

O-232-08

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2386672
IN THE NAME OF THE OUTDOOR GROUP LIMITED
FOR REGISTRATION OF THE TRADE MARK TECHNICALS
IN CLASSES 18, 20, 22 AND 25**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 94503
IN THE NAME OF TECNICA S.P.A**

Trade Marks Act 1994

**IN THE MATTER OF application No. 2386672
in the name of The Outdoor Group Limited
for registration of the trade mark TECHNICALS
in Classes 18, 20, 22 and 25**

And

**IN THE MATTER OF opposition thereto under No. 94503
in the name of Tecnica S.P.A**

BACKGROUND

1. On 10 March 2005, The Outdoor Group Limited made an application to register the trade mark TECHNICALS in Classes 18, 20, 22 and 25 in respect of the following goods:

- Class 18** Articles made of leather or imitation leather; articles of luggage; bags, trunks, rucksacks, knapsacks, satchels, haversacks, travel bags, backpacks, sports bags, valises, holdalls, cases; belts and straps; wallets, purses, pouches and hand bags; bags for campers and climbers; key cases; beach bags; saddlery and harnesses; parts and fittings for all of the aforesaid goods, all included in Class 18.
- Class 20** Sleeping bags; beds; cots; pillows; mattresses; air beds; air cushions and air pillows; air mattresses; roll mats; tent pegs; furniture for camping; parts and fittings for all of the aforesaid goods, all included in Class 20.
- Class 22** Tents; ground sheets and fly sheets; ropes, lines and strings; trawl fishing nets; bags in the nature of sacks for the transport and storage of materials in bulk; boat covers, waterproof coverings for tents and tarpaulins; clothes-lines, hammocks, rope ladders and marquees (textile); parts and fittings for all the aforesaid goods, all included in Class 22.
- Class 25** Articles of clothing for men, women and children; under and outer clothing; waterproof clothing; trousers and over trousers; breeches, shorts, skirts, dresses, jackets, sleeveless jackets, shirts, tee-shirts, sweatshirts, sweaters, blouses, jumpers, cardigans, jerseys, coats, jumpsuits, tracksuits, overalls; underwear; knitwear; balaclavas, mitts and thermal underwear; belts, jeans, jog pants and blousons; sportswear; ski wear; gilets; footwear; shoes, socks, gaiters, boots and moccasins; headgear; caps, sports headgear other than helmets; hats.

2. On 21 July 2006, Tecnica S.P.A filed notice of opposition to Classes 18 and 25 of the application, the grounds of opposition being in summary:

- 1. Under Section 5(2)(b)** because the mark applied for is similar to the opponent's earlier trade mark, and is sought to be registered in respect of goods that are identical and/or similar to the goods covered by that mark, such that there exists a likelihood of confusion on the part of the public.
- 2. Under Section 5(3)** because use by the applicant of a similar mark in relation to the goods covered by Classes 18 and 25 of the subject application, will, without due cause, take unfair advantage of, or be detrimental to the opponent's earlier mark.
- 3. Under Section 5(4)(a)** by virtue of the law of passing off.

3. The applicants filed a Counterstatement in which they deny the grounds on which the opposition is based.

4. Both sides ask that an award of costs be made in their favour.

5. Both sides filed evidence in these proceedings, which insofar as it is relevant I have summarised below. The matter came to be heard on 22 January 2008, when the applicants were represented by Mr Ian Wilkes of Groom, Wilkes & Wright LLP, their trade mark attorneys. The opponents were not represented.

Opponents' evidence

6. This consists of two Witness Statements. The first is dated 9 February 2007, and comes from Roger Morrison, Sales and Marketing Director of Mastco Limited, a position he has occupied since 2000.

7. Mr Morrison states that his company has been the sole UK distributor of Tecnica S.P.A. products since 2000, the goods having previously been distributed by other unnamed companies. He lists the goods sold under the TECNICA mark as being "ski-boots, trekking shoes, après ski boots, footwear, luggage, bags, rucksacks, walking poles, and other accessories, including clothing", being typically sold in specialist ski and outdoor shops. He goes on to refer to his company having attended the Soltex trade show in Manchester for the past seven years where the TECNICA products are a prominent feature of his company's stand, and four regional shows although nothing specific about these has been provided. Mr Morrison says that his company offers intensive product training for TECNICA ski boots for seventy-five shops, training over 350 staff each year. Mr Morrison says that in addition to the trade shows his company spends about £28,000 per annum on direct promotion of TECNICA branded products, advertising in specialist magazines and in the Snow and Rock retailer catalogue in which the TECNICA brand is strongly featured.

