

O-179-08

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NUMBER 2430294
BY FOX INTERNATIONAL GROUP LIMITED
TO REGISTER A TRADE MARK IN CLASS 28**

BACKGROUND

1. On 18 August 2006, Fox International Group Limited of 56-58 Fowler Road, Hainault Industrial Estate, Hainault, Essex IG6 3UT, applied to register trade mark number 2430294 under the provisions of the Trade Marks Act 1994. The mark consists of the word “ENFORCER”, and was applied for in respect of the following goods:

Class 28 Angling apparatus; angling accessories.

2. An examination report was issued on 27 November 2006. In this report, the applicant’s attention was drawn towards two earlier conflicting rights, and an objection was taken under section 5(2) of the Act.

3. The marks raised as citations against application number 2430294 were as follows:

- (i) UK trade mark registration number 2011957, consisting of the word “ENFORCER”. The registered proprietor for this mark is recorded as Dunlop Slazenger International Limited of Maxfli Court, Riverside Way, Camberley, Surrey, GU15 3YL. The mark has been registered in respect of “gymnastic and sporting articles” in class 28.
- (ii) Community trade mark registration number E1263318, consisting of the word and device mark shown below, and registered in respect of “Clothing, footwear, headgear” in class 25, “Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees; toys, action figures, action figure accessories, role play accessories, play sets, toy vehicles, dolls” in class 28, and “Education; providing of training; entertainment; sporting and cultural activities; entertainment services in the nature of live performances of roller skating exhibitions and competition, television program series featuring roller skating exhibitions and competitions; entertainment services in the nature of skating events” in class 41. The registered proprietor for this mark is recorded as World Skating

League LLC of 342 Troy Circle, Knoxville, Tennessee, 37919, United States of America:



4. With the examination report having been issued on 27 November 2006, the examiner provided the applicant with a six month period until 27 May 2007 for response. By that date, the Registrar had not received any correspondence from the applicant. As a consequence, the examiner issued a letter dated 2 August 2007 in which he confirmed refusal of the application under section 37(4) of the Trade Marks Act on the grounds that the applicant had failed to respond before the end of the specified period.

5. On 3 September 2007, the Registrar received a form TM5 Request for a statement of reasons for registrar's decision. Attached to this form was a letter setting out reasons why the applicant had failed to submit any response to the examination report. This letter also contained a request for an additional two month period to deal with the outstanding objection.

6. In his letter of 19 October 2007, the examiner stated that additional time would not be granted, and confirmed that the Statement of Grounds would be forthcoming.

7. I am now asked under section 76 of the Trade Marks Act 1994 and rule 62(2) of the Trade Marks Rules 2000 to state in writing the grounds of my decisions and the materials used in arriving at it.

DECISION

8. The grounds for objection to the application are under the terms of section 5(2) of the Act. If none of the objections under this section of the Act were justified, then final refusal of the mark under section 37(4) should not have been issued.

The Law

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

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

(a) it is identical with an earlier 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 mark.”

10. An earlier trade mark is defined in section 6(1) where it states that:

“6.(1) In this Act an “earlier trade mark” means-

(a) a registered trade mark, international trade mark (or UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

11. I take into account guidance provided by the European Court of Justice (ECJ) in the following cases: *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] ETMR 1, *Lloyd Schuhfabrik Meyer & Co GmnH v Klijsen Handel BV* [2000] FSR 77 and *Marca Mode CV v Adidas AG and Adidas Benelux BV* [2000] ETMR 723.

12. It is clear from these cases that:

(i) the likelihood of confusion must be appreciated globally, taking into account all relevant factors. (*Sabel BV v Puma AG*)

(ii) the matter must be judged through the eyes of the average consumer of the goods/services in question. (*Sabel BV v Puma AG*) The average consumer 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 kept in his/her mind. (*Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel*)

(iii) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. (*Sabel BV v Puma AG*)

(iv) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components. (*Sabel BV v Puma AG*)

(v) a global assessment of the likelihood of confusion implies some interdependence between the relevant facts, and in particular a similarity between the trade marks and between the goods or services. Accordingly, a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the marks and vice versa. (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*)

(vi) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it. (*Sabel BV v Puma*)

(vii) mere association in the sense that the later mark brings the earlier mark to mind is not sufficient for the purposes of section 5(2). (*Sabel BV v Puma*)

(viii) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of section 5(2). (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*)

13. The global comparison of marks therefore means that a number of elements must be analysed before effective judgement can be made.

