

O-131-09

In the Matter of THE TRADE MARKS ACT 1994

**In the Matter of Trade Mark Application No. 2386672
TECHNICALS in Classes 18, 20, 22 and 25
in the name of THE OUTDOOR GROUP LIMITED**

**In the Matter of Opposition No. 94503 thereto by
TECNICA SpA**

**Appeal of the Applicant from the decision of
Mr. M. Foley dated 11th August 2008**

DECISION

1. This is an appeal against a decision of Mr M Foley, the Hearing Officer for the Registrar, dated 11 August 2008, in which he upheld in part an opposition to the registration of the mark TECHNICALS. The grounds of opposition were based primarily on the Opponent's prior trade mark registration, a device form of the word TECNICA. The Hearing Officer held that the opposition succeeded in part under section 5(2)(b) of the Trade Marks Act 1994 ("the Act") and under s 5(4)(a), but rejected the grounds of opposition based on s 5(3).

Background

2. On 10 March 2005, The Outdoor Group Limited made an application to register the word trade mark TECHNICALS in Classes 18, 20, 22 and 25. For the purposes of this appeal, I need not consider the goods in Classes 20 or 22. The specification of goods in Class 18 was:

Class 18 Articles made of leather or imitation leather; articles of luggage; bags, trunks, rucksacks, knapsacks, satchels, haversacks, travel bags, backpacks, sports bags, valises, holdalls, cases; belts and straps; wallets, purses, pouches and hand bags; bags for campers and climbers; key cases; beach bags; saddlery and harnesses; parts and fittings for all of the aforesaid goods, all included in Class 18.

The specification in Class 25 was:

Class 25 Articles of clothing for men, women and children; under and outer clothing; waterproof clothing; trousers and over trousers; breeches, shorts, skirts, dresses, jackets, sleeveless jackets, shirts, tee-shirts, sweatshirts, sweaters, blouses, jumpers, cardigans, jerseys, coats, jumpsuits, tracksuits, overalls; underwear; knitwear; balaclavas, mitts and thermal underwear; belts, jeans, jog pants and blousons; sportswear; ski wear; gilets; footwear; shoes, socks, gaiters, boots and moccasins; headgear; caps, sports headgear other than helmets; hats.

3. On 21 July 2006, Tecnica S.P.A filed notice of opposition to all the goods in Classes 18 and 25 of the application, under sub-sections 5(2)(b), 5(3) and 5(4)(a). It relied upon its earlier mark No 410677, registered in Class 25 for the limited range of goods: 'Ski, mountain and après-ski footwear and sports footwear in general'. The mark is for the word "Technica" in the following form:



4. Both sides filed evidence and there was a hearing before Mr Foley on 22 January 2008, when the applicants were represented by Mr Ian Wilkes of

Groom, Wilkes & Wright LLP, their trade mark attorneys. The opponents were not represented.

Mr Foley's decision

5. Mr Foley summarised the evidence filed by each party. No criticism is made of that summary. He then considered the opposition based upon s 5(2)(b). He summarised in the usual way the ECJ's guidance on the assessment of the likelihood of confusion as set out in a number of cases from *Sabel BV v Puma AG* [1998] RPC 199 onwards. At paragraph 24 of his decision he said:

"24. In my view the stylization does not take away from the fact that this is the word TECNICA, and will be seen as such by the consumer. I shall write my decision on this basis, taking into account any impact and relevance of the stylization. However, in respect of the consideration of whether the opponent's earlier mark and the mark in suit are similar, I believe it must follow that if there is a finding that the words TECNICA and TECHNICALS without any other matter are not similar, it must follow that the stylized version of the opponent's earlier mark cannot be either."

6. Mr Foley then referred to the decision of Mr Simon Thorley sitting as the Appointed Person in *React* trade mark [2000] R.P.C. 285, to the effect 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." Mr Foley commented:

"25. 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 the trade marks are encountered by the consumer, particularly at the point at which the purchase is made, is an important consideration. That said, the matter must be considered by applying an assessment of all

relevant factors. This should be balanced by the decision of the CFI in *Devinlec Développement Innovation Leclerc SA v OHIM* (Case T- 147/03) in which they stated that a conceptual difference between the marks at issue may be such as to counteract to a large extent any visual and aural similarities between the signs. However, this requires at least one of the marks to have a clear and specific meaning so that the public is capable of grasping it immediately.”

7. Applying that guidance to the facts of this case, Mr Foley continued:

“26. The earlier mark relied upon by the opponents consists of the word TECNICA, albeit stylised, but as I have already said, for the purposes of comparison I will first consider the issue as though the word was in plain font. There is no element of TECNICA or TECHNICALS, negligible or otherwise, that could be considered dominant, so the question is whether the marks as a whole are similar.

