

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2313032
BY CF COLLECTIONS LIMITED
TO REGISTER THE TRADE MARK
KO BOXER
IN CLASS 25**

**AND IN THE MATTER OF OPPOSITION No. 91559
BY JOE BOXER COMPANY LLC**

**AND IN THE MATTER OF AN APPEAL
TO THE APPOINTED PERSON
BY THE OPPONENT
AGAINST THE DECISION OF MR G.W. SALTHOUSE
(BL O/272/04)
DATED 3 SEPTEMBER 2004**

DECISION

Background

1. By an application filed on 12 October 2002 under number 2313032, CF Collections Limited (“the Applicant”) applied to register the trade mark KO BOXER for use in relation to “articles of clothing; underwear, including men’s underwear; headgear; footwear”. The specification was subsequently restricted to “men's underwear”.
2. Following publication, Joe Boxer Company LLC (“the Opponent”) opposed the application on 11 March 2003 under section 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“the TMA”).
3. In relation to the ground of opposition under section 5(2)(b) of the TMA, the Opponent relied on several earlier trade marks within the meaning of section 6(1) including both United Kingdom and Community trade marks. The Hearing Officer appeared to decide the opposition only on the basis of UK Trade Mark No. 1519012 and CTM No. 1491919 with which he considered the Opponent’s strongest case to reside. However, a complete list of the Opponent’s earlier trade marks concerned is set out below.

Mark	Number	Date	Goods/services
	UK 1409857	05.01.90	<u>Class 25</u> Articles of underclothing; socks; all included in Class 25; but not including babies' napkins, clothing to be worn for boxing or shorts.
JOE BOXER	UK 1519012	17.11.92	<u>Class 25</u> Articles of underclothing; socks; all included in Class 25; but not including shorts or clothing to be worn for boxing.
JOE BOXER	CTM 1146224	20.04.99	<u>Class 3</u> Colognes, fragrances, lotions, soaps, bath salts, nail polish and hair products, colours. <u>Class 9</u> Sunglasses, optical frames and telephones. <u>Class 24</u> Bed sheets, pillow cases, bed spreads, pillow shams, draperies, curtains, duvets, towels and fabric shower curtains.
JOE BOXER	CTM 1491919	04.02.00	<u>Class 14</u> Jewellery, including jewellery made of precious and non-precious metals; watches and clocks. <u>Class 18</u> Carrying cases, bags, luggage, suitcases; umbrellas; handbags, purses; belts and wallets. <u>Class 25</u> Clothing, footwear, headgear.
JOE BOXER	CTM 1530450	28.02.00	<u>Class 16</u> Paper and paper articles including paper patterns for making clothing; printed matter, publications, books, notebooks, agenda and address books; writing and drawing instruments and articles, stationery not included in other classes. <u>Class 27</u> Rugs and carpets.

			<p><u>Class 35</u> Operation of a retail store selling clothing, headgear, footwear, sunglasses, toilet preparations, perfumery and cosmetics, watches and jewellery, paper goods, furniture, home furnishings, toys and sporting goods; retail store services relating to clothing, headgear, footwear, sunglasses, toilet preparations, perfumery and cosmetics, watches and jewellery, paper goods, furniture, home furnishings, toys and sporting goods; retail store services, namely, the bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling consumers to conveniently view and purchase those goods.</p>
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4. As regards the ground for opposition under section 5(4)(a) of the TMA, the Opponent claimed earlier rights in the name and trade mark JOE BOXER such that the Applicant's use of KO BOXER in the UK was liable to be prevented by the law of passing off. The Opponent stated that it or its predecessors in title had conducted business in the UK under the name and trade mark JOE BOXER since 1990 when JOE BOXER figurative was registered under UK No.1409857. Further, the Opponent currently markets its products in the UK and many other countries in Europe. By virtue of this activity, the Opponent enjoys substantial reputation in the JOE BOXER name and trade mark especially in relation to clothing products.

The Opponent's evidence

5. The Opponent's evidence comprised a witness statement of Colette Sipperly, the Opponent's Vice President, Public Relations, dated 19 May 2004. Ms. Sipperly states that she has access to the Opponent's records of sales and promotions in the USA and elsewhere and of the corresponding activities of the Opponent's predecessors in title to the JOE BOXER trade marks. She confirms that the Opponent and its predecessors have conducted business in the UK since 1990 and states her belief that as a consequence of that activity, the Opponent enjoys a reputation in the JOE BOXER name in the UK. Ms. Sipperly explains that in recent years, a licensee marketed JOE BOXER products in the UK. She says that sales of these products were substantial during the 1990s and into the current decade. For 2001 – 2002 sales were in excess of \$1 million. She adds that there was some corporate restructuring in the Opponent's predecessors during this period, and new licence arrangements are in discussion. Ms. Sipperly states that the JOE BOXER name is applied in various forms to most if not all of the Opponent's products. She exhibits

illustrations of JOE BOXER swing tags that she says are applied to the Opponent's products together with photocopies showing the name applied to products themselves (two pictures of what could be men's underwear with JOE BOXER written in elasticated waistbands) and a length of JOE BOXER ribbon tape (Exhibit A). She also exhibits copies of the Opponent's current business stationery bearing the mark JOE BOXER (Exhibit B).

