

**DECISION OF THE CONTROLLER OF PATENTS, DESIGNS AND TRADE
MARKS IN PROCEEDINGS UNDER THE TRADE MARKS ACT, 1996**

BETWEEN

SHOE CITY LIMITED

Applicant

and

PLANET FASHIONS LIMITED

Opponent

CONCERNING

Trade Mark Application No. 2006/00254 (233591)

PLANETFOOTWEAR (and device)

Background

1. On 31 January, 2006, Shoe City Limited of 44 James Place East, Dublin 2 (trading at Dundalk Road, Castleblayney, Co. Monaghan) made application (No. 2006/00254) under Section 37 of the Trade Marks Act, 1996 ("the Act") to register the sign shown below as a trade mark in respect of goods in Class 25, namely, clothing, footwear and headgear.



2. The application was accepted for registration and advertised accordingly under No. 233591 in Journal No. 2043 on 5 April, 2006.

3. Notice of opposition to the registration of the mark pursuant to Section 43 of the Act was filed on 3 July, 2006 by Planet Fashions Limited, a British company of Windsmoor House, Lawrence Road, London N15 4EP, United Kingdom. The Applicant filed a counter-statement on 28 September, 2006 and evidence was subsequently filed by the parties under Rules 20, 21 and 22 of the Trade Marks Rules, 1996 (“the Rules”).
4. The opposition became the subject of a hearing before me, acting for the Controller, on 7 May, 2009. The parties were notified on 22 May, 2009 that I had decided to uphold the opposition and to refuse registration of the trade mark. I now state the grounds of my decision and the materials used in arriving thereat in response to a request by the Applicant in that regard pursuant to Rule 27(2) filed on 8 June, 2009.

Scope of the opposition

5. The notice of opposition lists eleven grounds of opposition across four different Sections of the Act but the great majority of these were not particularised in the notice of opposition nor substantiated in the evidence subsequently filed by the Opponent. The only grounds of opposition that may be said to have been shown to have any basis are those that arise under Section 10 of the Act and which are based on the Opponent’s registration and claimed use of the trade mark PLANET, which is registered under No. 128964 as of 14 November, 1988 in respect of articles of clothing included in Class 25, footwear and headgear. I have therefore confined my decision to a determination of the grounds of opposition under Section 10 of the Act as set out in paragraphs 5-8 of the notice of opposition, namely, those under subsections (1), (2) and (3) of Section 10.

The evidence

6. Evidence submitted by the Opponent under Rule 20 consisted of a Statutory Declaration dated 3 September, 2007 of Daphne Valerie Cash, its Company Secretary. Evidence submitted by the Applicant under Rule 21 consisted of a Statutory Declaration dated 28 November, 2007 of Leo McArdle, its Company Secretary. Evidence in reply submitted by the Opponent under Rule 22 consisted of a further Statutory Declaration (and Exhibit PF1), dated 1 August, 2008 of Daphne Valerie Cash.

7. In my opinion, the evidence filed does not serve to establish any fact that is relevant to the matters that I have to decide. It is mainly taken up with expressions of opinion on the merits of the opposition and the only matter of relevant fact addressed in the evidence is whether or not the Opponent has used its trade mark PLANET in this jurisdiction. The Applicant's evidence is to the effect that it could discover no use of that trade mark by the Opponent, to which the Opponent replied in evidence that the mark has been used and continues to be used in Ireland. However, the Opponent offered no proof in support of that claim.

