

O-193-09

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2435597
IN THE NAME OF MAKO MARINE INTERNATIONAL INC

AND
OPPOSITION THERETO UNDER NO 96237
BY MARK RUSSEL LOUW

TRADE MARKS ACT 1994

IN THE MATTER OF application
No 2435597 in the name of
Mako Marine International Inc
and opposition thereto under
No 96237 by Mark Russel Louw

Background

1. Application No 2435597 is for the trade mark MAKO and was applied for on 16 October 2006. It stands in the name of Mako Marine International Inc ("MMI"). Registration is sought in respect of the following goods in class 12:

Boats.

2. Following publication of the application in the *Trade Marks Journal*, Notice of opposition was filed by Sandiford Tennant Trade Marks on behalf of Mark Russel Louw. The grounds of opposition are based on section 5(2)(b) of the Act and in support of the objection he relies on the following earlier rights:

2360187



Mr Louw claims the colours black, white, red, blue and grey as an element of the second mark in the series.

2360189

MAKO INFLATABLES INTERNATIONAL

3. Both of the earlier rights relied on are registered in respect of the following:

Apparatus for locomotion by water; boats; rigid inflatable boats.

4. Both of the registrations relied on by Mr Louw have a registration date of 3 September 2004 and thus, whilst they are earlier marks, they are not subject to the proof of use requirements of section 6A of the Act.

5. MMI filed a counterstatement denying the claims made.
6. MMI did not file evidence but a witness statement was filed on behalf of Mr Louw.
7. Neither party requested to be heard and neither filed written submissions in lieu of attendance at a hearing. I therefore make this decision on the basis of the Notice of Opposition, the counterstatement and the evidence filed by Mr Louw.

Mr Louw's evidence

8. This takes the form of a witness statement by W R Tennant, partner in Sandiford Tennant, Mr Louw's representatives in these proceedings. Mr Tennant states that the information he gives has either been provided to him by Mr Louw or is from his own knowledge.
9. Mr Louw first used his marks in South Africa in 1995 then began exporting boats to Europe and the UK. He used UK agents based in South Hayling and Southampton to market and sell the boats. Marketing was conducted in coastal towns in the UK and in London and Northern Ireland.
10. Turnover of goods under the marks in the UK between 1995 and 2008 (this latter date is after the relevant date in these proceedings) is said to equate to approximately £115,000. Whilst the amount of money spent on marketing the goods is unknown, various advertisements are said to have been placed in local marine magazines and boat shows were attended under the MAKO banner. From 2006 to 2008 marketing has taken place via the Internet and by direct marketing to UK agents at a cost of approximately £1900.
11. Mr Tennant's witness statement is accompanied by two exhibits:

BT1-an extract from the Naval Technology website showing details of the marks on the products;

BT2-details of the goods as were shown at the Southampton Boat Show. No date is given for when this took place.

12. No further evidence was filed by either party.

The objection under section 5(2)(b)

13. This section of the Act reads:

(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.

14. In determining the question under Section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel v Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R.723. 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 he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen 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 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*, 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.

15. In essence the test under Section 5(2)(b) is whether there are similarities in marks and goods which, when taking into account all the surrounding circumstances, would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements and taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed.

Similarity of goods

16. There is no dispute that identical goods are involved.

The relevant public and the purchasing act

17. Boats may be bought by individual members of the public who sail as a hobby as well as the more professional sailor or business including organisations who use them in the course of their work such as the rescue services. They are relatively specialised items sold through specialist marine suppliers (whether in person or via the Internet) and will not be an everyday purchase for most, if not all, people. As the evidence shows, boats may be customised to the purchaser's individual requirements. Whether bought by an individual or the more professional user, a relatively high degree of care is likely to be taken during the purchasing act to ensure the product meets the needs of the purchaser.

Similarity of marks and their dominant and distinctive components

18. When assessing the similarity of the marks, I must do so with reference to the visual, aural and conceptual similarities between them, bearing in mind their dominant and distinctive components (*Sabel BV v Puma AG*, para 23).

