

O-119-11

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2479536  
IN THE NAME OF PAINTED-MANTIS LIMITED  
FOR REGISTRATION OF THE TRADE MARK  
ARAMANTIS IN CLASSES 18 AND 25**

**AND**

**AND IN THE MATTER OF OPPOSITION THERETO  
UNDER NO 98187 IN THE NAME OF MANTIS WORLD LIMITED**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF application No 2479536  
in the name of Painted-Mantis Limited  
for registration of the trade mark ARAMANTIS  
in Classes 18 and 25**

**and**

**IN THE MATTER OF Opposition thereto  
under No 98187 in the name of Mantis World Limited**

**DECISION**

1. On 12 February 2008 Painted-Mantis Limited applied to register the trade mark ARAMANTIS in respect of the following goods in Classes 18 and 25:

**Class 18** Handbags, purses, travelling bags, diary covers, toiletry bags.



**Class 25** Ladies clothing and clothing accessories.

2. On 3 November 2008 Mantis World Limited filed notice of opposition, the grounds being in summary:

**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 identical or similar to those for which these earlier marks are registered such that there exists a likelihood of confusion.

**Under Section 5(4)(a)** by virtue of the law of passing off.

3. The earlier marks relied upon are as follows:

2212975 (UK)	
1737550 (CTM)	
3212801 (CTM)	MANTIS

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

5. The applicants and the opponents both ask for an award of costs in their favour.

6. Both sides filed evidence in these proceedings, which, insofar as it may be relevant I have summarised below. Neither party took up the offer to be heard, instead electing to file

written submissions and to have the proceedings determined from the papers. After a careful study of the submissions and evidence I now go on to give my decision.

### **Opponent's evidence**

7. This consists of a Witness Statement dated 10 August 2009 from Shadi Jian-Zibae, a Director and founder of Mantis World Limited, the opponents in these proceedings.

8. Ms Jian-Zibae says that her company first used MANTIS as a trade mark in the UK in January 2000 in respect of clothing products, the UK being her company's largest market with customers including distributors, wholesalers and direct customers. She says that Mantis produces brochures and other pieces of literature, exhibits at various trade shows in the UK and across Europe, advertises in the trade press and features in distributors' catalogues. Other activities include email/direct mailing campaigns, websites, sponsorship, sales promotions and sampling campaigns, including the supply of literature and photography resources for use in promoting the product range. The company also operates the website [www.mantisworld.com](http://www.mantisworld.com).

9. Ms Jian-Zibae says that each garment includes a MANTIS branded woven neck label or printed wash care label, and MANTIS swing tickets. All garments are packed into polybags with a MANTIS branded pack sticker attached, the polybags in turn being placed into a MANTIS branded carton, sealed with MANTIS branded tape and a MANTIS branded carton sticker attached to the outside. Examples of this use are introduced as Exhibit SJZ1 which consists of:

photographs of tops having a swing-tag and/or sew-in label with the word MANTIS in the stylised font.

photograph marked "TAPE SAMPLE" depicting what appears to be a tape used for packaging, and that bears the words MANTISWORLD and MANTIS in the stylised font. There is an electronically inserted date of 24 April 2009.

photographs of what appears to be a plastic bag (image quality is very poor), a carton marked "French Terry and Pique Programme – Mantis Carton", and two labels, all bearing the word MANTIS in the stylised form..

10. Ms Jian-Zibae gives the number of clothing goods sold under the MANTIS trade mark in the United Kingdom since 2000 as follows:

<b>Year</b>	<b>Quantity</b>
2000	84,428
2001	303,584
2002	287,333
2003	411,875
2004	482,518
2005	328,922
2006	422,092

2007	244,041
2008	241,073
2009 (Jan-June)	90,511

11. Turnover resulting from the sale of clothing goods under the MANTIS trade mark in the United Kingdom since 2000 is given as follows:

<b>Year</b>	<b>£</b>
2000	£160,414
2001	£598,061
2002	£577,539
2003	£835,700
2004	£916,818
2005	£698,967
2006	£653,376
2007	£395,518
2008	£268,579
2009 (Jan-June)	£85,976

12. Advertising expenditure for clothing sold under the MANTIS trade mark in the United Kingdom since 2000 is as follows:

<b>Year</b>	<b>£</b>
2000	£49,300
2001	£76,880
2002	£130,880
2003	£156,712
2004	£80,961
2005	£46,377
2006	£91,913
2007	£89,186
2008	£101,213
2009 (Jan-June)	£97,760

13. Ms Jian-Zibae states that since January 2000 Mantis has produced significant literature and other promotional products showing the MANTIS trade mark, including an “Annual Brochure”, a “Mid-Year Seasonal update” brochure, company stationery, and documentation such as invoices, “Swatch Books” and promotional gifts with “postcards, bags and posters being cited as examples.

