

## **TRADE MARKS ACT 1994**

**IN THE MATTER OF Application No 2156362A  
by Wolfgang Joop to register a series of trade marks  
in Classes 18,24 & 25**

**AND IN THE MATTER OF Opposition thereto under  
No 49624 by Canadelle Limited Partnership of Canada.**

### **Background**

1. On 23 January 1998, Wolfgang Joop of Monte Carlo applied to register the series of two trade marks shown below:-

WUNDERKIND  
Wunderkind

2. The goods in respect of which registration is sought are as follows:-

#### **Class 18**

Leather and imitation of leather, and goods made of these materials (as not included in other classes); animal skins; hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery; parts and fittings for the aforesaid goods.

#### **Class 24**

Textiles and textile goods, in particular curtains, fabrics for textile use; bed and table cloths and covers, household linen, venetian blinds; parts and fittings for the aforesaid goods.

#### **Class 25**

Clothing, footwear, headgear, sportswear, sports shoes; parts and fittings for the aforesaid goods.

3. There were originally further classes of goods and a third mark in the series, but these have been divided into a separate application or deleted and no further reference need therefore be made to them.

4. The applicant claims a priority date of 26 September 1997 for the application by virtue of an earlier filing in Germany.

5. On 6 April 1999, Canadelle Limited Partnership of Canada filed Notice of Opposition to the application. The following extract from the grounds of opposition sets out the factual basis of the opponent's case.

- “1. The opponent manufactures and/or has manufactured for it, and markets and sells, a wide range of goods, including in particular umbrellas, parasols, articles of clothing, underwear, lingerie, foundation garments, hosiery and swimwear (hereinafter referred to as “the Goods”).
  2. The opponent is the proprietor of a number of trade marks which commence ‘WONDER’ - (or with equivalent words such as ‘WUNDER’-, ‘WONDA’- and ‘WUNDA’-), and which are registered and used in respect of the goods. Such trade marks (which are hereinafter referred to as “the Canadelle Trade Marks”) include (but are not limited to WONDERLEGS, WONDERGRIP, WONDERFIT, WONDERBRA, WONDERBODY and WUNDERPANTS, WONDAPANTS and WUNDAPANTS.
  3. The opponent and its predecessors in trade and title, together with the licensees and affiliates of the opponent and of its predecessors in trade and title, have made extensive use of the Canadelle Trade Marks in the United Kingdom, Canada, the United States of America, and in numerous other markets (including member states of the European Union) in respect of the goods.”
6. On the basis of these facts it is claimed that registration of the WUNDERKIND marks in Classes 18, 24 and 25 would be contrary to Section 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994.
7. The applicant filed a counterstatement denying the grounds of opposition.
8. Both sides seek an award of costs.
9. The matter came to be heard on 4 June 2001 when the applicant was represented by Mrs M Heal of Counsel, instructed by David Keltie Associates, and the opponent was represented by Mr M Edenborough of Counsel, instructed by Eric Potter Clarkson.
10. The opponent filed evidence in the form of two declarations by Arthur J DeBaugh, who is the Vice-President and Assistant Secretary of Canadelle Limited. The second of Mr DeBaugh’s declarations was filed as evidence-in-reply to the applicant’s evidence. I will return to this later. His first declaration provides details of the various marks that the opponent has registered in the UK or as Community Trade Marks. These include six registrations in Class 25 for marks including, or consisting of, the word WONDERBRA and five further registrations for four marks in Classes 10, 18 or 25 including the prefix WONDER-, eg WONDERLEGS (Classes 10 and 25), WONDERGRIP (Class 18), WONDERFIT (Class 18), WONDERBODY (CTM - Class 25). Mr DeBaugh also provides details of a series of three marks registered in the UK in Class 25 ie WUNDERPANTS, WONDAPANTS and WUNDAPANTS. All the UK registrations are “earlier trade marks” with the meaning of Section 6 of the Act. At least one of the community trade marks appears to be a later mark, however nothing turns on this because the community marks do not place the opponent in any better position than the national trade marks.
11. Mr DeBaugh states that his company and its predecessors, licensees and applicants have

made extensive use in the UK of marks consisting of, or including, the word WONDERBRA. From 1994 onwards, the opponent sold over a million items per year in the UK under the WONDERBRA marks. The products sold under the WONDERBRA marks have been extensively promoted in the UK, including television and radio advertising. Mr DeBaugh claims that the WONDERBRA marks have been used in respect of “clothing, underwear, lingerie and foundation garments”, although, as far as I can see, the only product apparent in the various exhibits to Mr DeBaugh’s declaration are brassieres.

