

O-308-04

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2308358
BY WILLIAM PLENDERLEITH TO REGISTER THE
TRADE MARK DRIBOARD IN CLASSES 25 AND 28**

AND

**IN THE MATTER OF OPPOSITION NO 91427
BY DECATHLON**

TRADE MARK ACT 1994

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by William Plenderleith to register the
Trade Mark DriBoard in Classes 25 & 28**

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**IN THE MATTER OF Opposition No 91427
by Decathlon**

BACKGROUND

1. On 17 August 2002 William Plenderleith applied to register the mark **DriBoard** in Classes 25 and 28 of the International Classification system for:

Clothing; footwear; headgear.

Skates, wheeled skateboards, skateboards fitted with rotating discs, all-terrain skateboards, skateboard bindings and parts and fittings for the aforesaid.

2. The application is numbered 2308358.

3. On 20 January 2003 Decathlon filed notice of opposition to this application. Decathlon is the registered proprietor of international trade mark No 691507, **TRIBORD**, which has a date of protection in the United Kingdom of 17 November 1997.

4. The protection extends to Classes 3, 9, 12, 13, 14, 16, 18, 22, 25, 28, 29, 30, 31, 32, 36, 37, 38, 39, 41 and 42.

5. The opponent claims to have used its mark since June 1999 in relation to “diving suits, diving gloves, diving masks, swimming belts, swimming glasses, diving bags, sails and rigging, clothing for men, women and children (dressing gowns, bathing suits, bathing caps, sandals and shoes of bath, trousers, jackets, shirts, t-shirts, shorts, caps, shoes, boots, waterproof clothing), kites, board of surfing, covers for windsurfing boards, covers for sails, covers for boards of surfing, bodyboards, snorkels, grips nose, palms, plays and toys of water and goods similar to all the aforesaid.”

6. On the basis of these facts and claims objection is raised as follows:-

- (i) under Section 5(2)(b) on the basis of a likelihood of confusion arising from the similarity of marks and identity/similarity of goods;
- (ii) under Section 5(4)(a). The objection has been framed in somewhat unusual terms but I understand it to be based on the law of passing-off. Specifically it is said that registration would be contrary to the provisions of Section 5(4)(a) so far as it relates to goods in Classes 9,

18, 22, 25 and 28 (a list of goods is given) and goods similar to all the aforesaid (not specified). As the applicant has not sought coverage in three of the above classes and has specified a different set of goods in Class 28 it follows that the application cannot relate to the goods thus specified by the opponent. I infer that the opponent intended this to be a list of its own goods in relation to which registration of the applied for mark is considered objectionable (it corresponds to the list of goods on which use is claimed). A further difficulty arises in that there is a reference to “take unfair advantage of or be detrimental to the distinctive character or repute of the opponents trade mark” which is more consistent with an objection under Section 5(3) of the Act. However, no such objection has been specifically identified.

7. It will be apparent that there are difficulties inherent in dealing with the Section 5(4)(a) objection in the terms in which it is cast. However, for the reason which I will endeavor to set out below I do not think it has a material bearing on the outcome of the case.

8. The applicant filed a counterstatement denying the above grounds.

9. Both sides filed evidence. Neither side has asked to be heard. Written submissions have been received from Barlin Associates on behalf of the opponent (under cover of their letter of 21 September 2004). Acting on behalf of the Registrar I give this decision.

Opponent’s Evidence

10. The opponent filed two witness statements in support of its case. The first is by Hugues Delpire, the General Manager of Decathlon.

11. Mr Delpire says that the opponent operates its business in the United Kingdom through its local subsidiaries. Decathlon is a retailer and designer of sporting and leisure goods. The mark TRIBORD is said to have been adopted by the opponent in 1999 and used on the goods identified in the opponent’s statement of grounds. Turnover is given as follows:

From 1 June 1999 to 31 December 1999	£ 84,110.55
For the year 2000	£ 911,680.75
For the year 2001	£1,187,606.36
For the year 2002	£1,419,946.43

12. No breakdown of turnover is given for the year 2002 to show what part of the turnover is attributable to the period prior to the relevant date of 17 August 2002.