8. Mr Morrison provides a list of retail outlets throughout the UK where TECNICA branded goods are sold. These are described as being an "illustration" so is presumably not exhaustive. Sales figures for goods sold under the TECNICA name

for the period 2000 to 2006 range from £600,000 to a peak of £694,000. At Exhibit RM1, Mr Morrison provides copies of TECNICA brochures. The earliest relates to an ACCESSORIES COLLECTION for 2000 – 2001. The cover bears the stylized TECNICA name in conjunction with, but separate to a stylized letter “T”. This is a mode of representation that is consistent throughout later brochures although there are also examples of TECNICA being used in a plain font. This first brochure shows the TECNICA name being used in relation to items of outer-clothing and footwear for outdoor activities, namely, jackets, pants, fleeces, coats, gloves, bags for ski-boots and ski apparatus, socks (bearing the T logo alone although in conjunction with TECNICA on display signage), hats, headbands, boots, including those for hiking, climbing and skiing, bum bags, backpacks, soft travel bags, sandals and clogs. Brochures from 2001/2002 (and thereafter) show Mast Co Limited in the UK as part of an international sales network.

9. The second Witness Statement is dated 23 February 2007, and comes from Alberto Zanatta, General Manager of Tecnica S.P.A, a position he has occupied since 2004, having been employed by his company since 9 October 1995.

10. Mr Zanatta says that his company has used the trade mark TECNICA since the 1960s, the use being throughout the world. He refers to Exhibit AZ1, which consists of a print from the Tecnica website. The first page has a time-line in bar chart form under the heading "Tecnica Heritage". The chart starts at 1960 and goes through to "03", underneath showing the numeral 1960 followed by the text "1960 TECNICA produced work boots and mountain boots". The subsequent pages are in the same format but for later years. For 1970 it refers to a "Moon Boot" having sold 20 million pairs, 1973 refers to a TECNUS product, for 1980 it refers to TECNICA being a world leader in après-ski, depicting a number of casual boots. For 1985 the page refers to TECNICA having diversified launching the outdoor collection, in this case depicting a shoe. In 1989 TECNICA buy the THINK PINK clothing brand, and in 1989 the IOWA footwear company. The remainder of the exhibit is in the same vein, referring to the launch of in-line skates and ski boots. Whilst the exhibit catalogues the expansion of the business; it does not say that this extended into the UK.

11. Mr Zanatta says that his company produces ski boots for skiers of all abilities, from professional to beginners, showing details as Exhibit AZ2. The Exhibit consists of pages from an online catalogue for ski boots, the top of the page showing the stylised TECNICA name with the T logo, the boots bearing the TECNICA name. He says that his company's product range goes beyond goods for skiing, referring in particular to items such as rucksacks, gloves, hats, walking poles, bags, walking boots and outdoor clothing. Exhibit AZ3 consists of further pages from the on-line catalogue, this time depicting mountaineering and hiking boots, rucksacks, a shoulder bag, walking poles, running shoes, sandals and flip-flops. These exhibits do not show whether, and if so when the trade in such goods may have extended into the UK. Mr Zannata later refers to his company having been trading in the UK under the TECNICA name since around 1982, although is unable to provide supporting material from that date. He says that from around 1994 to 2000 they had a UK distributor called Blue Ridge Limited, thereafter Mastco Limited took over. Exhibit AZ4 consists of copies of invoices dating from 7 November 2001, from TECNICA to Mast-CO LTD in Reading. The invoices bear the TECNICA name on the top along with the T logo. None of the product descriptions mention TECNICA, but it is

possible to determine that some are TECNICA by linking the invoices to the catalogues in the previous exhibits.

12. The next Exhibit referred to is AZ5, which consists of copies of brochures and reports. The earliest dates from 1974-75, but given that Mt Zanatta has already confirmed that his company began trading in the UK around 1982 it can be taken that only those from that date are relevant. The earliest that can be seen to have a connection with the UK is dated "84/85". This has the stylised TECNICA mark on the front cover. The inside refers to the "ORIGINAL MOON BOOT BY TECNICA...THE FIRST" referring to them as being for after skiing. The back page lists representatives in various countries, showing Zapata Ltd as the UK representative. The 1986 brochure depicts TECNICA being used in connection with sports/leisure footwear, again listing Zapata as the UK representative for the company. For the 1991/2 brochure the UK representative changes to Ski Serve (UK) Ltd, by which time the product range had extended into an après-ski range of footwear, coats, socks and hats. The next brochure listing a UK representative is dated 2001, which shows Mast Co Limited. This contains a range of in-line skates. The exhibit includes the 2004/2005 Snow and Rock catalogue that shows TECNICA (in both stylized and plain font) being used in connection with ski boots. Many of the brochures relating to other years do not show a UK representative, but it would seem reasonable to infer that one existed. Mr Zanatta says that this is the case and his claims have not been challenged.

13. Mr Zanatta says that since 2000 his company has been a major player in the winter-sports market, and holds a 16% share of the UK market, although not specifically in relation to what products. He specifically mentions the ski-boot market where his company is the second-largest seller in the UK, through its distributor, Mastco.

