

O-155-05

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2281486
BY RAJAN IMPORTS LIMITED TO REGISTER THE
TRADE MARK TURBO-CAT IN CLASS 25**

AND

**IN THE MATTER OF OPPOSITION NO 91106
BY REGISTROS INTERNACIONALES APLICADOS S.L.**

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By Rajan Imports Limited to register the trade
Mark TURBO-CAT in Class 25**

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BACKGROUND

1. On 26 September 2001 Rajan Imports Limited (hereafter Rajan) applied to register the mark TURBO-CAT for “clothing, footwear, headgear” in Class 25 of the International Classification System.
2. On 18 September 2002 Registros Internacionales Aplicados, S.L. (hereafter RIA) filed notice of opposition to this application. RIA is the proprietor of Community Trade Mark Registration No 222661 for the mark TURBO in respect of “clothing”.
3. RIA claims that Rajan’s mark incorporates the whole of its own mark and covers identical goods and that this application should be refused under Section 5(1). In the alternative, it is submitted that, in the case of footwear and headgear the goods are similar and refusal should be on the basis of Section 5(2)(a).
4. In the further alternative, it is submitted the marks are similar and the goods either identical (in the case of clothing) or similar (in the case of footwear and headgear) such that the application should be refused under Section 5(2)(b).
5. Rajan filed a counterstatement denying that the marks are identical or similar but conceding that the goods are identical and/or similar. The grounds of opposition are denied.
6. Both sides ask for an award of costs in their favour. The only evidence filed in this case consists of a witness statement from the opponent’s professional representative exhibiting details of CTM No 222661 relied on in the opposition. Neither side has requested a hearing. Written submissions have been received from Wilson Gunn on behalf of the applicant (under cover of a letter dated 3 June 2005) and from Boulton Wade Tennant on behalf of the opponent (by letter dated 31 May 2005).

THE LAW

7. The relevant parts of the statute read:-

“5.-(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if because -

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

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

DECISION

8. For Section 5(1) or 5(2)(a) to come into play it requires the respective trade marks to be identical. I have been referred to *Decon Laboratories Ltd v Fred Baker Scientific Ltd*, [2001] RPC 17 in support of the view that the marks in issue here are identical. However, that case can be distinguished as the suffixes of the marks were held to be descriptive of the nature and quality of the goods. It is not suggested that the same can be said of the element CAT. In any case there is now guidance from the ECJ in *LTJ Diffusion SA and Sadas Vertbaudet SA*, Case C-291/00, [2003] ETMR 83 as follows:

“50. The criterion of identity of the sign and the trade mark must be interpreted strictly. The very definition of identity implies that the two elements compared should be the same in all respects. Indeed, the absolute protection in the case of a sign which is identical with the trade mark in relation to goods or services which are identical with those for which the trade mark is registered, which is guaranteed by Art. 5(1)(a) of the directive, cannot be extended beyond the situations for which it was envisaged, in particular, to those situations which are more specifically protected by Art. 5(1)(b) of the directive.

51. There is therefore identity between the sign and the trade mark where the former reproduces, without any modification or addition, all the elements constituting the latter.

52. However, the perception of identity between the sign and the trade mark must be assessed globally with respect to an average consumer who is deemed

to be reasonably well informed, reasonably observant and circumspect. The sign produces an overall impression on such a consumer. That consumer only rarely has the chance to make a direct comparison between signs and trade marks and must place his trust in the imperfect picture of them that he has kept in his mind. Moreover, his level of attention is likely to vary according to the category of goods or services in question (see, to that effect, Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, para. 26).

53. Since the perception of identity between the sign and the trade mark is not the result of a direct comparison of all the characteristics of the elements compared, insignificant differences between the sign and the trade mark may go unnoticed by an average consumer.

54. In those circumstances, the answer to the question referred must be that Art. 5(1)(a) of the directive must be interpreted as meaning that a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

9. It is not enough, therefore, that the applied for mark reproduces the whole of the earlier trade mark unless it does so in a way that any remaining differences between the marks are so insignificant that they may go unnoticed by the average consumer. CAT is neither a visually negligible element in the mark applied for nor is it suggested it should be accorded less weight because it is descriptive in nature. I can see no basis, therefore, for reaching the view that the element –CAT is so insignificant that it will go unnoticed. It follows that the grounds under Section 5(1) and 5(2)(a) must fail. Strictly, I note that the opponent’s written submissions make no reference to the section 5(1) ground but the point becomes academic in the light of this finding.

10. The matter, therefore, falls to be decided under Section 5(2)(b). In approaching this ground I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723.

