

O-247-04

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 2247557  
IN THE NAME OF HARJEET SINGH JOHAL**

**AND**

**IN THE MATTER OF  
OPPOSITION THERETO UNDER NO. 52622 IN THE NAME OF  
MICHAEL KORS, LLC**

**Trade Marks Act 1994  
In the matter of application No. 2247557  
in the name of Harjeet Singh Johal**

**And**

**In the matter of opposition thereto  
under No. 52622 in the name of  
Michael Kors, LLC**

**Background**

1. On 5 October 2000 Harjeet Singh Johal applied to register the trade mark KÖRE in Classes 25 and 35 in respect of the following specifications of goods and services:

**Class 25:** Articles of clothing; footwear; headgear.

**Class 35:** The bringing together, for the benefit of others, of a variety of goods, enabling customers conveniently to view and to purchase those goods from a clothing, footwear, headgear and accessories store; the bringing together, for the benefit of others, of a variety of goods, enabling customers conveniently to view and to purchase those goods from a clothing, footwear and headgear catalogue by mail order or by means of telecommunications; the bringing together, for the benefit of others, of a variety of goods, enabling customers conveniently to view and to purchase those goods from an Internet site specialising in clothing, footwear, headgear and accessories.

2. On 29 May 2001, Michael Kors, LLC filed notice of opposition based on the following grounds:

- 1. Under Section 5(2)(b)** in view of the similarity between the opponents= earlier trade marks and the identity or similarity of the respective goods and services,
- 2. Under Section 5(4)(a)** by virtue of the law of passing off,
- 3. Under Section 5(3)** insofar as any of the goods or services are held to be dissimilar to those for which the opponents= trade marks have been registered and used.

3. The earlier marks relied upon by the opponents are as follows:

<b>Number</b>	<b>Mark</b>	<b>Class(es)</b>	<b>Specification(s)</b>
1431776	MICHAEL KORS	3,9,14,18	<p>Fragrances, cosmetics, perfumery, toilet preparations, soaps, preparations for the hair; all included in Class 3.</p> <p>Sunglasses; spectacles; frames and cases, all for sunglasses and spectacles; parts and fittings for all the aforesaid goods; all included in Class 9.</p> <p>Jewellery, all included in Class 14.</p> <p>Articles of leather and/or imitation leather; handbags, luggage, travel goods; umbrellas; all included in Class 18.</p>
1406978	MICHAEL KORS	25	Articles of clothing for women and girls; all included in Class 25; but not including footwear.
2020744	KORS	25	Articles of outer clothing; articles of clothing for men and women; anoraks, aprons, ascots, babushkas, bandanas, bathing suits, bathrobes, belts, blazers, blouses, blousons, body suits, boleros, boots, boxer shorts, brassieres, briefs, baby buntings, kaftans, camisoles, capes, caps, cardigans, chemises, clogs, cloth diapers, fur coats, suit coats, top coats, coats, corselets, culottes, dresses, earmuffs, galoshes, garter belts, girdles, gloves, nightgowns, halter tops, hats, headbands, hosiery, jackets, jeans, jogging suits, jumpers, jumpsuits, kerchiefs, kimonos, leggings, leotards, loungewear, mittens, moccasins, mufflers, neckerchiefs, neckties, neckwear, negligees, nightshirts, overalls, overcoats, overshoes, pyjamas, panties, pants, pantsuits, pantyhose, parkas, pedalpushers, peignoirs, pinafores, playsuits, pocket squares, ponchos, pullovers, raincoats, sandals, scarves, shawls, shirts, shorts, undershirts, athletic shoes, gym shorts, sweatshorts, ski suits, slacks, snow suits, socks, sports coats, sports shirts, stockings, stoles, suits, suspenders, sweatpants, sweatshirts, sweaters, tee-shirts, trousers, tuxedos, underpants, vests, vested suits, warm-up suits, swimming suits; footwear.

4. The applicant filed a counterstatement in which he admits that the goods covered by Class 25 of the application and those covered by the opponents earlier marks, Nos 1406978 and 2020744 are identical, but denies the grounds on which the opposition is based.