14. Exhibit AZ6 consists of a table detailing the turnover of Mastco in the years 2002 to 2006, listing the following product types; "ski-boots, trekking shoes, Moon boots, footwear, clothing, accessories, spare parts and technical tools". No figures are shown for clothing after 2002 when 20 items at a cost of €518 were sold. The unit sales and turnover show the opponent's primarily trade in "ski-boots", and "accessories/technical tools" which I suspect are for ski-boots. Even without knowing the size of the market it is self-evident that the trade in the other goods listed is small. At Exhibit AZ7, Mr Zanatta provides the figures shown in Exhibit RM1 to Mr Morrison's Statement, stating that the differences can be explained by the currency, and the fact that Mr Morrison quotes retail prices whereas the figures he provide are wholesale. Exhibit AZ8 consists of Mastco Limited's PRICELIST 2004 – 2005 and 2005 – 2006. Amongst other brands these list products from the TECNICA range of ski-footwear, winter footwear, skis and Moon boots.

15. Exhibit AZ9 consists of details of the opponent's annual world-wide spend on advertising goods sold under the TECNICA trade mark, which is in the range of €2.1 million to €2.6 million. There is no means by which to apportion the figures to any particular country. The exhibit also includes a brochure for the "soltex05" exhibition at the G-Mex Centre between 20 and 23 February 2005. MastCo are listed amongst the exhibitors, TECNICA being shown as a connected brand. The remainder of the exhibit post-dates the relevant date by some time.

Applicant's evidence

16. This consists of a Witness Statement dated 12 July 2007 from Ian Wilkes, a trade mark attorney and partner in Groom, Wilkes and Wright LLP, the applicant's representatives.

17. Mr Wilkes says that he is aware that the applicant's have been using TECHICALS as a trade mark for clothing since as "early as the summer season of 2006". He refers to Exhibits IW1 and IW2, which consists of prints taken from Blacks online store on 8 March 2007, showing the TECHNICALS name being used in relation to a range of clothing. In the second Exhibit, the name is represented with TECHNIC in white, the suffix "ALS" being darker, both shown on a black background.

18. Mr Wilkes states that the applicant's use of the word TECHNICALS is intended to allude to the goods having "technical features", stating that Exhibits IW3 to IW6 give details of other trade marks for TECHNIC, TECNIC or TEC that have been registered in the UK in Classes 18 and 25. Not all of these show the elements as referred to, or the element on its own. Mr Wilkes goes on to give details of the results of his search of the Internet. Exhibit IW7 showing use of various marks incorporating TEC, TECH, TECNIC, TEC, TECHNICS and TECHNO in relation to bags or luggage. From these exhibits Mr Wilkes draws the conclusion that the use of TECHNICAL and derivatives of this are commonplace for bags and clothing. Exhibits IW8 and IW9 consist of two extracts from an online dictionary, showing TECHNICAL to be an ordinary English word, and TECHNICA not to be.

19. That concludes my summary of the evidence insofar as it is relevant to these proceedings.

DECISION

20. Turning first to the ground under Section 5(2)(b). That Section reads as follows:

"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."

21. An earlier trade mark is defined in Section 6 of the Act as follows:

"6.- (1) In this Act an "earlier trade mark" means –

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) 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.”

22. In my consideration of a likelihood of confusion or deception I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] 45 F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723 *Medion AG v Thomson multimedia Sales Germany & Austria GmbH*, Case C-120/04, and the CFI in *Shaker di L. Laudato & C. Sas v OHIM* Case C-334/05 P. It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*, but, beyond this, and notwithstanding that the overall impression may be dominated by one or more parts of a composite sign, it is possible that an earlier mark used as part of a composite sign may have an independent distinctive role in that sign without necessarily being the dominant element *Medion AG v Thomson multimedia Sales Germany & Austria GmbH*
- (d) 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*, but it is only when all the other elements of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element. *Shaker di L. Laudato & C. Sas v OHIM*,
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,
- (f) 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 AG*,
- (g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier

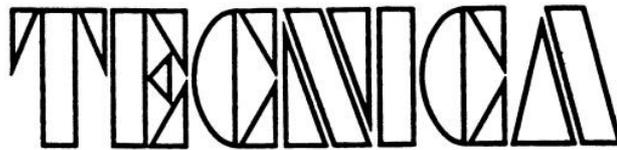
mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

- (h) 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 AG*,
- (i) further, 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; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,
- (j) 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 the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

23. The opponents rely on one earlier International trade mark, details of which are as follows:

Number: 410677

Mark:



Class: 25

Specification: Ski, mountain and après-ski footwear and sports footwear in general.

24. In my view the stylization does not take away from the fact that this is the word TECNICA, and will be seen as such by the consumer. I shall write my decision on this basis, taking into account any impact and relevance of the stylization. However, in respect of the consideration of whether the opponent's earlier mark and the mark in suit are similar, I believe it must follow that if there is a finding that the words TECNICA and TECHNICALS without any other matter are not similar, it must follow that the stylized version of the opponent's earlier mark cannot be either. The goods at issue here are articles of clothing of various forms, including footwear and headgear. In his decision sitting as the Appointed Person in the *React* trade mark case [2000] R.P.C. 285, Mr Simon Thorley stated:

“There is no evidence to support Ms Clark's submission that, in the absence of any particular reputation, consumers select clothes by eye rather than by placing orders by word of mouth. Nevertheless, my own experience tells me it is true of most casual shopping. I have not overlooked the fact that catalogues

and telephone orders play a significant role in this trade, but in my experience the initial selection of goods is still made by eye and subsequent order usually placed primarily by reference to a catalogue number. 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.”

