

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2196430
BY BCA (TRADING AS A PARTNERSHIP) TO REGISTER A TRADE MARK
IN CLASS 16**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No. 51040
BY DIKNAH S.L.**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No. 2196430
by BCA (trading as a partnership) to register a Trade Mark
IN CLASS 16**

AND

**IN THE MATTER OF Opposition thereto under No. 51040
by Diknah S.L.**

BACKGROUND

1. On 4 May 1999 BCA (trading as a partnership) applied to register the trade mark MANGO in Class 16 of the Register for a specification of: "Printed publications, printed matter, magazines, brochures, books; all relating to fiction."
2. The application was accepted by the Registrar and published in the Trade Marks Journal. On 1 June 2000 Frank B Dehn & Co, on behalf of Diknah S.L. filed Notice of Opposition against the application on the following grounds:

(i) Section 5(1) or in the alternative Section 5(2)(a) of the Act, because the mark is identical to the following earlier registered trade mark owned by the opponent and is to be registered for the same or similar goods and there is a likelihood of confusion on the part of the public:

NUMBER	MARK	REGISTRATION EFFECTIVE	GOODS
1514026	MANGO	24 September 1992	Paper, paper articles; cardboard and cardboard articles; printed matter; photographs; all relating to fashion and body care; all included in Class 16.

(ii) Under Section 5(4)(a) of the Act by virtue of the law of passing off as a result of the opponent's use of their mark in the U.K. on catalogues and similar goods at least since September 1998.

3. The applicant, through its agent Marks & Clerk, filed a Counterstatement denying the grounds of opposition. Both sides filed evidence and asked for an award of costs in their favour. Neither party requested a hearing.

Opponent's Evidence

4. This consists of a statutory declaration by Daniel Lopez Garcia dated 23 May 2001. Mr Garcia is a legal advisor to Diknah S.L. (The opponent).

5. Mr Garcia confirms that the opponent is the registered proprietor of the earlier registration 1510426. He states that the trade mark MANGO has been used in the UK since September 1998 on articles of clothing and shoes, and since September 1999 on postcards by a sub-licensee of the opponent. Mr Garcia claims that a reputation has built up in consequence of the use made of the mark and he draws attention to Bundle B to Exhibit DLG1 to his declaration which contains samples of brochures relating to MANGO clothing.

6. Mr Garcia goes on to provide U.K. turnover figures for Class 25 products sold under the MANGO trade mark for the years 1999 and 2000, which are £3,666,667 and £14,722,223 respectively. At Bundle C to Exhibit DLG1 to his declaration is a list of retail outlets where MANGO clothing products are sold and where, he states MANGO postcards are available.

7. Next, Mr Garcia turns to marketing and advertising and he draws attention to Bundle D to Exhibit DLG1 which contains copies of press articles and advertising material relating to the mark. He states that the advertising expenditure incurred was £150,000 in 1999 and £335,000 in 2000.

8. Mr Garcia explains that as part of the advance publicity to opening new retail outlets in the U.K., and for ongoing promotional reasons, his company regularly makes available MANGO postcards. At Bundle E to Exhibit DLG1 to his declaration are copies of such postcards together with invoices issued to the publishers. He adds that the U.K. turnover figure for Class 16 products under the MANGO trade mark was £45,335 in the year 2000.

Applicant's Evidence

9. This consists of a witness statement by Stephen Charles Rand dated 31 October 2001. Mr Rand is the Executive Board Secretary of BCA (the applicant).

10. Mr Rand explains that his company launched a book club under the mark MANGO in July 1999 and that the name MANGO was selected after an internal brainstorming session and consideration via focus groups.

11. Mr Rand states that the approximate annual turnover by his company of books sold through the MANGO book club are as follows:

Year	Turnover
July 1999 to June 2000	£774,000
July 2000 to June 2001	£2,073,000

12. Turning to advertising, Mr Rand states that the following has been spent by his company in relation to the MANGO book club:

Year	Turnover
July 1999 to June 2000	£967,000
July 2000 to June 2001	£1,091,700

13. Mr Rand goes on to refer to the following Exhibits to his declaration:

- (i) Exhibit SCR 1 - a diary listing from 11 July 1999 to 27 November 2001, advertisements relating to the MANGO book club;
- (ii) Exhibit SCR 2 - copies of press advertisements relating to the MANGO book club;
- (iii) Exhibit SCR 3 - various publicity materials for the MANGO book club.

14. Mr Rand states that, although his company has used the mark MANGO on a substantial scale, he is unaware of any confusion with the MANGO mark of the opponent.

15. This completes my summary of the evidence filed in this case. I would add that the opponent has made a number of written submissions in support of the grounds of objection and I have taken these into account in reaching my decision.

