

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 211175B
BY B-LINE CLOTHING LIMITED TO REGISTER
A TRADE MARK IN CLASS 25**

AND

**IN THE MATTER OF OPPOSITION No 47966 THERETO
BY H & M HENNES & MAURITZ AB**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2111175B
by B-Line Clothing Limited to register
a Trade Mark in Class 25**

and

**IN THE MATTER OF Opposition No 47966 thereto
by H & M Hennes & Mauritz AB**

BACKGROUND

1. On 25 September 1996 B-Line Clothing Limited applied to register the trade mark PULSE 8 in Class 25 in respect of the following goods:

"Clothing for outdoor and sporting activities; but not including neckties or any similar goods to these excluded goods."

2. The application numbered 2111175B was published for opposition purposes on 1 October 1997. (The application was divided from the original application at the same time as 2111175A, for the same goods. That part consists of a series of four marks - PULSE 8 and device - and is the subject of Opposition No. 47967).

3. On 23 December 1997 H & M Hennes & Mauritz AB filed notice of opposition to this application. The grounds of opposition in summary are:

- 1, The opponent is the registered proprietor of registration No. 2008651 for PULS & device.
2. The mark applied for offends the provisions of Section 5(2)(b) of the 1994 Trade Marks Act in that the applicants' mark is similar to the opponents' mark and is to be registered for goods identical or similar to those for which the opponents' earlier mark is protected.
3. The mark applied for offends Section 5(4)(a) of the Act and is liable to be prevented by the common law rights of the opponent.
4. The applicant has no bona fide intention to use the trade mark applied for in relation to the goods for which registration is sought and should be refused under the provisions of Section 3(6) and 32(3) of the Act.
5. The application was filed in bad faith and registration will accordingly offend the provisions of Section 3(6) of the Act.

6. The opponents' trade mark is entitled to protection in the United Kingdom under the Paris Convention as a well-known trade mark and registration of the applicants' mark will offend the provisions of Section 5(4) and Section 56 of the Act.
4. The applicants filed a counterstatement denying all grounds and saying they have used the mark applied for in the United Kingdom for at least six years and are unaware of any instances of confusion.
5. Both sides seek an award of costs.
6. Both sides have filed evidence but neither party has asked to be heard. Acting on behalf of the Registrar and after a careful study of the papers I give this decision.

OPPONENTS' EVIDENCE

7. This consists of a statutory declaration dated 17 July 1998 by John Alfred Caisley. He says that he is a member of the Institute of Trade Mark Agents, a partner in The GSCP Partnership and is acting for the opponent in these proceedings.
8. Mr Caisley says that the opponents are the proprietors of registration No. 2008651 in Classes 14, 18 and 25. The details are produced as Exhibit JAC1, and as Annex A to this decision. He goes on to say that the applicants' mark was filed for a list of goods identical to those covered by the opponents' mark and that the marks are similar. Both marks include the four letters PULS and are likely to be pronounced the same or in a very similar manner and would lead to confusion.
9. Mr Caisley says that the opponents have not yet commenced use of its mark in the United Kingdom but that the marks are too similar to co-exist in the market place and that the opponent should not be prejudiced from being able to commence use of its registered mark. He also says that, if they do, it is likely that the public will be deceived and damage caused to the opponents' future sales under its mark.

APPLICANTS' EVIDENCE

10. This consists of a statutory declaration dated 2 February 1999 by Brian Annetts. He says he is the proprietor and Managing Director of B-Line Clothing Limited, the applicants.
11. Mr Annetts says that the applicants have manufactured mountaineering and outdoor clothing under the mark since 1990 and is "now nationally and internationally recognised as a supplier of high quality, performance outdoor clothing." He further says that the mark, including the device element, has been unchanged since its launch. The range, he says, was initially sold by mail order. A copy of a 1990 order form showing the mark and device is provided at Exhibit BA.1. A copy of a 1992 brochure is provided at Exhibit BA.2 and a copy of a "current" (undated) brochure is provided at Exhibit BA.3.

12. Mr Annetts goes on to say that the mark has been widely advertised in the Yorkshire area in daily and weekly local newspapers, 12-15 times a year. A total of £15,000 - £20,000 has been spent on advertising. In 1993 the company attended and exhibited a range of clothing featuring the PULSE 8 name at the Camping and Outdoor Leisure Association Festival (COLA) and at various local trade fairs. Turnover is described as reaching £60,000 to £70,000 by 1994 and has been maintained at that figure for the next five years.

13. Mr Annetts argues that the marks are not confusable since his mark is the phonetic equivalent of "pulsate" which has its own meaning to distinguish it from Puls ("pulse"). He also refers to the visual differences and says he is not aware of any confusion. Mr Annetts also argues that the goods of interest are in different markets. He says that the applicants' company produces "only high quality outdoor clothing" while the opponents produce "general clothing not including outdoor garments of the type marketed under the Pulse 8 name and logo by our company. " Mr Annetts also goes on to say that until Notice of Opposition was received he was unaware of the existence of the opponents' mark and points out it was not cited by the Registry during Examination.

