

**IN THE MATTER OF APPLICATION NUMBER 2204547
IN THE NAME OF HARMONY GOLD USA
TO REGISTER A TRADE MARK IN CLASSES 16 AND 25**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 50806 BY ALGOTEX**

**IN THE MATTER OF application number 2204547
in the name of Harmony Gold USA
to register a trade mark in Classes 16 and 25**

And

**In the matter of opposition thereto under number 50806
by Algotex**

Background

1. On 30 July 1999, Harmony Gold USA filed an application to register the trade mark MACROSS in classes 16 and 25 in respect of the following goods:

Class 16 Comic books, novellas and role-playing books; instruction sheets for the construction of toy action figures; newspapers, periodicals, magazines; manuals; revues; books; posters; agendas; albums; almanacs; announcement sheets; articles for binding; playing cards.

Class 25 Articles of clothing, footwear and headgear; socks, footwear, shirts, sweatshirts, pajamas, warm-up suits, coats, shorts, gym shorts, dresses, clothing belts, bandannas, sweaters, gloves, ear muffs, neckwear, skiwear, slacks, sun visors, suspenders, turtlenecks, vests, headwear, bathrobes, beachwear.

2. On 8 March 2000, Algotex filed notice of opposition against Class 25 of the application, and in which they say that they are the proprietors of an earlier trade mark, details of which can be found below. The ground of opposition is in summary:

Under Section 5(2)(b) because the mark applied for is similar to the opponent's earlier trade marks and is sought to be registered for goods identical or similar to those covered by this earlier trade mark, and as a result there exists a likelihood of confusion on the part of the public.

3. The earlier trade mark relied upon by the opponent is as follows:

Number	Mark	Class	Specification
1550749	ACROSS	25	Articles of clothing; jeans; coats; dresses; jackets; jerseys; jumpers; leggings; pants;

shirts; skirts; T-shirts; sweat shirts; trousers; waistcoats; all included in Class 25.

4. The applicant filed a counterstatement in which they deny the ground on which the opposition is based. Both sides requests that an award of costs be made in their favour.

5. Both sides filed evidence in these proceedings. The matter came to be heard on 23 July 2002, when the opponent was represented by Mr Keith Howick of Carpmaels & Ransford, their trade mark attorneys, the applicant by Mr Christopher Morcom of Her Majesty's Counsel, instructed by Venner & Shipley, their trade mark attorneys.

Opponent's evidence

6. This consists of a Statutory Declaration dated 22 February 2001, by Pierre Kuborn, General Manager of Algotex, a position he has held since at least 1985.

7. Mr Kuborn gives his views on the likely similarity in pronunciation of the words ACROSS and MACROSS and the reasons why he considers confusion to be likely; namely, that both marks are made-up words in relation to the goods for which they are used, the aural and visual similarity, and the tendency to drop the beginnings of words.

Applicant's evidence

8. This consists of a Statutory Declaration dated 1 October 2001 by Paul John Kelly, a trade mark attorney with Venner Shipley, the applicant's representatives in these proceedings.

9. Mr Kelly sets out the details of his client's trade mark application, and goes on to say why he considers Mr Kuborn's assessment to be incorrect, namely, that any similarity in pronunciation does not prove a likelihood of confusion, and that the assertion that people do not pay attention to the beginnings of marks is incorrect as the emphasis is always placed on the beginning, it being the end that tends to be slurred or lost in pronunciation. Mr Kelly does not deny that the goods covered by Class 25 of the application are identical or similar to those covered by the opponents' earlier mark.

Opponent's evidence in reply

10. This consists of a Witness Statement dated 2 April 2002 from Nicholas Keith Howick of Carpmaels & Ransford, the opponent's representatives in these proceedings.

11. Mr Howick gives some examples of circumstances that he says illustrate the phonetic similarity alleged by Mr Kuborn, and to say that he disagrees with Mr Kelly's assertion that the marks would be pronounced with the emphasis on AC or MAC.

That concludes my review of the evidence insofar as it is relevant to these proceedings.

