

TRADE MARK ACT 1994

**IN THE MATTER OF APPLICATION NUMBER 2133827
BY HALFORDS LIMITED TO REGISTER A TRADE MARK
IN CLASSES 9 & 25**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
NUMBER 47790 BY N V KIPLING**

TRADE MARKS ACT 1994

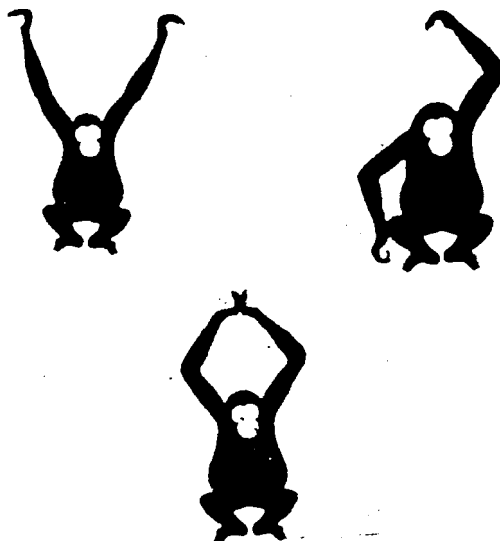
**IN THE MATTER OF Application Number 2133827
by Halfords Limited to Register a Trade Mark in
Classes 9 and 25**

and

**IN THE MATTER OF Opposition thereto Under
Number 47790 by N V Kipling**

BACKGROUND

1. On 23 May 1997 Halfords Limited applied to register the following trade mark:



Application for a series of three marks.

- in Class 9 for “Protective Clothing, headgear and masks” and in Class 25 for “Articles of clothing including headgear and footwear”.
2. The application was subsequently accepted by the Registrar and published in the Trade Marks Journal. On 12 November 1997 Stevens Hewlett & Perkins on behalf of N V Kipling filed a Notice of Opposition. In summary the grounds were:-

- (1) Under Section 3(1)(c) of the Act in that it consists exclusively of signs or indications which may serve in trade to designate the kind, quality and origin or other characteristics of the goods.
 - (2) Under Section 3(6) of the Act to the extent that the application was made in bad faith in respect of the application as filed.
 - (3) Under Section 5(2)(b) of the Act because the trade mark applied for is confusingly similar to trade mark registrations 1367448, 1367449, 1367450 and 1578841 in Classes 16, 18, 25 and 18 respectively, owned by the opponent and registered for the same goods and similar goods. Details of these registrations are at Annex One to this decision.
 - (4) Under Section 5(3) of the Act because the trade mark applied for is similar to the above mentioned trade marks owned by the opponent and is to be registered for some goods which are not similar to those for which the opponent's marks are registered and these earlier trade marks have a reputation in the United Kingdom so that use of the applicant's mark without due cause would take unfair advantage of or be detrimental to the distinctive character and repute of the earlier marks.
 - (5) Under Section 5(4) of the Trade Marks Act 1994 in that the opponent's mark is entitled to protection under Article 6 ter of the Paris Convention as the opponent is a national of a Convention Country and has registered the opponent's marks and variations thereof in a substantial number of countries throughout the world and has made extensive use of the mark in a number of countries.
3. On 19 February 1998 the applicants through their agents, Wynne-Jones, Laine & James, filed a counterstatement denying the above grounds. Both sides asked for an award of costs in their favour and have filed evidence. The matter came to be heard on 24 April 2001 when the applicant for registration was represented by Mr Hicks of Counsel, instructed by Wynne-Jones, Laine & James and the opponents by Ms Clark of Counsel, instructed by Stevens Hewlett & Perkins.

Opponent's Evidence

4. This consists of two statutory declarations, one each from Mr Antonie Gram and Jonathan Kraines, dated 15 September 1998 and 17 September 1998.
5. Mr Gram is the President of Kipling N V with whom he had been associated since November 1992. He states that his company is the proprietor of United Kingdom trade mark registrations 1367448, 1367449, 1367450 and 1578841 and refers to Exhibit AG 1 to his declaration which comprises copies of a print out showing details of these registrations, from which it can be seen that each mark includes the device of a monkey, either with a long tail or in the form of a rounded great ape.

