

O-509-19

TRADE MARKS ACT 1994

IN THE MATTER OF:

**APPLICATION No. 3309990
BY MICHEL ROGER MAURER
TO REGISTER**

WOOLABIES

IN CLASSES 18, 25 & 28

AND

**OPPOSITION THERETO (UNDER No. 413873)
BY C. & J. CLARK INTERNATIONAL LIMITED**

Background and pleadings

1. The relevant details of the subject application are as follows:

Mark:	WOOLABIES
Filing date:	10 May 2018
Publication date:	27 July 2018
Applicant:	Michel Roger Maurer

Class 18: Leather and imitations of leather; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery; articles of luggage being bags; baggage; travel baggage; travel bags; weekend bags; work bags; toiletry cases sold empty; tool bags [empty]; sports bags; shopping bags; bags for clothes; bags made of leather; bags made of imitation leather; travel bags made of plastic material; money bags; school bags; shoe bags.

Class 25: Clothing; footwear; headgear.

Class 28: Sports equipment.

2. Registration of the mark is opposed by C. & J. Clark International Limited (“the opponent”). Its grounds are based on sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). In relation to the section 5(2)(b) ground, the opponent relies on the following marks:

- i) UK registration 1134824 for the mark **WALLABEES** which was filed on 5 June 1980 and registered shortly thereafter. The mark is registered for the following goods in class 25: “Stockings, pantie-hose; socks and tights, all for wear.....Boots, shoes, sandals, slippers, leggings and gaiters.....Boots and shoes.”

- ii) European Union Trade mark (“EUTM”) 224006 for the mark **Wallabees** which was filed on 1 April 1996 and registered on 23 October 1998. The mark is registered for the following class 25 goods: “Footwear; boots, shoes and slippers.”

3. Under section 5(2)(b), the opponent claims that the marks are very similar visually and aurally. It states that “WALLABEE is similar to “wallaby”. “WOOLABIES” has no meaning”. It states that the respective goods are similar and that there is a likelihood of confusion.

4. Under section 5(4)(a), the opponent relies on the use of the word **WALLABEES** in the UK since 1967 in connection with footwear. It states that it has considerable goodwill and reputation in that sign and that the use of the applied for mark would constitute a misrepresentation, with the public likely to believe that there is an economic connection between the applicant and the opponent.

5. Both of the opponent’s marks were filed before the applicant’s mark, so meaning that they qualify as earlier marks in accordance with section 6 of the Act. It is not in dispute that the proof of use provisions (as set out in section 6A of the Act) apply to the earlier marks, both having completed their respective registration procedures before the 5-year period ending on the date the applicant’s mark was published for opposition purposes. In respect of the first mark above, the opponent made a statement of use in relation to “shoes” and, in respect of the second mark, “footwear”.

6. The applicant filed a counterstatement denying the grounds of opposition. It also put the opponent to proof of use in respect of its earlier marks.

7. Only the opponent filed evidence, together with some written submissions. This will be summarised to the extent necessary. Neither side requested a hearing. The applicant filed written submissions in lieu of a hearing. The opponent has been represented by Squire Patton Boggs (UK) LLP, the applicant by Taylor Wessing LLP.

The proof of use provisions

8. The relevant provisions are contained in section 6A of the Act, which read:

“6A Raising of relative grounds in opposition proceedings in case of non-use

(1) This section applies where-

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier mark unless the use conditions are met.

(3) The use conditions are met if-

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of

the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and,

(b).....

(5)

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

9. Section 100 is also relevant; it reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

10. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) (28 June 2018), Arnold J. summarised the case-law on genuine use:

“114. The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 *P Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F.*

Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse
[EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]- [51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]- [23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

11. The opponent's evidence comes in the form of a witness statement by Mr Paul Wakefield, its Chief Legal Officer and Company Secretary. The first part of his witness statement contains evidence about the opponent's business generally. I do not consider it necessary to provide a great amount of detail in relation to this because it is the use of the mark(s) relied upon which is important. However, for context, it appears clear that the opponent operates the well-known footwear retailer **Clarks** and sells products under that name.

