

O-096-13

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2584064  
IN THE NAME OF AHMET EROL  
FOR REGISTRATION OF A TRADE MARK

AND

OPPOSITION THERETO UNDER NO 102427  
BY LONSDALE SPORTS LIMITED

## Background

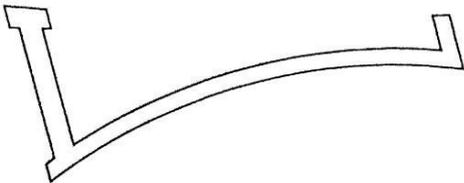
1. Application No. 2584064 has an application date of 9 June 2011 and stands in the name of Ahmet Erol ("the applicant"). It seeks registration of the following trade mark:



2. Registration is sought in respect of the following goods:

*Articles of clothing; shirts, t-shirts (short-sleeved); sports shirts; bodices (lingerie); jumpers (clothing); sweaters; pullovers; scarves; jackets; waistcoats; parkas, jackets, tracksuits; coats; overcoats; bathrobes; swimsuit; bathing caps, slippers and pool sandals; pyjamas; dressing gowns; scarves and ties; stockings; socks; boxer shorts; tights; underpants; braces; belts (clothing), trousers and skirts; raincoats; lingerie; neckerchiefs; clothing for gymnastics; underwear, sweat absorbent underwear; braces; uniforms; boots; football boots; ski boots; footwear; sports and beach footwear; shoes; articles of headgear; peaked caps, caps; visors (headgear).*

3. Following publication of the application in the *Trade Marks Journal* on 22 July 2011, notice of opposition was filed by Lonsdale Sports Limited ("the opponent"). Basing its opposition on grounds under sections 5(2)(b) and 5(3) of the Act, the opponent relies on the following trade marks:

Mark	Filing/Registration date	Specification
2371554 	25.8.2004/28.1.2005	Goods in classes 18 and 25

<p>2368165</p> 	<p>14.7.2004/23.3.2007</p>	<p>Goods in classes 3, 5, 9, 12, 14, 15, 16, 18, 21, 22, 24, 25, 26, 28, 29, 34, 35, 43</p>
<p>1479025 (Series of two marks)</p>  <p>LONSDALE</p>	<p>9.10.1991/15.9.1995</p>	<p>Goods in class 25</p>
<p>2363127</p> 	<p>12.5.2004/11.3.2005</p>	<p>Goods in classes 3, 5, 7, 9, 12, 14, 16, 18, 21, 24, 25, 27, 28, 34, 35</p>
<p>1206935</p> 	<p>11.11.1983/23.7.1993</p>	<p>Goods in class 25</p>

4. For completeness, I should say that whilst the opponent also relied on a further mark (No 770999A) in its statement of grounds, that mark has subsequently expired and the opponent indicated in its skeleton argument that it is no longer relying on it in these proceedings. I will say no more about this.

5. Under the provisions of section 5(4)(a) of the Act, the opponent relies on use in the course of trade of various signs corresponding to the above marks as well as the following marks:

Mark	Use claimed since
2461258 	12 July 2007
2368108 	13 July 2004
2461261 	12 July 2007
2122643  	4 February 1997
2301971 	30 May 2002
1038179 	13 November 1974
CTM 2421279 	23 October 2001

6. The applicant filed a counterstatement. He admits that “certain goods for which [he] seeks registration of [his] mark are identical to goods for which the Opponent’s Marks are registered, whereas others are merely similar” though does not further

elaborate. He denies that the respective marks are similar for the purposes of section 5(2)(b) of the Act, does not admit that the opponent's marks, relied on for the purposes of section 5(3) of the Act, have a reputation and, further, denies the signs relied on for the purposes of section 5(4) of the Act have the requisite reputation and goodwill.

7. Only the opponent filed evidence. This takes the form of a witness statement dated 20 February 2012 by Robert Frank Mellors who is employed by the opponent as a director, a position he has held since November 2005. The matter came before me for a hearing on 8 October 2012. The applicant did not attend but written submissions were filed on his behalf by Williams Powell, his professional representatives in these proceedings. The opponent filed written submissions as well as a skeleton argument and was represented at the hearing by Mr Tom Moody-Stuart of Counsel instructed by Bristows, its professional representatives in these proceedings.