14. She goes on to say that since 2000 Mantis has worked with a list of named distributors to produce "Co-op print ads" that are “dual branded” with the MANTIS

trade mark and the distributor details and in "Co-op promotions" in the form of sampling campaigns, leaflets, postcards and brochure mailings and email campaigns. No detailed information on these activities has been provided.

15. Ms Jian-Zibae says that since February 2000 the MANTIS name has been promoted in connection with clothing products at the Printwear & Promotions Show at the Birmingham NEC, and also the Incentive World Show, National Incentive Show, the Promota Show and Trade Only Show Coventry which are all held annually. Staff at the shows dress in MANTIS branded uniforms, with visitors receiving bags bearing the MANTIS brand along with samples and brochures. Exhibit SJZ2 consists of photographs of retail areas, three appearing to be exhibition booths said to be from the Trade Only and Printwear & Promotion shows in 2007, 2008 and 2009. These show signage for MANTISWORLD and MANTIS in the stylised form, with articles of clothing on display. Ms Jian-Zibae says that as well as exhibition staff issuing flyers and leaflets, MANTIS branded clothing also regularly features at fashion shows and events held at these exhibitions. The MANTIS name also appears in Exhibition Directories and packs which are handed out by the organizers at each show.

16. Ms Jian-Zibae goes on to say that Mantis has also been involved in high-profile sponsorship activities, mentioning in particular the British Heart Foundation stand at the Clothes Show Live event at the NEC in Birmingham in December 2002. She says that the stand included displays using MANTIS trade mark, with clothing bearing the MANTIS and British Heart Foundation logos being worn by exhibition staff on the stands. Ms Jian-Zibae also mentions the "Fashion DIY" stand where visitors could customise MANTIS clothing, and the "Celebrity DIY" stand that exhibited customized MANTIS clothing created by celebrities that were eventually auctioned on the e-Bay website. Other sponsorship is said to include the "Missing Lynx Team" who participated in the Rhino Charge 2003 event held in Kenya, the supply of clothing to the charity 'One Water' to dress staff manning the events around Live 8 and Make Poverty History. In 2008, Mantis supported the 'Lohada' organisation for destitute children in Tanzania helping to fundraise towards the building of a new roof for the dormitory in the children's home.

17. Ms Jian-Zibae also mentions the coverage across the trade press, most recently for winning three media awards in the Printwear & Promotion 2008 - Finalist Environmental / Energy Saving Award, Printwear & Promotions 2008 - Manufacturer of the Year Award, ProTextile Chic European Awards 2008 - Best Collection for Childrenswear, RE:Fashion Awards 2008- RE:Manufacturer (in the category of Making a Difference).

18. Exhibits SJZ3 to SJZ8 are provided as examples of various articles and advertisements available to the public between 2001 and 2009, with the origins of the articles given as follows:

**Exhibit SJZ3**

<b>PUBLICATION</b>	<b>Date</b>
Printwear & Promotions	Dec 2002
Images	Feb/March 2002
Images	Oct/Nov 2001
Images	Oct/Nov 2001
Images	Feb/Mar 2002

Images	Jan 2003
Printwear & Promotions	March 2003
Company Clothing	Feb 2003
Images	August 2003
Printwear & Promotions	May 2003
Images	Oct/Nov 2003
Images	Feb 2004
Printwear & Promotions	Dec 2003

#### Exhibit SJZ4

<b>PUBLICATION</b>	<b>Date</b>
Printwear & Promotions	2005
Images	Jan 2005
Images	June 2005
Printwear & Promotions	June 2005
Images	Aug/Sept 2005
Printwear & Promotions	Dec 2005