25. The decisions in *Claudia Oberhauser v OHIM (Fifties)* [2003] E.T.M.R. 58, and *Criminal Clothing Ltd v Aytan’s Manufacturing (UK) Ltd*, [2005] EWHC 1303 indicate that the circumstances in which the relevant goods and the trade marks are encountered by the consumer, particularly at the point at which the purchase is made, is an important consideration. That said, the matter must be considered by applying an assessment of all relevant factors. This should be balanced by the decision of the CFI in *Devinlec Développement Innovation Leclerc SA v OHIM (Case T- 147/03)* in which they stated that a conceptual difference between the marks at issue may be such as to counteract to a large extent any visual and aural similarities between the signs. However, this requires at least one of the marks to have a clear and specific meaning so that the public is capable of grasping it immediately.

26. The earlier mark relied upon by the opponents consists of the word TECNICA, albeit stylised, but as I have already said, for the purposes of comparison I will first consider the issue as though the word was in plain font. There is no element of TECNICA or TECHNICALS, negligible or otherwise, that could be considered dominant, so the question is whether the marks as a whole are similar.

27. In a visual comparison it is self-evident the words TECNICA and TECHNICALS are not identical, but what is just as clear is that they have a substantial part in common. The similarity resides in the beginning of the applicant’s mark, a position generally accepted to be of most significance in a comparison. That the opponent’s mark is shorter in length will be apparent to anyone who studies the respective marks side-by-side. That the difference in construction is but one letter in the body of the applicant’s mark (which could easily be overlooked) and two letters at the end (the least important part) could lead to the view that these marks are visually similar. It is, however relevant to consider the impression that the respective words convey to the consumer as I believe this will influence what they see when encountering the words.

28. As can be seen from Exhibits IW8 the word TECHNICAL is an ordinary English word, but as far as I can see cannot be pluralized into the word TECHNICALS. The word TECHNICAL is in fairly common use in the UK, with a meaning that I consider will be well known to the relevant public. Adding a terminal letter “S” will most likely strike them as unusual or inappropriate, but will not change their understanding of the word; to my mind they will still see TECHNICAL when TECHNICALS is used in connection with the relevant goods. I am personally aware that “TECHNICAL” is used to describe clothing for protection against extreme conditions, such as is encountered in mountaineering or fire protection, but without supporting evidence I cannot take this as being within the knowledge of the relevant consumer. To me the meaning of TECHNICAL or TECHNICALS will be understood, but not to have any descriptive relevance for goods such as luggage and clothing.

29. Exhibit IW9 is provided to show that TECNICA is not a word in the English language, which appears to be the case. There is a reference for “técnica” but no further details, but from the accent over the letter “e” it would appear that this usage is not in the English language. Even so, I do not think that the word is all but the word TECHNICAL will escape the notice of the consumer.

30. Extending these considerations to the question of whether there is any conceptual similarity. If, as I have accepted, the consumer is likely to see TECNICA and connect this with TECHNICAL and TECHNICALS as an extension of this word, then it seems to me that the conceptual message must be the same.

31. Turning to the question of whether the respective marks are aurally similar. In the word TECHNICAL(S) the letter “H” is silent, so a word composed of the same letters in the same sequence but without the H will have an identical sound when spoken. It is possible that the terminal letters can change the sound of an identical first element, but that is not the case here. In my view adding the letters “LS” to TECNICA does not significantly change the ending. The terminal syllable of both marks will be an “AH” sound, in the applicant’s case followed by two, soft-sounding letters that drift quietly away. Even if the termination were to be enunciated with care, which as is generally accepted not to be how words are spoken, the words TECNICA and TECHNICALS will sound very similar.

32. I consider the marks TECNICA and TECHNICALS to have visual similarities, and to be aurally and conceptually similar. On balance, I consider these to be similar marks.

33. The opponent’s objection is against the application being registered for goods in Classes 18 and 25. Having been registered in less than five years at the date of publication of the application the provisions of the Trade Marks (Proof of Use, etc.) Regulations 2004 (SI 2004/946) do not apply.

34. The opponent’s earlier mark is registered in respect of “Ski, mountain and après-ski footwear and sports footwear in general”. On my assessment, with one exception the evidence shows use in respect of these goods. The exception is the description “sports footwear in general”. This would cover footwear ranging from “training shoes” to “football boots”, the latter clearly not being part of the use shown. This, however, is a distinction of no consequence, because the consumer would consider sports footwear to be a reasonable and recognisable subset of goods for the use shown by the opponents, and these goods would, in any event be considered similar. There is evidence of use of TECNICA in relation to footwear that is for use in sports, so in my view it is appropriate to accept use having been shown in respect of this description.