## **Decision**

### **The objection under section 5(2)(b) of the Act**

8. Section 5(2)(b) of the Act states:

“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,

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

9. 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,
- (b) .....
- (c) .....

(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.”

10. Under this ground, the opponent relies on its registration Nos. 2371554, 2368165, 1479025, 2363127 and 1206935. In my view, the opponent’s strongest case lies in 2371554 and 2363127: if it cannot succeed in respect of these earlier registrations, it will be in no better position as regards its other marks. I proceed on that basis. Both of these marks are an earlier mark within the meaning of section 6(1) of the Act. In its counterstatement, the applicant requested that the opponent prove use of these marks. As each of these marks was registered more than five years prior to the date the application was published, the requirements of Section 6A of the Act are relevant to each of them.

11. Section 6A of the Act reads:

“6A (1) This section applies where-

an application for registration of a trade mark has been published,

there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if-

within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes-

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) .....

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7)....”

12. Also of relevance is section 100 of the Act which states:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

13. The relevant period in which the opponent is required to prove use of its marks is 23 July 2006 to 22 July 2011. The guiding principles to be applied in determining whether there has been genuine use of a mark are set out in *Ansul BV v Ajax Brandbeveiliging BV* [2003] RPC 40 and *Laboratoire de la Mer Trade Mark* [2006] FSR 5. From these cases it is clear that:

- genuine use entails use that is not merely token. It must also be consistent with the essential function of a trade mark, that is to say to guarantee the identity of the origin of goods or services to consumers or end users (*Ansul*, paragraph 36);
- the use must be „on the market’ and not just internal to the undertaking concerned (*Ansul*, paragraph 37);
- it must be with a view to creating or preserving an outlet for the goods or services (*Ansul*, paragraph 37);
- the use must relate to goods or services already marketed or about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns (*Ansul*, paragraph 37);
- all the facts and circumstances relevant to determining whether the commercial exploitation of the mark is real must be taken into account (*Ansul*, paragraph 38);
- the assessment must have regard to the nature of the goods or services, the characteristics of the market concerned and the scale and frequency of use (*Ansul*, paragraph 39);
- but the use need not be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39);
- an act of importation could constitute putting goods on the market (*Laboratoire de la Mer*, paragraph 25 referring to the earlier reasoned order of the ECJ);

- there is no requirement that the mark must have come to the attention of the end user or consumer (*Laboratoire de la Mer*, paragraphs 32 and 48);
- what matters are the objective circumstances of each case and not just what the proprietor planned to do (*Laboratoire de la Mer*, paragraph 34);
- the need to show that the use is sufficient to create or preserve a market share should not be construed as imposing a requirement that a significant market share has to be achieved (*Laboratoire de la Mer*, paragraph 44).

14. I must also keep in mind the guidance in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32, in relation to determining what constitutes a fair specification, namely:

“Pumfrey J in *Decon* suggested that the court’s task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view the task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use”.

15. In *Animal Trade Mark* [2004] FSR 19, Jacob J held:

“The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pernicky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for three-holed razor blades imported from Venezuela (Mr T.A. Blanco White’s brilliant and memorable example of a narrow specification) “three-holed razor blades imported from Venezuela” is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say “razor blades” or just “razors”. Thus the “fair description” is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection (“the umbra”) for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods (“the penumbra”). A lot depends on the nature of the goods—are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.”

16. Also of relevance are the comments of the Court of First Instance in *Reckitt Benckiser (España) SL v OHIM*, Case T-126/03 where it said:

“45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it

to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories to which the goods or services for which the trade mark has actually been used belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of „part of the goods or services’ cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.”