DECISION

16. Firstly, I go to the ground of opposition based upon Section 5(1)/Section 5(2)(a) of the Act which read as follows:

“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)

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

17. An earlier right 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,”

18. I go on to consider whether the ground raised under Section 5(1) of the Act or Section

5(2)(a) is appropriate to this particular case. This turns on whether the applicant's goods as specified, includes goods identical to those covered by the opponent's registration.

19. The application is made in respect of "Printed publications, printed matter, magazines, brochures, books; all relating to fiction" and the opponent's registration includes (inter alia) printed matter relating to fashion and body care. While printed matter encompasses publications, books, magazines and brochures it seems to me that the specific content and purpose of the respective printed matter/printed publications is not identical. This may be a narrow interpretation but in my opinion it is nevertheless correct. While the customer for the goods could be the public at large and I accept that many publications e.g. magazines, include numerous topics in their content including fashion and fiction, there exist specific markets for works of fiction and specific markets for fashion and body care publications and the public at large may discriminate in choosing the particular content of the publication which they wish to purchase or read. It follows that as I do not consider the respective goods to be identical, I do not believe the opposition succeeds under Section 5(1) of the Act and I go on to consider the opposition in the light of Section 5(2)(a).

20. 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.

21. 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* paragraph 27;
- (c) 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;
- (d) 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;
- (e) 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;
- (f) 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;

- (g) 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.

22. As the marks are identical and fully distinctive in relation to the goods for which they are registered the test is whether there are similarities in goods which would create a likelihood of confusion. This involves a consideration of the category of goods in question, how they are marketed and the customer for the goods.

23. Both the applicant's and opponent's marks have been used prior to the date of application for the mark in suit, the applicant's goods having been sold by the MANGO Book Club and the opponent's having sold MANGO printed matter in relation to its fashion, primarily clothes business. There is no evidence of confusion in the market place. However, I must compare the mark applied for and the opponent's registration assuming normal and fair use on all the goods covered within the respective specifications.

24. In determining whether the goods covered by the application are similar to the goods covered by the opponents trade marks 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:

"The following factors must be relevant in considering whether there is or is not similarity:

- (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 acts of 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 particular 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."

25. Whilst I acknowledge that in view of the CANON-MGM judgement by the European Court of Justice (3-39/97) 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/or services.

26. As stated earlier in this decision, both the applicant's and opponent's specifications of goods include printed publications e.g. books, magazines, periodical publications and brochures, the difference in these publications being in their subject matter.

27. The uses or purposes of the parties' printed publications can be said to overlap in that they both consist of reading material which could be of interest to the general public. Both fiction and fashion/body care are subjects appealing to wide rather than specialised audiences. Turning to the users of the goods it seems to me that the purchasers of both magazines or periodical publications relating to fiction and those relating to fashion and body care could overlap to a considerable degree. On the physical nature of the printed publications, it must follow that they are identical, notwithstanding the differences in subject matter. Furthermore, the respective trade channels through which the goods reach the market are likely to be identical, in that books, magazines and periodical publications of general interest to the purchasing public are sold through the same outlets. Finally, there may be instances when the respective goods are in competition e.g. a customer choosing a magazine for general leisure reading could browse through fashion/life style publications and also those magazines comprising short fictional stories before reaching a decision on a purchase.

28. As mentioned above, it seems to me that the relevant customer for both the applicant's and opponent's printed publications would be the general public. My own knowledge and experience tells me that customers are usually fairly selective in their choice of reading material, but not overly selective in their choice of "general interest" publications, which could include magazines relating to fashion and body care or fiction, or magazines which would encompass articles, features and stories relating to all these subjects. Although magazines etc are often bought in a hurry, this is not a "bag of sweets" case.

CONCLUSION

29. On a global appreciation, taking into account all the relevant factors, I come to the following conclusions in relation to the Section 5(2)(a) ground:

- (i) the respective marks are identical;
- (ii) the respective specifications of the applicant's and opponent's goods include goods ie. printed publications, which are similar, notwithstanding the difference in subject matter;
- (iii) while the customer for the goods is likely to be relatively discerning, the printed publications would be in such close proximity that if sold under the same brand name the consumer is likely to consider that they originate from the same undertaking or economically linked undertaking.

30. In reaching a decision in relation to the likelihood of confusion I have particularly borne in mind the following comments of the European Court of Justice in Cannon:

“Accordingly the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically linked undertakings, constitutes a likelihood of confusion within the meaning of Article 4(1)(b) of the Directive (see SABEL paragraphs 16 to 18).”

31. The opposition is successful under Section 5(2)(a) of the Act and as I have found for the opponent under Section 5(2) I have no need to consider the other ground raised.

COSTS

32. The opponent is entitled to a contribution towards costs and I therefore order the applicant to pay the opponent the sum of £900. 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 14th day of October 2002

JOHN MacGILLIVRAY
For the Registrar
the Comptroller-General