

O-011-08

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2359834
IN THE NAME OF ASCOT (S & F) INTERNATIONAL LIMITED
FOR REGISTRATION OF A TRADE MARK IN CLASS 25**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 93923 IN THE NAME OF NIKE INTERNATIONAL LIMITED**

Trade Marks Act 1994

**IN THE MATTER OF trade mark application No. 2359834
in the name of Ascot (S & F) International Limited
for registration of a trade mark in Class 25**

And

**IN THE MATTER OF opposition thereto
under No. 93923 in the name of Nike International Limited**

BACKGROUND

1. On 31 March 2004, Ascot (S & F) International Limited made an application to register a trade mark in Class 25 in respect of “Clothing; footwear; headgear.”
2. The mark applied for looks as follows:



3. On 21 November 2005, Nike International Limited filed notice of opposition to the application, the grounds of opposition being in summary:

- 1. Under Section 5(2)(b)** because the mark applied for is similar to the opponent’s earlier marks, and is sought to be registered in respect of goods that are either identical or similar to those for which these earlier marks are registered, such that there exists a likelihood of confusion.
- 2. Under Section 5(3)** because the mark applied for is the same or similar to the opponent’s earlier marks for which they have a reputation, and is sought to be registered in respect of goods that are the same or similar to those for which it is used such that use of the mark by the applicants would take unfair advantage of, or be detrimental to the distinctive character of the opponent’s reputation.
- 3. Under Section 5(4)(a)** by virtue of the law of passing off.

4. Under Section 56

because the opponents' marks identified under Section 5(4)(a) are well known trade marks at least for the goods specified and the use of the applicants' mark is likely to cause confusion because the opponent's marks are well known both when used alone and in combination with other words and devices.

The earlier marks relied upon can be found as an annex to this decision.

4. The applicants filed a counterstatement in which they deny the grounds 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 is relevant I have summarised below. Neither side took up the offer of an oral hearing, instead electing to file written submissions in lieu of a hearing. After a careful study of the evidence and submissions, I now go on to give my decision.

Opponent's evidence

7. This consists of a Witness Statement dated 21 August 2006, from Christine Ray, Trade Mark Manager for Nike (UK) Limited. Ms Ray confirms that she has been employed by the company since 1984 and has been involved in brand protection since 1987. Ms Ray says that she also acts for Nike International Limited.
8. Ms Ray refers to the logo that she describes as the Nike "Swoosh" or "tick" having been used since the early 1970's, later saying that it was first designed in 1971. She next refers to Nike, Inc. beginning franchise operations in Europe, including the UK, in the late 1970s. Ms Ray says that in the 1980s most of the franchises were purchased by Nike International Limited, a subsidiary of Nike, Inc., with a new subsidiary company, Nike (UK) Limited being formed to deal with the UK market. She describes Nike, Inc as being the largest of the "big three" sportswear brands, going on to give turnover figures for the US, and the combined area of Europe, Middle East and Africa. The figures are very substantial, but have not been broken down to apportion the UK share.
9. Ms Ray states that the Nike "swoosh" logo appears on virtually every product manufactured by her company, both directly on the products, neck labels, swing tickets, packaging and on headed paper in place of the company name. Exhibit CR1 consists of copies of two photographs. The first depicts the frontage of a shop in Barcelona Airport, the Nike "swoosh" logo can be seen on the signage; there is no other indicator. Ms Ray says that there is a similar shop in Heathrow Airport. The second photograph is stated to be from an article that appeared in the 17 July 2005 edition of The Independent on Sunday Sportweek supplement. The Nike "swoosh" logo cannot be seen.
10. Ms Ray states that in general the Nike group aims to spend about 12% of their

annual turnover on advertising and promotion. By way of example she states that in the year to April 2003 Nike (UK) Limited spent some £56 million promoting the Nike name and logo by means of advertising and direct sponsorship. Ms Ray states that this was backed by a worldwide spend of US\$1,300 million in 2003, some of which would have impacted on travellers from the UK. Ms Ray refers specifically to her company's sponsorship of the 2003 England rugby team that won the rugby world cup, various high-profile individuals from sport, the 2004 US Olympic team, the 2002 World Cup winners Brazil, and Portugal during the 2004 European Football Championship.

11. Ms Ray goes on to say that whilst her company is best known for sports footwear and clothing, it is also known for sports equipment such as soccer balls, basket balls, safety equipment, weights, golf clubs, sports bags such as duffel bags, rucksacks and carrying bags, fitness watches, wrist watches, personal stereo holders, goggles, sunglasses, towels, water bottles, hats, caps and gloves. In support Ms Ray refers to Exhibits CR2, CR3 and CR4 which consist of brochures and catalogues from:

2002 to 2005 advertising a range of sports footwear,

2002 and 2004 promoting sports tops and pants, shorts, socks and caps,

2003 advertising a range of swimwear and accessories some of which mention the "Swoosh" device in the description,

2002 and 2004 showing a range of golf clothing and equipment,

2003 depicting a range of travel and sports bags, satchels, backpacks, padding and carrying aids, weight-training gloves, joint and back supports, hand weights, exercise mats and equipment,

2002 relating to watches and heart/pulse monitors,

12. The Nike "swoosh" logo is consistently used upon and in relation to the goods, both on its own and in conjunction with other matter. Ms Ray refers to Exhibit CR5 which consists of a crossword puzzle that is endorsed as having been printed in the 2 July 2005 Edition of the Gloucester Echo, Ms Ray referring to the clue "Sportswear manufacturer whose logo is a tick (4)", and the solution showing this to be NIKE. Ms Ray takes this to be an illustration that the logo is well known. Exhibit CR6 consists of the results of a search using the Google search engine conducted on 8 July 2006 using the criteria "Nike tick", the search bringing back nearly 1.2 million hits, the first 10 of which are exhibited. These mention the Nike tick. The exhibit also includes images of the Nike tick obtained from the search engine, showing the sign being used in various scenarios, including on items of sportswear. The remaining parts of the exhibit consists of a cartoon and an article on business ownership from "biz ed", which, although mentioning Nike and the Nike "tick" either cannot be dated or date from well after the relevant date.

13. Exhibit CR7 consists of an extract from the judgment in *Addidas-Saloman Ag v Drape & Ors* [2006] EWHC 1318 CH, Ms Ray mentioning that the judge referred to her company's logo as its "swoosh" logo with the expectation that the public knows

to what he is referring. Exhibit CR8 consists of a number of articles. The first is entitled “Be a Design Group: What is the value of De\$ign?” that sets out the history and development of the Nike logo. There is an extract from a website called ELEMENT L DESIGN called “Understanding Identity” that considers the purpose of logos, and an article from smithsonianmagazine.com entitled “One Under The Sun” that starts “If a “swoosh” emblazons your athletic shoes, everybody knows what brand you are wearing...The Nike swoosh and McDonalds golden arches, for example, have become so recognizable on the consumer landscape that the company’s products can be identified in a single glance.” These articles cannot be dated and apart from some historical references to the origins of the Nike “swoosh” there is nothing that casts any light backwards to reveal any relevant facts. An extract from Wikipedia that is headed “Swoosh” states that “Swoosh is the symbol of the athletic shoe and clothing manufacturer Nike. It is among the most easily recognized brand symbols in the world...” Ms Ray concludes her Statement by referring to Exhibit CR9. This consists of a photograph of a sports shoe called Ascot Junior Rocky Trainers that Ms Ray says “appears to have been produced by the applicant” and which “bears a logo of the same general type as the logo which is the subject of the application.” Ms Ray says that where the “cross piece of the A appears on the shoe it is the dominant colour orange and stands out very prominently from the rest of the logo.”

Applicant’s evidence

14. This consists of a Witness Statement dated 20 February 2007, from Guru Dev Seth, Managing Director of Ascot (S & F) International Limited. Mr Seth recounts the history of his first company Ascot Sports (Sussex) (subsequently Ascot Sports Goods) from its formation in 1970, the company specialising in badminton, tennis and squash racquets, table tennis bats and accessories for these sports, as well as footballs, rugby balls, volley balls, basketballs, golf putters and accessories, and sports holdalls. Mr Seth says that by 1976 the company was selling a wider variety of sports equipment and apparatus, sports clothing, footwear and holdalls.

