

O/091/12

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2555128  
BY DUNLOP SLAZENGER GROUP LIMITED TO REGISTER A  
SERIES OF TRADE MARKS**

**AERO-DRY  
AERO DRY  
AERODRY**

**IN CLASS 25**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 101423  
BY BRIAN W DICKSON & JULIE M DICKSON**

## BACKGROUND

1. On 6 August 2010, Dunlop Slazenger Group Limited (“Group”) applied to register **AERO-DRY**, **AERO DRY** and **AERODRY** as a series of 3 trade marks for goods in class 25. Following examination, the application was accepted and published for opposition purposes on 15 October 2010. On 3 December 2010, Group filed a Form TM21 to amend its specification. The amended specification reads as follows:

Sportswear; footwear; sports shoes, trainers, boots, walking boots, football boots, shoes, cycling shoes; waterproof and weatherproof clothing for sports; thermal clothing for sports; lightweight clothing for sports; sports clothing; salopettes; gloves for sports; gaiters; clothing, footwear and headgear for sports purposes including tennis, squash, table tennis, paddle tennis, racquetball, softball, golf, badminton, volleyball, basketball, cricket, hockey, football, rugby and baseball [other than for protection against accident or injury]; wet suits; sports headgear (other than helmets); sportswear, sports uniforms; sporting articles (clothing) for equestrian use [other than for protective purposes]; fishing smocks; fishing jackets, boots and vests; parts and fittings for all the aforesaid goods, all for use in sports.

2. On 14 January 2011, Brian W Dickson & Julie M Dickson (“the Dicksons”) filed a notice of opposition which consisted of a single ground based upon 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The Dickson’s opposition is based upon the following trade marks:

Trade Mark	No	Application date	Registration date	Goods relied upon
	2432333	12.9.2006	4.7.2008	Martial arts clothing, sports clothing, headwear, ski hardware, protective clothing, wet suits, headgear, (not footwear); non of the aforesaid clothing being leather clothing.
Aero Sport AERO SPORT aero sport aERO sPORT	2432331	12.9.2006	4.7.2008	As above

3. In their notice of opposition, the Dicksons indicated that their opposition was directed against the following goods in Group’s application:

Sportswear; waterproof and weatherproof clothing for sports; thermal clothing for sports; lightweight clothing for sports; sports clothing; salopettes; gloves for sports; gaiters; clothing, footwear and headgear for sports purposes including tennis, squash, table tennis, paddle tennis, racquetball, softball, golf, badminton,

volleyball, basketball, cricket, hockey, football, rugby and baseball [other than for protection against accident or injury]; wet suits; sports headgear (other than helmets); sportswear, sports uniforms; sporting articles (clothing) for equestrian use [other than for protective purposes]; fishing smocks; fishing jackets, vests; parts and fittings for all the aforesaid goods, all for use in sports.

4. Consequently, while the Dicksons do oppose:

Footwear for sports purposes including tennis, squash, table tennis, paddle tennis, racquetball, softball, golf, badminton, volleyball, basketball, cricket, hockey, football, rugby and baseball [other than for protection against accident or injury],

it appeared that they do not oppose the following goods in Group's application:

"Footwear; sports shoes, trainers, boots, walking boots, football boots, shoes, cycling shoes, boots."

5. On 9 February 2012, I wrote to the parties pointing out what I considered to be the tension between the Dickson's positions in relation to the goods shown in paragraph 4. In a letter dated 13 February 2012 the Dickson's responded to that letter. They said, inter alia:

"We confirm that there was a typographical error on form TM7.

The opponent is not opposing footwear.

Where that part of the TM7 stated that the opposition was for:

...footwear and headgear for sports purposes including tennis, squash, table tennis, paddle tennis, racquetball, softball, golf, badminton, volleyball, basketball, cricket, hockey, football, rugby and baseball [other than for protection against accident or injury]....

The words "footwear and" should have been omitted so that it read:

....headgear for sports purposes including tennis, squash, table tennis, paddle tennis, racquetball, softball, golf, badminton, volleyball, basketball, cricket, hockey, football, rugby and baseball [other than for protection against accident or injury]...."

6. In a letter dated 20 February 2012, Group said, inter alia:

"Our client is content for the Hearing Officer to proceed to consider this opposition on the basis that "footwear" is removed in its entirety from its scope."

The combination of the clarification contained in the Dickson's letter of 13 February and Group's response to it, means that the Dickson's opposition is now only directed against the following goods in Group's application:

Sportswear; waterproof and weatherproof clothing for sports; thermal clothing for sports; lightweight clothing for sports; sports clothing; salopettes; gloves for sports; gaiters; clothing and headgear for sports purposes including tennis, squash, table tennis, paddle tennis, racquetball, softball, golf, badminton, volleyball, basketball, cricket, hockey, football, rugby and baseball [other than for protection against accident or injury]; wet suits; sports headgear (other than helmets); sportswear, sports uniforms; sporting articles (clothing) for equestrian use [other than for protective purposes]; fishing smocks; fishing jackets, vests; parts and fittings for all the aforesaid goods, all for use in sports

7. In their notice of opposition the Dickson's state:

"[Group's] sign consists of the element AERO which is the dominant element of [Group's] sign. The dominant element of [the Dickson's] trade mark[s] is also AERO. In addition, the goods covered by [Group's] application are identical or similar to the goods which are covered by [the Dickson's] earlier mark[s]"

8. On 31 March 2011, Group filed a counterstatement in which the ground of opposition is denied. Group says, inter alia:

"2. The marks differ visually, phonetically and conceptually, and include distinct and dissimilar suffixes with very different meanings. The overall impression given by the marks is dissimilar.