6. Next, Mr Gram states that, in addition to those in the UK, registrations exist for various forms of Kipling and a monkey device in many jurisdictions of the world, which he then goes on to list. Exhibits AG 2 and AG 3 to his declaration contain copies of registration certificates or journal extracts in which registration of the marks is published, and a list providing details of registration numbers, countries and classification in relation to the overseas registrations.
7. Mr Gram asserts that the trade mark showing the word Kipling with the device of a monkey is well known. He goes on to say that, not only does a monkey appear as part of the trade mark, but three dimensional monkeys are attached to the goods and these come in different models and sizes. Mr Gram refers to Exhibit AG 4 which comprises extracts from various catalogues showing products particularly bags, supplied by the opponent from which either the device of a monkey or the three dimensional monkey can be seen. He then draws attention to Exhibit AG 5 consisting of examples of furry monkeys used as mascots, each bearing the Kipling and Monkey Logo.
8. Mr Gram explains that in all window displays of his company's products, enormous emphasis is given to the monkey trade mark and he draws attention at Exhibit AG 6 to his declaration which is a copy of the 1995 Sales Manual for the United Kingdom, intended for every distributor and retailer of the opponent's goods. The Manual encourages use of the Kipling Monkey soft toy in window displays.
9. Mr Gram concludes that the public seeing a monkey used in connection with clothing or bags would associate the product with his company and that registration of the applicant's mark could result in confusion.
10. The second statutory declaration filed on behalf of the opponents is by Jonathan Kraines who is the Operations Director of Pelham Leathergoods Limited and who has been involved in the luggage and leather goods industry for ten years. His company acts as the distributor in the United Kingdom for N V Kipling, the opponents.
11. Mr Kraines explains that from 1988, when the Kipling products were first introduced into the United Kingdom, great emphasis was placed upon the association of a monkey with Kipling goods. He states that the KIPLING and monkey device mark has been used on backpacks, small leather goods, handbags, shoes, holdalls, clothing and luggage, that the items retail to the public at prices starting at £9.99 and going up to around £250. He adds that sales of products bearing the mark are made direct to retail outlets and also from the "flagship" stand-alone Kipling shop in Covent Garden. Photographs of the Covent Garden store are at Exhibit JK 1 to Mr Kraines' declaration. He adds that products bearing the KIPLING and monkey device mark are generally available throughout the United Kingdom.
12. Mr Kraines provided the following approximate sales figures (exclusive of VAT), for products bearing the Kipling and monkey device mark:

YEAR	VALUE (£)
1994	145,091
1995	296,906
1996	417,233
1997	432,477
1998	299,765 (to end of July)

13. Next, Mr Kraines says that a public relations company is employed on a monthly retainer to promote goods sold under the mark and a monthly fee of £400 plus expenses, generally averaging at about £100 per month, are put towards this cost. The mark has appeared in many magazines and newspapers in promotion and articles and these include national newspapers, in addition to trade and fashion magazines. At Exhibit JK 2 to the declaration are copies of cuttings from some of these publications and Mr Kraines states that some of the articles focus upon the association of monkeys with the Kipling brand eg the Sunday Times Style Section of 29 June 1997 which contains a feature noting that monkey mascots are given away with KIPLING BAGS.
14. Mr Kraines explains that all N V Kipling promotional matter and labels (a sample of which is at Exhibit JK 3) show either the monkey mascot or the KIPLING and monkey device trade mark and the monkey mascot itself (Exhibit JK 4) bears the KIPLING and monkey device trade mark.
15. Mr Kraines concludes that a monkey device in relation to luggage, accessories and leather goods is associated with KIPLING and that use by another party could lead the public to consider that there was an association as to the source of goods.

Applicant's Evidence

16. This consists of three statutory declarations by Jane Claire McKechnie, Brian Kenneth Charles Dunlop and Lynda Jane Illing respectively.
17. Ms McKechnie's declaration is dated 10 March 1999. She is employed as a designer by Endura Limited who manufacture and sell clothing for cyclists and snowboarders and who supply third parties, including Halfords Limited (the applicant). Ms McKechnie states that this area of the clothing market is very fashion orientated and it is one of her duties to monitor markets and spot up and coming trends. She explains that she was very surprised to hear that N V Kipling had opposed the application in suit because she did not associate that company with monkeys at all and had been aware of the brand for about two years. If asked to describe their logo, she would have described the roundel with a central star and the word KIPLING surrounding it (as she was familiar with this logo from the brightly coloured bags she had seen) and although she had noticed a monkey key ring attached to some bags, she assumed it was some kind of free gift.
18. Ms McKechnie has read the declarations of Mr Gram and Mr Kraines but she confirms that she was not aware of any strong monkey brands in the clothing industry. Prior to

