

O-221-07

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION
NO. 2375668 IN THE NAME OF ROAD CLOTHING LIMITED
TO REGISTER A TRADE MARK IN CLASS 25**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 93622 IN THE NAME OF
GROTTO S.P.A**

Trade Marks Act 1994

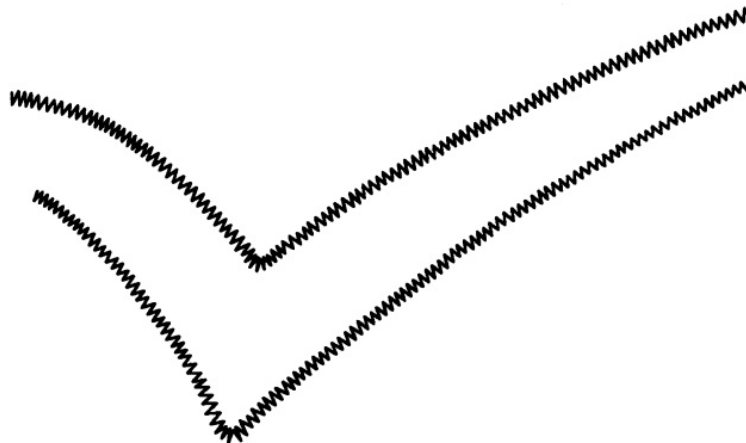
**IN THE MATTER OF trade mark application
No. 2375668 in the name of Road Clothing Limited
to register a trade mark in Class 25**

And

**IN THE MATTER OF opposition thereto
under no. 93622 in the name of Grotto S.p.A**

BACKGROUND

1. On 13 October 2004, Road Clothing Limited made an application to register a trade mark in Class 25 in relation to “Articles of clothing. The mark applied for is as follows:



2. On 26 July 2005, Grotto S.p.A filed notice of opposition to the application, the ground of opposition being as follows:

Under Section 5(2)(b) because the mark applied for is similar to the opponents' earlier trade marks, and is sought to be registered in respect of goods that are identical and/or similar to the goods covered by these earlier marks such that there exists a likelihood of confusion on the part of the public.

3. The opponents rely on three earlier marks, details of which are shown as an annex to this decision.

4. The applicants filed a counterstatement in which they deny the ground on which the opposition is based.

5. Both sides ask that an award of costs be made in their favour.

6. Both sides filed evidence in these proceedings, which, insofar as it may be relevant I have summarised below. The matter came to be heard on 13 February 2007, when the Opponents were represented by Ms Gill Smaggasgale of W P Thompson, their trade mark attorneys. The applicants were not represented.

Opponents' evidence

7. This consists of a Witness Statement dated 16 March 2006, from Gillian Helen Smaggasgale, a trade mark attorney with W P Thompson, the opponents' representatives in these proceedings. Ms Smaggasgale's Statement consists of submissions on the relative merits of these proceedings. Being submissions rather than evidence of fact I do not consider it to be necessary or appropriate that I should summarise them here. I will, of course, take them fully into account in my determination of this case.

Applicants' evidence

8. This consists of a Witness Statement dated 13 July 2006, from Brian Herbert March, a trade mark attorney with Wildbore and Gibbons, the applicants' representatives in these proceedings. Mr March's Statement also consists of submissions on the substance of the proceedings, and I do not consider it to be necessary or appropriate that I should summarise these as evidence. I will, of course, take them fully into account in my determination of this case. Mr March provides one exhibit under reference Annex 1, which consists of two sheets containing close-up photographs showing the stitching on the pockets of men's and women's jeans that he says were obtained some 18 months previously.

Opponents' evidence in reply

9. This consists of a Witness Statement dated 11 October 2006, from Gillian Helen Smaggasgale. Ms Smaggasgale's Statement consists of submissions on the Witness Statement provided by Brian March on behalf of the applicants. This is not evidence of fact and that being the case, it is not appropriate that I should summarise it here. I will, of course, take the submissions fully into account in my determination of this case.

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

DECISION

11. The opposition is founded on Section 5(2)(b), which 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.”

12. An earlier trade mark is defined in Section 6 of the Act as follows:

“6.- (1) In this Act an “earlier trade mark” means–

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) 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. 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, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG & Adidas Benelux BV* [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;

(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 24;

(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*, 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 & Adidas Benelux BV*, 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 opponents rely on three earlier marks. One is for what I shall describe as a solid black “tick”, the remaining two being the same “tick” with the words “GAS” and “BLUE JEANS – GAS” contained within. The applicants’ mark also consists of a “tick”, but in this case represented by two irregular lines in the style of stitching, the ends being open. In any analysis of the similarity of trade marks it is inevitable that in any comparison for the purposes of establishing similarity, reference will be made to the construction of the respective marks, and rightly so, for the case law requires consideration to be given to the distinctiveness and dominance of any discernible component parts. However, it must be remembered that it is the marks as a whole that are to be compared.

