

O-279-18

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No. 3228253

BY COMBATE BJJ LIMITED

TO REGISTER THE TRADE MARK

COMBATE

IN CLASSES 9, 16, 25, 28 & 41

AND

IN THE MATTER OF OPPOSITION

THERE TO UNDER No. 409930 BY

BASIC TRADEMARK S.A.

BACKGROUND

1) On 2 May 2017, Combate BJJ Limited (hereinafter the applicant) applied to register the trade mark COMBATE in respect of the following goods and services:

Class 9: Prerecorded fitness DVDs; Prerecorded exercise DVDs; Digital recording media; Digital data recording media; Teaching and instructional apparatus.

Class 16: Instructional and teaching material (except apparatus); Instructional material (except apparatus); Instructional and teaching materials; Instructional manuals for teaching purposes; Manuals for instructional purposes; Instructional manuals; Printed matter for instructional purposes.

Class 25: Clothing; Martial arts uniforms; Clothing for martial arts; Gymwear.

Class 28: Martial arts training equipment; Gymnastic and sporting articles.

Class 41: Instruction in martial arts; Training in martial arts; Martial arts instruction; Operating of martial arts' schools; Conducting fitness classes; Conducting physical fitness conditioning classes; Provision of gymnasium facilities; Gymnasium facilities (Provision of -); Providing health club and gymnasium services; Gymnasium services; Conducting of instructional seminars; Conducting instructional courses; Publication of instructional literature; Publishing of instructional books; Instructional and training services; Boxing instruction; Judo instruction.

2) The application was examined and accepted, and subsequently published for opposition purposes on 12 May 2017 in Trade Marks Journal No.2017/019.

3) On 2 August 2017 Basic Trademarks S.A.(hereinafter the opponent) filed a notice of opposition, subsequently amended. The opponent is the proprietor of the following trade mark:

Mark	Number	Dates of filing and registration	Class	Specification relied upon
KOMBAT	M 1158057	Date of protection of the international registration in UK 24.10.13	25	Technical apparel for the practice of sports, namely, shirts, team and competition jerseys and team and

		International registration date 28.02.13		competition uniforms, polo shirts, tracksuits, warm-up suits, shorts, pants, socks, tights; underwear, namely, underpants, long underpants, tank tops, long and short sleeve undershirts.
		Designation date 28.02.13		
		Office of origin: Italy	28	Skis; protective padding for the practice of sports, namely, shin guards, knee pads, elbow pads; gloves for sports, namely, for football, soccer, hockey, rugby and golf.

a) The opponent contends that the mark applied for and its mark are similar and the respective goods and services are also identical and/or similar. As such it contends that the application offends against Section 5(2)(b) of the Trade Marks Act 1994. The opposition originally included grounds under section 5(3) and 5(4)(a) but these were withdrawn by the opponent on 11 December 2017.

4) On 5 October 2017 the applicant filed a counterstatement, subsequently amended, which basically denied all the grounds pleaded. The applicant points out that its mark is the Portuguese word for “fight”, but that the average English consumer would not be aware of this and would pronounce the word differently to the opponent’s mark. The applicant put the opponent to Proof Of Use.

5) Both parties seek an award of costs in their favour. Neither party filed evidence. The matter came to be heard on 26 April 2018 when Mr Morgan of Messrs Beck Greener represented the opponent; the applicant was represented by Mr Zuridis, a Director of the company.

DECISION

6) The only 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.”

7) An “earlier trade mark” is defined in section 6, the relevant part of which states:

“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.”

8) The opponent is relying upon its trade mark listed in paragraph 3 above which is clearly an earlier filed trade mark. Although the opponent sought Proof of Use (pou), the interplay between the date of the instant mark being published and the opponent’s mark being registered mean that the pou requirements do not bite as at the point of the instant mark being advertised the opponent’s mark had not been registered for five years. The opponent is therefore able to rely on the specification of the earlier mark without having to show genuine use.

9) When considering the issue under section 5(2)(b) I take into account the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, 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, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) 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;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

The average consumer and the nature of the purchasing process

10) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods/services. I must then determine the manner in which these goods/services are likely to be selected by the average consumer in the course of trade.

