

TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION No 2229129  
BY JOSEPH YU  
TO REGISTER A TRADE MARK  
STORM  
IN CLASS 9

AND IN THE MATTER OF OPPOSITION THERETO  
UNDER NUMBER 52523  
BY SUN 99 LIMITED

## BACKGROUND

1) On 12 April 2000, Joseph Yu of 165 Bradwell Common Boulevard, Milton Keynes, Bucks, MK13 8AL applied under the Trade Marks Act 1994 for registration of the mark STORM in respect of the following goods in Class 9: "Safety footwear, safety garments: but not including protective eyewear, goggles and armbands."

2) On the 3 May 2001 Sun 99 Limited of 37-19 Conway Street, London, W1P 6ST filed notice of opposition to the application, subsequently amended. The amended grounds of opposition are in summary:

a) The opponent is the proprietor of the five UK earlier trade marks set out in Annex A.

b) The mark in suit is identical to the opponent's trade mark and is to be registered for similar goods. The mark applied for therefore offends against Section 5(2)(b) of the Trade Marks Act 1994.

c) The opponent has generated goodwill in its marks through substantial expenditure on advertising and marketing since it first used its' mark in 1993. The marks have been used on casual clothing of all kinds and outerwear, including jackets, jeans and leather clothing. The general public are likely to assume an association between the two businesses and the applicant would therefore be taking unfair advantage of the opponent's goodwill. Use of the later mark would constitute passing off and registration would be contrary to Section 5(4)(a) of the Trade Marks Act 1994.

3) The applicant subsequently filed a counterstatement denying the opponent's claims.

4) Only the opponent filed evidence in these proceedings. Both sides ask for an award of costs. Neither side wished to be heard.

## OPPONENT'S EVIDENCE

5) The opponent filed a declaration, dated 19 December 2001, by Steve Sun, the Managing Director of the opponent company, a position he has held for over fifteen years.

6) Mr Sun states that “the STORM trade mark was first used by the opponent in the UK in relation to leather jackets, T-shirts, jumpers, jeans and jump suit jeans, shoes, hats bags and luggage from 1988 onwards.” He states that the opponent began using the STORM mark on sunglasses in 1992 and “are expanding this into protective eyewear for skiers”. Mr Sun states that the opponent sells direct to the public through wholly owned stores in the Kings Road , Carnaby Street and also Windsor. He states that “until recently we also had stores in Neal St, Convent Garden, Heathrow Airport, Gatwick Airport and Gees Court (W1). In addition the opponent also wholesales.

7) At exhibit SS1 Mr Sun provides photographs of clothing products sold by the opponent. The photographs show six different jackets hanging in a shop display. In each the mark STORM can be seen as both a neck label and also on the hanger. There is also a picture of a boot with the STORM label on its sole and on the display stand. Mr Sun states that the mark is also promoted by way of swing tags, carrier bags and point of sale material.

8) On the similarity of goods he states:

“One of the jackets [at exhibit SS1] shown is made from rubber, a traditional ‘protective material’. It can be seen that some of our boots are of a very similar style to the traditional safety footwear used by railway workers and the like.”

“I would also note the recent fashion trend, led by companies such as Caterpillar and Dr Martens, to make fashion clothing and footwear based on styles modelled on what was traditionally regarded as ‘protective’ clothing or working-mens clothing. There can also be, and is a high degree of overlap between the materials used in safety wear and fashion clothing. A well-known example of such overlap is the jump suit worn by Anneka Rice in her television programme of a few years ago. There is in fact no clear demarcation between ‘fashion clothing’ and ‘safety’ or ‘protective’ clothing as claimed by the applicant. The former dips into and borrows much from the latter as fashion trends develop or change. There is no reason to suppose that the average consumer would not think that the applicant’s products are not a natural extension of our business or in some way connected with the opponent, particularly where marketing is under an identical trade mark.”

9) Mr Sun claims that “there will be a significant and inevitable degree of overlap between the channels of trade, particularly where larger stores or the internet is concerned.” Given the identity of the marks he believes that the average consumer would believe that there was a connection between the two parties.

10) That concludes my review of the evidence. I now turn to the decision.

## DECISION

11) I turn first to the ground of opposition under section 5(2) which reads:

“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.”