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

6. Both sides filed evidence in these proceedings. Neither side took up the offer of being heard, although the opponents filed written submissions in lieu of a hearing. Taking the evidence and submissions into account I go on to make a decision on the issues alleged.

### **Opponents= evidence**

7. This consists of three Witness Statements from Stewart Penrose Hosford, a partner in the firm of trade mark attorneys, Marks & Clerk and the opponents=representatives in these proceedings, and an Affidavit from John Orchulli, Chief Executive Officer of Michael Kors (USA) Inc., the opponents.

8. The first of Mr Hosford=s Statements is dated 12 December 2002. Mr Hosford says that the opponents began selling clothing in the UK in 1985, clothing accessories in 2000, potentially after the relevant date, and fragrances in 2001 which is after the relevant date. He states that sales figures range from \$300,000 to \$400,000 in the years from 1995 to 1999, (which I take to be per annum), rising to \$800,000 in 2000 and \$1 million in 2001, although does not give a breakdown by goods. Mr Hosford mentions the opponents having an annual spend of around \$100,000 on advertising in various publications, some of which he mentions. Copies of advertisements are shown as exhibit SPH1. All relate to high-end clothes although none can be dated as having originated at, or prior to the relevant date. Mr Hosford describes the opponents=products as Adesigner@goods sold through high-class stores, primarily, although not exclusively in London.

9. Mr Hosford says that the opponents= goods enjoy a high profile and are regularly featured in fashion magazines such that a wide range of customers aspire to purchase such goods, and as a consequence, the reputation and goodwill attached to the trade mark extends beyond what might be implied by volumes of sales. Exhibit SPH2 consists of copies of various documentation relating to orders, none of which is dated, or can be dated as originating prior to the relevant date.

10. The second of Mr Hosford=s Statements is dated 10 February 2003. Mr Hosford refers to exhibit SPH3, which consists of a schedule provided by the Commercial Director of Harvey Nichols & Company Limited, providing details of their purchases of the opponents= clothing from the Spring/Summer 2001 to date, and exhibit SPH4, which consists of extracts from the Spring 2001 issue of Harvey Nichols magazine which featured an article on the re-launch of the opponents= clothing within that store. Mr Hosford acknowledges that much (in fact all) of these exhibits post date the relevant date, stating that they are indicative of, and provide some historical data with regard to the opponents= commercial activities and reputation. Mr Hosford=s final statement is dated 13 February 2004, and at exhibit SPH5 introduces a list of applications and

registrations for the trade mark KORS and MICHAEL KORS owned by the opponents.

11. The Witness Statement of John Orchulli is dated 14 February 2003. Mr Orchulli refers to the UK trade mark registrations relied upon in the grounds of opposition, details of which he shows as exhibit MK1. Exhibit MK2 consists of samples of swing-tags and sew-in labels showing how the applicant uses the mark. Two bear the name MICHAEL KORS, one has the word KORS in red with MICHAEL KORS shown alongside in a smaller font.

12. Mr Orchulli gives details of his company's use and promotion of the mark, and sales achieved, all of which concur with the information given by Mr Hosford. Exhibit MK3 consists of copies of advertisements that have been published in magazines available within the UK, none of which can be seen to have been in circulation prior to the relevant date. Exhibit MK4 consists of undated plans and photographs of the Michael Kors shop established within Harvey Nichols. Mr Orchulli refers to exhibit MK5 which is all but identical to exhibits SPH3 and SPH4 referred to above. The one additional piece of relevant evidence contained within the exhibit is a list detailing purchases of MICHAEL KORS and KORS branded goods at Harvey Nichols, which shows an average of 200-300 items being sold each season.

13. Mr Orchulli restates that his company trades in high quality expensive designer clothes and accessories that are sold through exclusive stores. He concludes his Statement by giving his views on the likelihood of the mark applied for being confused with his company's mark KORS.

#### **Applicant's evidence**

14. This consists of a Witness Statement by David George Minto, a partner in the firm of Eric Potter & Clarkson, the applicant's representatives in these proceedings. Much of Mr Minto's statement consists of submissions on the merits of the case and the evidence filed. Whilst I have not included much of this in my summary, I will take it fully into account in my decision.

