

O-244-05

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2352498
BY KALEEM RAJA TO REGISTER A TRADE MARK
IN CLASSES 18 AND 25**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No. 92490
BY VICTOR-SPORT VERTRIEBES GMBH**

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**IN THE MATTER OF Application No. 2352498
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**IN THE MATTER OF Opposition thereto
under No. 92490
by Victor-Sport Vertriebes GmbH**

BACKGROUND

1. On 23 December 2003 Kaleem Raja applied to register the following trade mark in Classes 18 and 25 of the register:



2. Registration was sought in respect of the following goods:

Class 18:

Leather belts, leather bags, umbrellas.

Class 25:

Clothing, hats, shoes.

3. The application was subsequently published in the Trade Marks Journal and on 13 May 2004 Victor-Sport Vertriebes GmbH filed a Notice of Opposition under Section 5(2)(b) of the Act on the grounds that the mark applied for is similar to the following earlier trade mark owned by the opponent which covers identical and similar goods and there exists a likelihood of confusion on the part of the public –

European Community Registration No.	Mark	Date Registration Effective	Specification of Goods
3495165		31 October 2003	Class 18: Leather and imitations of leather and goods made of these materials, namely bags

		<p>and other containers not specifically designed for the goods to be carried, and small leather goods, in particular purses, pocket wallets, key wallets; hand bags, briefcases, shopping bags, school satchels; backpacks, rucksacks; trunks and travelling bags; umbrellas, parasols and walking sticks; saddlery; travelling sets (leatherwear).</p> <p>Class 25: Clothing, including sportswear; sports shoes for badminton, squash and/or tennis; headgear, including sports headgear; gloves, including sports gloves; accessories, namely headscarves, shawls, dress handkerchiefs, ties, belts and scarves; stockings.</p> <p>Class 27: Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors of rubber, plastic and textile material; gymnasium mats, car mats, artificial turf, insulating floor coverings, floor coverings for tennis and badminton courts.</p> <p>Class 28: Gymnastic and</p>
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			sporting articles (included in class 28); gymnastic and sporting equipment, in particular badminton, tennis and squash rackets, feather shuttlecocks, nylon shuttlecocks; racket bags for badminton, tennis and squash rackets; nets for ball games; tennis nets, net holders for tennis nets and badminton; net tensioners; badminton and tennis racket strings of cattle gut and sheep gut fibres; monofilament and multifilament strips and imitation catgut of synthetic spun compounds being semi-finished goods for badminton and tennis racket strings;
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4. The applicant filed a Counterstatement denying the grounds of opposition, submitting that the parties were in different markets and that the marks are different in light of the particular stylised presentation of the mark applied for.

5. Neither party has filed evidence. The opponent relies upon written submissions in lieu of evidence. Both parties ask for an award of costs in their favour. The parties are content for a written decision to be made without recourse to a hearing.

Opponent's Submissions

6. The opponent's written submissions are attached to a letter dated 27 July 2005 from Marks & Clerk, the opponent's professional advisors in these proceedings.

7. The opponent refers to a list of well known European Court of Justice decisions on the interpretation and application of the relevant law.

8. The opponent goes on to submit the following in relation to similarity of marks:

“2.3 The Opponents have relied solely on Community Trade Mark application No. 3495165, which consists of a figurative element combined with the word VICTOR. In terms of the visual impact of the figurative element, it does not

dominate the mark in any way. The degree of stylisation in the representation of the word VICTOR is negligible. The figurative element is obviously the stylised letter “V”, which merely emphasises the first letter of the verbal element of the mark. Single letters are generally seen as inherently weak and therefore, the dominant and distinctive element of the mark is the word VICTOR. The overriding visual impact of the Earlier Right is of a “Victor” mark.

The Contested Mark consists solely of the word VICTOR presented in a stylised form. The Applicant, in his counter-statement states that his mark “uses Gothic text with all the letters except the V, c and o, reversed 180 degrees”. The Opponents would submit that irrespective of the Applicant’s statements, the overriding visual impression of the mark is of the word VICTOR. The degree of stylisation in the Contested Mark does not detract from the fact that to the human eye, the Contested Mark is a “Victor” mark.