12. In relation to the name **WALLABEES** (prints of the respective registrations are provided in Exhibit PAW3), Mr Wakefield provides the following exhibits:

- **PAW4** - After stating that the mark WALLABEES has been used since 1967, Mr Wakefield provides this Exhibit which contains a print from the website welldresseddad.com entitled "Clarks Wallabees, everything for everyone?". The webpage appears to date from April 2014. The website is in the form of blog. The blog article details the history of the product (a moccasin style boot or shoe) from 1967 onwards, including small changes in its design. The article highlights the band The Verve, who wore them on the cover of their 1997 album Urban Hymns. The article further notes that they were worn by the main character in the TV series Breaking Bad and that they were popular with the rap band Wu Tang Clan; members of the Wu Tang Clan have, apparently, referenced the Wallabee in rap.
- **PAW5** - After stating that the Wallabee has been sold through the opponent's own website, and via retailers such as Asos, Amazon and Jacamo, Mr Wakefield provides this exhibit which contains i) an undated print from the opponent's website headed WALLABEES, with 3 individual Wallabee shoes depicted; ii) an undated print from the website ASOS.COM featuring Clarks Original Wallabee shoes/boots, iii) an undated print from the website amazon.co.uk showing a Clarks Men's Wallabee Shoe and a Clarks Originals Men's Wallabee Derby, and iv) an undated print from the website jacamo.co.uk showing two pairs of Clarks Originals Wallabee.

- **PAW6** – This contains an article from the website internetretailing.net. The article is about the Clarks brand and how it has tried to win over new, younger customers. In relation to what is said to be its sizeable following, reference is made to the Clarks Wallabee. The Wu Tang Clan are mentioned, who are apparently “Wallabee aficionados”. Apparently, the celebrities Kanye West and Drake have been spotted wearing Wallabees. It is stated that Clarks has sought to make the most of such associations through its Clarks Originals sub-brand which has the tagline “Iconic. Authentic. Individual”. The date of this article is not clear, but there is a reference to the article first appearing in the Internet Retailing Brand Index Report 2018.
- **PAW7** – This contains an article dated 25 April 2018 from the website pausemag.co.uk. It is about a tie in between Clarks and the clothing label (OVO), the label of the celebrity Drake. It states that “today”, it has been announced that a collaboration will take place in relation to “OVO x Clarks Originals “Made in Italy” Wallabee.” The article refers to the Wallabee as “..an iconic silhouette”, and a “70s Cult Classic”.
- **PAW8** – This contains extracts from a book published in 2013 entitled “Clarks: made to last: the story of Britain’s best known shoe store”. Pages 204, 342 and 343 are provided which refer to the Wallabee. It is referred to as “iconic”. Reference is also made to the album cover by The Verve.
- **PAW9** - Mr Wakefield states that there has been continuous use of the name and in this exhibit he provides internet archive prints from the opponent’s website which feature Wallabee boots or shoes from December 2014, June 2015, July 2016 and September 2018.
- **PAW10** – This contains what are said to be representative invoices dated between 2013 and 2018. The customer details are redacted, but they must be wholesale customers given the numbers involved. Although the invoices cover other items, the Wallabee name is used in relation to a good number of products.

Genuine use

13. The relevant period in which genuine use must be shown is 28 July 2013 to 27 July 2018. I note when reaching my conclusions, the comments made in the applicant's submissions relating to the opponent's evidence, highlighting, amongst other points, the absence of dates in some of the exhibits. In terms of whether genuine use has been (and proven to be) made, I would not describe Mr Wakefield's evidence as good, but it is, in my view, just good enough. It is surprising that in a case requiring the establishment of genuine use that no turnover or sales figures are provided, and there is no evidence of what is spent on promoting the goods sold under the mark. Similarly, there are no examples of traditional advertising. That said, the internet archive evidence does show the goods being offered for sale during the relevant period and sales have been made at least on a wholesale basis. The evidence from third party websites does not greatly assist because many are not dated. Neither does the material relating to the brand history greatly assist because this adds little to the objective detail of use in the relevant period, although it does support the general picture set out in the evidence that this is a longstanding and ongoing product. In reaching this view (that genuine use has been made), I have of course borne in mind that the opponent's stylised mark is an EUTM and, consequently, that the use must be "in the EU". However, bearing in mind the guidance in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, I am satisfied that the genuine use requirement is met within the EU context.