15. Mr Minto states that the mark applied for is KÖRE with an umlaut, and not KORE as referred to by the opponents. He asserts that the umlaut over the letter O enhances the distinctive and singular character of the word and is a feature of the mark which provides a clear differentiation from other trade marks giving it a Germanic or Nordic character. Mr Minto says that the evidence shows that the opponents evidently use the name KORS in conjunction with MICHAEL KORS. Mr Minto refers to the opponents' turnover and promotional expenditure figures, taking the view that these do not suggest that the opponents' business is particularly substantial.

#### **Opponents' evidence in reply**

16. This consists of a Witness Statement dated 29 December 2003, from Stewart Penrose Hosford. All of Mr Hosford's Statement consists of comments on the claims made by Mr Minto in his Statement. As such I do not consider it necessary or appropriate to summarise its contents, but will take the submissions into account in my determination of this case.

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

## Decision

17. I turn first to consider the ground under Section 5(2)(b). That section reads as follows:

**A5.-**(2) A trade mark shall not be registered if because **B**

(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. @

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

**A6.-** (1) In this Act an **A**earlier trade mark @ means **B**

(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, @

19. 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* [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 & 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*,

- (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) 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*,
- (i) 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*.

20. Although the opponents rely on three earlier marks, I propose to conduct my analysis on the basis of mark No. 2020744 for the trade mark KORS. This, in my view is the closest of the opponents' marks and in my mind undoubtedly covers goods identical to the entirety of the goods of the application, and similar to all of the services. If they do not succeed in respect of this earlier mark, they will be in no better position in respect of the remaining two.

21. The easiest matter to determine is the question of the respective goods and services. To me it is self-evident that the goods covered by the application are identical, and the services similar to the goods for which the opponents' earlier mark is registered. Although the opponents make reference to their goods as being high-end designer clothing, this is not reflected in the specification which covers clothing at large. The applicants' goods and services are not limited in any way, so notionally at least, the respective marks must be considered to share the same channels of trade and end consumer. I would add that even if the opponents' specification had been limited to reflect the nature of their trade, this would not have made any difference; high-end fashion can, and is bought by the general consumer.

22. Whilst marks should be compared as a whole, it is inevitable that in any comparison reference

will be made to the various constituent parts of which marks are composed, and rightly so where there is a particularly distinctive or dominant element, although that is clearly not the case here. The mark also has to be considered in relation to the goods and services for which it is, or is intended to be used, in this case clothing and retailing of such goods. In the *React* trade mark case [2000] RPC 285, Mr Simon Thorley QC, sitting as the Appointed Person considered the question of the importance of the eye and the ear in the selection of clothing. Mr Thorley said:

There is no evidence to support [Counsel's] submissions that, in the absence of any particular reputation, consumers select clothes by the 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 that 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. Whilst *React* indicates that in a case such as this it is the visual similarity of the respective marks that is of primary importance, it does not say that I should give no weight to the question of aural and/or conceptual similarity.

24. The mark applied for is KÖRE; the opponent's mark is KORS. Ignoring for the moment that the mark applied for has an umlaut over the letter O, both are constructed from a single syllable formed by the letters KOR, with one terminal letter, albeit different. If only to that extent the marks must have a degree of visual and aural similarity.

25. I would say that other than to linguists, the umlaut is likely to make little if any difference to the pronunciation, which I would take to be as CORE (KORE) and CORES (KORS). The terminal letters are both soft in their sound, and in the case of the applicant's mark would have limited impact, on the manner in which the word sounds when spoken, almost passing unnoticed. The terminal S in KORS has a more significant effect on the pronunciation and being such a short word, will invariably be articulated. I accept that if used in a pluralised or possessive form the marks are closer in sound.

26. The umlaut does have an impact on the visual similarity of the respective marks, and more significantly, so do the terminal letters. The umlaut could affect the conceptual message conveyed by the applicant's mark, which even to non-linguists is likely to be that it is a foreign word, albeit probably of some indeterminate meaning. However, as KORE and KORS are not, as far as I am aware, common English words, with or without the umlaut both marks have the potential to create the same conceptual impression in the mind of the consumer.