reading Mr Kraines' declaration, Ms McKechnie was not aware that KIPLING sold clothing and she simply associated the company with strongly coloured rucksacks. She then comments that the applicant's sales figures are very low, especially as they are not just limited to clothing sales, and adds that their public relations budget is at a very low level. Next, Miss McKechnie states that she is not aware of the opponent's clothing being on sale prior to May 1997, the date the mark in suit was applied for. She reiterates that she does not believe that the opponents have a reputation in a monkey logo or brand.

19. The second declaration contained in the applicant's evidence is by Mr Dunlop and is dated 12 March 1999. He is a Chartered Patent Agent, a member of the Institute of Trade Mark Attorney and a partner in Wynne Jones, Laine & James, the applicant's representatives.
20. Mr Dunlop states that he was completely unaware of N V Kipling, its trade marks or products prior to his firm receiving correspondence in relation to the opposition proceedings. However, prior to the relevant date (23 May 1997) he was aware of a range of fleeces and related products manufactured and sold under the name STONE MONKEY and if he had seen a monkey alone on clothing any association he would have made would have been with STONE MONKEY. He then draws attention to the then current catalogue of STONE MONKEY, at Exhibit B1 to his declaration, and states that their logo is quite distinct both from the logo of the present application and the monkey device which the opponents use in association with their trade mark Kipling. Exhibit BD 1 also includes details of the STONE MONKEY trade mark registration in Class 25 (No 1546255).
21. Mr Dunlop has carried out a brief internet search (after the relevant date) under the name MONKEY and has found that he could purchase products from companies known as RED MONKEY, GLASS MONKEY and MONKEY and that RED MONKEY and GLASS MONKEY use a monkey logo. Examples are at Exhibit B2 to Mr Dunlop's declaration. He adds that his firm had carried out a search in relation to monkey and ape logos and the results of this search and one for monkey marks are attached at Exhibit BD 6 which shows a number of "monkey marks" co-existing on the register in Classes 9 and 25.
22. Mr Dunlop is critical of the evidence filed on behalf of the opponents, particularly in that the turnover figures are not limited to sales of clothing and he adds that the quoted article from the Sunday Times Style section post-dates the application date. He had inspected the web site of N V Kipling and notes that the company has 40 shops worldwide of which fifteen are in Belgium and only one in the United Kingdom.
23. The applicant's final statutory declaration is by Lynda Jane Illing and is dated 15 March 1999. Ms Illing is the Legal Services Controller for Halfords Limited, a position she has held for fifteen years. She states that one of her responsibilities is the protection and clearance of trade marks and she takes a particular interest in third party marks. Up until the opposition proceedings, Ms Illing was unaware of the opponents and their trade marks.

24. Ms Illing visited the KIPLING shop in Covent Garden on 2 March 1999 and she expresses her surprise about its small size. She adds that the shop sold predominantly bags and the only clothing available was a small range of outdoor coats. Ms Illing states that the KIPLING and monkey device mark was very “low down” on the list of prominence and the most noticeable trade marks in use was a circular mark incorporating a central star with the word KIPLING above and below it.