15. Mr Seth says that in August 1984 he formed a new company under the name Ascot (S & F) International Limited, the applicants for the trade mark in suit. He says that from its formation the company has sold a wide range of sports goods and sports clothing, including footwear. Mr Seth says that this company acquired the ownership of the UK and foreign trade marks previously owned by Ascot (Sports Goods) together with the associated goodwill. This is said to have been by assignment but no documentation has been provided.

16. Mr Seth goes on to give details of the structure of his company, stating that in addition to direct advertising, the applicant and its predecessors have been involved in sponsorship of a number of sporting tournaments, training schemes and individual sports persons, and regularly participate in trade fairs around the world. He later says that this has included advertising at sports grounds and venues, including English and Scottish football league and cup games, including Division One, Premier League, international matches, and FA Cup semi-final and Final matches, some of which were televised. Beyond this Mr Seth does not provide any further detail or evidence.

17. Mr Seth states that his company sells through “approximately 2000 outlets, ranging from large department stores in city centres to small sports shops and shoe shops in local high streets” throughout the UK. He lists the company’s turnover for the years 1984/85 through to 2003, which for each of the first five years was in the region of £225,000 to £500 000, and for the following thirteen years range from a base of nearly £12 million, peaking at just under £20 million in 1997.

18. Mr Seth says that whilst the principal brand name of Ascot (S & F) International Limited is ASCOT, the company has also adopted several secondary brands consisting of logos and devices, one of which he refers to as the “hockey stick” device that was first used in 1970. He refers to Exhibit GDS1, which consists of details of four UK and Community trade mark registrations for the “hockey stick” device. Exhibit GDS2 consists of photographs of various shoes and packaging materials bearing the “hockey stick” device. These show a logo of the same design as applied for, in one case with the tick shown in solid white, another with a green border and a black interior, two others bordered in red with a black and red segmented interior, and one with a white border and solid black interior.

19. Mr Seth says that he is aware of the opponent’s “swoosh” or “tick” trade mark and the “undoubted and enviable reputation that it enjoys.” Mr Seth concludes his Statement by commenting on the substance of the opposition.

Opponent’s evidence in reply

20. This consists of a Witness Statement dated 21 May 2007 from Victor Caddy, a trade mark attorney with Wynne-Jones, Laine & James. Mr Caddy says that from paragraph 3 of Mr Seth’s Statement it would appear that much of the applicant’s turnover may relate to sports equipment and other goods not covered by the application. Mr Caddy puts the figures into context by providing a summary of a report relating to the UK sportswear industry, referring in particular to 2006 when the market for such goods was valued at £3.65 billion, being slightly less in 2005.

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

DECISION

22. Turning first to consider the ground under Section 5(2)(b). That section reads as follows:

“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.”

23. 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,”

24. 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.

25. In any analysis of the similarity of trade marks it is inevitable that 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.

26. The goods at issue here are articles of clothing of various forms, including footwear and headgear. In his decision sitting as the Appointed Person in the *React* trade mark case [2000] R.P.C. 285, Mr Simon 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.”

27. 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 also 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 to consider and balance the aural and conceptual similarities.

28. In a visual comparison it is self-evident that the opponent’s earlier marks are not identical to the mark applied for. The alleged similarity resides in one of the several elements of which the applicant’s mark is composed. This is the “cross-bar” in the letter “A” of the applicant’s mark. This element has the appearance of a “tick” albeit sharper, and being part of a letter, is somewhat less obviously a tick than the opponent’s version, but there is a degree of similarity in their appearance. There is also the matter that the mark applied for contains the word ATOM. This is a word that as far as I am aware has absolutely no connection with the opponents, or any relevance for the goods at issue.

29. Because consumers regard a mark as a whole and will not dismantle it into its component parts, this sort of analysis is of limited value, serving only to determine whether there is a dominant, distinctive element. Single letters are used in

codification of products, and absent any other distinguishing matter, are generally not considered to possess a distinctive character. By virtue of the “tick” forming the cross-bar, the letter “A” forming part of the applicant’s mark has a fair degree of stylisation and I would say to the level that it individually and collectively contributes to the distinctive make-up of the mark. The word ATOM is wholly distinctive for the goods of the application, and being an ordinary English word is in my view the element most likely to fix in the mind of the consumer and used as the point of reference. I do not see why it would be seen as, or considered to be a “tick” or “swoosh” mark.

30. The opponent’s earlier marks are very simple, and as can be seen from the evidence have a visual appearance that registers as a “tick”. Even if the applicant’s mark was just the cross-bar from the letter “A”, the fact that the opponent’s tick is rounded whereas in the mark applied for the “tick” element is sharp will be apparent at first impression. Factor in the other matter in the mark applied for and the respective marks are clearly different in their visual impression.

31. The only way of referring to purely figurative marks in speech is by describing them. Consumers who encounter the opponent’s mark without any prior knowledge are likely to refer to it as the “tick” mark, whereas those who already know the sign may refer to it as the Nike “tick“ or Nike “swoosh“; there is evidence showing use of these and the “tick” and “swoosh” without Nike attached. In composite marks such as the one applied for, 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 and the mark applied for will be aurally distinct.

32. Insofar as a figurative mark conveys an idea, this will be a matter of impression on the eye. The opponent’s marks will only say, “swoosh” or “tick”. A consumer seeing the applicant’s mark may register the “tick” element but this is by no means the dominant, distinctive component. In composite marks it is the words that are considered to speak. The word ATOM emphasises the fact that the element above is a letter “A”, which reduces the potential for the cross-bar being seen as a “tick“. In my view the mark applied for is likely to be seen as an “A ATOM” or “ATOM” mark rather than as a “tick“ mark. From the conceptual viewpoint the respective marks say different things.

33. Having found the respective trade marks to be visually, aurally and conceptually different, the only conclusion that can be reached is that these are not similar marks. Other than where the respective marks have no similarity whatsoever, this intellectual assessment is the end of the matter. The judgment in *Vedial SA v Office for the Harmonization of the Internal Market (marks, designs and models) (OHIM)* [2005] ETMR 23, tells me that I need go no further. If it is decided that the trade marks are not similar, whether there is a reputation and/or identical goods counts for naught; one of the two essential requirements for a finding of likelihood of confusion has not been satisfied and that is it. However, where two marks have some similarity, other factors such as the distinctiveness and uniqueness of the earlier mark in the market place, in respect of the goods at issue, and the strength of any reputation can go some way towards bridging the gap in the similarity of the marks and create an environment where consumer confusion is possible.

34. On my reading the evidence shows the opponents to have an exceptionally strong reputation in respect of their “swoosh” or “tick” mark, which is commonly used as the sole visible identifier on the goods. The extent of the opponent’s reputation is a fact acknowledged by Mr Seth who states that he is aware of these trade marks and the “undoubted and enviable reputation that it enjoys” although Mr Seth does not allocate this to any particular type of goods or services. This reputation exists in an area of trade referred to by Ms Ray as “sportswear”, Nike being stated to be the largest of the “big three”. The extent of the Nike reputation is supported by references such as “If a “swoosh” emblazons your athletic shoes, everybody knows what brand you are wearing...The Nike swoosh and McDonald’s golden arches, for example, have become so recognizable on the consumer landscape that the companies’ products can be identified in a single glance.”. A mention in the Wikipedia online encyclopaedia states “Swoosh is the symbol of the athletic shoe and clothing manufacturer Nike. It is among the most easily recognized brand symbols in the world...”. Whilst Ms Ray says that her company is best known for sportswear, in particular sports footwear and clothing, it is also known for sports equipment, sports bags, fitness watches, wrist watches, personal stereo holders, goggles and sunglasses, towels, water bottles, hats, caps and gloves. Exhibits CR2 to CR4 support this use.

35. The goods at issue are articles of clothing. The opponent’s earlier marks are registered, *inter alia*, in respect of various items of clothing such as footwear, and more generally for clothes, shoes and hats. The description “clothing” covers all items used to clothe (including footwear and headwear) for both normal daily wear and for engagement in activities such as sports. The application seeks to register the mark for “clothing, footwear and headgear”. Self-evidently, the descriptions “clothes” and “clothing” mean the same, and consequently 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 notionally the same channels of trade are involved, from manufacturer to retailer, and that the respective goods reach the same end consumer by identical means.

36. 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, this 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, in their potential, 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”.

