

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2192118 BY  
CLIVE MELVILLE CHARLES SMITH AND SCOTT CHARLES SMITH  
TO REGISTER THE MARK STONEHEAD  
IN CLASS 25**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER NO  
50343 BY HEAD SPORT AG**

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### **DECISION**

1. On 18 March 1999 Clive Melville Charles Smith and Scott Charles Smith applied to register the mark STONEHEAD for the following specification of goods in Class 25.

“Clothing; sports clothing; swimwear; ski-wear; waterproof garments; leisure clothing; outer garments; t-shirts; polo shirts; rugby shirts; football shirts; sweatshirts; tracksuits; fleece jackets; fleece shirts; fleece dresses; knitwear; tank tops; body warmers; jackets; trousers; jeans; shorts; underwear; articles of headgear; hats; caps; wooly hats; baseball caps; headbands; bandanas; socks.”

2. The application is numbered 2192118.

3. On 25 October 1999 Head Sport AG filed notice of opposition to this application. They are the proprietors of trade mark No 1502616 for the mark HEAD registered for “articles of outer clothing; footwear; sportswear; all included in Class 25; but not including headgear”. That registration has a filing date of 2 June 1992. The opponents also say they have used the mark and claim an extensive reputation therein. They raise grounds under Section 5(2)(b), 5(3) and 5(4)(a) of the Act.

4. The applicants filed a counterstatement denying the above grounds.

5. Both sides ask for an award of costs in their favour.

6. Both sides filed evidence as follows:

#### **OPPONENTS’ EVIDENCE**

Witness Statement of David Gilbert

Witness Statement of Georg Kroll with exhibits GK1-GK15

Witness Statement of Georg Kroll with exhibit GK16

Witness Statement of John Francis Symonds with exhibits JFS1-JFS3

## APPLICANTS' EVIDENCE

Witness Statement of Clive Melville Charles Smith with exhibits CMCS1-CMCS5

7. Neither side has asked to be heard but both parties have filed written submissions. For the opponents' these are under cover of a letter dated 17 October 2001 from Brookes Batchellor and for the applicants under cover of a letter dated 30 October 2001 from Withers & Rogers.

8. Acting on behalf of the Registrar and with all the above material in mind I give this decision.

9. Section 5(2)(b) reads as follows:-

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

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

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

10. I have been referred in the parties' written submissions to a number of Registry and Appointed Person decisions, together with guidance from the ECJ. I propose to take as my starting point the following ECJ authorities *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.

### **Distinctive Character of the Opponents' Earlier Trade Mark**

11. The word HEAD is a common dictionary word with a well known meaning. It has no obvious descriptive connotation in relation to the goods for which it is registered. I note that headgear, for which it would be descriptive, has been excluded from the specification of earlier trade mark No 1502616. HEAD is also a surname. In fact it is the surname of the founder of the opponent company (see Exhibit GK6).

12. The opponents have filed a body of evidence showing use of their mark. I infer that they consider the inherent qualities of their mark have been enhanced as a result of this use. This is, therefore, an appropriate point at which to consider the opponents' evidence particularly that of Mr Kroll who is their Vice President of International Licensing. The main points I draw from his evidence (including the exhibits) are as follows:

- Head were represented in the UK by a company called Sportline during the period 1997 to 1999 by means of a formal licensing agreement.
- the company is particularly known for sports goods and clothing notably in the tennis and skiing fields.

- it has accordingly been promoted at relevant sporting events and by well known sports personalities (such as Andre Agassi, Franz Klammer, Leonard Stock and Bjorn Borg).
- regular advertising has taken place during the years 1997 to 1999 in lifestyle magazines such as LOADED, FHM and GQ and sports magazines such as Skier and Surfboarder, The Good Ski Guide, Tennis, Ace etc.
- the mark HEAD is used both on its own, with the company's ski tip logo as well as in other combinations such as HEAD MAX, HEAD EXPLORATION and with other elements.
- turnover in the UK has been £3.4 million (1997), £4.1 million (1998), £757,000 (1<sup>st</sup> quarter of 1999). These are wholesale values. Retail values would I assume be significantly higher.
- there is some evidence to suggest that the company has diversified beyond the sports clothing and equipment market and also sells leisure wear.

13. In their written submissions the applicants comment that the opponents' evidence does not provide any breakdown of turnover for goods bearing the mark HEAD. That is true but taking the evidence as a whole I am satisfied that HEAD is one of the primary marks (along with the ski tip logo) by which the opponents' goods will be known. The exhibits to Mr Kroll's witness statements confirm that the company is likely to possess a reputation in the sports clothing field. The evidence is less persuasive in establishing that the opponents have a significant reputation beyond this in, for instance, outdoor clothing and leisure wear generally. I nevertheless bear in mind that I must in any case assume use across the full breadth of the specification for which the opponents' earlier trade mark is registered.

