

O-389-11

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION
No. 2528515
BY JAY FOLLY t/a STALKER
TO REGISTER THE TRADE MARK**



IN CLASSES 25 & 28

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No. 100953 BY
FOX INTERNATIONAL GROUP LIMITED**

BACKGROUND

1) On 12 October 2009 Jay Folly t/a Stalker (hereinafter the applicant), applied to register the following trade mark:



2) In respect of the following goods:

In Class 25: Fishing clothing, footwear, headgear, clothing.

In Class 28: Fishing tackle, bait, fishing bags, terminal tackle.

3) The application was examined and accepted, and subsequently published for opposition purposes on 30 July 2010 in Trade Marks Journal No.6846.

4) On 15 September 2010, Fox International Group Limited, (hereinafter the opponent) filed a notice of opposition. The ground of opposition is in summary:

a) The opponent is the proprietor of the following trade mark:

Number	Mark	Filing and Registration Date	Class	Specification
CTM 587808	STALKER	12.06.97 / 18.06.99	18	Luggage; backpacks; rucksacks; luggage for retaining angling equipment; all goods in Class 18.
			25	Clothing; clothing for anglers; suits, one-piece suits, salopettes, jackets and trousers; all being waterproof; all goods in Class 25.
			28	Angling apparatus; all goods in Class 28.

b) The opponent states that the marks are similar and that both parties' goods are identical or similar. The opponent states that the application offends against Section 5(2)(b).

5) On 3 November 2010, the applicant filed a counterstatement which basically denied the opponent's claims. The applicant did not put the opponent to proof of use.

6) Both sides filed evidence. Both parties seek an award of costs in their favour. The matter came to be heard on 9 November 2011. At the hearing, the opponent was represented by Mr Crouch of Messrs Broomhead Johnson; the applicant represented himself.

OPPONENT'S EVIDENCE

7) The opponent filed a witness statement, dated 3 January 2011, by Paul Reeves the Managing Director of the opponent company, and who has worked for the company for eleven years and been involved in the angling apparatus industry for seventeen years. He states that the opponent first sold angling apparatus and angling accessories under the STALKER mark in the EU on 16 January 2001. He provides the following sales figures for the EU:

Period	Number of items	Value £
2005	41,234	914,884
2006	35,799	718,973
2007	35,925	646,942
2008	28,161	482,315
2009	7,260	184,921
2010	4,635	132,107

8) Mr Reeves states that in the period November 2005 – September 2010 a total of £92,404 was spent advertising angling goods under the STALKER mark in the EU. He confirms that angling products under the STALKER mark were sold throughout the UK during the period 2005 – 2010. He also provides a list of towns elsewhere in the EU, and outside it, where angling products under the STALKER mark were sold. Mr Reeves provides the following exhibits:

- PR1: Copies of catalogues distributed in the UK for the years 2005, 2007, 2008, 2009 & 2010. These show a range of angling accessories which have the trade mark STALKER upon them.
- PR2: Copies of pages from the company website which it is claimed received an average of 40,000 unique visits from the UK per month during the period 2007 – July 2009. These show angling accessories under the mark STALKER.
- PR3: Copies of price lists for the years 2005-2010 showing angling products with the STALKER mark upon them.
- PR4: Copies of invoices for sales in the UK for the period November 2005 – September 2010. These show angling products being sold within the UK under the STALKER trade mark.

- PR5: Copies of fishing magazines and periodicals distributed in the UK during the period 2005 – 2010 which shows the opponent advertising angling products under the STALKER mark.

APPLICANT'S EVIDENCE

9) The applicant, Mr Folly, provided a witness statement dated 22 April 2011. He states that he began selling products under his logo on 28 January 2010. He states that prior to the opposition he had spent over £40,000 promoting his products under the logo. He also provides the following exhibits:

- L1: A list of companies with product names which include the word STALKER, all said to be within the angling industry. There are copies of webpages showing the various items and the fact that they use the word STALKER as part of their overall mark.
- D1: A page of images which shows a number of FOX marks, including the Fox Stalker mark. Mr Folly states that the differences between the opponent's marks and his are obvious.
- F1: A copy of the opponent's website which shows that the opponent's catalogue is entitled "Fox Carp & Specialist" whilst the name of the product shown on the page is "STALKER".
- IPOF: A copy of an examination report issued by the IPO which shows that in the examiners' opinion the term stalker, when used on items for hunting or fishing, is generic as it refers to a hunter of game (including fish).
- EB1-2: copies of eBay searches for fishing equipment where the term STALKER returned large numbers of items for sale only a fraction of which were found when the search was altered to FOX STALKER.

10) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

11) The only ground of opposition is under Section 5(2)(b) of the Act 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.”

12) An “earlier trade mark” is defined in section 6, the relevant part of which states:

“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.”

13) The opponent is relying upon its trade mark CTM 587808 which is clearly an earlier trade mark. It was registered on 18 June 1999. Although subject to The Trade Marks (Proof of Use, etc) Regulations 2004, the applicant decided not to put the opponent to proof of use, by answering “No” to the question regarding proof of use on the form TM8.

14) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the European Court of Justice (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] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 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). In the recent case of *La Chemise Lacoste SA v Baker Street Clothing Ltd* [ALLIGATOR O/333/10] Mr Hobbs QC acting as the Appointed Person set out the test shown below which was endorsed by Arnold J. in *Och-Ziff Management Europe Ltd and Oz Management Lp v Och Capital LLP; Union Investment Management Ltd & Ochocki*, [2010] EWCH 2599 (Ch).

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods/ services in question; 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, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in

mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements; nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(e) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element in that mark;

(f) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

(g) 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;

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient;

(i) 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;

(j) if the association between the marks causes the public to wrongly believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

15) 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 the goods in their specifications.

16) In the instant case the opponent has provided evidence regarding use of its mark. However, whilst the opponent has provided turnover figures it has not put these into context of the market for fishing accessories in the UK. I take judicial notice of the fact that as angling is the biggest participation sport in the UK this market is likely to be very substantial and the opponent's turnover figures appear to be modest. Nor has the

opponent filed evidence from the trade or independent witnesses. It cannot therefore benefit from an enhanced reputation. Further, in my opinion, the opponent's mark has a low degree of inherent distinctiveness given that the term stalker is a widely known and used term to describe a hunter of game and fish.

17) As the case law in paragraph 14 above indicates I must determine the average consumer for the goods of the parties. I must then determine the manner in which these goods are likely to be selected by the said average consumer. The average consumer for the class 28 goods would be those members of the general public who are interested in fishing. This encompasses a large number of the UK population as fishing is the largest sport in terms of the number of participants in the UK. The goods which could be included within the specifications of both parties vary enormously in terms of price and complexity. Some items such as floats are quite cheap and will not be the subject of lengthy consideration. However, other items such as rods can be very expensive and would be given a great deal of thought. Overall, I believe that the vast majority of the goods will not be purchased or selected without considerable care. The same applies to the fishing specific clothing in class 25. However, the class 25 goods of both parties also have "clothing" within them. The average consumer for these general types of clothing would be the general public. Such items can vary enormously in price and so the level of attention paid by the consumer will vary. However, given that clothing needs to fit, and that fabrics are increasingly a consideration in the purchasing decision, it is likely that a reasonable level of attention will be paid by the average consumer. I accept that when considering clothing the selection is made primarily by eye [*REACT (2000) RPC 285*]. I also take on board Mr Folly's point regarding the "tribal" nature of anglers in that they tend to stick with a brand once they are satisfied with it.

18) I shall now consider the goods of the two parties. For ease of reference, I set out the specifications of both parties below:

Applicants' specification	Opponent's specification
	Luggage; backpacks; rucksacks; luggage for retaining angling equipment; all goods in Class 18.
In Class 25: Fishing clothing, footwear, headgear, clothing.	Clothing; clothing for anglers; suits, one-piece suits, salopettes, jackets and trousers; all being waterproof; all goods in Class 25.
In Class 28: Fishing tackle, bait, fishing bags, terminal tackle.	Angling apparatus; all goods in Class 28.

