

O-353-04

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 81578
BY BUFFALO BOOTS GMBH
FOR A DECLARATION OF INVALIDITY

IN RESPECT OF TRADE MARK No 2339714
STANDING IN THE NAME OF
TERENCE BALL

BACKGROUND

1) The trade mark BUFFALO CREEK is registered as UK trade mark No 2339714 for the following goods:




In Class 18: “Bags, travel bags, holdalls”

In Class 25: “Footwear, clothing and headgear”

2) The mark was placed on the Register on 2 January 2004, in the name of Terence Ball with an effective date of 2 August 2003 (the application date).

3) By an application received on 12 January 2004 Buffalo Boots GmbH applied for a Declaration of Invalidity under the provisions of Section 47(2)(a) of the Act. The grounds are:

- i) The applicant is the proprietor of the following trade marks, the specifications of which have been restricted to those goods which the applicant has identified in its statement of grounds:

Mark	Number	Effective date	Class	Specification
	UK 1570363	31.10.94	25	Footwear, boots, shoes, slippers and sandals; all included in Class 25.
Buffalo	MADRID 669747	07.12.96	25	Shoes.
	CTM 1495753	07.02.00	25	Clothing, footwear, headgear.
	CTM 2183614	17.04.01	18	Leather and imitations of leather, and goods made of these materials and included in class 18; trunks and travelling bags, briefcases, beach bags, sacks (bags) of leather for packaging, handbags of leather, trimmings of leather for furniture, pocket wallets, camping bags, blankets, coverings of skins, attaché cases, boxes of leather or leather board, boxes and cases of vulcanised fibres, string bags for shopping, shopping bags; key cases and manicure cases (leatherwear); gaiters of leather, umbrella covers, purses, belts of leather, game bags, card cases (notecases), cases of leather or leather board, garment bags for travel, vanity cases, umbrellas, travelling bags, rucksacks, boxes of leather or leather board, school satchels, school bags, parasols, sticks (walking sticks), bags with wheels, haversacks, tool bags of leather.

ii) The applicant contends that the marks of the two parties are similar as are the respective goods and so a likelihood of confusion exists. The mark in suit therefore offends against Section 5(2)(b) of the Trade Marks Act 1994.

4) The registered proprietor filed a counterstatement denying all the grounds of opposition. The registered proprietor also questioned whether the applicant was the proprietor of trade mark numbers 1570363, 1495753 and 2183614 as claimed as the address shown for these marks was different to that shown for the applicant. In addition the registered proprietor claimed that trade mark number 669747 was refused protection in the UK. The registered proprietor admitted that the following goods are identical:

Applicant's Marks and specifications	Registered Proprietor's specification
1570363 Footwear, boots, shoes, slippers and sandals; all included in Class 25.	"Footwear" in Class 25.
1495753 Class 25.	Class 25.
2183614 Class 18.	Class 18.
669747 Class 25.	"Footwear" in Class 25.

5) Both sides ask for an award of costs. Only the applicant filed evidence in these proceedings. The matter came to be heard on 16 November 2004 when the applicant was represented by Mr Hodgkinson of Messrs Marks & Clerk, and the opponent by Mrs Arnott of Messrs Mathys & Squire.

APPLICANT'S EVIDENCE

6) The applicant provided two witness statements. The first, dated 22 March 2004, by Herr Nothen an employee of the applicant with responsibility for trade mark issues. Herr Nothen is a German citizen who states that he is familiar with the English language. He states that there is only one Buffalo Boots GmbH registered under German law and that the addresses shown on the Trade Mark Register all belong to the same company. The applicant is therefore the proprietor of the four trade marks as claimed in the statement of grounds.

7) The second witness statement, dated 5 May 2004, is by Keith Leonard Hodgkinson, the applicant's Trade Mark Attorney. In his exhibits B,C,D and E he provides certified copies which show that all four of the trade marks set out in the statement of grounds are effective in the UK.

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

DECISION

9) The request for the declaration of invalidity is made under the provisions of Section 47(2) by reference to Section 5(2)(b) of the Trade Marks Act 1994. The relevant provisions read as follows:

“47. (2) The registration of a trade mark may be declared invalid on the ground -

- (a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or
- (b)

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.”

And:

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

- (a)
- (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.”

10) 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,”

11) The applicant is relying on four trade marks (detailed at paragraph 3 above) all of which are registered with effect prior to 2 August 2003, the effective date of the registered proprietor’s trade mark. The applicant’s trade marks are, therefore, plainly “earlier trade marks”.