12. The applicant’s evidence consists of a statutory declaration by Sue Palmer, who is the Intimate Apparel Executive of UK Fashion Exports, a trade body created to encourage the export of British clothing. Ms Palmer has sixteen years experience in the “fashion industry”. She says she recognises the reputation attached to the mark WONDERBRA in respect of “push-up” bras, but does not know of any other WONDERBRA products.

13. The applicant’s evidence also includes a statutory declaration by David Arthur Keltie, who is the applicant’s UK Trade Mark Attorney. His “evidence” is mostly opinions and arguments. The only factual information is details of various other trade marks with the prefix WONDER- registered in Classes 18, 24 and 25 in the names of third parties. The closest are:-

- a) WONDERBAG registered in the UK by Hartstone Leather Goods Ltd in 1995; in Class 18 in respect of, inter alia, bags;
- b) WONDER BY BRAX protected in the UK with effect from 21 June 1997 in respect of trousers, sports outer clothing, belts, shoes and headgear in the name of Bernward Leineweber.

14. Mr DeBaugh’s second declaration consists largely of counterarguments rather than facts. I will come to the arguments of the parties later. The only point I should record here is that Mr DeBaugh accepts that his company has established its reputation for “primarily brassieres.”

15. With the opponent’s consent, the applicant filed some additional evidence just before the hearing intended to establish that the word “wunderkind” was known and understood in the UK as meaning “child prodigy”. The additional evidence takes the form of a further statutory declaration by David Keltie exhibiting newspapers articles taken from “Metro” (20 February 2001), “Evening Standard” (10 May 2001) and “The Independent” (13 May 2001). The first exhibit consists of a page from “Metro” which includes an article on the English Chamber Orchestra and, in particular, about a Guy Johnstone, who is described as “the wunderkind”. The exhibit from the Evening Standard contains an example of similar use in respect of an Australian film director. The exhibit consisting of the (front) page of “The Independent” includes an article describing the footballer Michael Owen as “the footballing *Wunderkind*”.

### **Section 5(2)(b)**

16. I will address the Section 5(2)(b) objection first. The relevant provision is re-produced below:-

"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."

17. I approach the matter taking account of the following guidance from the European Court of Justice (ECJ) in *Sabel BV v Puma AG* (1998 RPC 199 at 224), *Canon v MGM* (1999 ETMR 1) and *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* (1999 ETMR 690 at 698) and *Marca Mode CV v Addidas AG & Others* (2000 ETMR 723):

- a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- b) the matter must be judged through the eyes of the average consumer, of 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;
- c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- 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;
- e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;
- 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;
- 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);
- h) but if the association between the marks results in a likelihood that the average consumer will 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;
- i) A positive finding of a likelihood of confusion is required; even where the earlier mark enjoys a reputation with the public, it is not sufficient to find that confusion cannot be ruled out because of a likelihood of association.

18. The opponent has established that WONDERBRA was a highly distinctive trade mark for brassieres at the relevant date, partly because of the extensive use and promotion of the mark by the opponent. If point 'f)' above is correct, this means that the opponent has a better case based on its WONDERBRA registration in Class 25 than it has for some of its other WONDER- prefixed marks, none of which are shown to have had their inherent distinctiveness enhanced by use and promotion.

19. The opponent has sought to gain advantage from its registration of a 'family' of marks with the prefix WONDER-, but in the absence of any evidence of the use of these marks (other than WONDERBRA marks) I do not believe that the registration of other marks with the prefix WONDER- has any bearing on the likelihood of confusion with the WONDERBRA marks.

20. The applicant's best WONDER- mark is therefore the mark WONDERBRA solus, which is registered in Class 25 in respect of:

“Swimwear incorporating provision for bust support; brassieres; panties; briefs; bodies.”

21. If the opponent cannot succeed on the basis of this registration, particularly for the goods for which the marks has been shown to be highly distinctive - brassieres - it will not succeed with any of its other WONDER- registrations.

22. However, the closest of the opponent's earlier marks to the applicant's marks is, in my view, the mark WUNDERPANTS, which is registered in Class 25 for

“Pants; underwear; trousers; briefs; panties; knickers; boxer shorts; all for men, women and children; all included in Class 25.”

