

O-470-15

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 3072356
BY MULTIBRANDS INTERNATIONAL LTD
TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 28:**

FIREFLY

AND

**AN OPPOSITION THERETO (NO. 403364) BY
IIC-INTERSPORT INTERNATIONAL CORPORATION GMBH**

Background and pleadings

1. This dispute concerns whether the trade mark **FIREFLY** should be registered for the following goods in class 28:

Sports and games equipment for table tennis and tennis; parts and fittings for the aforementioned goods

2. The mark was filed by Multibrands International Ltd (the applicant) on 12 September 2014 and was published for opposition purposes on 10 October 2014.

3. Registration of the mark is opposed by IIC-Intersport International Corporation GmbH (the opponent). Its grounds are under sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (the Act). The opponent relies on the following trade mark registrations:

i) Under section 5(2)(b), the opponent relies on International Registration (IR) 1052170 which designated the EU for protection on 14 September 2010, with protection being conferred on 23 August 2011. The mark and the goods on which the opponent relies are:



Class 28: Sporting articles included in this class, including wrist guards, elbow guards, shoulder pads, ankle pads, shin guards and knee guards; bags adapted to the transport of sports items; protective paddings (parts of sports suits); roller skates, ice skates; skateboards; snowboards, skis, ski, snowboard and snowshoe bindings, ski sticks/poles, scooters (toys).

ii) Under sections 5(1)/5(2)(a), the opponent relies on Community trade mark (CTM) registration 2679215 for the mark **FIREFLY** which was filed on 30 April 2002 and which completed its registration process on 8 August 2003. The opponent relies on the mark in so far as it is registered for:

Class 28: Sporting articles included in this class, including roller skates, in-line skates, skateboards, snowboards, ice skates, sporting equipment for roller skating, in-line skating, skateboarding, sledding, ice skating and for winter sports that slide over snow, including boards and skis of all kinds; wrist pads, elbow guards, shoulder pads, ankle pads, shin guards, and knee guards, sports bags for carrying sports articles; protective paddings (parts of sports suits).

4. In opposition proceedings, certain earlier marks may only be relied upon to the extent that they have been used. However, this only applies to earlier marks which have been protected or registered for five years or more, measured at the date on which the applied for mark was published. At the date of publication mark i) had been protected for less than five years (so the proof of use provisions do not apply), whereas mark ii) had been registered for more than 5 years (so the proof of use provisions do apply). In its statement of case the opponent made a claim that mark ii) has been used in relation to all of the goods on which it relies (as set out above).

5. The applicant filed a counterstatement. It put the opponent to proof of use of mark ii), but only in respect of “sporting articles deals [sp] with Table Tennis under Class 28”. It made a number of other points including that:

- i) The average consumer (identified as a sports person) is “more conscious” towards sporting articles.
- ii) There are significant differences between the marks – the black coloured word FIREFLY underneath a coloured shield vs a flaming fireball followed by the word FIREFLY in white. I note at this stage, though, that the applied for mark does not contain a fireball, it is for the word FIREFLY alone.
- iii) The opponent’s goods deal particularly with sporting articles relating to snow sports.

6. The opponent is represented by Stobbs. The applicant is self-represented. Only the opponent filed evidence. Neither side requested a hearing or filed written submissions.

The evidence

7. The opponent’s evidence is given by Ms Emma Louise Pettipher, a trade mark attorney at Stobbs, the opponent’s representatives in this matter. Her evidence provides examples of sporting article retailers who supply both table tennis articles and skiing/winter sport articles. For reasons that will become apparent, I do not consider it necessary to summarise this evidence further.

The proof of use provisions

8. As I have already indicated, mark i) is not subject to the proof of use provisions with the consequence that it may be considered in these proceedings for its full specification as registered (to the extent relied upon) without having to prove that it has been used.

