

O-148-09

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 2450719
BY KANGOL LIMITED
TO REGISTER A TRADE MARK
IN CLASS 25**

**AND IN THE MATTER OF OPPOSITION THERETO
UNDER No. 95489
BY CAK TEXTILE B.V.**

BACKGROUND

1) On 26 March 2007, Kangol Ltd applied under the Trade Marks Act 1994 for registration of the following trade mark:



2) In respect of the following goods in Class 25 “Clothing; headgear; footwear; sports shoes, trainers, boots, walking boots, football boots, shoes, cycling shoes; waterproof and weatherproof clothing; thermal clothing; lightweight clothing; coats; sports clothing; jackets, anoraks, pullovers, trousers, shirts, T-shirts, cagoules, smock and salopettes; gloves, hats, balaclavas, socks, underwear and gaiters; clothing, footwear and headgear for fashion, leisure, industrial and sports purposes including tennis, squash, table tennis, softball, golf, badminton, volleyball, basketball and baseball; leisure clothing, wet suits; safety clothing, gloves, headgear and footwear (other than for protection against accidents or injuries); sports headgear (other than helmets); sportswear; sports uniforms; sporting articles (clothing) for equestrian use; fishing smocks; fishing jackets, boots and vests.”

3) On 14 September 2007 Cak Textile B.V. filed notice of opposition to the application. The ground of opposition is, in summary:

- a) The opponent is the proprietor of the following International Trade mark registration which the opponent claims is similar to that of the applicant and the goods are identical and therefore offends against Section 5(2)(b).

Mark	International Registration Date	Class	Relevant Specification
M0940001 	1 May 2007 International priority date: 07.11.06	25	Clothing (other than for protective purposes), namely clothing of combed cotton, tricot, denim, leather and paper; sports clothing, underwear, gloves, socks; footwear, namely, rubber boots, boots, slippers, baby shoes and parts thereof; shoes for sport and their spikes; shoe parts, namely soles, heels, legs, uppers; headgear, namely, hats, berets, caps, caps with a peak; special textile clothes for babies namely baby jackets, eye diapers, baby diapers (not of paper); ties, bow ties, foulards, shawls, scarves, pareos; sarongs, collars, bandanas, muffs, bands for arms, head bands [clothing]; belts [clothing], suspenders, garter belts.

4) The applicant subsequently filed a counterstatement denying that the marks and/or goods are similar.

5) Neither side filed evidence in these proceedings. Both sides ask for an award of costs. Neither side wished to be heard. Only the applicant filed written submissions which I shall refer to as and when required in my decision.

DECISION

6) The only ground of opposition is under Section 5(2)(b) which reads:

“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.”

7) An “earlier trade mark” is defined in Section 6, the relevant parts of which state:

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

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,”

8) The opponent’s International Registration was filed on 14 March 2007 and registered on 1 May 2007. However a priority dated was claimed in relation to a Turkish registration with a priority date of 7 November 2006. The Registry requested that the opponent file a copy of the Turkish registration and also provide a translation. The opponent complied with this request and the specification in Class 25 of the Turkish registration is identical to that of the International trade mark. The opponent’s mark is therefore an “earlier trade mark”.

9) In determining the question under section 5(2)(b), I take into account the following cases: *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabusiki Kaisha v Metro-Goldwyn-Mayer Inc.* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Kilsen Handel BV* [2000] 45 FSR 77, *Marca Mode CV v Adidas AG & Adidias Benelux* [2000] ETMR 723, Case C 120/04 *Medion* [2005] ECR 1-8551 and Case C 421/04 *Metratzen Concord v OHIM* [2002].

10) In essence the test under section 5(2)(b) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of

confusion I am guided by the judgments mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed. Furthermore, I must compare the applicant's mark and the mark relied upon by the opponent on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods covered within the respective specifications.

