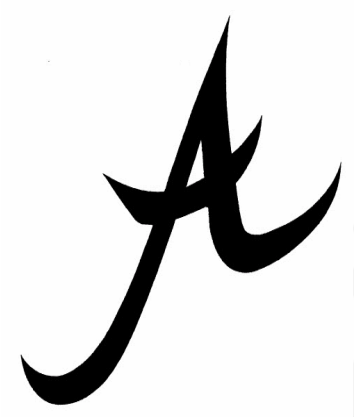
Trade Marks Act 1994

In the matter of application to register trade mark
No. 2272753A in the name of:
Aloha Surfboards Pty Limited in Classes 3, 16 and 18

Background

1. On 16th June 2001 Aloha Surfboards Pty Limited of 8/111 Old Pittwater Road, Brookvale 2100, New South Wales, Australia applied under the Trade Marks Act 1994 for registration of the trade mark:

No. 2272753A



in respect of :

Class 3 Shower gels, body sprays, shampoo, soaps, hair lotions and gels, essential oils and perfumery

Class 16 Book binders, pencil/stationery cases, stationery artist materials

Class 18 Toiletry bags

2. Following examination under the provisions of Section 37(1) of the Trade Mark Act 1994 the applicant was informed by an examination, issued on 12th July 2001, that there was an objection to the application with respect to Class 18 only, under Section 5(2) of the Act in respect of the following mark which is now registered:

No. 2248246

in respect of:

Class18:

in respect of Athletic bags, overnight bags, backpacks, duffel bags, tote bags, knapsacks, attache cases, briefcases, purses, handbags, wallets, billfolds, fanny packs, waist packs, cosmetic cases sold empty, toiletry cases sold empty, key cases, luggage, suitcases, garment bags for travel, trunks for travelling, umbrellas, canes, card cases, dog collars and dog leashes.

Class 25:

Clothing; caps, hats, visors, knitted headwear, headbands, bandannas, shirts, t-shirts, tank tops, sweaters, turtlenecks, pullovers, vests, shorts, pants, dresses, skirts, overalls, bodysuits, baseball uniforms, jerseys, warm-up suits, sweatshirts, sweatpants, underwear, boxer shorts, robes, sleepwear, swimwear, clothing wraps, coats, jackets, ponchos, raincoats, cloth bibs, infant wear, infant diaper covers, cloth diaper sets with undershirt and diaper cover, jumpers, rompers, onesies, coveralls, creepers, baby booties, ties, suspenders, belts, money belts, mittens, gloves, wristbands, earmuffs, scarves, footwear, socks, hosiery, slippers, aprons, sliding girdles and costumes.

Class 28:

Toys and sporting goods; stuffed toys, plush toys, bean bag toys, bean bags, puppets, balloons, marbles, checker sets, chess sets, board games, dart boards and dart board accessories, toy cars and trucks, toy mobiles, puzzles, spools incorporating coiled string which rewind and return to the hand when thrown, toy banks, toy figures, dolls and doll accessories, inflatable baseball bats, decorative wind socks, toy tattoos, flying discs, mini bats, neck and wrist lanyards for mini bats, mini baseballs, toy figures and sports whistles, video game cartridges, hand held video and electronic games, coin-operated pinball machines, baseballs and holders for baseballs, autographed baseballs, basketballs, footballs, playground balls, rubber action balls, golf balls, golf club covers, golf club bags, golf putters, bowling balls, bowling bags, baseball bases, pitcher's plates, baseball bats, catcher's masks, grip tape for baseball bats, baseball batting tees, pine tar bags for baseball, rosin bags for baseball, batting gloves, baseball gloves, mitts, umpire's protective equipment, chest protectors for sports, athletic supporters, baseball pitching machines, fishing tackle, swim floats for recreational use, party favors in the nature of noise makers, and Christmas tree ornaments.

Class 41:

Entertainment, education and information services; baseball games, competitions and exhibitions rendered live, through broadcast media including television and radio and via a global computer network or a commercial on-line service; providing information in the field of sports, entertainment and related topics, providing multi-user interactive computer games, and providing for interactive exchange of messages and information, all via a global computer network or a commercial on-line service.

3. Confirmation was issued on 11th April 2002 that Classes 3 and 16 were to be divided out of application 2272753. Application 2272753 becoming 2272753A for Class 18 while Classes 3 and 16 were to continue separately under application number 2272753B.

The Law

4. Following refusal of application 2272753A I am now asked under Section 76 of the Act and Rule 56(2) of the Trade Marks Rules 1994 to state in writing the grounds of the decision.

5. A period of 6 months was allowed for the applicant to respond under Section 37(3) following the issue of the examination report on 12th July 2001 objecting under Section 5(2) to Class 18. However by 5th September 2002 no response had been received to the objection and the application was therefore refused in accordance with Section 37(4) of the Act.

6. In relation to the section 5(2) objection raised at the examination stage for application 2272753A .

7. Section 5(2) of the Act reads as follows:

> "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."

Decision

8. Dealing firstly with the respective goods, it is apparent that the goods contained within the specification of the application are contained within the specification of the earlier application. Consequently, the matter hinges on the question of the similarity between the respective marks.

9. Since the mark of this application is not identical to the cited mark the matter falls to be decided under sub-section (b) of Section 5(2). The question, therefore, is whether the mark of this application is so similar to the mark of the cited application that there exists a likelihood of confusion which includes the likelihood of association on the part of the public.

10. Taking 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 consideration must be given to the following:

(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;

(d) 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 I*nc, paragraph 17;

(e) 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;

(f) 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;

(g) 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;

(h) 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.

11. The above judgements link the question of a likelihood of confusion to a number of factors including the visual, aural and conceptual similarities between the marks and whether the earlier mark has a particularly distinctive character, either per se, or by reputation.

12. The mark A (stylised) has a distinctive appearance in respect of the specified goods. Each of the marks are the same letter both sharing a curvilinear style. The A of the applicant is not visually identical to the cited mark but there does seem to be a conceptual similarity between both marks. Whilst I accept that visually the marks differ, the likelihood of confusion is not disproved by

placing marks side by side and demonstrating how small is the chance of error. In most persons, the eye is not an accurate recorder of visual detail, the marks are remembered rather by general impressions or by some significant detail rather than by photographic recollection of the whole (de Cordova and others v Vick. Chemical Co (1951) 68 R.P.C.103). When placed side by side the similarities and differences in appearance between the marks are plain to see, but it is not usual to have the marks before you to compare in this way.

13. The marks must be compared as a whole, although in any comparison it is inevitable that reference will be made to the distinctive and dominance of any individual elements. In this case I do not consider that any element in the marks could be said to be any more distinctive or dominant than another. The two trade marks are very similar in that although there are differences in presentation, they will both be referred to, and known as, "A" marks. I believe that the public would expect the goods to come from either the same undertaking or at least from economically-linked undertakings.

14. Having found that the goods are the same or closely similar, that the marks are confusingly similar and taking all of the above factors into account, I conclude that the similarities between the marks are sufficient to give rise to a likelihood of confusion between the applicants` mark and the cited marks, which includes the likelihood of association with the earlier marks.

I therefore believe that the application would be debarred from registration by Section 5(2) of the Trade Marks Act 1994.

Dated this 20TH day of November 2002.

Robert Fowler
For the Registrar
The Comptroller General