27. The respective marks are both short words, where small changes have a disproportionate effect. Whilst the marks have similarities, taking all factors into account I come to view that they

are not similar.

28. As far as I am aware, the word KORS is not an ordinary English word and has no relevance for clothing, and must therefore be considered to be possessing of a strong distinctive character. The opponents claim to a reputation is disputed by the applicant, who point to the size of the turnover figures, and the limited number of outlets at which they have made available goods to the public. The opponents rely on the fact that their clothing is not mass-market, but high-end designer fashion that sells in low volumes through more exclusive outlets, and consequently, the figures are more significant than at first sight. Although the evidence leaves something to be desired, I am content that it shows the opponents to have established a reputation as a designer label. However, neither their nor the applicant's specification of goods is limited to that sector, and I must therefore consider the use in relation to the clothing market at large, and the general public in particular. The applicant also questions the mark that the opponents have used, saying that they have not used KORS on its own, only in conjunction with, or in the form of MICHAEL KORS. Whilst there is a small amount of evidence showing use of KORS on its own, I believe it is clear that the use is primarily as the applicant contends. Taking all this into account, I come to the view that the opponents are not in a position to claim that the mark has become any more distinctive and warranting a greater degree of protection by virtue of the use they have made of it.

29. Taking all of the above into account and adopting the global view advocated, I find that there is no likelihood that the public will be wrongly led into believing that goods bearing the mark applied for come from the opponents or some economically linked undertakings, and that there is no likelihood of confusion. The opposition fails on the section 5(2)(b) ground.

30. Turning to 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,

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.

31. Mr Geoffrey Hobbs QC, sitting as the Appointed Person set out a summary of the elements of an action for passing off in his decision in the *WILD CHILD* Trade Mark case [1998] RPC 455. Mr Hobbs summarised the requirements as follows:

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

- (b) that there is a misrepresentation by the defendant (whether or not intentional leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and
- (c) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

32. The opponents say that they began selling clothing in the UK in 1985, although not whether this was under KORS or MICHAEL KORS, and provide nothing in the way of evidence to substantiate this. This trade extended into clothing accessories and fragrances, although not clearly prior to the relevant date. Both Mr Hosford and Mr Orchulli place the opponents' business in the designer fashion bracket,. This is a small part of the clothing industry, but as I have no evidence by which to put their trade into context in respect of that market, let alone in relation to the industry as a whole, I do not really know how significant or otherwise their trade has been. Whilst the evidence leaves something to be desired, I am reasonably satisfied that there has been a trade likely to have established a goodwill and reputation in the names KORS/MICHAEL KORS in relation to designer clothing.

33. That the opponents have goodwill is but part of the consideration; that goodwill must subsist in a sign that is at least similar to the sign tendered for registration, for if it is not, there cannot be a misrepresentation likely to mislead the public. As I have already said above, in my view the marks (or signs) are not similar, and I am therefore unable to see how the opponent will suffer damage as a result of the applicant's use of KÖRE. In my view the fact that the opponents are a designer label reduces the likelihood of the public being misled. Purchasers of such clothing are well informed and circumspect in their buying. I therefore find that the opposition fails in respect of Section 5(4)(a).

34. This leaves the objection founded 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, and

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, 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.@

35. I have already determined that the opponents' mark is neither the same, or similar to the mark applied for, so this ground of opposition must fall at the first hurdle. There is also the matter that I have already found the respective goods and services to be the same and/or similar; the attack is based on them being dissimilar. Whilst I have accepted that the opponents are likely to have a reputation in their marks, this was not sufficient to compensate for the differences in the

respective marks in relation to identical and/or similar goods and services. I do not, therefore see that they can be in any better a position in respect of dissimilar goods and services, and have no hesitation in dismissing the ground under Section 5(3).

36. The opposition having failed on all grounds, I order the opponents to pay the applicant the sum of , 1,250 as a contribution towards his costs. This sum 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 12<sup>th</sup> day of August 2004**

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