27. In a visual comparison it is self-evident the words TECNICA and TECHNICALS are not identical, but what is just as clear is that they have a substantial part in common. The similarity resides [it] in the beginning of the applicant’s mark, a position generally accepted to be of most significance in a comparison. That the opponent’s mark is shorter in length will be apparent to anyone who studies the respective marks side-by-side. That the difference in construction is but one letter in the body of the applicant’s mark (which could easily be overlooked) and two letters at the end (the least important part) could lead to the view that these marks are visually similar. It is, however relevant to consider the impression that the respective words convey to the consumer as I believe this will influence what they see when encountering the words.

28. As can be seen from Exhibits IW8 the word TECHNICAL is an ordinary English word, but as far as I can see cannot be pluralized into the word TECHNICALS. The word TECHNICAL is in fairly common use in the UK,

with a meaning that I consider will be well known to the relevant public. ... they will still see TECHNICAL when TECHNICALS is used in connection with the relevant goods. I am personally aware that "TECHNICAL" is used to describe clothing for protection against extreme conditions, such as is encountered in mountaineering or fire protection, but without supporting evidence I cannot take this as being within the knowledge of the relevant consumer. To me the meaning of TECHNICAL or TECHNICALS will be understood, but not to have any descriptive relevance for goods such as luggage and clothing.

29... I do not think that the word is all but the word TECHNICAL will escape the notice of the consumer.

30. ... it seems to me that the conceptual message must be the same.

31. ... adding the letters "LS" to TECNICA does not significantly change the ending. ... the words TECNICA and TECHNICALS will sound very similar.

32. I consider the marks TECNICA and TECHNICALS to have visual similarities, and to be aurally and conceptually similar. On balance, I consider these to be similar marks."

8. Having found the marks to be similar in that manner, Mr Foley went on to consider whether the opponent's mark had acquired an enhanced reputation by use. He concluded at paragraph 39:

"Balancing these facts I come to the conclusion that the opponents have a reputation for TECNICA established in connection with ski-boots and certain accessories and tools for these goods. In respect of any other goods for which use has been claimed, the trade appears to have been too small to have established any significant reputation, let alone one that could be said to justify greater protection than would otherwise be afforded."

9. The Hearing Officer then went on to consider the identity or similarity of the relevant Class 18 and Class 25 goods. He found:

"40. ... Being the same class as the "footwear" for which the earlier mark has been registered and used, the question is whether the application explicitly or implicitly mentions the same or similar goods. The term "clothing" covers all items of clothing including "footwear", so the terms "Articles of clothing for men, women and children" and "outer clothing" must constitute the same or similar goods. The term "waterproof clothing" would encompass "waterproof footwear" so that term must also be considered to contain the same or similar goods, likewise the terms "sportswear" and "ski wear". Clearly the descriptions "footwear", "shoes", "boots" and "moccasins" are all identical goods to those of the opponent's earlier mark. "Socks" can have a sole affixed so in my view are capable of being similar goods to "footwear", or are at the very least, closely allied. The same is true in the case of "gaiters" which are worn as an extension to "footwear". The remainder of the goods in this class, are not the same or similar to those covered by the opponent's earlier mark and for which they have shown use.

41. In answering the question of whether the goods in Class 18 of the application are the same or similar to the footwear covered by the opponent's earlier mark and for which they have shown use, I propose to look to the guidelines formulated by Jacob J in *British Sugar ...*

42. ...in view of the *Canon* judgement the *Treat* case may no longer be wholly relied upon, ... the factors ... (... listed in *Treat*) are still relevant in respect of a comparison of goods:

"23. ... all the relevant factors relating to those goods or services themselves should be taken into account. Those

factors include, inter alia, their nature, intended purpose and their method of use and whether they are in competition with each other or are complementary.”

...

43. Whether for particular activities such as skiing, climbing, or walking, or for general wear, footwear is an item to clothe the feet. That is not the purpose or use to which any goods in Class 18 may be put, so the only conclusion that can be reached is that the uses of the opponent’s goods and those covered by Class 18 of the application are different.

44. The opponent’s “footwear” is essentially, but not exclusively for use in sporting activities, namely skiing, or for wear in outdoor or winter pursuits. These are activities engaged in by people from all walks of life. In some cases, such as the opponent’s “Moon boots”, the footwear is capable of being worn as leisurewear, and with the exception of the ski boots, is little if any different to footwear in general. The consumer of such goods notionally covers the public at large. The goods for which the applicants seek registration in Class 18 are of a general and everyday nature; they are not stated to be specialised in any way. They are capable of being for use by all, and by the same sectors of the buying public as the opponent’s footwear.

45. As far as the physical nature of the respective goods is concerned, there is, in my view a close correlation here. With the exception of ski boots, footwear of whatever type is generally made from leather or imitations of leather, which self-evidently is what part of the specification in this class covers, so the goods are similar in this respect.

46. I have no evidence which goes to the markets and trading patterns of the respective goods. However, these are fairly ordinary

items which every person will at some time use or come into contact with, and as such, personal knowledge can be an adequate substitute for evidence.

