

O-406-03

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2288986B
BY START-RITE SHOES LIMITED TO REGISTER A SERIES OF
TRADE MARKS IN CLASSES 18 AND 25**

AND

**IN THE MATTER OF OPPOSITION No. 91222
BY NEW YORKER S.H.K. JEANS GMBH**

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**IN THE MATTER OF Application No. 2288986B
by Start-Rite Shoes Limited
to register a series of Trade Marks in Classes 18 and 25**

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**IN THE MATTER OF Opposition No. 91222
by New Yorker S.H.K. Jeans GmbH**

Background

1. On 24 December 2001 Start-Rite Shoes Limited applied to register the following series of two trade marks:

**M.O.G.
MOG**

in relation to the following specification of goods:

“Leather and imitations of leather and goods made of these materials and not included in other classes; skins and hides; luggage, cases, trunks, travelling bags, carry-on luggage, overnight luggage, bags for travel accessories, shoe bags for travel and garment bags; bags, holdalls, rucksacks, handbags, shoulder bags, clutch bags, tote bags, athletic bags, beach bags; hip pouches; belts; wallets, purses and key cases; keyrings; umbrellas, parasols, canes and walking sticks; whips, harnesses and saddlery; card cases; parts and fittings for the aforesaid goods.” (Class 18)

“Articles of clothing, footwear and headgear.” (Class 25)

The application is numbered 2288986B. The suffix reflects the fact that the application has been divided. Nothing now turns on this point.

2. On 7 November 2002 New Yorker S.H.K. Jeans GmbH filed notice of opposition to this application. They are the proprietors of protected international registration No. 722799 for the following mark:

SMOG

registered in various Classes but in particular for the following goods:

“Leather and imitations of leather, and goods made of these materials (included in this class); animal skins and hides; trunks, briefcases and small suitcases; bags, sports bags, handbags, school bags, backpacks; travelling sets (leatherware); small articles of leatherware; small articles of leather; purses, pocket wallets, key cases; hip bags and belt bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.”

“Clothing, footwear, headgear.”

3. The opponents say that their earlier trade mark covers identical and/or similar goods and that the marks are similar such that there is a likelihood of confusion within the meaning of Section 5(2)(b) of the Act. They ask for refusal of the application.

4. The applicants filed a counterstatement denying the above ground of opposition.

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

6. The only evidence filed in this case is a witness statement from Brian Herbert March of Wildbore and Gibbons, the opponents’ professional representative, supplying details of the protected international registration relied on.

7. The papers were reviewed by a Hearing Officer who expressed the view that the matter could be decided without the need for a hearing. The parties were nevertheless reminded of their right to be heard or to offer written submissions. In the event neither side has asked to be heard but written submissions have been received from the applicants under cover of a letter dated 11 November 2003 from Barlin Associates, their professional representatives. Acting on behalf of the Registrar and with this material in mind I give this decision.

Decision

8. Section 5(2) reads as follows:

“(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.”

Sub-paragraph (b) applies here. The opponents' mark is an earlier trade mark within the meaning of Section 6(1)(a) of the Act.

9. I take into account the guidance provided by the European Court of Justice in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, and *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77.

10. No issue arises so far as the goods are concerned. The respective specifications cover goods which are in large measure identical in the terminology they use or if not would be subsumed within the broad terms used.

11. The matter therefore turns critically on my views on the marks themselves. The distinctive character of the respective marks is a factor that must be taken into account (*Sabel v Puma*, paragraph 23). So far as I am aware neither mark has any meaning in relation to the goods concerned. Both SMOG and MOG are dictionary words – the first meaning a mixture of smoke, fog etc the second being a slang term for a cat. The second mark in the applicants' series, M.O.G. is, in my view, more likely to be articulated as a combination of letters rather than a word. I note that the written submissions suggest that it is derived from the applicants' other trade mark (MISERABLE OLD GIT) but that is unlikely to be generally known (and the application contemplates or allows for use independently of any other mark). Again the letters have no meaning in relation to the goods. I conclude that the marks enjoy at least an average degree of distinctive character but absent use (and none has been claimed by either party) are not possessed of the qualities that are traditionally associated with invented words or more complex graphical marks.

12. The applicants' written submissions can be summarised as being that:

- the marks are conceptually different according to their dictionary meanings;

- the words are made up of different numbers of letters with the initial letter S of SMUG making a material difference as does the use of fullstops in the first mark of the applied for series;

- the consonant blend SM gives a different sound at the start of the opponents' mark.

I have also been referred to another mark that the opponents have registered in Germany and which is said to demonstrate that their mark is intended to evoke a foggy atmosphere. I do not derive any assistance from this reference.

13. It is well established that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components (*Sabel v Puma*, paragraph 23). The matter is to be judged through the eyes of the average consumer for the goods in question. In the case of the goods at issue here I take the average consumer to be the public at large. Sequential rather than simply concurrent or side by side acquaintance with the marks must also be allowed for.

14. Although the applied for marks are nominally a series they seem to me to give rise to somewhat different considerations. Taking the mark M.O.G. first it is, of course, possible that consumers would treat it as an acronym in which case it would be indistinguishable from MOG. But it is equally possible that the letters would be pronounced individually rather than as a word. That would point to significant visual, aural and conceptual dissimilarities to SMOG. Even if it was treated as an acronym the fullstops create a strong visual cue and in my view puts considerable distance between the opposed marks.

15. The opponents' stronger case must, therefore, be in relation to a comparison of SMOG and MOG. They are both short words and share three letters in common. Nevertheless the initial S in the opponents' mark makes for a material and noticeable visual difference between them. Given that the average consumer is deemed to be reasonably observant etc (*Lloyd Schuhfabrik v Klijsen*, paragraph 27) and that these are familiar words, the marks appear to me to be readily distinguishable. I believe the same is true from the phonetic standpoint. It is of assistance from both a visual and aural point of view that the difference is at the start of the marks.

16. Conceptually, consumers will more readily be able to differentiate between marks where they are familiar words of the English language. The applicants' written submissions draw an analogy with MUG and SMUG. There is some force to that argument but it is not a complete answer. Use of the words as trade marks means that they will not have the benefit of supporting sentences or phrases to give them context. Nevertheless, I can see no basis for finding any conceptual similarity between the marks.

17. The likelihood of confusion is a matter of global appreciation taking account of all relevant factors (*Sabel v Puma*, paragraph 22). According to *Canon* there is interdependency between the elements of the test. Thus a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods and vice versa (*Canon v MGM*, paragraph 17). I have concluded here that there is identity between the goods and a low degree of similarity between the marks. The net effect of consideration of the similarities and differences in this case points towards a finding in favour of the applicants. In short, I can see no reason to assume that there will be a likelihood of confusion. Imperfect recollection can sometimes influence the outcome but it does not in my view swing the balance of the argument back in favour of the opponents particularly bearing in mind that these are short and familiar dictionary words. The opposition fails accordingly.

18. The applicants are entitled to a contribution to their costs. I order the opponents to pay them the sum of £700. 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 29th day of December 2003

**M REYNOLDS
For the Registrar
the Comptroller-General**