23. All of these goods fall within the Class 25 specification of the application in suit. I will therefore consider first the opponent's case on the basis of this mark, accepting that the respective goods are identical.

24. There is no evidence of use of this mark so the distinctive character of the earlier mark is determined wholly by its inherent qualities. The applicant contends that the word “wonder” is not distinctive because the word is laudatory and therefore describes the quality or other characteristics of goods rather than their trade source. In my view, the word “Wonder” is more allusive than descriptive. In any event, the earlier mark WUNDERPANTS adopts the Germanic form of the word and, at least to the eye, is that much more distinctive as a result. I consider WUNDERPANTS to be an unexceptional trade mark, meaning that it has neither a particularly strong distinctive character, nor a particularly weak one.

25. It is usual to assess the visual, aural and conceptual similarities of marks in that order. However, in this case, I intend to address the conceptual similarity first because this is key to the way in which the respective marks would be seen and (to a lesser extent) heard.

26. The applicant submits that the average consumer would recognise the mark

WUNDERKIND as a German word meaning “child prodigy”, which has found its way into the English language. The applicant relies partly on the fact that “wunderkind” appears in Chambers English Dictionary (1983 edition). Mr Edenborough, for the opponent, pointed out that the same dictionary has adjacent entries for, inter alia, “wulfenite” “wurley”, “wurn”, “wurtzite” and “wyandotte”, none of which would be understood by the average consumer of clothing in the UK. I do not believe that Mrs Heal seriously contended otherwise. Entries in English dictionaries cannot therefore be regarded as conclusive evidence that the meanings of words appearing therein are understood by the average UK consumer.

27. Mrs Heal relied rather more heavily on the evidence of the word “wunderkind” appearing in UK publications. She submitted that journalists would not use a word unless they were satisfied that readers would know what it meant. Mr Edenborough pointed out that:

- a) The three examples of use of “wunderkind” in evidence all dated from the current year whereas the relevant date in these proceedings is 26 September 1997;
- b) Consequently, even if the evidence established that the German word ‘wunderkind’ had entered the ‘English language by 2001, it does not mean that it was widely understood in 1997;
- c) In any event, the evidence only showed three instances of the use of ‘wunderkind’ by journalists;
- d) One of these is in an article about classical music - readers of that article may not be typical of the average consumer of clothing in the UK;
- e) Another was in a broadsheet newspaper and italicised, indicating that the journalist did not consider the word “wunderkind” to be an ordinary English word.

28. I believe there is force in these points. It may be that by 2001 the word “wunderkind” had entered the English language to a sufficient extent that some journalists felt confident that, when used in a suitable context, the meaning of the word would be apparent to their readers. I do not believe that it is safe to infer from these articles that four years before they were written the average consumer of clothing in the UK would have readily, and without analysis, attached the meaning of “child prodigy” to the word WUNDERKIND when presented with that word out of a context that invited such a meaning.

29. Mrs Heal reminded me that the average consumer is deemed to be reasonably well informed and circumspect. I accept that, but the average UK consumer is notorious for his or her poor grasp of foreign languages. It is plain that some German words, such as ‘kindergarten’, have truly entered the English language with the result that the meaning of the word would be apparent to the average UK consumer for clothing. I am not persuaded by the evidence that ‘wunderkind’ fell into the same category in 1997. I accept that some consumers of clothing may have attached the meaning to ‘wunderkind’ that the applicant suggests, even in 1997, but I do not accept that this would have been the reaction of the average consumer. I therefore approach the matter on the footing that the German meaning of “wunderkind” would

not have been apparent to the average UK consumer at the relevant date.

30. To the eye, the marks WUNDERKIND and WUNDERPANTS share the same prefix and are distinguished by the less distinctive suffix, ‘-PANTS’ (which appears wholly descriptive of most of the goods for which the earlier trade mark is protected) and “-KIND”, which is a well known English word meaning, inter alia, “type” or “sort”.

31. In circumstances where the suffix PANTS does no more than to describe the nature of the goods at issue, the common prefix WUNDER- clearly contributes much more to the distinctive character of the mark WUNDERPANTS than does the suffix -PANTS. Given that -KIND has a descriptive meaning in English, the prefix WUNDER- is also likely to be the feature of the later mark which will fix itself most strongly in the recollection of the average consumer.

32. I therefore believe that, where identical goods in the nature of pants are concerned, the resemblance between WUNDERPANTS and WUNDERKIND is sufficient to have resulted in a likelihood of confusion through imperfect recollection at the relevant date.