Opponents Evidence in Reply

25. This consists of a further statutory declaration by Mr Gram, which is dated 12 October 1999.
26. In answer to criticisms relating to the opponent’s reputation, Mr Gram draws attention to the June 1997 article in the Sunday Times Style Section (this post dates the date of application for the mark in suit) which he says exemplifies the huge impact of his company’s trade marks. He also contends that Ms McKechnie has, in effect, in her evidence made the association between his company’s “Monkey Mascot” and his company’s key ring product.
27. Next, Mr Gram refers to Exhibit AG 1 to this declaration which comprises a copy of an article taken from Fashion Weekly that appeared in the 21 September 1989 issue. He states that the article reflects on the high attendance at the Kipling stand at a trade exhibition called Fashion Page which was held in Brussels and makes specific mention of “Monkey Mascots” being given away at the exhibition. He adds that the article features a photograph of one of his company’s typical shop fronts which bears the Kipling Monkey Device.
28. Mr Gram explains that the Kipling Monkey Device and Monkey marks are not the company’s only marks but are nevertheless associated with the company. He adds that his company provides the consumer with a whole range of fashion items and that Kipling’s products have been sported by famous actors and actresses eg at Exhibit AG 2 is an extract taken from Movieline Magazine, dated May 1997, mentioning a Kipling garment bag in relation to Bonnie Hunt and Renee Zellwejer.
29. Mr Gram is critical of Mr Dunlop’s comments about products sold under monkey devices, stating that the Stone Monkey device is not clearly recognisable as a monkey and that the Red Monkey designs are for the US, not UK market. Mr Gram continues that his company’s products have been sold through a whole network of dealers in the UK as well as famous department stores eg Harrods, Harvey Nicholls and Selfridges. At Exhibit AG 3 to his declaration is a copy of an advertisement for his company’s products (in this example bags with a monkey keyring attached), that appeared in Harrods Magazine.

Applicant’s Additional Evidence (Rule 13 (11))

30. This consists of a witness statement by Brian Kenneth Charles Dunlop, dated 26 February 2001, in which Mr Dunlop draws attention to the advertisement of trade

mark application number 2230468 in The Trade Marks Journal of 15 November 2000, details of which are at Annex 2 to this decision. Mr Dunlop notes that application 2230468 has been accepted alongside the application in suit, that the applicant for registration is Kipling Switzerland AG and that the registrations cited against the mark in suit by the opponents now stand in the name of Kipling Switzerland AG with the assignments to that company being effective from 31 May 2000.

31. This concludes my summary of the evidence filed in this case. I now turn to the decision.

DECISION

32. Prior to the hearing Ms Clark withdrew the ground of opposition under Section 3(6) of the Act.

33. In relation to the Section 3(1) ground, Ms Clark explained that the only point the opponent wished to pursue was the need for an exclusion to the applicant's specification of goods in relation to goods made of monkey and/or primate skins. Ms Clark pointed out that such exclusions are contained within the specifications of the opponent's registrations number 1367448, 1367449, 1367450 and 1578841. However, the opponent has provided no evidence that the goods covered by the applicants specification of goods could or would, in UK market or trading conditions, be manufactured from monkey and/or primate skins and I heard no substantive submissions at the hearing on this point. Regarding the exclusions contained within the specifications of the opponents registrations (mentioned above), I would add that the mere evidence of entries on the register is of very little aid and I have no knowledge of the background to these registrations. The opposition under Section 3(1) of the Act fails.

34. I turn now to the ground of opposition under Section 5(2)(b) which reads as follows:

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

- (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 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."

35. An earlier right is defined in Section 6, the relevant parts of which state:

6.-(1)

- (c) 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,

36. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schufabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723.

It is clear from these cases that:-

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, 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; *Lloyd Schufabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;
- (d) 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; *Sabel BV v. Puma AG*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (f) 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; *Sabel BV v. Puma AG*, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;
- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG*, paragraph 41;

- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.
38. The opponent relies upon four registrations; three of which (numbers 1367448, 1367449 and 1367450 in Classes 16, 18 and 25 respectively), are identical with each other and comprise the word KIPLING and the device of a monkey with a long tail; the fourth (registration number 1578841 in Class 18) comprises the device of a monkey or ape. A reputation is claimed in these marks. In relation to registration number 1578841, Ms Clark claimed reputation through use as a three dimensional mark, in view of the "monkey key rings" attached to the opponent's products. However, as no evidence has been filed to show that the "monkey key ring" is seen as a three dimensional mark or even a trade mark by the public, I have no hesitation in rejecting this assertion.
39. The reputation of a mark is an element to which importance may be attached in Section 5(2) considerations. At the hearing, Mr Hicks argued that the opponent's evidence on this issue was weak, should be treated with caution, and that much of it post-dated the date of application for the mark in suit (23 May 1997). It was submitted that the opponent's Covent Garden store (their only UK store) did not open until 1998, that the UK sales and promotion figures are relatively low and are in relation to all their activities (which are mostly in relation to Class 18 goods), that no actual sales of clothing are demonstrated and that the opponent's primary trade marks were either the word KIPLING solus or the word KIPLING and a "star" logo. Mr Hicks criticisms are substantial and while the opponent is able to demonstrate evidence of use of their KIPLING and monkey device registrations in relation to Class 18 and to a far lesser degree in Class 25, in my opinion they have not shown that they possess a reputation in the United Kingdom for the purpose of these proceedings. I must therefore compare the mark applied for and the opponent's registrations on the basis of notional and fair use.
40. In essence the test under Section 5(2)(b) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion, I am guided by the recent judgements of the European Court of Justice mentioned earlier in this decision. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural or conceptual similarity between the marks, evaluating the importance to be attached to those different elements, taking into account the category of goods in question and how they are marketed.
41. The marks at issue contain devices of monkeys or apes. The mark applied for consists of a series of three marks, comprising a frontal silhouette of an ape but with the outline of a face shown (in relief) without features. In two of the representations both arms are raised and in the remaining representation one arm is raised. The opponent's marks consist of the word KIPLING together with the silhouette of a monkey on all four legs, in profile, the monkey possessing an extremely long tail which ascends over the