37. Earlier in this decision I said that the opponent's "tick/swoosh" is a simple mark, and that any possibility of confusion relies upon the consumer disregarding the other matter and picking this element from the applicant's mark. 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."

38. From my own knowledge I am aware that ticks in the form of "stitching" and "flashes" are commonly used on goods such as jeans and "sports footwear". Although brand specific, unless educated otherwise the consumer is likely to regard insignia of this type more as decoration than a badge or origin. For this reason such marks are not considered to have a particularly strong inherent distinctive character. I do not dispute that they may acquire an enhanced distinctiveness and reputation through exposure to the public, which is accepted as being the case in respect of the opponent's mark. It is also relevant that the opponents have not used their tick in a way where it could be mistaken for mere decoration; the use has clearly been as a sign to indicate origin.

39. There is the argument that having established a strong reputation in their "swoosh/tick" mark, the consumer may see another mark incorporating another "tick" as a sub-brand to the mark that they already know. In Case BL-0-448-01, the "K" case, the Hearing Officer at paragraph 50 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."

40. 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 the word BUDMEN as a Community Trade Mark, for amongst other goods, 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) at paragraph 57 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 principal 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."

41. 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 these cases 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 and thus associate the two undertakings. That is not the case here.

42. 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. If the tick in the applicant’s mark was similar to the opponent’s tick/swoosh, that would be the case here; but it is not. In BUDMEN the additional matter, 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 appears 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 in the mark applied for are not brought about by some descriptive addition; they are a fundamental part of what makes the mark distinctive. The assessment of a likelihood of confusion is a consideration that takes into account how the applicants may notionally use their mark in normal and fair use. There is no evidence that they use the “cross-bar” from the letter A as a mark in its own right, but in any event that is not the mark under consideration. To assess the consequences should this element be used on its own goes beyond what I would consider to be normal and fair use. So the opponent’s case must rest on the premise that the “cross-bar“, “tick” or “hockey stick” will be picked out from amongst the other matter, and through imperfect recollection, confused with the opponent’s “swoosh/tick” mark.

43. There is evidence that shows how the applicants actually trade and ordinarily there can be no better measure of what is normal or fair use than this. Exhibit GDS2 consists of photographs of various shoes and packaging materials, all of which bear the “A” logo of the same design as in the mark applied for. In one case the cross-bar is in solid white, another shows this with a green border and a black interior, two other versions show the cross-bar bordered in red with a black and red segmented interior, and one with a white border and solid black interior. That the cross-bar is shown in a different colour to the rest of the letter “A” makes it stand out. The opponents also exhibit a photograph of a sports shoe bearing the mark applied for (Exhibit CR9). They draw attention to the fact that the crossbar of the letter “A” is in a bright orange colour and stands out prominently from the logo.

44. These photographs do not depict the shoes in their actual size; they are much smaller and as a consequence the logo on the shoe is proportionally smaller. Given that the cross-bar is in a different, often brighter colour in comparison to the other matter, it inevitably stands out to the extent that from a cursory glance it could be mistaken as being the opponent’s “swoosh” mark. This gives a false impression of how the mark will be presented to the consumer. I accept that in mail order catalogues the picture will be small, but I am aware that in such publications each product is accompanied by a description that includes the brand name. When the shoe is seen in its actual size I consider that the notional observant and circumspect

consumer will see that the applicant's "A" logo is different to the Nike "swoosh". On the packaging where the logo is much larger the cross-bar to the letter "A" can be clearly seen to be different in its appearance to the opponent's "swoosh" mark.

45. The opponents have a massive reputation as Nike, and from the evidence also a very significant reputation in their "swoosh/tick" marks. Although established in relation to a range of goods that are identical to those of the application, this, of itself, does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association. The association between the marks must cause the public to wrongly believe that the respective goods come from the same or economically linked undertakings; there must be a likelihood of confusion. To my mind, when all facts and circumstances are collated and considered as a whole, the "global" approach, I come to the position that even factoring in the possibility of imperfect recollection, there is no real likelihood of confusion between the mark applied for and the opponent's earlier marks. The ground under Section 5(2)(b) is dismissed.

46. Turning next to consider the ground under Section 5(3) of the Act. As a result of regulation 7 of The Trade Marks (Proof of Use etc) Regulation 2004 Section 5(3) now reads:

"5.- (3) A trade mark which –
(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC) in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark."

47. The standard test for the sort of reputation that is needed to underpin a Section 5(3) action is set out in *General Motors Corp v Yplon SA* [2000] R.P.C. 572. In this case the Court concluded that the requirement implies a certain degree of knowledge amongst the public, and that the required level would be considered to have been reached when the earlier mark is known by a significant part of the relevant sectors of the public. In deciding whether this requirement is fulfilled all relevant factors should be considered, including, the market share held by the trade mark, the intensity, geographical extent and duration of its use and the size of the investment made by the undertaking promoting it; the stronger the reputation and distinctive character, the easier it will be to accept that detriment has been caused to it.

48. The raft of recent case law relating to objections under Article 8(5) of Regulation 40/94, equivalent to Section 5(3) of the Trade Marks Act was considered by the CFI in some detail in *Sigla SA v. Office for Harmonisation in the Internal Market* Case T-215/03, namely, Case C-292/00 *Davidoff & Cie SA v Gofkid Ltd* [2003] E.C.R. I-389 at [24]-[26], and Case C-408/01 *Adidas-Salomon AG v Fitnessworld Trading Ltd* [2003] E.C.R. I-12537 at [19]-[22], Case T-67/04 *Monopole SpA v OHIM--Spa-Finders Travel Arrangements* [2005] E.C.R. II-1825 at [30], the Opinion of Advocate General Jacobs in *Adidas-Salomon and Adidas Benelux* at [36]-[39], Case T-104/01 *Oberhauser v OHIM-- Petit Liberto* [2002] E.C.R. II-4359 at [25], Case C-39/97 *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1998] E.C.R. I-5507 at [29], Case C-342/97 *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [1999]

E.C.R. I-3819 at [17], Case C-251/95 *Sabel BV v Puma AG* [1997] E.C.R. I-6191 at [20] and Case C-375/97 *General Motors Corp v Yplon SA* [1999] E.C.R. I-5421 at [30]. Some of these cases I will refer to in more detail.

49. The CFI concluded that the mark at issue must be either identical or similar to an earlier mark relied upon. In its judgment in *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd*, Case C-408/01, the ECJ were not so conclusive about the need for the respective marks to be “similar”, only that they should have a “certain degree of similarity”:

“29. The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them: see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23”

50. In *Inlima S.L.’s* application [2000] RPC 661 Mr Simon Thorley QC, sitting as the Appointed Person posed the question of what “similar” meant in the context of Section 5(3):

“13..The word ‘similar’ is a relative term. One has to ask the question ‘similar for what purpose’. The question of similarity accordingly can only be answered within the context of a particular set of facts, once one has identified both the facts and the purpose for which similarity is required. In the case of section 5(3), the purpose of requiring similarity is so that the possibility of detriment or unfair advantage might arise. In any particular case, a conclusion as to whether it does arise must depend not only upon the degree of similarity but on all the other factors of the case, not least, the extent of the reputation.

14. I therefore conclude that the same global appreciation as is required for confusion under section 5(2) is likewise to be applied to the changed circumstances of section 5(3).”

51. In *Esure Insurance Limited v. Direct Line Insurance plc*, a decision of the High Court of Justice, Chancery Division, [2007] EWHC 1557 (CH), Mr Justice Lindsay stated that whether marks were found to be similar involved the passing of a “threshold”:

“94 At his para 114 the Hearing Officer concluded:

"In my view, a distinctive feature of both marks is the unusual juxtaposition of wheels attached to (albeit recognisably different) electronic communication devices. I find that this gives rise to a recognisable similarity between the marks".

But if the threshold question is as I have indicated -- see para 46. above -- the threshold question is more a matter of law and first impression rather than one requiring detailed analysis or evidence and, if the threshold is as I have taken

it to be, it is in my judgment here satisfied; I would not be able to say that duly-arrived-at overall impressions made by the rival marks are such that one could reasonably say that a likelihood of confusion could not thereby have been created. Despite the differences -- and there are several -- between the phone on wheels and the mouse on wheels, the relevant services are identical and both the sign and the mark are indicators of a means of making contact and doing business with the provider of those identical services and in both cases (against all experience) black road wheels have been added to that means of communication and give it the appearance of a vehicle.

