

O-099-13

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2595350  
IN THE NAME OF TOBY TIGER WHOLESALE LTD

AND

OPPOSITION THERETO UNDER NO 103164  
BY JACK WOLFSKIN AUSRÜSTUNG FÜR DRAUSSEN GmbH & CO KGaA

## Background


1. Application no 2595350 was filed on 22 September 2011 and stands in the name of Toby Tiger Wholesale Ltd ("TT"). It seeks registration of the following trade mark:

Toby tiger 

2. The application seeks registration in respect of the following goods in class 25:

*Clothing and footwear*

3. Following publication of the application in the *Trade Marks Journal* on 30 December 2011, notice of opposition was filed by Jack Wolfskin Ausrüstung für Draussen GmbH & Co KGaA ("JW"). There is a single ground of opposition brought under the provisions of section 5(2)(b) of the Act. Under this ground, JW relies on the following community trade mark insofar as it is registered for the following goods:

Mark	Relevant dates	Specification of goods
CTM 9274648 	Application: 27 July 2010  Registration: 10 January 2011	Clothing, footwear, headgear

4. TT filed a counterstatement in which it was accepted that the respective goods are identical but denied that the respective marks were similar, or in the alternative similar enough, such that there would be no likelihood of confusion.

5. Both parties filed evidence. Neither party sought to be heard but both filed written submissions in lieu of attendance at a hearing. I have considered all of this material in reaching my decision.

## **The evidence**

6. The following evidence has been filed:

### **JW's evidence**

- A witness statement by Christopher David Morris dated 23 August 2012 along with exhibits CM1-14. Mr Morris is a trade mark attorney at Burges Salmon LLP who act for JW in these proceedings;
- A second witness statement by Christopher David Morris also dated 23 August 2012 along with exhibits CM15-17.

### **TT's evidence**

- A witness statement by Zoe Francesca Mellor dated 23 October 2012 with exhibits ZM1-6. Ms Mellor is the Managing Director and proprietor of TT;
- A witness statement by Aaron Ronald Wood dated 24 October 2012 with exhibits ARW1-4. Mr Wood is the Head of Trade Marks and Brand Protection at Briffa, who act for TT in these proceedings.

7. Given the nature of it, I do not intend to summarise the evidence but will refer to it as necessary in this decision.

## **Decision**

8. As indicated above, there is a single ground of opposition founded on section 5(2)(b) of the Act. This 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.”

9. An earlier trade mark is defined in section 6 of the Act, 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 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,

(b) .....

(c) .....

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

10. JW relies on its CTM 9274648 as set out above. Whilst it is an earlier mark within the meaning of the Act, JW is not required to prove the use made of it as it had not been registered for five years at the date of the publication of TT’s application.

11. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs Q.C., expressed the test under this section (by reference to the CJEU cases mentioned) on the basis indicated below:

### **The CJEU cases**

*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; *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723; *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market* (Trade Marks and Designs) (OHIM), Case T-6/01; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04; *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market* (Trade Marks and Designs) (OHIM) C-334/05 P.

### **The principles**

“(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 or 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;

(e) 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;

(f) 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 of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

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

(j) 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;

(k) 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.”

### **Comparison of the respective goods**

12. In her witness statement, Ms Mellor, on behalf of TT, comments on the respective parties' goods and states that “we do childrenswear for 0-6 year olds” and that the parties “produce clothing for different markets and are not in competition with each other”, however, I am mindful of the findings of the Court of First Instance (now General Court) in *Saint-Gobain SA v OHIM* Case T-364/05 where it said:

“67... it is important to reiterate that the comparison between the goods in question is to be made on the basis of the description of the goods set out in the registration of the earlier mark. That description in no way limits the methods by which the goods covered by the earlier mark are likely to be marketed.”