11. It is clear that the outcome of this case turns critically on my view of the marks themselves. But, I should first of all comment briefly on the goods and the average consumer for those goods. It is conceded that identical goods are involved at least to the extent that the respective specifications cover clothing. There may be scope for argument as to whether footwear and headgear are encompassed within the general term clothing. As the opponent’s written submissions suggest it is difficult to draw a dividing line between clothing and headgear/footwear. They share many of the characteristics set out in the well known *Canon* test. Equally, it is possible to think of examples of items that would fall within the broad terms that would not be similar - a wedding dress, a bowler hat and gumboots for instance. But it must be borne in mind that, where broad terms are involved, full effect must be given to the notional scope of the specification involved. To take a couple of other examples - a scarf can be worn around the head, neck or shoulders (and may, therefore, be termed clothing or

headgear) and footwear will include not just shoes but socks etc (the latter can quite naturally be referred to as an item of clothing). It is not, therefore, essential to decide whether the broad term clothing includes footwear and headgear because there will be items that are capable of being described and/or used in more than one way. Accordingly, I find the goods to be either identical and/or closely similar.

12. The average consumer for clothing, footwear and headgear is the public at large. Most people can be expected to employ a modicum of care in the selection and purchase of clothing items and it has been said (see *REACT Trade Mark* [2000] RPC 285) that the purchasing process is primarily a visual one though oral recommendations/ordering cannot be ruled out.

13. Turning to the marks, the visual, aural and conceptual similarities must be assessed by reference to their overall impressions bearing in mind their distinctive and dominant components (*Sabel v Puma*, paragraph 23). Consumers are generally not credited with pausing to analyse marks (*Sabel v Puma*, paragraph 23). Allowance must also be made for the effects of sequential rather than concurrent acquaintance with the marks and hence imperfect recollection (*Lloyd Schuhfabrik*, paragraph 27).

14. The marks in issue are TURBO and TURBO-CAT. Self-evidentially the applied for mark reproduces the whole of the earlier trade mark and does so in a way (the effect of the hyphen) that leads to that element being picked out.

15. The only meaning of TURBO that I am aware of is as a combining form relating to turbines. It has no significance to the best of my knowledge in relation to clothing and must be considered to have a reasonably high degree of distinctive character in relation to such goods. As there is no evidence before me as to the use of RIA's mark the issue of whether that distinctive character has been further enhanced does not arise.

16. Rajan's mark is not just the word TURBO but that element in combination with the word CAT. A hyphen links the two elements of the mark. The fact that the mark is composed of two elements will be apparent on visual appraisal less so, if at all, in oral usage. The applicant's written submissions suggest that ".....the term TURBO-CAT has no obvious meaning. CAT is clearly a feline reference and the context that can be attached to the mark is a fanciful one of a fast feline, or cat. Since no such animal exists.....it is clearly apparent that [it] has no immediate meaning. The term TURBO conversely immediately conveys the image of an engine, or piece of machinery." The opponent adopts the contrary position and suggests that the additional matter in the subject application does not add enough to the mark to create a totally different overall impression.

17. Where marks employ a common element competing considerations are likely to come into play in determining the proper outcome. In *10 Royal Berkshire Polo Club Trade Mark*, [2001] RPC 32, Mr Hobbs QC, sitting as the Appointed Person, said:

"31..... I am satisfied that the use of the word POLO as part of the applicant's mark does not capture the distinctiveness of the opponent's earlier trade marks [POLO]. I do not think that people exposed to the use of the applicant's mark would notice that it contained the word POLO without also

noticing that it contained the words ROYAL BERKSHIRE and CLUB. The message of the mark comes from the words in combination and that is not something that I would expect people to overlook or ignore in the ordinary way of things.”

18. The weight of other matter and the context in which the common element occurred was sufficient in that case for the Appointed Person to hold that consumers’ attention would not focus on the element POLO to the point where the marks would be regarded as sharing a distinctive character.

19. In *Cardinal Place* Trade Mark, BL O/339/04, Mr Hobbs QC had before him the mark CARDINAL (and small device) and CARDINAL PLACE. He held that:

“15. The perceptions and recollections triggered by the earlier mark are likely to have been ecclesiastical whereas the perceptions and recollections triggered by the Applicant’s mark are likely to have been locational as a result of the qualifying effect of the word **PLACE** upon the word **CARDINAL**. A qualifying effect of that kind can be quite powerful as indicated by the examples cited in argument on behalf of the Applicant: **SOMERSET** as compared with **SOMERSET HOUSE**; **COUNTY** as compared with **COUNTRY HALL**; **CANARY** as compared with **CANARY WHARF**.”

20. He posed the following question:

“17. So why should it be thought that the visual, aural and conceptual differences are sufficiently significant to render the marks distinguishable, but not sufficiently significant to enable them to be used concurrently without giving rise to a likelihood of confusion? This, to my mind, is the critical question. The answer to it depends upon how much or how little the word **PLACE** would be likely to contribute to the distinctive character of the mark **CARDINAL PLACE** taken as a whole.”

