

O-097-14

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2645444
BY RICHARD WELLESLEY-COLE
TO REGISTER:**

KissChase
&
KISS CHASE

AS A SERIES OF 2 TRADE MARKS IN CLASSES 9 & 25

AND:

**OPPOSITION THERETO UNDER NO. 400026
BY TONY CHIMAObI OLUIGBO**

BACKGROUND

1. On 11 December 2012, Richard Wellesley-Cole (“the applicant”) applied to register the two marks shown on the cover page of this decision. The application was published for opposition purposes on 11 January 2013 for the following goods:

Class 9 - Computer games; application games for use with mobile phones; mobile phones; games for use with tablet computers; tablets and software.

Class 25 - Clothing, Footwear, Headgear.

2. The application is opposed by Tony Chimaobi Oluigbo (“the opponent”). Proceedings before the Tribunal are governed by the Trade Marks Act 1994 (the Act). The Act implements, inter alia, Directive 2008/95/EC of the European Parliament and the Council of 22 October 2008 (the Directive) (as it is now). Consequently, interpretation of the Act is made on the basis of judgments of the Court of Justice of the European Union (CJEU) and the General Court (GC), both with their seats in Luxembourg, as well as those of the courts in the United Kingdom. All of the judgments of the GC (previously the Court of First Instance) and the CJEU can be found at the url:

<http://curia.europa.eu/jurisp/cgi-bin/form.pl?lang=en>

Judgments preceded by the letter C are from the CJEU and judgments preceded by the letter T are from the GC. The former is the higher court.

Decisions of the appointed persons, who are one of the two fora for appeal from decisions of the registrar, can be found on the website of the Intellectual Property Office at the url:

<http://www.ipo.gov.uk/types/tm/t-os/t-find/t-challenge-decision-results.htm>

Decisions of the appointed persons can be identified by the prefix BL (decisions of the registrar also have this prefix). (The other fora of appeal are the High Court of England and Wales, the High Court of Northern Ireland and the Court of Session (in Scotland).)

Where available the urls for judgments of the courts of England and Wales have been given.

The acronyms RPC, FSR and ETMR refer to Reports of Patent, Design and Trade Mark Cases, Fleet Street Reports and European Trade Mark Reports respectively. These are publications in which various decisions and judgments in relation to intellectual property and the law of passing-off are reported.

3. The opposition, which is only directed against the goods in class 25 of the application, is based upon grounds under sections 5(1), 5(2)(a) and 5(2)(b) of the Act.

Although registered in classes 3, 25 and 45, the opponent only relies upon the goods in class 25 of the following Community Trade Mark (“CTM”) registration:

CTM no. 6471635 for the mark: **KISSCHASE** which was applied for on 28 November 2007 and for which the registration procedure was completed on 22 January 2009.

Class 25 – Clothing, footwear, headgear; shirts, t-shirts, vests; jeans, trousers; jackets, coats, sweaters, dresses, skirts; suits; sleepwear; underwear, undergarments; shorts, lingerie, hosiery, bras; scarves, gloves; belts; shoes, boots, trainers, sandals; beachwear, swimwear; hats and caps; socks.

4. In his Notice of opposition, the opponent states:

“4. The [competing marks] are both plain word marks consisting of the words “kiss” and “chase”, having no particular figurative elements or appearances. Both trade marks are visually, aurally and conceptually identical and/or highly similar. There is an insignificant difference between the applicant’s trade mark and the opponent’s trade mark, namely, “kisschase” is presented in a combination of upper case and lower case letters in the applicant’s trade mark and “kisschase” is presented in upper case letters in the opponent’s trade mark.

As far as the other variation of the applicant’s trade mark is concerned, the space between the words “kiss” and “chase” is insufficient to distinguish the applicant’s trade mark from that of the opponent’s, as the opponent’s trade mark separates naturally to make two words, namely, “kiss” and “chase”. As such it is highly probable that the public would regard the applicant’s trade mark as having a clear connection to the goods and services of the opponent...”

5. Insofar as the competing goods are concerned, the opponent notes that his registration and the application for registration either contain or consist of the terms “clothing, footwear and headgear” in class 25.

6. The applicant filed a counterstatement in which he states:

“The upper and lower case joined up version of KissChase does give it a distinct appearance. The upper case with a space also gives it a distinct visual appearance. More importantly this mark will be globally associated with application games, use with mobile phones, android and iPads and tablets (classification 9). The app game is based on the school playground game of Kiss Chase. This will therefore from the outset of its use associate the mark through the medium of application games and playing Kiss Chase. Further to our knowledge the opponent’s names is associated with a band. In the case of this mark, the public perception will be formed from the outset linking the mark with app games. This will ensure a distinct association between the mark and goods. This is a major factor in demonstrating that the public will not connect the trade mark with the same goods and services as the opponent, thereby there being no

likelihood of confusion. We also have a limited company called Kiss Chase Ltd strengthening and supporting the above counterstatement.”

7. Whilst neither party filed evidence, both filed submissions during the evidence rounds. Neither party asked to be heard nor did they file written submissions in lieu of attendance at a hearing. I will bear the submissions filed in mind and refer to them as necessary below.

DECISION

The Law

8. Sections 5(1), 5(2)(a) and 5(2)(b) of the Act read 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) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

(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,

(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. In these proceedings, the opponent is relying upon the mark shown in paragraph 3 above, which constitutes an earlier trade mark under the above provisions. Given the

interplay between the date on which the application was published (11 January 2013) and the date on which the earlier mark completed its registration process (22 January 2009), the earlier trade mark is not subject to proof of use as per section 6A of the Act.