### **Comparison of Goods**

14. The opponents' mark is registered in Class 25 for a broad range of outer clothing, footwear and sportswear. It does not require a particularly careful analysis of the applicants' specification to establish that most of the items listed would or could, fall within these broad headings and are therefore, identical. Other items such as underwear are likely to be similar. Certain items in the applied for specification such as headgear, along with specific examples of such goods (hats, caps etc) fall within the category specifically excluded from the opponents' specification. They are neither identical to the opponents' goods nor, arguably, even similar.

### **Comparison of the Trade Marks**

15. The applicants' mark is STONEHEAD and the opponents' HEAD. In approaching this issue I bear in mind the evidence and submissions from both parties. The opponents suggest in their statement of grounds that the applicants' mark may be taken to indicate a range of goods of the opponents' manufacture which are stone coloured or exceptionally strong or reliable or that they constitute a range of the opponents' goods. Their evidence indicates that HEAD is used in combinations such as HEAD MAX, HEAD EXPLORATION and HEAD

PERFORMANCE and that it is used as a house mark with sub brands indicating particular styles of clothing. It is also suggested that in the applicants' mark HEAD is not 'swamped' by the additional element STONE.

16. The applicants for their part suggest that their mark would be seen as a whole and would bring to mind a head made of stone. In relation to the point that 'stone' may be used to indicate a colour they say that the public would be more likely to refer to common colours. They contend that the respective marks are visually different and that their mark may either be pronounced STONE-ED or alternatively with both syllables clearly pronounced and the emphasis on the first syllable. Mr Smith's evidence on their behalf also suggests that other 'HEAD' marks are in use in the marketplace.

17. It was held in REACT and Device Trade mark [1999] RPC 529 that a "majority of the public rely primarily on visual means to identify the trade origin of clothing although I would not go so far as to say that aural means of identification are not relied upon". I have no reason for adopting a different approach here. Visually the respective marks are of unequal length. Equally clearly the whole of the opponents' mark is contained within the word STONEHEAD. It is not a separate element (STONEHEAD being presented as one word) but nor is it disguised as the applicants' mark is clearly the result of conjoining two very common words. The first element of marks usually has particular significance and that is so here. Overall I find that the common element HEAD is not enough in itself to create an overall visual similarity.

18. In oral usage the strong first syllable STONE is unlikely to be missed but I reject the applicants' suggestion that their mark might be pronounced as if it were STONE-ED. It is perhaps arguable as to whether conjoining STONE and HEAD into a single word alters the natural stress. In my view it probably does with a resulting increased emphasis on the first syllable but I would not want to place too much reliance on that view of the matter.

19. Conceptually I am not aware that STONEHEAD has any recognised (in the sense of dictionary) meaning. Again it might be thought that, presented as a single word, it suggests a slightly different meaning to an adjective and noun combination (in the way that bighead and fathead have developed meanings beyond the literal connotations attaching to the elements from which those words are made up). More likely the simple and most obvious meaning of a head made of stone will prevail.

20. I do not accept the opponents' submission that STONE might simply be seen as a colour with the result that the applicants' mark would be taken to be a reference to a stone (coloured) garment from HEAD. The fact that Exhibit GK7 shows that certain garments are available in a 'stone' colour does not change my view. 'Stone' is altogether too imprecise as a colour identifier. It seems more than a little contrived to suggest that the consumer purchasing process will involve reference to a 'stone HEAD' garment.

21. The Exhibits support the opponents' claim that HEAD is used as a house mark with sub-brands used to designate individual styles of jackets etc. However HEAD is normally given greater prominence and appears as the first or a separate element. I do not think the applicants' mark would naturally be seen as use of the HEAD house mark. That is not the message conveyed by the totality of the applicants' mark.

### **Likelihood of Confusion**

22. I have found that, with a few exceptions, identical or similar goods are involved and that the opponents can claim a reputation particularly in relation to sports clothing for skiing and tennis. The respective marks share a common element but differ in their overall character bearing in mind visual, aural and conceptual considerations. There is in my view no realistic likelihood of confusion. In reaching that view I have given no weight to the applicants' claim that there are other HEAD marks in the marketplace. The claim is insufficiently substantiated and, in the case of HEADSTRONG, involves a word with a clear meaning of its own. The opposition fails under Section 5(2)(b).

23. In the circumstances I do not consider it necessary to deal with the Section 5(3) and 5(4)(a) grounds. I have taken the opponents' reputation into account under Section 5(2). Even assuming for Section 5(3) purposes that items of headgear are dissimilar goods I cannot envisage circumstances in which the opponents could succeed when they have failed in relation to identical and similar goods under Section 5(2). Similarly under Section 5(4)(a), even accepting goodwill in relation to tennis and skiing clothing, the opponents will be unable to establish misrepresentation and damage. These grounds also fail.

24. The applicants are entitled to a contribution towards their costs. I order the opponents to pay the applicants the sum of **£635**. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 11 Day of January 2002**

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