3. [Group] denies that all the goods for which registration is sought are identical or similar to the goods for which [the Dickson's] registrations are registered.

4. [Group] contends, taking into account, in particular, the differences between the respective trade marks and the prevalence of trade marks co-existing on the register containing the word AERO in class 25 that no likelihood of confusion on the part of the public, nor any likelihood of association with [the Dickson's] registrations, does or would arise as a result of the registration of the application mark."

9. Both parties filed evidence; Group filed written submissions in lieu of attendance at a hearing. I will refer to these written submissions as necessary below.

## EVIDENCE

### The Dickson's evidence-in-chief

10. This consists of two witness statements. The first statement, dated 13 June 2011, comes from Brian Dickson. Mr Dickson's statement consists of a mixture of evidence and submissions. I will not summarise the submissions here but will refer to them as necessary later in this decision. Mr Dickson explains that the registrations which are being relied upon in these proceedings were originally in the name of Sport Direct International Limited but now stand in the name of the Dicksons. The Dicksons have, he states, granted the exclusive right to use the trade marks to Sport Direct Limited a company of which the joint opponents are directors.

11. Mr Dickson states that since 2006 he has created and has developed a comprehensive range of sports clothing, including cycling, running, skiing and weightlifting clothing which bears the Dickson's trade marks. In addition, he has, he says, established a range of hardware, particularly cycle accessories such as tyres, tubes and saddles. Mr Dickson says:

“9...At pages 7 to 16 are photographs of the range of products bearing [the trade marks relied upon] that are currently on sale in the United Kingdom.”

12. Page 7 of exhibit BWD1 consists of what appears to be an undated web page. The page, which contains various references to Sport Direct, also contains a photograph of a pair of what is described as “AeroSport MTB Cycling Shorts” at a cost of £19.99; the shorts appear to bear the stylised version of the trade mark being relied upon. While pages 8, 9, 10, 11, 14 and 16 all contain reference to Aero Sport (in one form or another), as far as I can tell they are (with the exception of page 8 which bears a date of 9/6/11) undated and all relate to accessories for bicycles rather than clothing. Pages 12, 13 and 15 all relate to the same AeroSport MTB Cycling Shorts mentioned earlier; page 15 comes from [www.flogyourbike.com](http://www.flogyourbike.com); pages 12 and 15 are undated; page 13 indicates that the JPEG image of the shorts was taken on 22/4/2007. Mr Dickson states that pages 17 to 28 consist of “a further range of products that are to be put on the market in the UK in the future.” With the exception of pages 21 and 26 which indicate that the JPEG images of the jackets were taken on 22/4/2007, the pages are undated. The pages provided contain photographs of various gloves and jackets all of which appear to bear the stylised version of the Dickson's trade mark.

13. Mr Dickson states that products are sold under the trade marks at [www.sport-direct.co.uk](http://www.sport-direct.co.uk) and by a range of retail and on-line outlets. Pages 29 to 53 are said to consist of pages taken from the websites of suppliers of AERO SPORT products. Once again as far as I can tell, while all of the pages refer to Aero Sport (in one form or another), all of the pages are either undated or after the material date in these proceedings, and, with the exception of pages 46 and 47 (which relate to the same cycling shorts mentioned above), all of the other goods for sale are accessories for bicycles.

14. Mr Dickson states that goods bearing the trade marks have been extensively promoted and advertised. Pages 54 to 56 consist of what Mr Dickson describes as an extract from: “the 2 million run and distributed Motor World catalogue for 2007”. Page 54 consists of photographs of a range of bicycle related items; as far as I can tell the only item (which bears the stylised version of the trade mark) are the shorts mentioned earlier. Page 55 consists of a list of Motor World Stores and page 56 an invoice dated 5 October 2007 from Sport Direct International Limited to Motor World Ltd in the amount of £23.42 in relation to what Mr Dickson explains was: “2 sample pairs of shorts, sent for further photography for MotorWorlds internet sales”.

15. Mr Dickson goes on to say that the AERO SPORT brand has featured in *Bike Biz Bible* which he explains is: “the definitive directory for the entire UK cycling industry which returned in 2010 to much acclaim.” Total circulation via mail and digital is, he says, 4,500 including 2,500 buyers, branch and store readers. Mr Dickson states that according to Google Analytics audit, the online version of this publication at bikebiz.com has an average of 50,000 unique visitors and page views per month. Pages 57 to 67 consist of pages taken from *BikeBiz*. Once again the pages appear to be either undated or after the material date in these proceedings. I note that in the Brand Index Aero Sport is listed under the following headings: components, spares and service items and clothing and accessories. Pages 68 and 69 consist of the results of an undated Google search for the words “aero sport bicycle” and “aero sport clothing” (sic) with Mr Dickson referring to “the variety of products available in the UK bearing the opponent’s marks”; none of the hits have been expanded. Of the relevant hits the vast majority refer to accessories for bicycles. That said, I note that the following reference has been highlighted:

“AERO sport Clothing Range Launches March 08”

I note that a similar reference which appears above the highlighted reference and which is taken from [www.bike-x-co.uk](http://www.bike-x-co.uk) reads:

“Clothing – Bike X  
AeroSport MTB Cycling Shorts. More info. Sport Direct Windbreaker  
Breathable Gloves – AERO Sport Clothing Range Launches March 08.”