Section 5(1) – case law

11. I turn first to the objection based upon section 5(1) of the Act. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA* [2003] FSR 34, the CJEU said, in relation to what constitutes an identical trade mark:

“51 There is therefore identity between the sign and the trade mark where the former reproduces, without any modification or addition, all the elements constituting the latter.

52 However, the perception of identity between the sign and the trade mark must be assessed globally with respect to an average consumer who is deemed to be reasonably well informed, reasonably observant and circumspect. The sign produces an overall impression on such a consumer. That consumer only rarely has the chance to make a direct comparison between signs and trade marks and must place his trust in the imperfect picture of them that he has kept in his mind. Moreover, his level of attention is likely to vary according to the category of goods or services in question (see, to that effect, Case C-342/97 Lloyd Schuhfabrik Meyer [1999] E.C.R. I-3819 at para.[26]).

53 Since the perception of identity between the sign and the trade mark is not the result of a direct comparison of all the characteristics of the elements compared, insignificant differences between the sign and the trade mark may go unnoticed by an average consumer.

54 In those circumstances, the answer to the question referred must be that Art.5(1)(a) of the Directive must be interpreted as meaning that a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

Comparison of marks

Opponent's mark	Applicant's marks
KISSCHASE	KissChase
	KISS CHASE

12. The opponent's mark consists of the nine letters K-I-S-S-C-H-A-S-E presented as one word in upper case. The applicant's marks consist of the same nine letters in the same order. In the first mark in the series the letters are, with the exception of the letters K and C which are presented in upper case, presented in lower case. Although

presented in a conjoined fashion, the presentation of the letters K and C in upper case serve to separate the mark into two elements i.e. Kiss and Chase. The second mark in the series is presented as two separate words in upper case. The opponent's mark and the first of the applicant's marks are both conjoined; they differ only in respect of the case in which they are presented. The second of the applicant's mark is presented in upper case as is the opponent's mark; they differ only to the extent that the applicant's mark is presented as two separate words. In his Notice of opposition, the opponent submits that his mark: "separates naturally to make two words". As the words KISS and CHASE are well known words in the English language with which the average consumer will be very familiar, I have no doubt that the opponent's submission in this respect is correct. Whilst I remind myself that the applicant thinks that the presentation of its marks gives them a "distinct appearance", the guidance provided in *Sadas* indicates that marks may be considered as identical where viewed as a whole the differences between them are "so insignificant that they may go unnoticed by an average consumer". That, in my view, is the position here. The competing marks are identical.

Comparison of goods

13. The applicant seeks registration in class 25 for "Clothing, footwear, headgear". As the opponent's specification in class 25 includes identical terms, the competing goods are clearly identical.

Conclusion under section 5(1) of the Act

14. Section 5(1) of the Act indicates that a mark shall not be registered if it is identical to an earlier mark (which I have concluded the applicant's marks are), and the goods for which the mark is applied for are identical with the goods of the earlier trade mark (which they clearly are). **As a consequence of those conclusions, the opposition to the application in class 25 succeeds.**

15. In reaching the above conclusion, I have not overlooked the applicant's comments to the effect that: (i) Kiss Chase is a school playground game (although I was not familiar with this meaning), (ii) that as his mark will be associated with application games based on the game of Kiss Chase this will condition how the average consumer perceives his mark, (iii) the opponent uses his mark in connection with a band, and (iv), that he has registered a company called Kiss Chase Limited. Having already concluded that the competing marks are identical, it follows that if the applicant's mark conveys the conceptual message he submits, the opponent's mark will convey the same message. Although the applicant submits that the opponent's mark "is associated with a band", this is irrelevant. As neither parties' specifications are limited in any way, and as marketing considerations may vary over time (the decision of the CJEU in *Devinlec Développement Innovation Leclerc SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* – case C-171/06P refers), it is on the basis of the specifications applied for and registered that I must proceed, not on the basis of how the parties intend to or may currently be using their marks. Finally, in relation to the

registration by the applicant of the company Kiss Chase Ltd, in his submission the opponent drew my attention to the following comment which appears on the Intellectual Property Office's ("IPO") website at: <http://www.ipo.gov.uk/types/tm/t-about/t-what-is/t-companies.htm>

"Company law is different from trade mark law. You cannot stop someone using a trade mark, which is the same or similar to yours, just by registering your name with Companies House."

16. Although in his submissions the applicant indicates that his reference to the registration of a company was to:

... "strengthen the counter statement based around association and interpretation of the mark relating to the game of Kiss Chase",

having already dismissed the applicant's submissions regarding the perception that will be created in relation to the goods at issue by virtue of its use on application games based on the game of Kiss Chase, the mere registration by the applicant of a company name similar to the marks the subject of his application does not assist him.

Opposition based upon sections 5(2)(a) and 5(2)(b) of the Act

17. Having found that the opposition succeeds under section 5(1) of the Act, it is not necessary for me to consider the other grounds upon which the opponent relies.

Overall conclusion

18. The opposition based upon section 5(1) of the Act succeeds and the application will be refused in so far as the goods in class 25 are concerned. The goods in class 9 have not been opposed and may proceed to registration.

Costs

19. As the opponent has been successful he is entitled to a contribution towards his costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. In making an award, I bear in mind that the opponent has represented himself throughout these proceedings.

Preparing a statement and considering the applicant's statement:	£100
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Preparing submissions and reviewing the applicant's submissions:	£100
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Opposition fee: £200

Total: £400

20. I order Richard Wellesley-Cole to pay to Tony Chimaobi Oluigbo the sum of **£400**. 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 3rd day of March 2014

C J BOWEN
For the Registrar
The Comptroller-General