19) The applicant's specification of "fishing clothing and clothing" in class 25 must be considered to be identical to the opponent's "clothing, clothing for anglers". The opponent does not have "footwear" or "headgear" within its class 25 specification, but it is clear that these must be regarded as being very similar to "clothing". To my mind the parties' goods in Class 28 are clearly identical as the opponent's specification covers all angling apparatus in Class 28 and so encompasses all of the applicant's specification.

20) I now turn to consider the marks of the two parties. For ease of reference these are reproduced below:

Applicants' Trade Mark	Opponent's Trade Mark
	<p>STALKER</p>

21) The applicant referred me to four cases, *Unilever Plc v RDPR Ltd* (O-016-10); *Virgin Enterprises Ltd v Michael Casey (Carbon Virgin)* [EWHC (ch) 1036]; *Calvin Klein Trademark Trust v OHIM, Zafara Marroquinos (Creaciones Kenya)* [C-254/09]; and *Vidieffe Sri v OHIM, Perry Ellis International Group Holdings Ltd (Gotha)* [T 169/09]. However, I do not believe that these add anything to the principles outlined in paragraph 14 above.

22) The applicant also referred me to a very recent case between the two parties in the Patents County Court, (*Fox International Group Ltd v Folly* [2010] EWPC 30). The same marks as in the instant case were involved, although the court was considering an infringement action. Mr Folly referred me to the comment of the learned Judge at paragraph 50 where he said:

“In my judgement Mr Folly’s device is not identical to Fox’s trade mark”.

23) I believe that this conclusion is one that anyone blessed with the gift of sight would also have come to. I note that Mr Folly’ mark was found to have infringed Fox’s rights. Mr Folly contended that the opponent’s never use their mark *solus*, but always in conjunction with their house mark “Fox”. However, under section 5(2) I have to consider the marks as applied for/registered in my comparison.

24) To my mind, visually there are differences, in that the applicant’s mark has a device of a man holding a fishing rod where the opponent has a letter “t”. To my mind the public will view the angler as a highly stylised way of forming the letter “t”, in order to form the word “stalker”. The applicant’s mark also has the word “tackle” in it, although when used on rods, reels etc in class 28 this would be viewed as a description of the fishing tackle on offer. However, the word “tackle” is not usually used in relation to clothing, footwear or headgear. Overall the visual similarities outweigh the differences.

25) Aurally, both marks are primarily “stalker” marks albeit that the applicant’s mark also has the word “tackle”.

26) Conceptually, the applicant's mark is irretrievably linked to fishing. The term "stalker" is used to describe a hunter of game including fish and clearly the device element reduces the association solely to fishing. This is primarily achieved through the device element but is reinforced by the addition of the word "tackle" which is commonly used to describe fishing apparatus. The opponent's mark is simply the word "stalker". Absent any context this could be seen as a hunter, particularly a deer stalker, but may also bring to mind an image of a celebrity obsessed lunatic. The marks do share a common conceptual image of a hunter of some description.

27) Taken overall although there are a number of differences between the marks there are considerable similarities which far outweigh the differences.

28) When determining whether there is a likelihood of confusion I have to take a number of factors into consideration. There is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. I must consider whether the opponent's trade mark has a distinctive nature, the average consumer for the goods, the nature of the purchasing process and the issue of imperfect recollection. I must also take into account that these goods will not be chosen without a degree of care. In the instant case the opponent's mark has a low degree of inherent distinctiveness. I accept that the goods are, in the main identical, however, even when used on goods which are merely similar given the clear similarities in the trade marks there is a likelihood of confusion on the part of the public, or a likelihood of association with the earlier trade mark. The ground of opposition under Section 5(2)(b) succeeds.

COSTS

29) The opponent has been successful and it is therefore entitled to a contribution towards its costs.

Preparing a statement and considering the other side's statement	£300
Preparing evidence and considering and commenting on the other side's evidence	£500
Preparing for and attending a hearing	£600
Expenses	£200
TOTAL	£1600

30) I order the applicant to pay the opponent the sum of £1600. 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 10 day of November 2011

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