word (registrations number 1367448, 1367449 and 1367450), which I shall refer to as the first mark. The second mark consists of a cartoon like drawing showing a frontal view of an "upright" ape with a smiling face, toes but no legs, with arms "at the side" (registration 1578841). It is, of course, possible to over analyse marks and in doing so shift away from the real tests which is how the marks would be perceived by customers in the normal course and circumstances of trade and I must bear this in mind when making the comparisons.

42. At the hearing both counsel drew my attention to *Sabel BV v Puma AG* (mentioned earlier in this decision) which is of particular relevance. It states that where there is a similarity between two pictorial marks, one of which includes a text, the inclusion of a textual element in one of the marks does not in itself preclude a finding of likelihood of confusion (para 64(3)); that the registration of a trade mark may be opposed on the basis that the ideas conveyed by the pictorial elements of two trade marks are similar, provided that it is established that there is a likelihood of confusion (para 64 (4)); and it is not enough, because the idea behind the marks is the same, that there is a risk the public will associate the two marks, in the sense that one will simply bring the other to mind, without a likelihood of confusion (para 64 (2)).
43. Turning firstly to a visual comparison of the applicant's mark the opponent's first mark (registrations number 1367448, 1367449 and 1367450), I find their overall impact to be quite different. The word appearing in the opponent's mark is an important and "eye-catching" feature and while both marks contain silhouettes of primates, they have a very different appearance with the applicant's mark being a frontal view of an ape with a blank face and the opponent's silhouette being of a monkey on "all fours" with an extremely prominent tail.
44. While the applicant's mark has a primarily visual identity, I go on to consider aural use and a comparison of the applicant's mark and the opponent's first mark on this basis. Both marks contain silhouettes of primates which could both be described as monkeys, although it seems to me that the applicant's mark has the look of an ape as opposed to a monkey. Furthermore, the opponent's mark contains the prominent word **KIPLING** which in aural use is likely to be used by the public to indicate the opponent's mark. I also need to bear in mind that the goods of interest to the applicant are clothing in Classes 9 and 25 and in this regard, the following comments appeared in a recent Registry Decision (In the matter of Application No. 2001040 by React Music Limited to register a trade mark in Class 25 and in the matter of Opposition thereto by Update Clothing Limited under Number 45787):

'There is no evidence to support Ms Clarke's submission that, in the absence any particular reputation, consumers select clothes by eye rather than by placing orders by word of mouth. Nevertheless, my own experience tells me it is true of most casual shopping. I have not overlooked the fact that catalogues and telephone orders play a significant role in this trade, but in my experience the initial selection of goods is still

made by eye and subsequent order usually placed primarily by reference to a catalogue number. I am therefore prepared to accept that a majority of the public rely *primarily* on visual means to identify the trade origin of clothing, although I would not go so far as to say that aural means of identification are not relied upon.'