35. The evidence relating to the extent of this use is a little thin. It is known to have commenced in the UK around 1982, but not in respect of all goods; the trade has built over the years. Mr Zanatta claims that since 2000 his company has been a major player in the winter-sports market, and holds a 16% share of the UK market. Apart from ski boots where his company is the second-largest seller in the UK, he does specify the goods, but it would seem reasonable to expect they are of the type shown in the brochures. Turnover has been provided for the years 2002 to 2006, listing the products as “ski-boots, trekking shoes, Moon boots, footwear, “clothing”

“accessories” “spare parts” and “technical tools”. The unit sales and turnover evidence a trade centred on ski-boots, followed by “accessories” and “technical tools” which I suspect are for ski-boots.

36. The only figure for clothing relates to a trade in 2002 when 20 items at a cost of €518 were sold. This cannot be significant in relation to the market as a whole, or justify a finding that they have established much, if any reputation in respect of such goods. The term “clothing” is also somewhat broader in its scope than is shown by the use.

37. Even without knowing the size of the market, the figures provided for other goods are small and unlikely to have established any significant reputation although there would potentially be some spill-over from the core trade.

38. Details of the opponent’s annual world-wide spend on advertising goods sold under the TECNICA trade mark are significant, but as there is no means by which to apportion the figures to any particular country cannot be taken to have established anything in relation to the UK. Mr Morrison refers to his company, Mastco as having expended around £28,000 per annum promoting TECNICA goods, primarily in specialist magazines and the Snow and Rock retailer catalogue, but does not say what goods. Mr Zanatta refers to Mastco as selling to 85% of winter outlets, including the largest UK retailers, but again this provides no assistance; it could be their main product line of ski boots and skis. I do not know the significance of the “soltex05” exhibition at the G-Mex Centre attended by MastCo in February 2005, or any of the other regional shows mentioned in passing, so again it is impossible to gauge the significance.

39. Balancing these facts I come to the conclusion that the opponents have a reputation for TECNICA established in connection with ski-boots and certain accessories and tools for these goods. In respect of any other goods for which use has been claimed, the trade appears to have been too small to have established any significant reputation, let alone one that could be said to justify greater protection than would otherwise be afforded.

40. Turning next to look at the similarity, or otherwise, of the goods covered by Class 25 of the application. Being the same class as the “footwear” for which the earlier mark has been registered and used, the question is whether the application explicitly or implicitly mentions the same or similar goods. The term “clothing” covers all items of clothing including “footwear”, so the terms “Articles of clothing for men, women and children” and “outer clothing” must constitute the same or similar goods. The term “waterproof clothing” would encompass “waterproof footwear” so that term must also be considered to contain the same or similar goods, likewise the terms “sportswear” and “ski wear”. Clearly the descriptions “footwear”, “shoes”, “boots” and “moccasins” are all identical goods to those of the opponent’s earlier mark. “Socks” can have a sole affixed so in my view are capable of being similar goods to “footwear”, or are at the very least, closely allied. The same is true in the case of “gaiters” which are worn as an extension to “footwear”. The remainder of the goods in this class, namely

Under clothing; trousers and over trousers; breeches, shorts, skirts, dresses,

jackets, sleeveless jackets, shirts, tee-shirts, sweatshirts, sweaters, blouses, jumpers, cardigans, jerseys, coats, jumpsuits, tracksuits, overalls; underwear; knitwear; balaclavas, mitts and thermal underwear; belts, jeans, jog pants and blousons; headgear; caps, sports headgear other than helmets; hats.

are not the same or similar to those covered by the opponent's earlier mark and for which they have shown use.

41. In answering the question of whether the goods in Class 18 of the application are the same or similar to the footwear covered by the opponent's earlier mark and for which they have shown use, I propose to look to the guidelines formulated by Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281 (pages 296, 297) as set out below:

“...the following factors must be relevant in considering whether there is or is not similarity:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive.

This inquiry may take into account how those in the trade classify goods, for instance whether market research companies, who of course act for the industry, put the goods or services in the same or different sectors.”

42. Whilst I acknowledge that in the view of the *Canon* judgement the *Treat* case may no longer be wholly relied upon, as can be seen from the following paragraph, the ECJ said the factors identified by the UK government in its submissions (which are listed in *Treat*) are still relevant in respect of a comparison of goods:

“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, intended purpose and their method of use and whether they are in competition with each other or are complementary.”

(see paragraph 56 of Case T-169/03 explaining the change from “end consumers” to “intended purpose”. This appears to have resulted from a mis-translation of the original text.).

43. Whether for particular activities such as skiing, climbing, or walking, or for general wear, footwear is an item to clothe the feet. That is not the purpose or use to which any goods in Class 18 may be put, so the only conclusion that can be reached is that the uses of the opponent’s goods and those covered by Class 18 of the application are different.

44. The opponent’s “footwear” is essentially, but not exclusively for use in sporting activities, namely skiing, or for wear in outdoor or winter pursuits. These are activities engaged in by people from all walks of life. In some cases, such as the opponent’s “Moon boots”, the footwear is capable of being worn as leisurewear, and with the exception of the ski boots, is little if any different to footwear in general. The consumer of such goods notionally covers the public at large. The goods for which the applicants seek registration in Class 18 are of a general and everyday nature; they are not stated to be specialised in any way. They are capable of being for use by all, and by the same sectors of the buying public as the opponent’s footwear.

