

O-001-05

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2320908
BY COWLEY DESIGNS LIMITED TO REGISTER
A TRADE MARK IN CLASSES 14, 18 AND 28**

AND

**IN THE MATTER OF OPPOSITION No. 91755
BY G.B. INTERNATIONAL S.P.A**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No. 2320908
by Cowley Designs Limited to register
a Trade Mark in Classes 14, 18 and 28**

and

**IN THE MATTER OF Opposition No. 91755
by G.B. International S.p.A**

Background

1. On 16 January 2003 Cowley Designs Limited (Cowley) applied to register the following trade mark:



in respect of:

Watches, clocks, alarm clocks, timepieces; key rings (trinkets or fobs); jewellery, hair ornaments of precious metal; tiaras.

Bags none being adapted for use in rock/mountain climbing; evening bags; purses; umbrellas and parasols.

Games and playthings; costumes being children's playthings; dressing up clothes; fancy dress outfits being children's playthings.

2. The above goods are in Classes 14, 18 and 28 of the International Classification system.

3. The application was published with the following clause:

“The applicant claims the colours light pink, dark pink, black, red and white as an element of the mark”.

4. On 9 June 2003 G.B. International SpA (G.B.) filed notice of opposition to this application. G.B. is the proprietor of the following registration (No. 1169310):



in respect of:

Trousers, jackets, jerseys, pullovers, overalls; boots foulards and socks, all being articles of clothing; all for use in rock and/or mountain climbing.

Sporting articles (other than clothing) adapted for use in rock and/or mountain climbing.

These goods are in Classes 25 and 28 of the International Classification system.

The registration is subject to the following disclaimer and limit:

“Registration of this Trade Mark shall give no right to the exclusive use of the word “Pink”.

“The device of a spot appearing in the Trade Mark is limited to the colour pink.”

5. G.B. says that the applied for mark so closely resembles its own earlier trade mark that there is a likelihood of confusion. In this respect G.B. contends that the goods “bags none being adapted for rock/mountain climbing; evening bags” in Class 18 of the applied for mark are identical or similar to its own Class 28 goods. Objection is taken under Section 5(2)(b). An objection is also raised under this head on the basis that G.B.’s mark is a well known one and entitled to protection under the Paris Convention.

6. The same goods are objected to under Section 5(4)(a) and in particular the law of passing off having regard to G.B.’s use of marks comprising and/or containing the element THINK PINK since at least as early as 1986.

7. In the alternative, objection is taken under Section 5(3) in the event that the contested goods are held to be dissimilar to G.B.'s goods in Classes 25 and 28.

8. G.B. says it has asked Cowley to withdraw its application in respect of "bags none being adapted for rock/mountain climbing; evening bags" but the applicant has declined to do so. G.B. ask for the application to be dismissed. It has been confirmed in correspondence that the opposition is directed solely at these contested goods (Mewburn Ellis' letter of 26 June 2003 refers).

9. Cowley filed a counterstatement denying the above grounds. It says that the application consists of a distinctive two toned pink coloured heart device that does not resemble G.B.'s mark. Furthermore, Cowley denies that the respective goods are identical or similar.

10. Both sides ask for an award of costs in their favour. Both sides filed evidence. Neither side has asked to be heard. Acting on behalf of the Registrar I give this decision.

Evidence

11. The evidence that has been filed in this case can be dealt with fairly briefly. Alastair John Rawlence of Mewburn Ellis has filed a witness statement on behalf of G.B. He says that:

"3. The opponent began using its mark THINK PINK + device in the UK in connection with clothing, bags and accessories in 1987. Originally, the opponent's merchandise was oriented towards activity and sports wear but over the years however, the opponent's THINK PINK brand has diversified into other fashion areas, culminating in 2002 in their launching on the UK market a more fashion orientated range of clothing, bags and related accessories. Samples of our client's brochure and marketing material as circulated throughout the EU (including the UK) of this fashion orientated range of goods is attached as Exhibit AJR1. To summarise, what had started life as essentially a sportswear/activity brand in the late 1980s was expanding into more mainstream fashion sectors by the year 2002."

12. The exhibited material shows a selection of bags and footwear. The quality of the photocopied material makes it difficult to determine the mark used but it can be seen to be THINK PINK in various forms on a few of the items. The nature of the document is not explained. It gives the impression of being an internal catalogue directed at agents, distributors and such like. No prices are given. There is some foreign language text. There is no evidence that the goods were placed before consumers in the UK or that sales had been made by the relevant date. This limited material does not in my view advance the opponent's case under any of the heads of opposition.

