

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 2139537 BY  
AVTAR SINGH BAINS, TARO KAUR BAINS, BALJIT SINGH BAINS,  
SUKHPAL KAUR BAINS, JALBINDER SINGH BAINS, AND  
BALJINDER KAUR BAINS T/A BAINS & SONS  
HUFF AND PUFF CLOTHING CO  
TO REGISTER A MARK IN CLASS 25**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 48005  
BY UMBRO EUROPE LIMITED**

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**DECISION**

On 18 July 1997 Avtar Singh Bains, Taro Kaur Bains, Baljit Singh Bains, Sukhpal Kaur Bains,  
20 Jalbinder Singh Bains, and Baljinder Kaur Bains t/a Bains & Sons Huff and Puff Clothing Co  
applied to register the following mark for 'articles of clothing'.



The application is numbered 2139537.

35 On 5 January 1998 Umbro Europe Ltd filed notice of opposition to this application citing the  
following grounds;

- (i) under Section 5(2) having regard to a number of registrations standing in their name (see Annex A for details)
- 40 (ii) under Section 5(4)(a) in that the marks used by the opponents are capable of protection by means of an action for passing off
- (iii) under Section 3(4) (no further explanation or particularisation is offered)
- 45 (iv) under Section 3(3)(b) in that the mark applied for is of such a nature as to be deceptive

The opponents also say “It is considered that the Applicants’ should have been aware of the Opponents’ reputation and the goodwill attached to their Trade Marks and the Applicants’ Mark being a Trade Mark which closely resembles the Opponents’ Trade Marks would take unfair advantage of or be detrimental to the distinctive character or repute of the Opponents’ Trade Marks and the Application should be refused Registration as being contrary to Section 3(6) of the Trade Marks Act 1994.”

The applicants filed a counterstatement denying the above grounds.

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 and after a careful study of the papers I give this decision.

### **Opponents’ Evidence**

The Opponents filed evidence in the form of a statutory declaration by Anthony Hutchinson, Umbro Europe’s Director of Operations, a position he had held for 10 years (by July 1998).

He says that the opponents have a worldwide reputation in what he calls the diamond device (see for instance registration No. 991668). The mark is registered on its own and combined with the word UMBRO all over the world. Clothing bearing the mark is supplied to the national football teams of England, Scotland, Eire and Norway as well as numerous leading football clubs. Prominent and well known footballers are also supplied with clothing bearing the mark. Such use results in the mark being seen when football matches are televised. The diamond device is not only shown on replica football kits but also on other clothing. Mr Hutchinson exhibits at TH1 copies of pages from magazines in support of this as well as a catalogue showing products bearing the mark and a history of the mark.

He says that in the year 1997, turnover for goods sold under the mark in the United Kingdom was approximately £110 million and turnover for goods sold worldwide was approximately \$550 million. In excess of £20 million was spent on advertising and making the mark known, including sponsorship.

Mr Hutchinson goes on to exhibit (TH2) what he says is a photocopy showing use of the applicants’ mark on a garment. He suggests that “this shows more clearly the similarity both of the Mark and the manner in which it is used to the Opponents’ Trade Mark and the ensuing likelihood of confusion given that when the garment is worn, the slight separation between each side of the Mark would not be as obvious as when the Mark is shown on a flat piece of paper and I consider that this use could well be held to be infringement and/or passing-off.”

The above contentions are he says “supported by the fact that seizures of garments bearing the Applicants’ Trade Mark have taken place in all parts of the country from London to Northern Ireland by Trading Standards Officers without prior reference to the Opponents, and attached hereto and shown to me marked “TH3” are copies of letters from various Trading Standards

Offices and witness statements which have been made by the Brand Security Manager of the Opponents. These are examples taken from approximately 30 such witness statements which have been made.”

5 **Applicants’ Evidence**

The applicants filed a statutory declaration by Avtar Singh Bains of Bains & Sons, Huff and Puff Clothing.

10 He describes the mark and the process leading to its adoption in the following terms:

15 “..... the Applicant’s Trade Mark comprises not only a device element but also word elements, namely the words ACTIVE and SPORT. The device element is made up of four letter As arranged horizontally in “mirror image” pairs with two smaller As contained within two larger As.

20 I can state that the Applicant’s Trade Mark was first formulated in the late Spring/early Summer of 1997 and that the device element thereof was specifically designed to emphasise and utilise in an attractive manner the word elements. For this purpose the Applicant devised a device around the first letter of the word element, namely A. At a later date and in order to ensure that the Applicant’s Trade Mark would not be considered confusingly similar to other marks in use for sport and leisure clothing items the Applicant consulted Trading Standards Officers attached to Leicester City Council. As a result of this approach a Senior Trading Standards Officer, Mr Colin Hoskins, together with a female colleague visited the Applicant’s place of manufacture on 27 January 1998, and inspected items of clothing marked with the Applicant’s Trade Mark.