14. In response to the opponents' arguments regarding similarity Mr Annetts concedes that both marks contain "PULS" but argues that his mark will not be pronounced in a confusingly similar way and the first four letters of his mark will not be pronounced in isolation. He also argues that, even allowing for imperfect recollection, PULSE 8 is the phonetic equivalent of "pulsate" and not "pulse" as in the opponents' mark and therefore unlikely to be confused. Furthermore, the marks are visually different and the device element in the opponents' mark helps to distinguish them visually. Mr Annetts also repeats his argument that the applicants and opponents are in different clothing markets.

15. With regard to the assertions of the applicants having no bona fide intention to use their mark and the allegations of bad faith Mr Annetts refers to the use made of the mark and to Exhibit BA.3.

16. Turning to the opponents' claim of being entitled to protection as a well known trade mark Mr Annetts points out that the opponents' evidence does not indicate why. He also says that he has never heard of the opponents' mark. While acknowledging the opponents' mark "H & M Hennes & Mauritz" is a well known mark Mr Annetts says "I do not believe that the Opponents' Registration to also be such a mark."

17. That concludes my review of the evidence.

DECISION

18. In my view no evidence has been filed to support any of the grounds of opposition other than Section 5(2)(b). therefore, all other grounds are dismissed. The remaining ground reads as follows:

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

(a)

- (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

19. An earlier right is defined in Section 6, 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 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,"

I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723.

It is clear from these cases that:-

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a

highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;

- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;
- (h) further, 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; *Marca Mode CV v. Adidas AG*, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

20. The respective specifications are set out earlier in the decision. I note the applicants' claim that they and the opponents operate in different areas of the clothing trade. However, I must compare the specifications as set out earlier since this is a notional test, comparing the goods that each party is claiming. When I do so it is clear that identical and/or closely similar goods are involved. For example the applicants' "clothing for outdoor and sporting activities" must include such items as boots for sports, footwear, headgear, coats, trousers, outerclothing, jackets and sweaters, all of which appear in the specification of the opponents' mark.

21. I now turn to the marks themselves. It is clear that they are not identical. The opponents' mark consists of what appears to be a hand-written word which could be read as an invented word "puls" contained within a triangular border. The applicants' mark on the other hand consists of two elements - the dictionary word PULSE and the numeral 8. When compared visually I consider there are clear differences between the marks. Furthermore, they also convey different ideas as the opponents' mark consists of an invented word and the totality of the applicants' mark conveys the word "pulsate". Even if this concept was not identified by the customer the fact that the applicants' mark consists of a dictionary word and numeral again conveys a different identity.

22. I also take account of the fact that the goods at issue are clothing. I believe it is generally acknowledged that clothes are usually bought visually and the primary use of trade marks in the purchasing of clothes is a visual act. (See e.g. comments by Mr Simon Thorley QC when acting as the Appointed Person in *React Music Limited* trade mark case, 2000 RPC 285). Bearing in mind the differences in meaning between "pulse" and "pulsate", the fact that in any event the opponents' mark is "puls" and not "pulse", the absence of a numeral in the opponents' mark and that the device element of the opponents' mark cannot be totally ignored, I consider that visual confusion is highly unlikely.

23. Notwithstanding the comments above I cannot totally disregard aural use as goods may be purchased by telephone. When the marks are compared aurally I find that I agree with the opponents that "PULSE" and "PULS" are likely to be pronounced identically or in such a

similar way that any difference would be hard to detect. However, I can see no reason why the applicants' mark would be dissected in use and would, again, convey the word "pulsate" aurally rather than "puls" or "pulse" as in the opponents' mark. Therefore, I consider the marks are unlikely to be confused aurally.

24. Finally, I must consider whether the marks are confusable conceptually. I would say that, for the reasons given previously, the marks are not confusable whether used visually or aurally. Even if the comparison is between the two dictionary words "pulse" and "pulsate" I consider the meanings far enough apart that they are unlikely to be confused, even with imperfect recollection. "Pulse" would indicate the reaction on a body's arteries caused by the beating of the heart, or possibly, edible seeds such as lentils or beans. "Pulsate", on the other hand, conveys the idea of rhythmical beating or throbbing.

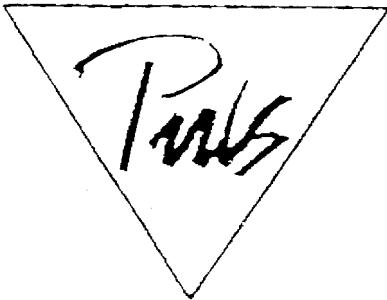
25. The Act requires me to consider the likelihood of confusion, as opposed to the mere possibility of confusion. Taking all the above into account and assuming that the "average consumer" is "reasonably well informed and reasonably circumspect and observant" and that he or she "normally perceives a mark as a whole and does not proceed to analyse its various details" I consider that confusion is highly unlikely. Therefore the opposition fails under the only remaining ground, Section 5(2)(b).