13. The remainder of Mr Rawlence's witness statement deals with a decision by another hearing officer in relation to an earlier dispute between the parties. I will come to this during the course of my decision below.

14. Cowley has filed a witness statement by Carin Elizabeth Burchell of Carin Burchell Trade Mark Services. Her witness statement consists largely of submissions. She too refers to the decision in the previous proceedings between the parties. She has also referred to an Exhibit filed by her client in the evidence in those proceedings in order to demonstrate that in practice the parties operate in different product areas. If it was the applicant's wish to have that material taken into account it should, in my view, have been refiled as an exhibit to Ms Burchell's witness statement. In the circumstances I cannot take it into account.

Decision

15. The opponent's failure to provide anything other than the briefest evidence about its trade must, in my view, mean that those grounds which would be reliant on evidence fall away. Accordingly, I dismiss the grounds based on Section 5(3), 5(4)(a) and the claim to a well known mark. The matter resolves itself into one based on Section 5(2)(b) with the opponent having no sustainable claim that its mark has an enhanced degree of distinctive character through use.

16. Section 5(2)(b) 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.”

17. I take into account the well established guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. *Canon Kabushiki Kaisha v. Metro-Goldwin-Mayer Inc* [1999] R.P.C. 117, *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.

18. The applicant's counterstatement places reliance on what is described as a very distinctive two toned pink coloured heart device as the means by which the marks can be distinguished. There can be little doubt that the heart device in a striped (pink) patterning is a feature of the mark. The device also serves to contain, and act as a background to, the words THINK PINK. The words themselves are presented in a slightly stylised format. Whether the particular form in which the words are presented can itself be said to be a distinctive feature of the mark is open to debate. There can, however, be little debate that the words THINK PINK constitute the most distinctive feature of the mark. Not only do the words have no obvious descriptive significance in relation to the goods but they have an internal alliterative and assonantal quality that is likely to fix them in the recollection of consumers. In my view their effect is to reduce the heart device to an element of somewhat lesser importance within the overall context of the mark.

19. G.B.'s mark has the words THINK PINK in a bold typeface with a pink circle beneath the letter T. The latter is apt to reinforce the message behind the mark. There appears to be some barely decipherable manuscript writing over the bottom right hand corner of the mark. The mark is overwhelmingly a THINK PINK mark.

20. I conclude that, notwithstanding, the visual differences (notably the heart device) that are apparent on a side by side comparison, the marks share the same distinctive words and ideas and will be referred to in the same way in oral usage. They are similar to a high degree.

21. Turning to the goods, the relevant comparison is between:

| Cowley's goods | G.B.'s goods |
|--|--|
| Bags none being adapted for use in rock/mountain climbing; evening bags (Class 18) | Sporting articles (other than clothing adapted for use in rock and/or mountain climbing (Class 28)). |

22. The principles to be applied in considering similarity of goods are to be found in the *Canon* case where the ECJ stated at paragraph 23:

“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 end users and their method of use and whether they are in competition with each other or are complementary.”

23. In *British Sugar Plc v James Robertson & Sons Ltd* (TREAT) [1996] RPC 281 it was considered that channels of trade should also be brought into the reckoning.

24. In the previous proceedings between the parties (Case O/484/02) G.B. was successful in having ‘bags’ removed from the application in suit. Both sides have referred me to passages from that decision in support of their case. The main passage relied on is as follows (paragraph 53 of the decision):

“The class 28 goods of GB are *sporting articles adapted for use in rock and/or mountain climbing*. The term *sporting articles* is a general term and in the context of the specification is limited only by its purpose – rock and/or mountain climbing. Consequently, the term includes bags which are specially adapted to carry sporting articles; the bags themselves falling into the category of being sporting articles owing to their special adaptation. In practical terms this could include such items as rucksacks specially adapted to carry mountain and rock climbing articles. The specification of Cowley includes bags at large. So, for the purposes of this example, it also includes rucksacks. To follow this example and apply the *Canon* criteria the bags have the same purpose – to carry items on the back, they could readily have the same customer – someone who wishes to go hiking or climb for instance, they are likely to be of the same material, the specially adapted bags and the unadapted bags could be substituted for one

another, they are, therefore in competition, both types of bag could be for sale in the same specialist shops or in the same areas of non-specialist shops. The long and short of it is that *bags* of the Cowley specification are similar, and potentially highly similar, to the goods encompassed by the Class 28 specification of GB. From the evidence of Cowley, the actual goods upon which they currently use their trade mark would be most unlikely to clash with those for which GB has protection in Class 28. However, I have to consider notional and fair use in relation to the specification of Cowley as a whole. Even if it had been limited an avoidance of a clash would be very problematic; the dividing line between bags in the two classes can be very narrow e.g. specially adapted holdalls and ordinary holdalls.”