Decision

12. The opposition is based on Section 5(2)(b) of the Act. That section reads as follows:

“5.-(2) A trade mark shall not be registered if because –

- (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.”

An earlier trade mark is defined in Section 6(1) of the Act as follows:

“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 my consideration of a likelihood of confusion or deception 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. 2, *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] 45 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; 15

(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 224;

(g) mere association, in the sense that the later mark brings the earlier mark to 3 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 opposition stands against Class 25 of the application only. The applicant concedes that the goods in that class of their application are either identical or similar to those covered by the opponent's earlier trade mark. As neither the opponent's nor the applicant's specifications are limited in any way, I must assume that they relate to the same market, from manufacture through distribution, to retail and the customer base.

15. The opponent relies on one earlier trade mark for the word ACROSS. This is an ordinary word, in common use in the English language, and I would say likely to be well known to those with a basic knowledge of English. That it is an existing word does not make it any less distinctive as a trade mark; it has no relevance for the goods in question. The opponent is silent on the use that they may have made and rights that they consider that they are entitled to claim in their mark. Consequently I am unable to say whether their earlier trade mark is any more distinctive by virtue of the use they may have made of it.

16. In any comparison it is inevitable that particular elements of a mark will be referred to, and should be if they are the distinctive and dominant components, I do not consider that there is such an element within either word. It is also clear from the above cases, that the average consumer normally perceives a mark as a whole, and that the visual, aural and

conceptual similarities of the marks must be assessed by reference to the overall impressions that they create. I am, however, mindful of the decision of Geoffrey Hobbs QC sitting as the Appointed Person in the *React* trade mark case [2000] RPC 285. In considering the question of the importance of the eye and the ear in the selection of clothing, Mr Hobbs went on to say:

“There is no evidence to support [Counsel’s] submissions that, in the absence of any particular reputation, consumers select clothes by the 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.”

17. The mark applied for consists of the word MACROSS. To those who care to look this can be seen to contain the word ACROSS and if only to this limited extent there is a degree of visual similarity. However, many words can be seen to contain or be broken up into shorter words but this is not something that I believe is habitually done other than by linguists, and as I have previously said, is not the approach to be adopted other than in determining whether any element predominates. In my view, that the applicant’s mark contains the word ACROSS will be hidden and unlikely to be seen on first impression. I have already mentioned that ACROSS is an ordinary and well-known word; MACROSS, as far as I am aware has no meaning. I do not, therefore, see that they have any conceptual similarity.

18. Not surprisingly, the opponent and the applicant differ as to the importance of the letter M, and first syllable at the beginning of the mark. The opponent contends that consumers pay less regard to the beginnings of marks, arguing that the letter M in MACROSS would be all but silent or lost in pronunciation, and the syllable MA would be no different in sound to the A at the beginning of ACROSS. The applicant says that this is wrong, that it is the endings of marks that tend to be slurred or lost, and consequently, seen as being of lesser importance. They argue that the M has a significant impact on the pronunciation, and that the first syllable will sound like MAH. It has long been the case that the endings of words have been considered to be of less significance when considering aural similarity, but this is not a hard and fast rule and can be affected by factors such as the strength of the beginning, the length of the word, the familiarity of the public with the word, etc. It is possible that to some the initial letter M will have a soft sound, but this is likely to affect the first syllable as a whole, to something akin to Muh-Cross. But just as likely the word will be pronounced with a strong emphasis on the first syllable, as in Mack-ross. Either way the sound will be some distance away from ACROSS.

19. Taking all of the above factors into account and applying the guidance of the cases referred to, I come to the view that even allowing for the possibility of imperfect recollection, that should the applicant uses the mark applied for, the public will not be led to believe that the respective goods come from the same or economically linked undertakings, and that there is no real likelihood of confusion. The objection under Section 5(2)(b) fails accordingly.

20. The opposition having failed on all grounds the applicant is entitled to a contribution towards their costs. I order that the opponent should pay the applicant the sum of £450 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 12th Day of December 2002

Mike Foley
For the registrar
The Comptroller-General