#### Exhibit SJZ5

<b>PUBLICATION</b>	<b>Date</b>
Images	Jan 2006
Printwear & Promotions	Jan 2006
Images	June/July 2006
Images	June/July 2006
Images	Aug/Sept 2006
Images	Aug/Sept 2006

#### Exhibit SJZ6

<b>PUBLICATION</b>	<b>Date</b>
Images	March 2007
Images	March 2007
Images	June/July 2007
Printwear & Promotions	June 2007
Printwear Today	Sept 2007
Printwear Today	Oct 2007
Promotions & Incentive	Dec 2007

#### Exhibit SJZ7

<b>PUBLICATION</b>	<b>Date</b>
Promotions Buvor	Nov 2008
Printwear Today	Oct 2008
Images	Dec/Jan 2009
EcoTextile New	Dec 2008
Printwear & Promotions Exhibition Catalogue	March 2008
Printwear & Promotions Exhibition Catalogue	March 2008
Images	March 2008
Printwear & Promotions Exhibition Catalogue	March 2008
Promotions Buvor	April 2008
Printwear Today	April 2008
Printwear Today	April 2008
Printwear & Promotions	April 2008
Printwear Today	May 2008

Printwear Today	May 2008
Printwear Today	June 2008
Printwear Today	June 2008
Printwear & Promotions	June 2008
Printwear & Promotions	July 2008
PPD Trade Only Show Magazine	Dec 2008
Promotions Buyer	July 2008

### Exhibit SJZ8

<b>PUBLICATION</b>	<b>Date</b>
Images	Jan 2009
Images	March 2009
Printwear & Promotions	April 2009
Images	March 2009
Images	April 2009
Images	April 2009
Printwear & Promotions	Feb 2009

19. Exhibit SJZ3 consists of various items of printed matter as follows:

Features referring to the “fashionable promowear label Mantis” helping the British Heart Foundation celebrate the 2002 CLOTHESHOW LIVE event (6-11 December 2002) by donating “...several hundred Mantis skinny-fitted tops”. The feature refers to the MANTIS website.

Advert for MANTIS promowear referring to the 2002 collection, with MANTIS being shown in plain script and also the stylised form, and as a neon light in the background.

Advertisements depicting a waitress and a baseball player with the word MANTIS in the stylised form beneath and referring to the MANTISWORLD website. The baseball player advert mentions the availability of baseball tops and hooded fleece jackets as being part of an “all American Casuals Summer/Autumn 2001 collection.

Company profile for MANTIS from the Feb/March edition of Images publication that refers to the “Mantis Collection 2002 brochure” with two new styles of tops aimed at the “fashion workwear market.”

Article dating from March 2003 entitled “MANTIS – adding a modern and feminine twist to well loved classics” saying that since the launch of Mantis in 2000 it has “...played a leading role in the development of fashionable ladieswear in the promotional industry.” Another article from the same time confirms the launch in 2000 into “...a perceived gap for the younger side, putting the emphasis on ladieswear.”

Covers from Autumn/Winter 2003 Images, and May 2003 Printwear & Promotion magazines depicting MANTIS clothing.

Feature from the October/November 2003 edition of Images reporting the donation of £5,000 by MANTIS WORLD Limited to the Rhino Ark charity.

Feature from the What's New 2004 section of Images, reporting the expansion of the MANTIS range of "fashionable promo wear"

What's New 2004 section of Images, and December 2003 edition of Printwear & Promotion publications, reporting the expansion of the MANTIS range of "fashionable promo wear", the latter referring to the new Mantis 2004 brochure.

20. Exhibits SJZ4 to SJZ8 consist of similar items of printed matter to those previously described, but in this case relating to activities of MANTIS in the period 2005 to 2009. These also show the brand to have moved into mainstream fashion.

21. Exhibit SJZ9 consists of various examples of the promotion of MANTIS in the period from 2001 to 2009. The earliest item is dated 10 April 2001 and appears to be a working document of a feature to be placed. Ms Jian-Zibae says that the exhibit originates from the "Images, Printwear & Promotions, Promotions Buyer, Printwear Today and EcoTextile New publications. She says that she is advised that Images has a current circulation of around 5,000, Printwear & Promotions has a current circulation of 5,800, Printwear Today had a circulation of 6,000, Company Clothing has a current circulation of 5,000, Promotions & Incentive had a circulation in 2008 of 15,997 and Promotion Buyer has a circulation of 21,000.

