

O-272-04

TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION No 2313032  
BY CF COLLECTIONS LIMITED  
TO REGISTER THE TRADE MARK  
**KO BOXER**  
IN CLASS 25

AND IN THE MATTER OF OPPOSITION THERETO  
UNDER NUMBER 91559  
BY JOE BOXER COMPANY LLC

## BACKGROUND

1) On 12 October 2002, CF Collections Limited of 433 Rayners Lane, Pinner, Middlesex, HA5 5ER applied under the Trade Marks Act 1994 for registration of the trade mark KO BOXER. The specification was subsequently amended to “Mens underwear”.

2) On 11 March 2003 Joe Boxer Company LLC of 1599 Post Road East, Westport, Connecticut 06880, United States of America filed notice of opposition to the application. The grounds of opposition are in summary:

a) The opponent is the proprietor of the following Trade Marks:

Mark	Number	Effective Date	Class	Specification
	UK 1409857	05.01.90	25	Articles of underclothing; socks; all included in Class 25; but not including babies' napkins, clothing to be worn for boxing or shorts.
JOE BOXER	UK 1519012	17.11.92	25	Articles of underclothing; socks; all included in Class 25; but not including shorts or clothing to be worn for boxing.
JOE BOXER	CTM 1146224	20.04.99	3	Colognes, fragrances, lotions, soaps, bath salts, nail polish and hair products, colours.
			9	Sunglasses, optical frames and telephones.
			24	Bed sheets, pillow cases, bed spreads, pillow shams, draperies, curtains, duvets, towels and fabric shower curtains.
JOE BOXER	CTM 1491919	04.02.00	14	Jewellery, including jewellery made of precious and non-precious metals; watches and clocks.
			18	Carrying cases, bags, luggage, suitcases; umbrellas; handbags, purses; belts and wallets.
			25	Clothing, footwear, headgear.
JOE BOXER	CTM 1530450	28.02.00	16	Paper and paper articles including paper patterns for making clothing; printed matter, publications, books, notebooks, agenda and address books; writing and drawing instruments and articles, stationery not included in other classes.
			27	Rugs and carpets.
			35	Operation of a retail store selling clothing, headgear, footwear, sunglasses, toilet preparations, perfumery and cosmetics, watches and jewellery, paper goods, furniture, home furnishings, toys and sporting goods; retail store services relating to clothing, headgear, footwear, sunglasses, toilet preparations, perfumery and cosmetics, watches and jewellery, paper goods, furniture, home furnishings, toys and sporting goods; retail store services, namely, the bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling consumers to conveniently view and purchase those goods.

b) The opponent has conducted business in the UK under these marks since 1990 and enjoys a substantial reputation. Therefore, the application offends against Sections 5(2)(b) & 5(4)(a) of the Trade Marks Act 1994.

3) The applicant subsequently filed a counterstatement in which they accepted that the opponent's goods in Class 25 were identical but denied the opponent's other claims.

4) Only the opponent filed evidence, both sides ask for an award of costs. Neither side wished to be heard although the opponent provided written submissions. I shall refer to their submissions as and when relevant in my decision.

#### OPPONENT'S EVIDENCE

5) The opponent filed a witness statement, dated 19 May 2004, by Colette Sipperly the Vice President, Public Relations of the opponent company. She states that the opponent has conducted business in the UK since 1990 and that as a consequence enjoys a reputation in the name JOE BOXER in the UK. Ms Sipperly states that sales of Joe Boxer products in the UK were "substantial" during the 1990s and that during the year 2001-2002 sales in the UK were in excess of \$1,000,000.

6) Ms Sipperly states that the name JOE BOXER is applied "in various forms to most if not all of my company's products". She supplies copies of tags attached to products and also a photograph of a waistband which shows the name JOE BOXER printed all the way round it. Also provided as part of the exhibits are examples of notepaper and envelopes which also show use of the name JOE BOXER.

7) Ms Sipperly states that underwear, particularly men's underwear, constitutes a very significant proportion of the opponent's product range. As part of the exhibits are materials relating to a launch of the range by a new licensee in Debenhams stores.