11) I shall first consider the goods at class 25 which are, broadly speaking, clothing. The average consumer for such goods will be the public at large. Such goods will typically be offered for sale in retail outlets, in brochures and catalogues as well as on the internet. The initial selection is therefore primarily visual. I accept that some, probably more expensive, items of clothing may, for example, be researched or discussed with a member of staff or be made to measure. The latter, along with personal recommendations, bring aural considerations into play. I note that in *New Look Ltd v OHIM* Cases T-117/03 to T-119/03 and T-171/03, the General Court (GC) said this about the selection of clothing:

“50. 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.”

12) In the same case the Court also commented upon the degree of care the average consumer will take when selecting clothing. It said:

“43. It should be noted in this regard that the average consumer's level of attention may vary according to the category of goods or services in question (see, by analogy, Case C 342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26). As OHIM rightly pointed out, an applicant cannot simply assert that in a particular sector the consumer is particularly attentive to trade marks without supporting that claim with facts or evidence. As regards the clothing sector, the Court finds it comprises goods which vary widely in quality and price. Whilst it is possible

that the consumer is more attentive to the choice of mark where he or she buys a particularly expensive item of clothing, such an approach on the part of the consumer cannot be presumed without evidence with regard to all goods in that sector. It follows that that argument must be rejected.”

13) Clearly, the average consumer’s level of attention will vary considerably depending on the cost and nature of the item at issue. However, to my mind even when selecting routine inexpensive items of clothing such as socks the average consumer will pay attention to considerations such as size, colour, fabric and cost. **Overall the average consumer for these types of goods is likely to pay an average degree of attention to the selection of items of clothing.**

14) Turning to the goods in classes 9, 16, 28 and services in class 41 these are all, broadly, concerned with sporting equipment, teaching materials of all descriptions and actual instruction. The average consumer will be the general public, including businesses who sell such goods and services possibly as a franchise. To my mind, considerable care will be taken by the consumer to ensure that they get the right product/service which meets their needs and requirements. Equipment and teaching aids vary enormously in cost and complexity and if the equipment is to be worn the size, materials etc. will be given careful consideration, as will the whole area of teaching aids/instruction, as there are usually different levels depending upon how serious the consumer is on mastering a given sport/activity, and the whole issue of whether the aids/teachers are recognised by a relevant body. **Overall the average consumer for these types of goods and services is likely to pay at least an average degree of attention to the selection of such items.**

Comparison of goods and services

15) When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*, the CJEU stated at paragraph 23 of its judgement:

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

16) Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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 are 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 trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

17) In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question”.

18) In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) OHIM*) case T-133/05, the General Court (“GC”) stated:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T110/01 Vedral V OHIM France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

19) The specifications of both sides are reproduced below for ease of reference:

Opponent’s goods	Applicant’s goods and services
<p>Class 25: Technical apparel for the practice of sports, namely, shirts, team and competition jerseys and team and competition uniforms, polo shirts, tracksuits, warm-up suits, shorts, pants, socks, tights; underwear, namely, underpants, long underpants, tank tops, long and short sleeve undershirts.</p> <p>Class 28: Skis; protective padding for the practice of sports, namely, shin guards, knee pads, elbow pads; gloves for sports, namely, for football, soccer, hockey, rugby and golf.</p>	<p>Class 9: Prerecorded fitness DVDs; Prerecorded exercise DVDs; Digital recording media; Digital data recording media; Teaching and instructional apparatus.</p> <p>Class 16: Instructional and teaching material (except apparatus); Instructional material (except apparatus); Instructional and teaching materials; Instructional manuals for teaching purposes; Manuals for instructional purposes; Instructional manuals; Printed matter for instructional purposes.</p> <p>Class 25: Clothing; Martial arts uniforms; Clothing for martial arts; Gymwear.</p> <p>Class 28: Martial arts training equipment; Gymnastic and sporting articles.</p> <p>Class 41: Instruction in martial arts; Training in martial arts; Martial arts instruction; Operating of martial arts' schools; Conducting fitness classes; Conducting physical fitness conditioning classes; Provision of gymnasium facilities; Gymnasium facilities (Provision of -); Providing health club and gymnasium services; Gymnasium services; Conducting of instructional seminars; Conducting instructional courses; Publication of instructional literature;</p>