47. From my own experience I know that it is not unusual for traders in clothing to also trade in complementary fashion items such as handbags, which are often sold as a matching accessory to footwear. However, that is not the case in respect of the sports and outdoor footwear for which the opponents have used the mark. That said, there is a genus of goods such as sports holdalls, backpacks, etc, that would be sold alongside such footwear. They may not be sold on the same shelves, but being goods for use in the same activity are likely to be displayed on shelves or in areas in reasonably close proximity.

48. My conclusion is that the goods in Class 18 of the application that are for use in outdoor pursuits are likely to share the same channels of trade at the retail end ... At the very least I would consider the opponent's footwear and the goods I have mentioned in Class 18 of the application to be complementary. They are, however bought in addition to rather than as an alternative so I do not consider them to be in any way competitive.

49. Based on the above reasoning, I take the view that the following goods are similar to the opponent's goods in Class 25:

"Articles of luggage; bags, rucksacks, knapsacks, satchels, haversacks, travel bags, backpacks, sports bags, holdalls, cases; bags for campers and climbers; parts and fittings for all of the aforesaid goods."

50. The term "Articles made of leather or imitation leather" notionally covers all of the above so also contains similar goods.

51. So I reach the conclusion that there is identity or similarity in respect of some of the goods in both Class 18 and Class 25 of the application.

52. Balancing all of the factors and adopting the global approach advocated, I take the view that the similarities are such that use of the marks applied for will lead to confusion, and particularly so when the possibility of imperfect recollection is taken into account. The opposition under Section 5(2)(b) therefore succeeds in respect of the following goods:

Class 18 Articles made of leather or imitation leather; articles of luggage; bags, rucksacks, knapsacks, satchels, haversacks, travel bags, backpacks, sports bags, holdalls, cases; bags for campers and climbers; parts and fittings for all of the aforesaid goods.

Class 25 Articles of clothing for men, women and children; outer clothing; waterproof clothing; sportswear; ski wear; footwear; shoes, socks, gaiters, boots and moccasins.

10. The Hearing Officer, having rejected the opposition based upon s 5(3), went on to consider the opposition under s 5(4)(a). He referred to a number of authorities, including *Wild Child* [1998] R.P.C. 455 and continued:

"72. ... there cannot be any doubt that the opponents are the owners of the goodwill in the TECNICA mark established through the use by the succession of distributors. Whilst the opponent's use in relation to goods beyond ski boots and parts/accessories appears to be small, but does not mean that [they] do not have any goodwill. This goes no wider than their reputation which I have already taken account of ... the position is different in respect of passing off, where the goodwill can extend into different areas

of trade, more particularly, to a field of activity that is a natural extension of the opponent's trade. When this is the case, damage is likely to be inferred even where the opponent has shown no present intention of trading in that area (*Eastman Photographic Materials Co Ltd v John Griffiths Cycle Corporation Ltd (1898)* 15 R.P.C. 105).

73. In this case, it is clear that the applicants are not just seeking to register their mark in an area that is a natural progression from that in which the opponents have traded; there is evidence they are in an area where the [opponents] have been trading in for some time and have established goodwill. In this I am referring to the various items of outdoor clothing beyond footwear."

11. As a result, the Hearing Officer found that in addition to the goods already excluded from registration by reason of his findings under section 5(2)(b), numerous items of clothing should be excluded by reason of s 5(4)(a).

Standard of review

12. The standard of review for this appeal is helpfully set out at paragraphs 5-6 of the decision of Daniel Alexander QC in *Digipos Store Solutions Group Limited v. Digi International Inc.* [2008] EWHC 3371, [2008] Bus. L.R. 1621:

"5... It is clear from *Reef Trade Mark* [2003] RPC 5 ("*Reef*") and *BUD Trade Mark* [2003] RPC 25 ("*BUD*") that neither surprise at a Hearing Officer's conclusion nor a belief that he has reached the wrong decision suffice to justify interference by this court. Before that is warranted, it is necessary for this court to be satisfied that there is a distinct and material error of principle in the decision in question or that the Hearing Officer was clearly wrong (*Reef*). As Robert Walker LJ (as he then was) said:

“...an appellate court should in my view show a real reluctance, but not the very highest degree of reluctance to interfere in the absence of a distinct and material error of principle” (Reef, para. 28)

6. This was reinforced in *BUD*, where the Court of Appeal made it clear that it preferred the approach of the appellate judge but nonetheless held that there was no error of principle justifying departure from the Hearing Officer’s decision. As Lord Hoffmann said in *Biogen v. Medeva* [1997] RPC 1 at 45, appellate review of nuanced assessments requires an appellate court to be very cautious in differing from a judge’s evaluation. In the context of appeals from the Registrar relating to section 5(2)(b) of the Act, alleged errors that consist of wrongly assessing similarities between marks, attributing too much or too little discernment to the average consumer or giving too much or too little weight to certain factors in the multi-factorial global assessment are not errors of principle warranting interference.”