13. Mr Delpire estimates that some 56.15 per cent of the total turnover is attributable to clothing and the balance of 43.85 per cent to sporting goods. No further breakdown is given between the various categories of sporting goods (or indeed, clothing which occurs in both classes 9 and 25).

14. It is said that the opponent advertises widely by reference to the mark TRIBORD but that, as such advertising and promotion is handled on a global basis, there is no

information as to precise amounts spent in the UK. A selection of labels and advertising is exhibited at HD/1. As a result of this use Mr Delpire says that the opponent enjoys a substantial goodwill in this country.

15. Also exhibited to Mr Delpire's witness statement are full details of the protected international registration on which the opponent relies (HD/2) and a copy of the applicant's website (HD/3). The purpose of the latter is to show that the mark in use is a stylised version of the mark applied for and to suggest that there is overlap in the goods marketed by the parties.

16. The second witness statement is by Andrew Ross, the Editor of London Sport, a sports magazine. He completed a questionnaire in response to an approach from the opponent's trade mark attorneys. His evidence is advanced as showing that there is a likelihood of confusion between the respective marks. I will return to this evidence when I come to my own decision on the matter.

Applicant's Evidence

17. William Plenderleith has filed a witness statement. Much of this statement is in essence submissions which I will deal with in my decision below. He also exhibits copies of advertising material for his own goods (WP1); extracts from the opponent's website intended to show that its goods are water sports related (WP2 and 3); an extract from the website of London Sport magazine suggesting that there is commercial relationship between the magazine and the opponent (WP4); and print-outs showing other '-BOARD' suffixed marks on the UK register which co-exist with the TRIBORD mark (WP5).

18. That completes my review of the evidence.

Decision

19. I will deal firstly with the objection under Section 5(2)(b). This 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.”

20. I take into account the well established 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] R.P.C. 117, *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*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, 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.* paragraph 27;
- (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*, paragraph 23;
- (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*, paragraph 23;
- (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*, paragraph 17;
- (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*, paragraph 24;
- (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*, paragraph 26;
- (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*, paragraph 41;
- (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*, paragraph 29.

Comparison of Goods

21. The applicant has specified a range of goods in Classes 25 and 28. The

opponent's specification covers some twenty classes. It will suffice to consider the goods that are in the same classes as the applicant's.

Applicant's Goods

Opponent's goods

Clothing; footwear; headgear.

Ready-made clothing for men, women and children; knitwear and hosiery, lingerie, underwear, robes, bath robes, bathing suits, bathing caps; sandals and bath slippers; pyjamas, dressing gowns, sweaters, skirts, frocks and dresses, trousers, jackets, coats, shirts, layettes, neckties, scarves, belts, gloves (clothing), waterproof garments, wet suits for water skiing, sportswear; hats, caps, socks, stockings, tights, shoes (except for orthopedic shoes), slippers, boots; sports, beach and ski footwear; sportswear (except diving gear); clothing for hunting.

Skates, wheeled skateboards, skateboards fitted with rotating discs, all-terrain skateboards, skateboard bindings and parts and fittings for the aforesaid.

Games, toys, play balloons; gymnastic and sporting articles (except clothing, shoes and mats); skating boots with skates attached; boxing gloves; hang gliders; archery implements; bows for archery; bob-sleighs; kites; kite reels; strings for rackets; gut for rackets; bats for games, balls for games; fishing tackle; sailboards; surf boards without automotive power; boards used in the practice of water sports; breathing tubes; balls, balloons, nets for sports; golf clubs, skis, waterskis, edges of skis, ski bindings; fishing rods and fishing accessories, namely reels, lines, bite indicators, fish hooks, fishing bait and lures, weights and dumb-bells; bows; crossbows and arrows; harpoon guns (sports articles); flippers for swimming; swimming pools (sports or play articles); slides for swimming pools; skateboards; jokes and conjuring tricks; swings; billiards and billiard balls, billiard cues; stationary exercise bicycles; chest expanders (exercisers); fencing weapons; hockey sticks; skittles and balls; bowling balls; physical rehabilitation apparatus (gymnastic apparatus); abdominal boards (gymnastic apparatus); tables for table tennis; theatrical masks; sleighs (sports articles), scooters; Christmas tree decorations (except lighting implements and confectionery).