16. Mr Dickson states that between 2006 to the date of his statement (June 2011) approximately £20k has been spent on the promotion and advertisement of products bearing the trade marks and that sales of those products have amounted to some £200k at retail value. Pages 70 to 72 consist of undated extracts from Sport Direct’s website; on page 70 under the stylised version of the trade mark there is, inter alia, a reference to “Shorts”. Also shown on this page under the heading “New Products” is another (but different to the ones mentioned earlier) pair of shorts and what may be a cycling shirt. Pages 71 and 72 refer, inter alia, to the same cycling shorts mentioned earlier.

17. The remainder of Mr Dickson's statement consists of commentary on the history between his company and the company which owns Group. I shall return to this point below.

18. The second statement, dated 13 June 2011, is from Julie Dickson. Ms Dickson's statement merely confirms that she is the joint opponent in these proceedings and that she has read and agrees with the contents of Mr Dickson's statement.

### **Group's evidence-in-chief/submissions**

19. This consists of a witness statement, dated 15 August 2011, from Paul Walsh who is a partner in the firm of Bristows, Group's professional representatives in these proceedings. Exhibit PAW1 to his statement consists of the results of a search of the UK and Community trade mark registers for trade mark applications and registrations in class 25 containing the word AERO. Exhibit PAW2 consists of extracts from various websites which, says Mr Walsh, shows the common use of the term AERO in relation to clothing within the United Kingdom. Group also filed written submissions of the same date. Ordinarily I would not summarise these written submissions here. However, I intend to do so at least in so far as they relate to the exhibits attached to Mr Walsh's statement and the conclusions he draws from them. The main points which emerge are, in my view, as follows:

- Excluding any trade marks owned by either Group or the Dicksons, 75 trade marks containing the word AERO co-exist in class 25 owned by 55 different proprietors;
- There are 3 prior registrations for the word AEROSPORT which are not owned by the Dicksons, 2 in class 25 and 1 in class 9;
- Group itself owns registrations in class 28 for AEROGEL, AEROFLITE and AEROBRIDGE.

20. Mr Walsh states:

“7. The word AERO connotes a product with aerodynamic qualities or that facilitates the flow of air through fabric...”

21. He says that exhibit PAW2 to his statement shows:

“7...that the term aero is commonly used as a technical term in the clothing industry, especially in respect of cycle apparel, to denote “aerodynamically optimised clothing”. By itself, the term AERO strongly alludes to clothing and headgear that has a function that does or could relate to aerodynamic performance.”

22. He concludes:

“7...Therefore, the word AERO in each mark connotes a quality of the class 25 goods claimed and, as such, AERO performs an inherently non-distinctive role [in both parties’ trade marks].”

23. Exhibit PAW2 consists of extracts downloaded on 15 August 2011 from a range of websites which contain references to AERO. While the majority of the pages appear to relate to the UK, as far as I can tell, the majority of the pages are either undated or are after the relevant date in these proceedings. The points Group want me to take from the extracts downloaded from the websites shown in brackets below are, I assume, as follows:

**“UCI to ban aero bike clothing?”** - (pages 27 & 28)

20/12/10

“...appears to be set on banning some aero bike clothing in the same effort to level the sporting playing field...”

(www.magazine.bikeradar.com)

**“Smart Aero Clothing** (page 29)

Smart Aero Technology™ clothing is here!

“...over the last three years has identified the performance potential and need for aerodynamically optimised clothing. We embarked on a development programme...in November 2009...we made numerous prototypes for field testing in 2010...”

(www.smartaerotechnology.com)

**“Castelli announces new aero clothing”** (page 30)

21/1/2009

“”reports that Castelli has launched a new line of super-aerodynamic clothing...”

(www.bikebiz.com)

**“Mavic Aero Track Mitts 2011”** (page 31)

“Aerodynamic race glove.”

(www.gbcycles.co.uk)

**“Aero Leathers”** (pages 32 & 33)

**“AEROLEATHER CLOTHING”**

([www.aeroleatherclothing.com](http://www.aeroleatherclothing.com))

**“AEROPOSTALE”** (pages 34 & 35)

([www.clothingtrends.co.uk](http://www.clothingtrends.co.uk))

**“AERO-IST CLOTHING LIMITED”** (pages 36 & 37)

([www.aero-ist.co.uk](http://www.aero-ist.co.uk))

**“R&G Racing Aero Knee Sliders”** (page 38)

([www.demon-tweeks.co.uk](http://www.demon-tweeks.co.uk))

**“G Star Aero Garber Coat Navy”** (page 39)

([www.mensdesignerclothesonline.co.uk](http://www.mensdesignerclothesonline.co.uk))

**“G-STAR RAW/AERO TAPERED JEAN”** (page 40)

([www.diffusiononline.co.uk](http://www.diffusiononline.co.uk))

**“Vintage Body Warmer Aero Vest BMX Clothing BMX Vest 34”** (pages 41 & 42)

([www.ebay.co.uk](http://www.ebay.co.uk))

**“Nike Aero Capri Pants Ladies”** (page 43)

“...benefiting from Nike’s Dri-Fit moisture management fabric to keep you cooler and drier...”