Comparison of the goods

14. In assessing the similarity of goods concerned, all the relevant factors relating to these goods should be taken into account. Such factors include *inter alia* their nature, their end users and method of use, and also whether they are in competition with each other or are complementary (see *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer* [1999] ETMR 1 paragraph 23). Further factors include the purpose of the goods, their origin, and their pertinent distribution channels and sales outlets.

15. Turning first to the application, the list of goods claimed is relatively narrow being “angling apparatus” and “angling accessories” in class 28. By comparison, whilst the goods of earlier registered marks numbers 2011957 and E1263318 are similarly confined to class 28, the terms themselves are noticeably broader in scope than those of the application. To illustrate, earlier mark number 2011957 contains “sporting articles” within its class 28 specification, whilst E1263318 contains “sporting articles not included in other classes”.

16. In making my comparison between the respective goods, I have to consider the extent to which the applicant’s goods might be deemed either identical or similar to *any* of the goods protected by the earlier registrations. As a starting point, I am aware that the term “angling” is defined in the New Oxford Dictionary (Oxford University Press 2001) as being “the sport or pastime of fishing with a rod and line”. I can therefore confidently assume that the terms listed by the applicant on its trade mark application form refer to fishing equipment and paraphernalia.

17. Some of the terms listed in the earlier registrations denote categories of products which would not, on first impression, appear to hold any great deal of similarity to angling apparatus and accessories. Taking into consideration the criteria set out in paragraph 14 above, products such as decorations for Christmas trees, action figures, play sets, playthings, and toy vehicles (all of which are listed in earlier registration number E1263318) would not appear to have similar uses, purposes, retail channels or end users to those of angling products. In respect of gymnastic articles (claimed by *both* earlier registrations) and games (claimed by registered Community mark number E1263318), the distinction is less clear. Like the applicant’s “angling apparatus”, both

terms “gymnastic articles” and “games” refer to products which can be *sporting* in nature and which do, therefore, hold some general similarity to those of the applicant.

18. However, I do not consider that a detailed analysis of every individual term contained within the earlier registrations is necessary due to the fact that both of those registrations clearly contain the term “sporting articles” *at large*.

19. Any such reference to “sporting articles” without further qualification or limitation equates, in essence, to a claim in respect of *any and all* articles used in the course of *any and all* sporting activities – including angling (the dictionary definition provided in paragraph 16 confirms its recognition as a *sport*, rather than simply a hobby or pastime).

20. It therefore follows that, by way of their reference to “sporting articles” at large, registered trade mark numbers 2011957 and E1263318 both have protection in respect of articles used in the sport of angling. As a consequence, I must conclude that the “angling apparatus” and “angling accessories” claimed by the applicant in class 28 are *identical* to the “sporting articles” and “sporting articles not included in other classes” protected by earlier cited mark numbers 2011957 and E1263318 respectively.

Comparison of marks

21. Earlier registered mark number 2011957 consists of the word “ENFORCER” in a standard upper-case typeface i.e. it is a word-only mark. As the mark applied for also consists of the word “ENFORCER” in plain upper-case typeface, it is immediately apparent that these two marks are *identical*. I need not make any further comment in respect of the first cited mark.

22. The second of the two cited earlier marks, Community mark number E1263318, consists of the word “ENFORCERS” presented in a bold italicised typeface, accompanied by a stylised representation of the upper-case letter “E”. Both of these elements are presented within a dark oval-shaped device.

23. It is apparent that Community registration number E1263318 incorporates a number of visual and phonetic elements which are not found in the mark applied for. However, whilst such uncommon elements must be taken into consideration when comparing the signs, it is important to emphasise that any comparison limited solely to assessing the *quantity* of dissimilar or uncommon elements is unlikely to produce a conclusion which accurately reflects the potential for confusion in the marketplace. As stated in *Sabel BV v Puma AG*, it is necessary to identify those components within composite marks which are both *distinctive* and *dominant*.