As a matter of first impression I would take the low threshold to have been cleared.

95 Mr Silverleaf draws attention to the passage in the Hearing Officer's paragraph 110 where he said:

"The requirement for similarity is therefore passed when there is any visual, aural or conceptual similarity between marks which is likely to be recognised as such by an average consumer."

He had said much the same in his paragraph 108; once there was that degree of similarity then the Tribunal was obliged to go on to consider the other factors identified in section 5(2)(b) or section 5(3) of the 1994 Act. As will have been seen from my observations on thresholds, I take a different view but it is not, as it seems to me, a difference that can here be magnified into a material and clear error of principle. The difference in approach would only have been a material error of principle if, upon adopting my view as to the threshold, I had taken the view that the threshold had not been equalled or exceeded. But, as I have indicated, in my view the threshold is low, as I have described it, and was exceeded. The Hearing Officer, in my view, was thus obliged to go on to consider whether there was a likelihood of confusion in the manner that he did and, equally, to consider questions as to unfair advantage and detriment, as I shall come on to, as he did.

96 I would add this (as I apprehend Mr Silverleaf asserted error in principle as to the Hearing Officer's response to conceptual similarity): it is difficult to elevate matters essentially of weight and degree into ones of principle but, even if one were to take out of the Hearing Officer's evaluation his concept of desk top electric communication devices as a feature common to both, I would, having regard to other similarities between the mark and the sign (especially if the mouse could be used in red with black wheels) nonetheless take the low threshold to have been exceeded.

97 If that is right then I next need to look into whether such similarity as there was, as globally appreciated in the way described in the authorities which I have touched upon in paragraphs 24 et seq. above, caused a likelihood of relevant confusion."

52. The paragraph 46 referred to (and paragraph 45 which puts it into context) read as follows:

“45 Lewison J's judgment does not itself specify what kind of minimum threshold Mr Wyand QC had contended for but I have been given a copy of the very full Skeleton argument which Mr Wyand and his junior, Mr Moody-Stuart, deployed before Lewison J.. At para 29 the Skeleton Argument makes the point that "absent at least similarity there can be no infringement". The argument continues:--

"This is a threshold test and is to be considered in each case by a visual, aural and conceptual comparison of the mark and sign".

Although that is not a complete specification of the test for the relevant 4(1)(b) similarity -- it leaves out, inter alia, the concept of interdependence -- it is hard to fault it as far as it goes. If all that Mr Wyand was arguing for was that there had to be at least some similarity, I would not think that Lewison J. was intending to reject that argument. Nor does the fact that the question is one of degree of itself exclude there being a threshold. I notice, too, that, so far as one can tell from the report, Vedral supra was not referred to the Judge. But Lewison J's observation that whether "something is relevantly similar to another thing must depend on why you are asking the question" is, as it seems to me, irresistible. "Are they similar", asked of marks, would be almost bound to meet the response "For what purpose?"

46 That is not to say that in every case where some one or more items or aspects, howsoever insignificant, of the rival marks can be said to be similar, the fact-finding body necessarily has to go on to examine into the existence or not of a likelihood of confusion because that would obviate the necessity for an overall impression being formed of the rival marks in the relevant surrounding circumstances and for those overall impressions then to be compared. There can be cases -- see e.g. Vedral and Soffass supra -- where the fact-finding body, deploying the proper approach to the overall assessment which the authorities require and having due regard for interdependence and the other relevant surrounding circumstances, is able to conclude that notwithstanding some aspects of similarity, no likelihood of confusion could have been created. But, although I am far from sure I am here differing in any material way from Lewison J, I would hold there to be some form of threshold, albeit a low one. In a case such as the one before me, the threshold, in my judgment, is arrived at as follows. First, overall impressions of the rival marks are formed, paying full regard to all the requirements of the autonomous concept of 4(1)(b) similarity. Next one has to have in mind the types of confusion which are then relevant, namely (as I shall come on to below) those identified in Sabel supra at its para 16. Then the threshold question arises: are those overall impressions such that one can reasonably say that a likelihood of confusion could not thereby be created?"

53. Clearly the earlier mark must have a reputation. There must be a risk that the use of the mark applied for, without due cause, would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark. In *Sigla* the CFI went on to say that that along with the "similarity" requirement for the marks, these conditions are cumulative and a failure to satisfy one of them is

sufficient for a case to fail.

54. In my consideration of the ground under Section 5(2)(b) I found the opponent's to possess a strong reputation in respect of their "swoosh" mark, but that the mark applied for was not similar. To my mind that is the case whether determined by reference to the law and first impression, or by detailed analysis; there is no evidence for me to consider on this point. On the "cumulative" approach advocated in *Sigla* that is effectively the end of the matter. Notwithstanding the significance of the reputation that they have, the ground under Section 5(3) must fail and accordingly be dismissed.

55. Whilst it does not appear necessary that I go on to consider the other aspects of a Section 5(3) action, in the *Esure* case Mr Justice Lindsay indicated that there was a threshold of similarity that had to be crossed, and that it is a lower one. I am not entirely sure, but it seems to me that he was saying that the threshold is higher for a test requiring a likelihood of confusion under Section 5(2) than the "association" test found in Section 5(3); that to my mind would be a logical position. Therefore I will go on to comment on the specifics of this case, in particular, the reasons why I consider that whether the "threshold" of similarity is the same or lower, the relevant consumer or public will not associate the applicant's and the opponent's trade marks. The point is that the newcomer must have a similarity to the established trade mark sufficient for the consumer to make an association. If that is not the case how can the earlier mark be affected in any material way? Even if the respective marks had been similar, that does not necessarily mean that the opponents would have succeeded with this ground. Both the ECJ and the CFI have reiterated the comment made in *Premier Brands UK Ltd v Typhoon Europe Ltd* [2000] FSR 767 (in relation to Section 10(3)), that the purpose of the Regulation is not to prevent registration of any mark which is identical or similar to a mark with a reputation.

56. In *Intel Corporation Inc v CPM United Kingdom Ltd* [2006] EWHC 1878, Patten J said at para 28:

"But the first step to the exploitation of the distinctive character of the earlier mark is necessarily the making of the association or link between the two marks and all that Neuberger J is, I think, saying in this passage [*Premier Brands* at p. 789] is that the existence of a later mark which calls to mind the earlier established mark is not sufficient to ground an objection under s.5(3) or s.10(3) unless it has one or other of the consequences specified by those provisions. It must be right that the making of the association is not necessarily to be treated as a detriment or the taking of an unfair advantage in itself and in cases of unfair advantage it is likely to be necessary to show that the making of the link between the marks had economic consequences beneficial to the user of the later mark. But in relation to detriment the position is more complicated. The association between two marks and therefore potentially between the products or services to which they relate may be detrimental to the strength and reputation of the earlier mark if it tarnishes it by association or makes it less distinctive. This is likely to take place as a consequence of the same mental process which links the two marks in the minds of consumers and is essentially a negative reaction and effect."

57. In *Electrocoin Automatics Limited v Coinworld Limited and Others* [2005] FSR 7, Mr Geoffrey Hobbs Q.C. (sitting as a Deputy Judge stated:

“ 102. I think it is clear that in order to be productive of advantage or detriment of the kind prescribed, ‘the link’ established in the minds of people in the market place needs to have an effect on their economic behaviour. The presence in the market place of marks and signs which call each other to mind is not, of itself, sufficient for that purpose

58. In *Daimler Chrysler v Alavi* (the *Merc* case) [2001] RPC 42 at para 88, Pumfrey J stated:

“In my view, the best approach is just to follow the section remembering Jacobs A.G.’s warning that it is concerned with actual effects, not risks or likelihoods...”.

59. In this case the applicants are seeking to register a mark that is similar to the opponent’s “swoosh” mark to the extent that it in part contains a tick type element as the cross-bar to a letter. The opponent’s marks are wholly visual and although they may be referred to as “tick” or “swoosh” marks, that does not mean a consumer will associate any mark that could be seen as a “tick” with the opponents. The mark applied for has other matter that moves the perception to something other than a “tick” *per se*. There is no evidence that the opponent’s use their “tick” with other matter in a similar way so the consumers receptiveness will not have been cultivated to expect use in this fashion. If the respective trade marks have any similarity, it is not sufficiently high to step over the “threshold” to them being regarded as similar. I do not see that use of the mark applied for, even in respect of the goods for which the opponents and their mark have a reputation would lead to it being associated with the opponents and impact upon the distinctiveness of their “swoosh” marks. These will be just as distinctive as they ever were.