#### DECISION

8) The first ground of opposition is under Section 5(2)(b) which reads:

"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."

9) An "earlier trade mark" is defined in Section 6, the relevant parts of which 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,”

10) The opponent is relying on five UK and Community Trade Marks all of which were registered with effect before the application in suit was filed on 12 October 2002, and they are all plainly “earlier trade marks”.

11) In determining the question under this section, 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-Meyer 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 & 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-Meyer 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-Meyer Inc.*.

12) In essence the test under Section 5(2) is whether there are similarities in marks and goods and/or services which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgements 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 and/or services, the category of goods and/or services in question and how they are marketed. Furthermore, I must compare the mark applied for and the opponent's registration on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods and services covered within the respective specifications.

13) Clearly, the opponent's strongest case is under UK Trade Mark 1519012 and CTM 1491919 both for the plain word mark JOE BOXER and both registered for goods which the applicant accepts are identical to those of the mark in suit.

14) The opponent has claimed that it has a substantial reputation in the UK. However, it has provided sales figures for only one year and this amounted only to US\$1million for their range of products. However, their marks are registered for, inter alia, all items of clothing, footwear, bedding, sunglasses, colognes and fragrances, jewellery, luggage, stationery, carpets and retail services. In this context the sales must be regarded as, at best, average. The opponent cannot benefit from an enhanced reputation.

15) I must also consider the inherent distinctiveness of the opponent's marks. Clearly when used on men's underwear it could be seen as an allusion to boxer shorts, but it is more likely to be seen as a name and therefore must be regarded as being inherently distinctive.

16) I now turn to consider the marks of the two parties KO BOXER and JOE BOXER. There are obvious visual and phonetic similarities and differences. The opponent claims that:

“When pronounced, the elements KO and JOE rhyme, and notwithstanding the different initial consonants, when spoken before “BOXER” as this word appears in both marks, the two marks as a whole sound similar”, and;

“Even if the letters of the acronym were pronounced, there is still in the Opponent's submission a potential for confusion between “kay-oh boxer” and the Opponent's mark JOE BOXER, when used in conversation.”

17) Whilst I accept that the beginnings of the two marks, “KO” and “JOE” could be said to rhyme, I believe that the average consumer would view the start of the mark in suit as a clear reference to the acronym for “knock out” which is frequently used in

boxing. Therefore, rather than viewing the start of the mark in suit as a word which would be pronounced “co”, the average consumer would, in my opinion, see and pronounce the first part of the mark in suit as the two letters “K” and “O”. There is still a degree, albeit lessened, of rhythmical similarity.

18) Conceptually, to my mind the opponent’s mark will be seen as a “name”, which, when applied to men’s underwear, has an allusive character. The mark in suit will, in my opinion, be viewed as a clear reference to pugilism. Applied to similar goods there is still an allusive nature but it actually reinforces the sporting theme. Overall I believe that the differences outweigh any similarities.

19) Items of clothing, even underwear, are not, I would suggest, chosen without some consideration. The average consumer of such products would, in my opinion, exercise some care in the selection. In *REACT* [1999] 15 RPC 529 the Hearing Officer held the following:

“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.”

20) Taking account of all of the above when considering the marks globally, I do not believe that there is a likelihood of consumers being confused into believing that the goods provided by the applicant are those of the opponent or provided by some undertaking linked to them, even allowing for the concept of imperfect recollection. The opposition under Section 5(2)(b) therefore fails.

21) I have already found that the opponent had reputation and goodwill in its trade marks used as the basis of this opposition but concluded that this was not enough to result in a likelihood of confusion under Section 5(2)(b). It seems to me that the necessary misrepresentation required by the tort of passing off would not occur here, either. The ground of opposition under Section 5(4)(a) therefore fails.

22) The opposition having failed I order the opponent to pay the applicant the sum of £750. 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 3<sup>rd</sup> day of September 2004

George W Salthouse  
For the Registrar,  
the Comptroller-General