

O-071-05

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2307145
BY DURHAM FOOTWEAR DISTRIBUTORS LIMITED
TO REGISTER A TRADE MARK IN CLASS 25**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No. 92050
BY AMBERES S.A.**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No. 2307145
by Durham Footwear Distributors Limited
to register a trade mark in Class 25**

and

**IN THE MATTER OF Opposition thereto under No. 92050
by Amberes S.A.**

BACKGROUND

1. On 3 August 2002 Durham Footwear Distributors Limited applied to register the following trade mark in Class 25 for a specification of; “Sweaters, jackets, shirts, t-shirts, jeans, trousers, footwear; but not including socks or hosiery”:



2. The application was subsequently published in the Trade Marks Journal and on 13 October 2003 Amberes S.A. filed Notice of Opposition on grounds under Section 5(2)(b) of the Act because the mark applied for is similar to the following earlier trade mark registrations owned by the opponent, both of which are registered in respect of clothing in Class 25, therefore covering identical and similar goods to the application, and there exists a likelihood of confusion on the part of the public –

Registration No.	Mark	Effective Date	Specification of goods
Community Trade Mark No. 778217	ESCORPION	16 April 1998	<p>Class 22: Nets and netting.</p> <p>Class:24: Bed covers, bed sets, table linen, white and coloured linen (household linen), bath sheets, towels, knitwear items, mesh (fabric).</p> <p>Class 25: Coats, dressing gowns, housecoats, smoking jackets, smocks, trousers, collar protectors, underpants, shirting, undershirts, nightdresses, layettes (outfits), windcheaters, slips, bodices, shawls, head scarves, jackets, scarves, petticoats, girdles, skirts, gabardines, waterproof clothing, jerseys, kimonos, bed jackets, head and neck scarves of wool, pelisses, pyjamas, ready-made clothing, brassieres, swimsuits, ready-made clothing for women, men and children, lingerie, corsetry, dresses, hats, collars and wristbands (for clothing); stockings and socks; ready-made hosiery, made-up netting.</p> <p>Class 26: Hair nets.</p>
Community Trade Mark Registration No. 746347	<p style="text-align: center;">ES DE ESCORPION</p>	16 March 1998	<p>Class 22: Nets and netting.</p> <p>Class 24: Bed covers, bed sets, table linen, white and coloured linen (household linen), bath sheets, towels, knitwear items, mesh (fabric).</p> <p>Class 25: Coats, dressing gowns, housecoats, smoking jackets, smocks, trousers, collar protectors, underpants,</p>

		shirting, undershirts, nightdresses, layettes (outfits), windcheaters, slips, bodices, shawls, scarves, jackets, wraps, petticoats, girdles, skirts, gabardines, waterproof clothing, jerseys, kimonos, bed jackets, head and neck scarves of wool, pelisses, pyjamas, ready-made clothing, brassieres, swimsuits, ready-made clothing for women, men and children, lingerie, corsetry, dresses, hats, collars and wristbands (for clothing); stockings and socks; ready-made hosiery, made-up netting. Class 26: Hair nets.
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3. The applicant filed a Counterstatement denying the grounds of opposition.
4. Both sides filed evidence and ask for an award of costs in their favour. The parties are content for a decision to be taken without recourse to a hearing and have forwarded written submissions for the hearing officer's consideration.

OPPONENT'S EVIDENCE

5. The opponent's evidence consists of a witness statement by Bernat Biosca dated 7 April 2004. Mr Biosca is sole Director of Amberes S.A. (the opponent).
6. Mr Biosca explains that ESCORPION is the Spanish word for "scorpion". He states that his company sells a variety of women's fashions under the ESCORPION trade mark and he refers to Exhibit BB2 to his statement, which comprises copies of catalogues, to show use of the mark. The catalogues refer to a handful of retail outlets in the UK.
7. Mr Biosca goes on to provide at Exhibit BB3 to his statement, sales figures in the United Kingdom for the years 2000-2002 inclusive. A copy is attached as Annex One to this decision.
8. Next, Mr Biosca provides, at Exhibit BB4 to his statement, advertising figures for the period 2001-2003 (a copy is attached at Annex 2 to this decision), with sample invoices relating to advertisements placed. Mr Biosca also draws attention to two exhibitions (held in 2002 and 2003) at which his company's products were promoted.
9. Mr Biosca points out that his company has made sales throughout the United Kingdom and at Exhibit BB6 to his statement is a list of customers' addresses.

APPLICANT'S EVIDENCE

10. The applicant's evidence comprises a witness statement, dated 29 July 2004, by Bill Tennant. Mr Tennant is a trade mark agent with Jordans Limited, the applicant's professional advisors in these proceedings.

11. Mr Tennant states that the mark applied for is in use and that the applicant has used the mark SCORPIO solo, for in excess of twenty years. He refers to Exhibit BT1 to his statement which contains copies of extracts from magazines etc. showing use of the mark SCORPIO solus in relation to shoes.