13. I am also mindful of the findings of the Court of First Instance (now General Court) in the case of *NHL Enterprises BV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-414/05:

“71 The Court considers, first, that that assessment by the Board of Appeal is not called in question by the particular conditions in which the applicant's goods are marketed, since only the objective marketing conditions of the goods in question are to be taken into account when determining the

respective importance to be given to visual, phonetic or conceptual aspects of the marks at issue. Since the particular circumstances in which the goods covered by the marks at issue are marketed may vary in time and depending on the wishes of the proprietors of those marks, the prospective analysis of the likelihood of confusion between two marks, which pursues an aim in the general interest, namely that the relevant public may not be exposed to the risk of being misled as to the commercial origin of the goods in question, cannot be dependent on the commercial intentions of the trade mark proprietors-whether carried out or not- which are naturally subjective (see, to that effect, *NLSPORT*, *NLJEANS*, *NLACTIVE* and *NLCollection*, cited at paragraph 61 above, paragraph 49, and Case T-147/03 *Devinlec v OHIM – TIME ART (QUANTUM)* [2006] ECR II-11, paragraphs 103 to 105, upheld on appeal by the Court by judgment of 15 March 2007 in Case C-171/06 P *TIME ART v OHIM*, not published in the ECR, paragraph 59).”

14. In accordance with the above cases, I have to make the comparison on the basis of the specification of goods as currently registered by JW’s earlier mark and that for which registration is applied by TT. As TT’s application seeks registration for *clothing and footwear* and identical wording is included within JW’s earlier mark, it is self-evident that identical goods are involved. TT has acknowledged as much in its written submissions.

#### **The average consumer and the nature of the purchasing process**

15. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods. I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade.

16. In respect of clothing, in *React trade mark* [2000] R.P.C. 285, Mr Simon Thorley, sitting as the appointed person, said:

“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 order by word of mouth. Nevertheless, my own experience tells me it is true of most casual clothing. 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 orders 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.”

17. In *New Look Ltd v Office for the Harmonization in the Internal Market* (Trade Marks and Designs) Joined cases T-117/03 to T-119/03 and T-171/03 the General Court considered the level of attention paid by the average consumer when purchasing goods in the clothing sector:

“43 It should be noted in this regard that the average consumer’s level of attention may vary according to the category of goods or services in question



(see, by analogy, Case C-342/97 Lloyd Schuhfabrik Meyer [1999] ECR I-3819, paragraph 26). As OHIM rightly pointed out, an applicant cannot simply assert that in a particular sector the consumer is particularly attentive to trade marks without supporting that claim with facts or evidence. As regards the clothing sector, the Court finds that it comprises goods which vary widely in quality and price. Whilst it is possible that the consumer is more attentive to the choice of mark where he or she buys a particularly expensive item of clothing, such an approach on the part of the consumer cannot be presumed without evidence with regard to all goods in that sector. It follows that that argument must be rejected.”

18. As the *New Look* case acknowledges, the cost of clothing can vary considerably, however, I must keep in mind goods across the whole price spectrum. The same is true in respect of footwear. While the average consumer’s level of attention is likely to vary considerably given the cost and nature of the particular item being bought, I consider that, even when selecting routine items, the average consumer is likely to be conscious of factors such as the size, colour, material and price of the article concerned, its suitability for purpose and, where applicable, ease of being laundered. Overall, I think the average consumer is likely to pay a reasonable degree of attention to the selection of all the goods at issue which will be bought, primarily, by eye.

**Comparison of the respective marks**

19. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as wholes and does not pause to analyse their various details. In addition, the average consumer rarely has the chance to make direct comparisons between trade marks but must, instead, rely on the imperfect picture of them he may have kept in mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant elements of the respective trade marks and, with that conclusion in mind, I must go on to compare the respective trade marks from the visual, aural and conceptual perspectives.

20. For ease of reference, the marks to be compared are as follows:

JW’s earlier mark	TT’s application
	

21. I pause at this point to acknowledge that on the form by which it sought registration of its mark, TT requested the entry on the register of a voluntary disclaimer. It appears that the wording of that disclaimer was later amended and, as published, now reads:

“Registration of this mark shall give no right, separately to the exclusive use of the words Toby Tiger and the device of a paw print”.

