

**BL O-178-20**

**TRADE MARKS ACT 1994**

**TRADE MARK REGISTRATION NO. 3193372 IN THE NAME OF AA TEXTILES  
LTD AND A REQUEST FOR INVALIDITY THERETO UNDER NO. 502490 BY  
CALVIN KLEIN TRADEMARK TRUST**

## BACKGROUND & PLEADINGS

1. On 26 October 2016, AA Textiles Ltd (“the proprietor”) applied to register the words **KLEIN BOXER** as a trade mark for the goods in class 25 shown in Annex 2 of this decision. The application was published for opposition on 11 November 2016 and entered in the register on 20 January 2017.

2. On 4 March 2019, Calvin Klein Trademark Trust (“the applicant”) applied to declare invalid the registration in full. Although the application was originally based upon sections 5(2)(b) and 5(4)(a) of the Act, as the applicant elected not to file any evidence, the proceedings continued on the basis of section 5(2)(b) of the Act only, with the applicant relying upon the European Union Trade Mark (“EUTM”) registrations/goods shown in Annex 1 of this decision. The applicant states:

“...that the later trade mark KLEIN BOXER is highly similar to the earlier trade marks [CK Calvin Klein/Calvin Klein] and the goods covered by the marks are identical and highly similar. As a result, there is a risk of confusion on the part of the public between the later trade mark and the Applicant's earlier trade mark, which includes a likelihood of association between the marks...”

3. The proprietor filed a counterstatement. It states:

“I , Mr Nasir Rahim owner of AA Textiles Ltd...would like to clarify that the later trade mark Klein Boxer is not similar to the earlier trade mark CK Calvin Klein and the goods covered by the both marks are not identical and similar.

1) It is cleared that there is no risk of confusion whatsoever to the public in relation to the earlier trade mark.

2) I would like to mention that there are other trademarks with the same name as Klein being sold on the main high street stores like B&M Stores with the name as - Pierre Klein/Mark Klein and also Calvin Classics which are being used for selling boxer-shorts .

3) I request you to please look into this matter as this is having a big impact on the sales of our company, and we are losing business as a result of this cancellation being filed against our brand, as many of our customers have been approached by Ebay to remove the listings as they have been advised by CK Calvin Klein that these goods are in violation with their trade mark and they are counterfeit goods which is not true.

4) Due to above reasons I submit that earlier trade mark CK Calvin Klein is not similar with later trade mark Klein Boxer.”

4. In these proceedings, the applicant is represented by Forresters IP LLP; from 2 December 2019, the proprietor has been represented by Wilson Gunn. Although neither party filed evidence or requested to be heard, both elected to file written submissions in lieu of attendance at a hearing. I shall keep all of these written submissions in mind, referring to them to the extent I consider it necessary.

## **DECISION**

5. The relevant legislation insofar as these proceedings are concerned, is as follows:

“47(1)...

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

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

(b)...

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2ZA)...

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B)...

(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are-

(a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

(c)...

(3) An application for a declaration of invalidity may be made by any person, and may be made either to the registrar or to the court, except that-

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court;  
and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(4)...

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed."

Section 5(2)(b) of the Act reads as follows:

"5(2) A trade mark shall not be registered if because –

(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.

5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

6. The trade marks relied upon by the applicant qualify as earlier trade marks under the provisions of section 6 of the Act. As all of the trade marks relied upon had been registered for more than five years at both the date the application for invalidation was filed and the date the proprietor’s trade mark was filed, they are, in principle, subject to the proof of use provisions. In its counterstatement, the proprietor ticked the appropriate box to ask the applicant to provide proof of use. In an official letter dated 21 May 2019, the Casework Examiner (“CWE”) stated:

**“PROOF OF USE**

At question 7 of the Form TM8, you have requested the opponent provide ‘proof of use’ when filing evidence in these proceedings. However, in the box provided, you have not supplied the details of the trade mark(s) for which you require ‘proof of use’ evidence be filed.

In light of the preliminary view expressed above, you are invited to file an amended Form TM8, on or before **11 June 2019**. If you choose not to amend the form, the Registrar may move to strike out any grounds which are not adequately particularised.”

7. In a further official letter dated 12 September 2019, the CWE stated:

“The letter advised re was an issue with your claim for proof of use...A deadline of 11 June 2019 was given for those matters to be addressed, I apologise for the delay in issuing this correspondence.