11) I shall first consider the specifications of both parties, which are as follows:

Applicant's specification	Opponent's specification
Clothing; headgear; footwear; sports shoes, trainers, boots, walking boots, football boots, shoes, cycling shoes; waterproof and weatherproof clothing; thermal clothing; lightweight clothing; coats; sports clothing; jackets, anoraks, pullovers, trousers, shirts, T-shirts, cagoules, smock and salopettes; gloves, hats, balaclavas, socks, underwear and gaiters; clothing, footwear and headgear for fashion, leisure, industrial and sports purposes including tennis, squash, table tennis, softball, golf, badminton, volleyball, basketball and baseball; leisure clothing, wet suits; safety clothing, gloves, headgear and footwear (other than for protection against accidents or injuries); sports headgear (other than helmets); sportswear; sports uniforms; sporting articles (clothing) for equestrian use; fishing smocks; fishing jackets, boots and vests	Clothing (other than for protective purposes), namely clothing of combed cotton, tricot, denim, leather and paper; sports clothing, underwear, gloves, socks; footwear, namely, rubber boots, boots, slippers, baby shoes and parts thereof; shoes for sport and their spikes; shoe parts, namely soles, heels, legs, uppers; headgear, namely, hats, berets, caps, caps with a peak; special textile clothes for babies namely baby jackets, eye diapers, baby diapers (not of paper); ties, bow ties, foulards, shawls, scarves, pareos; sarongs, collars, bandanas, muffs, bands for arms, head bands [clothing]; belts [clothing], suspenders, garter belts.

12) In their submissions the applicant states that it "... accepts that the earlier mark covers goods in Class 25 and includes goods identical to the goods covered by the alleged earlier mark". I assume that the applicant was attempting to accept that the goods of both parties were either identical or very similar. I shall proceed on this basis as, to my mind, the goods clearly are identical and/or very similar.



13) The average consumer for clothing, footwear and headgear of this generalised nature must be deemed to be the general public. In my view items of clothing etc such as those covered by the specifications of both parties are not purchased without some consideration as to the material, cut, design, quality etc. I must also take into account imperfect recollection.

14) In considering the issues I also take into account the views of Mr S Thorley sitting as the Appointed Person in the *REACT* case [2000] RPC 285 where he said:

“[*Counsel*]drew my attention to the fact that in relation to clothing of the type for which the mark is to be registered, anybody using the mark aurally would be informed to some extent of the nature of the goods they were proposing to purchase; they will therefore know of a mark; and they will know what they want. I think there is force in this in the context of purchasing clothes. The Hearing Officer was prepared of his own experience to hold that the initial selection of goods would be made by eye, and I believe this is correct. I must

therefore, in taking into account the likelihood of aural confusion, bear in mind the fact that the primary use of the trade marks in the purchasing of clothes is a visual act.”

15) I now turn to the marks of the two parties. For ease of reference I shall reproduce these below:

Applicant's Mark	Opponent's Mark
	

16) The applicant describes the marks thus:

“The applicant’s mark is for a device comprising a first member in a wave formation and terminating in a portion which contains a further curved element lying on top of the wave element and terminating as part of the wave element at its extremity. The opponent’s trade mark is also for a graphic trade mark which contains a first portion substantially of the shape of a letter “U” and a second portion connected at one side of the “U” device at its upper end and having a shallow curve.”

17) In my view, the marks cannot be verbalised, nor do either appear to have any conceptual meaning, notwithstanding the applicant’s eloquent description. I am therefore left only to compare the marks visually. To my mind, when placed alongside each other there are clear differences between the marks. However, the average consumer does not normally view the marks side by side. Rather they will have seen one mark and then, at a later date, will come across the other. In the absence of any conceptual meaning or verbalisation which could fix an image in the consumers mind it will, I believe, be recalled only as a wavy or curved device. Taking into account all of the aspects set out above, considering the marks when used on identical goods I believe that there is a likelihood of consumers being confused into believing that the goods provided by the applicant are those of the opponent or provided by some undertaking linked to them. The opposition under Section 5(2)(b) therefore succeeds.

COSTS

18) As the opponent has been successful it is entitled to a contribution towards its costs. I order the applicant to pay the opponent the sum of £500. 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 28th day of May 2009

**George W Salthouse
For the Registrar,
the Comptroller-General**