Variant use

14. The marks as registered are: **WALLABEES** and **Wallabees**. Whilst a good deal of the actual use uses the name Wallabee (as opposed to WALLABEES) there is some use of WALLABEES per se when used to identify products collectively. In any event, I would have been prepared to accept that the use of Wallabee is an acceptable variant form of the registered form WALLABEES. The difference is just in terms of pluralisation and does not alter the distinctive character of the mark as registered. All of this applies in equal measure to the stylised form of the registered mark. The

stylisation is minimal. Use without such stylisation, whether that is of the word WALLABEES or Wallabee, similarly does not alter its distinctive character.

Fair specification

15. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

16. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows:

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme

Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

17. In terms of the opponent's statement of use, it claims "shoes" in relation to its word mark, and "footwear" in relation to its stylised mark. In terms of the use actually made, it is clear from the evidence that the mark has been used in relation to one product and one product only. The goods are moccasin style (this is how some of the articles refer to them) shoes. They have also been sold in boot form. In terms of a fair specification to reflect such use, stripping protection down to being moccasin styled is too picky. However, when it comes to sub-categories, I think it fair to assume that the average consumer would consider it to be a casual shoe (or boot). I do not consider that the term footwear at large is an appropriate sub-categorisation. The fair specifications will be as follows:

The word only mark: casual shoes (I cannot go wider than this because use was only claimed for shoes).

The stylised mark: casual boots and shoes

Section 5(2)(b)

18. 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.”

19. 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 greater 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.

Comparison of goods

20. All relevant factors relating to the goods should be taken into account when making the comparison. In *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer* the Court of Justice of the European Union (“the CJEU”), Case C-39/97, stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

21. Guidance on this issue has also come from Jacob J where, in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, the following factors were highlighted as being relevant:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance

whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

22. In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v OHIM*, Case T- 325/06, it was stated:

“It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”

23. The applicant seeks registration in relation to:

Class 18: Leather and imitations of leather; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery; articles of luggage being bags; baggage; travel baggage; travel bags; weekend bags; work bags; toiletry cases sold empty; tool bags [empty]; sports bags; shopping bags; bags for clothes; bags made of leather; bags made of imitation leather; travel bags made of plastic material; money bags; school bags; shoe bags.

Class 25: Clothing; footwear; headgear.

Class 28: Sports equipment.

24. Looking firstly at the applied-for goods in class 28, the opponent’s submissions highlight that the terms could cover skating boots which are similar, in its view, to goods in class 25. Whilst this submission is noted, the example given does not in my view give rise to similarity with casual boots (or shoes). The purpose is different, the channels of trade will differ and the nature (although both may potentially be boot shaped) is also likely to be different. The goods do not compete nor are they

complementary. I find no similarity between the goods in class 28 with the (fair) specifications of the earlier marks.

25. I now consider the goods in class 18, breaking them down where appropriate:

Leather and imitations of leather; animal skins, hides

26. These are raw materials, not items made from such materials. Whilst the goods of the earlier marks could be made from such materials, they are still very different in nature, purpose and channels of trade. The average consumer will rarely be in a position to make their own shoes/boots, so there is no material level of competition. In terms of complementarity, whilst the material per se is indispensable in the creation of a shoe/boot, the relationship is not one where it is obvious to me that the average consumer would expect the same undertakings to produce both. I come to the view that there is no similarity between the goods. If I am wrong on that, any similarity must be very low.

Umbrellas, parasols and walking sticks

27. I see no rhyme or reason to find that these goods are similar to the (fair) specifications of the earlier marks. The purpose and nature are like chalk and cheese. Whilst they could be sold in the same shop (if the shop sold a large range of goods) they will not be sold in close proximity. The goods do not compete. Any argument that they are complementary is extremely weak; I see no reason for concluding that the consumer would regard the undertakings responsible for these goods as being the same. I find no similarity between these goods with the (fair) specification of the earlier mark.

Whips, harness and saddlery

28. I see no rhyme or reason to find that these goods are similar to the (fair) specifications of the earlier marks. The goods are not similar.

Trunks and travelling bags; articles of luggage being bags; baggage; travel baggage; travel bags; weekend bags; work bags; sports bags; shopping bags; bags made of leather; bags made of imitation leather; travel bags made of plastic material; money bags; school bags

29. In comparison to shoes/boots, the goods are very different in nature and serve a very different purpose. The goods do not compete. It is possible for them to be sold through the same trade channels, but, in my experience, not in particularly close proximity. The closest goods are likely to be fashion bags such as hand bags, compared to shoes. However, any complementarity (and resulting similarity) on this basis is only low given that the shoes/boots of the fair specification are casual in nature – the degree to which they aesthetically complement is therefore less compared to more formal shoes/boots. For goods other than fashion bags such as handbags, there is no similarity.