([www.sportsdirect.com](http://www.sportsdirect.com))

**“AERO-GEAR™ by Parisistos Slant Runner Shirt”** (pages 44 & 45)

([www.zazzle.co.uk](http://www.zazzle.co.uk))

**“Get the aero edge with our bikes, clothing and accessories”** (pages 46 & 47)

“...we’ve got a massive range of bikes, clothing and accessories to give you the aero edge.”

In relation to named items the following appears:

**“Santini Defend Seamless Long Sleeve Jersey”**

“Dryarn provides the perfect combination of warmth and breathability...”

“...and other areas with a higher air-permeability. The result is a garment that moves and regulates temperature with you.”

**“Mavic 2011 Aero Gloves Summer 2011”**

“Aerodynamic race glove. Streamlined, light fitting construction for increased aerodynamics”

“Aerodynamic Race shape”

**“Sportful Saxo Bank Windstopper Bootie 2011”**

“Aerodynamic construction to minimise seams”

([www.chainreactioncycles.com](http://www.chainreactioncycles.com))

**“Viga Man ULTRACOOOL Aero Vest”** (pages 48 & 49)

“A premium running vest...When worn next to the skin it enables the rapid transfer of perspiration from the body...”

([www.viga.co.uk](http://www.viga.co.uk))

**“Girls Aero Vest”** (page 50)

([www.team-colours.co.uk](http://www.team-colours.co.uk))

**The Dickson’s evidence-in-reply**

24. This consists of a further statement, dated 15 November 2011, from Mr Dickson. Mr Dickson’s statement consists of submissions rather than evidence, I will treat these submissions in the same manner mentioned in paragraph 10 above. However, there are two points I should comment upon here. In paragraph 3 of his statement Mr Dickson says, inter alia:

“3. Trade Mark No. 1481511 for the word “Aero” I know has been successfully defended on several occasions when similar companies as [Group] have sought

to use a similar argument that the word “Aero” is generic on all occasions this argument has failed.”

While I note Mr Dickson’s comment above, in the absence of evidence to put this assertion into context it cannot assist the Dicksons.

25. Finally, in paragraph 7 of his statement Mr Dickson says, inter alia:

“...as such I maintain that [Group] have made this application in bad faith intentionally trying to damage our company commercially and financially.”

26. In its submissions dated 11 January 2012 Group said, inter alia:

“22. Mr Dickson’s allegations of bad faith in these proceedings are unfounded, and are not relevant as section 3(6) has not been claimed in this opposition. Accordingly, these allegations can have no relevance to this opposition and should not be considered further by the tribunal...”

27. As I mentioned earlier, the opposition as filed was based solely upon section 5(2)(b) of the Act. The Dickson’s professional representatives Virtuoso Legal (“Virtuoso”) wrote to the Trade Marks Registry (“TMR”) on 15 November 2011 it said:

“We refer to the above matter and enclose the witness statement of Brian Dickson in reply to the Applicant’s evidence.”

28. Having admitted Mr Dickson’s statement of 15 November 2011 into the proceedings, the TMR issued a letter to the parties dated 14 December 2011 indicating that the evidential rounds were complete and asking if they wished to be heard or if they were content for a decision to be made from the papers on file. On 20 December 2011, Virtuoso wrote to the TMR. It said:

“Due to the holiday period we will not be able to obtain our client’s instructions until 4 January 2012 and we would be grateful therefore if the deadline for advising whether a party wishes to be heard could be extended to that date.”

29. An extension was allowed and on 11 January 2012 Virtuoso wrote to the TMR. It said:

“We refer to the above matter and write to advise that our clients are happy for this matter to proceed without the need for a hearing.”

30. Despite at least three opportunities, at no point have the Dicksons sought leave to formally amend their pleadings to include a ground based upon section 3(6) of the Act. Had such a request been made and subsequently allowed, it would have led to Group being given an opportunity to amend its counterstatement and to consider filing evidence going to this new ground. Given the serious nature of an allegation of bad

faith, combined with the ample opportunity available to the Dicksons to make such a request, section 3(6) of the Act is not an issue in these proceedings and as such I need say no more about it.

## **DECISION**

31. The opposition is based solely upon section 5(2)(b) of the Act which 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, or

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

32. An earlier trade mark is defined in section 6 of the Act, 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 or international trade mark (EC) 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,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

33. In these proceedings the Dicksons are relying upon the trade marks shown in paragraph 2 above, both of which constitute earlier trade marks under the above provisions. Given the interplay between the date on which Group’s application was published (15 October 2010) and the date on which the Dicksons trade marks completed their registration procedure (4 July 2008), the Dickson’s earlier trade marks are not subject to proof of use, as per The Trade Marks (Proof of Use, etc) Regulations 2004.

34. As both of the Dickson’s earlier trade marks stand registered for the same specification of goods, as registration No. 2432333 is presented in a stylised format,

and keeping in mind the format of the series of trade marks applied for by Group, it is registration No. 2432331 and specifically the second trade mark in the series i.e. AERO SPORT which, in my view, offers the Dicksons the best prospect of success in these proceedings. If the Dicksons do not succeed on the basis of this trade mark, they will, in my view, be in no better position in relation to any of their other earlier trade marks.