6. Moving to the goods in the application, Ms. Sipperly says that men's underwear constitutes a very significant proportion of the Opponent's product range. In order to demonstrate this, she exhibits material, which she says was used in September 2000 for a promotion at the Debenhams' store in London (Exhibit C). First an advertisement reads: "Thank you for wearing pants today. NOW AT DEBENHAMS." Two men and two women are pictured wearing underpants with JOE BOXER elasticated waistbands. The mark JOE BOXER appears at the bottom with the website address www.joeboxer.com. Second, a flyer headed "Fresh pants now at Debenhams!" offers: "FREE PANTS! Buy any 2 JOE BOXER products between September 6th – 10th and get the 3rd free, when you show this flyer. Watch out for the Joe Boxer Invasion at Debenhams Wednesday, 6th September, at 12 noon, Debenhams, Oxford Street, London. [No year is stated.] PANTS WILL BE FLASHED AND THROWN!" The small print reads: "Terms of offer: available at Debenhams, Oxford Street only. Lowest priced item is free." The JOE BOXER mark and website address appear underneath. At Exhibit C, Ms. Sipperly further includes copy material of a JOE BOXER launch party taking place off Regent Street, London on 7th September (presumably at the same time as the Debenhams' promotion.) This material also bears the slogan "Thank you for wearing pants today." The material announces that the American JOE BOXER brand of pants and sleepwear is being launched in the UK under licence and to celebrate its arrival, JOE BOXER has collaborated with the Royal College of Art to sponsor a competition to be judged by Damien Hirst. The material pictures a range of women and men's underwear some with the JOE BOXER elasticated waistband.

The Hearing Officer's decision

7. Neither side wished to be heard and the Hearing Officer came to a decision (BL O/272/04) based the papers including the written submissions of the Opponent.
8. The Hearing Officer dealt first with the ground of opposition under section 5(2)(b) of the TMA, which provides:

"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.”

Having acknowledged that all of the registrations relied upon by the Opponent were earlier trade marks within the meaning of section 6(1) of the TMA, the Hearing Officer directed himself in the usual way according to the judgments of the Court of Justice of the European Communities (“ECJ”) in Case C-251/95 *Sabel BV v. Puma AG* [1997] ECR I-6191, Case C-39/97 *Canon Kabushiki Kaisha v. Metro-Goldwyn-Meyer Inc* [1998] ECR I-5507, Case C-342/97 *Lloyd Schuhfabrik Meyer & Co GmbH v. Klijsen Handel BV* [1999] ECR I-3819 and Case C-425/98 *Marca Mode CV v. Adidas AG* [2000] ECR I-4881. This statement of the applicable principles is well known and there is no need to repeat it here. The Opponent accepts that the Hearing Officer correctly summarised the law.

9. The Hearing Officer concluded that the ground for opposition under section 5(2)(b) of the TMA was not made out. His reasoning was as follows:

“13) Clearly, the opponent’s strongest case is under UK Trade Mark 1519012 and CTM 1491919 both for the plain word JOE BOXER and both registered for goods which the applicant accepts are identical to those of the mark in suit.

14) The opponent has claimed that it has substantial reputation in the UK. However, it has provided sales figures for only one year and this amounted only to US\$1 million for their range of products. However, their marks are registered for, inter alia, all items of clothing, footwear, bedding, sunglasses, colognes and fragrances, jewellery, luggage, stationery, carpets and retail services. In this context the sales must be regarded as, at best, average. The opponent cannot benefit from an enhanced reputation.

15) I must also consider the inherent distinctiveness of the opponent’s marks. Clearly when used on men’s underwear it could be seen as an allusion to boxer shorts, but it is more likely to be seen as a name and therefore must be regarded as being inherently distinctive.

