

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2069669
BY M.J.AINGE & CO LIMITED
TO REGISTER A TRADE MARK IN CLASS 25**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
NO 45709 BY B.U.M. INTERNATIONAL, INC**

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by M.J. Ainge & Co Limited
to register a trade mark in Class 25**

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**IN THE MATTER OF Opposition thereto under
No 45709 by B.U.M. International, Inc.**

DECISION

On 26 April 1996, M.J. Ainge & Co Limited of 15 Southern Avenue, Leominster, Hertfordshire, applied to register the trade mark HORSE BUMS in Class 25 for the following specification of goods:

Articles of clothing; clothing for equestrian use; leisure wear; sweatshirts; jogging bottoms; leggings; shorts; T-shirts; knitwear; sweaters; waistcoats; hats; caps

The application, numbered 2069669 was advertised for opposition purposes on 17 July 1996 and on 16 October 1996 B.U.M. International, Inc filed notice of opposition to the application.

The grounds on which the opposition is based are, in summary:-

1. **Under Section 5(2)** The opponent is the proprietor of an earlier registration, number 1333411, details of which are set out later in this decision.
2. **Under Section 5(3)** The opponents' mark has a reputation in the United Kingdom and use of the applicants' mark would take unfair advantage of, or be detrimental to the distinctive character or reputation of the opponents' mark.
3. **Under Section 5(4)** The opponents' mark is distinctive of its goods by reason of the use of the mark in the UK. Registration of by the applicant of the mark proposed would be contrary to Section 5(4) of the Act in that the opponent is the proprietor of an earlier right.
4. **Under Section 3(3)(b)** Because the mark applied for is of such a nature as to deceive the public who would associate the mark with the opponent.
5. **Under Section 5** The opponents' mark is a famous trade mark within the meaning of Section 56 of the Trade Marks Act
6. **Under Section 3(6)** Because the mark was applied for in bad faith.

The opponent requests that the registrar exercise his discretion and refuse the application.

The applicants filed a counterstatement in which they deny these grounds of opposition and ask that the Registrar exercise his discretion and allow the registration of the application. Both sides request that an award of costs be made in their favour.

Neither party has requested a hearing, accepting that the Registrar should make his decision on the basis of the written evidence. Acting on the Registrar's behalf and after a careful study of the evidence filed by the respective parties I now give this decision.

The evidence

Only the opponent filed evidence in these proceedings; a Statutory Declaration dated 9 October 1997 by Graham Farrington, a registered trade mark agent with Ladas and Parry, their trade mark agents.

Mr Farrington says that the opponent is a Nevada Corporation. He explains that the company had run into financial difficulties and around April 1996 had filed for bankruptcy to protect their commercial position. He states that he was instructed to file opposition to the application but had experienced problems in collating evidence to substantiate the level of use the opponents have made of their mark because of the bankruptcy. He goes on to refer to the trade mark registrations in the ownership of the opponent and refers to exhibit GF1 which consists of copies of documentation relating to these registrations.

That concludes my review of the evidence, and I turn to consider the respective grounds upon which the opposition has been brought.

I will deal first with the objection based in Section 5(2), which reads:-

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.

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

5 I consider this ground first of all on the basis of the approach adopted by the European Court of Justice in *SABEL v. PUMA* 1998 RPC 199. The Court considered the meaning of Article 4(1)(b) of the Directive (EC Directive 104/89) which corresponds to Section 5(2) of the Act and stated that:

10 “..... it is clear from the tenth recital in the preamble to the Directive that the appreciation of the likelihood of confusion ‘depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified’. The likelihood of confusion must therefore
15 be appreciated globally, taking into account all factors relevant to the circumstances of the case.

20 That 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 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
25 does not proceed to analyse its various details.”

I also have regard to the approach adopted by the European Court of Justice in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc.* (Case C-39/97) which also dealt with the interpretation of Article 4(1)(b) of the Directive. The Court in considering the relationship between the nature of
30 the trade mark and the similarity of the goods stated:

35 “A global assessment of the likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between these goods or services. Accordingly, a lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the marks, and vice versa. The interdependence of these factors is expressly mentioned in the tenth recital of the preamble to the Directive, which states that it is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion, the appreciation of which depends, in particular, on the recognition of the trade mark on the market and the degree of similarity between the mark and the sign and between the goods
40 or services identified.”

Finally, the court gave the following judgement on the interpretation of Article 4(1)(b):

45 “On a proper construction of Article 4(1)(b) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks, the distinctive character of the earlier trade mark, and in particular its reputation, must be

taken into account when determining whether the similarity between the goods or services covered by the two trade marks is sufficient to give rise to the likelihood of confusion.