### **Section 5(2)(b) – case law**

35. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the CJEU cases mentioned) on the basis indicated below:

#### **The CJEU cases**

Sabel BV v Puma AG [1998] RPC 199; Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc [1999] RPC 117; Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V. [2000] F.S.R. 77; Marca Mode CV v Adidas AG & Adidas Benelux BV [2000] E.T.M.R. 723; Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-6/01; Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH C-120/04; Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P.

#### **The principles**

“(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, 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, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) 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;

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

### **Comparison of goods**

36. For the sake of convenience, the competing goods which remain to be considered are as follows.

<b>The opposed goods in Group's application</b>	<b>The Dickson's goods</b>
Sportswear; waterproof and weatherproof clothing for sports; thermal clothing for sports; lightweight clothing for sports; sports clothing; salopettes; gloves for sports; gaiters; clothing and headgear for sports purposes including tennis, squash, table tennis, paddle tennis, racquetball, softball, golf, badminton, volleyball, basketball, cricket, hockey, football, rugby and baseball [other than for protection against accident or injury]; wet suits; sports headgear (other than helmets); sportswear, sports uniforms; sporting	Martial arts clothing, sports clothing, headwear, ski hardware, protective clothing, wet suits, headgear, (not footwear); non of the aforesaid clothing being leather clothing

<p>articles (clothing) for equestrian use [other than for protective purposes]; fishing smocks; fishing jackets, vests; parts and fittings for all the aforesaid goods, all for use in sports</p>	
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37. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05 the GC said:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

38. The Dickson’s specification includes the phrases “sports clothing”, “headwear”, “headgear” and “wet suits”. The words “wet suits” appears in both parties’ specifications and is clearly identical. On the principles outlined in *Gerard Méric*, the goods mentioned above in the Dickson’s registration are also to be regarded as identical to the remainder of the opposed goods in Group’s application.

### **The average consumer and the nature of the purchasing process**

39. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods. I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. In its submissions of 15 August 2011 Group said:

“14. Further, the average consumer of the goods in question is a sports person who purchases sports clothing for specific purposes....the goods in question give the wearer an advantage when racing or practising speed dependant sports and so have a functional advantage and a highly technological character. As such, these items command a higher purchase price and the average consumer would pay a high level of attention when purchasing them...”

40. While the majority of the goods are for use in sports of one sort or another, not all of the goods (i.e. headwear, protective clothing and headgear in the Dickson’s registration) are so limited. Not all items of sport clothing are highly sophisticated nor are they only worn when carrying out sporting activities. Whether articles of clothing for general or sporting use, the average consumer will be a member of the general public. As to the manner in which the goods are likely to be selected by the average consumer, this is

most likely to consist of a visual act made on the basis of self selection in either a retail environment, from a catalogue or on-line. In *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs)* Joined cases T-117/03 to T-119/03 and T-171/03 the General Court (GC) said:

“50. The applicant has not mentioned any particular conditions under which the goods are marketed. Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

The GC also considered the level of attention taken purchasing goods in the clothing sector. It said:

“43 It should be noted in this regard that the average consumer’s level of attention may vary according to the category of goods or services in question (see, by analogy, Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26). As OHIM rightly pointed out, an applicant cannot simply assert that in a particular sector the consumer is particularly attentive to trade marks without supporting that claim with facts or evidence. As regards the clothing sector, the Court finds that it comprises goods which vary widely in quality and price. Whilst it is possible that the consumer is more attentive to the choice of mark where he or she buys a particularly expensive item of clothing, such an approach on the part of the consumer cannot be presumed without evidence with regard to all goods in that sector. It follows that that argument must be rejected.”

41. When selecting general items of clothing or sports clothing, the average consumer will be conscious of factors such as material, size, colour, cost, compatibility with other items of clothing etc. all of which suggests that they will pay a reasonable level of attention when making their selection. I accept that the average consumer is likely to pay more attention when selecting, for example, a specialised (and consequently more expensive) article of sports clothing such as an item of cycling or running wear designed to reduce drag and the effects of perspiration. However, as neither of the competing specifications is limited in any way, it is goods across the whole price spectrum that I must keep in mind.

### **Comparison of trade marks**

42. The competing trade marks are as follows:

<b>Group’s trade marks</b>	<b>The Dickson’s trade mark (best case)</b>
AERO-DRY AERO DRY	AERO SPORT

43. In approaching the comparison of the trade marks, I keep in mind my comments above in relation to the version of the trade mark that offers the Dickson's the best prospect of success in these proceedings i.e. AERO SPORT. In my view, the hyphen present in the first trade mark in Group's series of three may well go unnoticed by the average consumer and the third trade mark in the series splits naturally into the elements AERO and DRY. As, in my view, there are no material differences between the versions of the trade marks in Group's series of three (and as none have been drawn to my attention), I will, for the sake of convenience, compare the Dickson's AERO SPORT trade mark with Group's AERO DRY trade mark.

44. The average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as wholes and does not pause to analyse their various details. In addition, he rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has kept in his mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant components of the respective trade marks and, with that conclusion in mind, I must then go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

#### **Distinctive and dominant elements**

45. In their submissions of 13 June 2011, the Dicksons said:

"8. The dominant and distinctive element of [the Dicksons trade marks] is AERO. The dominant and distinctive element of [Group's trade marks] is also AERO which is identical to the dominant and distinctive element of [the Dickson's trade marks]. The addition of SPORT in [the Dickson's trade marks] and the addition of DRY [in Group's trade marks] are secondary parts of the respective marks..."