60. In relation to detriment to the repute of the earlier mark, the CFI considered that this would occur where the goods or services of the mark applied for “have a characteristic or a quality which may have a negative influence on the image of an earlier mark”. The potential for detriment in this case is not clear. There is no evidence that the applicant’s goods are of such a quality that if the consumer were to make an association this would tarnish the shine of the opponent’s reputation. But in any event, for the reasons I have repeatedly given, I see no reason why a consumer seeing the applicant’s mark would make the leap to connect it with the opponent’s mark.

61. As I have already said, the ground under Section 5(3) fails and is dismissed.

62. I will next go on to consider the ground under Section 5(4)(a). That section reads as follows:

“5.-(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark”.

63. The requirements for this ground of opposition have been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *WILD CHILD* Trade Mark [1998] R.P.C. 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

(1) that the opponents’ goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the applicant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the applicant are goods or services of the opponents; and

(3) that the opponents have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the applicant’s misrepresentation.

64. To the above I add the comments of Pumfrey J in the *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* case [2002] RPC 19, in which he said:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent’s reputation extends to the goods comprised in the applicant’s specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under Section 11 of the 1938 Act (See *Smith Hayden & Co Ltd’d Application (OVAX)* (1946) 63 RPC 97 as qualified by *BALI Trade Mark*[1969] RPC 472).

Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed at the relevant date. Once raised the applicant must rebut the prima facie case. Obviously he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of possibilities that passing off will occur.”

65. The first question is whether the opponents have any goodwill in their “swoosh” marks. From the evidence there can be little doubt that the answer to this must be in the affirmative. They have made substantial use of their “swoosh” mark in relation to, inter alia, sports wear, and built a significant reputation. I see no reason why the position should be any different in respect of goodwill.

66. The difficulty arises when I come to look at the question of misrepresentation. For this to occur the applicants would have to be representing their products in a way that would be likely to lead the consumer into believing that their goods are those of, or are in some way the responsibility of the opponents. I have already gone at some length into the reasons why I do not consider the mark applied for and the opponent’s earlier “swoosh” marks to be similar, and consequently, why the consumer will not form a link between them. This being the case, I do not see that how use of the mark applied for could constitute a misrepresentation. I believe it must follow, that there is no likelihood of any damage being caused to the goodwill or reputation attached to the opponents “swoosh” mark. The ground under Section 5(4)(a) is also dismissed.

67. Turning finally to the ground under Section 56 of the Act protecting well known marks. That section reads as follows:

“56.(1) References in this Act to a trade mark which is entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark are to a mark which is well-known in the United Kingdom as being the mark of a person who-

(a) is a national of a Convention country, or

(b) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country, whether or not that person carries on business, or has any goodwill, in the United Kingdom.

References to the proprietor of such a mark shall be construed accordingly.”

68. This provision has to be read in conjunction with the Section 6(1) of the Act which I have already set out above, and Section 55(1)n which reads as follows:

“55.(1) In this Act –

(a) ‘the Paris Convention’ means the Paris Convention for the Protection of Industrial Property of March 20th 1883, as revised or amended from time to time,

(aa) ‘the WTO agreement’ means the Agreement establishing the World Trade Organisation signed at Marrakesh on 15th April 1994, and

(b) a ‘Convention country’ means a country, other than the United Kingdom, which is a party to that Convention.”

In the *Le Mans* case (BL O-012-05), Mr Richard Arnold QC sitting as the Appointed Person considered the current case law in the UK as to what must be shown for a mark to qualify for protection as a well-known mark within the meaning of Section 56(1). After coming to the conclusion that he could not derive any assistance from these decisions, Mr Arnold went on to mention that since the hearing the decision of the Registrar's Hearing Officer in *PACO/PACO LIFE IN COLOUR* trade marks [2000] RPC 451 had come to his attention. In that case the Hearing Officer had held that (a) a trade mark could only be well known in respect of the goods or services in respect of which it has been used, and (b) accordingly PACO RABANNE was not a well-known trade mark for clothing even though it had a reputation in relation to perfume. Agreeing conclusion (a) to be a "commonsense proposition of law", Mr Arnold went on to say:

"57. In reaching conclusion (b) Mr James referred to paragraph 31 of the Opinion of Advocate General Jacobs in Case C-375/97 *General Motors Corp v Yplon SA* [1999] ECR I-5421. Although it is primarily concerned with Articles 4(4)(a) and 5(2) of the Directive, I think it is worth quoting the relevant section of the Opinion in full:

"30. Both in the proceedings before the Court, and in general debate on the issue, attention has focused on the relationship between 'marks with a reputation' in Article 4(4)(a) and Article 5(2) of the Directive and well known marks in the sense used in Article 6bis of the Paris Convention for the Protection of Industrial Property. Well-known marks in that sense are referred to in Article 4(2)(d) of the Directive.

31. General Motors, the Belgian and Netherlands Governments and the Commission submit that the condition in the Directive that a mark should have a 'reputation' is a less stringent requirement than the requirement of being well known. That also appears to be the view taken in the 1995 WIPO Memorandum on well-known marks.

32. In order to understand the relationship between the two terms, it is useful to consider the terms and purpose of the protection afforded to well known marks under the Paris Convention and the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs). Article 6bis of the Paris Convention provides that well-known marks are to be protected against the registration or use of a reproduction, an imitation, or a translation, liable to create confusion in respect of identical or similar goods. That protection is extended by Article 16(3) of TRIPs to goods or services which are not similar to those in respect of which the mark is registered, provided that use of the mark would 'indicate a connection between those goods or services and the owners of the registered trade mark and provided that the interests of the owner of the registered trade mark are likely to be damaged by such use'. The purpose of the protection afforded to well-known marks under those provisions appears to have been to provide special protection for well-known marks against exploitation in countries where they are not yet registered.

33. The protection of well-known marks under the Paris Convention and TRIPs is accordingly an exceptional type of protection afforded ever to unregistered marks. It would not be surprising therefore if the requirement of being well-known imposed a relatively high standard for a mark to benefit from such exceptional protection. There is no such consideration in the case of marks with a reputation. Indeed as I shall suggest later, there is no need to impose such a high standard to satisfy the requirements of marks with a reputation in Article 5(2) of the Directive.

34. The view is supported by at least some language versions of the Directive. In the German text, for example, the marks referred to in Article 6bis of the Paris Convention are described as ‘notorisch bekannt’, whereas the marks referred to in Article 4(4)(a) and Article 5(2) are described simply as ‘bekannt’. The two terms in Dutch are similarly ‘algemeen bekend’ and ‘bekend’ respectively.

35. The French, Spanish, and Italian texts, however, are slightly less clear since they employ respectively the terms ‘notoirement connues’, ‘notoriamente conocidas’, and ‘notoriamente conosciuti’ in relation to marks referred to in Article 6bis of the Paris Convention, and the terms ‘jouit d’une renommée’, ‘goce de renombre’, and ‘gode di notorietà’ in Article 4(4)(a) and Article 5(2) of the Directive.

36. There is also ambiguity in the English version. The term ‘well known’ in Article 6bis of the Paris Convention has a quantitative connotation (The Concise Oxford Dictionary defines ‘well known’ as ‘known to many’) whereas the term ‘reputation’ in Article 4(4)(a) and Article 5(2) might arguably involve qualitative criteria. *The Concise Oxford Dictionary* defines reputation as ‘(1) what is generally said or believed about a person’s or thing’s character or standing...; (2) the state of being well thought of; distinction; respectability;... (3) credit, fame, or notoriety’. Indeed it has been suggested that there is a discrepancy between the German text compared with the English and French texts on the grounds that the ‘reputation’ of a trade mark is not a quantitative concept but simply the independent attractiveness of a mark which gives it an advertising value.

37. Whether a mark with a reputation is a quantitative or qualitative concept, or both, it is possible to conclude in my view that, although the concept of a well-known mark is itself not clearly defined, a mark with a ‘reputation’ need not be as well known as a well-known mark.”