30 Further in this connection, a pre-filing search was conducted on behalf of the Applicant by its Trade Mark Agents Lewis & Taylor on the basis of which the Applicant was advised that its Trade Mark was apparently free for use and registration. Moreover, upon examination by the Trade Marks Registry no Registration/Application of the Opponent was cited against the Applicant’s Trade Mark Application.”

35 Mr Bains exhibits examples of clothing bearing the applicants’ trade mark and gives information on sales made since Spring/Summer 1997 through retail outlets such as ‘The Store’, Matalan and What Everyone Wants. He is not aware of any instances of customer confusion or of clothing being seized by Trading Standards Officers.

40 Mr Bains goes on to make a number of detailed observations on the respective marks (which I bear in mind) and the opponents’ evidence. The main points to emerge from the latter are that

S the opponents’ double diamond device is mainly used with the word UMBRO

45 S in relation to Mr Hutchinson’s exhibit TH2 he says the applicants’ mark is not attached and that the said material was neither manufactured nor supplied by the applicants. The opponents do not say where it came from

S the letters from Trading Standards (TH3) do not show the mark they relate to.

### **Opponents' Evidence In Reply**

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A statutory declaration has been filed by Mark Panes, the International Operations Manager of Umbro Europe Ltd. The points made in his declaration can be summarised as follows:

10 S he exhibits copy correspondence between the applicants' trade mark agents and Leicester City Council Trading Standards Department regarding the outcome of the latter's visit to the applicants' premises. The applicants' agents indicated that they had been informed that the Trading Standards Officers advised that the applicants' mark was not in their view confusingly similar to other trade marks in the field. The response from Trading Standards suggests that this was  
15 overstating the position and that Mr Bains had been advised to take legal advice on the matter

20 S a further issue arises in relation to photographs sent to Trading Standards by the applicants' agents and whether certain ones were omitted - these being photographs showing the applicants' trade mark being used repeatedly down the side of each sleeve of a garment. It is said that this use would give rise to a successful passing off action.

25 S Mr Panes comments on the respective marks and the non-distinctive nature of the word elements of the applicants' mark, a view supported by reference to a trade mark search, pages from catalogues and web site pages (Exhibits MP2, MP3 and MP4)

30 S the opponents concede that they cannot show conclusively that their exhibits (TH2 and TH3) relate to the applicants' goods but it is suggested that the description of the applicants' mark in the applicants' own declaration is so similar that the exhibits must relate to the applicants' goods.

35 That concludes my review of the evidence.

35

The opponents have raised a number of objections based on Section 3 of the Act. The side heading of that Section indicates that it is dealing with absolute grounds for refusal of registration. That is to say the Section is concerned with some inherent characteristic of the mark which may leave it open to objection rather than the applicants' position in relation to a third party's earlier trade mark or earlier right which is dealt with in Section 5 of the Act. The  
40 references to Section 3(3)(b) and 3(4) have not been explained and, to the extent that the latter is referred to in a paragraph dealing with issues that properly fall to be considered under Section 5(4)(a), the objection is, I think, misconceived. I have recorded above the precise wording used by the opponents in framing their objection under Section 3(6). It appears to  
45 draw on wording that is found in Section 5(3) of the Act but as that provision is expressly concerned with situations where the goods are 'not similar' it has no part to play in these proceedings where identical and/or similar goods are involved. Issues to do with the

opponents' reputation and goodwill will be considered under Sections 5(2) and 5(4). If the opponents intended some other form of objection under Section 3(6) in relation to the mark applied for it is not clear from the ground as pleaded. Section 3(6) is concerned with applications made in bad faith. That is a serious matter and one which requires a clear explanation of the nature of an opponents' objection. As can be seen from the evidence summary a number of issues have been raised about the use of a mark (or marks) which is said to be similar to the opponents' double diamond device. However for reasons which I will explain later in this decision that is not the mark before me and in any case the ownership of it has not been established or admitted. Accordingly I dismiss all the grounds based on Section 3 of the Act.

Section 5(2) reads:

“(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.”

I bear in mind the advice given by the European Court of Justice in relation to the issues of similarity of marks and likelihood of confusion. The following is from *Sabel BV v Puma AG* 1998 RPC 199.

“Global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The wording of Article 4(1)(b) of the Directive - “there exists a likelihood of confusion on the part of the public” - shows that the perception of the marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.

In that perspective, the more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either per se or because of the reputation it enjoys with the public.”