The decision with regard to each of the issues in this case involved a multi-factorial assessment of the kind mentioned above.

Similarity of the marks

13. The first ground of appeal is that the Hearing Officer failed to take any or any sufficient account of the stylisation of the opponent’s earlier mark. As set out above, in paragraph 24 of his decision the Hearing Officer indicated that he would do that after first considering whether the words *TECNICALS* and *TECNICA* were similar, ignoring the stylisation. He went on to consider of the similarity of the marks on a visual, conceptual and aural basis, and concluded in paragraph 32 that the marks had visual similarities and were aurally and conceptually similar. However, there is no

indication in that paragraph or elsewhere in his decision that his view that the marks were visually similar arose from a consideration of the stylised form of the earlier mark. If Mr Foley did take undertake an assessment of the visual similarities between the mark applied for and the registered form of the opponent's mark, unfortunately he did not set out the reasoning underlying his conclusion.

14. It seems to me that Mr Foley was perfectly entitled to approach the question of whether the marks were similar in the way set out in paragraph 24 of his decision. However, as far as one can see from the decision, he failed to return to the issue of the visual similarity of the marks, as he had indicated that he would do. This seems to me to be a distinct and material error in his decision requiring me to revisit this aspect of the opposition.
15. Mr Malynicz argued on behalf of the applicant not only that the stylisation of the opponent's mark was significant, in making the word difficult to read, and giving it a real distinction from the applicant's word mark in a notional simple font, but also that I should take care not to confer "word only" protection on a heavily stylised mark.
16. As to the impact of the stylisation of the mark in this case, it seems to me that the particular typeface used does not disguise the fact that the mark essentially consists of the word TECNICA. I do not think that the average consumer would have any difficulty in seeing and reading that word in the stylised form of the registered mark. Furthermore, the significance of the use of the particular font does not seem to me to be particularly great, as the font is not particularly unusual or artistic and only moderately memorable. To the extent that the Hearing Officer did consider the impact of the stylisation of the mark at paragraph 24, he thought that it did not

detract from the fact that the prominent part of the mark is the word. I agree. Even taking into account the stylisation, it seems to me that there is some level of visual similarity between the marks.

17. As to the policy point, I do not consider that this can be carried very far. In my view, the fact that the mark may (or may not, I do not know) only have been capable of being registered by virtue of its visual elements does not alter the fact that the extent of any visual similarity to the later mark is just one element of the global assessment of the likelihood of confusion. As numerous cases show, a word mark can perfectly well be compared with a figurative mark: see e.g. Case T-363/06, *Honda Motor Europe Limited v. OHIM* (9 September 2008). Moreover, I take account of the view expressed by Jacob LJ in *Phones 4u Ltd v. Phone4u.co.uk. Internet Ltd* [2007] R.P.C. 5, at paragraph 78, where he said:

“... Can one say, because the mark is a logo, ... that the mere words “phone4u.co.uk” cannot infringe? One can heighten the point by asking whether the words “Phones 4u” simpliciter would infringe?

79 If one were starting trade mark law all over again there would be something to be said for this. If you need to put words in a device to get them registered you ought not to be allowed later (unless there is later acquired distinctiveness) to say the words alone infringe. ...

80 But one is not starting trade mark law now. ... Once a mark has got on the register, ... The only question here is that posed by Art.5(1)(b)--confusing similarity. That involves an overall (global) comparison of the registered mark with the alleged infringement. If one undertakes that here, a clear, prominent and memorable part of the registered mark is the words as such. ...”

18. The next ground of appeal was that the Hearing Officer's analysis of the aural similarities between the marks was flawed. It does not seem to me, however, that the applicant identified any error of principle on the part of the Hearing Officer in this respect. It seems to me that the Hearing Officer was perfectly entitled to reach the conclusion that he did as to the aural similarities between the marks. I see no reason to revisit that part of his decision, and in any event I would have come to the same conclusion on this point.
19. Similarly, it was said that the Hearing Officer had failed properly to analyse the conceptual similarities between the marks, or rather, that he had found conceptual similarity where none existed. The grounds of appeal suggested that the Hearing Officer failed to apply the "rule of counteraction" in assessing the conceptual similarities between the marks. I do not think that he did fail to apply that rule, which arises out of ECJ Case C-206/04, *Mülhens GmbH & Co KG v. OHIM* [2006] E.T.M.R. 57, a case to which the Hearing Officer specifically referred in paragraph 25 of his decision. Moreover, it does not seem to me that the rule is of any help to the applicant in this case, because there is *no* conceptual difference between the marks at issue here – both make some allusion to the technical qualities of the marked goods.
20. The appellant next argued that both of these marks are essentially descriptive, making reference to the "technical" attributes of the goods on which they are used. That being so, it was said, the small differences between them would be sufficient to distinguish them. The argument is based upon the well-known line of passing off cases such as the *Office Cleaning* case (1946) 63 R.P.C. 30, considered by Jacob LJ in relation to the assessment of likelihood of confusion in trade mark cases in *Reed Executive plc v. Reed Business Information Ltd* [2004] R.P.C. 40 (at