24. In the case of E1263318, I do not need to attach much significance to the black oval device. Common geometric shapes are often used as background material in figurative trade marks and, as such, are familiar to the potential consumer. In this case, I find it unlikely that the background device will make any significant visual, aural, or conceptual impact upon the purchaser encountering the mark. By comparison, the stylised letter “E” has a novel presentation, and is positioned in a way that makes it clearly visible to the consumer. I also note the equally prominent presentation of the word “ENFORCERS”. In this case, where the earlier mark consists of a word, a letter, and figurative material, it is the word and letter elements which must, in general, be considered the dominant components. This is largely due to the simple fact that an average consumer would choose to comprehend and refer to the mark by its pronounceable and communicable word elements i.e. “ENFORCERS” or simply “E”, rather than via any abstract (and therefore unpronounceable) figurative elements.

25. In the context of the goods for which Community mark number E1263318 has been registered, the word “ENFORCERS” must be considered to have at least a normal level of distinctiveness (as is the case for the mark applied for). The same is true of the earlier mark’s letter “E”, although it is worthwhile pointing out that this letter’s highly stylised visual presentation offsets the much lower level of inherent distinctive character normally found in single letters. In the case, where the single letter used is identical to the first letter of the word it accompanies i.e. “E” and “ENFORCERS”, I am of the opinion that these two distinctive elements are complementary to each other, and would be perceived as such by the relevant consumer.

26. In the above analysis, I have sought to identify those elements within the composite mark registered as E1263318 which are likely to make an impact upon the consumer. In doing so, I have noted the prominence and distinctiveness of both the stylised letter “E” and the stylised word “ENFORCERS”. As the letter “E” actually serves to reinforce the recognisable and distinctive word it accompanies i.e. “ENFORCERS”, I find “ENFORCERS” to be the mark’s most dominant and distinctive component

27. Comparing this dominant element with the *only* element found in the mark applied for i.e. “ENFORCERS” versus “ENFORCER”, I have to conclude that the signs are similar.

Likelihood of confusion

Section 5(2)

28. Although the examiner’s refusal of the application was based upon section 5(2) of the Trade Marks Act 1994, I have already concluded at paragraphs 20 and 21 above that, in respect of earlier citation number 2011957, both the marks and the specifications are *identical*. It therefore appears that, in relation to earlier cited UK mark number 2011957 only, it would have been more appropriate for the examiner to have refused the application under section 5(1). However, this issue has not been raised by the applicant during the course of the proceedings. As a consequence, I need not address the issue of identity pursuant to section 5(1) in this decision. As the original objection and subsequent refusal was taken under section 5(2), I shall assess the case according to those grounds.

29. I find no reason to further analyse or compare the mark applied for against earlier cited mark number 2011957. Both consist exclusively of the word “ENFORCER”, and both are used in respect of identical products. As the respective marks and specifications are identical, I consider it more than probable that a relevant consumer faced with identical “ENFORCER” brands used in respect of two or more separate sets of identical angling apparatus would expect such apparatus to have come from the

same commercial undertaking. Therefore, there is a likelihood of confusion in respect of application number 2430294 and E1263318.

30. Having dealt with cited mark number 2011957, I must now address the potential for confusion between the mark applied for and citation number E1263318. I have already concluded that these two signs are similar, rather than identical, and must therefore consider the extent to which the similarities would give rise to a likelihood of confusion.

31. According to guidance laid down by the European Court of Justice, the likelihood of confusion must be assessed using a global comparison, taking into account all factors relevant to the case. This issue at stake can, for the sake of simplicity, be summarised by asking the following question: ‘is it reasonable to assume that an average consumer of angling apparatus and accessories would believe that goods sold by the applicant under the mark applied for originated from the same source as those protected by the earlier registration?’

32. The average consumer is considered to be reasonably circumspect. However, he or she must also be understood as having an imperfect recollection of any two marks. Confusion is not likely where a shopper can stand in front of two products and measure any differences in their branding. In reality, confusion is more likely to occur where a consumer encounters one product some time after encountering the other. Therefore, one must understand that a holistic analysis occurs in the mind of the average consumer. The consumer does not disassemble marks in his or her own mind, but rather the memory of one whole sign is compared with the next. As a consequence, in situations where marks are either highly distinctive in their totality and/or contain a highly distinctive element, confusion is more likely than in those where marks are relatively weak.

33. Through my comparison of the signs, I have already concluded that the word “ENFORCERS” constitutes a dominant and distinctive element of the earlier cited community mark. With that in mind, three criteria must be given due consideration as part of the global comparison of marks, namely a visual comparison, an aural comparison, and a conceptual comparison.