Details of the opponent's registration are as follows:

Number	Mark	Class	Specification
1333411	b.u.m. equipment	25	Shirts, t-shirts, sweatshirts, sweaters, shorts, jeans, pants, jackets and coats; all being articles of clothing for men and all included in Class 25

The specification of the application covers clothing at large and must include goods for which the opponents' mark is registered, and I therefore need only consider whether the two marks are the same or similar. It is self evident that the mark applied for is not identical to the opponents mark, so the likelihood of confusion falls to be determined under sub-section (b) and by reference to the similarity of the marks.

The opponents have the word "b.u.m." as the first part of the mark and although represented with full stops between each letter will, in my view, be seen as the word "BUM". The applicants have the word "BUMS" as the second part of their mark. While both marks contain a similar feature, they also have an additional element which in my view makes them visually, aurally and conceptually different.

If the opponents have a case, it exists in my view in the argument that there may be confusion through imperfect recollection. That argument relies upon the proposition that the addition of the word "HORSE" in the applicants' mark will be insufficient to indicate a different trade origin to the public, but also that the word "BUMS" will be picked out of the applicants' mark and through poor recollection will be confused with the opponents' mark. In the SABEL- PUMA case it was said "The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details." which, if applied to this case would support the view that there is little likelihood of confusion.

The goods in question are clothing and are most unlikely to be selected without the purchaser actually seeing the good, be it in a shop or a catalogue. A person who buys such goods by reference to a designer or label would be aware of the names and exercise a degree of care in the selection, and be unlikely to confuse these marks. In Case C-342-97, Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V., Advocate General Jacobs concluded that he doubted "whether the average consumer of the goods in question who is reasonably well informed and reasonably observant and circumspect" would make that mistake. That is, I believe the position here.

When considered "globally" I come to the view that the marks are not similar and that the opposition under Section 5(2)(b) fails.

I now turn to the remaining grounds upon which the opposition is based. These set out the objections in very general terms and mostly do not refer to a specific subsection of the Act. I note

the remarks of Geoffrey Hobbs QC sitting as the Appointed Person in the Wild Child case, (1998 RPC 455), when referring to the scope of the opposition said:

5 “In the interests of justice and fairness it is plainly necessary for an objection to registration under Section 5(4) to be framed in terms which: (i) specify whether the objection is raised under sub-section 4(a) or sub-section 4(b); (ii) identify the matters which are said to justify the conclusion that use of the relevant trade mark in the United Kingdom is liable to be prevented by virtue of an “earlier right” entitled to recognition and protection under the relevant sub-section; and (iii) state whether the objection is raised in respect to all or only some (and if so, which) of the goods....”

10 Although in this case referring specifically to Section 5(4), “in the interests of justice and fairness” this must, in principle, be equally applicable to other grounds of opposition.

15 The onus under Section 5(3), 5(4) and 56 of the Act falls on the opponents, who must establish through the filing of evidence that their mark or goods have acquired goodwill or reputation, and that use of the mark applied for would damage or be detrimental to them in some way. The evidence filed by the opponents is about as thin as it is possible to get, consisting entirely of copies of certificates relating to the registration of their trade mark in a number of countries, including the United Kingdom. There is nothing to substantiate whether the opponents have ever used the mark, let alone acquired any goodwill or reputation in the market place. The opponents' mark may well be on the trade marks register, but that in itself does not enable me to assume that it has been used or has acquired goodwill and a reputation. I have no evidence before me on which to base a decision, and consequently, I find that the opposition fails under Section 5(3), 5(4) and 25 56 of the Act.

30 The grounds of opposition based upon Section 3(3)(b) and Section 3(6) I dismiss as being without foundation. In relation to Section 3(3)(b) there is no indication that there is anything inherent in the trade mark which would deceive the public, and no evidence has been submitted to substantiate this ground. Similarly, no evidence has been submitted to substantiate the ground under Section 3(6) that the mark was applied for in bad faith.

35 Finally, the Registrar has no discretion to refuse an application which meets the requirements for registration set out in the Act, and consequently, this final ground cannot succeed. The opposition having failed on all grounds the applicants are entitled to an award of costs in their favour. I therefore direct the opponents pay to the applicants the sum of £135 as a contribution towards their costs.

40 **Dated this 5 day of March 1999**

45 **Mike Foley
Principal Hearing Officer
For the Registrar
The Comptroller General**