

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2134984
BY W MARLOW & SONS (FOOTWEAR) LTD
TO REGISTER A TRADE MARK IN
CLASS 25**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No 47807 BY KICKERS INTERNATIONAL BV**

TRADE MARKS ACT 1994

5 **IN THE MATTER OF Application No 2134984
by W Marlow & Sons (Footwear) Ltd to register
a trade mark in Class 25**

and

10 **IN THE MATTER OF Opposition thereto under
No 47807 by Kickers International BV**

15 **BACKGROUND**

On 4 June 1997 W Marlow & Sons (Footwear) Ltd of Leicester applied under the Trade
Marks Act 1994 to register the trade mark MOKKERS in Class 25 for a specification which
20 reads:

"Articles of footwear".

The application is numbered 2134984.

25 On 13 November 1997 Haseltine Lake Trade Marks on behalf of Kickers International BV of
the Netherlands filed a Notice of Opposition to the application for registration. The Grounds
of Opposition are in summary:-

30 1. Under Section 5(2) of the Act - because the trade mark the subject of the
application is similar to the opponents earlier trade marks in respect of identical or
similar goods. The opponents trade marks and the specifications of goods for which
they are registered are set out at Annex A.

35 2. Under Section 5(4) of the Act - because the opponent could prevent the applicants
use of their trade mark under the law of passing off.

40 3. Under Section 56 of the Act - because the opponents trade marks are well known
trade marks under the Paris Convention and they are entitled to restrain use of the
trade mark the subject of the application in suit.

4. Under Section 3(3)(b) of the Act - because the trade mark the subject of the
application is of such a nature as to deceive the public.

45 5. Under the provisions of Section 3(6) of the Act - because the application was made
in bad faith.

The opponents seek an award of costs in their favour.

The applicants for registration, through their trade mark agents, Serjeants, deny all of the Grounds of Opposition. In particular they state that the trade mark MOKKERS is not similar
5 to the trade mark KICKERS on which all of the Grounds of Opposition are founded and therefore there is no likelihood of confusion on the part of the public.

Both sides filed evidence in these proceedings under the provisions of the Trade Marks Rules but neither side have sought to make oral submissions. Therefore, after a careful study of the
10 papers I give this decision.

DECISION

I do not intend to summarise the evidence filed in these proceedings because, in my view, none
15 of it is at all relevant to the grounds of opposition pleaded. The absence of any evidence to support the Grounds of Opposition means that those based upon Section 5(3), Section 56, Section 5(4), Section 3(3)(b) and Section 3(6) can all be summarily dismissed because without evidence there are no relevant substantiated facts on which to base a decision.

Insofar as the Section 5(2) Ground of Opposition is concerned it is a matter which can be
20 determined without evidence because the actual facts are available and substantiated (the trade marks and the specifications of goods). Section 5(2) states:

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

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- (a) it is identical with an earlier trade mark and is to 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 is to be registered for goods or services
30 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.

In reaching a view of the matter I have regard simply to the approach adopted by the
35 European Court of Justice- in SABEL v PUMA 1998 RPC 199 at 224, Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc (Case C-39/97) and in Lloyd Schufabrik Meyer & Co GmbH v Klijsen Handel IBV (1999 ETMR 690 at 698) where:

40 **S** the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

S the matter must be judged through the eyes of the average consumer, of
45 the goods/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;

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

5 S the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components;

10 S a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

15 S there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it.

For convenience I set out the opponents' and applicants' trade marks below.

KICKERS

MOKKERS

20 Taking into account the points set out above, both trade marks have the suffix KERS and therefore both visually and aurally the endings of each trade marks are the same. However, there are significant differences between the prefixes of each trade mark (MOK and KIC). Sufficient differences, in my view, to ensure that both visually and aurally, when seen as
25 wholes, most members of the general public would regard these trade marks as different. This would be so even in a case such as this where the two trade marks might be seen alongside each other on identical goods as the respective specifications cover the same goods. In the circumstances I have no hesitation in finding that the applicants' and opponents' trade marks are not similar and that therefore there exists no likelihood of confusion on the part of the
30 public at large if the applicants trade mark is registered for the goods sought. The opposition under Section 5(2) fails.

35 As this opposition has failed completely I order the opponents to pay to the applicants the sum of £300 as a contribution towards their costs. This sum to be paid within 7 days of the expiry of the appeal period or within 7 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 8 day of August 2000

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**M KNIGHT
For the Registrar
The Comptroller General**

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MARK	REGISTRATION NO.	GOODS REGISTERED
KICKERS	1054447	Boots, shoes, slippers and sandals, and parts and fittings included in Class 25 for all the aforesaid goods, but not including any such goods for sports wear.
KICKERS	1067562	Articles of outerclothing; and parts and fittings therefore included in Class 25, but not including any such goods for sportswear.
KICKERS	1073957	Boots, shoes, sandals, and slippers, but not including any such goods for use in sports.