paragraphs 84-5). Jacob LJ explained that where a mark is largely descriptive, small differences may suffice for the consumer to distinguish one from the other “because where you have something largely descriptive the average consumer will recognise that to be so, expect others to use similar descriptive marks and thus be alert for detail which would differentiate one provider from another.” Mr Malynicz sought to persuade me that the Hearing Officer had said that these marks were descriptive. On reflection, however, he agreed that was not what was said in paragraph 29. Nonetheless, he argued both marks had such strongly allusive characteristics in referring to the technical functions of the clothing that I should apply the *Office Cleaning* principles. I do not consider that it would be right to do so on the facts of this case. Neither of these marks appears to me to be completely or even “largely” descriptive. Both are merely allusive or laudatory in nature rather than descriptive in any real sense. In the circumstances, I do not accept that the small differences between them would overcome their conceptual similarity and alert consumers to the differences between them.

21. Mr Malynicz also sought to persuade me that the visual element of the mark was a particularly important, indeed “paramount,” factor, given the nature of the goods concerned. He relied upon the *React* case to which the Hearing Officer referred at paragraph 24 of his decision. It seems to me that the later decisions of the CFI in *Claudia Oberhauser* and of the High Court in *Criminal Clothing* (both of which decisions were also considered by Mr Foley) show that one should not treat *React* as if Mr Thorley QC had meant to lay down a rule giving such importance to the purely visual aspect of a mark used on clothing as to ignore the other factors relevant to the global appreciation of likelihood of confusion. It is generally accepted that the public is accustomed to seeing marks used in different “configurations” especially with the use of “sub-brands” in the

clothing field. This is a factor which may, it seems to me, reduce the impact of upon members of the general public (who are the likely customers for such goods) of the visual differences between otherwise similar marks (see e.g. comments at paragraphs 49-50 of *Claudia Oberhauser*.) Further, I note the comment made by Mr Christopher Floyd QC (as he then was) in the *Criminal Clothing* case at paragraph 26:

“... in the *React* case Mr Thorley QC, having concluded that there was some aural similarity, went on to hold that there was no visual or conceptual similarity. It is also noteworthy that he compared the conceptual similarity of the words themselves, as opposed to the entire marks. Furthermore he expressly declined to come to a conclusion as to whether there was a likelihood of confusion in aural use until he had considered conceptual similarity of the words. His decision is therefore, in my judgment, entirely consistent with an approach which allows the court to consider, in the context of aural use, and even in a clothing case, the combined effect of the aural and conceptual similarities of the words alone even where one of the marks has a complex and distinctive device element.”

22. As a result, I think that it would be wrong to treat the question of the visual similarities of the marks as the “paramount” issue here. It is one factor in the assessment of similarity/likelihood of confusion amongst others, albeit possibly an important one in relation to clothing or many Class 18 goods. I consider that there are strong aural and conceptual similarities between the signs in this case, as well as a lesser visual similarity. For these reasons, even if the visual aspect of a mark may be important in the context of the relevant goods, I arrive at the same conclusion as the Hearing Officer, namely that the marks are similar. Indeed, in my view, they are strongly similar.

Similarity of goods

23. The grounds of appeal next complained of the manner in which the Hearing Officer considered the question of the identity/similarity of the respective goods and said that Mr Foley erred in his approach to the Class 25 goods. Mr Foley identified particular goods (footwear of various types) which he said were identical to those in the opponent's specification, and the appellant does not quarrel with that analysis. The problem is in his approach to the assessment of the similarity of other Class 25 goods to those in the opponent's specification.

24. The appellant complained that in paragraph 40 of the decision, Mr Foley appears to have assumed that all goods in Class 25 would be at least similar to the goods in the earlier mark's (footwear) specification and he did not analyse that similarity by reference to the criteria from *Treat* or *Canon* as he felt it necessary to do in respect of the Class 18 goods at issue. The essential part of *Canon* in this respect is found at paragraph 23 of the judgment of the ECJ:

"23. In assessing the similarity of the goods or services concerned, ... all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their end users and their method of use and whether they are in competition with each other or are complementary."

'Complementary goods' has since been given a reasonably restricted meaning, in that complementary goods are those which are closely connected in the sense that one is indispensable or important for the use of the other, so that consumers may think that the same undertaking is responsible for both. The fact that consumers regard a product as a complementary to or as an accessory for another does not necessarily mean that they will believe that those products have the same commercial

origin; to show the necessary level of “complementarity”, they must think it *normal* for that to be the case and this may depend upon the sectors concerned. See CFI Case T-169/03 *Sissi Rossi* [2005] ECR II-685, paragraphs 60-64 and now the approval in Case C-398/07 P (7 May 2009) by the ECJ of the views of the CFI on complementarity in Case T-105/05: *Assembled Investments v OHIM - Waterford Wedgwood* [2007] ECR II-60.