I can confirm there has been no response to the Registry's letter, therefore, the opposition will now proceed with those pages of evidence removed from the Form TM8 and the opponent is not required to provide 'proof of use' when filing its evidence."

8. In those circumstances, the applicant is entitled to rely upon all the goods it has identified in its trade marks without having to establish that genuine use has been made of them.

### **Case law**

9. The following principles are gleaned from the decisions of the courts of the European Union in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles:

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

(f) however, it is also 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 creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

## **My approach to the comparison**

10. In point 2 of its counterstatement (filed before it was professionally represented), the proprietor commented upon a number of trade marks being used by others. In the official letter dated 21 May 2019, the CWE stated:

“You have also filed an ‘owner statement’ of Nasir Rahim along with pictures of goods from various marks.

Please note, the statement filed will be taken into consideration by the Registry, however, the pictures supplied will not be considered as they are classed as evidence and will need to be filed in the appropriate format, i.e. supported by a Witness Statement.

**Please note, there will be an opportunity for you to file evidence at a later stage of the proceedings.”**

11. The proprietor elected not to file any evidence in this regard. What I must now do, is compare the competing specifications and trade marks on the basis of notional and fair use. In its written submissions, the applicant stated:

“12. We take the opportunity to advise that the best earlier trade marks relied upon are [the three trade marks consisting of the words Calvin Klein]...”

That is the basis on which I shall conduct the comparison.

## **Comparison of goods**

12. The competing goods are shown in Annex 2 to this decision. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the Court stated at paragraph 23:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all

the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

13. In its written submission, the proprietor admits:

“3...that the class 25 goods of its registration are identical or at least similar to the class 25 goods of the applicant’s registrations.”

14. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court (“GC”) stated:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

15. The class 25 specification of the applicant’s trade mark no. (6) includes the following terms: “women’s men’s, boy’s and girl’s wearing apparel”, “socks”, “hats/caps”, “shoes, boots, slippers” and “active sportswear”. Where they are not literally identical, the competing goods are, in my view, to be regarded as such on the principles outlined in *Meric*. However, even if I am wrong in that regard, given the obvious overlap in the nature, users, intended purpose, method of use and trade channels, if not identical, the competing goods are similar to the highest degree.

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

16. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods at issue. I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem*

*Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

17. In its submissions, the applicant states:

“8. The average consumer for the goods at issue is a member of the general public. The goods are likely to be self-selection from retail premises and any on-line equivalents, where visual considerations will dominate. However, it is not possible to rule out any oral aspect of the selection. The average consumer may pay attention to factors. such as price and quality.

However, these goods are likely to be relatively inexpensive and bought frequently. On that basis these factors suggest that the average consumer will pay a medium degree of attention in purchasing process of the goods at issue.”

18. I agree with the above as, it appears, does the proprietor who describes the level of attention likely to be paid by the average consumer as “standard” (paragraph 7 of its submissions refer).

### **Comparison of trade marks**

19. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the

overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

20. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create. The trade marks to be compared are as follows:

The applicant’s trade mark identified by it as it’s best case	The proprietor’s trade mark
Calvin Klein	KLEIN BOXER

21. The applicant’s trade mark consists of the words “Calvin” and “Klein” presented in title case in a slightly stylised but unremarkable script. The words create a unit which will be understood as the name of a person. It is in that unit the overall impression and distinctiveness lies. In my experience which, I am satisfied is likely to be much the same as the average consumer, in the United Kingdom, both the forename “Calvin” and surname “Klein” are relatively unusual.

22. The proprietor’s trade mark consists of the word “KLEIN” presented in upper case together with the word “BOXER” also presented in upper case. Despite the proprietor’s initial written submissions to the contrary, the word “BOXER” appears in both parties’ specifications in class 25 and is, self-evidently, wholly descriptive in

relation to boxer shorts. However, even in relation to goods which are not boxer shorts, in relation to some of the proprietor's goods it is likely to be construed as a reference to items of clothing suitable for those involved in the sport of boxing. That, however, may not to be the case in relation to, for example, "clothing for cyclists".

