attaché cases and briefcases, umbrellas, parasols and walking sticks, clothing, footwear and headgear; advertising services; information relating to all these services.

21) The question arises as to whether the above goods/services are similar to the class 25 goods (clothing, footwear & headgear) of earlier mark 2443925 and

whether such similarity, when the degree of similarity between the marks as assessed above is also borne in mind, results in there being a likelihood of confusion. It is noted that the GC has identified a complementary relationship between clothing on the one hand and, on the other, those goods in class 18 which could be characterised as fashion accessories and with services in class 35 for the retailing of clothing (see *El Corte Inglés SA v OHIM* Case T-443/05 and *Oakley, Inc v OHIM* Case T-116/06, respectively). Such findings, for obvious reasons, do not result in an identical or highly similar relationship but, nonetheless, there is certainly more than a low degree of similarity. Having considered such degree of similarity together with the various other factors before me, I extend my finding of there existing a likelihood of confusion to such goods and services. I believe, again, that the similarities between the marks and the goods/services will be put down to there being an economic connection between the responsible undertakings. For clarity, the opposition succeeds in respect of:

**Class 18:** [Leather and imitations of leather and] goods made of these materials (not included in other classes); bags; purses; handbags

**Class 35:** Retail services connected with the sale of clothing, footwear and headgear; information relating to all these services.

but fails in respect of:

**Class 18:** Leather and imitations of leather; trunks and travelling bags; vanity cases; holdalls, back packs and rucksacks; wallets, key cases, pouches; credit card cases, tote bags, bottle bags, record bags, book bags; sports bags; shopping bags; luggage and suitcases, weekend bags; jewellery rolls; attaché cases and briefcases; umbrellas, parasols and walking sticks; parts and fittings for all the aforesaid goods

**Class 35:** Retail services connected with the sale of leather and imitations of leather and goods made of these materials (not included in other classes), bags, trunks and travelling bags, vanity cases, holdalls, back packs and rucksacks, wallets, key cases, purses and pouches, credit card cases, tote bags, bottle bags, record bags, book bags, handbags, sports bags, shopping bags, luggage and suitcases, weekend bags, jewellery rolls, attaché cases and briefcases, umbrellas, parasols and walking sticks; advertising services; information relating to all these services.

22) I have only considered it appropriate to uphold the opposition for a limited range of goods in class 18 for which there seems to me to be a self-evident capacity for such goods to be characterized as fashion accessories likely to be co-ordinated with clothing. For the remaining goods, there is no such self-evident link, and no evidence has been filed to demonstrate one. **The opposition to the registration of NDL's mark is upheld to the extent identified above.**

## The opposition to application 2534122

23) Three earlier marks are relied upon. Given my findings above, 2501575 can no longer be relied upon in respect of its class 25 goods, but it can be relied upon for certain of its goods and services in classes 18 and 35. There is also 2396693 (NICHOLAS DEAKINS and device) and 2501576 (NICHOLAS DEAKINS), but as 2501576 is closer to the applied for mark than 2396693, 2396693 need not be discussed further. I will consider the opposition firstly on the basis of earlier mark 2501576; the conflict is therefore between:

**NICHOLAS DEAKINS** v **MASTER DEAKIN**  
SON OF MR. DEAKIN

24) Again, both the specifications cover clothing, footwear and headgear and are, therefore, identical. The earlier mark, by parity of reasoning with my earlier decisions, is reasonably distinctive from an inherent perspective and the evidence filed does not enhance this (for the same reasons as per NICHOLAS DEAKINS and device).

25) The comparison is somewhat different from the other oppositions because the applied for mark is not DEAKIN/DEAKINS alone. However, in terms of the more dominant elements of the mark, then the mark NICHOLAS DEAKIN, by parity of reasoning with my earlier findings, will be dominated more by DEAKIN than by NICHOLAS. I consider the same to apply in relation to the applied for mark. This is particularly so given that the word DEAKIN is larger in size than the other words and, also, because the focus of the mark is on the name DEAKIN, i.e. the Master DEAKIN who is the son of Mr DEAKIN.