25. I agree that it is difficult to discern the reasoning by which Mr Foley concluded that some items of clothing were similar to the opponent’s specification of goods, but others were not, especially given his reference to certain goods being “the same or similar”. Possibly he felt it unnecessary to carry out the usual analysis, because all of the goods are in the one class, as the appellant suggested. Alternatively, he may have carried out an appropriate analysis but failed to set out his reasoning in full. In any event, it seems to me that he failed to identify precisely which goods he considered to be identical to those in the opponent’s specification, as opposed to those which he thought were similar to them. For these reasons, it seems to me that this error or lack of explanation requires me to revisit this aspect of the opposition too.

26. The opponent’s mark is registered for ‘Ski, mountain and après-ski footwear and sports footwear in general’. The appellant conceded that footwear, shoes, boots, and moccasins in its specification are all identical to those goods. However, no concession was made as to any of the items of clothing in the specification. Mr Malynicz objected that the opponent had not adduced any evidence as to the similarity of the goods applied for to the clothing in its specification, despite paragraph 22 of *Canon* which provides: “for the purposes of applying Article 4(1)(b), even where a mark is identical to another with a highly distinctive character, it is still

necessary to adduce evidence of similarity between the goods or services covered." In particular, he argued that one cannot assume that because the opponent's own brochures show that it sells a particular combination of goods, that necessarily means that such goods are similar according to the appropriate criteria, especially where (as appears to be the case here) the opponent has not succeeded in penetrating the market in the UK with its complete range of goods.

27. Mr Geoffrey Hobbs QC sitting as the Appointed Person said in *Raleigh International trade mark* [2001] R.P.C. 11 at paragraph 20, that such evidence will be required if the goods or services specified in the opposed application for registration are not identical or self-evidently similar to those for which the earlier trade mark is registered. But where there is self-evident similarity, and especially in relation to everyday items such as those in the Class 25 specifications of each party here, evidence may not be necessary. The tribunal may, in an appropriate case, consider the question of similarity from the viewpoint of the notional member of the relevant purchasing public. That approach is taken in OHIM, and appears to be accepted as appropriate practice by the CFI, see e.g. Case T-185/02 *Ruiz-Picasso and Others v. OHIM – DaimlerChrysler (PICARO)* [2004] ECR II- 1739, paragraph 29:

"According to the case-law, the restriction brought about by Article 74(2) of Regulation No. 40/94, according to which, in proceedings relating to relative grounds for refusal of registration, OHIM's examination is restricted to the facts, evidence and arguments provided by the parties and the relief sought, does not preclude it from taking into consideration, in addition to the facts expressly put forward by the parties to the opposition proceedings, facts which are well known, that is, which are likely to be known by anyone or which may be learnt from generally accessible sources."

28. It does not seem wrong to me for a tribunal to take into account factors which may be accepted as a matter of judicial notice, such as everyday facts about the way in which ordinary consumer goods are sold and purchased. In addition, there are numerous CFI decisions which indicate that clothing and footwear may be similar goods, such as Case T-115/02, *AVEX Inc v OHIM* [2005] E.T.M.R 30 and, more recently Case T-96/06, *Tsakiris-Mallas AE v OHIM* (10 September 2008). I note that in *Avex*, at paragraph 26, the CFI found that clothing was similar to footwear and boots “even if they are so only in a limited way”. That finding was made in the absence of evidence to that effect, on the basis of the respective purposes of the goods, and the possibility that they might be produced by the same operators or sold together, which might lead to a link in the mind of the public.
29. Here, the opponent merely provided evidence as to the sort of shops and distribution channels through which its own goods are sold, which predictably is mainly through specialised ski and outdoor shops, such as the “Snow & Rock” chain. That information, whilst not conclusive in any way, in my view helps in the assessment of the similarity of the relevant goods, according to the *British Sugar/Canon* criteria and supports the expectation that such goods would be sold in such retail outlets.
30. Comparing the somewhat specialist footwear in the opponent’s specification with the numerous items of clothing in the applicant’s Class 25 specification, and doing the best I can in the absence of specific evidence about the similarity of individual items, it seems to me:
- a) The respective nature or use of the goods is not the same – they are not “substitutable”. On the other hand, (as the

cases mentioned above have found) all of them have the same wider purpose, namely to clothe parts of the body;

- b) The end users in each case are ordinary consumers;
- c) The 'method of use' is the same;
- d) The goods are not in competition with each other; they may be complementary to some extent, (e.g. ski wear and gaiters are likely to be worn with ski boots) but in the absence of evidence to that effect, I do not think that I am in a position to find that they are complementary in the strict sense discussed above;
- e) They may in some cases be sold through the same channels of distribution. Again, this suggests a greater level of similarity for clothing designed to be worn with the opponent's specialist, sporting footwear, than for more general categories of clothing.