22. I do not know what TT’s intention might have been when it sought to enter a disclaimer, however, the wording adopted appears to me to be otiose. It does no more than spell out the rights that would accrue to the mark in any event, should it achieve registration: that any rights in the mark lie in its totality.

23. JW referred me in its submissions to the case of *Medion AG v Thomson multimedia Sales Germany & Austria GmbH*, Case 120/04 which provides key guidance on how to approach issues of similarity involving composite marks as follows:

“29. In the context of consideration of the likelihood of confusion, 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. On the contrary, 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 (see *Matratzen Concord*, paragraph 32).

30. However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case and earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.

31. In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.

32. The finding that there is a likelihood of confusion should not be subject to the condition that the overall impression produced by the composite sign be dominated by the part of it which is represented by the earlier mark.

33. If such a condition were imposed, the owner of the earlier mark would be deprived of the exclusive right conferred by Article 5(1) of the directive even where the mark retained an independent distinctive role in the composite sign but that role was not dominant.

34. This would be the case where, for example, the owner of a widely-known mark makes use of a composite sign juxtaposing this mark and an earlier mark which is not itself widely known. It would also be the case if the composite sign was made up of the earlier mark and a widely-known commercial name. In fact, the overall impression would be, most often,



dominated by the widely-known mark or commercial name included in the composite sign.

35. Thus, contrary to the intention of the Community legislator expressed in the 10<sup>th</sup> recital in the preamble to the directive, the guarantee of the earlier mark as an indication of origin would not be assured, even though it still had an independent distinctive role in the composite sign.

36. It must therefore be accepted that, in order to establish the likelihood of confusion, it suffices that, because the earlier mark still has an independent distinctive role, the origin of the goods or services covered by the composite sign is attributed by the public also to the owner of that mark.”

24. There is no dispute that JW’s mark consists of a depiction of what I take to be the paw print of a four-toed clawed animal. For TT, Mr Wood’s evidence consists of exhibits of various printouts taken from the Internet which, he states, “support ... the assertion that the use of paw prints is common in the design of items of clothing”. In its written submissions, dated 10 January 2012 (but most likely misdated as they were received 11 January 2013), TT refers to this evidence and submits that “devices or paws and animal prints are common within the sector of clothing, headwear and footwear”. The printouts show a variety of clothes, boots, a beanie and a baseball cap decorated with various paw prints. Mr Wood states that his search for this material was carried out on 24 October 2012. i.e. some 13 months after the material date in these proceedings. Whilst this may not be fatal to TT’s submissions of itself, the fact is that the printouts show paw prints on the items in a decorative sense rather than in a trade mark sense.

25. In line with the decision of the CJEU in Case C-196/00 P, *Formula One licensing BV v OHIM, Global Sports Media Ltd*, it is not permissible to regard the earlier mark as having no distinctive character. Consisting as it does of a clawed paw print device with no other elements, the distinctiveness of the mark lies in that device. Mr Morris’s second witness statement on behalf of JW acts as a vehicle for the introduction of three exhibits (CM14 – CM17) which consist of excerpts from the book *Animal Tracks and Signs* by Preben Bang and Preben Dahlstrom and from the BBC website *Wild Britain Field Guide*. The extracts show a number of animal tracks and footprints. Mr Morris gives no explanation in his evidence of the purpose of this material though JW’s written submissions, dated 10 January 2013, state that “the content and relevance [of them] were self-explanatory”. I can only say that it is not self-explanatory to me. If it is intended to show that different animals have different footprints (a fact that I doubt would be open to dispute) I cannot see how this would assist JW. The fact remains that JW’s mark is a device which has no meaning in relation to the goods for which it is registered. It is a mark with an average degree of distinctive character.

26. TT’s application consists of the words “Toby tiger” written in a somewhat “wobbly” style resembling a child’s writing. To the right of the words is what I take to be a paw print of a four-toed animal absent claws. The words within the mark hang together as a name (whether e.g. of a real tiger called Toby or, perhaps a cartoon character) and are a distinctive element of the mark. TT submits that “it is generally accepted that consumers focus on the beginning of marks; we believe this is all the

more likely when the left hand side contains the textual element which will be retained...”