Further, the Opponents submit that the rotation of the letters V, c and o in the Contested Mark does not assist them having regard to the decision in *Cording* (1916) 33 RPC 83, in which it was held that the mark “Gnidroc”, being the name “Cording” reversed, was calculated to deceive and registration was refused. The Contested Mark is far closer to the Earlier Right than “Gnidroc” is to “Cording”.

In conclusion, from a visual point of view, the Earlier Right and Contested Mark are visually extremely close, to the extent that they share the identical verbal element, VICTOR. The degree of stylisation in the Contested Mark and the combined effect of the figurative element and stylisation of the word VICTOR in the Earlier Right are not sufficient to outweigh the strong similarity of the marks due to the presence of the identical dominant element VICTOR. The Opponents would draw attention to OHIM Decision Nos. 753/2001, 81/2000, 849/1999 and Decision No. R 451/1999-2 confirming 324/1999 in support of the submissions put forward above.

- 2.4 It is a well-established principle that in marks consisting of a word and Figurative element, the word element is in general the dominant component because the public can refer to trade marks more easily by their word element. The Earlier Right will be referred to as VICTOR and the goods covered by the Earlier Right in classes 18 and 25, would be ordered and requested aurally as “Victor” goods. The only way the public would refer to the Contested Mark aurally is as “Victor” and the goods covered by the Contested Mark would be requested aurally as “Victor” goods. Therefore, the marks are clearly aurally identical.

Further, the dominant feature of the Earlier Right and the Contested Mark is the word “Victor”. Phonetically, the essence and identity of the pronunciation of the marks, is dominated by the word VICTOR.

- 2.5 The Earlier Right and the Contested Mark would be perceived and referred to as “Victor” marks. The public would not give a high level of importance to the figurative element of the Earlier Right, particularly since this is a stylised

letter “V”. The inherently weak nature of the stylised letter “V” merely makes the word VICTOR in the Earlier Right stand out. Therefore the marks concerned are conceptually identical.

2.6 The Applicant has referred to the existence of the Opponents’ UK Registration No. 1162945 for the word VICTOR in a stylised form and a stylised letter “V”. It should be noted that the only right relied on in these proceedings is Community Trade Mark No. 3495165. Further it will also be noted that the only common element between the Earlier Right and the Contested Mark is the word “Victor”. The word “Victor” is distinctive of goods contained in classes 18 and 25 and would be perfectly registrable as a trade mark under the 1994 Act, which is the only Act which applies to these proceedings.”

9. In relation to the likelihood of confusion, the opponent states that identical and similar goods exist in Classes 18 and 25 and that the relevant public is the average consumer. It goes on to say that it is not uncommon for the goods concerned to be ordered by phone and that in the clothing industry, it is quite common to add an additional element to a mark to distinguish categories of clothing.

10. I now turn to the decision.

DECISION

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

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

12. An earlier right is defined in Section 6, the relevant parts state:

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

- (a) a registered trade mark, international trade mark (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”.

13. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

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 & C. 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*;
- (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*;
- (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) 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*;
- (h) 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*.

14. In essence the test under Section 5(2) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. In my considerations on whether there are similarities sufficient to show a likelihood of confusion I am guided by the recent judgments of the European Court of Justice mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual; aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods, the category of services in goods and how they are marketed. I must compare the mark applied for and the opponent's earlier registration on the basis of their inherent characteristics assuming notional fair use of the marks across the width of the respective specifications of goods.

15. Firstly, I go to a comparison of the respective goods. It is obvious that the goods applied for are identical and/or closely similar to the goods covered by the opponent's earlier registration in Classes 18 and 25.

16. I now go on to compare the mark in suit with the mark comprising the opponent's earlier registration.

17. The guiding authorities make it clear that I must compare the marks as a whole and by reference to overall impression. However, as recognised in *Sabel BV v Puma AG* (mentioned earlier in this decision) in my comparison, reference will inevitably be made to the distinctiveness and dominance of individual elements. It is, of course, possible to over analyse marks and in doing so shift away from the real test which is how the marks would be perceived by customers in the normal course and circumstance of trade. I must bear this in mind when making the comparisons.

18. The opponent contends that the dominant and distinctive element of its earlier mark is the word VICTOR. While this word is both a dominant and distinctive element I must not lose sight of the fact that the earlier mark also contains a stylised letter V which is also striking and given the stylisation, possesses a degree of distinctive character.

