

O-057-13

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2578524
BY TEAM MAGNUS LTD
TO REGISTER THE TRADE MARK**



IN CLASSES 18, 21, 25 & 28

AND:

**OPPOSITION THERETO UNDER NO. 102260
BY RENO SPORTSWEAR HANDELS GMBH**

BACKGROUND

1. On 5 December 2012, my interim decision in these proceedings (BL O-485-12) was issued. In that decision I said:

“Interim decision

54. As a result of the above conclusion, Reno’s opposition succeeds in relation to:

all of the opposed goods in Team’s application in classes 18 and 25 and in relation to “Gymnastic and sporting articles” in class 28.

55. The goods in Team’s application which, in its letter of 16 November, Reno indicated are no longer open to opposition i.e.:

“umbrellas, parasols and walking sticks” in class 18;

all of the goods in class 21;

and

“Playing cards, decorations for Christmas trees and children’s toy bicycles” in class 28,

will, in due course, proceed to registration.

56. That leaves “games and playthings” in class 28. As I indicated at paragraphs 31 and 32 above, these are broad terms which would include a range of goods which are not similar to any of Reno’s goods. In approaching this matter, I am guided by the approach outlined in Tribunal Practice Notice (TPN) 1 of 2012 entitled “Partial Refusal”, the relevant part of which reads:

“3.2.2. Defended Proceedings

c) If the Hearing Officer considers that the proceedings are successful against only some of the goods/services, but the result of the proceedings cannot be clearly reflected in the application through the simple deletion of particular descriptions of goods/services, or by adding a "save for" type exclusion, then the Hearing Officer may indicate the extent to which the proceedings succeed in his/her own words. The parties will then be invited to provide submissions/proposals as to the appropriate wording for a list of goods/services that reflects his/her findings and after considering the parties’ submissions, the Hearing Officer will determine a revised list of goods/services. Subject to appeal, the trade mark will be, or remain, registered for this list of goods/services.

d) This third approach will be taken when a Hearing Officer considers that there is real practical scope to give effect to Article 13, having due regard to the factors in each individual case. For example, the original specification of the international trade mark registration which was the subject of *Giorgio Armani SpA v Sunrich Clothing Ltd* (cited above) was clothing, shoes, headgear. The successful opposition only opposed the registration to the extent that it covered “men’s and boys’ clothing”, thereby leaving other goods covered by the specification as unobjectionable. Such an outcome could not be reflected in changes to the specification via either the „blue pencilling’ approach or the „save for’ type of exclusion. The specification was reworded and the international registration was eventually protected for a specification reading Clothing for women and girls, shoes and headgear. Generally speaking, the narrower the scope of the objection is to the broad term(s), compared to the range of goods/services covered by it, the more necessary it will be for the Hearing Officer to propose a revised specification of goods/services. Conversely, where an opposition or invalidation action is successful against a range of goods/services covered by a broad term or terms, it may be considered disproportionate to embark on formulating proposals which are unlikely to result in a narrower specification of any substance or cover the goods or services provided by the owner’s business, as indicated by the evidence. In these circumstances, the trade mark will simply be refused or invalidated for the broad term(s) caught by the ground(s) for refusal. “

57. Team are allowed 21 days from the date of this decision to consider my comments at paragraphs 31 and 32 above and to provide me with submissions/proposals for a list of goods which fall within the broad phrase “games and playthings” which, in its view, do not clash with Reno’s goods in class 28. These submissions should be copied to BWT, who will then be allowed a further 21 days from receipt of Team’s submissions to provide any submissions they may have on Team’s proposals. I will review both parties’ submissions and issue a supplementary decision in which I will also determine costs.

58. The period for any appeal against this decision will run concurrently with the appeal period for the supplementary decision and so will not commence until the supplementary decision is issued.”

2. Both parties responded to paragraph 57 of my interim decision. In its letter dated 18 December 2012, Team pointed out that while Reno initially opposed all of the goods in its application, the scope of Reno’s opposition was restricted in response to my letter of 13 November 2012. Team add that:

“We were unaware that [Reno] had changed their position until this time.”

3. Team also comment on the proof of use position, explaining that its own research as to the scope of Reno's activities was, in its view, sufficient to make a request for proof of use unnecessary. Team add that:

“Based on this, and the evidence submitted and highlighted in paragraph 11 of your interim decision it is a reasonable conclusion to state that [Reno] does not produce bags and has not, and does not, sell a wide range of clothing in the UK”.

4. Regardless of the reason why Team chose not to request proof of use, the fact remains that given the position outlined in paragraph 15 of my interim decision i.e. that as Team did not request proof of use Reno were entitled to rely upon all of the goods for which its earlier trade marks were registered, Team's explanation does not change the position.

5. Team's letter concludes in the following terms:

“For our application to proceed, we are willing to accept:

Class 18: Rucksacks, sports bags, casual bags and waterproof bags suitable for children's use, umbrellas and walking sticks.

Class 21: As in original application.

Class 25: For the time being, we will cease our application for this class.

Class 28. board games, water rugby games, neoprene football games playing cards, decoration for Christmas trees and children's toy bicycles.”