27. In *Spa Monopole compagnie fermière de Spa SA/NV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-438/07* it was stated:

“23 Admittedly, the consumer normally attaches more importance to the first part of words (Joined Cases T-183/02 and T-184/02 *El Corte Inglés v OHIM-González Cabello and Iberia Líneas Aéreas de España (MUNDICOR)* [2004] ECR II-965, paragraph 81). However, that argument cannot hold in all cases (see judgment of 16 May 2007 in Case T-158/05 *Trek Bicycle v OHIM –Audi, (ALL TREK)*, not published in the ECR, paragraph 70 and the case-law cited) and does not, in any event, cast doubt on the principle that the assessment of the similarity of marks must take account of the overall impression created by them.”

28. In my view the paw device, whether a true depiction of an actual tiger’s footprint or not, is an independently distinctive element within the mark and is of equal dominance to the words Toby tiger within TT’s mark.

29. Whilst TT’s mark includes words that are absent from JW’s mark and therefore the respective marks have some visual differences, each consists of or contains the device of a paw print and so there is a degree of visual similarity between them. One of the devices has claws whereas the other does not, however, this would only be noticed on a very careful inspection: the overwhelming impression of each is of a footprint of an animal. The respective marks are visually similar to a fairly high degree.

30. As TT submit, its mark is likely to be referred to as Toby tiger on the general principle that it is the words within a mark that the average consumer is likely to use. JW’s mark, is likely to be referred to as ‘animal print’ or ‘footprint’. From an aural perspective, the marks are dissimilar.

31. Being a depiction of an animal footprint, that is what JW’s mark is likely to bring to mind. Given the words within TT’s mark, it is likely that the footprint within its mark will be taken to be that of the tiger called Toby. As both marks bring to mind the footprint of an animal there is a moderate degree of conceptual similarity between them.

### **The distinctive character of the earlier mark**

32. The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which it has been acquired and, secondly, by reference to the way it is perceived by the relevant public (see *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods and services for which it has been registered as coming from a particular undertaking and thus to distinguish those goods and

services from those of other undertakings (see *Windsurfing Chiemsee v Huber and Attenburger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585).

33. JW has not provided any evidence of what use may have been made of its earlier mark. That being the case, I take into account only the inherent distinctiveness of the mark which, as I have already concluded above, is average.

### **The likelihood of confusion**

34. In determining whether there is a likelihood of confusion, a number of factors have to be borne in mind. The first is the interdependency principle whereby 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 also have to factor in the distinctive character of the earlier mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely on the imperfect picture of them he has retained in mind.

35. Earlier in this decision I found that:

- JW's earlier mark is of average distinctive character which has not been shown to have been enhanced through its use;
- the device is an independently distinctive and equally dominant element within TT's mark;
- the respective goods are identical;
- the purchase of those goods is primarily visual and will involve a reasonable degree of care;
- the respective marks share a fairly high degree of visual similarity, are aurally dissimilar and have a moderate degree of conceptual similarity.

36. Taking all matters into account, I find that there is a likelihood of confusion between the respective marks. Given the words Toby tiger which appear in TT's mark which are absent from that of JW, I do not consider the marks will be directly confused with each other. Rather, I consider that the average consumer will believe that the respective goods will originate from the same or a linked undertaking and will therefore confuse them indirectly. The opposition based on section 5(2)(b) of the Act succeeds.

### **Costs**

37. The opposition having succeeded, the opponent is entitled to an award of costs in its favour. In making the award, I take into account the fact that no hearing took place. I also take into account that whilst evidence was filed it was not particularly well directed to the issues to be determined. I award costs on the following basis:

Preparing a statement and considering the applicant's counterstatement:	£300
Fee:	£200
Preparing and filing evidence:	£300
Filing written submissions:	£200
<b>Total:</b>	<b>£1000</b>

38. I order Toby Tiger Wholesale Ltd to pay Jack Wolfskin Ausrüstung für Draussen GmbH & Co KGaA the sum of £1000. 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 28th day of February 2013**

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