58. The Advocate General refers in one of his footnotes to Mostert. Mostert at 8-17 suggests the following criteria derived from a number of sources for assessing whether a mark is well-known:

- (i) the degree of recognition of the mark;
- (ii) the extent to which the mark is used and the duration of the use;

- (iii) the extent and duration of advertising and publicity accorded to the mark;
- (iv) the extent to which the mark is recognised, used, advertised, registered and enforced geographically or, if applicable, other relevant factors that may determine the mark's geographical reach locally, regionally and worldwide;
- (v) the degree of inherent or acquired distinctiveness of the mark;
- (vi) the degree of exclusivity of the mark and the nature and extent of use of the same or a similar mark by third parties;
- (vii) the nature of the goods or services and the channels of trade for the goods or services which bear the mark;
- (viii) the degree to which the reputation of the mark symbolises quality goods;
- (ix) the extent of the commercial value attributed to the mark.

59. In September 1999 the Assembly of the Paris Union for the Protection of Intellectual Property and the General Assembly of the World Intellectual Property Organisation (WIPO) adopted a Joint Recommendation concerning Provision on the Protection of Well-Known Marks. Article 2 of the Joint Recommendation provides:

(1)(a) In determining whether a mark is a well-known mark, the competent authority shall take into account any circumstances from which it may be inferred that the mark is well known.

(b) In particular, the competent authority shall consider information submitted to it with respect to factors from which it may be inferred that the mark is, or is not, well known, including, but not limited to, information concerning the following:

1. the degree of knowledge or recognition of the mark in the relevant sector of the public;
2. the duration, extent and geographical area of any use of the mark;
3. the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies;
4. the duration and geographical area of any registration, and/or any applications for registration, of the mark, to the extent that

they reflect use or recognition of the mark;

5. the record of successful enforcement of rights in the mark, in particular, the extent to which the mark was recognized as well known by competent authorities;

6. the value associated with the mark.

(c) The above factors, which are guidelines to assist the competent authority to determine whether the mark is a well-known mark, are not pre-conditions for reaching the determination. Rather, the determination in each case will depend upon the particular circumstances of that case. In some cases all of the factors may be relevant. In other cases some of the factors may be relevant. In still other cases none of the factors may be relevant, and the decision may be based on additional factors that are not listed in subparagraph (b), above. Such additional factors may be relevant, alone, or in combination with one or more of the factor listed in subparagraph (b), above.

(2)(a) Relevant sectors of the public shall include, but shall not necessarily be limited to:

(i) actual and/or potential consumers of the type of goods and/or services to which the mark applies;

(ii) persons involved in channels of distribution of the type of goods and/or services to which the mark applies;

(iii) business circles dealing with the type of goods and/or services to which the mark applies.

(b) Where a mark is determined to be well known in at least one relevant sector of the public in a Member State, the mark shall be considered by the Member State to be a well-known mark.

(c) Where a mark is determined to be known in at least one relevant sector of the public in a Member State, the mark may be considered by the Member State to be a well-known mark.

(d) A Member State may determine that a mark is a well-known mark, even if the mark is not well-known or, if the Member State applies subparagraph (c), known, in any relevant sector of the public of the Member State.

(3)(a) A Member State shall not require, as a condition for determining whether a mark is a well-known mark:

(i) that the mark has been in, or that the mark has been registered or that an application for registration of the mark has

been filed in or in respect of, the Member State;

(ii) that the mark is well known in, or that the mark has been registered or that an application for registration of the mark has been filed in or in respect of, any jurisdiction other than the Member State; or

(iii) that the mark is well known by the public at large in the Member State.

(b) Notwithstanding subparagraph (a)(ii), a Member State may, for the purpose of applying paragraph (2)(d), require that the mark be well known in one or more jurisdictions other than the Member State.

60. Two points of interest emerge from Article 2 of the Joint Recommendation. The first is that the list of six criteria contained in Article 2(1)(b) is not inflexible, but provides as it were a basic framework for assessment. The second is that *prima facie* the relevant sector of the public consists of consumers of and traders in the goods or services for which the mark is said to be well known.”

69. The above reference states that Article 6*bis* of the Paris Convention provides protection for well known marks against “...exploitation in countries where they are not yet registered.” To me this is an acknowledgement that where a trade mark is registered, other provisions such as those found under Section 5 of the Trade Marks Act provide appropriate protection, and if an opponent is not able to succeed in respect of an action based on these provisions, they will be no more likely to under Section 56.

70. I have little doubt that the name Nike and the “swoosh” or “tick” logo that they use in connection with their sportswear activities are very well known in the UK. They have been extensively promoted in all of the usual avenues of the media, and by sponsorship of high-profile and successful teams and individuals. The earlier marks relied upon by the opponent’s include a number of Community Trade Mark registrations which is evidence of the logo having been protected through registration in other jurisdictions. I am not aware of any other proceedings that are ongoing, and there is no evidence that shows a track record of successful enforcement of any rights in the logo. Beyond saying that there is an undoubted value associated with the opponent’s “swoosh” mark, it is not really possible to put this in monetary terms. On my assessment it is safe to say that the Nike “swoosh” logo is well known in the UK.

71. Being well known is not the end of the matter; it is necessary to pose the question “well known for what purpose?” The answer can be found in the 1995 WIPO Memorandum on well-known marks which is referred to above, the relevant extract being that “...well-known marks are to be protected against the registration or use of a “reproduction, an imitation, or a translation, liable to create confusion” where use of the other mark “...”would indicate a connection between those goods or services and the owners of the registered trade mark...” and where the interests of the owner of the well known trade mark is “...likely to be damaged by such use.” I do not see any need to reiterate the reasons why I do not consider the respective marks to be similar,

or why I do not consider the consumer will form a link between them. Even though the opponent's "swoosh" mark warrants protection as a well known trade mark, I do not see that there is a potential for damage to be caused to the opponent's interests in their "swoosh" marks, and the ground under Section 56 is also dismissed.

72. The opposition having failed on all grounds, the applicants are entitled to a contribution towards their costs. I therefore order that the opponents to pay the applicants the sum of £2,000 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 day of January 2008

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

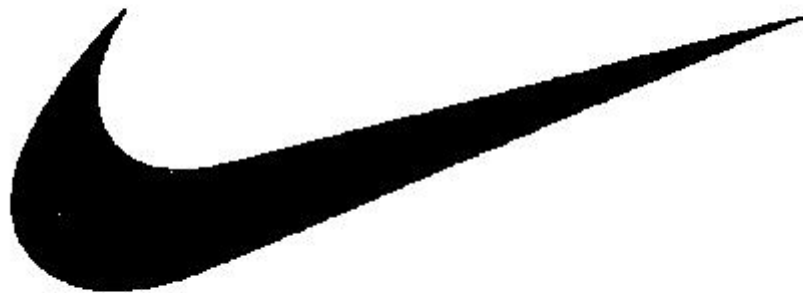
Trade mark details as at 17 January 2008

Case details for Trade Mark 1363284

[Case history](#)

Licensee details, where held, are available via Case history

Mark



Status

Status:

Registered

Class:

25

Relevant dates

Filing date:

10 November 1988

Next renewal date:

10 November 2015

Registration date:

24 May 1991

Publication in Trade Marks Journal

First advert:

Journal:

5866

Page:

1875

Publication date:

27 March 1991

Registration:

Journal:

5884

Publication date:

31 July 1991

Renewal:

Journal:

6587

Publication date:

24 June 2005

Assignment:

Journal:

6145

Publication date:

02 October 1996

List of goods or services

Class 25:

Footwear, all being sports clothing and leisurewear; all included in Class 25.

Names and addresses

Proprietor:

Nike International Ltd

One Bowerman Drive, Beaverton, Oregon 97005-6453, United States of America

Incorporated country:

Bermuda

Residence country:

United States of America

Customer's ref:

BD/JS/4414

Effective assignment date:

01 April 1996

ADP number:

0839549001

[Other cases owned by this proprietor](#)

Agent:

Wynne-Jones, Lainé & James LLP

Essex Place, 22 Rodney Road, Cheltenham, Gloucestershire, GL50 1JJ

ADP number:

0001792001

Service:

Wynne-Jones, Lainé & James LLP

Essex Place, 22 Rodney Road, Cheltenham, Gloucestershire, GL50 1JJ

ADP number:

0001792001

Other particulars

Special circumstances:

Advertised before acceptance by reason of use and special circumstances. Section 18(1)(proviso).