22. Exhibit SJZ10 consists of pages depicting various items described as "promotional clothing" under the MANTIS/MANTISWORLD name, the first page of which is headed "Collection 2000". Ms Jian- Zibae says that the exhibit is a copy of her company's catalogue from 2000, and that in the same year MANTIS also produced a Mid-season Autumn /Summer Flyer, a copy of which is also included in this Exhibit. Next are shown Exhibits SJZ11 to SJZ20 which are introduced as copies of the MANTIS catalogues and mini-brochures and "mailers" from 2001 to 2009, again showing use of the MANTIS trade mark in connection with clothing. Mini Brochures and Mailers are described as "promotional articles which are sent to distributors to send out to their database, are inserted into magazines and are sent by Mantis to its own database of customers." Ms Jian-Zibdae gives the following "estimated" information relating to the production of brochures and mailers in certain years:

2004	25,000 catalogues, 18,000 mini brochures and 59,000 mailers produced.
2005	30,900 catalogues, 33,600 mini brochures and 42,750 mailers produced.
2006	34,200 catalogues and 6,500 mini brochures produced.
2007	40,000 catalogues, 27,200 mini brochures and 5,000 mailers produced.
2008	35,500 catalogues and 6,850 mailers produced.
2009	23,500 catalogues produced.

### **Applicant's evidence**

23. This consists of a Witness Statement dated 19 January 2010 from Margaret Elaine Pinder, the sole Director of Painted-Mantis Limited with which she has been associated since its formation in June 2006.

24. Ms Pinder describes Painted-Mantis Limited as a small company selling high-end luxury goods, principally unique travel bags and handbags which she designs and makes exclusively for the applicants. Exhibit MEP 1 is said to show the goods currently sold by the applicants



along with promotional information. The exhibit depicts various types of handbags, travel bags, wash bags, tote bags and evening bags, none of which bear any date. Ms Pinder says that the applicant sells these bags at exclusive shows such as Boutique de Noel, Kennington, Ripley Castle Grand Summer Sale, Harrogate Fashion and Gift Fair, Beverley Victorian Christmas Market and over the internet. Ms Pinder refers to another mark owned by her for the mark PAINTED-MANTIS which was registered in January 2008. She concludes her evidence by referring to her company's plans to extend into high-quality hand-printed and hand-painted silk scarves.

25. That concludes my review of the evidence insofar as it may be relevant to these proceedings.

## Decision

26. I turn first to the objection made under Section 5(2)(b) which reads as follows:

“5. - (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected

(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.”

27. 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), 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,”

28. The opponent relies on one earlier UK trade mark registration and two earlier Community trade mark (CTM) registrations. The UK registration and one CTM have a date of registration more than five years prior to the date of publication of the application so the provisions of The Trade Marks (Proof of Use, etc.) Regulations 2004 apply. However, as the remaining CTM has a specification equal in scope to these other marks it is possible to determine the ground based on this mark alone, for if the opponents do not succeed with this they will be in no better position with regard to the other marks.

29. In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the ECJ in *Sabel BV v Puma AG* [1998] RPC 199, *Canon*

*Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] FSR. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] ETMR 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO)*. 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*,

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, 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.*,

(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*,

(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*,

(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*,

(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*,

(g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(h) 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*,

(i) 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 and Adidas Benelux BV*,

(j) 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*.

(k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-3/03P *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market* [2004] ECR I-3657 at 32, That is the case where the component in the complex is likely to dominate, by itself, the image of that mark which the relevant public keeps in mind, with the result that all the other components of the mark are negligible within the overall impression created by it (Case T-6/01 *Matratzen Concord v OHIM – Hukla Germany (MATRATZEN)* [2002] ECR II-4335, paragraph 33, and Case T-28/05 *Ekabe International v OHIM – Ebro Puleva (OMEGA3)* [2007] ECR II-4307, paragraph 43, *Shaker di L. Laudato & C. Sas v OHIM (LIMONCELLO)*.)

30. With the goods at issue in mind I also have regard to the decision of Mr Simon Thorley when sitting as the Appointed Person in the *React* trade mark case [2000] R.P.C 285 in which he 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.”