26) In terms of the visual comparison, given the prominence of the word DEAKIN in the applied for mark, and its similarity to the DEAKINS element of NICHOLAS DEAKINS, there is certainly a degree of visual similarity. The differences, though, need to be borne in mind. I assessed the degree of similarity in the oppositions above to be midway (the first opposition) or slightly above midway (the second opposition) between low and high – it is fair to say that the degree here is slightly less than that assessed already but I still do not consider it to be of only a low degree. In terms of the concept, then, again, both marks are referring to a person called DEAKINS/DEAKIN, albeit one is specifically identified as having the forename Nicholas, whereas the other has the title of Master and is the son of another Deakin. Overall I consider the marks to be moderately similar.

27) The question is whether, as in the other oppositions, the factors combine to create a likelihood of confusion. In my view, and whilst the degree of similarity between the marks is slightly less than in the other oppositions, there is a likelihood of confusion. The name DEAKIN/DEAKINS not being a common surname means that the presence of it in the respective marks will lead the

consumer to believe that the identical goods at issue are the responsibility of the same or an economically linked undertaking. The marks will likely be perceived as an off-shoot of each other but still originating from the same stable. **There is a likelihood of confusion. The opposition to the registration of Mr Deakin's mark is upheld.**

28) Although the above findings results in the opposition being upheld, I will also give my view on the basis of earlier mark 2501575. As stated above, the opposition failed in respect of certain goods and services in class 18 and 35, but this was largely due to the lack of similarity with such goods to clothing goods. In view of this, and by parity of reasoning, the remaining goods of 2501575 cannot assist NDL in its opposition. The position in respect of this earlier mark need not be addressed further.

29) It should be noted that during the hearing, I highlighted to the parties' representatives that they were providing somewhat contradictory arguments in relation to the oppositions. For example, Mr Fiddes (for NDL) was arguing that NICHOLAS DEAKINS (with device) was similar enough to DEAKIN to cause confusion whilst also arguing that JUSTIN DEAKIN was not similar enough to DEAKINS to cause confusion; Mr Buehrlen was arguing the reverse position. Mr Buehrlen responded by saying that from his position there were further differences (e.g. the flower device) which meant that his arguments were not contradictory. Mr Fiddes had more difficulty in rationalizing the position. I have borne the submissions in mind, particularly those of Mr Buehrlen. As can be seen above, I took account of the differences that he identified but I considered that they were insufficient to avoid a likelihood of confusion.

#### **SECTION 5(4)(A) – PASSING-OFF**

30) I must consider this ground in relation to the goods/services which Mr Deakin unsuccessfully opposed (under section 5(2)(b)) in application 2501575. In relation to where the parties were successful under section 5(2)(b), then there is, strictly speaking, no need to consider this ground. However, I will consider whether the parties are in any stronger position, more generally, under this ground. Section 5(4)(a) of the Act reads:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) .....

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

31) The elements of passing-off (often referred to as the classic trinity) can be summarised as: 1) goodwill, 2) misrepresentation and 3) damage. In *Reckitt & Colman Products Ltd v Borden Inc* [1990] R.P.C.341, Lord Oliver summarised the position quite succinctly when he stated:

“The law of passing off can be summarised in one short general proposition--no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff...Thirdly he must demonstrate that he suffers, or in a *quia timet* action that he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff.”

32) The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at 223 as:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first.”

33) I note from the relevant case-law that to qualify for protection under the law of passing-off, any goodwill must be of more than a trivial nature<sup>3</sup>. However, being a small player does not necessarily prevent the law of passing-off from being relied upon<sup>4</sup>.

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<sup>3</sup> *Hart v Relentless Records* [2002] EWHC 1984

<sup>4</sup> See, for instance, *Stannard v Reay* [1967] FSR 140, *Teleworks v Telework Group* [2002] RPC 27 and *Stacey v 2020 Communications* [1991] FSR 49.



34) In terms of the material date(s), I note the judgment of the GC in *Last Minute Network Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Joined Cases T-114/07 and T-115/07 where it was stated:

“50 First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51 However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non registered national mark before the date of filing, in this case 11 March 2000.”