26. The opposition having failed the applicants are entitled to a contribution towards their costs. I order the opponents to pay the applicants the sum of £350. A separate award has been made in the related opposition case (47967). The sums have been adjusted to reflect the cost of defending separate oppositions and the fact that the evidence is essentially the same in both cases. This sum to be paid within seven days of the end 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 8TH day of June 2001

**R A JONES
For the Registrar
the Comptroller-General**

ANNEX A

<u>Application No.</u>	<u>Mark</u>	<u>Class</u>	<u>Specification</u>
2008651		14	Alarm clocks, amulets, anchors, ashtrays of precious metal for smokers, barrels (clock and watch-making), baskets of precious metal (for household purposes), boxes of precious metal, boxes of precious metal for sweetmeats, cabarets (trays) of precious metal, candelabra of precious metal, candle extinguishers of precious metal, candle rings of precious metal, candlesticks of precious metal, cases for clock and watch-making, cases for watches (presentation), chain mesh purses of precious metal, chains (watch), chronographs (watches), chronometers, chronometrical instruments, chronoscopes, cigar boxes of precious metal, cigar cases of precious metal, cigar holders of precious metal, cigarette cases of precious metal, cigarette holders of precious metal, clock cases, clock hands (clock and watch making), clocks, clocks and watches (electric), clockworks, coffee services of precious metal, containers (household) of precious metal, cruet stands of precious metal, for oil and vinegar, cruets of precious metal, cups of precious metal, dials (clock and watch making), dials (sun), dishes of precious metal, earrings, epergnes of precious metal, flasks of precious metal, goblets of precious metal, gold (objects of imitation), household utensils of precious metal, ivory (jewellery), jewel cases of precious metal, key rings (trinkets or fobs), kitchen containers of precious metal, kitchen utensils of precious metal, links (cuff), movements for clocks and watches, napkin holders of precious metal, napkin rings of precious metal, necklaces (jewellery), nutcrackers of precious metal, ornamental pins, paste jewellery (costume jewellery) pearls made of ambroid (pressed amber), pins (ornamental), plated articles (precious metal plating), purses of precious metal, salad bowls of precious metal, salt cellars of precious metal, salt shakers of precious metal, saucers of precious metal, silver plate (plates, dishes), snuff boxes of precious metal, soup bowls of precious metal, statues of precious metal, straps for wrist watches, sugar bowls of precious metal, tankards of precious metal, tea caddies of precious metal, teapots of precious metal, tie clips, tie pins, tobacco jars of precious metal, tokens (copper),

toothpick holders of precious metal, trays of precious metal for household purposes, trinkets (jewellery), watch bands, watch cases, watch glasses, watch springs, watch straps, watches, works of art of precious metal.

- 18 Animal skins, attache cases, backpacks, bags (garment) for travel, bags (net) for shopping, bags for climbers, bags (envelopes, pouches) of leather for packaging, bandoliers, beach bags, boxes of leather or leather board, boxes of vulcanised fibre, briefcases, canes, card cases (notecases), cases of leather or leatherboard, cattle skins, chain mesh purse, not of precious metal, collars for animals, covers (umbrella), dog collars, handbags, handles (suitcases), hat boxes of leather, haversacks, key cases (leatherware), leather leashes, leather thongs, muzzles, parasols, pocket wallets, purses, satchels (school), school bags, shoes (linings of leather for), sling bags for carrying infants, tool bags of leather (empty), travelling bags, travelling sets (leatherware), travelling trunks, trunks, umbrella handles, umbrella or parasol ribs, umbrella rings, umbrella sticks, umbrellas, valises, vanity cases (not fitted), walking-sticks, wallets (pocket).
- 25 Babies' pants, bath robes, bath sandals, bath slippers, bathing caps, bathing drawers, bathing suits, bathing trunks, beach clothes, beach shoes, belts, berets, bibs (not of paper), bodices, boots, boots for sports, braces, brassieres, cap peaks, caps (headwear), coats, coats (top), collars, cyclists clothing, detachable collars, drawers, dressing gowns, football boots, football boots (shoes, studs for football shoes), footwear, frocks, furs, gabardines, garters, gloves, gymnastic shoes, hats, headbands, headgear, jackets, jerseys, jumpers, knitwear, layettes, leggings, linen, mittens, motorists' clothing, muffs, outerclothing, overalls, overcoats, pants, parkas, petticoats, pullovers, pyjamas, robes, sandals, shawls, shirts, shoes, shoulder wraps, singlets, ski boots, skirts, slippers, slips, smocks, socks, sports (boots), sports jerseys, sports shoes, stockings, stuff jackets, suits, bathing suits, sweaters, swimsuits, teddies, tights, topcoats, trousers, trunks, underclothing, underclothing (anti-sweat), underpants, underwear, underwear (anti-sweat), vests, waistcoats.