31. 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. In the comparison of the respective marks the applicants refer me to the decisions in *Pianotist* (1906 23 RPC774), *Aristoc v Rysta* (1942) 62 RPC 65, *London Lubricants (1920) Limited* (1925) 42 RPC 264 and *Sabel v Puma*. The opponents refer to *Sabel v Puma* and also *Cannon v Metro-Goldwyn-Meyer*. I have taken full account of these in this decision.

32. The earlier marks are for the word MANTIS in plain block capitals, and in a stylised lettering that is still clearly the word MANTIS. The subject mark is for the word ARAMANTIS which the opponents rightly point out is their mark MANTIS with the prefix ARA. Setting aside the stylisation, that the opponent’s marks are subsumed within the entirety of the mark applied for does not, of itself mean that they are similar. The assessment of the similarity means more than taking just one component of a trade mark and comparing it with the other mark.

33. The opponents do not make any submissions on the distinctiveness of their mark, or its significance in the mark applied for. The applicants say that MANTIS "...is a dictionary word and as such is not highly distinctive..." which is plainly the wrong consideration. As MANTIS is not a generic description such as "soap" for "soap" the question is whether the word describes either the goods for which it is registered or some characteristic of them. I am not aware that MANTIS has any such descriptive relevance and there is no evidence that shows this to be the case. I must therefore proceed on the basis that MANTIS is a word with a strong distinctive character.

34. In determining the potential for confusion as part of the "global appreciation" it is the impression that the respective marks convey to the "average consumer" of the goods and services in question that is important. This is created by the impact that the marks have on the eye when seen, how they sound when spoken and heard, and by the idea or message that they convey. In their written submissions the opponents say that "...the addition of the letters ARA is not sufficient to distinguish completely the Applicant's mark from that of the Opponent. It still appears similar to the eye and further, shares significant aural similarities." They make no comment on the question of whether there is any conceptual similarity.

35. Looking first at the question of whether the marks are visually similar, as I have already said, the mark applied for contains the opponent's mark as its final part, albeit preceded by the letters ARA. Whilst in pure letter count this similarity outweighs the difference, I must take into account that the letters ARA are the first part of the applicant's mark, which unless wholly and obviously descriptive (which is not the case here) is generally accepted as being of most significance in any comparison. The effect of ARA ending with a vowel is that it creates a syllable that enables the letters to run through and join with MANTIS to create what looks like a unified whole. In my view this lessens the visual significance of MANTIS within the mark by creating what appears to be an invented word. In my assessment the marks MANTIS and ARAMANTIS have some visual similarities but are not visually similar.

36. The considerations that I mention in the assessment of the visual similarity are just as relevant when looking at whether they should be viewed as being aurally similar. It is difficult to argue that there is no similarity when the whole of the opponent's mark forms the terminal two syllables of the mark applied for. However, the tendency for slurring (or at least less clear enunciation) of the endings of words lessens this. That the letters ARA are at the beginning of the applicant's mark, create a definite sound that will be pronounced, and run through to join naturally with MANTIS to create a wholly pronounceable word all lead me to the view that the respective marks are not aurally similar.

37. As I have already said, the opponents are silent on the question of conceptual similarity. I think this is indicative of the fact that MANTIS does not stand out in the mark applied for, which when viewed as a whole is likely to be taken to be an invented word. The opponents have not disputed that MANTIS is a word in use in the English language. Even so, I do not believe that it is commonly used, and where it is this will most likely be as part of a name such as "praying mantis" so I do not discount the possibility that some will see it as an invented word.

38. Taking the above into account I come to the position that whilst there are similarities in the respective marks these are not sufficient for the earlier marks to be considered similar.

39. Ms Jian-Zibae says that her company first used MANTIS as a trade mark in the UK in January 2000 in respect of clothing products, and that this is her company's largest market. The evidence shows this clothing to be primarily what is called "promowear" or corporate clothing, but there is also evidence of use in respect of mainstream fashion wear. In unit terms sales started at 84,428 items in 2008, rising to a peak of 482,518 in 2004 falling back to 244,041 in 2007, the last full year before the relevant date. Each item is said to have borne several MANTIS branded labels, and to have been placed within packaging bearing the MANTIS name. Turnover ranges from a base of £160,414 in 2000, reaching a peak of £916,818 in 2004, progressively falling back to £395,518 in 2007. Even without evidence of the size of the clothing market at large it would seem reasonable to assess this activity as being of a reasonable scale albeit not massive, but if limited to the promowear (or corporate clothing) sector the use is more significant.