Toiletry cases sold empty; tool bags [empty]

30. I see no rhyme or reason to find that these goods are similar to the (fair) specifications of the earlier marks. The goods are not similar.

Bags for clothes; shoe bags

31. In respect of these goods, there is no similarity in purpose or nature, neither do the goods compete. It is unlikely that bags for clothes will be sold in close proximity or through the same trade channels as casual shoes/boots. There is, though, a much closer link at the point of sale with shoe bags, which will likely be sold in close proximity. Bags for clothes are not complementary to shoes/boots, however, there is some complementarity with shoe bags, which may be sold specifically to protect and carry the shoes that they are intended to contain. I consider there to be no similarity with bags for clothes, and a medium degree of similarity with shoe bags.

32. That then leads to the goods in class 25: clothing; footwear; headgear. In relation to footwear, the goods encompass boots/shoes, so are identical on an inclusion basis. Even in relation to other types of footwear, I still consider there to be a reasonably high

degree of similarity given the inherent similarities in nature and purpose, and the similar trade channels through which they will be sold. Headwear presents different considerations. The goods will differ in nature, and any similarity in purpose is based on the fact that they all clothe certain (but different) parts of the body. The goods do not compete. They may be some overlap in trade channels, but they are unlikely to be sold in particularly close proximity. In terms of complementarity, I doubt there is much aesthetic complementarity between headwear and casual shoes/boots. I consider there to be only a very low level of similarity. That leaves clothing. The term clothing could include footwear, so the same findings I have already made apply. If footwear were removed from the broad term clothing, the remaining clothing items will be different in nature and have only a very general degree of similarity in purpose (clothing parts of the body). The goods do not compete. There may be slightly more complementarity between clothing and boots/shoes (than assessed for headwear) but not by much - the same applies to the channels of trade assessment. I consider the goods (if footwear were removed) to be similar to only a low degree.

Average consumer and the purchasing act

33. 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.”

34. I have found similarity in the field of clothing and bags. The average consumer is a member of the general public. Such items are not, generally speaking, greatly expensive. Some care will be taken in respect of style, colour, fitness for purpose etc. Some of the goods will be tried on. I consider that this all equates to a reasonable, no higher or lower than the norm, level of care and consideration. The goods will be perused in traditional bricks and mortar retail establishments and their online equivalents. The goods and the marks used in relation to them may be seen in advertisements and on websites. This means that the visual impression of the marks may take on more significance, but the aural impact of the marks should not be ignored from the assessment completely.

Comparison of marks

35. 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.”

36. It would be wrong, therefore, to dissect the trade marks artificially, 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:

WOOLABIES

v

WALLABEES & **Wallabees**

37. All of the marks have just one component, consequently, that is the only thing that contributes to their respective overall impressions. Whilst acknowledging that the opponent's stylised mark has a degree of stylisation, the font used is fairly unremarkable so, whilst the stylisation will be taken into account in the assessments I come to make, the degree to which it contributes to the overall impression of the mark is limited.

38. Aurally, the articulations will be along the lines of: wool-a-bees v wall-a-bees. All the marks have a three-syllable structure. The middle and end of the articulations sound the same. There is some similarity in the articulation of the beginning parts of the marks as the first syllables start with a W sound and end with an L sound. The applicant notes that the difference is at the beginning of the mark, nevertheless, there is still, in my view, a very high degree of aural similarity as a whole.

39. Visually, the marks are of the same length (both being 9 letter words). They all have a W at the start, have the letters L-A-B in the middle, and end in the letters E-S. There are, though, some differences; the A-L instead of O-O as the second and third letters, and the E for an I as the seventh letters. The competing submissions highlight such similarities and the differences, with the applicant, again, highlighting the difference at the beginning of the marks. Weighing the similarities and differences, I consider there to be a reasonably high level of visual similarity. This applies even to the stylised mark. This is because even though the stylisation constitutes a difference, its impact is minimal given the limited weight that the stylisation plays in the overall impression of that earlier mark.