45. As far as the physical nature of the respective goods is concerned, there is, in my view a close correlation here. With the exception of ski boots, footwear of whatever type is generally made from leather or imitations of leather, which self-evidently is what part of the specification in this class covers, so the goods are similar in this respect.

46. I have no evidence which goes to the markets and trading patterns of the respective goods. However, these are fairly ordinary items which every person will at some time use or come into contact with, and as such, personal knowledge can be an adequate substitute for evidence.

47. From my own experience I know that it is not unusual for traders in clothing to also trade in complementary fashion items such as handbags, which are often sold as a matching accessory to footwear. However, that is not the case in respect of the sports and outdoor footwear for which the opponents have used the mark. That said, there is a genus of goods such as sports holdalls, backpacks, etc, that would be sold alongside such footwear. They may not be sold on the same shelves, but being goods for use in the same activity are likely to be displayed on shelves or in areas in reasonably close proximity.

48. My conclusion is that the goods in Class 18 of the application that are for use in outdoor pursuits are likely to share the same channels of trade at the retail end, and I see no reason why this should not also be the case in respect of the manufacturing and wholesaling stages. At the very least I would consider the opponent’s footwear and the goods I have mentioned in Class 18 of the application to be complementary. They are, however bought in addition to rather than as an alternative so I do not consider them to be in any way competitive.

49. Based on the above reasoning, I take the view that the following goods are similar to the opponent’s goods in Class 25:

“Articles of luggage; bags, rucksacks, knapsacks, satchels, haversacks, travel bags, backpacks, sports bags, holdalls, cases; bags for campers and climbers; parts and fittings for all of the aforesaid goods.”

50. The term “Articles made of leather or imitation leather” notionally covers all of the above so also contains similar goods.

51. So I reach the conclusion that there is identity or similarity in respect of some of the goods in both Class 18 and Class 25 of the application.

52. Balancing all of the factors and adopting the global approach advocated, I take the view that the similarities are such that use of the marks applied for will lead to confusion, and particularly so when the possibility of imperfect recollection is taken into account. The opposition under Section 5(2)(b) therefore succeeds in respect of the following goods:

Class 18 Articles made of leather or imitation leather; articles of luggage; bags, rucksacks, knapsacks, satchels, haversacks, travel bags, backpacks, sports bags, holdalls, cases; bags for campers and climbers; parts and fittings for all of the aforesaid goods.

Class 25 Articles of clothing for men, women and children; outer clothing; waterproof clothing; sportswear; ski wear; footwear; shoes, socks, gaiters, boots and moccasins.

53. Turning next to the ground under Section 5(3). That section reads as follows:

“5.- (3) A trade mark which –
(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC) in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

54. The standard test for the sort of reputation that is needed to underpin a Section 5(3) action is set out in *General Motors Corp v Yplon SA* [2000] R.P.C. 572. In this case the Court concluded that the requirement implies a certain degree of knowledge amongst the public, and that the required level would be considered to have been reached when the earlier mark is known by a significant part of the relevant sectors of the public. In deciding whether this requirement is fulfilled all relevant factors should be considered, including, the market share held by the trade mark, the intensity, geographical extent and duration of its use and the size of the investment made by the undertaking promoting it; the stronger the reputation and distinctive character, the easier it will be to accept that detriment has been caused to it.

55. The raft of recent case law relating to objections under Article 8(5) of Regulation 40/94, equivalent to Section 5(3) of the Trade Marks Act was considered by the CFI in

some detail in Case T-215/03 *Sigla SA v. Office for Harmonisation in the Internal Market*, namely: Case C-292/00, *Davidoff & Cie SA & Zino Davidoff SA v Gofkid Ltd* [2003] E.C.R. I-389 at [24]-[26], Case C-408/01 *Adidas-Salomon AG v Fitnessworld Trading Ltd* [2003] E.C.R. I-12537 at [19]-[22], Case T-67/04 *Monopole SpA v OHIM--Spa-Finders Travel Arrangements* [2005] E.C.R. II-1825 at [30], the Opinion of Advocate General Jacobs in *Adidas-Salomon and Adidas Benelux* at [36]-[39], Case T-104/01 *Oberhauser v OHIM-- Petit Liberto* [2002] E.C.R. II-4359 at [25], Case C-39/97 *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1998] E.C.R. I-5507 at [29], Case C-342/97 *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [1999] E.C.R. I-3819 at [17], Case C-251/95 *Sabel BV v Puma AG* [1997] E.C.R. I-6191 at [20] and Case C-375/97 *General Motors Corp v Yplon SA* [1999] E.C.R. I-5421 at [30].