17. I also note the comments of Mr Geoffrey Hobbs Q.C. sitting as the appointed person, in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited* BL O/345/10, where he stated:

“However, that does not appear to me to alter the basic nature of the required approach. As to that, I adhere to the view that I have expressed in a number of previous decisions. In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

### **The opponent’s evidence**

18. There is no dispute that the word LONSDALE comes from the name of Hugh Cecil Lowther, the Fifth Earl of Lonsdale, who organised boxing matches in 1909 and became president of the National Sporting Club of Britain. Boxers who became a champion, and defended the title successfully three times, received “the Lonsdale Belt”, the oldest belt in boxing. In 1960, his heir, the Seventh Earl, James Lowther, granted permission to a Bernard Hart, an ex-boxer, to use the name “Lonsdale” for boxing clothes and equipment.

19. Mr Hart later incorporated Lonsdale Sports Equipment Limited and developed trade marks which consisted of or included the words LONSDALE and LONSDALE

LONDON presented in the style shown above and with the initial letter L of LONSDALE in elongated form. He later began selling a wider variety of clothing and sporting equipment. In August 1960 Mr Hart opened a shop in Beak Street, Soho and by 1986 the company had 6 shops (4 in London and 2 in North Wales). In 1994, the company granted a license allowing its goods to be distributed in mainland Europe. The company was purchased subsequently by Sports Direct International Plc but is said to retain its own identity.

20. The opponent's marks are said to have been in continuous use in the UK for over 50 years with the range of goods sold under them having expanded to include a wide range of sports and leisure clothing, footwear, headgear and equipment including such goods for use in cycling, football, swimming, judo, wrestling and table tennis. The marks are said to have been used on the products themselves as well as on internal tags, swing tags and promotional material.

21. Mr Mellors' evidence included an exhibit which has subsequently been made the subject of an order for confidentiality. The exhibit contains details of: a) the value of sponsorship deals since 2002; b) sales made in the EU through Sports Direct stores in the years April 2005 to April 2008; c) worldwide sales from 2001 to April 2004; and d) the value of royalties received in the EU from 2004 to 2007. Whilst each of the figures provided is substantial, they have not been broken down in terms of the proportion which might have accrued to the various marks used or the goods to which those sales relate and no indication is given of the proportion of the totals that relate to sponsorship or sales in the UK and so are not of any great assistance to me in reaching my decision.

22. Many hundreds of pages of exhibits have been filed. They include catalogues, many of which are undated and some of which have been filed more than once (see e.g. Exhibit 5 at pages 212-221 and again at 255 -264) and some of which appear to be from outside the UK (see e.g. Exhibit 5 pages 155-162). Others have clearly been available in the UK within the relevant period (see e.g. Exhibit 5 page 189 onwards, Boxing Catalogue 2006-2007, page 223 onwards the Sportsdirect.com Xmas '09 catalogue and page 289 onwards the Sportsdirect.com Spring/Summer 2010 catalogue). The various boxing catalogues offer for sale a variety of specialist clothing such as gloves, boots and headguards for use by boxers as well as equipment such as protective pads for use in boxing rings, punch bags and holdalls. Other catalogues show a range of clothing, footwear and headgear for men, women and children.

23. At RM8 are exhibited a number of invoices along with explanatory pages showing the goods sold under those invoices. They show sales of clothing, footwear and headgear which bear the marks. The invoices date from 2008-2011 (with others dating from after the relevant period) and show sales to a number of different traders within the UK.

24. The material shows many examples of the use of the word LONSDALE (either in plain block capitals or in what the parties have referred to as cinemascope style) and either alone or with other elements such as the word London or devices such as a lion. Whilst the evidence suffers from a number of flaws, I am satisfied that it shows use of earlier mark 2363127 during the relevant period in relation to a wide range of

clothing, footwear and headgear. On that basis, I consider that the opponent is entitled to rely on this registration for the full specification as registered. There are examples within the exhibits of use of the word Lonsdale with the initial letter L in a different colour to the rest of the word but this is not enough to persuade me that it is use of earlier mark 2371554 as and of itself. That being the case, I consider the opponent is not entitled to rely on this mark in these proceedings.

