

O/165/12

**TRADE MARKS ACT 1994
SUPPLEMENTARY DECISION**

**IN THE MATTER OF APPLICATION NO 2471691
BY
IMRAN SARDAR
TO REGISTER THE TRADE MARK**

BAD BYZ

IN CLASS 25

**AND
AND IN THE MATTER OF OPPOSITION THERETO
UNDER NO 96602
BY
PLATYPUS WEAR INC.**

Trade Marks Act 1994
IN THE MATTER OF application 2471691
By Imran Sardar
To register the trade mark
BAD BYZ
In Class 25
AND IN THE MATTER OF opposition thereto
Under no. 96602
By Platypus Wear Inc.

1. On 10 August 2011 I issued a provisional decision in relation to this opposition. The decision was provisional as the final outcome depended upon the registration of a trade mark application. This application has now been registered (in the name of Platypus Wear, Inc) under number 2572396 for the following mark:

BAD BOY

2. In the original decision I stated the following:

“47. Taking all the above factors into account, and considering the marks as a whole, I conclude that the similarities between the marks are such that if used on goods which are identical, there is a likelihood that consumers will be confused into believing that the respective goods are provided by the same or linked undertaking. Taking account that marks are rarely recalled perfectly, the average consumer is likely to assume that the respective marks are the same. Even if I am wrong in this and the average consumer makes a distinction between the marks this does not necessarily negate a finding of there being a likelihood of confusion. In *Jose Alejandro SL v OHIM (Budman)*¹¹ the GC said:

“It must be observed that it is common in the clothing sector for the same mark to be configured in various different ways according to the type of product which it designates. It is also common for a single clothing manufacturer to use sub-brands (signs that derive from a principal mark and which share with it a common dominant element) in order to distinguish his various lines from one another (women’s, men’s, youth). In such circumstances it is conceivable that the relevant public may regard the clothing designated by the conflicting marks as belonging, admittedly, to two distinct ranges or products but as coming, none the less, from the same undertaking.”

48. As such, I find that even where the consumer may notice the visual differences between the marks; it is very likely that they will still assume that the goods provided in respect of the two marks will have originated from the same or linked undertaking.

49. Accordingly, I find that there is a likelihood of confusion and the opposition would succeed in respect of all the goods applied for.

50. However, as noted in paragraph 5 above, Platypus’s earlier mark was converted from a CTM and is currently pending registration; it does not

therefore qualify as an earlier mark within the provisions of s.6 of the Act. However, if it proceeds to registration it will provide the necessary earlier right in these proceedings. As a consequence, this decision is a provisional one and I will issue a further supplementary decision when the outcome of the earlier mark's registration procedure is finally determined. I will consider the issue of an award of costs at that time and also set the date from which any appeal period will run."

3. The application is made in respect of the following goods in class 25:

'Clothing; head gear; footwear'

4. Platypus's mark is registered in respect of the following class 25 goods:

'Articles of clothing; footwear; headgear.'

5. I have no hesitation in concluding that these are identical goods to those in Mr Sardar's application.

6. It follows that the provisional finding that there is a likelihood of confusion is confirmed and I will move on to consider the matter of costs.

Costs

7. The opposition having succeeded, Platypus is entitled to a contribution towards its costs. I have taken into account that no hearing has taken place, but that Platypus filed written submissions in lieu. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, I award costs to Platypus on the following basis:

Preparing a statement and considering the other side's statement:	£200
Official fee:	£200
Preparing evidence and considering the other side's evidence:	£500
Written submissions:	£300
Total:	£1200

56. I order Imran Sardar to pay to Platypus Wear, Inc. the sum of £1200. 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 18th day of April 2012

**Ms. Al Skilton
For the Registrar**