	Publishing of instructional books; Instructional and training services; Boxing instruction; Judo instruction.
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20) I take into account comments in *Commercy AG, v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-316/07, where the GC pointed out that:

“43. Consequently, for the purposes of applying Article 8(1)(b) of Regulation No 40/94, it is still necessary, even where the two marks are identical, to adduce evidence of similarity between the goods or services covered by them (see, to that effect, order of 9 March 2007 in Case C-196/06 P *Alecansan v OHIM*, not published in the ECR, paragraph 24; and Case T-150/04 *Mülhens v OHIM – Minoronzoni(TOSCA BLU)* [2007] ECR II-2353, paragraph 27).”

21) Thus where the similarity between the respective goods or services is not self-evident, the opponent must show how, and in which respects, they are similar. The opponent did not provide evidence regarding similarity. I shall first consider the class 25 goods of the two parties where, to my mind, it is clear that the term “Technical apparel for the practice of sports, namely, team and competition uniforms” included in the opponent’s specification would encompass the following goods in the mark applied for: “Martial arts uniforms; Clothing for martial arts; Gymwear”. I note that in its counterstatement the applicant accepted that there is a degree of similarity in the class 25 goods.

These must be regarded as identical.

22) This leaves the term “clothing” in the specification applied for by the applicant. The opponent’s specification consists of items of clothing, which can be worn either to indulge or participate in a sports activity or for leisure wear such as team jerseys, polo shirts, warm-up suits, shorts, socks and the various items of underwear listed in the opponent’s specification. I take note that sportswear is frequently used as leisure wear, and that most manufacturers of sportswear also produce leisure wear clothing. **I therefore regard the applicant’s class 25 goods to be identical to the class 25 goods of the opponent.**

23) Next, I turn to consider the goods of both parties in class 28. The applicant seeks to register its mark for “Martial arts training equipment; Gymnastic and sporting articles” whereas the opponent’s mark is registered for “protective padding for the practice of sports, namely, shin guards, knee pads, elbow pads”. To my mind, the opponent’s specification is wholly encompassed within that of the applicant **and so the goods in class 28 must be regarded as identical.**

24) I now turn to the remaining goods and services applied for in classes 9, 16 & 41. These are not obviously similar to the opponent's goods, and as noted earlier, no evidence regarding trade channels etc. has been filed. However, at the hearing the opponent contended that some of the goods and services were similar and/or complementary. These and the contentions attached are set out below:

Class	Goods/services	reasons
9	Pre-recorded fitness DVDs; pre-recorded exercise DVDs	Relate to sport, fitness and health; have the same users/uses as all of the Opponent's Goods; sold through the same trade channels; complementary.
9	Digital recording media; digital data recording media	may reasonably contain exercise, fitness or sporting content, hence are similar to the Opponent's Goods also for the same reasons given above.
9	Teaching and instructional apparatus	teaching and instructional apparatus relating to sport ; these have the same users as the Opponent's Goods, and will often be sold through the same trade channels. The purposes are also similar in that they facilitate the public in engaging in sport. Further, they are complementary.
16	All of the goods	variations on instructional and teaching material. They manifestly include instructional and teaching material relating to sport. These have the same users as the Opponent's Goods, and will often be sold through the same trading channels. The purposes are also similar and they are complementary.
41	All services	<p>These are in essence:</p> <ul style="list-style-type: none"> a) instruction or training services relating to specific sports, b) provision of facilities for gymnastic activities, or c) publication services relating to instructional material (which is not confined to any particular area, and so necessarily also encapsulates publication of instructional material relating to sport). <p>The users of such services and the users of the Opponent's Goods will be the same people. Further, the channels of trade are often identical; Complementary.</p>