31. All in all, it seems to me that there is some level of similarity between the opponent's footwear items and some of the appellant's items of clothing. Without specific evidence as to the similarity of particular items, I do not consider that I can make a finding of similarity to the opponent's goods in respect of skirts, dresses, blouses, belts or jeans. The rest of the items in my view are similar to a greater or lesser degree, from slightly similar (e.g. knitwear) to the much more similar items of clothing likely to be worn with and sold alongside sports footwear (e.g. waterproof clothing, sportswear, ski wear, and sports headgear, socks and gaiters). In this regard, as I have indicated above, I take account of the fact that the opponent's goods are (as the ordinary consumer would expect) sold in specialist retailers, and alongside related items of clothing.

32. An additional point to bear in mind is that it is accepted by the appellant that Mr Foley was right to find (at paragraph 39) that the opponent has a well-established reputation for TECHNICA in respect of ski boots.
33. The interdependence of the various factors in the global assessment of a likelihood of confusion means that the greater degree of similarity I have found between the marks may compensate for a lesser similarity between the various goods in Class 25. Moreover, the likelihood of confusion includes a likelihood of association in the sense that the public would mistakenly believe the goods under the later mark to be further goods in the range of the proprietor of the earlier mark (*Canon*, paragraphs 29-30) especially in the clothing sector where the public is used to seeing sub-brands (*Claudia Oberhauser* at paragraph 49). For all of these reasons, it seems to me that there would be a likelihood of confusion for the purposes of section 5(2)(b) if the appellant's application proceeded in respect of waterproof clothing, sportswear, skiwear, socks, gaiters, and sports headgear other than helmets, as well as the footwear, shoes, boots and moccasins conceded by the appellant. A number of goods in the list such as over-trousers, thermal underwear and tracksuits are on the borderline, in my view, and it seems right to me not to exclude them from the specification in the absence of evidence from the opponent. However, it seems to me that it is also correct to exclude the general terms "articles of clothing for men, women and children," and "headgear" and "hats" which would otherwise include the items which ought in my view to be excluded from the specification. In the event, it will be seen that I have come to a similar conclusion to that of the Hearing Officer.
34. In assessing the likelihood of confusion in relation to the goods for which registration is sought in Class 18, the Hearing Officer referred to the principles in *British Sugar* and *Canon*. In this respect, therefore, the appellant could not and did not appeal on the basis that the Hearing

Officer had failed to apply the correct principles. Instead, it appealed against his findings on the basis that the Hearing Officer misapplied the law, and in particular complained that he had come to his conclusions in the absence of evidence of similarity.

35. As the Hearing Officer pointed out at paragraph 46 of his decision, the Class 18 goods in consideration are ordinary, everyday items, so that what he termed “personal knowledge” can be relied upon in making the assessment of similarity. I do not disagree, for the reasons given above. Again, the similarity of Class 25 and Class 18 goods has been considered in a number of the cases, and some similarities found to exist, see e.g. two cases of *El Corte Ingles S.A. v OHIM*, Case T-443/05 and Case T-8/03.
36. The appellant objected to the Hearing Officer’s reference to “complementary fashion items” in paragraphs 47 and 48 of his decision, for the reasons discussed above, and on the basis that it would be wrong to find “aesthetic complementarity” without evidence that it exists in a particular field. I do not think that the Hearing Officer based his decision upon “aesthetic” complementarity, but upon the likelihood that “sports holdalls, backpacks, etc” would be sold alongside items of sports footwear in the same retail outlets, as goods likely to be used effectively as accessories for the opponent’s footwear, in the field of outdoor pursuits. In my judgment, he meant no more than that by his comments in paragraph 48, given the first sentence of paragraph 47 of the decision. Furthermore, it is clear that the Hearing Officer excluded the broader categories of goods (such as ‘articles of luggage’) because he considered that they comprised the more specific items which he considered carried a likelihood of confusion.

37. Certain of the goods which the Hearing Officer concluded were similar to the opponent's goods may have only a low level of similarity to them. As a result, I might have reached a different conclusion to the Hearing Officer on the likelihood of confusion in respect of some of those goods. However, it seems to me that there is no error in his reasoning which would make it appropriate for me to revisit his conclusions in this respect.

