

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2236338 BY
MARTIN MITCHELL TO REGISTER A SERIES OF MARKS IN
CLASSES 18, 20 AND 25**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
NO 51687 BY MARTIN IMDAHL**

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DECISION

1. On 17 June 2000 Martin Mitchell applied to register the following series of two marks:



for specification of goods which read:

Class 18

All purpose sport and travelling bags; handbags; suitcases; attache cases; vanity cases sold empty; toilet bags sold empty; and travelling bags having a security closure system.

Class 20



Coat hangers; clothes hangers; protective garment covers; protective suit covers; jewellery cases not of precious metals; hand held mirrors.

Class 25

Clothing; footwear and headwear; jumpers; shower shoes; shirts; t-shirts; clothing for golf namely, footwear, headwear, shirts, jumpers, trousers.

2. The application is numbered 2236338.

3. On 9 November 2000 Martin Imdahl filed notice of opposition to this application. He is the proprietor of the following Community Trade Mark registrations.

No	Mark	Class	Specification
424069		18	Leather and imitations of leather, and goods made of these materials, included in Class 18; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery
		25	Clothing, footwear, headgear.
		28	Games and playthings; gymnastic and sporting articles, included in Class 28; decorations for Christmas trees.
548131		18	Leather and imitations of leather, and goods made of these materials, included in Class 18; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery
		25	Clothing, footwear, headgear.
		28	Games and playthings; gymnastic and sporting articles, included in Class 28; decorations for Christmas trees.

4. It is submitted that the mark applied for is identical from a phonetic point of view and similar from a visual point of view to the above marks and has been applied for in respect of identical and/or similar goods. Accordingly it is said that the application should be refused pursuant to Section 5(1) and/or Section 5(2)(a) or (b) of the Act. The opponent further claims to have used his marks on goods, particularly clothing and bags, in the UK since 1998 but has filed no evidence in substantiation of this claim.

5. The applicant filed a counterstatement denying the above grounds.

6. Both sides ask for an award of costs in their favour.

7. The opponent filed a statutory declaration by Sally Ann Schupke, his trade mark representative. Her declaration consists essentially of submissions.

8. Neither side has asked to be heard. Acting on behalf of the Registrar and after a careful study of the papers I give this decision. In doing so I take into account the opponent's written submissions.

9. The relevant part of the statute reads:

“5.-(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(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.”

10. The opponent has raised ground which go Section 5(1), 5(2)(a) and 5(2)(b) of the Act. If the respective marks are identical he has the prospect of success under Section 5(1) or 5(2)(a). If not he must rely upon Section 5(2)(b).

11. The issue as to whether marks are identical or similar was considered in opposition No 44755 by The Baywatch Production Company to an application for the word BAYWATCH by Mr Gananath Wimalal Ediriwira; O-051-01. In fact the applicant's mark was the word BAYWATCH represented in what the Appointed Person on appeal described as capital letters in different sizes. The Registry's Hearing Officer had held that the fact that one of the marks was presented in upper or lower case or a combination of both will not normally have a bearing on whether the marks are identical. The Appointed Person on appeal took a different view. He said:

“I am not satisfied that the marks are identical. I think it is important in the context of Section 5(2) that the word “identical” is given its normal English meaning, since under Section 5(2)(a), if the trade mark used is identical and is used in relation to identical goods or services, an absolute monopoly is granted. Just as there is an important distinction between anticipation and obviousness in patent law, so also there is an important distinction between identity and similarity for trade mark law. Here there is a plain difference. The earlier registered mark consists solely of capital letters in the same size. The mark opposed consists of capitals in different sizes. They are therefore not identical.”

12. The above remarks were made in the context of word marks but are relevant also in the content of letter/device marks. The opponent's earlier trade mark, No 424069 is a highly stylised representation of what may or may not be seen as a letter M. The applicant's counterstatements suggests that "it could be read as two capital F's, one a mirror image of the other, with a capital Y adjoining the two". Suffice to say for present purposes that it is a highly fanciful composition. No 548131 is more clearly a letter M and likely to be taken as such enclosed within concentric circles. However, neither mark can be said to be identical to the applied for mark. Further analysis seems to me to be unnecessary for the purposes of disposing of the objections under Section 5(1) and 5(2)(a).

