

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2021940
BY J TILLEARD TO REGISTER THE MARK
MOUNTAIN FOX IN CLASS 25**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No 45774 BY FJALLRAVEN AB**

TRADE MARKS ACT 1994

5 **IN THE MATTER OF Application No 2021940**
by J Tilleard to register the mark Mountain Fox
in Class 25

and

10 **IN THE MATTER OF Opposition thereto under**
No 45774 by Fjällräven AB

15 **DECISION**

On 6 May 1995 Mr J Tilleard applied to register the mark MOUNTAIN FOX in Class 25 for a
specification of goods which reads "leisurewear; but not including any such goods made from
20 or consisting of fox fur".




The application is numbered 2021940.

On 24 October 1996 Fjällräven AB filed notice of opposition to this application (the company
25 name is in fact spelt Fjällrävan in the notice of opposition but I take this to be clerical error
given the way the company name is spelt elsewhere in the evidence).

- (i) under Section 3(1)(a)(b)(c) and (d). The grounds follow the wording of the
relevant paragraphs without further commentary
- 30 (ii) under Section 5(2)(b) having regard to earlier trade marks in the ownership of
the opponents (see below for details)
- (iii) under Section 5(3), 5(4)(a) and 5(4)(b) where again the wording of the
35 objections substantially follows the wording of the relevant provisions of the
Act.

There is also reference to an objection under Section 5(6) based on bad faith. As there is no
such Section I take this to be an intended reference to Section 3(6). Finally the opponents ask
40 for refusal in the exercise of the Registrar's discretion and reserve their right to seek leave to
augment or amend the above grounds. As has been said now in many decisions there is no
discretionary power to refuse an application which otherwise meets the requirements of the
Act. I also regard it as unacceptable for an opponent to couch their pleadings in terms which
leave the door open as it were to add to them at a later date.

45 Details of the registrations relied on by the opponents are as follows:

No	Mark	Class	Journal	Specification
5 1034447		18	5070/2359	Ruck-sacks, trunks and suitcases, and bags included in Class 18
15 1034448		22	5090/0541	Ropes, strings, nets, sacks and padding and stuffing materials, all included in Class 22, tents, tarpaulins, awnings (textile) and raw fibrous textile materials
30 1034449		25	5104/1317	Articles of outerclothing

40 The applicant filed a counterstatement denying the above grounds. Both sides ask for an award of costs in their favour.

45 Only the opponents filed evidence. The matter was set down for a hearing but in the event the parties indicated that they would be content to have a decision from the papers. Acting on behalf of the Registrar and after a careful study of the papers I give this decision. In doing so I take account of the written submissions that have been made.

Opponents' evidence

The opponents filed a declaration dated 5 June 1997 by Kjell Apelquist, their Managing Director, a position he has held since 1991. He confirms that he understands English.

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Mr Apelquist says that the trade mark (presumably meaning the one referred to in the statement of grounds and set out above) has been used in Great Britain and Northern Ireland since 1983 in relation to rucksacks, tents, sleeping bags, outdoor accessories and clothing. Examples are shown at Exhibit KA1.

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Turnover is said to have been as follows:

	YEAR	APPROXIMATE ANNUAL TURNOVER	APPROXIMATE NUMBER OF UNITS SOLD
15		£	
	1987	129,568	5,300
	1988	34,744	1,450
	1989	-	
20	1990	-	
	1991	-	
	1992	9,356	350
	1993	34,605	550
	1994	280,475	13,200
25	1995	264,879	13,000
	1996	293,167	13,960

A selection of advertising and promotional material showing use of the mark is exhibited at KA2.

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Expenditure on advertising and promotional activity is said to be:

	YEAR	APPROXIMATE ADVERTISING EXPENDITURE
35		£
	1987	68,000
	1988	93,000
	1989	21,000
	1990	-
40	1991	-
	1992	-
	1993	-
	1994	24,845
	1995	41,147
45	1996	31,705

Goods have been sold in a large number of the principal towns and cities in Great Britain (these are listed but I do not need to record full details here). As a result of the above activity the opponents say they have acquired a substantial reputation and goodwill in their fox device mark.

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That concludes my review of the evidence.