The hearing and arguments presented

8. At the hearing the Applicant was represented by Leigh Hamilton, BL instructed by Woods Ahern Mullen, Solicitors. The Opponent was not represented.
9. In her submissions in support of the application, Ms. Hamilton invited me to regard the opposition as having been effectively abandoned by the Opponent in light of the delay by the Opponent in attending to the filing of evidence in the case and, more particularly, the fact that the Opponent had failed even to be represented at the hearing. As to the substance of the opposition under Section 10, Ms. Hamilton argued that the trade mark seeking registration and the Opponent's earlier trade mark could not be said to be identical as there were clear differences between them which could not go unnoticed by the average consumer. There was no evidence of any use whatsoever of the Opponent's trade mark in this jurisdiction so that there could be no question of consumers assuming a connection between goods sold by the Applicant under the mark applied for and goods that they already know by reference to the Opponent's trade mark. Even assuming a notional use of the Opponent's earlier trade mark, the differences between the earlier mark and the Applicant's mark, when assessed in its totality and not artificially broken up into separate elements, were such that confusion was unlikely in practice. In this latter regard, Ms. Hamilton asserted that the mark applied for, although presented in black and white on the application for registration, is used in a distinctive lilac colour, which further distinguishes it from the Opponent's trade mark.

Grounds of decision

Preliminary matter – abandonment of opposition

10. The notice of opposition in this case was filed within the period of three months of publication of the application specified in Rule 18 of the Rules. The Opponent subsequently filed evidence under Rule 20, as it was required to do lest it be deemed to have abandoned the opposition pursuant to Rule 20(2). At the time of the appointment of the hearing, the Opponent was represented by FRKelly, Trade Mark Agents, who indicated, within the period specified in Rule 25(2), that the Opponent would be represented at the hearing. Groom Wilkes & Wright LLP of the United Kingdom subsequently took over from FRKelly as the Opponent's representative and indicated, in the course of a telephone enquiry as to the procedures surrounding the hearing, that the Opponent would probably not be represented. As stated above, the Opponent was not represented at the hearing.
11. In my opinion, the consequence that ensued from the circumstances outlined is, quite simply, that the Opponent lost its opportunity to be heard as regards the merits of the opposition. There is no provision in the Act or the Rules to the effect that an opponent who does not attend a hearing thereby abandons his opposition and it would be going too far to infer from the manner in which the Opponent has pursued this case that the opposition has been abandoned. In Case No. T-171/06 *Laytoncrest Ltd. –v- OHIM and Erico International Corp.*, the Court of First Instance of the European Communities (Third Chamber) found that *“the applicant’s procedural inactivity at the stage of the opposition and appeal proceedings could not be treated ... as constituting a situation in which the applicant had implicitly withdrawn its Community trade mark application”*. Of course, that case was decided by reference to its own facts and within a different legislative context but the principles of interpretation underlying the decision support the proposition that an implicit abandonment of the opposition cannot be inferred in this case. I have decided, therefore, that the opposition should not be treated as having been abandoned.

Section 10

12. The relevant parts of Section 10 of the Act, insofar as this case is concerned, read as follows:

10-(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if because –

(a) it is identical with an earlier trade mark and would 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 would 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 of the later trade mark with the earlier trade mark.

(3) A trade mark which is identical with or similar to an earlier trade mark shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the State (or, in the case of a Community trade mark, in the Community) and the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier trade mark.

Section 10(1) and Section 10(2)(a) – identical trade marks

13. For either Section 10(1) or Section 10(2)(a) to apply, the trade mark seeking registration and the earlier trade mark would have to be identical. Clearly, they are not identical in the ordinary sense of the word in that one does not replicate the other exactly with nothing added and nothing omitted. However, in Case No. C-291/00 *LTJ Diffusion SA –v- Sadas Vertbaudet SA*, the European Court of Justice (ECJ) found that, in addition to the ordinary meaning of “identical”, a sign propounded for registration is identical with an earlier trade mark if, “*viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer*”.

14. The differences between the mark that the Applicant seeks to register and the Opponent’s earlier trade mark consist of the figurative element of an encircled and stylised “p” or “fp” and the word “footwear” as part of the composite word “planetfootwear”, which is presented in lower case letters. The figurative element of the Applicant’s mark is centrally positioned and much larger than the word element beneath it. It is, in nature, more than mere decoration or embellishment. It gives the impression, rather, of having been specifically designed to convey a

certain image in the manner of a corporate logo. When the mark is viewed as a whole, the figurative element strikes the eye and the mind in such a way that I find it inconceivable that it could go unnoticed by any observer. I am satisfied, therefore, that the Applicant's mark cannot be said to be identical with the Opponent's earlier mark, even within the wider interpretation of the concept of identity given by the ECJ. For that reason, I have decided that the opposition under Section 10(1) and Section 10(2)(a) should be dismissed.