45. This view was supported on appeal to the Appointed Person (*REACT Trade Mark* [2000] 8 RPC 285, at 289 lines 22 to 26).
46. Finally, I turn to a conceptual comparison of the marks bearing in mind that the applicant's mark appeals primarily to the eye while both marks contain a similar concept - the silhouette of a primate, there are noticeable differences in the silhouettes and the presence of the prominent word **KIPLING** in the opponent's mark lends the mark a surnominal conceptuality in that the word **KIPLING** will be taken (and remembered) as a strong indicator of origin.
47. I now consider the comparison of the applicant's mark with the opponents second mark, registration 1578841. On a visual comparison, both marks consist of frontal views of apes but while the applicants mark consists of a silhouette with the outline of a face shown (in relief) without features, the opponent's mark has a cartoon like quality and a smiling face which is a striking element within the mark. In my view the respective marks look very different.
48. While both marks have a primarily visual identity I go on to consider aural use. Both marks contain devices of apes and the opponents' case is that the differences in detail will not be distinguished in oral use. There is some strength in this proposition but it must be borne in mind that both marks are primarily intended as visual identifiers or indicators, that the opponent has not established that the device of a monkey or ape, per se, is distinctive of its goods and that the applicants goods ie. clothing in Classes 25 and 9, is primarily selected by the eye ie. on a visual basis - see the comments from the REACT Decision above.
49. On a conceptual comparison, both marks consist of ape devices but in my view, the "blank face" within the applicant's mark and the cartoon like "smiling face" within the opponent's mark are both strong conceptual elements which are likely to affix themselves in the mind.
50. I must now go on and take into account the goods covered by the specifications of the respective marks. In relation to the applicants Class 25 specification and the opponents registration 1367450 in Class 25, it was common ground at the hearing that same goods exist. Further more at the hearing Ms Clark did not argue that the opponents registration 1367448 in Class 16 covered similar goods to those of the application and it was not relied upon on this basis. However, in light of the applicants specifications in Class 9 and 25 and the opponents registrations in Classes 18 and 25 I need to decide:-
 - (i) whether the goods specified in Class 25 of the application are similar to the goods specified under Class 18 of the opponents registered marks number

1367449 and 1578841.

- (ii) whether the goods specified in Class 9 of the application are similar to the goods specified under Class 18 of the opponents registered marks number 1367449 and 1578841 or under Class 25 of the opponents registered mark number 1367450.

51. In determining whether the goods covered by the application are similar to the goods covered by the opponents' earlier trade mark I have considered the guidelines formulated by Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* (1996) RPC 281 (Pages 296, 297) as set out below:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or services;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

52. Whilst I acknowledge that in view of the *CANON - MGM* judgement by the European Court of Justice the *TREAT* case may no longer be wholly relied upon, the ECJ said the factors identified by the UK government in its submissions (which are listed in *TREAT*) are still relevant in respect of a comparison of goods and services.

53. In relation to the Class 25 and Class 18 determination, both counsel drew my attention to a recent Registry Decision (In the matter of Application No. 2001040 by S Oliver Bernd Frier GMBH & Co KG to register a trade mark in Class 18 and 25 and in the matter of Opposition thereto by QS Familywear PLC (1999) RPC 520), admittedly not without criticism, particularly from Ms Clark who contended that in modern trading conditions rucksacks and outdoor bags are fashion items that could be deemed fashion accessories. In this case the hearing officer commented as follows:-

"In utilising the same test (Jacob J's test in *British Sugar*) and applying it to this case I shall divide the goods specified under Class 18 of the application for registration into two parts. In doing so I am disregarding the argument put

forward at the hearing by the opponents that all items in Class 18 should be regarded as clothing accessories. Mr Moore referred to various shops, such as Miss Selfridge and Next which sell fashion clothing and handbags. he pointed out that outdoor stockists such as Blacks sell outdoor fashion clothing and rucksacks and other leather bags. Finally he referred to sports shops which sold sports fashion clothing and sports bags. I am not convinced that the type of bags sold by sports shops and outdoor stockists could be deemed to be clothing accessories. I therefore propose to deal with the opposition to the Class 18 specification as follows:

(a) sports bags, shopping bags, toilet bags, keybags, boxes, hereafter referred to as category A goods; and;

b) Leather goods, leather bags, other leather goods which are not specially made for the things they contain, containers & purses, hereafter referred to as category B goods.

Comparing the category A goods to the opponents' goods registered under Class 25, it is clear that they have different uses and that although they may be the same, there is nothing about the nature of the respective goods which suggests that the users will be the same. The physical nature of the goods is very different, as are the trade channels. They are not likely to be found on the same shelf or even in the same sector of a store, and they are not in direct competition.