35) However, if the mark sought to be registered was used prior to this then such use must also be taken into account. It could establish that the applicant is the senior user, or that there had been common law acquiescence, or that the status quo should not be disturbed which, in turn, could mean that the use of the mark could not have been prevented under the law of passing-off at the material date<sup>5</sup>.

36) In terms of NDL’s opposition to Mr Deakin’s application (2489547) to register DEAKIN as a trade mark then the material date is 9 June 2008. It is necessary to consider the factual position at this date (and earlier) in terms of what use the respective parties had made of the mark (the subject of Mr Deakin’s application) and of the signs relied upon by NDL. In terms of NDL’s use, the evidence of Mr Craig Nicholas Tate, NDL’s managing director, is relevant. It is abundantly clear that the sign NICHOLAS DEAKINS has been used as the primary name associated with NDL’s business. This much is not really in dispute. In terms of the use of DEAKINS alone, Mr Tate provides separate turnover figures for goods sold under both the NICHOLAS DEAKINS and DEAKINS signs. In the four years prior to the material date the use had risen from around £1/2 million to around £1 million per annum in respect of DEAKINS alone. He provides a number of exhibits which show use of the mark DEAKINS used on its own including articles/advertisements in magazines and product photographs. Much of this is criticized because it is not clearly from before the material date. However, whilst I agree that it could have been clearer, on the basis of what has been filed (including use in magazines in 2003 & 2006), together with Mr Tate’s narrative and turnover figures, I am prepared to accept that as of the material date NDL’s goodwill was associated with DEAKINS alone and not just NICHOLAS DEAKINS, at least in relation to footwear.

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<sup>5</sup> See, for instance: *Croom’s Trade Mark Application* [2005] RPC 2 and *Daimlerchrysler AG v Javid Alavi (T/A Merc)* [2001] RPC 42.

37) I also need to consider whether Mr Deakin was either the senior user or a concurrent user of the mark he seeks to register. Mr Deakin has provided a large amount of evidence about his activities. However, for it to be relevant I need to be satisfied that the mark (DEAKIN) sought for registration has been used in relation to the goods sought to be registered (footwear and clothing). The evidence of Mr Deakin establishes that he is a footwear designer. His name has been associated as the designer of a number of footwear products. However such use primarily indicates him as the designer but with the origin identifying sign for the actual goods being different; there is certainly no evidence of a product sold under DEAKIN solus. The only real use of DEAKIN solus is in the context of articles written about him or the products he has designed which sometimes abbreviate Justin Deakin's name to Deakin, but normally after already having referred to him as Justin Deakin. I do not consider that such use assists Mr Deakin in the confines of the decision before me. It does not show that he was a senior or concurrent user of DEAKIN solus in relation to footwear and clothing products.

38) In view of this, it seems to me to be a fairly inevitable conclusion that NDL would, therefore, succeed under this ground in opposing Mr Deakin's DEAKIN application as a misrepresentation (and subsequent damage) between DEAKINS and DEAKIN is very likely, even for clothing products other than footwear. NDL would, therefore, also have succeed under section 5(4)(a). As NDL also has a protectable goodwill in relation to NICHOLAS DEAKINS then, by parity of reasoning with my decisions under section 5(2)(b), misrepresentation (and subsequent damage) will also have occurred; I make this finding because this puts NDL in a slightly stronger position on account that there is no device mark to bear in mind in terms of the earlier sign being relied upon.

39) Taking the above findings forward, and by parity of reasoning, it seems to me that Mr Deakin would not have succeeded under section 5(4)(a) in his opposition to NDL's DEAKINS mark to the extent that he relied upon the use of DEAKIN alone given that any goodwill he had would have been associated with the full name JUSTIN DEAKIN; there is no need to consider the position on the basis of JUSTIN DEAKIN under section 5(4)(a) as this places him in no stronger position than he was in under section 5(2)(b). This means that the goods/services unsuccessfully opposed by Mr Deakin remain unsuccessfully opposed. Furthermore, NDL would also have succeeded in its opposition to the MASTER DEAKIN SON OF MR DEAKIN mark for similar reasons to that expressed in paragraph 38 (with the conflict this time being between DEAKINS and a mark with DEAKIN as its most prominent element). I have borne in mind in this paragraph the later material dates, but the evidence does not paint a materially different picture.