12) The sole ground of invalidity is under Section 5(2)(b). In determining the question under this section, I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel Bv v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer 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:

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel Bv v Puma AG*;

(b) the matter must be judged through the eyes of the average consumer, of the goods / services in question; *Sabel Bv v Puma AG*, 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.*;

(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*;

(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*;

(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-Meyer Inc.*;

(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*;

(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*;

(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*;

(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-Meyer Inc.*.

13) 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 registered and the applicant's registrations on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods covered within the respective specifications.

14) The registered proprietor accepts that there is overlap in the two parties specifications. These were outlined at paragraph four above. At the hearing the applicant identified its mark 669747 BUFFALO registered for "Shoes" as providing

its strongest case. As indicated the registered proprietor accepts that the applicant's specification under this mark is identical to its mark in respect of "footwear", although they contend that the other items in its specification are different.

15) The marks of the two parties being compared are "BUFFALO CREEK" and "BUFFALO".

16) At the hearing it was agreed that the relevant consumer for the goods in Class 25 of both parties would be the general public.

17) The applicant's mark is in a plain script and is a well known word. Visually the respective marks share the same first word, "BUFFALO" although the registered proprietor's mark has a second word "CREEK".

18) Aurally the marks share the first component "BUFFALO" whilst the registered proprietor's mark has the additional word "CREEK". The second word of the registered proprietor's mark has a "hard" sound and is unlikely to be lost if the mark is pronounced.

19) Conceptually the registered proprietor's mark suggests a geographical location, a stream or river which Buffalo frequent. The applicant contended that the registered proprietor's mark is also the name of a place in the USA. The applicant's mark brings to mind either the image of a large herbivore, or the geographical location in the USA. There are therefore potential similarities and differences dependent on how the mark strikes the average consumer.

20) I must also consider whether the applicant's mark is inherently distinctive. The product in its specification, shoes, can be made of buffalo hide. The word also can be said to allude to strength which is a desirable characteristic in shoes. To my mind the mark has a degree of inherent distinctiveness although not in the Kodak class.

21) The applicant has not provided any instances of use of its mark and so I must consider the matter on the basis of notional and fair use. The applicant has not provided any evidence of reputation in the market and so cannot benefit from an enhanced level of protection.

22) The registered proprietor sought to rely upon other marks on the register. In considering this state of the register evidence I am guided by the following comments of Mr Justice Jacob in *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281 where he said:

"Both sides invite me to have regard to the state of the register. Some traders have registered marks consisting of or incorporating the word "Treat". I do not think this assists the factual inquiry one way or the other, save perhaps to confirm that this is the sort of word in which traders would like a monopoly. In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the Registrar to put the marks concerned on the register. It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for

registration, see eg *MADAM Trade Mark* and the same must be true under the 1994 Act. I disregard the state of the register evidence.”


23) Items of clothing and footwear are not, I would suggest, chosen without some consideration. The average consumer of such products would, in my opinion, exercise some care in the selection. In *REACT* [1999] 15 RPC 529 the Hearing Officer held the following:

“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.”

24) Whilst there are differences between the marks there are also similarities. It was contended by the registered proprietor that the conceptual difference would provide such a different message that the concept of imperfect recollection could be ruled out. I accept that conceptual differences can and do permeate into visual and aural comparisons. However, in the instant case there are conceptual similarities as well as potential dissimilarities. Overall, to my mind there are similarities in the marks which outweigh the differences added to which the goods are identical.

25) Considering the matter globally and weighing all the factors outlined at paragraph 12 above I come to the conclusion that there is a likelihood that the relevant consumer will believe that the “footwear” of the registered proprietor would originate from the applicant or from an economically linked undertaking. Therefore, the application for invalidity under Section 5(2)(b) is successful in relation to footwear.

26) I now turn to consider the applicant’s CTM marks 1495753 and 2183614 which are both registered for the same mark. For ease of reference the marks of both parties are reproduced below:

Registered Proprietor’s mark	Applicant’s mark
BUFFALO CREEK	

27) At the hearing it was agreed that the relevant consumer for the goods in Classes 18 and 25 of both parties would be the general public.

28) The applicant’s mark is in a stylised script but is clearly recognisable as the word “Buffalo”. My comments at paragraphs 17-24 apply equally to these marks and the respective specifications.

29) Considering the matter globally and weighing all the factors outlined at paragraph 12 above I come to the conclusion that there is a likelihood that the relevant consumer will believe that the goods in Classes 18 & 25 of the registered proprietor originate from the applicant or from an economically linked undertaking. Therefore, the application for invalidity under Section 5(2)(b) is successful in relation to the whole of the registered proprietor’s specification.

30) The application for invalidity having succeeded the applicant is entitled to a contribution towards costs. I therefore order the registered proprietor to pay the applicant the sum of £2000. 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 1st day of December 2004

George W Salthouse
For the Registrar
The Comptroller-General