25. In determining the question under Section 5(2)(b), I take into account the guidance provided by the Court of Justice of the European Union (CJEU) in *Sabel v Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R 77, *Marca Mode CV v Adidas AG* [2000] E.T.M.R.723, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di Laudato & C. Sas v OHIM* C-334/05 (Limoncello), as cited with approval in *Och-Ziff Management Europe Ltd and Oz Management LP v Och Capital LLP, Union Investment Management Ltd and Ochoki* [2010] EWCH 2599 (Ch). It is clear from these cases that:

- (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 greater 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 the respective goods**

26. The applicant concedes, in his written submissions, that the respective goods are identical.

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

27. 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.

28. The term *sportswear* includes clothing specifically designed or adapted for use in a particular sport but is also commonly used and understood to refer to clothing which is worn more generally on less formal occasions i.e. a training sweatshirt worn as casual or leisure clothing. Clothing, whether sports clothing or the more general variety, are goods which will be bought by the public at large and these then are the average consumer for these goods. 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 (see for example the comments of the Appointed Person in *React Trade Mark* [2000] RPC 285).

29. 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 considered the level of attention taken when purchasing goods in the clothing sector:

“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.”

30. As the *New Look* case acknowledges, the cost of clothing can vary considerably, however, I must keep in mind goods across the whole price spectrum. While the average consumer’s level of attention is likely to vary considerably given the cost and nature of the particular item being bought, I consider that, even when selecting routine items, the average consumer is likely to be conscious of factors such as the size, colour, material and price of the article concerned and its suitability for purpose and ease of being laundered. Overall, I think the average consumer is likely to pay at least a reasonable degree of attention to the selection of the goods at issue.

**Comparison of the respective marks**

31. It is well established that 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, the average consumer rarely has the chance to make direct comparisons between trade marks but must, instead, rely on the imperfect picture of them he may have kept in mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant elements of the respective trade marks and, with that conclusion in mind, I must go on to compare the respective trade marks from the visual, aural and conceptual perspectives.

32. I set out below the marks to be compared:

Earlier mark 2363127	Application
	

33. In his written submissions, the applicant refers to the stylisation of the earlier mark and submits that that stylisation does not affect its distinctive character. He assets them to be non-distinctive additions and in support of this claim makes reference to another of the opponent’s registrations (i.e. 1479025 see above) which was registered for the word LONSDALE as a series of two marks where one is presented in plain block capitals and the other in „cinemascope’ style with an elongated initial letter L. I am not aware of the circumstances which led to

registration of these marks as a series other than the fact that they proceeded on the basis of honest concurrent use from 1961. Whatever the circumstances of the acceptance of that application for registration, I have to consider matters afresh on the basis of the marks before me. As was said by the registrar's Hearing Officer in *Elia International Ltd's application O-168-04*:

“ 32) Parts of both Philips' statement of grounds and its evidence deals with what it clearly considers as failings and/or errors at the examination stage. There are mechanisms for dealing with such matters. Third party observations can be made up to registration under section 38(3) of the Act. There are also well publicised routes for complaints. An opposition is a matter between two sides. The registrar is acting as an independent tribunal. It is neither possible nor appropriate to mix into a dispute between two sides complaints about how the application has been examined. Elia pointed this out in its counterstatement and is completely correct. I have to decide the issues before me on the basis of the application as it stands, the statement of grounds and the evidence submitted.”

34. Earlier mark 2363127 consists of the word LONSDALE presented in „cinemascope' style (i.e. where the size of each letter gradually decreases in a curved shape from the first letter to the middle of the word before gradually increasing again to the final letter). Each letter is presented in a slightly stylised font. The foot of the large initial letter L extends in an arc under and beyond the remaining letters with a slight upturn at its end as if to support or contain those other letters. The dominant element of the mark is the word Lonsdale with the style of the letter L being further distinctive element of the mark.