### **SECTION 3(6)**

40) For sake of procedural economy, I do not consider it appropriate to go into this ground of opposition save for when it is necessary to do. It is only necessary to do so in relation to opposition 2501575, and then only in so far as the following goods/services are concerned:

**Class 18:** Leather and imitations of leather); trunks and travelling bags; vanity cases; holdalls, back packs and rucksacks; wallets, key cases, pouches; credit card cases, tote bags, bottle bags, record bags, book bags; sports bags; shopping bags; luggage and suitcases, weekend bags; jewellery rolls; attaché cases and briefcases; umbrellas, parasols and walking sticks; parts and fittings for all the aforesaid goods

**Class 35:** Retail services connected with the sale of leather and imitations of leather and goods made of these materials (not included in other classes), bags, trunks and travelling bags, vanity cases, holdalls, back packs and rucksacks, wallets, key cases, purses and pouches, credit card cases, tote bags, bottle bags, record bags, book bags, handbags, sports bags, shopping bags, luggage and suitcases, weekend bags, jewellery rolls, attaché cases and briefcases, umbrellas, parasols and walking sticks; advertising services; information relating to all these services.

41) In respect of section 3(6) of the Act, Mr Deakin's claim is that NDL is attempting to move away from its name of NICHOLAS DEAKINS in order to progressively use a mark similar to those of Mr Deakin so as to benefit from Mr Deakin's reputation as a shoe designer. As stated earlier, both parties have filed evidence relating to the relationship that existed between Mr Deakin and NDL's predecessor. Whilst it has all been borne in mind, I do not consider it necessary to undertake a detailed analysis of such evidence. This is for two reasons; firstly, there is no strong evidence pointing to the alleged intention of NDL, but, more importantly, in relation to the residue of the goods and services under consideration, none of which relate to shoes or the design of shoes, then it is difficult to see how the filing of the mark for such goods would take advantage of a claimed reputation of a shoe designer. **The claim under section 3(6) is dismissed.**

### **CONCLUSION**

42) The outcome of the above findings is that the oppositions to all of the applications succeed save for application 2501575 which only partially succeeded; the goods/services on which the opposition failed (and which should therefore achieve registration) are:

**Class 18:** Leather and imitations of leather; trunks and travelling bags; vanity cases; holdalls, back packs and rucksacks; wallets, key cases,

pouches; credit card cases, tote bags, bottle bags, record bags, book bags; sports bags; shopping bags; luggage and suitcases, weekend bags; jewellery rolls; attaché cases and briefcases; umbrellas, parasols and walking sticks; parts and fittings for all the aforesaid goods

**Class 35:** Retail services connected with the sale of leather and imitations of leather and goods made of these materials (not included in other classes), bags, trunks and travelling bags, vanity cases, holdalls, back packs and rucksacks, wallets, key cases, purses and pouches, credit card cases, tote bags, bottle bags, record bags, book bags, handbags, sports bags, shopping bags, luggage and suitcases, weekend bags, jewellery rolls, attaché cases and briefcases, umbrellas, parasols and walking sticks; advertising services; information relating to all these services.

43) In relation to costs, it is noted that NDL have won two oppositions but partially lost the other, and vice versa from Mr Deakin's perspective. However, I bear in mind that the statements of case on all were broadly similar and that the proceedings were consolidated which will have kept the costs relating to evidence in check and that only one hearing took place. The measure of success/failure achieved by the parties is, therefore, roughly equal in relation to the primary battleground of class 25. However, I think it fair to reflect the fact that NDL's official fees were for filing two oppositions as opposed to one by Mr Deakin (in effect, NDL receiving £400 for its official fees but balanced by Mr Deakin's opposition fee of £200; so making an award of £200 in NDL's favour). I have borne in mind that the opposition launched by Mr Deakin was not fully successful, but the evidence and submissions relating to the unsuccessfully opposed goods and services were limited, therefore, I do not consider it appropriate to make a specific award for this. I therefore order Mr Justin Deakin to pay Nicholas Deakins Limited the sum of £200. The above sum should 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 16<sup>th</sup> day of April 2012**

**Oliver Morris  
For the Registrar,  
The Comptroller-General**