

# TRADE MARKS ACT 1994

IN THE MATTER OF  
APPLICATION NO. 2041474  
BY MUSTANG - BEKLEIDUNGSWERKE GMBH & CO  
TO REGISTER A TRADE MARK  
IN CLASSES 9, 18 AND 25

## DECISION AND GROUNDS OF DECISION

On 17 October 1995 Mustang - Bekleidungswerke GMBH & Co of Austrasse 10, 74653 Kunzelsau, Germany applied under the Trade Marks Act 1994 to register the mark - **Hermans** - as a trade mark in Classes 9, 18 and 25 of the register in respect of:-

- Class 9           Glasses, sunglasses; records, compact discs, music and video cassettes; magnetic and optical sound and image carriers; data carriers; computer programs; computer game programs; apparatus for recording, transmission or reproduction of sound or images.
- Class 18           Goods made of leather and/or of imitations of leather; handbags, cases; small articles of leather; purses, pocket wallets, briefcases, key cases, labels; rucksacks, school bags, trunks, travelling bags; umbrellas and parasols.
- Class 25           Clothing for men, women and children, sportswear, belts for clothing; headgear; footwear.

Objection was taken to the application under Section 5(2) of the Act by reason of conflict with the following registered marks:-

Number	Mark	Class	Specification
1099032	HERMAN SURVIVORS	25	Footwear being articles of clothing
1337681		9	Electrical and electronic measuring and testing apparatus and instruments; parts and fittings for all the aforesaid goods; all included in Class 9
1424366	HERMAN MILLER	24	Textile articles; upholstery fabrics; all included in Class 24

As a result of correspondence between the examiner and Boulton Wade & Tennant, agents for the applicant, the objections in respect of registered marks numbers 1337681 and 1424366 were waived. I need therefore make no further reference to these marks.

At the hearing at which the applicants were represented by Mr Wallace of Boulton Wade & Tennant, their trade mark agents, the objection under Section 5(2) relating to earlier registrations number 1099032 was waived on agreement that the word "Footwear" be deleted from class 25. Agreement to this amendment to the specification was provided in writing on 23 October 1997. However, the objection under Section 5(2) relating to earlier registration number 1442307 was maintained.

In correspondence following the hearing the agent informed me that the applicant had approached the agent representing the owner of registration number 1442307 requesting a letter of consent but no reply was received. The agent also argued that the two marks in conflict were not confusable but I maintained the objection.

Following refusal of the application under Section 37(4) of the Act I am now asked under Section 76 of the Act and Rule 56(2) of the Trade Marks Rules 1994 to state in writing the grounds of my decision and the materials used in arriving at it.

No evidence of use has been put before me, I have, therefore, only the prima facie case to consider and the provisions of Section 7(2) of the Act are not applicable.

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.

The earlier trade mark is for the words "HERMAN GEIST" in plain type and in upper case. The applicant's mark is the word "Hermans", again in plain type, but in upper and lower case. I have to consider if the totality "HERMAN GEIST" is similar to the mark Hermans, whether the goods are identical with or similar to those for which the earlier trade mark is protected, and (if so) whether there exists a likelihood of confusion on the part of the public,

which includes the likelihood of association with the earlier trade mark.

It is immediately apparent that the goods within the specification of the earlier trade mark are contained within the broader specification of this application, even after the deletion of "Footwear".

Since the mark of this application is not identical to the cited registered mark, I must address the issue of whether it so nearly resembles it for there to exist a likelihood of confusion on the part of the public. Although this matter is governed by the Trade Marks Act 1994 the principles of comparison of marks remain unchanged and I have considered the matter primarily by reference to the principles enunciated by Parker J in the PIANOTIST case (1906) 23 RPC at Page 777, line 26 et seq:

"You must take the two words. You must judge of them both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of these trade marks is used in the normal way as a trade mark for the goods of the respective owners of the marks. If, after considering all those circumstances, you come to the conclusion that there will be confusion - that is to say - not necessarily that one will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public, which will lead to confusion in the goods - then you may refuse the registration, or rather you must refuse the registration in that case".

It is my view that one mark is similar to another if an element (or something very similar to that element) of the earlier mark is included in the later mark with the result that the relevant public are likely to assume that the marks are associated and that the respective goods originate from the same source.

I have also born in mind the view expressed by Sir Wilfred Greene M.R. in the Saville Perfumery Limited versus June Perfect Limited case (1941) at page 162 lines 1-9 when he said :

"In the present case, for example, the evidence makes it clear that traders who have to deal with a very large number of marks used in the trade in which they are interested, do not, in practice, and indeed cannot be expected to, carry in their heads the details of any particular mark, while the class of the customer among the public which buys the goods does not interest itself in such details. In such cases the mark comes to be remembered by some feature in it which strikes the eye and fixes itself in the recollection. Such a feature is referred to as the distinguishing feature, sometimes as the essential feature of the mark".

And at lines 18-20 when he said:

"Now the question of resemblance and the likelihood of deception are to be considered by reference not only to the whole mark, but also to its distinguishing or essential features, if any".

The words "HERMAN" and "HERMANS" are obviously very close, the latter being the plural version of the same word or, as argued by the agent, the possessive form. It is worth noting that "HERMAN" is a well known but relatively rare forename. It has no other meaning. The word "GEIST" is a surname in Germany. I believe that a substantial number of people in this country seeing the mark HERMAN GEIST would recognise the combination of "HERMAN" and "GEIST" as forming a full name and it appears to me that the word "HERMANS" is likely to be taken as an abbreviated or alternative version of the same mark. There will, of course, be those members of the public who have no knowledge of the German language and who may well see the word "GEIST" as an invented word. In such circumstances I remain of the opinion that the presence in both marks of the very similar elements "HERMAN" and "HERMANS" would cause confusion in the sense that it would lead members of the public to the conclusion that the goods emanate from the same trade source. The addition of the word "GEIST" in the registered mark is, in my opinion, insufficient to prevent an association between the mark "HERMAN GEIST" and "HERMANS" in the manner outlined above. The application is, therefore, debarred from registration by Section 5(2) of the Act.

In this decision I have considered all the documents filed by the applicant and all the arguments submitted to me in relation to this application and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Section 5(2) of the Act.

Dated this 27th day of January 1998

A J PIKE  
For the Registrar  
The Comptroller General