35. The mark applied for consists of a number of elements. The largest element within the mark is the word LONDON, which is also presented in cinemascope style and again with each letter in a slightly stylised, somewhat angular, font and with the initial letter L extending in an arc under and beyond the remaining letters with a slight upturn at its end as if to support or contain those other letters. Below this is a smaller Union Jack type flag with the word ENGLAND below that again. Above the first two letters of the word LONDON, and in much smaller format, are what appear to be the letters NaS with the N and S capitalised and in the a in lower case. Above the last two letters of the word London and, again, much smaller than them, is a tick device. Whilst the letters NaS and the tick device are distinctive elements, their size in relation to the other elements of the mark mean they are not dominant elements. The flag device and the word England are not distinctive. The word LONDON is, given its size and positioning, the dominant element of the mark. Whilst the word LONDON is not, of itself, a distinctive word, it is the dominant element of the mark with the style and prominence of the elongated initial letter L adding to that distinctiveness.

36. From the visual perspective, the commonality of the elongated L and cinemascope style presentation of the dominant element of each mark leads to a degree of similarity between them. That similarity is increased by the fact that the words share the first three letters and have a letter D at their centre point. But there are also significant differences between the respective marks given the remaining letters of the dominant elements and the fact that the word LONDON in the applicant's mark is somewhat „surrounded' by the NaS, tick device, union jack device

and word England. In my view, there is a moderate degree of visual similarity between the respective marks.

37. The earlier marks are likely to be pronounced as “Lons”- “Dale” whereas the application is likely to be pronounced as “Lun” “Dun”. Whilst there is a degree of similarity which accrues to the commonality of the initial letter L and the presence of the letters N at the end of the first syllable and D start of the second in each mark, I consider the marks to be aurally similar to a very low degree.

38. Conceptually, the earlier marks are likely to bring to mind a surname and, for those aware of the relevant history, the relationship of the name with the boxing world may also be brought to mind. As for the mark of the application, the mark will bring to mind a geographical location. The respective marks are conceptually distinct.

### **The distinctive character of the earlier mark**

39. The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which it has been acquired and, secondly, by reference to the way it is perceived by the relevant public (see *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 and services for which it has been registered as coming from a particular undertaking and thus to distinguish those goods and services from those of other undertakings (see *Windsurfing Chiemsee v Huber and Attenburger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585).

40. Lonsdale is a surname and one that is likely to be well-known in the sporting world given its importance to the origins of the sport of boxing. For more general clothing, footwear and headgear, it is of greater distinctive character. As a surname, its inherent distinctive character is, at best, average. As I indicated above, the evidence of use filed suffers from a number of flaws not least in that the figures given (which are substantial) are general figures which have not been apportioned to the particular marks relied upon. Neither have they been separated to show what proportion of them relate to the particular goods in question, given that the opponent sells not only casual clothing but also e.g. clothing specifically for various sports use along with sporting equipment and bags. None of the figures given are specific to the trade in the UK. Whilst I have found the evidence to be sufficient to enable me to find that the earlier mark has been used, I cannot be certain as to what degree that use will have enhanced the distinctiveness of the mark. That said, it is abundantly clear from the evidence that the word LONSDALE presented in the cinemascope style with the elongated L has a reputation, as it has been used extensively in a variety of marks in relation to the sale of a wide variety of clothing, footwear and headgear over many decades and this will have had a positive, though unquantified, effect on the distinctive character of the mark as registered.

## **Likelihood of confusion**

41. In determining whether there is a likelihood of confusion, a number of factors have to be borne in mind. The first is the interdependency principle whereby 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. I also have to factor in the distinctive character of the earlier mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind 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 on the imperfect picture of them he has retained in mind.

42. Earlier in this decision I found that identical goods are involved. I found that the purchasing act will be primarily a visual one. I found that the respective marks share a moderate degree of visual similarity. I found there to be a very low level of aural similarity and found them to be conceptually distinct. I found the earlier mark to have, at best, an average degree of inherent distinctive character and that the word LONSDALE, presented in the cinemascope style with the elongated L has been used extensively in relation to the sale of clothing over many decades which will have had an unquantified positive effect on the distinctive character of the mark as registered.