Section 5(4)(a)

38. The appellant also appeals against the Hearing Officer's findings based upon s 5(4)(a), saying that there was insufficient evidence of goodwill, and none of misrepresentation or damage. In particular, the appellant submitted that the Hearing Officer was wrong to find that there would be passing off in respect of goods in categories representing 'a natural extension' of the opponent's trade.
39. In my judgment, the problem with the Hearing Officer's analysis is not so much that he had insufficient evidence of goodwill as that there is an apparent inconsistency in his findings on goodwill. First, in paragraph 72 he commented that the opponent's goodwill goes no further than the reputation that he had identified for the purposes of s 5(2). In paragraph 39 of his decision he had concluded that the opponent's evidence established use on any significant scale only in relation to ski-boots and accessories and tools for them. He assessed the opponent's evidence of use on other goods, such as clothing, which was minimal, and concluded at paragraphs 36 and 37 that such sales were unlikely to have "established any significant reputation although there would potentially be some spill-over from the core trade." Both of those conclusions were reinforced by his findings in paragraphs 64 and 65, when considering reputation for s 5(3).

40. However, in paragraph 73, the Hearing Officer said that the applicant was seeking to register its mark "in an area where the opponents have been trading in [*s/c*] for some time and have established goodwill. In this I am referring to the various items of outdoor clothing beyond footwear."
41. These two conclusions do not seem to me to be consistent. The findings in paragraph 39 seem to me to flow properly from his careful analysis of the evidence, but if, by the passage I have quoted from paragraph 73, the Hearing Officer meant to say that the opponent's goodwill extended *beyond* footwear to outdoor clothing, this seems to me to contradict his earlier findings and his view of the evidence. It seems from paragraph 73 that the Hearing Officer took the view that use of the applicant's mark in relation to goods which could be seen as 'a natural extension' of the opponent's trade should be measured not as a natural extension of the ski-boot/footwear trade, but extending from a wider trade in outdoor clothing. As a result, he found that use of the mark applied for would amount to a misrepresentation if used on a range of clothing, not limited to clothing linked to outdoor pursuits or (perhaps) just to skiing. In my judgment, the Hearing Officer made a material error in this regard, having found no goodwill arising from such wider trade in clothing.
42. In the circumstances, I think it appropriate to reconsider the position under s 5(4)(a). In my view, the Hearing Officer's findings in paragraphs 36 to 39 and 64 to 65 as to the extent of the opponent's goodwill are justified on the evidence produced by the opponent. I note that the appellant accepted that the opponent had an established goodwill for ski boots and related accessories, indeed that the opponent was a ski boot manufacturer of high repute and the largest (or one of the largest) on the market.

43. That being so, it seems to me that if the appellant used its mark upon the footwear within its specification there would plainly be a misrepresentation leading or likely to lead the public to believe that goods or services offered by the appellant are goods or services of the opponent, or goods connected in the course of trade with the opponent, leading to a likelihood of damage.
44. Equally, I consider that there would be likely to be a misrepresentation by use of the mark applied for upon certain of the goods in class 18 and some of the clothing in Class 25. In my judgment, on the limited evidence available, such goods would be restricted to goods designed for use in outdoor pursuits. Members of the public would be likely so to be misled by use of the applicant's mark upon the range of clothing I have identified in paragraph 33 above and in relation to rucksacks, knapsacks, haversacks, backpacks, sports bags, and bags for campers and climbers in Class 18. Mr Malynicz submitted that no likelihood of damage could be inferred, given the narrow field in which the opponent actually trades in the UK, but it seems to me that there could be damage either in terms of direct loss of sales or in terms of the impact upon the opponent's ability to expand its business, directly or through licensees, into closely related fields. I would therefore uphold the opposition based upon s 5(4)(a) but only for this narrower group of goods.

Conclusion

45. For these reasons, the appeal succeeds in part and essentially under s 5(4)(a). It succeeds in relation to a number of items of clothing in Class 25, but fails in respect of others. The appeal under s 5(2) in respect of the goods in Class 18 fails.

46. The result is that I find that the application may proceed to registration in Classes 18 and 25 for the following specification of goods:

Class 18: trunks, valises, belts and straps; wallets, purses, pouches and hand bags; key cases; beach bags; saddlery and harnesses; parts and fittings for all the aforesaid goods all included in Class 18.

Class 25: under and outer clothing; trousers and over trousers; breeches, shorts, skirts, dresses, jackets, sleeveless jackets, shirts, tee-shirts, sweatshirts, sweaters, blouses, jumpers, cardigans, jerseys, coats, jumpsuits, tracksuits, overalls; underwear; knitwear; balaclavas, mitts and thermal underwear; belts, jeans, jog pants and blousons; gilets; caps.

47. The Hearing Officer had ordered the applicant to pay the opponent the sum of £2,250 in respect of its costs of the opposition. In the circumstances, I am minded to order that each party shall bear its own costs of both the opposition and the appeal. However, I have not heard submissions from either side in relation to costs. If either party wishes to submit that I should award it some or all of its costs of the opposition or the appeal, they may provide me with written submissions to that effect by 5 p.m. on Friday 29 May.

Amanda Michaels
13 May, 2009

MR. SIMON MALYNICZ (instructed by Messrs. Groom Wilkes & Wright LLP) appeared on behalf of the Applicant/Appellant.

The Opponent/Respondent was not represented and made no submissions on the appeal.