12. Mr Tennant goes on to make a number of submissions on the issue of similarity of marks. He does not believe that the British public will, in general, interpret the word ESCORPION as Spanish for "Scorpion" and, in any event, the word SCORPIO would connote the astrological star sign.

13. Mr Tennant states that the first SCORPIO shop of the applicant opened in the 1970s and he refers to Exhibit BT3 to his statement, an extract from a "local" newspaper, in support. This appears to relate to the sale of DR MARTENS products from the shop.

14. Mr Tennant submits that the opponent has made very little use of its mark in the UK.

OPPONENT'S EVIDENCE IN REPLY

15. This consists of a witness statement by Sara Jane Leno dated 1 November 2004. Ms Leno is a partner in Forrester Ketley & Co, the opponent's professional representatives in these proceedings.

16. Ms Leno points out that while the applicant has claimed a considerable period of use in relation to the mark SCORPIO, solo, no turnover figures have been provided. She submits that the applicant primarily conducts business through a shop in Dr Martens footwear.

17. Turning to a comparison of the marks, Ms Leno submits that the scorpion device used in the applicant's mark does not approximate to that used in horoscopes and that this mitigates against the public perceiving the word SCORPIO as an astrological star sign.

OPPONENT'S WRITTEN SUBMISSIONS

18. The opponent's written submissions are attached to a letter of 30 December 2004 from Forrester Ketley & Co.

19. The opponent submits that the respective marks share the same essential particulars, as goods ordered under the applicant's mark are likely to be referred to by the word SCORPIO. Furthermore, it contends that the public will appreciate that the dominant word SCORPIO is based on the "scorpion". The opponent also points out that the evidence shows that the articles sold by the applicant are footwear.

APPLICANT'S WRITTEN SUBMISSIONS

20. The applicant's written submissions are attached to a letter from Jordans, dated 30 December 2004.

21. The applicant draws my attention to "standard" authorities in relation to Section 5(2)(b) of the Act.

22. This completes my summary of the evidence and submissions filed in these proceedings. I now turn to the decision.

DECISION

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

"5.-(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."

24. 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,"

25. I take into account the well established 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, and *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.

26. 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-Mayer 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) account should be taken on the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it was registered; *Lloyd*;
- (h) 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*;
- (i) 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*;
- (j) 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.*

27. The reputation of a trade mark is an element to which importance may be attached in Section 5(2) considerations in that it may enhance the distinctive character of the mark at issue and widen the penumbra of protection for such a mark. The opponent has filed evidence relating to the use of its ESCORPION trade mark. While the evidence confirms use of the mark and provides information on the turnover of goods sold under the mark, it provides no evidence of its extent of market share or the extent of its reputation. Given the very large market for the goods in question – clothing, it seems to me that the turnover details provided do not indicate a high market share and do not enable me to infer that the opponent has any great reputation under the mark. Furthermore, expenditure on the marketing and promotion of the mark is relatively light and there are no details as to the extent of the

circulation of the catalogues referred to in the evidence. I would add that no supporting evidence from third parties or the trade has been filed.

28. While the opponent had a presence in the UK market place prior to the relevant date for these proceedings, the evidence does not demonstrate a significant reputation among the relevant public in its earlier cited marks. The onus is upon the opponent to show that its marks enjoy a significant reputation and on the basis of the evidence filed in this case I do not believe the opponent has discharged this onus.

29. The effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act was recently considered by David Kitchen QC sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchen concluded at paragraph 17 of his decision:

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe that the observations of Mr Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion.”

30. While I have found in the present case that the opponent’s earlier marks do not have a significant reputation in the UK, it seems to me that the opponent’s marks are, in any event, inherently highly distinctive in relation to the goods at issue and are deserving of a wide penumbra of protection.

31. In essence the test under Section 5(2) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. 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 differing elements, taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed. Furthermore, in addition to making comparisons which take into account the actual use of the respective marks, I must compare the mark applied for and the opponent’s registrations on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods within the respective specifications.

32. The applicant points out that the mark SCORPIO, solus, has been in use some twenty years. However, from the evidence it would appear that the applicant’s mark has been used in relation to shoes, whereas the opponents ESCORPION mark has been used on women’s fashion clothing. In any event, the fact that no actual instances of confusion are demonstrated is not necessarily telling in relation to relative grounds – see *Compass Publishing BV v Compass Logistic Ltd* [2004] EWCA (Ch). As stated earlier, the comparisons must take into account notional, fair use across the width of the relative specifications. Furthermore, my comparisons should relate to the mark, as applied for, and the opponent’s earlier registrations.

33. I turn to a consideration of the respective goods covered by the application in suit and the opponent's earlier registration. The applicant's specification is for a range of clothing in Class 25 and it is obvious that it includes identical and closely similar goods to those encompassed in the opponent's earlier registrations.