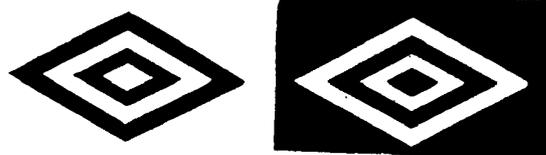
and the following from *Lloyd Schuhfabrik Meyer & Co v Klijsen Handel*, 1999 ETMR 690 in relation to the perception of the average consumer:

5 “26. For the purposes of that global appreciation, the average consumer of the category of products concerned is deemed to be reasonably well-informed and reasonably observant and circumspect (see, to that effect, Case C-210/96 *Gut Springenheide and Tusky* [1968] E.C.R.I-4657, paragraph 31). However, account should be taken of the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks but must place his trust in the imperfect picture of them that he has kept in his mind. It should also 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.”

10 Discounting for present purposes a later filed and now withdrawn application referred to by the opponents as “running diamond stripes”, the opponents rely on the three registrations set out in Annex A to this decision. It will be seen that numbers 1101642 and 1568347, whilst containing the double diamond device, have other elements which take them further away from the mark applied for. It is in any case the device element of the applicants’ mark that appears to be the primary source of the opponents’ concern. I therefore take the view that the opponents’ best chance of success rests on registration number 991668. For ease of reference I set out below the respective marks:

20 Applicants’ mark

Opponents’ mark



30 (series of two)

35 Self evidently the marks are not identical so Section 5(2)(a) does not apply. The matter falls to be considered under Section 5(2)(b). There is, I think, no dispute that identical and/or closely similar goods are involved. The similarity or otherwise of the marks is, therefore, of critical importance. The opponents have made the point that the words ACTIVE SPORT taken either singly or together are lacking in distinctive character in relation to sports clothing and that accordingly they should be disregarded. I accept on the basis of the evidence filed (particularly exhibits MP2 to MP4) that the first of these contentions is likely to be true.

40 Nevertheless the words form a feature of the composite mark applied for and it is the mark as a whole that I must consider. However in doing so I bear in mind the guidance in *Sabel v Puma* that in coming to an overall view I must have regard to the “distinctive and dominant components” of the mark. It seems likely also that the average consumer may not accord great weight to the words in the context of the overall character of the mark. It is also clear

45 from *Sabel v Puma* that I must take into account the distinctive character of the opponents’ earlier trade mark having regard to its inherent characteristics and the reputation it enjoys with the public. The double diamond device is in my view a relatively simple geometric form and

does not have any obvious claim to enhanced distinctiveness on that account. Mr Hutchinson's evidence indicates a substantial level of sales under the mark. However, the turnover figure relates to the year spanning the filing date of the application and no disaggregation of the figure is offered. The main supporting material is exhibit TH1. The use shown is almost exclusively of the double diamond device with the word UMBRO (as in or comparable to registration no. 1101642). There are a small number of exceptions but it is difficult to gauge from the exhibited material and the covering declaration the level of consumer recognition of the device independently of the word UMBRO. I think it is likely that there is some but the point really requires further substantiation.

With those preliminary observations in mind I go on to compare the marks and reach a view on the likelihood of confusion. The applicants have said how they came to adopt their mark.

"The device element is made up of four letter As arranged horizontally in "mirror image" pairs with two smaller As contained within two larger As.

I can state that the applicant's trade mark was first formulated in the late Spring/early Summer of 1997 and that the device element thereof was specifically designed to emphasise and utilise in an unattractive manner the word elements. For this purpose, the applicant devised a device around the first letter of the word elements. For this purpose, the applicant devised a device around the first letter of the word element, namely A."

It is nevertheless possible to see that the arms of the mirror image As might be seen as combining to create a diamond shape albeit an incomplete one given that the letters do not join in the middle. The applicants also say that their device is made up of four As. Whether the mirror image As at the heart of the device would be seen in this way or simply as another geometric shape is perhaps debatable and not of great importance. As the ECJ cases referred to above make clear consumers do not pause to analyse marks in this way. First impressions and imperfect recollection play a part.

My own view of the matter is that there are points of similarity between the respective marks but that they are of a superficial nature. The applicants' mark is a more complex one than the opponents' double diamond device (a conclusion that does not depend on close visual inspection or analysis of the marks). Whether casual observers would see the device element of the applicants' mark as horizontal letter As is open to debate. I suspect that it is even more doubtful whether the intended link with the initial letter of ACTIVE would be made. In the final analysis my view of the matter does not turn on the answers to these questions. It is mainly a matter of the visual impact made by the respective marks. In my view the averagely observant and circumspect customer would be unlikely to be confused despite certain points of similarity.