Enter the search name::

CTM-ONLINE - Detailed trade mark information



Trade mark name : Not a word mark
Trade mark No : 000277517
Trade mark basis: CTM
Number of results: 1 of 1



Trade mark

Filing date: 08/07/1996
Date of registration: 21/04/1999
Expiry Date: 08/07/2016
Nice Classification: 9, 14, 18, 25, 28, 42 ([Nice classification](#))
Trade mark: Individual
Type of mark: Figurative
Vienna Classification: 26.11.1, 26.11.6, 26.11.97 ([Vienna Classification](#))
Acquired distinctiveness: No
Your reference: MC 027
Status of trade mark: [CTM registered](#) ([Glossary](#))
([History of statuses](#))
Filing language: Spanish
Second language: English

Graphic representation



+ List of goods and services

Nice Classification:	9
List of goods and services	Scientific, aquatic, geodesic, electric, photographic, cinematographic, optical, weighing, measuring, signposting, controlling (inspection), helping (rescuing), education devices and instruments; recording, transmission, sound and images reproduction devices; magnetic recording media, acoustic records; automatic distributors and mechanism for advance payment devices; cash registers, calculating machines, data processing equipment and computers; extinguishers.
Nice Classification:	14
List of goods and services	Precious metals and their alloys and items thereof or plated not being comprised in other classes; jewellery, imitation jewellery, precious stones; watches and chronometric instruments.
Nice Classification:	18
List of goods and services	Leather and leather imitations, products from these materials not included in other classes; furs; trunks and suitcases; handbags and bags; umbrellas, parasols and walking sticks; riding whips and harness.
Nice Classification:	25
List of goods and services	Clothes, shoes, hats
Nice Classification:	28
List of goods and services	Games, toys, gymnastics and sport items not included in other classes; decorations for Christmas trees.
Nice Classification:	42
List of goods and services	Services rendered by hotels, boardinghouses, providing accomodation, lodging and meal; services rendered by establishments mainly engaged in the obtention of ready food or drinks; such services may be rendered by restaurants, self-service restaurants, canteens; personal services rendered by establishments engaged in covering individual needs; such services may include to accompany somebody in any social event, beauty parlours, hairdressing salons; services rendered by people, individually or collectively, as members of an organization requiring a high level of mental activity and referred to theoretical or practical aspects on complex matters of human effort. The services rendered by these people require from them an ample and deep university education or an equivalent experience. Srvices rendered by travel agencies or intermediaries providing hotel bookings for travelers; services rendered by associations to their own members and not being included in other classes. Services of computers programming.

+ Description

Description of the mark:	It is made by an irregular geometrical design, on a black background, one of its edges showing a curved form shaped like a thick and short hook finishing by a sharp point; the same portion shaped like a hook is being prolonged towards the opposite edge, by means of a long section which is gradually getting thinner, finishing by a point..
---------------------------------	---

Owner

Name:	Nike International Ltd.
ID No:	207
Natural or legal person:	Legal entity
Address:	One Bowerman Drive
Post code:	97005-6453
Town:	Beaverton,
Country:	UNITED STATES
Correspondence address:	Nike International Ltd. One Bowerman Drive Beaverton, Oregon 97005-6453 ESTADOS UNIDOS (EE UU)

Representative

Name: Mario
De Justo Bailey
ID No: 4803
Address: Paseo de la Castellana, 128
Post code: 28046
Town: Madrid
Country: SPAIN
Correspondence address: Mario De Justo Bailey Paseo de la Castellana, 128 E-28046 Madrid ESPAÑA
Telephone: 914111668
Fax: 914113091
E-mail: jp@jacobacciandpartners.es

Seniority

Country: DENMARK
Registration number: 4719/90
Status: Accepted

Country: SPAIN
Registration number: 1.518.998
Status: Accepted

Country: SPAIN
Registration number: 1.519.003
Status: Accepted

Country: SPAIN
Registration number: 1.519.007
Status: Accepted

Country: SPAIN
Registration number: 1.519.014
Status: Accepted

Country: SPAIN
Registration number: 1.519.017
Status: Accepted

Country: SPAIN
Registration number: 1.519.031
Status: Accepted

Country: AUSTRIA
Registration number: 147.823
Status: Accepted

Country: UNITED KINGDOM
Registration number: 1.363.284
Status: Accepted

Country: UNITED KINGDOM
Registration number: 2.008.517
Status: Accepted

Exhibition priority

No entry for application number: 000277517

Priority

No entry for application number: 000277517.

Publication

Bulletin no.: 1998/070
Date of publication: 14/09/1998
Part: A.1

Bulletin no.: 1999/068
Date of publication: 30/08/1999
Part: B.2

Bulletin no.: [+2006/040](#)
Date of publication: 02/10/2006
Part: D.1

Opposition

No entry for application number: 000277517.

Cancellation

No entry for application number: 000277517

Appeals

No entry for application number: 000277517.

Records

Title: Representative
Sub-title: Change of name and professional address
ID No: 000282361

Title: Representative
Sub-title: Replacement of representative
ID No: 000512486

Title: Representative
Sub-title: Change of name and professional address
ID No: 000805484

Renewals

Expiry Date: 08/07/2016
Status of renewal: Renewed
Type of renewal: Total

History of status (Glossary)	Status date
Renewed	06/08/2006
Renewal fee paid	31/07/2006
Renewal request received	20/02/2006
Need to renew communicated	11/12/2005

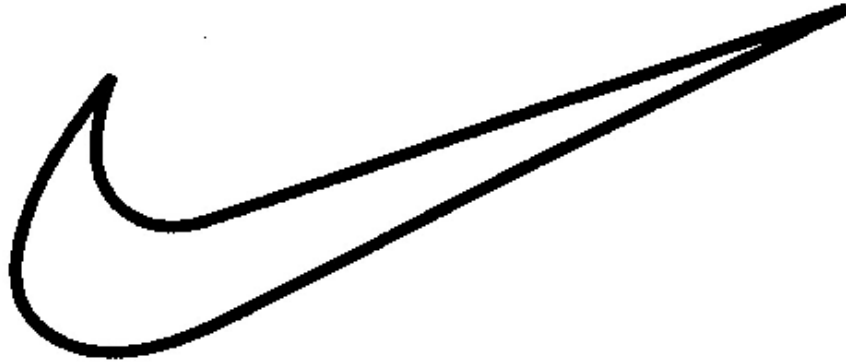
Trade mark name : Not a word mark
Trade mark No : 000277632
Trade mark basis: CTM
Number of results: 1 of 1



Trade mark

Filing date: 08/07/1996
Date of registration: 19/11/1998
Expiry Date: 08/07/2016
Nice Classification: 18, 25, 28 ([↗ Nice classification](#))
Trade mark: Individual
Type of mark: Figurative
Vienna Classification: 26.11.1, 26.11.6, 26.11.97 ([↗ Vienna Classification](#))
Acquired distinctiveness: No
Your reference: MC 026
Status of trade mark: [CTM registered](#) ([↗ Glossary](#))
([↗ History of statuses](#))
Filing language: Spanish
Second language: English

Graphic representation



List of goods and services

Nice Classification:	18
List of goods and services	Leather and leather imitations, products from these materials not included in other classes; furs; trunks and suitcases; handbags and bags; umbrellas, parasols and walking sticks; riding whips and harness.
Nice Classification:	25
List of goods and services	Clothes, Shoes, Hats.
Nice Classification:	28
List of goods and services	Games, toys; gymnastics and sport items not included in other classes; decorations for Christmas's trees.