9. Mark ii) is subject to the proof of use provisions, the opponent making a statement of use matching the goods on which it relies. The applicant put the opponent to proof of use, but only, in essence, in relation to sporting articles for playing table tennis. Whilst the opponent filed evidence, it was not directed to proving that use of the earlier mark had been made. The net effect of the limited extent to which the opponent was put to proof, coupled with the opponent’s failure to

file evidence of use, is that the opponent may rely on the class 28 goods it specified, albeit with the exclusion of any goods for playing table tennis.

My approach

10. Given that mark ii) cannot be relied upon in relation to goods for playing table tennis, and given that such goods feature in the application, it is sensible to begin the assessment with mark i) which is not so limited. The ground of opposition relevant to mark i) is section 5(2)(b).

Section 5(2)(b)

11. Section 5(2)(b) of the Act states that:

“5.-(2) A trade mark shall not be registered if because – ..

(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. The following principles are gleaned from the judgments of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

(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 be dominated by one or more of its components;

(f) however, it is also 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 creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

The goods

13. The applicant seeks registration for sports and games equipment for playing table tennis and tennis (and parts and fittings). The opponent's specification reads:

Sporting articles included in this class, including wrist guards, elbow guards, shoulder pads, ankle pads, shin guards and knee guards; bags adapted to the transport of sports items; protective paddings (parts of sports suits); roller skates, ice skates; skateboards; snowboards, skis, ski, snowboard and snowshoe bindings, ski sticks/poles, scooters (toys).

14. Whilst it is true that many of the specific items covered by the opponent's specification are specific to snow/winter sports, this does not mean that I should limit the analysis to just those items. The mark is not subject to proof of use and the opponent is able to rely on all of the goods for which it is registered. I particularly note that the first term of the specification reads "sporting articles included in this class". Examples of goods which are "included" within this term are then given, but, again, this does not limit the opponent. The use of the term "including" means that the items that follow as examples, but are not exhaustive of the wider term (unlike the use of a word such as "namely" which would have a limiting effect). Consequently, the opponent's specification is to be regarded on the basis that it covers all types of sporting articles.

15. In *Gérard Meric v OHIM* (Case T-133/05) the General Court explained that goods can be considered as identical if they fall within the ambit of a general category of the competing specification, it stated:

“In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, *OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

16. This seems to be the case here. The goods applied for are all sporting articles (the use of the terms equipment/articles is interchangeable). Consequently, the applied for goods fall within the ambit of the opponent's sporting articles. The goods are identical. This applies also to the applied for parts and fittings. If I am wrong on this then the parts and fittings would nevertheless be highly similar.

Average consumer and the purchasing act

17. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

18. The average consumer could be a member of the general public who wishes to play tennis or table tennis for a sport or pastime. The goods could also be bought by professional (or semi-professional) sports people. The applicant states in its counterstatement that the average consumer is conscious of what is being bought. Whilst I do not necessarily disagree with this, this does not always equate to the purchasing process being highly considered. A professional sportsperson may be very careful during the purchasing process, but I think a member of the general public, who is likely to represent the greatest part of the relevant public, will be less so, although, they will still deploy at least a reasonable degree of care and attention.

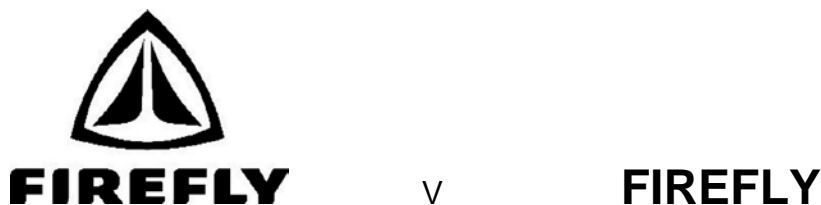
19. The goods will be selected through primarily visual means, with the goods most often being selected from sporting retail environments (or the online equivalents), from perusal of websites and brochures etc. I will not, though, ignore the aural aspects completely as the goods may be selected after discussion with salespeople.