15. The goods at issue here are articles of clothing. In his decision sitting as the Appointed Person in the *React* trade mark case [2000] R.P.C. 285, Mr Thorley stated:

“There is no evidence to support Ms Clark’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.”

16. The decisions in *Claudia Oberhauser v OHIM (Fifties)* [2003] E.T.M.R. 58, and *Criminal Clothing Ltd v Aytan’s Manufacturing (UK) Ltd*, [2005] EWHC 1303 indicate that the circumstances in which the relevant goods and trade marks are encountered by the consumer,

particularly at the point at which the purchase is made is an important consideration, but the matter must be assessed by applying an assessment of all relevant factors. So although the selection of clothes is a visual act that places most importance on the appearance of marks, this does not negate the need also to consider and balance the aural and conceptual similarities.

17. In a visual comparison it is self-evident that these marks are not identical, but what is just as plain to see is that the image of a “tick” is in common, so if only to that limited extent there will be a degree of similarity in appearance. The words contained within two of the opponents’ marks provide the main focal point and move the emphasis away from the tick which is all but relegated to the position of a background. The question really hinges around the similarity of the mark applied for as compared to the opponents mark consisting of the “tick” without any added matter. In relation to the question of visual similarity, Geoffrey Hobbs QC sitting as the appointed person in *Xarocid* Trade Mark BL 0-140-03 (unreported) had the following to say:

“Marks which converge upon a particular mode or element of expression may or may not be found upon due consideration to be distinctively similar. The position varies according to the propensity of the particular mode or element of expression to be perceived in the context of the marks as a whole as origin specific or origin neutral.”

18. There is no doubt that the respective marks are “tick” shaped. The applicant’s “tick” is represented by two irregular lines in the style of stitching, the ends being open, the shape being a sharper, more pronounced “V”. Mr March provided evidence that showed how the applicants’ mark looks in use, and it does look somewhat different, but the mark that I have to consider is the one in the application. The opponents’ “tick” is solid, black and flatter in shape and with a much shorter leg on the left side. Because consumers will regard a mark as a whole and will not dismantle it into its component parts, this sort of analysis will usually be of limited value. However, these are very simple marks, and I find that the overall visual appearance of the respective marks is similar insofar as they both are “ticks” but the differences that are apparent at first impression contribute to make them visually distinct.

19. The only way of referring to purely figurative marks in speech is by describing them, and that being the case the applicants’ mark and the opponents “tick only” mark are potentially aurally similar. It may well be that one will be referred to as a “stitch tick” and the other as a “black tick” but even then there will be a degree of aural similarity. In composite marks it is most unlikely that the consumer will embark upon a description of the graphical features; it will be the words that are the point of reference. Therefore, the opponents’ marks containing text will be aurally distinct from the applicants’ mark.

20. Insofar as a figurative mark will say anything, this will be a matter of impression on the eye. The applicants’ mark and the opponents “tick only” mark may potentially send out the same or similar message, which in this case is dependent on whether they are seen as a “tick” or “something tick” marks. However, the applicants’ mark is not just a “tick”, it is such a device made up of stitching, which given that the relevant goods are clothing, is a fact that will be reasonably obvious to the consumer. In the opponents’ marks containing text, it is the words that will speak, so will create a conceptually different idea to the applicants’ mark. The “tick” may have some part to play, but having words placed over a solid background

diminishes the significance of the figurative element moving the marks even further apart.

21. In relation to the stitching serving to distinguish, Ms Smaggasgale submitted that this is a false distinction because the opponents may also apply their mark by means of stitching or embroidery, and that from a distance the jaggedness of the stitching would not be apparent. It may well be that the opponents will apply their mark in this way, but that, in my view would not move the marks together to the extent that I would say that they would be visually and conceptually similar. For that to happen the opponents' mark would go beyond what I would consider to be normal and fair use by transforming the look of the mark into something different from that on the register, and I dismiss this line of argument. I can accept that from a distance the irregularity in the lines of the opponents' tick will not be as visible, but it will nonetheless still be discernable as a tick composed of two lines rather than a solid. Balancing these factors I come to the view that the respective marks should not be regarded as being similar.

22. As I have said, the goods at issue are articles of clothing. The opponents' "tick" mark and the "Tick" and "GAS" composite marks are registered in respect of clothing at large, whereas the remaining composite mark covers a narrower range of specific items of clothing. Self evidently, the description "articles of clothing" and "clothing" mean the same, and that means that identical goods are involved. There being no limitation or qualification to any of the specifications that would serve to separate, I have to assume that the same channels of trade are involved, from manufacturer to retailer, and that the respective goods reach the same end consumer by identical means.