23. While the word "BOXER" may not be directly descriptive in relation to goods such as those mentioned above, as the word "BOXER" has the meanings mentioned earlier and as the word "KLEIN" appears as the first component in the proprietor's trade mark, it will, in my view, have by far the highest relative weight in both the overall impression it conveys and its distinctiveness. That conclusion is, of course, even stronger where the word "BOXER" would be regarded by the average consumer as directly descriptive. I will bear the above conclusions in mind when conducting my assessment of the degree of visual, aural and conceptual similarity between the competing trade marks.

### **Visual similarity**

24. The competing trade marks contain the word "Klein"/"KLEIN". It is the first word in the proprietor's trade mark and the second word in the applicant's. As I mentioned above, the degree of stylisation present in the applicant's trade mark is so slight as to not be a factor that assists the proprietor. The trade marks differ to the extent that the applicant has "Calvin" as its first word and the proprietor has "BOXER" as its second word. If the average consumer construes the word "BOXER" as totally descriptive, I would pitch the degree of visual similarity as being of a medium level and if it considers the word to have some distinctive credentials, at a level between low and medium.

### **Aural similarity**

25. As all of the words in the competing trade marks are likely to be known to the average consumer the manner in which they will be pronounced is fairly predictable. However, if the average consumer considers the word "BOXER" to be descriptive, it is, in my view, highly likely that word will not be articulated at all. In those circumstances, there will be a medium degree of aural similarity between the trade

marks at issue, and, for the same reasons mentioned in relation to visual similarity, a between low and medium degree if the word “BOXER” is articulated.

### **Conceptual similarity**

26. As I mentioned above, the words “Calvin Klein” will be understood as the name of a person, in which the word “Klein” will be surnominal in nature. The word “KLEIN” in the proprietor’s trade mark will also be regarded as surnominal. Insofar as the word “BOXER” is concerned, when considered in relation to many of the goods at issue, it is most likely to be conceptualised by the average consumer as a descriptive reference to boxer shorts or to the sport of boxing. However, as both trade marks evoke the relatively usual surname “Klein”, they are conceptually similar to an above medium degree.

### **Distinctive character of the earlier trade mark**

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

28. As the applicant has filed no evidence of any use it may have made of its earlier trade mark I have only its inherent characteristics to consider. As I mentioned above, the words “Calvin” and “Klein” are, in my experience, fairly unusual. Considered absent use, the personal name “Calvin Klein” is possessed of at least a medium degree of inherent distinctive character.

## **Likelihood of confusion**

29. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the applicant's trade 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 upon the imperfect picture of them he has retained in his mind.

30. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.

31. Earlier in this decision I concluded that:

- If not identical, the competing goods are similar to the highest degree;
- The average consumer of the goods at issue is a member of the general public who, whilst not forgetting aural considerations, will select such goods by predominantly visual means while displaying a medium degree of attention during that process;
- The competing trade marks are visually and aurally similar to at least a low to medium degree and for many goods similar to a medium degree and conceptually similar to an above medium degree;
- The applicant's earlier trade mark is possessed of at least a medium degree of inherent distinctive character.

32. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU's judgment in *Bimbo*, Case C-591/12P, on the court's earlier judgment in *Medion v Thomson*. He stated:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of

confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

33. In *Harman International Industries, Inc v OHIM*, Case C-51/09P, the CJEU found that:

“Although it is possible that, in a part of the European Union, surnames have, as a general rule, a more distinctive character than forenames, it is appropriate, however, to take account of factors specific to the case and, in particular, the fact that the surname concerned is unusual or, on the contrary, very common, which is likely to have an effect on that distinctive character. That is true of the surname ‘Becker’ which the Board of Appeal noted is common”.

34. In *El Corte Inglés, SA v OHIM*, Case T-39/10, the GC found that:

“54. As the applicant asserted in its pleadings, according to the case-law, the Italian consumer will generally attribute greater distinctiveness to the surname than to the forename in the marks at issue (Case T-185/03 *Fusco v OHIM – Fusco International (ENZO FUSCO)* [2005] ECR II-715, paragraph 54). The General Court applied a similar conclusion concerning Spanish consumers, having established that the first name that appeared in the mark in question was relatively common and, therefore, not very distinctive (Case T-40/03 *Murúa Entrena v OHIM – Bodegas Murúa (Julián Murúa Entrena)* [2005] ECR II-2831, paragraphs 66 to 68).