The descriptions falling in category B cover goods which I regard as clothing accessories, such as hand bags and purses. Comparing these goods to the opponents' goods registered under Class 25, it is clear that the respective uses whilst being correlative or complementary are different. The users will however be the same. The physical make up of the goods is different but the trade channels will probably be the same. The items would be found adjacent to each other if not on the same shelf, whilst the goods are not in competition. The position is finely balanced but they are close enough to be considered similar"

54. Despite Ms Clarks submissions, I share the view that sports bags and ruck-sacks should not be regarded as clothing accessories and even taking into account modern trading conditions, I am not aware that they are sold as accessories to complement "a look" or outfit and no evidence has been submitted on this particular point.
55. In relation to the determination of similarity between goods in Classes 25 and 18 I find myself in full agreement with the hearing officer's reasoning and conclusions in the above case and accordingly find that the goods specified under Class 25 by the applicant include goods similar to those within the goods specified by the opponents registrations number 1367449 and 1578841 in Class 18, in particular "handbags" and "purses".

56. I turn now to a consideration of whether the goods specified in Class 9 of the application are similar to the goods specified under Class 18 and 25 of the opponent's registered marks.
57. Firstly, I intend to consider Classes 9 and 25 which both include clothing. Clothing for normal wear is proper to Class 25 and would include items often referred to as "protective" such as "rain suits/hats", "overalls", and "dungarees". Certain specialised clothing including footwear and headgear can be proper to Class 9 and these items serve to protect the wearer from injury due to impact in accidents or where there is some known potential for injury such as contact with chemicals, radiation or fire. In my view the uses and users of the respective goods are different and protective clothing would be of a different physical nature e.g. consist of specialised, treated or adapted materials, and usually be sold through specialist outlets. Accordingly, I consider the respective goods in Classes 9 and 25 to have a very low level of similarity for the purposes of Section 5(2)(b) of the Act.
58. Finally, I consider the goods covered in Class 9 of the applicant's specification and Class 18 of the opponent's marks. Whereas, goods such as bags and purses in Class 18 may be similar to articles of clothing in Class 25 on the basis that they may be regarded as clothing accessories which are complementary for fashion purposes, this clearly does not stretch to protective clothing in Class 9 which is intended to protect against accident or injury. I have no hesitation in finding that the respective goods in Classes 9 and 18 are not similar.
59. On a global appreciation, taking into account all the relevant factors, I come to the following conclusions in relation to the Section 5(2)(b) ground:-
- (i) The applicant's Class 25 specification of goods includes goods identical to those within the specification of goods of the opponent's registration number 1367450 in Class 25, and goods similar to those within the opponent's registrations number 1367449 and 1578841 in Class 18.
 - (ii) The opponent's registrations for their first mark, the word KIPLING and the silhouette of the monkey on "all fours" with a long tail, in profile (registrations number 1367448, 1367449 and 1367450) are not similar to the applicant's mark on either a visual, aural or conceptual basis and taking into account the category of the goods in question and how they are marketed, I believe that there is no likelihood of confusion.
 - (iii) The opponent's registration for their second mark, registration number 1578841 in Class 18, looks closer to the applicant's mark, particularly when one takes into account aural and conceptual similarities and imperfect recollection. However, the "blank face" within the applicant's mark and the "smiling face" within the opponent's mark are significant and both marks are primarily visual in nature. Furthermore, the respective goods in Classes 25 and 18, while similar are not, in my view, closely similar given their different uses and nature (the respective goods in Classes 9 and 18 are not similar) and after

taking into account the category of goods in question and how they are marketed, I believe the possibility of confusion is sufficiently remote that it cannot be regarded as a likelihood.

60. The opposition under Section 5(2)(b) fails.

61. I now turn to the ground of opposition under Section 5(3) of the Act which states:

5.-(3) A trade mark which -

(a) is identical with or similar to an earlier trade mark, and

(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

62. The term "earlier trade mark" is itself defined in Section 6(1) of the Act, which is set out earlier in this decision.