40. Annual advertising expenditure for MANTIS branded clothing since 2000 ranges from around £50,000, to a peak of over £150,000, the usual being in the £70,000 to £100,000 a year mark. Promotion has been primarily through industry vehicles such as Printwear & Promotions Exhibitions and catalogues, the Promotions Buyer and Printwear Today publications, brochure issues and sponsorship,. This will have exposed the brand quite widely to the trade, but for the public at large it is difficult to quantify.

41. On the basis of the evidence I believe it is reasonable to accept MANTIS to have a strong reputation in the field of corporate clothing, but a lesser reputation for general fashion.

42. Turning to look at the similarity or otherwise of the respective goods. The opponent's earlier mark covers "Clothing, headgear and footwear" in Class 25 which covers clothing for all genders, and accordingly the "Ladies clothing" in the corresponding class of the application. It is not stated what type of products are covered by "clothing accessories" but in Class 25 this description would cover items such as scarves and gloves, all of which are covered by the general term "clothing".

43. The applicants mention that the opponents are engaged in a trade in "...reasonably priced leisure wear sold to trade purchasers only and designed to be adapted either to carry the purchasers' own labels and/or to be used by individual enterprises as promotional wear." They seek to distinguish this from their "high end exclusive travel bags and handbags sold only by the Applicant directly to the general public." This distinction based on the opponent's use would have been of relevance had the opponent needed to meet the Proof of Use provisions that I referred to earlier but not so when the consideration is notional and based on the wording in the respective specifications of goods. As there is nothing here that would separate them in the market, course of trade, consumer or whatever, I must assume that they operate in the same sector, and share the same channels of trade, from manufacture to retail to the same consumer base. The conclusion that I must inevitably reach is that in respect of Class 25, the application and the earlier mark encompass identical goods.

44. The application also covers goods in Class 18 which at best can only be similar to the goods of the earlier mark. The established tests in assessing the similarity or otherwise of goods and services is set out in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*. I also have regard to the decision of the CFI in *Saint-Gobain SA v OHIM* Case T-364/05. From these I determine

that I must consider the uses and users of the respective goods, the physical nature of the goods and the trade and distribution channels through which they reach the market. In the case of self-serve consumer items this will also include consideration of where the respective goods are likely to be found, particularly in multi product outlets such as supermarkets. The extent to which the respective goods are competitive or complementary is also a relevant consideration guided by how they are classified in trade, and known by the relevant consumer.

45. Other than where the proof of use provisions have been applied, the comparison is a notional one based on the wording used in the specifications rather than the actual markets involved. As I have already mentioned, the earlier mark is registered in Class 25 in respect of “clothing, headgear and footwear” whereas the specification of Class 18 of the application mark covers “Handbags, purses, travelling bags, diary covers, toiletry bags.” In the decision of the General Court in *El Corte Inglés SA v Office for Harmonization in the Internal Market (Trade Marks and Designs)(OHIM)* Case T- 443/05 the General Court held that goods may be considered complementary if they have a common aesthetic function by jointly contributing to the external image (look) of the consumer concerned. The General Court went on to state:

“50 The perception of the connections between them must therefore be assessed by taking account of any attempt at coordinating presentation of that look, that is to say coordination of its various components at the design stage or when they are purchased. That coordination may exist in particular between clothing, footwear and headgear in class 25 and the various clothing accessories which complement them such as handbags in class 18. Any such coordination depends on the consumer concerned, the type of activity for which that look is put together (work, sport or leisure in particular), or the marketing strategies of the businesses in the sector. Furthermore, the fact that the goods are often sold in the same specialist sales outlets is likely to facilitate the perception by the relevant consumer of the close connections between them and strengthen the perception that the same undertaking is responsible for the production of those goods.”

46. To my mind the General Court is not saying that certain goods in Classes 18 and 25 are invariably similar, rather that they may be so provided that the relevant circumstances of “consumer”, “activity”, “marketing” and “outlet” would lead to the relevant consumer to the belief that the same undertaking is responsible for the goods.