23. In *New Look Ltd v OHIM (NL Sport)* [2005] E.T.M.R. 35, a decision of the Court of First Instance (CFI), it was held that it was wrong to regard the average consumer in the clothing market as displaying a particularly high level of attention at the point of purchase, for just as clothing varies in price, the attentiveness of the consumer will also vary. The CFI went on to add the caveat that this could not be presumed in the absence of evidence with regard to all goods in that sector. Whilst I have no argument with the contention that consumers may be careful when buying expensive goods, that does not mean that they will lack circumspection or be less observant when seeking out inexpensive items. But in any event, even though the goods covered by the respective marks are ordinary if not everyday items, as they are not limited to any particular market sector they notionally cover those from high-end designer labels costing hundreds if not thousands of pounds, to mass-market lines found in high street shops and supermarkets. When taken in conjunction with the guidance in *Lloyd* and *New Look*, this means that the degree to which the consumer will be circumspect and observant ranges from "reasonably" to "highly".

24. Earlier in this decision I said that these are simple marks. That is the case whether the "tick" is composed of stitching or a solid line, although I would say that the applicants' mark has a little more about it. Ticks are commonly used symbols that in my view do not have a strong inherent distinctive character, particularly in relation to goods such as jeans where stitching, although brand specific, may nonetheless be seen more as decoration. I do not dispute that they may acquire a strong distinctive character and reputation through use, but that is not the case here; there is no evidence of any use by the opponents.

25. Ms Smaggasgale referred me to the decision of the Registrar's Hearing Officer in Case

BL-0-448-01 the “K” case, in which he stated:

“The similarities between the trade marks are such that in my view, the average consumer on seeing the applicants’ trade mark in use would wrongly believe that the goods came from the opponents or an economically linked undertaking. It seems common for manufacturers to produce sub-brands.”

26. In *Jose Alejandro SL v OHIM (Budman)* [2004] E.T.M.R. 15, a case relating to consumer perceptions about sub-brands, the applicant had applied to register as a Community trade mark, the word BUDMEN, amongst other goods, for clothing, footwear and headgear. The intervener opposed, citing earlier national trade mark registrations for BUD for the same class of goods. In its judgment the CFI (2nd Chamber) stated:

“It must be observed that it is common in the clothing sector for the same mark to be configured in various different ways according to the type of product which it designates. It is also common for a single clothing manufacturer to use sub-brands (signs that derive from a principle mark and which share with it a common dominant element) in order to distinguish his various lines from one another (women’s, men’s, youth). In such circumstances it is conceivable that the relevant public may regard the clothing designated by the conflicting marks as belonging, admittedly, to two distinct ranges or products but as coming, none the less, from the same undertaking.”

27. Whilst I have no argument with the contention that the use of sub-brands based around a central feature is common in many trades, including clothing, there are some significant differences between the case to which Ms Smaggasgale referred me, the BUDMEN case, and the proceedings before me. In the K case the opponents had provided evidence that showed them to have used their K mark with other sub-brands, from which the Hearing Officer believed the public might assume that the mark applied for, a letter K containing the word KELME was merely another sub-brand and thus associate the two undertakings. There is no evidence of the opponents having used any of their marks; registration does not equate to use. In BUDMEN the opponents’ relied upon an earlier registration for BUD which the Board of Appeal noted was “contained in its entirety” within the later mark. That is not the case here. The word MEN was considered ancillary to the element BUD because it occupied second place, but also that the suffix would be likely to carry the suggestive or even descriptive connotation that the goods were intended for male customers. The CFI appear to have been saying that BUD is individually distinctive and dominant, whereas in the minds of the consumer the word MEN would be regarded as neither. In the case in hand, the differences are not brought about by some descriptive addition; they are a fundamental part of what makes the mark distinctive.

28. Taking all factors into account, and even allowing for the possibility of confusion through imperfect recollection, I come to the view that there is no real likelihood of confusion should the applicants use their mark in connection with the goods for which they seek registration. The objection under Section 5(2)(b) fails.

29. The opposition having failed, the applicants are entitled to a contribution towards their costs. I therefore order that the opponents' pay the applicants the sum of £750 towards their costs. 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 3rd day of August 2007

**Mike Foley
for the Registrar
the Comptroller-General**

International Trade Mark 824003

Mark



List of goods or services

Class 03

Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; deodorants for personal use.

Class 09:

Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), emergency (life-saving) and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmitting and reproducing sound or images; magnetic recording media, sound recording disks; automatic vending machines and mechanisms for coin-operated apparatus; cash registers calculating machines, data processing equipment and computers; fire extinguishers; electronic publications (downloadable); spectacles; frames; lenses; cases; cords; chains for spectacles; videogames.