56. The CFI concluded that the marks at issue must be either identical or similar to an earlier mark relied upon. In its judgment in *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd*, the ECJ were not so conclusive about the need for the respective marks to be “similar”, only that they have a “certain degree of similarity”:

“29. The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them: see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23”

57. In *Inlima S.L.’s* application [2000] RPC 661 Mr Simon Thorley QC, sitting as the Appointed Person posed the question of what “similar” meant in the context of Section 5(3):

“13..The word ‘similar’ is a relative term. One has to ask the question ‘similar for what purpose’. The question of similarity accordingly can only be answered within the context of a particular set of facts, once one has identified both the facts and the purpose for which similarity is required. In the case of section 5(3), the purpose of requiring similarity is so that the possibility of detriment or unfair advantage might arise. In any particular case, a conclusion as to whether it does arise must depend not only upon the degree of similarity but on all the other factors of the case, not least, the extent of the reputation.

14. I therefore conclude that the same global appreciation as is required for confusion under section 5(2) is likewise to be applied to the changed circumstances of section 5(3).”

58. The opponent’s attack is based on the allegation that the applicants would gain an unfair advantage by “riding on the reputation” of their earlier mark and that its distinctive character will be eroded by such use.

59. I have already found there to be a likelihood of confusion in respect of some of the goods covered by the disputed Class 18 and Class 25 elements of the application, so the question is whether under the “changed circumstance” of Section 5(3), use by the applicants in relation to the remaining goods in those classes would be unjustifiably

helped, or the distinctive character of the opponent's mark harmed. In the latter scenario the CFI considered the risk of dilution to be lower if the earlier mark consists of a term which, because of a meaning inherent in it, is very common and frequently used.

60. I proceed on the basis that the consumer will perceive the respective marks as the word TECHNICAL. This is an ordinary English word that for certain goods and services will be wholly descriptive, but there is no evidence that it is descriptive or its use commonplace in relation to clothes, footwear or bags and the like.

61. In my consideration of the ground under Section 5(2)(b) I found the opponents' earlier mark and the mark applied for to be similar. To my mind that is the case whether determined by reference to the law and first impression, or by detailed analysis; there is no evidence relating to the question of the similarity of the respective marks. The point is that the newcomer must have a similarity to the established trade mark sufficient for the consumer to make a link, for if that is not the case how can the earlier mark be affected in any material way? But even if the respective marks are similar, that does not necessarily mean that the opponents will succeed with this ground. Both the ECJ and the CFI have reiterated the comment made in *Premier Brands UK Ltd v Typhoon Europe Ltd* [2000] FSR 767 (in relation to Section 10(3)), that the purpose of the Regulation is not to prevent registration of any mark which is identical or similar to a mark with a reputation.

62. In *Electrocoin Automatics Limited v Coinworld Limited and Others* [2005] FSR 7, Mr Geoffrey Hobbs Q.C. (sitting as a Deputy Judge) stated:

“ 102. I think it is clear that in order to be productive of advantage or detriment of the kind prescribed, ‘the link’ established in the minds of people in the market place needs to have an effect on their economic behaviour. The presence in the market place of marks and signs which call each other to mind is not, of itself, sufficient for that purpose.”

63. In *Daimler Chrysler v Alavi* (the *Merc* case) [2001] RPC 42 at para 88, Pumfrey J stated:

“In my view, the best approach is just to follow the section remembering Jacobs A.G.'s warning that it is concerned with actual effects, not risks or likelihoods...”

64. It is reasonable to infer from the claimed 16% share of the Winter sports market, in conjunction with the sales figures at Exhibit AZ6, that the opponent's have a strong reputation in respect of ski-boots, and parts and accessories for such goods.

65. The details relating to clothing only relates to one year and is of a scale where it is unlikely to have generated a reputation of the sort envisaged in *General Motors Corp v Yplon SA*. The trade in trekking shoes, Moon boots and other footwear appears to have been ongoing for many years. However, the unit sales figures have only been provided for three years prior to the relevant date, and are small even without knowing the size of the market. There has been a significant world-wide expenditure by the opponents promoting TECNICA goods but it is not possible to apportion any of this to

the UK. Mr Morrison says that Mastco have also spent money promoting TECNICA goods in the UK, but does not say what, how or where. On my assessment, the evidence of trade under the TECNICA mark is not sufficient to be able to infer that the mark is known by a significant part of the relevant sectors of the public. I do not therefore consider that the ground under Section 5(3) takes the opponent's case any further forward than under Section 5(2), and it is dismissed.

66. This leaves the ground under Section 5(4)(a), that section reads as follows:

“5.-(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark”.

67. The requirements for this ground of opposition have been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *WILD CHILD* Trade Mark [1998] R.P.C. 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

(1) that the opponents' goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the applicant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the applicant are goods or services of the opponents; and

(3) that the opponents have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the applicant's misrepresentation.

68. To the above I add the comments of Pumfrey J in *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 in which he said:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under Section 11 of the 1938 Act (See *Smith Hayden (OVAX)* (1946) 63 RPC 97 as qualified by *BALI* [1969] RPC 472).

Thus the evidence will include evidence from the trade as to reputation;

evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed at the relevant date. Once raised the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of possibilities that passing off will occur.”