12) An earlier trade mark is defined in Section 6, the relevant parts of which state:

6.-(1) In this Act an "earlier trade mark" means -

- (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,

13) In determining the question under section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *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* page 224;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG* page 224, 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.* page 84, 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* page 224;
- (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* page 224;

- (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* page 132, 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* page 224;
- (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* page 224;
- (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* page 732, 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* page 133 paragraph 29.

14) In essence the test under Section 5(2) is whether there are similarities in marks and goods and/or services 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 judgements of the European Court of Justice mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods and/or services the category of goods and/or services in question and how they are marketed. Furthermore, I must compare the mark applied for and the opponent's registrations on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods and services covered within the respective specifications.

15) The opposition is based upon five trade marks detailed at annex A. Of these two, 2127268B and 2127274B, are not registered trade marks having been refused by the registry. They are therefore not earlier trade marks. The remaining three marks are all registered trade marks with effective dates prior to the relevant date of 12 April 2000. They are all for the word STORM.

16) In the statement of grounds the opponent claimed that the mark offended against Section 5(2)(b). However, as the opponent's marks are identical to the mark in suit clearly Section 5(2)(a) is more apt. The applicant can have been in no doubt as to the nature of the opposition, and is not put at a disadvantage by this change.

17) It is clear from the above cases that in the overall assessment of a likelihood of confusion,

the identity of marks is but one aspect. Due regard should be given to the closeness of the respective goods, the reputation the earlier mark enjoys in respect of the services for which it is registered, and any other relevant factors.

18) The applicant's specification is for "Safety footwear, safety garments; but not including protective eyewear, goggles and armbands." The opponent has not specified the goods that it regards as similar to those of the opponent. However, it is clear from the opponent's evidence that it believes that its strongest case is under trade marks 1250938 and 1500089. I agree with this view as the goods covered by the opponent's trade mark 2152209 are clearly dissimilar to those of the mark in suit. The opponent's other two trade marks have the following specifications:

- 1250938: In Class 25: "Jeans being articles of clothing; articles of clothing made from knitted textile fabrics; knitted articles of clothing".
- 1500089: In Class 25: "Jeans being articles of clothing; articles of clothing (none being waterproof) made from woven textile fabrics; knitted articles of clothing; all included in Class 25".

19) In order to assess the similarity of the goods and services, I note the factors set out by Mr Justice Jacob in *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281 at page 296. Adapted to the instant case, it can be stated as:

- a) the uses of the respective goods;
- b) the users of the respective goods;
- c) the physical nature of the goods;
- d) the trade channels through which the goods reach the market;
- e) in the case of self-serve consumer items, where in practice they are respectively found or likely to be found on the same or different shelves; and
- f) the extent to which the respective goods 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 in the same or different sectors.

20) These factors were referred to in the opinion of the Advocate General in *Canon*; page 127, paragraphs 45-48. In its judgement, the ECJ stated at paragraph 23:

"23. In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their end users and their method of use and whether they are in competition with each other or are complementary."

21) Protective clothing is that designed to protect against fire, accident or injury, such as shoes with steel toe caps and oil resistant soles, hard hats, padded clothing, leather gauntlets, fluorescent clothing and chain mail gloves. The users of such goods is restricted to those

engaged in potentially hazardous work whereas the users for the opponent's products would be the general public. Clearly the uses are different with the opponent's goods being general clothing which serves only to clothe the wearer whereas the applicant's goods are designed to protect the wearer from specific dangers.

22) In evidence the opponent has commented on the recent trend for general clothing to ape what might be called industrial clothing. This is particularly prevalent in the footwear sector. However, whilst the designs and materials have converged to a degree there would still appear to be differences. The opponent states that it sells a jacket made of rubber and comments that this is a "traditional protective material". This however does not make the jacket concerned a protective jacket, also the opponent's Class 25 registrations do not cover rubber jackets. Nor does the opponent's specification cover footwear. The opponent claims that the trade channels for the goods are similar, but has offered no evidence to corroborate this assertion. I accept that steel toe capped boots and shoes can be found in general shoe shops, however, in my experience protective clothing tends to be sold via specialised outlets and catalogues.

23) In my experience, items of general and/or fashionable clothing are found in self serve stores but protective clothing, with the exception of shoes and gloves, are not. I do not consider the goods to be competitive. They serve different markets.