22. The applicant's Class 25 specification is cast in broad terms. The opponent's contains a more specific list of items but it does not in my view require detailed analysis or argument to conclude that the opponent's goods are examples of items that would fall within the general terms clothing, footwear and headgear. In short they are identical goods.

23. The applicant's Class 28 specification has a narrower range of goods based on skates and skateboards. The opponent's goods include skateboards as a specific term along with skating boots with skates attached. In addition the opponent has the general term sporting articles. Again, therefore, identical goods are involved.

Comparison of marks

24. The marks are DriBoard and TRIBORD respectively. The former is presented in the mixture of upper and lower case letters shown, a natural consequence of which is to draw attention to the elements that make up the mark. The distinctive character of the respective marks is a factor to be taken into account. I note from the applicant's evidence that the mark is used in connection with a product which provides 'all season grass slope boarding' (see exhibit WP1). The promotional blurb indicates that the board uses saucer-shaped discs instead of wheels. The discs are said to "have the effect of using very large wheels to smooth out the bumps".

25. The opponent has not suggested that the mark DriBoard is of low distinctive character because it is directly or even indirectly descriptive of the product on which it has hitherto been used. Nevertheless, by analogy with dry slope skiing it is not difficult to understand why the mark has been chosen. I consider the applied for mark to be of no more than modest distinctive character at least so far as the Class 28 goods. The applicant commenced use of his mark in 2001 but no, or insufficient, substantiating detail is given to suggest that this prima facie appraisal of the distinctive character needs to be adjusted.

26. Turning to the opponent's mark, TRIBORD, Mr Plenderleith points out that it is the French word for starboard. No doubt there will be some people in this country with a sufficient command of the French language to appreciate that this is the case. Many others will not. In terms of the distinctive character of the mark I do not consider that it makes much difference. It may either be treated as an unknown/invented word or as the French word for starboard. Either way it is a word that has no obvious significance in relation to the relevant goods in Classes 25 and 28 and must be considered to have a reasonably high degree of distinctive character.

27. In addition to the inherent characteristics of the opponent's mark I must consider any enhancement to its distinctiveness as a result of the use made of it. Mr Delpire's exhibit HD/1 mainly shows use of the mark on clothing items such as jackets, trousers, bikinis and watersport clothing. There are also catalogue entries in relation to items such as kites. I should add that most of the use of TRIBORD is as one of a number of brands (both in-house and third party) in catalogues/advertisements for the Decathlon stores. I do not consider that the nature, extent and duration of use of the mark TRIBORD can be said to have further enhanced its claims. It is, however, as I have already suggested, a mark with reasonably strong inherent characteristics.

28. With those observations on the distinctive character of the marks in mind I turn to the usual visual, aural and conceptual comparisons. The average consumer, aided by the use of upper and lower case lettering employed in the applicant's mark, is likely to recognise that it is made up of two elements with well known meanings. In this

respect I take the view that the average consumer is likely to take Dri- as a misspelling of 'dry'.

29. The opponent's mark does not readily breakdown into elements with recognisable or discernible meanings. It seems to me that, unless the consumer understands the French meaning, it is more likely to be seen simply as an invented word or just possibly a name of some kind.

30. Mr Delpire's evidence refers me to the applicant's website where it is said that the mark is used in highly stylised form and not simply in the form applied for. In fact Exhibit HD/3 shows both the so-called stylised version and the form applied for. I am not so sure that it is correct to say that the first of these is highly stylised. Moreover, even the so-called stylised version illustrated in HD/3 retains the upper and lower case presentation. But the point is somewhat academic. I must consider normal and fair use of the mark in the form applied for. On that basis I find the respective marks to be visually dissimilar or, to put the matter another way, the visual dissimilarities outweigh the similarities.