33. Even if that is wrong, it seems to me that the resemblance between the marks, coupled with the identity of the respective goods and the fact that -PANTS and -KIND are descriptive to varying degrees, is likely to mean that even the average consumer who is aware of the differences between these marks is likely to suppose that the identical distinctive prefix is indicative of variant marks used by the same undertaking or undertakings with an economic connection.

34. For these reasons, the objection under Section 5(2)(b) succeeds, insofar as the application covers goods in the nature of “pants” in Class 25, as listed in paragraph 22 above.

35. Where the earlier mark is registered for goods which are not in the nature of pants (for which the suffix -PANTS is a more effective distinguishing feature) or where the respective goods are merely similar, a greater resemblance between the respective marks is necessary to establish a likelihood of confusion, particularly as the earlier mark WUNDERPANTS has not been shown to have a reputation with the public. I do not believe that use of the applicant’s mark on other types of clothing or footwear will cause confusion. It follows that I reach the same finding with regard to the applicant’s goods in Classes 18 and 24.

36. In case I am found to be wrong so far, I go on and consider the likelihood of confusion between the applicant’s mark and the opponent’s earlier mark WONDERBRA. As noted earlier, this mark enjoyed a substantial reputation with the public at the relevant date. The applicant accepts that the mark enjoyed such a reputation for “push-up” brassieres. This is nit-picking. The opponent is entitled to claim that its mark enjoys a reputation with the public for brassieres.

37. Once again, I do not intend to approach the matter on the footing that the German meaning of the applicant’s marks would have been readily apparent to the average consumer of brassieres or the other similar goods for which the opponent’s mark is registered (see

paragraph 20 above).

38. To the eye, the mark WONDERBRA has a degree of similarity to WUNDERKIND, (-BRA like -PANTS being wholly descriptive). However, unlike WUNDERPANTS, WONDERBRA does not share the (to an English person) mis-spelling or Germanic spelling of the WONDER- prefix. As a consequence there is less visual similarity between these marks than between WUNDERPANTS and WUNDERKIND.

39. I do not believe that the average consumer of brassieres and similar goods would pronounce WUNDERKIND any differently to WONDERKIND. There is therefore a greater degree of similarity between WONDERBRA and WUNDERKIND to the ear than to the eye.

40. There is no evidence before me, and I am in no position to use my own knowledge, but I would expect that brassieres, like most items of clothing, are more often selected by visual means than by word of mouth. Nevertheless, where the earlier mark has a reputation with the public, it is to be expected that many more orders will be placed by word of mouth than would otherwise be the case.

41. In Lloyd Schuhfabrik, the ECJ indicated that “mere aural similarity between trade marks may create a likelihood of confusion”, noting that the likelihood was greater where the respective goods are identical and the earlier mark is highly distinctive. That is the case here. The Court also stated that all relevant factors should be taken into account, including whether or not the earlier mark contains an element descriptive of the goods. The suffix -BRA clearly falls into that category. Although the prefix WONDER- alludes to qualities of the goods, I do not regard it as truly descriptive. In any event, by the date of these proceedings it seems plain that, in relation to brassieres, the word WONDER denoted only the goods of the opponent.

42. These findings, together with my earlier observation that the word KIND is well known to mean “type” or “sort” (indeed it appears in Section 3(1)(c) of the Act in that sense) persuades me that neither the mis-spelling of WONDER in the applicant’s marks (which would not be apparent to the ear) nor the substitution of the suffix -KIND for -BRA is sufficient to distinguish brassieres marketed by the applicant from those of the opponent. The same would apply to women’s “swimwear” (which appear to be very similar goods to brassieres) and “bodies”, which I understand could also incorporate provision for bust support.

43. The opponent’s mark has not been shown to enjoy a reputation (and thus an enhanced distinctive character) for any of the other goods for which it is registered. In these circumstances, on the basis of a global assessment of the relevant factors, including the similarities between the marks, I do not believe that the concurrent use of the marks by unrelated undertakings, even for identical goods such as “briefs”, would be likely to cause confusion.

44. In reaching the above findings, I have not overlooked the registration of other marks in Class 25 with the prefix WONDER- in the names of third parties. It has been held that the state of the register is, in principle, irrelevant to the question of whether a particular mark should or should not be registered : TREAT 1996 RPC 281. Further, there is no evidence that any of the other marks in the names of third parties were in use at the relevant date or at all.