55. Nevertheless, it is also clear from the case-law that that rule, drawn from experience, cannot be applied automatically without taking account of the specific features of each case (judgment of 12 July 2006 in Case T-97/05 *Rossi v OHIM – Marcorossi (MARCOROSSI)*, not published in the ECR, paragraph 45). In that regard, the Court of Justice has held that account had to be taken, in particular, of the fact that the surname concerned was unusual or, on the contrary, very common, which is likely to have an effect on its distinctive character. Account also had to be taken of whether the person who

requests that his first name and surname, taken together, be registered as a trade mark is well known (Case C-51/09 P Becker v Harman International Industries [2010] ECR I-5805, paragraphs 36 and 37). Likewise, according to the case-law cited in the previous paragraph, the distinctive character of the first name is a fact that should play a role in the implementation of that rule based on experience.”

35. While I am conscious of the comments of Arnold J (as he then was) in paragraph 20 of the decision mentioned above, as I explained earlier, both “Calvin” and “Klein” are relatively unusual. In *esure Insurance Ltd v Direct Line Insurance Plc*, [2008] EWCA Civ 842, L.J. Arden stated that:

“56. In my judgment, Mr Hobbs is correct on this point. What the hearing officer had to determine was what the average consumer would have thought of the two marks and whether they would have confused him. The services sold by the parties were identical and were of a kind familiar to members of the public. In those circumstances, I see no reason why the hearing officer should not have decided the issue of similarity on his own in the absence of evidence apart from the marks themselves and evidence as to the goods or services to which they were, or, in the case of esure's mark, were to be applied...”

36. I am also aware as will be the average consumer, of the propensity of undertakings in the clothing field to use both full names and the surname which forms part of the full name as indicators of origin. In reaching a conclusion, I bear the above in mind, together with the fact that the competing goods are, if not identical, similar to the highest degree, the degree of visual aural and conceptual similarity between the competing trade marks and the at least medium degree of inherent distinctive character the earlier trade mark enjoys.

37. Notwithstanding the fact that the word “KLEIN” appears first in the proprietor’s trade mark, even in relation to those goods for which the word “BOXER” is descriptive (and which will as a consequence have very little weight in, inter alia, the overall impression conveyed), the likelihood of direct confusion seems unlikely. If the

word “BOXER” operates as a distinctive component for some of the goods at issue, the likelihood of direct confusion is even more remote.

38. That leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

39. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two trade marks share a common element. In this connection, he pointed out that it is not sufficient that a trade mark merely calls to mind another trade mark. This is mere association not indirect confusion.

40. Even if the average consumer construes the word “BOXER” as distinctive, the unusual nature of, in particular, the surname “Klein” in the applicant’s trade mark is, given the (at least) highly similar nature of the goods at issue and the nature of the trade in clothing, likely to lead the average consumer to assume the proprietor’s goods are those of the applicant or an undertaking linked to the applicant. That will lead to indirect confusion.

## Overall conclusion

**41. Subject to any successful appeal, the proprietor's trade mark registration will be declared invalid and deemed never to have been made.**

## Costs

42. Awards of costs in proceedings are governed by Annex A of Tribunal Practice Notice ("TPN") 2 of 2016. As the applicant has been successful, it is entitled to a contribution towards the costs it has incurred. Keeping the guidance in that TPN in mind, I award costs to the applicant on the following basis:

Preparing the Application for invalidation, and reviewing the counterstatement:	£300
Written submissions:	£300
Official fee (invalidation):	£200
<b>Total:</b>	<b>£800</b>

43. I order AA textiles Ltd to pay to Calvin Klein Trademark Trust the sum of **£800**. This sum is to be paid within twenty one days of the expiry of the appeal period or within twenty one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 19<sup>th</sup> day of March 2020**

**C J BOWEN**  
**For the Registrar**

## Annex 1

**(1) No. 6192207 for the trade mark/goods shown below which was applied for on 21 August 1997 and entered in the register on 29 January 1999:**