In its submissions dated 15 August 2011 Group said:

"4...The common component is the word AERO. However, [Group] contends that the word AERO is not the most distinctive and memorable part of each trade mark, and that due to the nature of that word, the components DRY and SPORT act to distinguish the marks from each other."

Having commented on the evidence filed by it, Group goes on to say:

"7. The word AERO connotes a product with aerodynamic qualities or that facilitates the flow of air through fabric...By itself, the term AERO strongly alludes to clothing and headgear that has a function that does or could relate to aerodynamic performance..."

“8. Comparing the marks, the only common element is the non distinctive component AERO. The distinctive and dominant elements are SPORT and DRY...”

46. Both trade marks consist of the word AERO presented in upper case followed by either the word SPORT or DRY also presented in upper case. As the first word in each trade mark, it is the word AERO which is, in my view, the more dominant of the two elements, although as both trade marks consist of only two elements, the second element in each trade mark also has a role to play. That said, when considered in the context of the goods at issue in these proceedings i.e. broadly speaking items of sports clothing, the words SPORT and DRY will be well known to the average consumer as indicating either a category of clothing worn whilst engaging in sporting activities, or a type of clothing which will keep one dry, for example, against the elements or by wicking away perspiration. As such, these words are unlikely to be considered distinctive elements by the average consumer.

47. What then of the word AERO which Group says is non-distinctive? In *GfK AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-135/04* the General Court (GC) stated:

“68. As regards the search of the Cedexlex database, the mere fact that a number of trade marks relating to Class 35 contain the word ‘bus’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned. Firstly, the search in question does not provide any information on the trade marks actually used in relation to the services concerned. Secondly, it includes a number of trade marks in which the word ‘bus’ is used descriptively by public transport businesses.”

48. This was a view re-iterated by the GC in *Zero Industry Srl v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-400/06.* While I am aware of the judgment of Mr Daniel Alexander QC, sitting as a deputy judge of the High Court in *Digipos Store Solutions Group Ltd v Digi International Inc* [2008] RPC 24, in that case Mr Alexander was not referred to the judgment of the GC in *GfK AG*. I also note that in his judgment Mr Alexander referred to the *Madame* case being an absolute grounds case and appeared to consider this of some significance. The GC cases referred to above are relative grounds cases; clearly the GC considered that the principle of not giving weight to state-of-the-register evidence also applies in cases involving relative grounds issues.

49. More recently in *Petmeds Limited v Petmeds Express, Inc* (BL O/471/11) Mr Daniel Alexander QC acting as the Appointed Person said:

“30. In my view, the Hearing Officer’s statement that an element of a mark cannot constitute a dominant and distinctive element, if it is not distinctive, requires further analysis. It is true that if a term is wholly descriptive it would be unlikely to be taken to be the part of the mark which enabled the mark as a whole to

distinguish trade origin. However, there is a difference between marks (or elements of marks) which are apt to describe goods – in the sense that the term is appropriate to do so – and marks which use established descriptive terms.”

And:

“46. In my view, in general, where a specific assertion is made that marks are not likely to be confused because the common element is descriptive, or otherwise common to the trade, the onus lies on the undertaking asserting that proposition to establish it, with evidence, unless the element in question is so obviously descriptive of the goods or services that judicial notice may properly be taken of it. That is not an unreasonable burden since, if a sign is in common descriptive use, that fact is likely to be easy to prove.”

50. The authorities mentioned above indicate that without more, Group’s state-of-the-register evidence (exhibit PAW1), is rarely likely to be determinative; I agree. Consequently, I intend to approach the question in these proceedings on the basis indicated in paragraph 46 of the Appointed Person’s decision mentioned above i.e. unlike the words SPORT and DRY, as it is not immediately obvious (to me at least) that the word AERO is descriptive of the goods at issue or is otherwise common to the trade, it is for Group to establish by evidence that this is the case.

51. To support its contention that the word AERO is non-distinctive, Group relies on the results of the Internet searches provided as exhibit PAW2. As I indicated earlier, the majority of the pages provided are either undated or date from after the material date in these proceedings. However, as the meaning of the word AERO is, in my view, unlikely to have changed significantly since either the date of filing of the Dickson’s registrations (12 September 2006), Group’s application (6 August 2010) or the date the extracts were downloaded from the Internet (15 August 2011) this is unlikely, in my view, to undermine Group’s argument to any material degree.

52. What then do the searches reveal? The searches suggest that in relation to what appears to be specialised cycling and running gear (pages 27, 28, 29, 30, 31, 43, 46, 47, 48 and 49) the word AERO is used as an indirect reference to the fact that the clothing concerned offers either an aerodynamic advantage or will assist in regulating the wearer’s body temperature (or both). There are other examples provided where the word is being used in a different context i.e. as a reference to aviation (pages 32, 33, 36 and 37) and others where it appears to be being used in a purely trade mark context (pages 34, 35, 38, 39, 40, 41, 42, 44, 45 and 50). In short, when considered on the balance of probabilities, it appears that in the context of sports clothing in general and specialised cycling and running gear in particular, that, to use Group’s words, the word AERO “strongly alludes” to the properties I have mentioned above and is, as a consequence, a dominant but weak element of the competing trade marks. There is however nothing to suggest that the same is true of general i.e. non-sporting items of clothing. While the word AERO is likely to be considered a somewhat more distinctive element when considered in the context of items of non-sporting clothing, when

considered overall, I think the distinctive character of both parties' trade marks is more likely to lie in the totalities they create rather than the individual elements of which they are made up.