13. In approaching Section 5(2)(b) 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 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.

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 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*,

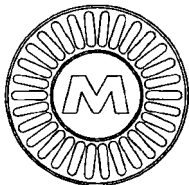
paragraph 26;

- (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.

14. The application in suit has goods in Classes 18 and 25 which must be considered to be identical to the goods of the opponent's earlier trade marks. Clothing and footwear in Class 25 are, for instance, common to both the earlier trade marks and the application under attack as are 'travelling bags' in Class 18. Other goods in Class 18 of the application such as handbags, suitcases and attache cases, although not expressed in these terms in the opponent's registrations must come within the broad heading 'leather and imitation of leather, and goods made of these materials'. If the opponent does not succeed on the basis of identical goods he is unlikely to fare any better on the basis of other items within his specification. That, therefore, is my starting point.

15. I will say straightaway that I regard the mark of No 424069 as being of such elaborate and unusual design that it transcends the notion of a letter M. It is a quite dissimilar mark to the mark applied for. It follows that No 548131 represents the opponent's strongest case. For ease of comparison I set out the respective marks as follows:-

Applicant's Mark



Opponent's Mark



16. Neither side has submitted evidence of use of their marks though both claim use since 1998. That state of affairs is not without importance for two reasons. Firstly it means that I have only the inherent attributes of the opponent's earlier trade mark to consider. Secondly I have no means of gauging the significance of the claim made in the statement of grounds that "the opponent expects to and does receive orders for their products by telephone and it is submitted that the two trade marks are virtually indistinguishable and are confusingly similar when referred to over the telephone".

17. It was said in REACT Trade Mark [2000] RPC 285

“There is no evidence to support [Counsel's] submission that, in the absence of 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 that 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.”

18. The general expectation that clothing is purchased as a result of a visual inspection of the goods and marks (either in a shop or in a catalogue) is of course one that can be displaced by evidence showing that a particular trader, for whatever reason, conducts his business to a greater or lesser extent through word of mouth orders or at least that such orders are more than usually important in his business. All that I have been told here (per the statement of grounds) is that the opponent's goods, especially clothing and bags, are sold in a number of shops located throughout the UK. That rather suggests a visual display of goods as part of a retail trade rather than oral ordering. However strictly there is no evidence before me one way or the other. I, therefore, approach the matter on the basis that REACT represents a reasonable statement of the relative importance of visual/oral considerations in the context of the clothing trade. Furthermore there is no reason to suppose that a significantly different state of affairs prevails in respect of bags etc in class 18.

19. In their statement of grounds (and evidence) and counterstatement the parties have made what amount to submissions bearing on the respective marks. The applicant's position is that

“It is denied that the device marks are identical from a phonetic point of view. Device marks, such as those of the applicant and the opponent, are not designed to be communicated orally and always require a visual representation. Comparing the marks' phonetic similarity is therefore spurious.

It is denied that the marks in question are visually similar. The applicant's mark, application No 2236338, consists of a capital M enclosed within a circle. Thick dashes then extend radially out from this circle, the dashes being approximately the same height as the letter M, around which a further circle encloses the mark. The capital M in question is in a simple, bold font and takes up a small proportion of the overall mark. In contrast, the opponent's CTM application No 548131 consists of a stylised capital M enclosed within two circles. In contrast to the applicant's mark the M takes up a large proportion of the mark and the distinctive radial elements of the applicant's mark are absent. The circles in the opponent's CTM application are also much closer together and convey a very different overall impression to that of the applicant's mark.”

20. The opponent says:

“We also note that Section 5(2) implements the mandatory provisions of Article 4(1)(b) of the Council Directive No 89/104/EEC and would draw the Registrar’s attention to Balmoral Trade Mark (18 August 1998) ¹ which provides for similarities (in terms of marks and goods or services) which would combine to create a likelihood of confusion if the “earlier trade mark” and the mark subsequently presented for registration were used concurrently in relation to the goods for which they are respectively registered and proposed to be registered in the UK. When comparing the two marks, the letter M is identical so that they are identical in sound and pronunciation. Furthermore, they resemble each other in their graphic depiction, both containing the letter M surrounded by a circle.”