69. The date at which the matter must be judged is not entirely clear from Section 5(4)(a) of the Act. This provision is clearly intended to implement Article 4(4)(b) of Directive 89/104/EEC. It is now well settled that it is appropriate to look to the wording of the Directive in order to settle matters of doubt arising from the wording of equivalent provisions of the Act. The relevant date may therefore be either the date of the application for the mark in suit (although not later), or the date at which the acts first complained of commenced, as per the comments in *Cadbury Schweppes Pty Ltd v The Pub Squash Co Pty Ltd* [1981] RPC 429.

70. As far as I can see the opponent's have not directly traded in the UK, but have done so through traders appointed as distributor. Relying on *Oertli v. Bowman* [1959] R.P.C. 1, Wadlow on the Law of Passing Off suggests that there are two questions to be asked when seeking to determine the ownership of goodwill; who is in fact most responsible for the character or quality of the goods? and who is perceived by the public as being responsible? The latter is said to be the more important of the two. Wadlow goes on to expand on these questions and poses the following questions; at page 183.

“(a) Are the goods bought on the strength of the reputation of an identifiable trader?

(b) Who does the public perceive as responsible for the character or quality of the goods? Who would be blamed if they were bad?

(c) Who is most responsible in fact for the character or quality of the goods?

(d) What circumstances support or contradict the claim of any particular trader to be the owner of the goodwill? For example. Goodwill is more likely to belong to the manufacturer if the goods are distributed through more than one dealer, either at once or in succession. If more than one manufacturer supplies goods to a dealer and they are indistinguishable, the dealer is more likely to own the goodwill.”

71. At page 195, Wadlow’s goes on to deal with foreign businesses and their Representatives. Citing the decision of the Court of Appeal in *Scandecor Development v Scandecor Marketing* [1999] FSR 26, Wadlow’s states:

“A foreign business may have a goodwill in the jurisdiction even though it may not trade here in its own right. As the Court of Appeal in *Scandecor*

Development v Scandecor Marketing:

We accept that in an appropriate case, it is legally and factually possible for a business based overseas to acquire a goodwill in this country by the supply of its products or services through a subsidiary, agent or licensee. Whether or not that occurs must depend on the facts of the particular case

It is sufficient that customers for its goods are to be found here, whether or not the foreign business is in direct contractual relations with them [*Anheuser-Busch Inc v Budejovicky Budvar NP* [1984] F.S.R. 413 CA]. In particular, if the foreign business is represented by a legally distinct person of whatever capacity then the goodwill will in general belong to the foreign business rather than its local representative *provided that the foreign business is recognised as the ultimate source of the goods.*" [my emphasis].

72. Whichever way this guidance is looked at there cannot be any doubt that the opponent's are the owners of the goodwill in the TECNICA mark established through the use by the succession of distributors. Whilst the opponent's use in relation to goods beyond ski boots and parts/accessories appears to be small, that does not mean that they do not have any goodwill. This goes no wider than their reputation which I have already taken account of in my consideration of Section 5(2)(b), but of course the consideration of that ground is restricted to the extent of the opponent's rights derived from their earlier mark. The position is different in respect of passing off, where the goodwill can extend into different areas of trade, more particularly, to a field of activity that is a natural extension of the opponent's trade. Where this is the case, damage is likely to be inferred even where the opponent has shown no present intention of trading in that area (*Eastman Photographic Materials Co. Ltd. v. John Griffiths Cycle Corporation Ltd.* (1898) 15 R.P.C. 105)

73. In this case, it is clear that the applicants are not just seeking to register their mark in an area that is a natural progression from that in which the opponent's have traded; there is evidence they are in an area where the opponent's have been trading in for some time and have established goodwill. In this I am referring to the various items of outdoor clothing beyond footwear. I therefore find that in addition to the goods that I have already found to be in conflict under Section 5(2)(b), use of the mark applied for in relation to the following goods will amount to a misrepresentation and damage will result:

Jackets, sleeveless jackets, coats, shirts, tee-shirts, sweatshirts, sweaters, jumpers, cardigans, jerseys, knitwear, shorts; trousers and over trousers; overalls; breeches; coats, blousons; jumpsuits, tracksuits, balaclavas, mitts; headgear; caps, sports headgear other than helmets; hats.

74. The application may therefore proceed to registration for the following goods, subject of course to there being no appeal:

Class 18 Trunks, valises, belts and straps; wallets, purses, pouches and hand bags; key cases; beach bags; saddlery and harnesses; parts and fittings for all of the aforesaid goods,

Class 25 Under clothing; skirts; dresses; blouses; tracksuits; underwear; belts, jeans; jog pants..

75. The goods in Classes 20 and 22 that were not the subject of these proceedings are clearly free to proceed to registration whether or not there is an appeal.

76. The opposition having been substantially successful, the opponents are entitled to a contribution towards their costs. I therefore order that the applicants pay the opponents the sum of £2,250 towards their costs. 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 11th day of August 2008

**Mike Foley
for the Registrar
the Comptroller-General**