63. The opponent has registrations in Classes 16, 18 and 25 for goods which are not identical or similar to the goods contained in the applicant's Class 9 specification. Additionally, the opponent's Class 16 registration covers goods which are not identical or similar to the goods contained within the applicant's Class 25 specification. However, as I have already found that the opponent's do not have a reputation in the United Kingdom and there is no likelihood of confusion under Section 5(2), the opponent has, in my view, no stronger case under Section 5(3) of the Act and the opposition on this ground fails.

64. Finally, I consider the ground of opposition under Section 5(4) of the Act, which at the hearing was pursued under Section 5(4)(a) in relation to passing off. Section 5(4)(a) reads as follows:-

"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

(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.

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.”

65. In deciding whether the mark in question offends against this section, I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the WILD CHILD case (1998 14 RPC 455). In that decision Mr Hobbs stated that to succeed in a passing off action, it is necessary for the opponent's to establish, at the relevant date (23 May 1997), that : (i) they had acquired goodwill under their mark; (ii) that use of the mark would amount to a misrepresentation likely to lead to confusion as to the origin of their goods; and (iii) that such confusion is likely to cause real damage to their goodwill.
66. I have previously found that the opponent does not have a reputation in the United Kingdom and that use of their trade marks which form the basis of this opposition, actual or on a fair and notional basis will not result in a likelihood of confusion under Section 5(2). Accordingly, it seems to me that the necessary misrepresentation required by the tort of passing off will not occur. The ground of opposition under Section 5(4) therefore fails.
67. The applicants are entitled to a contribution towards their costs and I therefore order the opponent's to pay them the sum of £700. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 29 day of May 2001

JOHN MACGILLIVRAY
For the Registrar
the Comptroller General

B1367448 Registered 13 December 1988 Journal 5861, 1098



kipling

Paper, cardboard, paper articles and cardboard articles; bookbinding materials, photographs and stationery; adhesives; artists' materials; paintbrushes; typewriters and office requisites; instructional and teaching materials; plastics materials for packaging; playing cards; all included in Class 16; but not including any such goods relating to Cercopithecidae.

PROPRIETOR: N V Kipling

1367449 Registered 13 December 1988 Journal 5885, 4617



kipling

Advertised before acceptance. Section 18(1)(proviso)

Bags; purses, wallets, keyholders, credit card holders, handbags, briefcases, rucksacks, suitcases, holdalls; all included in Class 18; but not including any of the aforesaid goods made of monkey skins.

PROPRIETOR: N V Kipling

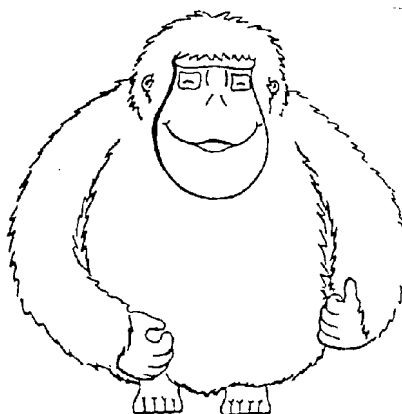


kipling

Advertised before acceptance. Section 18(1)(proviso)

Clothing, footwear, headgear, all included in Class 25; but not including any such goods made from primate skins.

PROPRIETOR: N V Kipling

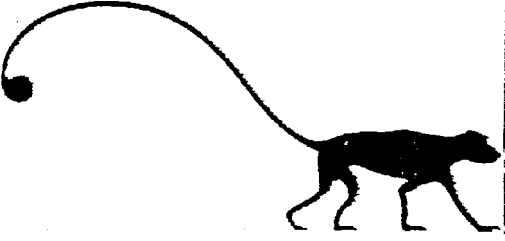


Bags; schoolbags; travelbags; sportbags; games bags; garmentbags; waistbags; shopping bags; handbags; make-up bags; toilet bags; purses; wallets; keyholders; credit card holders; briefcases; rucksacks; suitcases; cases for books; backpacks; umbrellas; holdalls; all included in Class 18; but not including any of the aforesaid goods made of monkey skins.

PROPRIETOR: N V Kipling

ANNEX TWO

PROPRIETOR: KIPLING SWITZERLAND A.G.

APPLICATION NO.	MARK	CLASS AND GOODS	JOURNAL
2230468		18 Leather and leather imitations, travelling cases, suitcases, schoolbags, bags, handbags, travelling bags, backpacks, umbrellas.	6354/20107