25) Given that the average consumer has been identified as the general public, the fact that the users may be the same does not add much to the opponent's argument as almost any good or service could be said to have the same user i.e. baked beans and hats but that does not make them similar. The opponent has not provided any evidence regarding trade channels, although I accept that some sports shops may sell fitness videos and printed material. However, simply purchasing sports clothing does not make one sporting or even inclined towards fitness. If one takes football as an example, millions of football shirts are sold by sports shops each year to people who, judging from their appearance have no interest in fitness or playing football. They are simply fans who go along to the matches wearing their teams' colours and eat pies. Similar arguments undermine all of the opponent's claims regarding the other goods and services, in particular the uses and physical natures are very different from the opponent's, broadly speaking, clothing and sports equipment.

26) As to whether they could be considered complementary, in *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that "complementary" means:

"...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking".

27) In *Sanco SA v OHIM*, Case T-249/11, the General Court indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

"It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes."

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

28) The applicant's goods and services under consideration are, broadly, digital and printed matter in classes 9 & 16 and instructional services in class 41. Whilst these may be in relation to sporting activities there is not a close connection with clothing (albeit sports clothing) and sports equipment. Companies such as Adidas, Puma, Nike etc. dominate in the sports clothing and equipment marketing and no-one would expect them to also provide actual personal instruction in classes. No evidence was provided regarding whether such companies engage in providing training material. At the hearing the opponent contended that gyms sold clothing with their own branding, but I do not believe that the purchasers of such clothing would expect the gym to have manufactured the product. These types of items would come from proper qualified exponents of the particular sport not a clothing or equipment manufacturer.

29) To my mind, there is no similarity between the opponent's goods in classes 25 & 28 and those of the applicant in classes 9 and 16, in terms of use, physical nature or trade channels. They cannot be said to be in competition with each other or indeed complementary. The same is equally true of the applicant's services in class 41. **The applicant's specification in classes 9, 16 & 41 are not similar to the opponent's goods in classes 25 & 28.**

Comparison of trade marks

30) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of

the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

31) The marks of the two parties are KOMBAT (opponent) and COMBATE (applicant). The marks of the two parties differ in their initial letter, although the substitution of letters “C” and “K” is hardly novel, the applicant’s mark also has an additional letter (“E”) at the end. The marks are identical in terms of letters 2-6 of each mark. The applicant drew my attention to the first letter difference pointing out that this was highly significant. In *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the General Court noted that the beginnings of word tend to have more visual and aural impact than the ends. The court stated:

“81. It is clear that visually the similarities between the word marks MUNDICOLOR and the mark applied for, MUNDICOR, are very pronounced. As was pointed out by the Board of Appeal, the only visual difference between the signs is in the additional letters ‘lo’ which characterise the earlier marks and which are, however, preceded in those marks by six letters placed in the same position as in the mark MUNDICOR and followed by the letter ‘r’, which is also the final letter of the mark applied for. Given that, as the Opposition Division and the Board of Appeal rightly held, the consumer normally attaches more importance to the first part of words, the presence of the same root ‘mundico’ in the opposing signs gives rise to a strong visual similarity, which is, moreover, reinforced by the presence of the letter ‘r’ at the end of the two signs. Given those similarities, the applicant’s argument based on the difference in length of the opposing signs is insufficient to dispel the existence of a strong visual similarity.

82. As regards aural characteristics, it should be noted first that all eight letters of the mark MUNDICOR are included in the MUNDICOLOR marks.

83. Second, the first two syllables of the opposing signs forming the prefix ‘mundi’ are the same. In that respect, it should again be emphasised that the attention of the consumer is usually directed to the beginning of the word. Those features make the sound very similar.”