Section 10(2)(b) – likelihood of confusion

15. Though not identical, the respective trade marks in this case are clearly similar. The entire of the Opponent's earlier trade mark, the word "planet", is contained within the Applicant's trade mark and is presented in a different shading to the word "footwear" with which it is conjoined, which emphasises its separate, individual identity. Also, the goods for which the Applicant seeks registration of its trade mark are identical with those for which the Opponent's earlier trade mark is protected. Thus, the basic "ingredients" of an objection under Section 10(2)(b) – similar marks and identical goods – are present in this case and the question to be addressed is whether there is a resultant likelihood of confusion on the part of the public.

16. That likelihood is to be appreciated globally, taking into account all factors relevant to the circumstances of the case¹. These include the degree of similarity between the respective trade marks and the respective goods, the distinctiveness of the earlier trade mark, the nature of the goods and the circumstances of the trade in them. In assessing the degree of similarity of the trade marks, it is necessary to make a global appreciation of the visual, aural and conceptual similarity between them based on the overall impression given by the marks, having regard to their distinctive and dominant components. Regard must also be had to the fact that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.

Comparison of the marks

17. Applying those principles of interpretation to the present case, I would say that the degree of similarity between the marks is very high. The Opponent's trade mark consists of the single word PLANET so that the overall impression formed

¹ ECJ in Case No. C-251/95 *Sabel BV –v- Puma AG and Rudolf Dassler Sport*

by it is determined by the look, the sound and, most importantly, the meaning of that word. I say that the meaning of the Opponent's mark is the most important factor because the identity of a mark that consists of a dictionary word is apt to be heavily influenced, if not determined, by the meaning of that word. It is the meaning of the word which creates the mental image of the brand that the average person carries in his mind. Thus, clothing brands such as DIESEL, DOCKERS and GAP are remembered less by their look or sound as by the concepts expressed by the respective words. The same may be said of PLANET, in my opinion. The overall impression given by the Applicant's mark is also greatly influenced by the word "planet". That is the distinctive component of the composite term "planetfootwear" since the element "footwear" describes the goods or field of activity of the Applicant and cannot, therefore, be regarded as a distinctive component of the mark. The figurative element of the Applicant's mark is also clearly a distinctive component and must be given due regard in the assessment of the overall impression given by the mark. However, because the word "planet" in the Applicant's mark tends to "speak" to the consumer and the figurative element conveys a less certain and memorable impression, I think it is right to say that the overall impression given by the mark is predominantly formed by the word "planet", which gives the brand its identity.

18. In assessing the overall impression formed by the Applicant's trade mark, I have taken account of the possibility that the message of the mark may be understood in more than one way. On the one hand, "planetfootwear" may be perceived in the sense of "brand name + product type" as in footwear branded as "planet". On the other hand, it may also be understood as suggesting a planet of footwear or a planet named "footwear". Although the latter perception is less closely aligned with the conceptual impact of the Opponent's trade mark, nevertheless it still expresses the basic idea of a planet, which is common to both trade marks. In summary, I think the concepts expressed by the respective trade marks are the most significant factors in determining the overall impressions given by them and that those concepts are highly similar.

Distinctiveness of the earlier mark

19. As regards the distinctiveness of the earlier trade mark, PLANET, I take the view that it is a mark that displays more than the minimum level of distinctiveness required for registration. It consists of a word which, while not an invented word of the Opponent's own making, is completely unrelated to the goods for which it

is protected or to any characteristic of those goods. It is inherently distinctive in relation to goods in Class 25. I am not prepared to attribute any additional, factual distinctiveness to the mark arising from its use in relation to the goods of the registration because the Opponent has not given any reliable evidence of use. Of course, the Opponent's registration constitutes an earlier trade mark as against the Applicant's mark and I must assume a notional use of it for the purposes of the determination of the likelihood of confusion.