One or two, such as WONDERWOMAN date from a time well before the opponent's mark acquired its reputation. The closest mark in Class 25, WONDER BY BRAX is not protected for brassieres (although admittedly it is protected for "sports clothing, which could include sports bras"). The mark contains a stronger distinguishing feature - BRAX - than the mark at issue here. In any event, in the absence of any evidence of use the mere fact of protection is irrelevant for the reasons already given.

45. I have also considered Mrs Heal's submission that the opponent has restricted its target market for its WONDERBRA brassiere by using sexually provocative imagery in its advertising. As a result, it was said that it was no longer open to the opponent to target its goods at children. As the applicant's specification is not in any way limited to goods for children, I fail to see how this has any bearing on the matter. In any event, as Mr Edenborough pointed out, even if the opponent does not wish to market brassieres to children under the mark WONDERBRA, that does not mean that it cannot object to another party doing so under a mark that is likely to falsely suggest an economic connection with the opponent.

46. I conclude that the opposition under Section 5(2)(b) based upon the earlier registration of WONDERBRA succeeds in respect of:

brassieres; women's swimwear and bodies.

47. The opposition fails in respect of the other goods in Class 25 of the application and all the goods in Classes 18 and 24.

48. The opposition under Section 5(2)(b) based upon the earlier trade mark WUNDERPANTS succeeds in respect of :-

Pants; trousers; briefs; panties; knickers; boxer shorts; all for men, women and children.

49. I have not included "underwear" in general (for which the earlier mark is also registered) because I consider the above list of goods sufficient to give effect to my decision that the later mark should not be registered for any goods in the nature of pants. The opposition fails in respect of the remainder of the goods in Class 25 and all the goods in Classes 18 and 24.

### **Section 5(3)**

50. Section 5(3) is as follows:

"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.”

51. In order to succeed in an opposition based upon Section 5(3) the opponent must be able to show that:-

- a) The earlier trade mark enjoys a reputation;
- b) For goods for which the earlier mark is registered and which are dissimilar to those for which the applicant seeks registration; and
- c) Use of the later mark would exploit either positively (by feeding off the reputation of the earlier mark), or negatively (by tarnishing the reputation or blurring the distinctive character of the earlier mark) the repute and/or distinctive character of the earlier trade mark.

52. The opponent satisfies the first part of the test. The WONDERBRA mark has a substantial reputation for brassieres. Mr Edenborough identified “whips” and “harnesses” in Class 18 of the applicant’s specification as being goods which were a) dissimilar to brassieres and b) goods in respect of which use of the mark WUNDERKIND may adversely impinge upon the reputation of the WONDERBRA mark.

53. The Section 5(3) ground fails because the resemblance between the marks WONDERBRA and WUNDERKIND, although sufficient to cause confusion if both are used in respect of identical (or nearly identical) goods for which the former enjoys a reputation, is insufficient to cause tarnishing, or any of the other heads of damage, if the mark WUNDERKIND is used in respect of goods as different as “whips” and “harnesses”. I have no evidence to guide me but, based upon my own assessment, I do not accept that such use would even bring the opponent’s mark to mind, which whilst not sufficient of itself, is an essential pre-requisite for the sort of damage the opponent complains about.

#### **Section 5(4)(a)**

54. Section 5(4)(a) is 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

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.”

55. Misrepresentation is an essential component of the tort of passing-off. This depends upon confusion and deception brought about by the use or proposed use of an indicia adopted by a defendant [in this case, applicant]. I have already considered the likelihood of confusion in my findings under Section 5(2)(b). The opponent is in no better position under Section 5(4)(a) and cannot succeed to any greater extent. Consequently, I need say no more about it.

### **Conclusion**

56. The consequences of my findings are that the application may proceed to registration if the applicant, within one month of the end of the period allowed for appeal, files a Form TM 21 limiting its specification in Class 25 to:

Clothing, footwear, headgear, sportswear, sports shoes; parts and fittings for the aforesaid goods; but not including pants, trousers, briefs, panties, knickers, boxer shorts, brassieres; women's swimwear or bodies.

57. If the applicant fails to amend the application so as to remove the offending goods the application will be refused in full.

### **Costs**

58. The opposition has partly succeeded and partly failed. In the circumstances I do not propose to make an award of costs to either side.

**Dated this 15<sup>th</sup> Day of August 2001**

**Allan James  
For the Registrar  
The Comptroller General**