Comparison of marks

20. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

21. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are:



22. The overall impression of the applied for mark is based on its sole component, the word FIREFLY. The opponent’s mark comprises two elements, the shield device, underneath which is the stylised word FIREFLY. The stylisation is in an extremely unremarkable font. I consider that the two elements of the earlier mark make a roughly equal contribution to its overall impression.

23. The marks are aurally identical, both will be articulated as FIRE-FLY.

24. The concept of the applied for mark will be based upon the insect, a firefly. Whilst the opponent’s mark has an additional shield device, it is still the firefly element that will form the basis of the mark’s conceptual hook. I consider the marks to be conceptually identical, if not then they must be highly similar.

25. Visually, that both marks have the word FIRELY in them creates an inevitable degree of similarity. The shield device creates a fairly obvious difference. Bearing in

mind the overall impression of the marks as identified earlier, I consider there to be a medium degree of visual similarity.

Distinctiveness character of the earlier marks

26. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

27. No evidence of use has been provided so I have only the inherent characteristics of the earlier mark to consider. The word FIRELY makes no allusion to the goods for which the mark is registered. It has an average level of distinctive character. Whether the shield device adds to the distinctiveness is not pertinent because it is the distinctiveness of the point of similarity that is key¹.

Likelihood of confusion

28. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

¹ See, for example, the decision of Mr Iain Purvis QC (sitting as the Appointed Person) in *Kurt Geiger v A-List Corporate Limited*, BL O-075-13.

29. The goods are identical. The earlier mark is averagely distinctive. A reasonable degree of care and attention will be deployed by the average consumer (at least by members of the general public). The marks are aurally and conceptually identical and there is a medium degree of visual similarity. In my view there is a likelihood of confusion. Confusion can be direct (mistaking one mark for the other) or indirect (the similarity between the marks being put down to the responsible undertaking being the same or related). Even if the average consumer noticed that one mark had a shield whereas the other did not, the common presence of the word FIREFLY, a word which is averagely distinctive and a word which plays an equal role in the overall impression of the mark, will suggest to the average consumer that the identical goods at issue come from the same or an economically linked undertaking. The opposition under section 5(2)(b) succeeds.

Section 5(1)/5(2)(a)

30. For sake of completeness, I should add that the opponent would also have succeeded under sections 5(1)/5(2)(a) based on mark ii) as set out earlier.

31. Both these grounds require that the marks be identical. They clearly are.

32. The grounds also require that the goods be identical (5(1)) or similar (5(2)(a)). Following my observations as to the proof of use provisions, the earlier mark can be relied upon for its sporting articles at large, but excluding those for playing table tennis. Therefore, to the extent that the application is for goods for playing tennis (as opposed to table tennis), such goods are identical, with the consequence that the ground under section 5(1) is made out.

33. To the extent that the application is for goods for playing table tennis, there must be at least a medium level of similarity between table tennis goods (as applied for) and tennis goods (as notionally covered by the earlier mark). When this is added to the identity between the marks and the average level of distinctiveness of the word FIREFLY, then there would, in my view, be a likelihood of confusion. The ground under section 5(2)(a) would therefore have succeeded in relation to table tennis goods.

Costs

34. The opponent has succeeded and is entitled to a contribution towards its costs. My assessment is set out below. It should be noted that I have not awarded costs in relation to the opponent's evidence. The evidence related to the channels of trade of table tennis articles on the one hand and winter sports apparatus on the other. Such evidence was simply unnecessary given what the opponent was able to rely on.

Opposition fee - £100

Preparing a statement and considering the other side's statement - £300

Total - £400

35. I therefore order Multibrands International Ltd to pay IIC-Intersport International Corporation GmbH the sum of £400. This should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 7th day of October 2015

**Oliver Morris
For the Registrar,
The Comptroller-General**