However, that is not the end of the matter as the opponents have adduced evidence (TH2) showing what is said to be the applicants' mark in use on a garment which in their view suggests a likelihood of confusion. They point particularly to the fact that the separation between each side of the mark would not be as obvious when worn as when seen as a flat piece of paper. There are a number of difficulties with this evidence and submission. The

mark exhibited at TH2 is not the mark applied for. For ease of comparison I have set out in Annex B the mark applied for, the mark in Exhibit TH2 and the opponents' device. The main difference is that the outer part of the device at TH2 is a nearly complete diamond and not part of letters A on their side. The internal proportions of the mark are also significantly different and the word SPORT does not appear at all.

I can of course only deal with the matter on the basis of the mark applied for and not some potentially bridging mark. The mark at TH2 is not before me and, in case it is or may be the subject of legal proceedings, I will say no more than it is self evidently closer to the opponents' double diamond device than the mark applied for.

I should say too that the applicants deny that the mark at TH2 has any relevance to these proceedings. They say that "..... the said material was neither manufactured nor supplied by the applicant and, indeed, the opponent does not trouble to attach any evidence alluding to the provenance of the material". I do not know what lies behind those words and in particular the reference to 'material' rather than the mark. It seems to me to be a somewhat less than unequivocal denial that it is a mark belonging to them or with which they are associated in some way. However, for the above reasons Exhibit TH2 is of no direct assistance to the opponents.

The opponents have also supplied at TH3 letters from various Trading Standards Offices (TSOs) and witness statements made by their (the opponents) Brand Security Manager. The copy correspondence and witness statements relate to dealings with four TSOs but in all some thirty witness statements are said to have been made. There is a fundamental difficulty with this evidence insofar as it does not show the marks that resulted in the TSOs' involvement. This is a significant omission and one that is made all the more important given the claimed use of the somewhat different mark at TH2. The mark that is the subject of the TSO letters is typically described in the following terms in the witness statements:-

"..... along the sleeves there was a logo that appeared to be the Umbro Double Diamond logo, but upon close inspection the logo was seen to be split down the Centre. On the Front of the garment a larger version of this logo was seen and this also appeared to be the Umbro double diamond and appeared to have in the Centre of the logo a design, which when turned through 90° gave the appearance of a capital letter "A" which had been laid on its side in a horizontal fashion. Underneath the logo on the front was the word "Active" in capital letters."

Although the matter cannot be free from doubt without a sight of the mark in question the above description seems to me to more accurately describe the TH2 mark than the mark applied for (particularly as it places the A device at the centre of the logo). It follows that I do not feel able to give any weight to this part of the opponents' evidence.

My initial view that there is no likelihood of confusion, therefore, remains unchanged after considering the supplementary material supplied by the opponents. The opposition fails under Section 5(2)(b).

Finally there is the objection into Section 5(4)(a). This reads:

“(4) 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.”

Establishing that use of the mark applied for would be liable to be prevented by the law of passing off requires the opponents to establish the three elements of the action that is to say goodwill, misrepresentation and damage (see WILD CHILD Trade Mark, 1998 RPC 455 at page 460 line 5 to page 461 line 22). In dealing with the Section 5(2)(b) objection I have already taken the opponents’ reputation into account to the extent that I feel able on the basis of the evidence filed (bearing in mind that this mainly goes to use of the double diamond device with the word UMBRO). I do not consider that the opponents are in a more advantageous position as a result of their use of their composite mark than they were in relation to my consideration of the double diamond device on its own. Even accepting goodwill in the composite mark there would in my view be no misrepresentation or damage if the applicants use their mark. The Section 5(4)(a) ground also fails.

As the opposition has failed on all the grounds on which it was brought the applicants are entitled to a contribution towards their costs. I order the opponents to pay the applicants the sum of £435.

**Dated this 24 day of February 2000**

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

Details of the opponents' registrations are as follows:

5	<u>No.</u>	<u>Mark</u>	<u>Class</u>	<u>Journal</u>	<u>Specification</u>
	991668		25	4908 /1896	Articles of clothing for use in sports, athletics and gymnastics.
10					
15	1101642		25	5247/0487	Articles of clothing for use in sports, athletics and gymnastics.
20					
25	1568347		25	6070/2382	Articles of outer clothing; leisure clothing and sports clothing; jogging suits, track suits and shell suits; shorts, trousers; shirts and blouses; T-shirts and tops; gloves; headgear; footwear; all included in Class 25.
30					
35					
40					
45					

A further application referred to in the statement of case has since been withdrawn and was in any case a later filed application.

(i) Applicants' mark

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(ii) The mark shown in exhibit TH2 of the opponents' evidence

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(iii) The opponents' double diamond device registration (series of two)

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