19. The application in suit is for the word MAKO in plain block capitals. This word appears as the first word in Mr Louw's registered mark no 2360189, which also contains the words INFLATABLES INTERNATIONAL. I consider the word MAKO to be the dominant and distinctive component in Mr Louw's mark partly because of its location within the mark but also given that inflatables are a type of boat and the word would therefore be non-distinctive for these goods. The word international is also non-distinctive.

20. The distinctive word MAKO, albeit presented in stylised form is also clearly shown in Mr Louw's earlier mark no 2360187. This registration is for a series of two marks which are identical otherwise than to colour as set out in paragraph 2 above. The word MAKO is presented in large font within an oval border with a shark appearing to swim forwards through the final letter O and having its tail fin around the upper branch of the letter K. The non distinctive words "Inflatable International" appear in smaller font under the letters MAK and an internet address www.makoinflatables.com, also in small font, appears in a band at the bottom of the oval border. Whilst the representation of a shark is distinctive in respect of the goods at issue, it is relatively small within the mark as a whole. It is a long established principle that words speak louder than devices and, whilst the shark device has a fair

degree of distinctiveness, in my view the word MAKO which presents as the dominant, distinctive element within each of this series of marks.

21. Each of the respective marks contains the word MAKO. In the case of earlier mark no 2360189, the words are presented in identical form and I consider there to be a high degree of visual and oral similarity between the marks when considered as wholes. In respect of earlier mark 2360187, the word MAKO is presented in stylised form but is still clearly the word MAKO and I consider there is also a high degree of visual and oral similarity between them when considered as wholes. I am aware that Mako is a genus of shark although I do not know how widely this is known. To those who do, and it is possible that boat owners are more likely to be aware of this fact than others, the presence of a representation of a shark in earlier mark no 2360187 will serve simply to reinforce the word. For others the word MAKO will have no particular conceptual meaning.

Distinctiveness of the earlier trade marks

22. I also have to take into account the distinctive character of the earlier trade marks having regard to their inherent characteristics and the reputation they enjoy with the public. Mr Louw's evidence is that he began selling boats under the marks in the UK in 1995. Sales since then amount to some £115,000. This does not appear to me to be a particularly high figure, given the length of time over which they are said to have been sold, though I have no evidence as to what market share this might represent. Advertising has taken place in marine magazines and boat shows were attended though no specific figures to show the cost of any advertising before the relevant date has been provided. Whilst this evidence is unchallenged and I have no reason to doubt it, it is not specific or detailed enough to allow me to determine what use was made of each of the respective marks by the relevant date in these proceedings (16 October 2006). I am therefore unable to say that either of the earlier marks have accrued any enhanced distinctive character. That said, I consider each of the earlier marks to be of relatively high, inherent distinctive character.

Likelihood of confusion

23. In reaching a decision on whether there is a likelihood of confusion, I must make a global assessment based on all relevant factors. I have already found that identical goods are involved. I have also found that some elements in Mr Louw's earlier marks are descriptive and that the dominant and distinctive element of each is the word MAKO, whether in plain font or stylised. I have also found that this element is identical to the word forming the mark of the application in suit and that each of the respective marks are highly similar both visually and orally. That being the case, and considering all relevant factors including imperfect recollection, I consider the average consumer would mistake one mark for the other and be confused as to the economic origin of the goods sold under the respective marks. The opposition based on section 5(2)(b) of the Act therefore succeeds.

Costs

24. The opposition has succeeded and Mr Louw is entitled to an award of costs in his favour. I take into account the fact that limited evidence was filed (and by one party only) and that no hearing took place nor were written submissions filed.

I therefore award costs to Mr Low on the following basis:

Filing form TM7	£300 & £200 fee
Considering counterstatement	£200
Filing evidence	£200
Total	£900

25. I order Mako Marine International, Inc to pay Mr Mark Russel Low the sum of £900. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 9th day of July 2009

**Ann Corbett
For the Registrar
The Comptroller-General**