32) Whilst the first letter is important, I accept that the letter “C” is often replaced by a letter “K” deliberately, and whilst it would not go unnoticed it would not be seen as being that unusual by the average consumer. Visually there are differences but also similarities such that the marks are similar

to a low to medium degree. At the hearing the applicant accepted that there was at least a low degree of visual similarity. Phonetically, the beginnings of the marks (KOM and COM) are identical. The second syllable alters from BAT to BAIT. The marks are phonetically similar to a low to medium degree. At the hearing the applicant contended that what he referred to as speakers of European languages would be more likely to refer to the mark as COM-BAT-EH as though the letter “e” had an accent. To my mind this would make the marks even more similar phonetically. In terms of conceptual meaning, despite the deliberate misspelling the opponent’s word will be seen as meaning COMBAT as in fighting. The applicant claims that its mark is the Portuguese word for fighting. There will, I accept, be a number of UK residents who speak Portuguese either because they have visited one of the numerous countries which use Portuguese (Brazil and a number of African countries), or have migrated from these areas to the UK, but no evidence was provided as to what proportion of the population they represent. Others will simply look at the applicant’s mark, recognise a word they know, and miss the last letter completely. At the least the marks must be regarded as having a low degree of conceptual similarity. **Overall, the marks are similar at least to a low to medium degree.**

Distinctive character of the earlier trade mark

33) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and

industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

34) The word “KOMBAT” has no meaning for either the class 25 or 28 goods, as whilst they include sports which involve fighting (martial arts & boxing spring to mind) other sports such as football and rugby are not supposed to involve actual fighting, despite such terms frequently being used to describe aspects of play (defence, attack etc.). The opponent has not filed any evidence of use. **I find that the opponent’s mark has an average degree of distinctiveness but cannot benefit from enhanced distinctiveness through use.**

Likelihood of confusion

35) In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent’s trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision, I concluded that:

- the average consumer is a member of the general public (including businesses), who will select the goods and services by predominantly visual means, although not discounting aural considerations and that they will pay at least an average degree of attention to the selection of such goods and services;
- the opponent’s marks have an average degree of inherent distinctiveness, but cannot benefit from an enhanced distinctiveness through use;
- The marks are similar to at least a low to medium degree;
- The class 25 and 28 goods of the two parties are identical. However, the applicant’s goods and services in classes 9, 16 & 41 are not similar to the opponent’s goods in classes 25 & 28;

36) I take into account the comments in *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, where Lady Justice Arden stated that:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

37) In view of the comments in paragraph 30 above, there is no likelihood of consumers being confused into believing that any of the class 9 and 16 goods or class 41 services applied for under the mark in suit and provided by the applicant are those of the opponent or provided by some undertaking linked to it. **The opposition under Section 5(2) (b) in respect of these goods and services fails.**

38) However, in respect of the goods in classes 25 and 28 which are identical I can easily conceive of a situation where the average consumer is selecting the goods (primarily visually) and notes the difference in the initial letters “K” and “C” but ignores it as merely a marketing gimmick whereby well-known words are deliberately misspelled in a forlorn effort to make them “new”. They will view the applicant’s mark which may be on an angle to their view and assume, as indeed at first glance did I, that it is the word COMBAT and simply miss the final letter “E”. Taking all of the above conclusions into account and allowing for the concept of imperfect recollection there is a likelihood of consumers being confused into believing that the applicant’s goods are those of the opponent or provided by some undertaking linked to it. The ground of opposition under section 5(2)(b) succeeds in relation to the goods in classes 25 and 28.

CONCLUSION

39) The opposition under Section 5(2)(b) was successful in relation to all the goods and services sought to be registered in classes 25 & 28.

40) The opposition under Section 5(2)(b) failed in relation to all the goods and services sought to be registered in classes 9, 16 and 41 and so the mark can continue to registration for these goods and services.

COSTS

41) At the hearing the opponent requested that the decision be issued and costs dealt with in later submissions. The reasoning behind this request was said to relate to “without prejudice” correspondence that was, fortunately, only obliquely referred to by Mr Morgan. The applicant resisted this line of action claiming that nothing had been agreed prior to the hearing and that the matter should be dealt with in the normal manner. In the circumstances I decided not to agree to the opponent’s request. As both sides have achieved a measure of success I do not propose to favour either side with an award of costs.

Dated this 11th day of May 2018

**George W Salthouse
For the Registrar,
the Comptroller-General**