31. Aurally, both marks are composed of two syllables. The opponent has stressed that it is particularly concerned about the phonetic rendering of the marks. I agree that this is the high point of its case. The applicant, on the other hand, relies on the mark TRIBORD being understood to be a French word and pronounced accordingly. That produces a pronunciation akin to 'tree-bor', that is to say with the final consonant silent. If that were the prevailing or most likely pronunciation it would indeed put some distance between the words. But I am not convinced that consumers generally will adopt that pronunciation. It is more likely in my view that they will pronounce the mark as TRI-BORD and in doing so give full effect to the final consonant. On that basis both marks have long vowel sounds in their first syllables, identical or closely similar vowel sounds in their second syllables and similar sounding consonants. I regard the marks as being similar to the ear and it would require careful enunciation of the initial consonants if they were to be distinguished.

32. Conceptually, I consider that the balance of the argument swings back in favour of the applicant because his mark yields a meaning (whether or not it is one that carries a message about the goods). Clearly that conceptual distinction between the marks is further aided if the consumer understands the meaning of TRIBORD but for the reasons I have already given I would not be confident that this is so. However, I do not think that drawing a conceptual distinction between these marks turns on whether or not the French meaning is understood. It is enough that DriBoard suggests a meaning of its own. In this latter respect reference may be made to the following passage from the Court of First Instances judgments in *Phillips-Van Heusen Corp v Pash Textilvertrieb und Einzelhandel GmbH* Case T-292/01:

“54. Next, it must be held that the conceptual differences which distinguish the marks at issue are such as to counteract to a large extent the visual and aural similarities pointed out in paragraphs 49 and 51 above. For there to be such a counteraction, at least one of the marks at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately. In this case that is the position in relation to the word mark BASS, as has just been pointed out in the previous

paragraph. Contrary to the findings of the Board of Appeal in paragraph 25 of the contested decision, that view is not invalidated by the fact that that word mark does not refer to any characteristic of the goods in respect of which the registration of the marks in question has been made. That fact does not prevent the relevant public from immediately grasping the meaning of that word mark. It is also irrelevant that, since the dice game Pasch is not generally known, it is not certain that the word mark PASH has, from the point of view of the relevant public, a clear and specific meaning in the sense referred to above. The fact that one of the marks at issue has such a meaning is sufficient – where the other mark does not have such a meaning or only a totally different meaning – to counteract to a large extent the visual and aural similarities between the two marks.”

Likelihood of Confusion

33. The likelihood of confusion must be appreciated globally taking account of all relevant factors. The matter is to be judged through the eyes of the average consumer who is deemed to have the qualities set out in the *Lloyd Schuhfabrik* case. A narrow view of the applicant’s Class 28 specification suggests that the average consumer would be anyone involved in skateboarding. That points to a younger, predominantly male (and probably knowledgeable) audience. But that may be too restricted a view of the matter as parents or other adults may be purchasing such goods for children. The applicant’s Class 25 goods are not restricted in terms of the consumer base being served. I take the average consumer for these goods to be the public at large.

34. The position I have reached is that I consider that the visual and conceptual dissimilarities between the marks outweigh any similarities but that the opposite is true so far as aural considerations are concerned. It was held in *Sabel Puma BV v Puma AG* that:

“In that perspective, the more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either per se or because of the reputation it enjoys with the public.”

35. If conceptual similarity may be enough to give rise to a likelihood of confusion so too may visual or aural similarity. An example of a case where aural considerations were held to be of particular importance was *David West & Fuller Smith & Turner Plc*, BL O/136/00 where the Hearing Officer was influenced by the fact that the trade in beers through public houses still relies heavily on word of mouth orders. As a consequence, oral/aural considerations were accorded particular weight.