25. As I understand it, there was no appeal against the hearing officer’s findings in that case. In short, therefore, he held that the term sporting articles included bags adapted for or to carry sporting articles and that such goods clashed with the general term bags in Class 18. The hearing officer gave as an example rucksacks adapted to carry sporting articles in Class 28 which would be similar to rucksacks at large in Class 18.

26. Ms Burchell’s witness statement makes the point that the specification of GB.’s registration “must in practical terms be limited to “bags which are adapted to carry sporting articles which are for use in rock and/or mountain climbing”.”

27. She goes on to submit that:

“The Application is applied for in respect of “bags none being adapted for use in rock/mountain climbing; evening bags; purses; umbrellas and parasols” in Class 18. We submit that these goods have a very different purpose from those of the Opponents’ goods in Class 28. Furthermore, we submit that the respective goods are not competitive and would not be sold from the same retail outlets. As far as I am aware, sporting articles which are specifically adapted for rock and/or mountain climbing would only be sold through specialist outdoor and climbing equipment shops, for example Nevisport. I certainly would not expect such shops to sell evening bags. Consequently, we submit that the goods in Class 18 of the Application are not similar to the Opponents’ goods in Class 28.”

28. It seems to me that there is an underlying flaw in the approach adopted by the applicant in relation to the first set of contested goods, that is to say “bags none being adapted for use in rock/mountain climbing;”. The purpose of the exclusion to the specification was, it seems, to separate out Cowley’s goods from G.B.’s Class 28 goods. But the exclusion is ineffective in achieving that end and in fact serves no practical purpose at all in redefining or narrowing the goods.

29. It was established in *Altecnic’s Trade Mark Application* [2002] RPC 34 that the Registrar is entitled to treat the Class number as relevant to the scope of the application. Once, therefore, the applicant had indicated that its bags were appropriate to Class 18 the addition of “none being adapted for use in rock/mountain climbing” became redundant because if they were so adapted they would in any case have been appropriate to Class 28 and not Class 18. The applicant is

nevertheless left with the full range of bags in Class 18 which must by definition include ordinary rucksacks (ie. not ones specifically adapted for use with sporting articles). The position is, therefore, no different in this respect than the one dealt with in the previous decision. It follows that the result is the same.

30. That leaves 'evening bags'. Neither side has indicated what they consider the scope of that term to be. I take it to refer to ladies' handbags, possibly intended for more formal use and, therefore, sometimes slightly more decorative or elaborate in nature than a handbag that is intended for day to day use. The comparison is, therefore, between such an item and the opponent's sporting articles adapted for use in rock and/or mountain climbing. Put in those terms the answer appears to be plainly obvious that the goods are quite dissimilar. Save perhaps that end users could in theory be the same at a very general level, they differ on all the CANON/TREAT criteria.

31. The answer as to whether there is a likelihood of confusion turns on a global appreciation taking all relevant factors into account and considering the matter from the perspective of the average consumer. The average consumer for G.B.'s sporting articles is that particular sub-set of the populace who engage in rock or mountain climbing. The average consumer for "bags none being adapted for use in rock/mountain climbing" might appear on the face of it to be quite different. But given that items such as rucksacks would be directed at those interested in outdoor pursuits such as trekking and hiking the dividing line is not that clear and may overlap.

32. Even allowing for a degree of specialist knowledge and discrimination amongst such consumers I do not think it is enough to offset the real likelihood of confusion that will arise if such closely similar marks are used on the goods in question.

33. As I have indicated above I regard the average consumer for evening bags to be quite different. But in any case the opponent's case cannot get off the ground if there is no similarity in the goods. I find that to be the case in relation to evening bags and sporting articles adapted for use in rock and/or mountain climbing.

34. It follows that the opposition has been partially successful. The application will be allowed to proceed if within 28 days of the expiry of the appeal period Cowley files a Form TM21 removing "bags none being adapted for use in rock/mountain climbing" from their Class 18 specification. If no Form TM21 is filed within the period set the application will be refused in its entirety.

35. Both sides have achieved a measure of success. In all the circumstances I do not propose to favour either side with an award of costs.

Dated this 4th day of January 2005

**M REYNOLDS
For the Registrar
the Comptroller-General**