34. I now go on to compare the mark in suit with the opponent's earlier registrations. The mark applied for comprises the obvious dictionary word SCORPIO, the device of a "cartoon like" scorpion and the strapline "NO SH!T JUST SHOES". The opponent's earlier registrations are for the word ESCORPION and also the words ES DE ESCORPION. While the opponent states that the word ESCORPION is the Spanish word for "scorpion", I doubt that the average customer for the goods would have sufficient detailed knowledge of the Spanish language to be aware of the word's meaning. It seems to me that the average customer for the goods in the UK is likely to perceive the word ESCORPION as an invented word, probably alluding to a scorpion. As mentioned earlier in the decision, the opponent's marks are highly distinctive in relation to the relevant goods. I would add that the mark applied for is also highly distinctive in its totality.

35. The guiding authorities make it clear that I must compare the marks as a whole and by reference to overall impression. However, as recognised in *Sabel BV v Puma AG* (mentioned earlier in this decision) in such comparisons reference will inevitably be made to the distinctiveness and dominance of individual elements. It is, of course, possible to over analyse marks and in doing so shift away from the real test which is how marks would be perceived in the normal course and circumstances of trade.

36. I turn to a visual comparison of the marks. In my view the word SCORPIO and the 'cartoon like' scorpion device are both distinctive, dominant components within the applicant's mark. The words "NO SH!T JUST SHOES" would in my view be seen as a strapline, notwithstanding the replacement of the letter I by an exclamation mark in the second word, to reduce/disguise the impact of its vulgarity.

37. The word SCORPIO is subsumed within the opponent's ESCORPION mark. However, the words differ in length, the mark applied for consisting of seven letters and the word ESCORPION nine letters. Significantly the first letter of the words and the terminating letters differ. Furthermore, it seems to me also relevant that the applicant's mark consists of an obvious dictionary word known to the public, whereas the word ESCORPION will be seen as an invented word. In this context I believe the meaning and look of a word will be closely associated by the public. While the word ESCORPION could allude to the scorpion insect it would not, in my view, be perceived by the public as an allusion to the astrological star sign SCORPIO. This will have an impact on the customer, as visual interpretation will be affected by identification of words.

38. The opponent's earlier registration No. 746347 contains the additional words ES DE. However, it seems to me that the addition of these words to the word ESCORPION, only go to further distance the mark from that of the applicant.

39. As mentioned earlier, my decision on similarity must be based on overall impression and notwithstanding that the words ESCORPION and SCORPIO share a high proportion of letters, that the word SCORPIO is subsumed within the word ESCORPION the beginnings, terminations and perception of the words are sufficiently different, for me to conclude that, in

totality, the marks look different overall and would be distinguished in visual use, particularly when the applicant's striking and unusual device is added into the comparison.

40. In relation to the aural comparison of trade marks used in respect of articles of clothing, I agree with the view expressed by the Registrar's Hearing Officer in the matter of application No. 2001040 by React Music Limited to register a trade mark in Class 25 and in the matter of Opposition thereto by Update Clothing Limited under No. 45787 (BL O/258/98) when he said:

“There is no evidence to support Ms Clarke's submission that, in the absence of any particular reputation, consumers select clothes by 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 this 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”.

41. This view was supported on appeal to the Appointed Person (*REACT Trade Mark* [2000] 8 RPC 285 lines 22 to 26) and I believe it appropriate to the present case.

42. The word SCORPIO is a three syllable word whereas ESCORPION is four syllables. Furthermore, the beginnings and endings of the respective words would sound obviously different. I also need to take into account that SCORPIO is an obvious dictionary word and ESCORPION is likely to be perceived as an invented word in aural considerations. While I do not overlook the fact that the applicant's mark contains a scorpion device, in oral considerations it has long been held that “words speak louder than devices”. I conclude that the marks would be distinguished in aural use.

43. I now go to a conceptual comparison of the marks. While the opponent's earlier marks may well denote a scorpion insect, it seems to me that the applicant's mark will primarily denote the astrological star sign. However, the star sign scorpio is associated with the scorpion insect and the device contained within the applicant's mark is of a scorpion, albeit highly fanciful and “cartoon like” in appearance. On this basis there may well be some conceptual association between the marks, although somewhat indirect.

44. In my considerations I must also consider the relevant public for the goods. Customers for clothing and footwear are the public in general. Such goods are often necessities as well as being fashion items and are sold through a wide variety of outlets and at a wide range of prices. The goods are not necessarily expensive nor sophisticated purchases but it seems to me that clothing, is usually bought with a reasonable degree of care e.g. as to size, colour, appearance, and after a visual reference.

45. On a global appreciation, taking into account all the relevant factors, I have reached the conclusion that while the respective specifications include goods which are identical or closely similar, the differences in the respective trade marks are such that there is no likelihood of confusion to the average customer for the goods. In reaching this conclusion I have borne in mind that the average customer for the goods is deemed to be reasonably circumspect and observant and that he/she normally perceives a mark as a whole.

46. The opposition fails.

COSTS

47. The applicant is entitled to a contribution towards costs and I order the opponent to pay the applicant the sum of £1,100 which takes account of the fact that no hearing was held in these proceedings. The 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 17th day of March 2005

**JOHN MacGILLIVRAY
For the Registrar
the Comptroller-General**