36. However, the ECJ in *Sabel v Puma* was not, I think, suggesting that similarity in one area would necessarily give rise to a finding of likelihood of confusion. The matter has to be judged in the round taking all relevant factors into account. That suggests I should return to the goods, the circumstances of trade and the methods by which consumers are likely to come into contact with the marks. It is possible that different sets of goods within the specifications might yield different results, but in

practice I have no reason to suppose that this is the case with the particular goods at issue here. It seems to me that, overwhelmingly, these goods will be purchased by a process of visual inspection. That was held to be the case in relation to clothing in *REACT Trade Mark* [2000] RPC 285. I do not see why skateboards and related paraphernalia should be any different. As a matter of commonsense and practical experience, clothing and sporting goods usually need to be seen to judge matters of styling, fit, quality etc. This is not to rule out oral orders or word of mouth recommendations but there is no reason to suppose that such considerations should be accorded particular weight in the context of the goods at issue here.

37. Furthermore, the evidence rather supports that view of the matter. The opponent's trade is conducted through its own retail outlets which are supported by catalogues/advertising displaying the brand available. The applicant's trade appears to be website based but again the goods and the mark will be viewed prior to ordering.

38. However, there is a further matter to be taken into account before reaching a concluded view on the likelihood of confusion. That is Mr Ross' evidence. He was approached as being someone with a knowledge of the sporting articles industry and invited to complete a questionnaire. Therein lies the first problem with this evidence. No information is given as to the number of people approached, the basis for their selection (other than a knowledge of this area of trade), what (if any) their relationship was with the opponent and what (if any) other replies were received. In this latter respect I note that the covering letter from the trade mark attorneys says "assuming that your answers are of assistance we would wish you to confirm said answers in the form of a Witness Statement". This begs the question as to whether other replies were received that were not in fact of assistance.

39. In terms of the substance of the questionnaire Mr Ross, in answer to the question "*If you saw the word DRIBOARD being used as a trade mark in relation to [the goods of the application] what conclusion would you come to as to the origin of said goods*", says "*Perhaps equipment for skateboarding or any other type of board sport not connected to snow/water*". That answer focused, it seems to me, on the nature or purpose of the goods rather than the origin question which had been asked and might in itself have suggested that no known origin association at all came to Mr Ross' mind. However, a further question invited the respondent to provide reasons for coming to the conclusion reached in answering the preceding question. To this Mr Ross says "*Decathlon has the brand TRIBOARD. Could it be their brand?*". This further question appears therefore to have prompted Mr Ross to embark on a process of speculation. In the event he answers it with a question of his own suggesting he was not confident of his answer. Furthermore, I note that he misidentified the opponent's mark which is TRIBORD and not TRIBOARD.

40. The applicant has suggested that there might be a commercial relationship between the opponent and Mr Ross' magazine. I confess that I find it difficult to work out from the single webpage exhibit (WP4) supplied in support of the claim to know what that relationship might be (if any). It may be that the magazine or its online equivalent has carried advertisements for or links to Decathlon but that may not in itself be enough to disqualify Mr Ross as editor from expressing a view.

41. Nevertheless, without knowing more about the conduct of the questionnaire, and given my doubts about the responses given in the only completed questionnaire, I find that Mr Ross' evidence does not displace my own view of the matter.

42. Taking all relevant factors into account and making due allowance for imperfect recollection, I have come to the conclusion that there is no likelihood of confusion. The opposition, therefore fails under Section 5(2)(b).

43. Objection has also been taken under Section 5(4)(a) of the Act having regard to the law of passing-off. The use shown by the opponent is of the mark as registered (or with a small degree of stylisation that does not affect matters) and in relation to goods that are within the specification of their protected international registration. In these circumstances the rights that would be entitled to protection under Section 5(4)(a) can be no wider than those considered under Section 5(2). Accordingly, I see no need to give further consideration to this ground and no different outcome is possible.

44. The opposition has failed. The applicant is entitled to a contribution towards his costs. I order the opponent to pay the applicant the sum of **£1200**. 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 the case if any appeal against this decision is unsuccessful.

Dated this 8th day of October 2004

**M REYNOLDS
For the Registrar
The Comptroller-General**