### **Visual similarity/aural similarity**

53. I have described the competing trade marks above. They consist of two words of four and five letters and four and three letters respectively; all the letters are presented in upper case; the first four letters are identical. In its submissions dated 15 August 2011, Group said in relation to visual and aural similarity:

“8. Comparing the marks, the only common element is the non-distinctive component AERO. The distinctive and dominant elements are SPORT and DRY, which bear no visual relation to each other...”

“9. Due to the nature of the term AERO, the elements SPORT and DRY would be heard as the most distinctive elements of the marks aurally. The element SPORT within [the Dickson's] trade mark has a sharp and defined P and T, while the DRY element of [Group's] marks has a strong D and defined Y (phonetically pronounced as “i” or “eye”. Thus, the marks are aurally dissimilar.”

54. Notwithstanding that the second element of the competing trade marks is completely different both visually and aurally, the fact that both parties' trade marks contain the word AERO as the first element leads, in my view, to a reasonable degree of both visual and aural similarity between them.

### **Conceptual similarity**

55. In its submissions dated 15 August 2011 Group said:

“10. Conceptually the term AERO in all the marks is a well-known truncation of the terms “aerodynamic” or “aerodynamically.” The term brings to mind goods that are aerodynamically beneficial, and therefore help the wearer go faster when taking part in their chosen sport....The attention of the consumer is consequently drawn to the nature of the second part of each mark. AERO DRY is a syntactically unusual juxtaposition of words and a lexical invention, as it is not common to state that a product is “aerodynamically dry”. AERO SPORT has, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately, being products that are used for sport and that have aerodynamic qualities. Further, taking the terms SPORT and DRY alone, each has completely different connotations...”

56. I agree that the words SPORT and DRY have completely different meanings. However, if the average consumer is familiar with the word AERO in the various contexts Group relies upon in these proceedings, it appears to me that its trade mark is likely to be construed by the average consumer as meaning clothing which has

aerodynamic qualities which also allow the wearer to stay dry, whereas the Dickson's trade mark will, on Group's own argument, be seen as indicating sports clothing with aerodynamic qualities. As both parties' trade marks focus on the aerodynamic nature of its clothing and as staying dry is a desirable quality for anyone performing certain sports, the conceptual messages sent by the competing trade marks are, in my view, complementary i.e. here we have aerodynamic sports clothing which will allow you to go faster (which in turn will make you perspire more) but will also keep you dry.

### **Distinctive character of the Dickson's earlier trade mark**

57. I must now assess the distinctive character of the Dickson's earlier trade mark. The distinctive character of a trade mark must be appraised first, by reference to the goods in respect of which it has been registered and, secondly by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

58. In its submissions dated 15 August 2011 Group said;

“16. Further, [the Dickson's] have not demonstrated that [they have] acquired any reputation in [their marks] that would make confusion more likely; noting that in light of the overall allusive nature of its mark...it must demonstrate a very strong reputation in order to support any likelihood of confusion.”

59. Having provided a detailed critique of the Dickson's evidence, Group concludes:

“16.6...Even if the figures relate solely to the goods in question in relation to the UK only, which is not accepted, these figures are not large enough to support a claim that [the Dickson's] marks are “widely known” amongst the relevant public.

16.7 In summary, the only evidence that [the Dickson's] have adduced of any use of [their trade marks] during the relevant period has been of the listing of one pair of shorts in a Motorworld catalogue, in which the use of the brand was not visible in the representation provided. Such evidence cannot be the basis of any claim of a reputation on which confusion would be based.”

60. Considered as an unused trade mark, I think that the Dickson's AERO SPORT trade mark is, as Group suggests, allusive. On that basis, it is, in my view, possessed of a degree of inherent distinctiveness neither higher nor lower than the norm. As to the use the Dickson's have made of its trade marks, I agree with Group's conclusions. Even if all of the promotional spend and turnover achieved by the Dickson's could be attributed to the goods the subject of these proceedings (which it cannot given that the turnover

claimed by the Dickson's runs to a period some 10 months after the material date in these proceedings and relates to a wide range of non-clothing related bicycle accessories) it would (given the inevitable size of the markets for both general sports clothing and specialist cycling clothing) be insufficient to improve upon the trade mark's inherent credentials.

### **Likelihood of confusion**

61. In determining whether there is a likelihood of confusion, I need to bear a number of factors in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. It is also necessary for me to keep in mind the distinctive character of the Dickson's earlier trade mark (as the more distinctive this trade mark is, the greater the likelihood of confusion), the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

62. Earlier in this decision I concluded that the average consumer of the identical goods at issue was a member of the public who would select the goods primarily by visual means and whose degree of attention was likely to vary from reasonable to heightened depending on the nature and cost of the item concerned. Insofar as the distinctive and dominant components of the trade marks are concerned, I concluded that as the words SPORT and DRY would be construed by the average consumer as being descriptive and as the word AERO would (insofar as articles of sports clothing is concerned) be considered a weak element, the distinctiveness of the competing trade marks lay in their totalities. I then went on to find that the competing trade marks were visually and aurally similar to a reasonable degree and shared a degree of conceptual complementarity. Finally, I assessed the degree of inherent distinctive character present in the Dickson's trade mark as no lower or higher than the norm and concluded that the use the Dickson's had made of the trade mark had not altered this position.