16) I now turn to consider the marks of the two parties KO BOXER and JOE BOXER. There are obvious visual and phonetic similarities and differences. The opponent claims that:

“When pronounced, the elements KO and JOE rhyme, and notwithstanding the different initial consonants, when spoken before “BOXER” as this word appears in both marks, the two marks as a whole sound similar”, and:

“Even if the letters of the acronym were pronounced, there is still in the Opponent’s submission a potential for confusion between “kay-oh boxer” and the Opponent’s mark JOE BOXER, when used in conversation.”

17) Whilst I accept that the beginnings of the two marks, “KO” and “JOE” could be said to rhyme, I believe that the average consumer would view the start of the mark as a clear reference to the acronym for “knock out” which is frequently used in boxing. Therefore, rather than viewing the start of the mark in suit as a word which would be pronounced “co” the average consumer would, in my opinion, see and pronounce the first part of the mark in suit as the two letters “K” and “O”. There is still a degree, albeit lessened, of rhythmical similarity.

18) Conceptually, to my mind the opponent’s mark will be seen as a “name”, which when applied to men’s underwear, has an allusive character. The mark in suit will, in my opinion, be viewed as a clear reference to pugilism. Applied to similar goods there is still an allusive nature but it actually reinforces the sporting theme. Overall I believe that the differences outweigh any similarities.

19) Items of clothing, even underwear, are not, I would suggest, chosen without some consideration. The average consumer of such products would, in my opinion, exercise some care in the selection. In *REACT* [1999] 15 RPC 529 the Hearing Officer held the following:

“I am therefore prepared to accept that a majority of the public rely *primarily* on visual means to identify the trade origin of clothing, although I would not go so far as to say that aural means of identification are not relied upon.”

20) Taking account of all of the above when considering the marks globally, I do not believe that there is a likelihood of consumers being confused into believing that the goods provided by the applicant are those of the opponent or provided by some undertaking linked to them, even allowing for the concept of imperfect recollection. The opposition under Section 5(2)(b) therefore fails.”

10. The Hearing Officer also rejected the ground for opposition under section 5(4)(a) of the TMA. He said:

“21) I have already found that the opponent had reputation and goodwill in its trade marks used as the basis of this opposition but concluded that this was not enough to result in a likelihood of confusion under Section 5(2)(b). It seems to me that the necessary misrepresentation required by the tort of passing off would not occur here, either. The ground for opposition under Section 5(4)(a) therefore fails.”

The appeal

11. On 1 October 2004, the Opponent filed notice of appeal to an Appointed Person under section 76 of the TMA. At the hearing of the appeal, Ms. Kate

Szell of Lloyd Wise represented the Opponent. The Applicant neither appeared nor was represented and made no written submissions.

12. Ms. Szell accepted that the appeal is a review and not a rehearing and that I should be reluctant to interfere with the Hearing Officer's decision in the absence of a material error of principle (*REEF Trade Mark* [2003] RPC 101, Robert Walker L.J. at page 109).
13. The Opponent's arguments on appeal are, shortly stated:

Section 5(2)(b)

- (a) The Hearing Officer did not identify the average consumer of the respective goods/services, that is, the public at large. The public at large does not necessarily have an intimate knowledge of boxing, which is a minority sport as compared to, say, football or cricket. The average consumer of men's underwear is often female. The knowledge of boxing is even lower amongst females than males. The Hearing Officer erred in presuming that the average consumer would view (i) the start of the Applicant's mark as a clear reference to the acronym "knock out" and (ii) the Applicant's mark as a clear reference to pugilism. In assessing likelihood of confusion for section 5(2)(b) of the TMA, the Hearing Officer was not "alert to the danger of allowing his own idiosyncratic knowledge or temperament to influence his decision" (*Neutrogena Corporation v. Golden Limited* [1996] RPC 473, per Morrill L.J. at 494, citing Lord Diplock's judgment in *GE Trade Mark* [1973] RPC 297 at 321).
- (b) The Hearing Officer appears to acknowledge the identity of the goods in question at paragraph 13 of his decision. However, when determining the potential for confusion between the marks at paragraph 18, he speaks of the Applicant's mark as being applied to "similar goods". The Hearing Officer did not factor the identity of the goods into his assessment of likelihood of confusion for section 5(2)(b) and, in particular, did not take into account the principle of interdependency between marks and goods.
- (c) The Hearing Officer did not accord the marks equal treatment when comparing them for conceptual similarity. The Opponent accepts that both marks contain an allusion to a type of underwear known as "boxer shorts". In the case of the Opponent's mark, the Hearing Officer considered that the allusion would be lost on the consumer who would view JOE BOXER as a name (albeit with an allusive character when applied to men's underwear). Contrariwise, when it came to the Applicant's mark, the Hearing Officer considered that the allusion would reinforce the boxing message in the KO BOXER mark.
- (d) Following on from (c), the Hearing Officer failed to recognise that "Joe" is often used in the common language to indicate a hypothetical average person – Mr. Average, Mr. Anyone; Joe Bloggs, Joe Boxer,

Mr. Any Boxer. The “boxer shorts” allusion was, therefore, equally capable of reinforcing the boxing message in the Opponent’s mark.