The goods, the consumer and the circumstances of trade

20. The goods under consideration are ordinary consumer goods, which are aimed at consumers generally so that the average consumer must be seen as being the average person. Clothing, footwear and headgear are goods in respect of which brand identity plays an important part in the average consumer's selection. The goods are usually purchased following a visual inspection of them, rather than by being asked for or ordered by name, and they are often tried on by prospective purchasers. The average consumer may be expected to pay a fair degree of attention to the selection and purchase of these goods because of issues of personal taste and cost but not the very highest degree of attention that might be expected as, for example, in the case of very high value goods.

Likelihood of confusion

21. Having regard to all of the foregoing, the question to be considered is whether it is likely that the average person who had once encountered clothing, footwear or headgear products for sale under the trade mark PLANET would be confused if he were to subsequently encounter the like goods offered for sale under the mark seeking registration. Confusion in this sense may be direct, in the sense that the consumer believes the goods to emanate from the same commercial source as those that he knows by reference to the earlier trade mark, or indirect, in the sense that he assumes a connection between the undertaking responsible for the goods and the proprietor of the earlier trade mark.

22. Having given the matter careful consideration in the light of my analysis of the relevant factors as set out above, I have come to the conclusion that, insofar as footwear goods are concerned, direct confusion is more likely than not because of the fact that the message of the Opponent's mark, which forms its identity, is repeated in the Applicant's mark and is also central to the overall impression given by the latter. I have not discounted the differences between the marks

created by the figurative element and the word “footwear” in the Applicant’s mark. However, I do not believe those differences to be sufficient to obviate the likelihood of confusion, particularly having regard to the fact that the likelihood of confusion must be assessed, not by reference to a side-by-side, direct comparison of the marks but on the basis of the imperfect recollection of the average consumer. Put simply, I think the average person who knew of shoes marketed under the trade mark PLANET and who encountered shoes branded with the figurative “planetfootwear” mark would undoubtedly make a connection between the two and would, in all probability, think that they were one and the same brand.

23. As to the other goods covered by the application and for which the earlier trade mark stands registered, namely, clothing and headgear, the fact is that the Applicant is a footwear company and it was intimated at the hearing that this is its primary focus so that the question of likelihood of confusion in relation to clothing and headgear products is somewhat academic. Nevertheless, the filing of the application implies an intention to use the mark on all of the goods included in the application² and a decision in relation to clothing and headgear is also required. In that regard, I take the view that the use of the Applicant’s mark in relation to those goods would be likely to lead to indirect confusion, having regard to a notional prior use of the Opponent’s trade mark. Although the inclusion of the word “footwear” as an element of the Applicant’s mark would serve to set it apart somewhat from the Opponent’s mark in the context of clothing and headgear products, nevertheless, I think that the average consumer would perceive the Applicant’s mark as connected with the PLANET brand, perhaps as a sub-brand denoting a specialised line of goods (footwear) from the makers of PLANET clothing. The notion of the extension of a brand name from clothing to footwear is not unusual (WRANGLERS is an example) so that the use of the “planetfootwear” device mark in relation to clothing or headgear, though somewhat incongruous, would, in my view, suggest to the average consumer that a connection existed between that mark and the PLANET brand of clothing, headgear and footwear, which the consumer must be assumed to know. The result would be confusion of the kind that Section 10(2) of the Act seeks to avoid. For these reasons, I have decided that the opposition under Section 10(2)(b) of

² the application itself actually contains a claim that the mark is being used in relation to the goods specified

the Act should be upheld and that the application for registration should be refused.

Section 10(3)

24. The Opponent's objection under Section 10(3) of the Act depends on its claim, expressed in paragraphs 7 and 8 of the notice of opposition, that its earlier trade mark PLANET has a reputation in the State. The Opponent did not provide any evidence in support of that claim when challenged by the Applicant so that its objection under Section 10(3) must be dismissed.

Tim Cleary

Acting for the Controller

22 June, 2009