34. The presence of a heavily stylised letter “E” together with the oval background device clearly contributes in part to the overall visual impression conveyed by earlier registered mark number E1263318. Nevertheless, the word “ENFORCERS” is itself presented in a prominent style and position and, due to its familiarity as a relatively common word and one which is of at least normal distinctiveness for the goods in question, is likely to draw the majority of the potential consumer’s attention. That being the case, and with the applicant’s mark consisting solely of the word “ENFORCER”, I find a moderate degree of visual similarity between the two signs.

35. Aurally, the applicant’s mark would be referred to by the word “enforcer”. As regards aural and oral reference to earlier cited mark number E1263318, the relevant consumer would probably choose one of three options – pronunciation as “enforcers”, “e enforcers”, or just “e”. I find it less probable that the consumer would choose the third of these options. The single letter “e” has less inherent distinctiveness than its accompanying word “enforcers”, and it is natural that any consumer wanting to make oral reference to the mark would choose to use the element most suited for the job. It is unlikely that any consumer would ignore the word “enforcers” when seeking to make oral reference to the earlier cited mark. On that basis, the aural and oral comparison which is most likely to reflect market reality is that between, on the one hand, “e enforcers” and “enforcers” (either of which might be used as verbal reference to the earlier mark), and, on the other, “enforcer” (the mark applied for). Irrespective of which route the relevant consumer takes when pronouncing the earlier cited mark, the word “enforcer” will form a substantial and dominant part of that pronunciation. Therefore, I find clear evidence of aural similarity between the two signs.

36. In order to assess conceptual similarity, I have to consider the possible meanings (or ‘concepts’) conveyed by the word and/or figurative elements contained within the marks. Neither the figurative elements nor the single letter “E” found within the earlier cited mark conveys any obvious meaning. Any conceptual properties conveyed by that mark will therefore result solely from its use of the word “enforcers”. For the applicant’s word-only mark, all conceptual identity will similarly be created by its single word element “enforcer”.

37. The term “enforcer” is generally understood as meaning someone or something that enforces compliance with a law, rule, or obligation. In this case, the difference between the word “ENFORCER” as it appears in the applicant’s mark, and “ENFORCERS” as it appears in the earlier cited Community mark is negligible. The addition of the letter “s” in “ENFORCERS” has little effect upon the earlier sign’s conceptual identity other than to render it the pluralised form of the term “ENFORCER”. Therefore, the applicant’s mark presents the concept of a single enforcer whilst the earlier cited mark presents the concept of *more than one* enforcers. Any relevant consumer encountering the applicant’s sign will extract a near-identical meaning to that which has been taken from encountering the earlier cited registration. For that reason, I find a high level of conceptual similarity between the two signs.

Conclusion

38. Having found identity of signs and specifications between the applicant’s mark and the first citation number 2011957, I have concluded that there is a likelihood of confusion between those two marks.

39. As regards the second citation, I have analysed and identified the distinctive and dominant components of earlier Community mark number E1263318 as being the word “ENFORCERS” and, to a lesser extent, the single stylised letter “E”. On that basis, I have concluded that the mark is visually, aurally and conceptually similar to the “ENFORCER” mark applied for.

40. To determine the likelihood of confusion, I must take these conclusions and incorporate them into a global comparison taking into consideration the degree of similarity or dissimilarity between the relevant goods. In this case, I have already identified clear identity between the goods claimed by the application and those already covered by the earlier cited marks. Therefore, there is a likelihood of confusion.

Decision regarding Section 5(2)

41. Overall, there appears to be sufficient similarity between cited Community mark number E1263318 and the applicant's trade mark, together with *identity* in respect of earlier cited UK mark number 2011957, to justify objection under section 5(2) of the Act. All of the marks share the same dominant and distinctive features, and it has been shown that the goods applied for in class 28 are identical to those claimed by the earlier registered marks in the corresponding classes.

42. I therefore conclude that there is a likelihood of confusion sufficient to warrant an objection, and that the application in class 28 is not registrable because it is debarred from registration by section 5(2) of the Trade Marks Act 1994.

Dated this 30th day of June 2008

Nathan Abraham
For the Registrar
The Comptroller-General