- (e) The Hearing Officer did not take into account the lack of punctuation (full stops/hyphen) in the Applicant’s mark. The average consumer is used to seeing unfamiliar names, for example, Koo, Britney, Shazney. There is no reason to suppose that the average consumer might not view KO BOXER also as a name.
- (f) The Hearing Officer discounted the recognition of the JOE BOXER marks on the marketplace in his assessment of likelihood of confusion despite the evidence of Ms. Sipperly that underwear especially men’s underwear constituted a significant proportion of the Opponent’s trade in the UK.
- (g) The Hearing Officer considered that the Opponent’s strongest case resided in its UK and Community registrations for the word marks JOE BOXER. The Opponent does not dissent from this in so far as it believes that the word marks JOE BOXER and KO BOXER are visually, aurally and conceptually so similar that when applied to identical goods confusion is likely to result. However, if the Hearing Officer believed, as he did, that a reference to boxing in the Applicant’s mark sufficed to distinguish it from the Opponent’s marks, then he should have considered also the Opponent’s JOE BOXER figurative mark UK 1409857, which contains a representation of a boxer and carries a clear conceptual reference to pugilism.

Section 5(4)(a)

- (h) Inadequate consideration was given to the ground of opposition under section 5(4)(a). At paragraph 21 the Hearing Officer stated that he had “already found that the opponent had reputation and goodwill in its trade marks ... but concluded that this was not enough to result in a likelihood of confusion under Section 5(2)(b)”. In fact, what the Hearing Officer found was that the marks were not entitled to an enhanced reputation for the purposes of assessing likelihood of confusion under section 5(2)(b). That is not the same as finding there is no likelihood of passing off.

14. I believe that there is justification in several of the Opponent’s criticisms. It is well established that the likelihood of confusion for section 5(2)(b) must be assessed in relation to the respective goods and services and through the eyes of the relevant consumer:

“The wording of Article 4(1)(b) of the Directive [section 5(2) TMA] – ‘... there exists a likelihood of confusion on the part of the public ...’ – shows that the perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion.” (*Sabel*, supra., para. 23)

The Opponent is correct that the average consumer of men's underwear is often female. Moreover, the Opponent's marks cover underclothing with no restriction to gender. The average consumer of such everyday items is the public in general. It seems that Hearing Officer's own experience may have led him to define the relevant consumer in rather a narrow way.

15. In *Canon*, supra., the ECJ said (at para. 17):

“A global assessment of the likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between these goods or services. Accordingly, a lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the marks, and vice versa ...” (see also *Lloyd*, supra., para. 19).

KO BOXER is applied for in respect of identical goods to those covered by the JOE BOXER Trade Marks Nos UK 1409857, UK 1519012 and CTM 1491919. Yet there is no indication that the Hearing Officer took into account the principle of interdependency when, in comparing the respective marks, he decided that the differences outweighed any similarities. Indeed, in that part of his decision, the Hearing Officer seemed to be under the impression that similar and not identical goods were involved.

16. I agree with the Opponent's comments regarding the lack of equal treatment in the Hearing Officer's conceptual comparison of the marks. Indeed, the limitations on the Opponent's UK Trade Marks Nos 1409857 and 1519012 (“but not including clothing to be worn for boxing”) suggest that the sporting theme of the JOE BOXER marks was not lost on the Registry during *ex parte* examination. I fail to understand why the allusion to boxer shorts when used in relation to men's underwear should reinforce the sporting theme in KO BOXER but not JOE BOXER. This is, of course, especially true in relation to the JOE BOXER figurative mark UK 1409857.
17. Ms. Szell is correct in her submission that there is no pre-set level of recognition a mark must enjoy in the marketplace before it can receive broader protection under section 5(2)(b) of the TMA (*Lloyd*, supra., para. 24, *STEELCO*, BL 0/268/04, Appointed Person, para.17). Nevertheless, I agree with the Hearing Officer that it is impossible to gauge from the Opponent's evidence the extent of any recognition the JOE BOXER marks enjoy in the market and in respect of what products. Ms. Sipperly gives UK sales figures for the year 2001 – 2002 at around \$1 million for the Opponent's products. As the Hearing Officer observed, the Opponent relies on earlier trade marks, which are registered for products as diverse as colognes and fragrances to rugs and carpets and retail store services. Later in her witness statement, Ms. Sipperly responds to the Applicant's restriction of its specification with the comment that underwear, and particularly men's underwear constitutes a very significant proportion of the Opponent's product range. (Is this, the Opponent's range of clothing, underclothing, or the Opponent's total product range including retail store services?) Ms. Sipperly provides copy material for

