

**TRADE MARKS ACT 1938 (AS AMENDED) AND
TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No 2201953
BY MILORDS INTERNATIONAL LIMITED
TO REGISTER A TRADE MARK IN CLASS 25**

AND

**IN THE MATTER OF OPPOSITION No 50414 THERETO
BY CANADELLE LIMITED PARTNERSHIP**

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by Milords International Limited
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**IN THE MATTER OF Opposition No 50414 thereto
by Canadelle Limited Partnership**

DECISION

1. On 2 July 1999, Milords International Limited applied to register the Trade Mark FUNDERPANTS in respect of pants and knickers. The application numbered 2201953 was examined, accepted and published. On 18 November 1999, Canadelle Limited Partnership of Montreal, Canada, filed a notice of opposition. The grounds of opposition are based upon Section 5(2)(b) of the Act in that the opponents have earlier registrations in respect of the trade mark WUNDERPANTS or its phonetic equivalent (WONDAPANTS and WUNDAPANTS) in respect of the same or similar goods to those for which the applicants seeks to register their trade mark. Details of the opponents' earlier registration are shown below:

<u>Trademark</u>	<u>Number</u>	<u>Class</u>	<u>Specification</u>
WUNDERPANTS WONDAPANTS WUNDARPANTS (series of three)	B1585199	25	Pants; underwear; trousers; briefs; panties; knickers; boxer shorts; all for men, women and children; all included in Class 25.

2. The applicants for registration admit that the opponents have the earlier registration they claim but deny that use of the trade mark sought to be registered would be likely to cause confusion on the part of the public such as to be contrary to the provisions of Section 5(2)(b) of the Act.

3. Both sides filed evidence but neither side sought to take up the offer of a Hearing. Therefore, after due consideration of the pleadings and the evidence filed by each side I give this decision.

4. I have read the Statutory Declarations of Mr Arthur J DeBaugh, Vice President and Assistant Secretary of Canadelle Limited Partnership and the Statutory Declaration of Mr Zubeir Ismail, the Managing Director of Milords International Limited. A substantial portion

of each of the declarants evidence is merely an expression of their opinion eg. in relation to the similarity or otherwise of the trade marks. In terms of factual information, Mr DeBaugh's declaration exhibits copies of the registration certificate in relation to the earlier trade mark on which the opponents base their opposition. For his part, Mr Ismail provides details of other trade marks on the Register prefixed with the word 'fun' and in the names of various proprietors. As he himself indicates, he is not aware how these trade marks are used therefore I do not consider that the information he has provided, or his opinion based upon it, is relevant.

5. My decision will therefore be based upon the details of the applicants' trade mark and those attached to the opponents' trade marks, together with the decided authorities.

6. The relevant Section of the Act states:

"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."

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

"6.-(1)

- (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,"

8. In respect of the comparison of trade marks in cases such as this I look to 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 Schuhfabrik 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.

From these it can be deduced 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 Schuhfabrik 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.

9. In this case I have two unused trade marks in the sense that the opponents are not claiming that they have used their trade mark WUNDERPANTS/WONDAPANTS/WUNDAPANTS to an extent where they have or can claim a reputation in the trade mark. I therefore consider the applicants' and the opponents' trade marks on the basis of notional and fair use of both across the range of goods covered by their specifications - see the comments in REACT trade mark [1999] RPC 285 and Premier Brands UK Ltd v Typhoon Europe Ltd [2000] FSR 767.

10. First of all, I do not think that there would be any dispute between the parties that the respective goods are the same or similar ie underwear. Though clothing generally is purchased by sight (and the visual impact of trade marks in that field is significant) the position

in relation to underwear is, I think, somewhat different. It is not in my experience invariably on display on racks and will therefore be asked for by the customer rather than self selected eg. the embarrassed spouse. It is also an area where personal recommendation is likely to play a significant part in the selection process. Thus aural use of the trade mark becomes important. Allowing for a well informed observant and circumspect customer and bearing in mind there is only one letter different at the beginning of each trade mark, (FUNDERPANTS against WUNDERPANTS) I think that there is the possibility that they could sound the same. On the other hand, I do not ignore the fact that a significant feature in each trade mark is the prefix element appearing in each trade mark (in the applicants trade mark the word 'fun' and in the opponents trade mark the word 'wonder' or its phonetic equivalent), each has its own distinct dictionary meaning, one conveys the idea of enjoyment whilst the other conveys the idea of awe, thus visually I believe that the similarity is much less.

11. In this case it seems to me on the basis of the global appreciation criteria set out above, the nature of the goods; the way in which they are likely to be bought and sold ie. referred to; that when considering the trade marks as wholes, there is sufficient similarity between them to satisfy me that when pronounced there could be confusion between the trade marks FUNDERPANTS and WUNDERPANTS. Very precise diction would be necessary to avoid it. Both trade marks are also a play on the word underpants with each having an additional letter at the beginning. Therefore, there are significant conceptual similarities between them. I also bear in mind the views of the ECJ in *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* where they said:

“In the light of the foregoing, the answer to the questions referred to the Court must be that it is possible that mere aural similarity between trade marks may create a likelihood of confusion within the meaning of Article 5(1)(b) of the Directive. The more similar the goods or services covered and the more distinctive the earlier mark, the greater will be the likelihood of confusion.”

12. This I consider is such a case where aural similarity is sufficient, bearing in mind the goods and the way in which they are likely to be sold and purchased. The opposition therefore succeeds under Section 5(2)(b) of the Act.

13. As the opposition has been successful the opponents are entitled to a contribution towards their costs. I therefore order the applicants to pay to the opponents the sum of £800 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 9th day of August 2001

M KNIGHT
For the Registrar
The Comptroller-General