21. As noted in *Sabel v Puma* visual, aural and conceptual similarities must be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components. What are the distinctive and dominant components of these marks? The parties have referred to the common element of a letter M. Although the marks are not simply letters M some appraisal of that element is necessary in order to determine its significance in each case within the totality of the marks.

22. Although distinctiveness on absolute grounds is not in issue in these proceedings it has been the practice both in this country and before OHIM to regard single letters as being either devoid of distinctive character or certainly of weakly distinctive character as unused marks (see for instance the consideration of letter marks in *Xe Trade Mark*, [1999] RPC 405 and *Fuji Photo’s CTM application* [1998] ETMR 343). I bear in mind also that in the context particularly of clothing that certain letters are commonly used as indicators of size (including M for medium). I, therefore, regard the letter M as having a low capacity to serve as a designation of origin in its own right. However the manner of presentation of the letter and/or any additional matter that is present can have a material effect on the impact it makes.

23. The opponent’s mark is of course more than a simple letter M. It is that letter presented in a rather monolithic manner that appears to give it great weight and solidity. It is not, as far as I am aware, any recognised typeface or at least not a commonly used one. The letter is also presented within two concentric circles.

24. The applicant’s mark too has an M at its centre. It might also be said to have two concentric circles surrounding it. But there the similarity ends. The letter itself is in an ordinary, or at least unremarkable, typeface. But it is undeniably a visually prominent feature of the mark. Even so it is in my view a less distinctive and dominant presence within the totality of the applicant’s mark than the M of the opponent’s mark. Furthermore the concentric circles in the applicant’s mark do little more than set the boundaries for the device that is contained within them. In contrast the concentric circles in the opponent’s mark exist as an element in their own right. The device in the applicant’s mark - whether one sees it as a sunburst effect, a flower-head, a spoked wheel or simply as an abstract device - does I would suggest, make a distinct visual impact and contribution to the mark as a whole.

¹ Reported at [1999] RPC 297

25. With these preliminary observations in mind I go on to consider the visual, aural and conceptual similarities. Visually I do not think there is any realistic danger of one mark being considered similar in the sense of contributing to direct confusion. But marks are seldom viewed side by side and as noted in the Lloyd case due allowance must be made for imperfect recollection. The presence of the letter M, albeit heavily stylised in the opponent's mark, is unlikely to be lost on the viewer. It is, one might say, a common reference point between the respective marks. But having a common reference point is not the same as saying that the marks are visually similar. If I am right in holding that a single letter is unlikely in itself (and for these goods) to be a particularly distinctive mark or element then it is likely to follow that a particularly stylised presentation will itself attract attention and fix itself in the mind of the consumer. That, in my view, is the position here. It is the striking stylisation of the letter in the opponent's mark that catches the eye whereas it is the surrounding device which sets off the quite ordinary letter M in the applicant's mark.

26. Aurally there is some force to the opponent's claim that both marks may be referred to as M marks. Whether a customer wishing to refer to the marks in speech would also attempt to do so by reference to the other feature of styling and devices is a matter for conjecture. The opposite is almost certainly true. That is to say customers would be unlikely to refer to the marks without mentioning the letters.

27. Conceptually too the presence of a common reference point suggests some similarity but on the whole I would expect visual and, to a lesser extent, aural considerations to be the major determinants.

28. I have not found this an easy matter on which to reach a view. The burden of proof lies on the opponent. It is for the opponent to show that the relevant likelihood of confusion exists. It may be that some people on encountering the applicant's mark would make an association with the opponent's mark on the basis of the common features (particularly the letter M). But the purchasing process for these goods is largely a visual act and these are marks that in their totalities make different visual impacts. I do not, therefore, think that I can with any confidence say that any association or link that is made between the marks would lead the purchasing public to believe that the underlying goods came from the same or economically linked undertakings. Accordingly there is no likelihood of confusion within the meaning of the Section. The application fails under Section 5(2)(b).

29. The applicant has been successful and is entitled to a contribution toward his costs. I order the opponent to pay him the sum of **£500**. 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 12TH day of December 2001

M REYNOLDS
For the Registrar
the Comptroller General