43. Taking all relevant matters into account, I have concluded that the competing goods are identical and that the marks have a moderate degree of visual similarity and a very low degree of aural similarity. I have found them to be conceptually distinct. I have found the average consumer will pay a reasonable degree of attention in the purchasing process. In my view there are significant visual, aural and conceptual differences in the respective marks which, given the nature of the purchasing process outweigh any similarities and lead me to conclude that there is no likelihood of either direct or indirect confusion between the respective marks even where identical goods are involved.

44. The opposition based upon section 5(2)(b) of the Act fails.

### **The objection under Section 5(3) of the Act**

45. Section 5(3) of the Act states:

“ A trade mark which-

- (a) is identical with or similar to an earlier trade mark shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

46. In relying on this ground, the opponent relies on the same marks as it did in support of its objection under section 5(2) of the Act. Again, I consider its strongest case to rest on its earlier mark 2363127.

47. The opponent puts its objection in the following terms in its notice of opposition:

“32. The Opponent’s Marks enjoy a huge degree of distinctiveness in addition to a massive reputation amongst the relevant public to the point of being a house-hold name. ....the “link” necessary to form the basis of an opposition under Section 5(3) would be created between the Opponent’s Marks and the Applicant’s Mark, given the high degree of similarity between the marks.

33. In addition to either establishing a “link” between the entities or in fact causing direct confusion as to origin, as the Opponent has no control over the Applicant’s use of the mark, particularly as regards the quality of the goods, detriment is likely to take the form of the dilution and tarnishing of the Opponent’s Marks such that the Opponent’s ability to distinguish its goods from those of its competitors will be compromised. Further, use of the Applicant’s Mark is likely to lead to a dilution of the capacity of the mark to identify and distinguish goods and services in the eyes of consumers.

34. It is submitted that the use of the Applicant’s Mark is also likely to lead to confusion in the market place and may lead consumers to select goods bearing Applicant’s Mark in error, which would impact negatively on the revenue which could be generated under the Opponent’s mark. Where there is such confusion, it is almost inevitable that the distinctive character and repute of the Opponent’s Registrations will be affected.

35. Further, there is no reason, independent of the Opponent’s brand, for the Applicant to use such a similar mark in connection with its goods. It is clear that the Applicant has adopted a mark that is very similar to the Opponent’s Mark in order to “free ride” on the back of the reputation of the Opponent’s Registrations and enable the Applicant to generate goodwill in the goods for which the Application has been filed, by creating the false impression that these goods emanate from the same source of origin as the Opponent’s Marks, or a related source. In such circumstances where the Applicant is seeking to associate itself with the Opponent, it is clear that an unfair advantage has been obtained by the Applicant.

36. To this extent, unfair advantage and detriment is a reasonably foreseeable consequence of the Application in the ordinary course of events and is not simply a hypothetical or remote possibility of the Applicant’s adoption of the Applicant’s Mark.”

48. In my consideration of the objection based on section 5(2) of the Act, I found the opponent’s mark to have a reputation. In addition to having a reputation, a link must be made between the respective marks. In *Adidas-Salomon* Case C-408/01 the CJEU stated:

“The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23). The existence of such a link must, just like a likelihood of confusion in the context of Article 5(1)(b) of the Directive, be appreciated globally, taking into account all factors relevant to the circumstances of the case (see, in respect of the likelihood of confusion, *SABLE*, paragraph 22, and *Marca Mode*, paragraph 40).”

49. In *Intel Corporation Inc v CPM (UK) Ltd* (C-252/07) (“Intel”) the CJEU provided further guidance on the factors to consider when assessing whether a link has been established. It stated:

“41. The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstance of the case...

42 Those factors include:

- the degree of similarity between the conflicting marks;
- the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;
- the strength of the earlier mark’s reputation;
- the degree of the earlier mark’s distinctive character, whether inherent or acquired through use;
- the existence of the likelihood of confusion on the part of the public.”