24) Items of protective clothing are not, I would suggest, chosen without considerable consideration. The average consumer of such products would, in my opinion, spend some time ensuring that the item would provide the precise level of protection required for the hazardous activity planned.

25) Ordinarily I would also consider whether the opponent's mark has a particularly distinctive character either arising from the inherent characteristics of the mark or because of the use made of it. However, no evidence has been filed. In such circumstances the opponent's marks cannot be regarded as enjoying an above average reputation at the relevant date, but it is an inherently strong mark. I must also take into account the dictum of imperfect recollection.

26) With all of this in mind I come to the conclusion that when all factors are considered, that there was no likelihood of confusion at 12 April 2000. Consequently, the opposition under Section 5(2)(b) fails.

27) I next turn the ground of opposition under Section 5(4) which reads:

"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.”

28) In deciding whether the mark in question “STORM” 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:

“The question raised by the Grounds of Opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the Applicant from those of other undertakings (see Section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Art.4(4)(b) of the Directive and Section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the Applicant in accordance with the law of passing off.

A helpful summary of the elements of an action for passing off can be found in Halsbury’s Laws of England 4th Edition Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd - v - Borden Inc* [1990] RPC 341 and *Even Warnik BV - v - J. Townend & Sons (Hull) Ltd* [1979] AC 731 is ( with footnotes omitted) as follows:

The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

- (1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the defendant ( whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and
- (3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.”

29) With these considerations in mind I turn to assess the evidence filed on the behalf of the parties in the present proceedings as set out earlier in this decision, and the arguments put forward at the hearing.

30) The opponent has provided no evidence, other than the assertion by Mr Sun, that it sold shoes or rubber jackets prior to the relevant date. Nor is there any indication of the size of any such trade. The opponent has failed to show that, at the relevant date, it enjoyed goodwill in its trade marks. On this footing the opposition under Section 5(4)(a) of the Act must fail.

31) The opposition having failed the applicant is entitled to a contribution towards costs. I order the opponent to pay the applicant the sum of £500. This sum 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 14<sup>TH</sup> day of October 2002

George W Salthouse  
For the Registrar  
The Comptroller General



## Annex A

Trade Mark	Number	Effective Date	Class	Specification
STORM	1250938	25.09.85	25	Jeans being articles of clothing; articles of clothing made from knitted textile fabrics; knitted articles of clothing.
STORM	1500089	09.05.92	25	Jeans being articles of clothing; articles of clothing (none being waterproof) made from woven textile fabrics; knitted articles of clothing; all included in Class 25.
STORM	2127268B	Refused	25	Articles of clothing of all kinds, made from woven, leather, knitted and synthetic fabrics for men, women and children; T-shirts, sweat shirts, formal casual shirts; coats; suits; jackets and anoraks; jumpers; cardigans; waterproof and non-waterproof outerwear; jeans; underwear; socks, scarves and headgear; sportswear including tracksuits, jogging suits, tops and bottoms; footwear and headgear.
STORM	2152209	03.12.97	9	Optical instruments and devices, none relating to weather forecasting or weather recording; sunglasses, spectacles, monocles, binoculars, monoculars, magnifying glasses, opera glasses, telescopes; headband magnifiers; night vision aids; parts, frames, cases and fittings for all the aforesaid goods.
			28	Toys, games and playthings for humans and for pets; balloons; dolls, puppets, mobiles, teddybears; dolls houses, furniture and fittings therefor; display stands for toys; clothing for toys; playhouses, play tents; card games and playing cards; board games; building bricks, building blocks and other components all being in the nature of toys; gymnastic and sporting articles (none being angling apparatus); models and replicas in kit form or complete; craft toys sold in kit form; jigsaw and other puzzles; conjuring and juggling sets; toy action figures and accessories therefor; roller skates, ice skates, in-line skates; skateboards, surfboards, snowboards; masquerade costumes and masks; amusement park rides, Christmas tree decorations; parts and fittings for all the aforesaid goods.

	2127274B	Refused	25	<p>Articles of clothing of all kinds, made from woven, leather, knitted and synthetic fabrics for men, women and children; T-shirts, sweat shirts, formal casual shirts; coats; suits; jackets and anoraks; jumpers; cardigans; waterproof and non-waterproof outerwear; jeans; underwear; socks, scarves and headgear; sportswear including tracksuits, jogging suits, tops and bottoms; footwear and headgear.</p>
---	----------	---------	----	--