**Class 25** - Women's and girl's underwear, intimate apparel and sleepwear, loungewear, bodywear, foundations, bras, girdles, garter belts, all in ones, corselettes, body stockings, control briefs, control hipsters, bra slips, bra top camisoles, waist cinchers, bustiers, leotards and unitards, daywear - including but not limited to culottes, bikinis, hipsters, briefs, slips, blouse slips, camisole slips, chemise slips, culotte slips, evening slips, maternity slips, panty slips, princess slips, shadow panel slips, strapless slips, suit slips, tailored slips, half slips, petti-slips, bra slips, chemises, teddies, camisoles, bra top camisoles, bralettes, tap pants and petti-pants, daywear, loungewear, sleepwear and bodywear - including but not limited to nightgowns, toga nightgowns, night shirts, pyjamas, shortie pyjamas, baby-doll pyjamas, T-shirt pyjamas, french maid sleepers, harem pyjamas, hostess culottes, lounging pyjamas, rompers, sleep shorts, peignoirs, bed jackets, caftans, jumpsuits, teddies, bath robes, dressing gowns, kimonos, housecoats, beach togas, beach wrap-ups, breakfast coats, brunch coats, hostess robes, kabuki robes, lounging robes, monk's robes, bra tops, crop tops and leggings.

**(2) No. 617415 for the same trade mark shown above and the goods shown below which was applied for on 21 August 1997 and entered in the register on 29 January 1999:**

**Class 9** - Optical goods, eyeglass frames, sunglasses, eyeglass cases.

**Class 25** - Women's, men's, boy's and girl's wearing apparel, jump suits, shirts, blouses, jackets, bathing suits, pants, shorts, warm-up suits, capes, walking shorts, jeans, suits, dinner jackets, raincoats, ties, socks, stockings/tights, hats/caps, outer coats, sweaters, skirts, coats, fur-trimmed coats, furs, vests, T-shirt, tennis and golf dresses, shorts, beach and swimming cover-ups, rainwear/raincoats, ponchos, tank tops, shoes, boots, slippers, blazers, pants, shirts, belts, gloves, dresses, shearling coats and jackets, scarves/shawls, sports jackets; handkerchiefs.

**(3) No. 6172217 for the same trade mark shown above and the goods shown below which was applied for on 21 August 1997 and entered in the register on 29 January 1999:**

**Class 25** - Men's and boy's underwear, underwear, sleepwear, loungewear including but not limited to briefs, boxers, athlete underwear, sport knits, T-shirts, tank tops, undershirts, basic underwear and robes, knitted and woven sleepwear, sleep shirts, pyjama tops, pyjama bottoms, breakfast jackets, smoking jackets, bed jackets, cover-ups, knitted and woven loungewear, lounging pants and tops, lounge jackets.

**(4) No. 6710107 for the trade mark/goods shown below which was applied for on 21 August 1997 and entered in the register on 29 January 1999:**

Calvin Klein

**Class 25** - Women's and girl's underwear, intimate apparel and sleepwear, loungewear, bodywear, foundations, bras, girdles, garter belts, all in ones, corselettes, body stockings, control briefs, control hipsters, contarter bikinis, bra slips, bra top camisoles, waist cinchers, bustiers, merry widows, camisettes, leotards and unitards, daywear - including but not limited to culottes, bikinis, hipsters, briefs, slips, blouse slips, camisole slips, chemise slips, culotte slips, evening slips, maternity slips, panty slips, princess slips, shadow panel slips, strapless slips, suit slips, tailored slips, half slips, petti-slips, bra slips, chemises, teddies, camisoles, bra top camisoles, braletts, tap pants and petti-pants, daywear, loungewear, sleepwear and bodywear - including but not limited to nightgowns, toga nightgowns, night shirts, pyjamas, shortie pyjamas, baby-doll pyjamas, T-shirt pyjamas, french maid sleepers, harem pyjamas, hostess culottes, lounging pyjamas, rompers, sleep shorts, peignoirs, bed jackets, caftans, jumpsuits, teddies, bath robes, dressing gowns, kimonos, housecoats, beach togas, beach wrap-ups, breakfast coats, brunch coats, hostess robes, kabuki robes, lounging robes, monk's robes, bra tops, crop tops and leggings.

**(5) No. 6710081 for the same trade mark shown above/goods shown below which was applied for on 21 August 1997 and entered in the register on 29 January 1999:**

**Class 25** - Men's and boy's underwear, underwear, sleepwear, loungewear including but not limited to briefs, boxers, athlete underwear, sport knits, T-shirts, tank tops, undershirts, basic underwear and robes, knitted and woven sleepwear, sleep shirts, pyjama tops, pyjama bottoms, breakfast jackets, smoking jackets, bed jackets, cover-ups, knitted and woven loungewear, lounging pants and tops, lounge jackets.

