TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2023410
IN THE NAME OF SPORTS DIRECT LIMITED
TO REGISTER A MARK IN CLASS 32

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO 45234 BY TWIN LABORATORIES, INC

TRADE MARKS ACT 1994

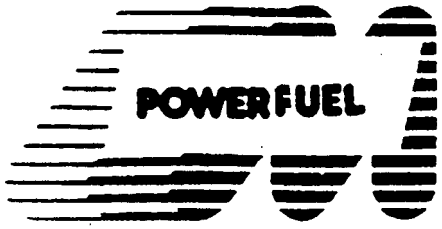
IN THE MATTER OF Application No 2023410
in the name of Sports Direct Limited
to register a mark in Class 32

and

IN THE MATTER OF Opposition thereto
under No 45234 by Twin Laboratories, Inc

DECISION

On 9 June 1995 Sports Direct Limited applied to register the following mark in Class 32 for a specification of goods comprising "non-alcoholic drinks and beverages; preparations for making drinks and beverages".



The application is numbered 2023410.

On 28 August 1996 Twin Laboratories, Inc filed notice of opposition to this application. The opponents' grounds of opposition are wide-ranging and specifically refer to Sections 1, 3(1)(a) and (b), 3(3)(b), 3(4), 3(6), 5(2)(b), 5(3)(a) and (b), and Section 5(4)(a) and (b). They also say that as at 9 June 1995 the trade mark POWER FUEL was a trade mark entitled to protection under the Paris Convention as a well known trade mark and, therefore, objection arises under Section 6(1)(c). The opponents ask for an award of costs in their favour.

The applicants did not file a counterstatement and neither side has filed any evidence.

The matter came to be heard on 24 June 1998 when the opponents were represented by Mr C Morcom of Her Majesty's Counsel instructed by Trade Mark Owners Association

Limited, their trade mark agents and the applicants by Ms V A B Lawrence of AA Thornton & Co, their trade mark attorneys.

I have not summarised the individual grounds of objection referred to above as it will be apparent that most of them cannot succeed in the absence of evidence. At the hearing Mr Morcom confirmed that he would be making submissions in relation to two grounds only, namely Sections 3(1)(b) and 5(2)(b). Accordingly all the other grounds fall away and I need not consider them further.

Section 3(1)(b) prohibits the registration of marks which are "devoid of any distinctive character". Mr Morcom, for the opponents, submitted that the mark at issue was made up of non-distinctive elements. The word FUEL was, he suggested, a jargon term in the sense that the goods concerned would provide fuel for the body. The word POWER was also said to be non-distinctive. The other element of the mark was a letter M. Single letters are themselves not distinctive and in this case the letter is overshadowed by the word POWERFUEL. Ms Lawrence, not surprisingly, took a different view of the mark claiming that the word POWERFUEL is distinctive and the M logo highly stylised.

The term "fuel" is normally used to indicate a substance used to provide a source of heat, light and power. I have not been pointed towards any dictionary references which might suggest that it has passed into common usage in relation to food and drink in the sense of providing fuel for the body though it is not, perhaps, difficult to envisage such usage taking place. However it is the mark as a whole I must consider and I do not for the purpose of these proceedings need to take a view on the merits or demerits of this aspect of the mark. I have little hesitation in coming to the view that the presentation of the mark as a whole (with the word POWERFUEL contained within a much larger and stylised logo) is such that it cannot be said to be devoid of distinctive character. The opposition under Section 3(1)(b) fails.

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

"……

(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."

The term "earlier trade mark" is itself defined in Section 6 as follows:

"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,

(b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), or

(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well known trade mark."

The opponents rely on the following registrations as earlier trade marks:

NUMBER	MARK	CLASS	JOURNAL	SPECIFICATION
1461937	CHROMIC FUEL	5	5931/5068	Pharmaceutical and veterinary substances; infants' and invalids' foods; preparations to be used as additives for food or as dietetic additives or supplements; vitamin, mineral and protein concentrates; all included in Class 5.
1551867	TWINLAB ULTRA FUEL	5	6051/7202	Pharmaceutical and veterinary substances; infants' and invalids' foods; preparations to be used as additives for food or as dietetic additives or supplements; vitamin, mineral and protein concentrates; all included in Class 5.

NUMBER	MARK	CLASS	JOURNAL	SPECIFICATION
2016661	HYDRA FUEL	5	6103/0556	Pharmaceutical and veterinary substances; infants' and invalids' foods; preparations to be used as additives for food or as dietetic additives or supplements; vitamin, mineral and protein concentrates.

I should add that the opponents refer in their statement of grounds to a number of overseas registrations. It is not suggested that they constitute earlier trade marks and Mr Morcom relied on the three UK registrations at the hearing. I do not, therefore, need to reproduce the information given in respect of overseas registrations.

Submissions before me concentrated primarily on the marks themselves and I do not think it is seriously disputed that similar goods are involved. I confirm that this is also my view. The "vitamin, mineral and protein concentrates", for instance, contained in the opponents' specifications could be the medicinal version of beverages covered by the applicants' Class 32 specification.

The central issue before me, therefore, is the similarity or otherwise of the respective marks. Mr Morcom relied principally on the marks HYDRA FUEL and, to a lesser extent, TWINLAB ULTRA FUEL. He acknowledged that CHROMIC FUEL was a rather different mark. Furthermore in the absence of evidence of use he did not rely on the opponents owning a "family" of marks. Rather he put his case on the basis of an association of ideas particularly as between HYDRA FUEL and the applicants' mark. HYDRA it was said, being close to HYDRO, is suggestive of power (as in hydro electric power) or perhaps health hydros. There was, he said, a risk of confusion arising from imperfect recollection or as a result of actual or potential purchasers assuming some sort of commercial connection arising from the respective marks. Ms Lawrence on the other hand said that the only common element was the word FUEL and that this was not in itself distinctive in relation to the goods. Furthermore the word was said to be disclaimed in the case of two of the opponents' marks which had been registered under the preceding law. In her view no trader can claim a monopoly in this word. She did not consider that there was any danger of a commercial connection being assumed as envisaged by Mr Morcom.

The comparison I have to make is between the opponents' word marks and the word and device mark belonging to the applicants. In Sabel BV v Puma AG (1998) RPC at page 224, in relation to Article 4(1)(b) of the first Council Directive of 21 December 1988, which corresponds directly with Section 5(2)(b) of the Act, the European Court of Justice, in dealing with the issue of comparison of marks, stated;

"Global appreciation of the visual, aural or conceptual similarity of the marks in question must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The wording of Article 4(1)(b) of the Directive - "There exists a likelihood of confusion on the part of the public" - shows that the perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the overall appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details."

It appears to be common ground between the parties that the word FUEL, the only common element, is non-distinctive and, on that basis, it seems to me that it must contribute little to the overall character of the respective marks. Mr Morcom had, therefore, to approach the matter from the point of view of the possible association of ideas created by the marks, particularly the opponents' HYDRA FUEL mark. The conceptual links he thus sought to establish are tenuous and indirect requiring as it does the dictionary word HYDRA to be seen as "hydro" and then to be associated with power. I think this is altogether too remote a connection for there to be any reasonable likelihood of confusion. Nor can I see any other basis in the submissions for coming to a different view.

The applicants' mark has in any case a strong visual impact which in my view puts the matter beyond doubt. In short the opposition under Section 5(2)(b) fails.

As the applicants have been successful in these proceedings they are entitled to a contribution towards their costs.

I order the opponents to pay the applicants the sum of £235.

Dated this 7th day of July 1998

M REYNOLDS
For the Registrar
the Comptroller General