63. In reaching a conclusion on the likelihood of confusion, I note that in *L'Oréal v OHIM* case C-235/05 P the CJEU said:

"42. It follows that the distinctive character of the earlier mark cannot have the significance which the applicant argues it should be given in the comparison of the signs in question, as it is not a factor which influences the perception which the consumer has of the similarity of the signs.

43. It must therefore be held that the applicant has misconstrued the concepts which govern the determination of whether a likelihood of confusion between two marks exists, by failing to distinguish between the notion of the distinctive character of the earlier mark, which determines the protection afforded to that mark, and the notion of the distinctive character which an element of a complex

mark possesses, which is concerned with its ability to dominate the overall impression created by the mark.

44. In the second place, as was pointed out at paragraphs 35 and 36 of this judgment, the existence of a likelihood of confusion on the part of the public must be assessed globally, taking into account all factors relevant to the circumstances of the case.

45. The applicant's approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders."

64. While I have accepted that in view of the evidence filed by Group that the word AERO appearing in both parties' trade marks is, when considered in the context of sports clothing, a weak element, I have also concluded that given the presence in the competing trade marks of the descriptive words SPORT and DRY that the distinctive character of both parties trade marks lies in the totalities they create, totalities which, in my view, send complementary conceptual messages. Weighing all the factors as I must, there is, in my view, no likelihood of the competing trade marks being mistaken for one another i.e. there will be no direct confusion. However, in view of the similarities I have identified earlier and notwithstanding the weak nature of the word AERO, but keeping in mind the comments in *L'Oreal*, I have concluded that the identity in the goods, combined with the reasonable degree of both visual and aural similarity and the conceptually complementary messages the competing trade marks are likely to create in the average consumer's mind, are likely to lead the average consumer to assume that the goods originate from economically linked undertakings i.e. there will be indirect confusion.

65. Whilst the Dickson's opposition to Group's application for registration succeeds in respect of:

Sportswear; waterproof and weatherproof clothing for sports; thermal clothing for sports; lightweight clothing for sports; sports clothing; salopettes; gloves for sports; gaiters; clothing and headgear for sports purposes including tennis, squash, table tennis, paddle tennis, racquetball, softball, golf, badminton,

volleyball, basketball, cricket, hockey, football, rugby and baseball [other than for protection against accident or injury]; wet suits; sports headgear (other than helmets); sportswear, sports uniforms; sporting articles (clothing) for equestrian use [other than for protective purposes]; fishing smocks; fishing jackets, vests; parts and fittings for all the aforesaid goods, all for use in sports,

Group's application may proceed to registration for those goods which the Dickson's did not oppose i.e.

Footwear; sports shoes, trainers, boots, walking boots, football boots, shoes, cycling shoes, footwear for sports purposes including tennis, squash, table tennis, paddle tennis, racquetball, softball, golf, badminton, volleyball, basketball, cricket, hockey, football, rugby and baseball [other than for protection against accident or injury]; boots.

### **Costs**

66. The Dicksons have been successful and are entitled to an award of costs. Awards of costs are governed by Annex A of Tribunal Practice Notice 4 of 2007. In its letter of 20 February 2012, Group said in relation to costs:

"However, we reserve the right to file submissions to the Hearing Officer in respect of costs once the decision has been handed down, on the basis that our client has been required to proceed to defend the opposition in relation to these goods, given that it is only on the eve of a decision, when pointed out by the Hearing Officer, that the anomaly is addressed. Further, we note that it is disingenuous to characterise the inclusion of footwear as a typographical error on the opposition form, when it was also referred to as being in the scope of the opposed goods in the opponent's two supporting witness statements."

67. I note that in its counterstatement Group said:

"3. [Group] denies that all the goods for which registration is sought are identical or similar to the goods for which [the Dickson's] registrations are registered."

68. Having reviewed Group's written submissions of 15 August 2011 and 11 January 2012, the only occasion on which Group specifically comment on the similarity of the competing goods at issue in these proceedings is that reproduced above. Given the nature of the proceedings and evidence filed, I can see no reason why the inclusion of the term "footwear" which occurred when the Form TM7 was drafted and which was carried through to the first of Mr Dickson's statements would have any significant impact on the costs Group incurred in defending its application. In those circumstances, I see no reason to seek the Dickson's views on the contents of Group's letter of 20 February 2012 nor do I intend to consider any further submissions from Group on the issue of costs.

69. In view of my comments above, and using the TPN mentioned as a guide, I award costs to the Dicksons on the following basis:

Preparing a statement and considering Group's statement:	£300
Official fee:	£200
Preparing evidence and considering Group's evidence	£300
<b>Total</b>	<b>£800</b>

70. I order Dunlop Slazenger Group Limited to pay to Brian W Dickson and Julie M Dickson the sum of **£800**. 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 29<sup>th</sup> day of February 2012**

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