**(6) No. 617381 for the same trade mark shown above and the goods shown below which was applied for on 21 August 1997 and entered in the register on 29 January 1999:**

**Class 9** - Optical goods, eyeglass frames, sunglasses, eyeglass cases.

**Class 25** - Women's, men's, boy's and girl's wearing apparel, jump suits, shirts, blouses, jackets, bathing suits, pants, shorts, warm-up suits, capes, walking shorts, jeans, suits, dinner jackets, raincoats, ties, socks, stockings/tights, hats/caps, outer coats, sweaters, skirts, coats, fur-trimmed coats, furs, vests, T-shirt, tennis and golf dresses, shorts, beach and swimming cover-ups, rainwear/raincoats, ponchos, tank tops, shoes, boots, slippers, blazers, pants, shirts, belts, gloves, dresses, shearling coats and jackets, scarves/shawls, sports jackets; active sportswear, sneakers.

The applicant's goods	The proprietor's goods
<p><b>Trade mark no. (4)</b></p> <p><b>Class 25</b> - Women's and girl's underwear, intimate apparel and sleepwear, loungewear, bodywear, foundations, bras, girdles, garter belts, all in ones, corselettes, body stockings, control briefs, control hipsters, contarter bikinis, bra slips, bra top camisoles, waist cinchers, bustiers, merry widows, camisettes, leotards and unitards, daywear - including but not limited to culottes, bikinis, hipsters, briefs, slips, blouse slips, camisole slips, chemise slips, culotte slips, evening slips, maternity slips, panty slips, princess slips, shadow panel slips, strapless slips, suit slips, tailored slips, half slips, petti-slips, bra slips, chemises, teddies, camisoles, bra top camisoles, braletts, tap pants and petti-pants, daywear, loungewear, sleepwear and bodywear - including but not limited to nightgowns, toga nightgowns, night shirts, pyjamas, shortie pyjamas, baby-doll pyjamas, T-shirt pyjamas, french maid sleepers, harem pyjamas, hostess culottes, lounging pyjamas, rompers, sleep shorts, peignoirs, bed jackets, caftans, jumpsuits, teddies, bath robes, dressing gowns, kimonos, housecoats, beach</p>	<p><b>Class 25</b> - Clothing, Garments, Head Wear, Footwear, Socks, Boxer Shorts, Underwear, Outerwear, Sportswear, Lingirie, Nightwear, Lounge Wear, Thermals, Base Layers; Clothing for fishermen; Clothing for martial arts; Clothing for wear in wrestling games; Clothing of imitations of leather; Clothing made of imitation leather; Clothing for leisure wear; Clothing; Clothing made of fur; Clothing for cycling; Clothing for cyclists; Clothing layettes; Clothing for gymnastics; Clothing for horse-riding [other than riding hats]; Clothing for skiing; Clothing for wear in judo practices; Clothing of leather; Clothing made of leather; Clothing for sports; Clothing for babies; Clothing for infants; Clothing for children.</p>

togas, beach wrap-ups, breakfast coats, brunch coats, hostess robes, kabuki robes, lounging robes, monk's robes, bra tops, crop tops and leggings.

**Trade mark no. (5)**

**Class 25** - Men's and boy's underwear, underwear, sleepwear, loungewear including but not limited to briefs, boxers, athlete underwear, sport knits, T-shirts, tank tops, undershirts, basic underwear and robes, knitted and woven sleepwear, sleep shirts, pyjama tops, pyjama bottoms, breakfast jackets, smoking jackets, bed jackets, cover-ups, knitted and woven loungewear, lounging pants and tops, lounge jackets.

**Trade mark no. 6**

**Class 9** - Optical goods, eyeglass frames, sunglasses, eyeglass cases.

**Class 25** - Women's, men's, boy's and girl's wearing apparel, jump suits, shirts, blouses, jackets, bathing suits, pants, shorts, warm-up suits, capes, walking shorts, jeans, suits, dinner jackets, raincoats, ties, socks, stockings/tights, hats/caps, outer coats, sweaters, skirts, coats, fur-trimmed coats, furs, vests, T-shirt, tennis and golf dresses, shorts, beach and swimming cover-ups, rainwear/raincoats, ponchos, tank tops,

shoes, boots, slippers, blazers, pants, shirts, belts, gloves, dresses, shearling coats and jackets, scarves/shawls, sports jackets; active sportswear, sneakers.	
---	--