21. His conclusion was that the overall effect and impact of the combination CARDINAL PLACE was sufficiently different to the word CARDINAL on its own that the two marks could be used concurrently without giving rise to a likelihood of confusion.

22. In Case T-22/04 the Court of First Instance (CFI) annulled the decision of OHIM’s Second Board of Appeal in a case involving the marks WESTLIFE and WEST. In its judgment the Court said:

“It must also be borne in mind that the Court of First Instance has already held that, on an initial analysis, where one of the two words which alone constitute a word mark is identical, both visually and aurally, to the single word which constitutes an earlier word mark, and where those words, taken together or in isolation, have no conceptual meaning for the public concerned, the marks at issue, each considered as a whole, are normally to be regarded as similar (Case T-286/02 *Oriental Kitchen v OHIM – Mou Dybfrost (KIAP MOU)* [2003] ECR II-0000, paragraph 39).

In this instance one of the two words which alone constitute the word mark applied for is actually identical in appearance to the sole word forming the earlier word mark. Aurally there is a degree of similarity, although the pronunciation of the word 'west' is not identical, at least as regards the whole of the relevant public. In this instance, the two words forming the Westlife mark mean something to the relevant public but they do not describe either the goods or services in question or their qualities and therefore do not have any particular connotation in relation to them.

Although the approach described at paragraph 37 above is not therefore directly applicable in this case, it must nonetheless be stated that the only visual difference between the two word marks at issue is that one of them contains a further element added to the first. Moreover, as stated above, there is a degree of similarity between the two marks in aural terms and, in particular, in conceptual terms.

It must therefore be held, in this case, that the fact that the Westlife trade mark consists exclusively of the earlier West trade marks to which another word, 'life' has been added, is an indication that the two trade marks are similar."

23. The CFI went on to find that the relevant public might consider the applied for mark to be a variant of the earlier mark or at least that there was an economic link between the companies or undertakings marketing goods or services under the marks.

24. It is apparent from these contrasting outcomes that questions of this kind are not susceptible to any single or mechanistically applied solution. Regard must be had to the overall content (similarities and dissimilarities) and structure of the marks, the ideas conjured up by the marks and their likely impact on consumers including the nature of any association that the marks might give rise to in the minds of consumers.

25. TURBO is the first and a prominent element in Rajan's mark but consumers are unlikely to fail to notice the -CAT element. As CAT has no obvious descriptive significance in relation to clothing, consumers can be expected to give due weight to that element as part of their mental picture of the mark and in oral references to it.

26. But the mark carries no clear meaning that would help to differentiate it from RIA's TURBO mark as might have been the case if the applied for mark was a known term such as turboprop or turbocharger say. The applicant has suggested that TURBO-CAT creates the fanciful idea of a fast feline. I do not rule out the possibility that some people will approach the mark in this way but I regard it as an uncertain outcome. It is more likely in my view that the combination will convey no particular meaning and will simply be seen as the bringing together of two elements with TURBO as a visually prominent and distinct element. The presence of the hyphen seems to me to reinforce the notion that the mark is made up of independent elements that have been brought together but which do not particularly 'hang together' in the sense of creating a new idea that overrides the meaning of the component words.

27. That suggests to me that, whilst consumers may not directly confuse one mark for the other, they would have good cause for thinking that goods sold under the mark TURBO-CAT represented either an extension of trade by the proprietor of the mark

TURBO or that TURBO-CAT was a product line from an economically-linked undertaking. The opponent's written submissions put it this way "consumers are simply likely to see this mark ...and assume that this was a new version of the opponent's trade mark, or related product to the opponent's TURBO product, thereby assuming some form of connection between the trade marks, and in particular a connection that indicates a common source of origin of product." I believe the prospect of that happening is sufficiently concrete for me to hold that there is a likelihood of confusion having regard to the following guidance from the *Canon* case dealing with association between marks:

"... Accordingly, the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 4(1)(b) of the Directive (see *SABEL*, paragraph 16 to 18)."

28. There is one final matter I should mention. Rajan's written submissions indicate that No. 222661 was raised as a citation against its application at the examination stage but subsequently waived by the examiner in response to submissions from Rajan's attorney. It is suggested that as no new evidence has been brought to bear in this opposition there is nothing that should persuade me to come to a different view to the examiner. If that was correct a potential opponent would effectively be estopped from having his position tested in opposition proceedings. That cannot be the case. I must, therefore, reach my own view of the matter for the purpose of the current proceedings.

29. The opposition, therefore, succeeds under Section 5(2)(b).

30. The opponent is entitled to a contribution towards its costs. I order the applicant to pay the opponent the sum of **£900**. 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 the case if any appeal against the decision is unsuccessful.

Dated this 10th day of June 2005

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