a promotion of pants at Debenhams, Oxford Street, London that she says took place in 2000. There was also a party to announce the UK launch under licence of JOE BOXER pants and sleepwear. But she gives no information on what resulted from this promotion and launch. Did Debenhams go on stocking the pants, for example? Ms. Sipperly mentions that during this period (by which she appears to mean 2001 – 2002) there was a company reorganisation and new licensing arrangements were under discussion. What did this mean for the sale of pants and sleepwear in the UK in the meantime? It goes without saying, that a party claiming recognition of its mark on the market must show it.

18. The Opponent's marks are entitled to a presumption of validity, i.e., that they are inherently distinctive (section 72 TMA, Article 95 Council Regulation 40/94/EC). Insofar as the marks are evocative of "boxer shorts" when used in relation to men's underwear, they are not of high distinctive character (Case T-10/03 *Jean Pierre Koubi v. OHIM (CONORFLEX/FLEX)*, 18 February 2004, CFI, para. 56). However, due to the interdependence of factors, that itself does not preclude a finding of likelihood of confusion when globally assessed in any particular case (Case T-99/01 *Mystery drinks GmbH v. OHIM (MYSTERY/MIXERY)* [2003] ECR II-43, CFI, para. 36, Case T-20/02 *Interquell GmbH v. OHIM (HAPPY DOG/HAPPIDOG)*, 31 March 2004, CFI, para. 46).
19. The respective trade marks share at least their second element BOXER in common. In general terms, two marks are similar when, from the point of view of the relevant public, they are at least partially identical as regards one or more relevant aspects (Case T-221/03 *Faber Chimica Srl v. OHIM (FABER/NABER)*, 20 April 2005, CFI, para. 26). The shared BOXER element must at least be an equally dominant element in all the marks in question. Aurally, due to the presence of the letters "O" and "OE" in the first elements and BOXER in the second elements, there is similarity between the marks whether the Applicant's mark is pronounced "CO BOXER" or "K-O BOXER". Conceptually, I believe there is strong similarity between the marks either through the "boxer shorts" allusion, the boxing connotation or as a name depending on the perceptions of the relevant consumer. Those perceptions are likely to remain the same for a particular consumer whether he or she is viewing either the KO BOXER mark or the JOE BOXER marks, and I see no grounds for differentiating between the marks on that basis. The perception of conceptual similarity may be especially strong in the case of the figurative JOE BOXER mark.
20. The Hearing Officer took into account that the purchase of underclothing, in the same way as clothing, is likely to be a visual act (*REACT Trade Mark* [2000] RPC 285, Appointed Person). I do not understand the Opponent to challenge that view. Despite the visual differences in the first elements of the marks, "KO" and "JOE", the Hearing Officer appears not to have considered the possibility of indirect confusion, i.e., that the consumer might believe that KO BOXER products constituted a new or another line in the JOE BOXER range of underwear (*Wagamama Ltd v. City Centre Restaurants PLC* [1995]

FSR 713, Case T-22/04 *Reemark Gesellschaft für Markenkooperation mbH*, 4 May 2005, CFI, para. 42).

21. I believe that if the Hearing Officer had applied the principle of interdependency and properly taken into account the identity of the goods in question, the strong conceptual similarity and, perhaps lesser but still pertinent, aural and visual similarities between the marks, and allowed for imperfect recollection on the part of the relevant consumer, then a finding of likelihood of confusion would have resulted. I have sympathy with Ms. Szell's remark that if the use of KO BOXER and JOE BOXER for identical goods is not likely to lead to confusion within the meaning of section 5(2)(b) then what is.

Conclusion

22. Having decided that the appeal succeeds in relation to section 5(2)(b) of the TMA there is no necessity for me to deal with the appeal against the decision of the Hearing Officer under section 5(4)(a). The Hearing Officer assessed the costs of the successful party in connection with the opposition in the sum of £750. I direct that the Applicant pay the Opponent the sum of £750 in respect of the opposition and a further sum of £750 towards the Opponent's costs of this appeal.

Professor Ruth Annand, 11 May 2005

The Applicant did not appear and was not represented.

Ms. Kate Szell, Lloyd Wise, appeared on behalf of the Opponent.