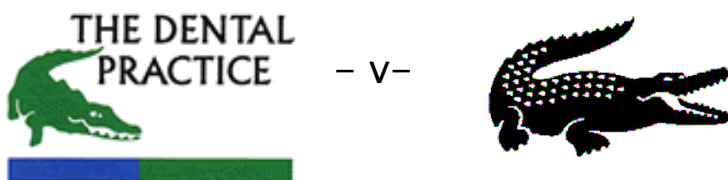




IP Briefing

January 2008

Crocodile attack dentists bite back



Cheltenham dentists Drs Simon Moore and Tim Rumney have succeeded in resisting a second challenge to their trade mark for dentistry services, which features a crocodile logo, from the clothing label established by former French tennis star René Lacoste.

La Chemise Lacoste (SA) (“**Lacoste**”) claimed that The Dental Practice logo was confusingly similar to its own iconic logo used for clothing, bags, sunglasses and fragrances and had opposed its registration and that it took unfair advantage of Lacoste’s reputation.

Having considered the evidence of both parties the Trade Marks Registry found in favour of the dentists application and dismissed Lacoste’s opposition.

Lacoste appealed, arguing that the Hearing Officer had: attributed too much importance to the words THE DENTAL PRACTICE; unduly emphasised the differences rather than the similarities between the two crocodile elements; and failed to consider Lacoste’s reputation in the earlier mark.

Key recommendations

- Carry out searches to make sure your intended mark is free to use.
- Register all of your trademarks, trade names, brands and logos for the widest protection.
- Set up effective watching services to monitor and guard against subsequent filings, infringement and dilution of your prior rights.
- Maintain accurate, complete and up to date records of sales revenue and advertising costs.
- Be prepared to act quickly.

The appeal was made on the basis that The Dental Practice trademark is similar to one of Lacoste's earlier trademarks, which it had registered in all 45 international classes (apart from class 08) including medical services, and that there is a likelihood of confusion between the two competing trademarks.

The gist of Lacoste's opposition and appeal was that the average consumer would be confused into thinking that the services provided by The Dental Practice were being provided by Lacoste or that The Dental Practice itself was in some way associated with Lacoste.

Even though it is not necessary to make a side-by-side comparison of the marks and more emphasis is put on the overall impression they create, as it is generally accepted in trademark law that consumers have imperfect recollection and rarely have the opportunity to make such comparisons, the appeal failed.

The marks were found to be visually, aurally and conceptually different. When considered the overall it was held that these differences would be apparent to the average consumer of dental services. It was also determined that Lacoste could not rely on its greater reputation when it had failed to show that it had used its trademarks for medical (or dental) services.

Although Lacoste has succeeded against many would-be infringers in this instance the dentists were able to show that their mark was sufficiently different and that they had a legitimate right to continue using it and to register it as a trademark.

Berg Legal provides a full range of intellectual property services including: licensing, enforcement of IP rights, trademark and design registrations and brand management.

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