40. From a conceptual basis, both marks are, strictly speaking, invented words. However, the opponent submits, and I agree, that WALLABEES (and its stylised version) is a word strongly suggestive of a wallaby. Whilst there is a difference in spelling (although some average consumers may not even notice this), the consumer will still conceptualise the mark on the basis of this marsupial. WOOLABIES, on the other hand, does not so strongly evoke a wallaby. I think that most average consumers will see the mark purely as an invented word, albeit one which makes some form of reference to wool. For such people, there is a conceptual difference. I believe, though, that a small number of average consumers may also conceptualise WOOLABIES on the basis of the marsupial; for such people there is conceptual similarity.

Distinctive character of the earlier trade mark

41. Having compared the marks, it is necessary to determine the distinctive character of the earlier mark, in order to make an assessment of the likelihood of confusion. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, the CJEU stated that:

“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 *WindsurfingChiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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).”¹

42. I will consider the mark firstly upon the basis of its inherent qualities. The mark is an invented word which evokes a wallaby. There is no material connection between a wallaby and the goods for which the earlier mark is to be taken into account. I consider there to be a reasonably high degree of inherent distinctiveness, but not of the highest level.

43. In terms of the use made, the opponent submits that the mark is highly distinctive. I accept that the evidence shows a long-standing use dating back many years. However, the absence of turnover and advertising figures makes it very difficult to establish the impact the use will have had on the average consumer. The evidence relating to celebrity use (such as the goods being worn by the band The Verve) does not in my view materially improve the position. It is not clear whether the average consumer will have noted any of this, or, even if they did, whether it would have been connected with the name WALLABEES. The latest Drake promotion is from so close to the relevant date it is difficult to gauge what impact this would have had on the relevant public. The history of the WALLABEE being given in a blog is noted, and I note the writer refers to it as being iconic, however, without better evidence I am not prepared to infer that the level of distinctive character, measured from the perspective of the average consumer, has been enhanced to any material extent.

Likelihood of confusion

44. 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. Confusion can be direct (which in effect occurs when the average consumer mistakes one mark for the

¹ C-342/97, paras. 22-23

other) or indirect (where the average consumer realises the marks are not the same, but puts the similarity that exists between the marks/services down to the responsible undertakings being the same or related). In terms of indirect confusion, this was dealt with by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 where he noted that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark”.

45. There are a number of factors competing here. Some of the goods are identical, but others are less so². There is a high/reasonably high degree of aural/visual similarity. For most average consumers there is a conceptual difference, but for some smaller number there may be a degree of conceptual similarity. The mark is reasonably high in inherent distinctiveness, but this has not been enhanced through use.

46. I begin by considering identical goods – footwear (and clothing consisting of footwear) in the applied for mark, against casual shoes/boots in the earlier marks. Whilst a conceptual difference may often counteract visual and aural similarities, this

² For those goods with no similarity there can be no likelihood of confusion as some similarity is required – see, for example, Case C-398/07 P, *Waterford Wedgwood plc v Assembled Investments (Proprietary) Ltd, OHIM*

is not always the case³. In my view, the visual and aural similarities are so pronounced that the average consumer may select one instead of the other by way of simple mistake, seeing one as the other. Thus, even for consumers who would not place a marsupial meaning on WOOLABIES, this is not enough to counteract the other aspects of similarity on this occasion. Even if the conceptual difference (and the inherent differences between the marks) were noticed, I believe that a good many people would simply assume that the applied-for mark is a wool based version of the earlier mark, in relation to the identical goods in play. There is a likelihood of confusion in relation to identical goods. To the extent that footwear includes items beyond shoes/boots my finding is the same. There is still a reasonably high degree of similarity between the goods, and the same mistake/assumption on the part of the average consumer is applicable. This also applies to footwear to the extent that it is additionally covered by the broad term clothing.

47. In relation to headwear, the similarity between the goods is lower. When this is added to the mix, there is less chance of the average consumer assuming that the headwear goods sold under the applied for mark comes from the same undertaking as the earlier mark. There is less prospect of mistake and less prospect of an assumption that the goods are wool versions of the boots/shoes of the opponent. Even for the small number of average consumers who may see a conceptual similarity, not enough of them will, in my view, go on to assume that the goods come from the same or related undertaking. There is no likelihood of confusion here.