50. I take note that both the CJEU and the GC have reiterated the comment made in *Premier Brands UK Ltd v Typhoon Europe Ltd* [2000] FSR 767 (albeit in relation to section 10(3)) that the purpose of the Regulation is not to prevent registration of any mark which is identical or similar to a mark with a reputation and am mindful of the comments of Patten J in *Intel Corporation Inc v CPM United Kingdom* [2006] EWCH 1878 where he stated:

“But the first step to the exploitation of the distinctive character of the earlier mark is necessarily the making of the association or link between the two marks and all that Neuberger J is, I think, saying in this passage [*Premier Brands* at p789] is that the existence of a later mark which calls to mind the earlier established mark is not sufficient to ground an objection under s.5(3) or s10(3) unless it has one or other of the consequences specified by those provisions. It must be right that the making of the association is not necessarily to be treated as a detriment or the taking of an unfair advantage in itself and in cases of unfair advantage it is likely to be necessary to show that

the making of the link between the marks had economic consequences beneficial to the user of the later mark.”

51. Although the issue of the effect on economic behaviour arose in the above case in the context of detriment or dilution, it is, I believe, reasonable to infer that similar considerations would also arise in the context of the question of unfair advantage.

52. Indeed in *Electrocoin Automatics Limited v Coinworld Limited and Others* [2005] FSR 7, Mr Geoffrey Hobbs Q.C, sitting as a Deputy Judge stated:

“102. I think it is clear that in order to be productive of advantage or detriment of the kind prescribed, “the link” established in the minds of people in the market place needs to have an effect on their economic behaviour. The presence in the market place of marks and signs which call each other to mind is not, of itself, sufficient for that purpose.”

53. In *C A Sheimer (M) Sdn Bhd’s TM Application (VISA)* [2000] RPC 484 Geoffrey Hobbs Q.C. sitting as the Appointed Person considered whether Sheimer’s mark

“would, without due cause:

(iv) take unfair advantage of the distinctive character or repute of Visa International’s earlier trade mark”.

In setting out his finding, he stated:

“I think it is clear that Sheimer would gain attention for its products by feeding on the fame of the earlier trade mark. Whether it would gain anything more by way of a marketing advantage than that is a matter for conjecture on the basis of the evidence before me. Since I regard it as quite likely that the distinctive character or reputation of Visa International’s earlier trade mark would need to increase the marketability of Sheimer’s products more substantially than that in order to provide Sheimer with an unfair advantage of the kind contemplated by Section 5(3) I am not prepared to say that requirement (iv) is satisfied.”

54. I must be satisfied, therefore, that, for those people who make a link between the respective marks, the link they make affects their economic behaviour and, if so, that the reputation of the earlier mark is transposed to the later mark with the result that marketing and selling of the applicant’s goods becomes easier.

55. There is no doubt that the opponent has a long established business and has sold its goods very successfully over a number of years. But despite this, I do not consider that the applicant would gain any unfair advantage through the use of his mark. It is not clear exactly what advantage he would gain and, furthermore, there is no evidence of any intention on his part nor is there any other added factor that would support the opponent’s claim under this ground. In relation to dilution, I can see no reason why the capacity of the earlier marks to distinguish the opponent’s goods would be diminished to any extent, and certainly not one that would have any impact on the economic behaviour of the relevant public. That being the case, the opposition brought under section 5(3) of the Act fails.

### **The objection under section 5(4)(a) of the Act**

56. Under this ground, the opponent's notice of opposition discloses thirteen earlier rights on which it seeks to rely. Given the evidence filed, I do not consider that it can be in any better position under this ground in relation to any of these marks than it was under section 5(2)(b) and I decline to deal with the matter further.

### **Summary**

57. The opposition fails in respect of all grounds on which it was brought.

### **Costs**

58. The opposition having failed, the applicant is entitled to an award of costs in his favour. I note that he filed a very brief counterstatement, did not any evidence but would have had to spend some time reviewing that filed by the opponent and provided brief and straightforward written submissions in lieu of attendance at a hearing. I make the award on the following basis:

Preparing a statement and considering the opponent's statement:	£300
Reviewing evidence:	£400
<b>Total:</b>	<b>£700</b>

59. I order Lonsdale Sports Limited to pay Ahmet Erol the sum of £700. 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 27th day of February 2013**

**Ann Corbett  
For the Registrar  
The Comptroller-General**