Description

Description of the mark:	It is made by an irregular geometrical design, on a white background, one of its edges showing a curved form shaped like a thick and short hook finishing by a sharp point; the same portion shaped like a hook is being prolonged towards the opposite edge, by means of a long section which is gradually getting thinner, finishing by a point..
---------------------------------	---

Owner

Name:	Nike International Ltd.
ID No:	207
Natural or legal person:	Legal entity
Address:	One Bowerman Drive
Post code:	97005-6453
Town:	Beaverton,
Country:	UNITED STATES
Correspondence address:	Nike International Ltd. One Bowerman Drive Beaverton, Oregon 97005-6453 ESTADOS UNIDOS (EE UU)

Representative

Name:	Mario De Justo Bailey
ID No:	4803
Address:	Paseo de la Castellana, 128
Post code:	28046
Town:	Madrid
Country:	SPAIN
Correspondence address:	Mario De Justo Bailey Paseo de la Castellana, 128 E-28046 Madrid ESPAÑA

Telephone: 914111668
Fax: 914113091
E-mail: jp@jacobacciandpartners.es

Seniority



Country:	BENELUX
Registration number:	357.294
Status:	Accepted
Country:	BENELUX
Registration number:	329.982
Status:	Accepted
Country:	DENMARK
Registration number:	3451/76
Status:	Accepted
Country:	DENMARK
Registration number:	525/80
Status:	Accepted
Country:	FINLAND
Registration number:	72.993
Status:	Accepted
Country:	FINLAND
Registration number:	83.631
Status:	Accepted
Country:	GREECE
Registration number:	63.006
Status:	Accepted
Country:	IRELAND
Registration number:	94.193
Status:	Accepted
Country:	IRELAND
Registration number:	96.879
Status:	Accepted
Country:	IRELAND
Registration number:	96.879
Status:	Accepted
Country:	PORTUGAL
Registration number:	202.157
Status:	Accepted
Country:	PORTUGAL
Registration number:	201.296
Status:	Accepted
Country:	SPAIN
Registration number:	899.850
Status:	Accepted
Country:	SPAIN
Registration number:	899.851
Status:	Accepted
Country:	AUSTRIA
Registration number:	91.144

Status:	Accepted
Country:	FRANCE
Registration number:	1.533.029
Status:	Accepted
Country:	GERMANY
Registration number:	932.811
Status:	Accepted
Country:	GERMANY
Registration number:	1.014.901
Status:	Accepted
Country:	GERMANY
Registration number:	643.135
Status:	Accepted
Country:	ITALY
Registration number:	374.859
Status:	Accepted
Country:	ITALY
Registration number:	299.504
Status:	Accepted
Country:	ITALY
Registration number:	461.068
Status:	Accepted
Country:	SWEDEN
Registration number:	158.679
Status:	Accepted
Country:	SWEDEN
Registration number:	170.177
Status:	Accepted
Country:	UNITED KINGDOM
Registration number:	B1.093.758
Status:	Accepted
Country:	UNITED KINGDOM
Registration number:	B1.021.357
Status:	Accepted

Exhibition priority

No entry for application number: 000277632

Priority

No entry for application number: 000277632.

Publication

Bulletin no.:	1998/019
Date of publication:	16/03/1998
Part:	A.1
Bulletin no.:	1999/011
Date of publication:	22/02/1999
Part:	B.2

Bulletin no.: [+2006/040](#)
Date of publication: 02/10/2006
Part: D.1

Opposition

No entry for application number: 000277632.

Cancellation

No entry for application number: 000277632

Appeals

No entry for application number: 000277632.

Records

Title: Representative
Sub-title: Change of name and professional address
ID No: 000282361

Title: Representative
Sub-title: Replacement of representative
ID No: 000512486

Title: Representative
Sub-title: Change of name and professional address
ID No: 000805484

Renewals

Expiry Date: 08/07/2016
Status of renewal: Renewed
Type of renewal: Total

History of status (Glossary)	Status date
Renewed	06/08/2006
Renewal fee paid	31/07/2006
Renewal request received	20/02/2006
Need to renew communicated	11/12/2005

Trade mark name : Not a word mark
Trade mark No : 004288486
Trade mark basis: CTM
Number of results: 1 of 1

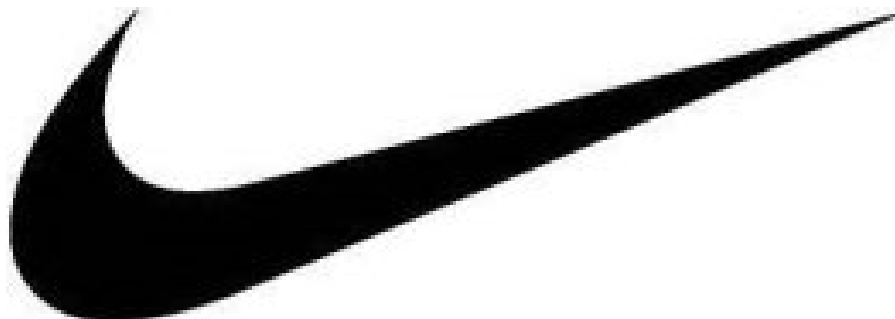


Trade mark



Filing date: 12/03/2005
Date of registration: 08/02/2006
Expiry Date: 12/03/2015
Nice Classification: 9, 14, 18, 25, 28 ([Nice classification](#))
Trade mark: Individual
Type of mark: Figurative
Vienna Classification: 26.11.1, 26.11.12 ([Vienna Classification](#))
Acquired distinctiveness: No
Your reference: BKCD
Status of trade mark: [CTM registered](#) ([Glossary](#))
([History of statuses](#))
Filing language: English
Second language: French

Graphic representation



List of goods and services



Nice Classification: 9
List of goods and services Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; 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; fire-extinguishing apparatus including eyewear, including

sunglasses, lenses, frames and cases; prescription eyewear, lenses, frames and cases, swimming goggles, ear plugs for swimming, nose clips for swimming, face masks for swimming, helmets for sports; computer hardware and software; global positioning systems; personal digital audio equipment, including portable digital music players, radio link watches and two-way radios; parts and fittings for all the aforesaid goods; cellular telephones; video game software; compact disc players; headphones; specialty carrying cases for cellular telephones, portable digital audio equipment, and compact disc players; pedometers; portable televisions and DVD's.

Nice Classification:
List of goods and services

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 including watches of all types, altimeters, compasses, pedometers, speed distance monitors with speed sensor and heart rate monitors, all being parts of watches; chronographs; stopwatches; jewellery and lapel pins; parts and fittings for all aforesaid goods.

Nice Classification:
List of goods and services

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 including bags; all purpose sports bags, duffle bags, backpacks, waist bags, fanny packs, shoe bags, purses, handbags, tote bags, shoulder bags, suitcases, luggage, bookbags, wallets, travel kits, computer bags, ball bags.

Nice Classification:
List of goods and services

25
Clothing, footwear, headgear.

Nice Classification:
List of goods and services

28
Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees including sports balls of all kinds; sporting goods, namely, golf clubs, golf balls, golf gloves, golf club grips, golf bags, golf tees, head covers for golf clubs, golf ball markers, weight lifting belts, bags specially designed for sports equipment, protective padding, guards and body protectors of all types for the practice of sports, bats, sporting gloves, swimming boards, pumps for inflating sports equipment, sports equipment for boxing and the martial arts, and other sporting equipment not belonging to other classes; games and playthings, toys, equipment for exercise.

Description

Description of the mark: No Description

Owner

Name: Nike International Ltd.
ID No: 207
Natural or legal person: Legal entity
Address: One Bowerman Drive
Post code: 97005-6453
Town: Beaverton,
Country: UNITED STATES
Correspondence address: Nike International Ltd. One Bowerman Drive Beaverton, Oregon 97005-6453 ESTADOS UNIDOS (EE UU)

Representative

Name: WYNNE-JONES, LAINE & JAMES LLP
ID No: 11536
Address: Essex Place 22 Rodney Road
Post code: GL50 1JJ
Town: Cheltenham,
Country: UNITED KINGDOM
Correspondence address: WYNNE-JONES, LAINE & JAMES LLP Essex Place 22 Rodney Road Cheltenham, Gloucestershire GL50 1JJ REINO UNIDO
Telephone: 00 44-1242515807
Fax: 00 44-1242224183
E-mail: [+email@wynne-jones.com](mailto:email@wynne-jones.com)

Seniority

No entry for application number: 004288486.

Exhibition priority

No entry for application number: 004288486

Priority

No entry for application number: 004288486.

Publication

Bulletin no.: [+2005/037](#)
Date of publication: 12/09/2005
Part: A.1

Bulletin no.: [+2006/011](#)
Date of publication: 13/03/2006
Part: B.1

Opposition

No entry for application number: 004288486.

Cancellation

No entry for application number: 004288486

Appeals

No entry for application number: 004288486.

Recordals

Title: Representative
Sub-title: Change of name and professional address
ID No: 002533407

Renewals

No entry for application number: 004288486.