48. In relation to clothing (other than footwear included within this term), I come to the same finding as above, for the same reasons. This also applies to the applied-for bags in class 18, save for shoe bags which I consider to have a close enough relationship with shoes to result in confusion. I should also add that because some of the class 18 goods are broad enough terms to include shoe (and boot) bags within their ambit, those terms must be limited by way of simply exclusion for them to be able to proceed.

³ See, for example, *Nokia Oyj v OHIM*, Case T-460/07

Section 5(4)(a)

49. Section 5(4)(a) of the Act reads:

“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. It is settled law that for a successful finding under the law of passing-off, three factors must be present: i) goodwill, ii) misrepresentation and iii) damage. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the Jif Lemon case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “a substantial number” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per

Interflora Inc v Marks and Spencer Plc [2012] EWCA Civ 1501, [2013] FSR 21).”

Goodwill

51. Goodwill was described in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), where the Court stated:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

52. It is clear that the opponent has the requisite goodwill, in terms of the operation of a business in the footwear field. This, though, is predominantly associated with the name CLARKS. The real question is about the degree of association, if any, between the opponent's goodwill and the name WALLABEES. Earlier I found that there had been genuine use, but no enhancement of distinctive character for the purposes of section 5(2)(b) of the Act. The legal test of goodwill and proof of use/enhanced distinctive character are, of course, different, but my assessment of the evidence is the same. The opponent has not done a good job of demonstrating how much use of the mark has been made and its resultant exposure to members of the public. Therefore, whilst I consider it fair to infer that the opponent's goodwill is associated with the WALLABEES name to some extent, I cannot infer that this is of a particularly strong nature.

Misrepresentation

53. The relevant test for misrepresentation was dealt with in *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, where Morritt L.J. stated:

“There is no dispute as to what the correct legal principle is. As stated by *Lord Oliver of Aylmerton in Reckitt & Colman Products Ltd. v. Borden Inc. [1990] R.P.C. 341 at page 407* the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

The same proposition is stated in *Halsbury's Laws of England 4th Edition Vol.48 para 148* . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd. (1941) 58 R.P.C. 147 at page 175* ; and *Re Smith Hayden's Application (1945) 63 R.P.C. 97 at page 101.*”

And later in the same judgment:

“.... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

54. In the same case, *Morritt L.J.* explained that it was the plaintiff's (in the case before me the opponent's) customers or potential customers that must be deceived:

“This is the proposition clearly expressed by the judge in the first passage from his judgment which I quoted earlier. There he explained that the test was whether a substantial number of the plaintiff's customers or potential customers had been deceived for there to be a real effect on the plaintiff's trade or goodwill.”

55. In a passing-off case, it is not necessary for the competing goods to be similar. I note, though, what Millet L.J. stated in *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA), about the lack of a requirement for the parties to operate in a common field of activity, and about the additional burden of establishing misrepresentation and damage when they do not:

“There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff’s business. The expression “common field of activity” was coined by *Wynn-Parry J. in McCulloch v. May* (1948) 65 R.P.C. 58, when he dismissed the plaintiff’s claim for want of this factor. This was contrary to numerous previous authorities (see, for example, *Eastman Photographic Materials Co. Ltd. v. John Griffiths Cycle Corporation Ltd.* (1898) 15 R.P.C. 105 (cameras and bicycles); *Walter v. Ashton* [1902] 2 Ch. 282 (The Times newspaper and bicycles) and is now discredited. In the *Advocaat* case Lord Diplock expressly recognised that an action for passing off would lie although “the plaintiff and the defendant were not competing traders in the same line of business”. In the *Lego case Falconer J.* acted on evidence that the public had been deceived into thinking that the plaintiffs, who were manufacturers of plastic toy construction kits, had diversified into the manufacture of plastic irrigation equipment for the domestic garden. What the plaintiff in an action for passing off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties.

The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration

‘...whether there is any kind of association, or could be in the minds of the public any kind of association, between the field of activities of the plaintiff and the field of activities of the defendant’:

Annabel's (Berkeley Square) Ltd. v. G. Schock (trading as *Annabel's Escort Agency*) [1972] R.P.C. 838 at page 844 per Russell L.J.

In the *Lego case Falconer J.* likewise held that the proximity of the defendant's field of activity to that of the plaintiff was a factor to be taken into account when deciding whether the defendant's conduct would cause the necessary confusion.