The evidence before me in this action is fairly brief as can be seen from the above summary. I will say at the outset that I cannot see any basis in that evidence for the Section 3 grounds. As indicated the opponents, in their statement of grounds, have followed the wording of the Act but without any further particularisation of their objections. I dismiss all the Section 3 grounds without further ado save for Section 3(6) where written submissions have been received to the effect that:-

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“The opponent has sold goods in the United Kingdom under the Mountain Fox device since 1983 in a small and specialised field where the names of suppliers such as the opponent and, for example, Lowe Alpine, are well known. The applicant has picked the English version of the opponent’s name which is not an obvious choice of mark in the United Kingdom where mountain foxes are not found. Furthermore, the applicant has chosen to adopt a virtually identical device mark illustrating a mountain fox which the opponents submit goes beyond the bounds of coincidence and must indicate a knowledge of the opponents’ mark, products and reputation”.

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It seems that the applicant uses a fox and mountain motif in addition to the words MOUNTAIN FOX. Hence the above reference to the applicant’s device mark. Although that mark itself is not an issue before me, Mr Tilleard has not sought to conceal its existence. I note that it appears on correspondence and Mr Tilleard shows it as part of his written submissions. It is a stylised representation of, presumably, a fox with mountain peaks in the background - a visual expression of the words MOUNTAIN FOX one might say. However, I have no basis for concluding that the applicant’s mark was chosen with any improper motive or that Mr Tilleard was aware of the opponents (or the translated meaning of their name). The opposition under Section 3(6) fails.

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Section 5(2)(b) reads:

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

(a)

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(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,

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There exists a likelihood of confusion on the part of the public, which concludes the likelihood of association with the earlier trade mark”.

The correct approach to the interpretation of the expression “a likelihood of confusion on the

part of the public” as used in article 4(1)(b) and section 5(2) was considered by the European Court of Justice in Case C-251/95 *Sabel BV v. Puma AG, Rudolf Dassler Sport* [1998] RPC 199. The way in which the presence or absence of a “likelihood of confusion” should be assessed was identified in paragraphs 23 and 24 of the judgment of the court at 223:

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“Article 4(1)(b) of the Directive does not apply where there is no likelihood of confusion on the part of the public. In that respect, it is clear from the tenth recital in the preamble to the Directive that the appreciation of the likelihood of confusion depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign, and between the goods or services identified’. The likelihood of confusion must therefore be appreciated globally taking into account all factors relevant to the circumstances of the case.

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That global appreciation of the visual, aural or conceptual similarity of the mark 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 global 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.

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In that perspective, the more distinctive the earlier mark the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that the two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either *per se* or because of the reputation it enjoys with the public”.

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Furthermore it is said

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“However, in circumstances such as those in point in the main proceedings, where the earlier mark is not especially well known to the public and consists of an image with little imaginative content, the mere fact that the two marks are conceptually similar is not sufficient to give rise to a likelihood of confusion.

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The answer to the national court’s question must therefore be that the criterion of “likelihood of confusion which includes the likelihood of association with the earlier mark” contained in Article 4(1)(b) of the Directive is to be interpreted as meaning that the mere association which the public might make between two trade marks as a result of their analogous semantic content is not in itself a sufficient ground for concluding that there is a likelihood of confusion within the meaning of that provision”.

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I do not think there can be any doubt that the applicant’s goods are the same as the opponents’ Class 25 goods. The matter, therefore, turns on the marks themselves. The opponents have referred me to, and I take note of, *Dewhursts Application* 1896 RPC 288

(The Golden Fan Brand) case. Given that the earlier trade marks relied on by the opponents are device marks and the applicant's mark is the words MOUNTAIN FOX visual and aural confusion are not in play. It is really a question of whether conceptual confusion may arise as a result of the possibility that the respective marks may convey the same idea or be referred to in similar terms, and if so, whether in terms of global appreciation of the matter, there is a likelihood of confusion within the meaning of Section 5(2)(b) having regard to the ECJ's guidance.