Class 14:

Precious metals and their alloys and goods made of or coated with these materials not included in other classes; jewellery, precious stones; horological and chronometric instruments; jewellery, silverware.

Class 16:

Paper, cardboard and goods made thereof, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' supplies; paintbrushes; typewriters and office articles (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks; writing or drawing books, pens, periodicals, magazines, books.

Class 18:

Leather and imitations of leather and goods made of these materials and not included in other classes; animal skins and hides; trunks and suitcases; umbrellas, parasols and walking sticks; whips and saddlery.

Class 25:

Clothing, shoes, headgear; coats, overcoats, blousons, short jackets, jean trousers, jackets, shirts, skirts, hosiery, shawls, tracksuits, sweatshirts, stockings, socks, neckties, hats, berets, scarves, shoes, boots, slippers.

Class 28:

Games, toys; gymnastic and sporting articles not included in other classes; Christmas tree decorations.

Class 32:

Beers; mineral and sparkling water and other non-alcoholic beverages; fruit drinks and fruit juices; syrups and other preparations for making beverages.

Class 35:

Advertising; business management; business administration; office functions; dissemination of advertising matter; distribution of advertising materials; rental of advertising space; management assistance and advice for commercial and industrial businesses; professional business consulting, modelling for advertising or sales promotion, franchising, namely services provided by a franchiser comprising assistance, management and development of a commercial enterprise (services for third parties).

Class 41:

Education; training; entertainment; sporting and cultural activities; photographic reporting; recording films on videotapes; rental of video cassettes and videogames.

Class 42:

Scientific and technological services and related research and design services; industrial analysis and research services; textile testing; styling (industrial design); industrial design; fashion designing services; new product research and development; creation and development of computer software and hardware; legal services; franchising, namely services provided by a franchiser comprising the transfer of technical know-how and licensing, consulting in drafting of plans and in the design of shops (services for third parties); fashion information; consulting in interior decoration of shops and in the design of signs (services for third parties).

Class 43:

Providing of food and drink; cafeterias, bar services, snack-bars, restaurants, self-service restaurants, hotel reservations, hotel services, temporary accommodation.

Class 45:

Rental of suits, clothing and uniforms, security services for the protection of goods and persons; rental of formal dress.

Community Trade Mark E306050

Mark



List of goods or services

Class 03:

Perfumes and cosmetics.

Class 09:

Spectacles.

Class 14:

Jewellery; gold ware; clocks and watches.

Class 25:

Trousers, jackets, jeans, shirts, skirts, heavy jackets, sports jerseys, sweaters, tailored jackets, stockings, socks, footwear, boots, slippers.

Community Trade Mark E2867463

Mark



List of goods or services

Class 03:

Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; deodorants for personal use.

Class 09:

Optical and teaching apparatus and instruments; apparatus and instruments for conduction, distribution, conversion, storage, regulation or control of electric current; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; electronic publications downloadable; spectacles, frames, lenses, cases, cords, spectacle chains, video games.

Class 14:

Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments; jewellery, goldware.

Class 16:

Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks; notebooks, pens, periodicals, magazines, books.

Class 18:

Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.

Class 25:

Clothing, shoes, headgear; coats, overcoats, blousons, greatcoats, pants, jeans, jackets, shirts, skirts, hosiery, tailored jackets, tracks, sweatshirts, stockings, socks, neckties, hats, berets, headscarves, footwear, boots, slippers.

Class 28:

Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees.

Class 32:

Mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; preparations for making beverages.

Class 35:

Advertising; business management, business affairs; business administration; office functions; dissemination of advertisements; dissemination of advertising matter; rental of advertising space; commercial and industrial management assistance and consultancy, professional business consultancy, modelling for advertising or business promotion, franchising, that is services provided by a franchiser consisting of assistance in the management and development of a commercial concern (services for others); commercial information on fashion.

Class 41:

Education; providing of training; entertainment; sporting and cultural activities; videotaping; rental of video cassettes and video games.

Class 42:

Scientific and technological services including related research and design services; industrial research and analysis; textile testing; styling (industrial design); industrial design; dress designing; research and development of new products; creation and development of computer software and hardware; legal services; franchising, namely services provided by a franchiser consisting of the transfer of know-how and granting of licences, consultancy relating to the installation and setting up of shops, the interior fittings of shops and related signs (services for others).

Class 43:

Restaurant services (food); cafeteria, cocktail lounge, snack-bars, restaurants; self-service restaurants; hotel reservations; hotels, temporary accommodation.

Class 45:

Personal and social services provided by others to meet the needs of individuals; rental of suits, clothing and uniforms, security services for the protection of property and individuals; evening dress rental.