47. My own experience matches the conclusions of the General Court in that I know it is not unusual for traders in clothing to also trade in items such as “Handbags, purses and diary covers as accessories to clothing such as footwear. The same is the case in respect of “travelling bags and toiletry bags” which may be coordinated with clothing such as overcoats/headwear, and “belts”. They are, however bought in addition to, rather than as an alternative so I do not consider them to be in any way competitive. Taking this into account, I am led to the conclusion that as there is nothing in the wording of either of the respective specifications that would separate them in the market, I must notionally assume that they operate in the same sector, and share the same channels of trade, from manufacture to retail. Additionally, I can see no reason why the consumer of the respective goods should be any different, which in this case must be the public at large.

48. Clothing, bags and the like range from the cheap and simple that will be selected with minimal attention to the brand, to the high-end expensive and exclusive where the purchaser will be well informed and circumspect in all aspects of the selection. The consumer will be used to seeing such goods available from a single trader, and marketed as a range to complete a particular look. These goods may not be sold on the same shelves, but being complementary are likely to be displayed in reasonably close proximity. There is no evidence on this, but it would be surprising if this accessorising did not feature in the marketing activity. My conclusion is that the goods in Class 18 of the application should be considered similar to the clothing, headgear, and particularly the footwear covered by the earlier mark. Taking all of the above into account and adopting the global approach advocated, I come to the view that whilst there are similarities, these do not outweigh the fundamental fact that the respective marks are not similar. In the circumstances of this case there is no likelihood of confusion, and consequently, the ground of opposition is dismissed.

49. This leaves 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”.

50. 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 *WILDCHILD* 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.

51. The first issue to determine is the material date at which this objection must be judged. A similar provision to section 5(4)(a) of the Act is to be found in Article 8(4) of Council Regulation 40/94 of December 20, 1993. This was the subject of consideration by the Court of First Instance in *Last Minute Network Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* joined cases T-114/07 and T-115/07. In that judgment the CFI stated:

“50 First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51 However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non-registered national mark before the date of filing, in this case 11 March 2000”

52. The material date is therefore the date of the application for registration. However, if there has been use of the trade mark by the applicant prior to the date of application this must be taken into account as it could establish that it was the senior user. Additionally, it may show that there are circumstances that mean that the use of the subject mark would not be liable to be prevented by the law of passing-off. (See *Croom’s Trade Mark Application* [2005] RPC 2 and *Daimlerchrysler AG v Javid Alavi (T/A Merc)* [2001] RPC 42).

53. In her evidence Ms Pinder mentions her company was formed in June 2006 although she does not say that the mark ARAMANTIS has been in use since this date. Nevertheless I shall take this to be the very earliest material date for passing-off, but for the reasons I shall give I do not consider that whether I use this date, or the date of application, the decision will be any different.

54. I have already said that in my view the evidence supports the conclusion that the opponents have established a strong reputation in the mark MANTIS in respect of “promowear” or, as otherwise described, “corporate” clothing. I also concluded that whilst the position is far less clear when it comes to any reputation in respect of general fashion wear, I nonetheless consider the evidence shows that this is likely to exist. But in any event, in the terms that it is expressed, the specifications of the application, at least as far as Class 25 is concerned would also cover such goods, so there is no separation in the markets and trading activities. I see no reason why the position in respect of accrued goodwill should be any different. This assessment focused on a relevant date of February 2008, the date of application, but given that they have had a reasonable level of trading activity in the UK since 2000 I would say that the position would be little, if any different if assessed as at June 2006.

55. I have already given a detailed explanation as to why I consider the mark ARAMANTIS to be dissimilar to MANTIS and I see no reason to arrive at a different conclusion under this ground. Given this I do not see how there can be a finding that use of the mark applied for would amount to a misrepresentation, or that damage would result if they were to do so. The ground of objection under Section 5(4)(a) therefore fails and is dismissed.

56. The opposition having failed the applicants are entitled to a contribution towards their costs. Both sides agreed that the circumstances of the case warranted an award being based on the set scale. I order the opponent to pay the applicants the sum of £1,050. 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 30 day of March 2011**

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