19. Turning to the mark in suit, it seems to me that it consists of a highly stylised word, and on first glance/impression I was hard pressed to decipher the word. While it consists of a very unusual presentation of a word, that word is "Victor". However, the word "Victor" is not easily identified due to the relatively unusual script and the rotation of the letters, i, t and r, within the mark. The opponent contends that rotation of the letters does not assist the applicant, having regard to the decision in *Cording* (1916) 33 RPC 83 – see paragraph 8 of this decision. However, there is no evidence and I have no reason to believe that the mark in suit is calculated to deceive.

20. In its submissions – paragraph 8 of this decision refers – the opponent also draws attention to a number of OHIM decisions. I have considered these decisions but it seems to me that in those marks, the degree of stylisation is not as strong as that of the mark in suit ie. the words HOT STUFF, OLYMPIC, DUCKS UNLIMITED and VITALA/VITALIA, in the OHIM decisions can be readily discerned on first glance/impression. I must compare the marks before me on the particular merits of the present case.

21. On the visual comparison of the respective marks, it seems to me that while the word VICTOR is a strong and distinctive element within the opponent's mark, the applicant's mark would not be readily or easily identified as that word, given the degree and unusual nature of the stylisation present. Bearing in mind that the average customer does not normally analyse the detail of a trade mark, it seems to me that the respective marks look different and are visually dissimilar.

22. In relation to the aural comparison of trade marks used in respect of articles of clothing, I agree with the view expressed by the Registrar's Hearing Officer in the matter opposition thereto by *Update Clothing Limited* under number 45787 (BL O/258/98) when he said:

"There is no evidence to support Ms Clarke'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”.

23. This view was supported on appeal to the Appointed Person (*REACT Trade Mark* [2000] 8 RPC 285 lines 22 to 26) and in the CFI decision *New Look v. OHIM* (mentioned earlier) at paragraph 50 which states:

“The applicant has not mentioned any particular conditions under which the goods are marketed. Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

24. The above views are, in addition to being appropriate to clothing, relevant to hats, shoes and the Class 18 goods, where purchasing considerations are similar.

25. While in aural use, I have no doubt that the opponent’s mark is likely to be orally described as “VICTOR”, it seems to me that the opponent’s mark acts primarily as a visual identifier given its highly stylised presentation. The mark in suit may well be spoken as “Victor” but given the nature of the goods and the presentation of the mark, likelihood of confusion does not follow, as oral use is likely to come after visual inspection e.g. in a shop or catalogue (with reference to a catalogue number).

26. Next, a conceptual comparison of the marks. The word VICTOR is a strong and distinctive element within the opponent’s mark and its obvious conceptual identity is apparent. However, as mentioned earlier in this decision, the mark applied for is presented in a highly stylised and unusual manner and this fact is likely to remain in the mind of the customer. Once the meaning of the applicant’s mark is deduced there is conceptual similarity. However, given the degree of stylisation present in the mark in suit, it does not follow that there is a likelihood of confusion.

27. In my considerations I must also consider the relevant customer for the goods, which, in these proceedings, are the public at large. The relevant goods are often necessities as well as being fashion items and are sold through a wide variety of outlets and at a wide range of prices. They are usually purchased with a good degree of care e.g. as to size, colour, appearance, function, and after a visual reference.

CONCLUSION

28. On a global appreciation taking into account all the relevant factors, I have come to the following conclusions:

- (i) the respective goods are identical and closely similar;
- (ii) the respective marks are visually dis-similar;

(iii) while there may be aural and conceptual similarity between the marks, the nature of the mark in suit and the nature of the goods at issue reduces the impact of such similarity in the global appreciation;

(iv) the customer for the goods is the public at large who normally purchase the goods on a visual basis with a relatively good degree of care.

29. Considering the position in its totality I believe there is no likelihood of confusion to the relevant public.

30. The opposition fails.

COSTS

31. The applicant is entitled to a contribution towards costs and I order the opponent to pay the applicant the sum of £550, which takes into account that no evidence was filed and no hearing took place in this case. 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 5th day of September 2005

JOHN MacGILLIVRAY
For the Registrar
the Comptroller-General