The Sabel v Puma case referred to above involved two devices of animals that might at one level be said to have certain conceptual similarities. The guidance referred to above indicates that "..... the mere association which the public might make between two trade marks as a result of their analogous semantic content is not in itself sufficient ground for concluding that there is a likelihood of confusion within the meaning of that provision [Article 4(1)(b)]". The pictorial representations in that case are of bounding feline beasts of prey in, it is fair to say, reasonably naturalistic poses and, save that one device is in silhouette form, unstylised in presentation. The opponents' device mark in the case before me is, by comparison, a highly stylised representation of an animal, whether it be a fox, a wolf or something similar. The body of the animal has been compressed into what at first glance looks like a moon shape. The head of the animal with a single visible eye has the appearance of being almost disconnected from the body. It is in short a visually striking image. In the context particularly of clothing, where visual display and selection is extremely important, it is the impact of the mark on the eye that is likely to represent its main attractive force.

How the opponents' mark is known or referred to has not been the subject of evidence before me save in one limited respect on which I will comment later. The "recognition of the trade mark on the market" can only therefore, be judged in terms of the bare facts of the trading history set out in the evidence. This suggests that the opponents' device mark is used largely (but not quite exclusively) in conjunction with the word Fjällräven. In this respect I note that the written submissions suggest that Fjällräven is the Swedish word for mountain fox. It is not clear to me from the statement of grounds or evidence that any such claim has ever been formally advanced let alone substantiated in evidence. More significantly, however, the opponents do not claim Fjällräven as an earlier trade mark. Their use of the device in combination with the word Fjällräven can only, in my view, be considered in the context of the ground based on Section 5(4)(a) (see below).

Taking all the above factors into account and even allowing for the fact that the opponents' device might be seen as stylised representation of a fox I have come to the clear view that there is no likelihood of confusion on the part of the public. The opposition fails under Section 5(2)(b).

The written submissions received from the opponents on relative ground issues concentrate on Section 5(2)(b) but do not go so far as to withdraw the other grounds. I do not propose to comment in detail on the Section 5(3) ground. In the light of my finding on the marks they cannot be in any better position in relation to use of the mark on dissimilar goods. That ground also falls away.

In the light of my above comments I can also deal fairly briefly with the objections under Section 5(4) which reads:

5 “(4) 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

10 (b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

15 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”.

The reference in the grounds to Section 5(4)(b) is neither explained or substantiated. I do not propose to consider it further. In the absence of any further or better particularisation of the Section 5(4)(a) ground I take it to be a claim that use of the mark applied for would be liable to be prevented by the law of passing-off. A summary of the elements of an action for passing-off were set out by Geoffrey Hobbs QC sitting as the Appointed Person in WILD CHILD Trade Mark, 1998 RPC 455 at page 460 line 5 to page 461 line 22. Briefly the opponents are required to establish that they have goodwill in an indicum, that there will be an operative misrepresentation and that there will be consequential damage.

On the basis of the evidence filed somewhat different considerations arise in relation to Section 5(4)(a) because the mark or sign used is a composite one consisting of the word or words Fjällräven and the device (as opposed to the device (only) mark that has been considered under Section 5(2)(b)). It is said that Fjällraven is Swedish for mountain fox though the point has not been formally taken or substantiated. This is not to say it could not be so substantiated though some care would be needed as even the opponents’ own submissions suggest (by reference to exhibit KA2) that it can also be translated as polar fox. More significantly however there is nothing to indicate that their mark is promoted by reference to its translated meaning or that it is known or recognised by customers under that meaning. The documentation at Exhibit KA2 suggests quite the opposite. In their written submissions Haseltine Lake, the opponents’ Trade Mark Attorneys, point to an article in Outdoor & Country Clothing magazine (an item in KA2) which contains the following “Fjällräven - which translated means “mountain fox” - based 500 kilometres north of Stockholm.....”. I cannot see, and my attention has not been drawn to, any other such references in the bundle of advertising and promotional material that make up Exhibit KA2. I find this passing reference wholly inadequate to support any claim under this head. It follows that the opponents are in no better position under Section 5(4)(a) as even if goodwill were established there could in my view be no misrepresentation or damage. The Section 5(4)(a) ground fails.

As the opposition has failed the applicant is entitled to a contribution towards his costs. I order the opponents to pay the applicant the sum of £335.

5 **Dated this 15 day of September 1999**

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M REYNOLDS
For the Registrar
The Comptroller General