6. In its letter dated 15 January 2013, Reno responded to Team's proposals. It comments upon the proof of use position (to the effect mentioned above) and makes specific comments on Team's revised specifications. In paragraphs 28 and 29 of my interim decision I said in relation to class 18:

28. The “travelling bags” and “rucksacks” in Team's specification find identically worded terms in Reno's CTM registration no.3001617 and are identical. The “handbags” and “trunks” in Team's application would be encompassed by the word “bags” and the phrase “suitcases and luggage of all kind” in the same registration and are, on the principle outlined in *Meric*, also identical. That leaves “purses”. Comparing “purses” with “bags” in its specification, in its submissions, Reno said:

“The users of the goods would be the same general public and the goods are complementary to one another...it is common to purchase matching purses and bags, or a purse for the purpose of fitting within a particular bag”.

29. In my view, the competing goods are not complementary in the sense identified in *Boston Scientific* i.e. “one is indispensable or important for the use of the other.” However, given that bags (particularly handbags) and purses may have the same users, the same physical nature, similar but not identical uses, may be sold in close proximity to one another in, for example, department stores and may, to a limited extent, be in competition with one another, results, in my view, in quite a high degree of similarity between them.”

7. Team’s revised specification appears to stem from its misunderstanding of the consequences of it not requesting proof of use. Needless to say, the “rucksacks” specified in its revised specification remain identical to the “rucksacks” in Reno’s registration. As to the terms “sports bags” “casual bags” and “waterproof bags suitable for children’s use” in its revised specification, it is arguable whether these goods were included in its original specification in class 18 to begin with. However, even if I accept that these terms fall within the phrase “travelling bags”, the “sports bags” and “casual bags” Team itemise are identical to the same terms in Reno’s registration, and “waterproof bags suitable for children’s use” would be identical to the “bags” in Reno’s registration on the *Meric* principle. In view of the above, the only goods Team can retain in class 18 are the “umbrellas, parasols and walking sticks” which Reno no longer oppose (although if Team no longer require protection for “parasols” it should ask for these goods to be deleted from its class 18 specification).

8. As class 21 is no longer opposed by Reno and as Team have indicated that they no longer wish to pursue the application in class 25, it is only class 28 upon which I need to comment. In its letter Reno said in response to Team’s revised specification in this class:

“With regard to the proposed amendments to the goods in class 28, we accept “board games”. However, the terms “water rugby games, neoprene football games” are similar to the “sporting articles” and “balls” covered by Reno’s earlier registrations since these are games based on sports and therefore the respective users of the goods may be the same. Also, the water rugby and football games are likely to utilise the same accessories (balls) and both involve varying degrees of physical activity. Therefore, we submit that these terms should not be accepted.”

9. In paragraphs 31 and 32 of my interim decision I said the following in relation to the goods in class 28:

“31. The “Gymnastic and sporting articles” in Team’s application are (given that the phrase “sporting articles” would include “gymnastic articles”) identical to the “sporting articles” in Reno’s CTM registration no. 3001617. That leaves “games and playthings” in Team’s application to consider. These are broad terms that include a wide range of differing goods. For example, the term “games” would include electronic games, board and parlour games as well as bowls, dart and hockey games. Similarly, the term “playthings” would include educational

playthings, playthings for babies, sandboxes, scale model vehicles, sledges and trains sets.

32. As the “games” in Team’s application would include games based upon a range of sports (for example hockey), the respective users may be the same, the games may utilise similar accessories (such as hockey sticks and balls) and as both may involve varying degrees of physical activity, there is, having applied the case law mentioned above, I think, a degree of similarity between “games” at large and the “sporting articles” in Reno’s registration. However, there is, in my view, no similarity between Reno’s “sporting articles” (or any of its other goods) and a range of named goods that would fall within the term “games”, such as board and parlour games. As the term “playthings” at large in Team’s application would include, for example, the “balls” and “sledges” in Reno’s registration, on the *Meric* principle, those parts of the competing specifications must be considered identical. However, much like games at large, the term playthings at large includes a range of named goods, for example, scale models, train sets etc. which would not be similar to any of Reno’s goods. I will return to this point when I consider the likelihood of confusion.”

10. As I suggested above (and which I note Reno accept), “board games” are not similar to any of Reno’s goods and can form part of Team’s revised specification in class 28. However, for the terms “water rugby games” and “neoprene football games” there remains (for the reasons mentioned above and commented upon by Reno in its letter), similarity between these named goods and both “sporting articles” and “balls” in Reno’s registration. Consequently, these terms cannot form part of Team’s specification in class 28.

Outcome

11. Having considered the parties’ written submissions, Reno’s opposition succeeds in relation to:

all of the opposed goods in Team’s application in classes 18 and 25 and in relation to “Games and playthings” (at large) and “gymnastic and sporting articles” in class 28.

12. Team’s application may proceed to registration for the following goods:

Class 18: Umbrellas, parasols and walking sticks.

Class 21: Household or kitchen utensils and containers; combs and sponges; brushes; articles made of ceramics, glass, porcelain or earthenware which are not included in other classes; electric and non-electric toothbrushes.

Class 28: Board games; playing cards; decorations for Christmas trees; childrens' toy bicycles.

Costs

13. As I mentioned above, Reno's opposition was originally directed at all of the goods in Team's application. Had I not intervened at the conclusion of the proceedings, it is likely that Reno's opposition would (with the exception of "games and playthings") only have succeeded to the extent outlined in my interim decision. That said, I think it unlikely that this belated restriction will have impacted to any significant extent upon the manner in which Team conducted these proceedings or any associated costs incurred by them. Bearing the above in mind, and as both parties' have achieved a measure of success, I do not propose to favour either with an award of costs.

14. The period for appeal against the interim decision runs concurrently with the appeal period for this supplementary decision.

Dated this 4th day of February 2013

**C J BOWEN
For the Registrar
The Comptroller-General**