Where the plaintiff's business name is a household name the degree of overlap between the fields of activity of the parties' respective businesses may often be a less important consideration in assessing whether there is likely to be confusion, but in my opinion it is always a relevant factor to be taken into account.

Where there is no or only a tenuous degree of overlap between the parties' respective fields of activity the burden of proving the likelihood of confusion and resulting damage is a heavy one. In *Stringfellow v. McCain Foods (G.B.) Ltd.* [1984] R.P.C. 501 Slade L.J. said (at page 535) that the further removed from one another the respective fields of activities, the less likely was it that any member of the public could reasonably be confused into thinking that the one business was connected with the other; and he added (at page 545) that

'even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.'

In the same case Stephenson L.J. said at page 547:

'...in a case such as the present the burden of satisfying Lord Diplock's requirements in the *Advocaat* case, in particular the fourth and fifth requirements, is a heavy burden; how heavy I am not sure the judge fully appreciated. If he had, he might not have granted the respondents relief. When the alleged "passer off" seeks and gets no benefit from using another trader's name and trades in a field far removed from competing

with him, there must, in my judgment, be clear and cogent proof of actual or possible confusion or connection, and of actual damage or real likelihood of damage to the respondents' property in their goodwill, which must, as Lord Fraser said in the *Advocaat* case, be substantial.' ”

56. In my view, bearing in my mind my assessment of the similarities between marks already made, together with my assessment of the strength of goodwill, the opponent only succeeds in terms of misrepresentation to the same extent as I have found under section 5(2)(b). Whilst recognising the difference in legal tests between likelihood of confusion and misrepresentation, I am not prepared to accept that there will be a relevant misrepresentation for anything beyond that.

Damage

57. In *Harrods Limited v Harrodian School Limited* Millett L.J. described the requirements for damage in passing-off cases like this:

“In the classic case of passing off, where the defendant represents his goods or business as the goods or business of the plaintiff, there is an obvious risk of damage to the plaintiff's business by substitution. Customers and potential customers will be lost to the plaintiff if they transfer their custom to the defendant in the belief that they are dealing with the plaintiff. But this is not the only kind of damage which may be caused to the plaintiff's goodwill by the deception of the public. Where the parties are not in competition with each other, the plaintiff's reputation and goodwill may be damaged without any corresponding gain to the defendant. In the *Lego* case, for example, a customer who was dissatisfied with the defendant's plastic irrigation equipment might be dissuaded from buying one of the plaintiff's plastic toy construction kits for his children if he believed that it was made by the defendant. The danger in such a case is that the plaintiff loses control over his own reputation.”

58. In *Ewing v Buttercup Margarine Company, Limited*, [1917] 2 Ch. 1 (COA), Warrington L.J. stated that:

“To induce the belief that my business is a branch of another man's business may do that other man damage in various ways. The quality of goods I sell, the kind of business I do, the credit or otherwise which I enjoy are all things which may injure the other man who is assumed wrongly to be associated with me.”

59. In this case, and bearing in mind where I have held misrepresentation, there is a likelihood of damage on the basis of the potential loss of sales and damage in the more general sense outlined in the above case.

Conclusion

60. The opposition succeeds in part. As such, and subject to appeal, the applied-for mark is refused registration in relation to:

Class 18: Shoe bags

Class 25: Footwear

61. But may proceed to registration (along with the simple exclusions mentioned earlier) in respect of:

Class 18: Leather and imitations of leather; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery; articles of luggage being bags; baggage; travel baggage; travel bags; weekend bags; work bags; toiletry cases sold empty; tool bags [empty]; sports bags; shopping bags; bags for clothes; bags made of leather; bags made of imitation leather; travel bags made of plastic material; money bags; school bags; but not including boot or shoe bags.

Class 25: Clothing, but not including footwear; headgear.

Class 28: Sports equipment.

Costs

62. The applicant has been largely successful, and I consider he is entitled to an award of cost, albeit reduced from what I may otherwise have awarded if he had been fully successful. My assessment is as follows:

Considering the statement of case and filing a counterstatement: £150

Considering evidence: £400

Preparing written submissions: £350

63. I therefore order C. & J. Clark International Limited to pay Michel Roger Maurer the sum of £900. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 30th day of August 2019

Oliver Morris

For the Registrar

the Comptroller-General