

O-315-10

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATIONS
Nos. 2459476 & 2459479
BY ARGOS LIMITED
TO REGISTER THE TRADE MARKS
GO EXPLORE
AND
GO PLAY
IN CLASS 18**

AND

**IN THE MATTER OF CONSOLIDATED OPPOSITIONS THERETO
UNDER Nos. 96728 & 97142 BY
DESIGN GO LIMITED**

BACKGROUND

1) On 26 June 2007 Argos Ltd (hereinafter the applicant), applied to register the following trademarks GO PLAY (2459479) and GO EXPLORE (2459476).

2) The specification applied for on each of the two marks was identical, and was as follows:

Class 18: Leather and imitations of leather, and goods made of these materials and not included in other classes; luggage; trolley cases; holdalls; trunks and travelling bags; rucksacks; backpacks; briefcases; sports bags; bags; umbrellas; wallets; purses; key holders.

3) The applications were examined and accepted, and subsequently published for opposition purposes on 7 March 2008 (2459479) in Trade Marks Journal No.6726 and 28 December 2007 (2459476) in Trade Marks Journal No.6716

4) Design Go Limited (hereafter the opponent), filed two notices of opposition, dated 28 March 2008 (2459476) and 16 May 2008 (2459479) subsequently consolidated. The grounds of opposition are in summary:

a) The opponent is the proprietor of the following trade mark:

Trade Mark	Number	Application Date and Registration Date	Specification
GO	1384842 Advertised before acceptance. Section 18(1) (proviso).	19.05.1989 / 17.07.1992	Class 18: Laundry bags; harness straps and belts; elasticated straps and cords, all for luggage; folding cases; shoulder bags, backpacks, holdalls, beach bags, shoe bags, holsters; money belts, money bags; pouches, purses, wallets, credit card holders; saddle bags adapted for use with briefcases; luggage label holders, luggage labels and luggage tags; bandoliers, wheels and combinations of wheels and straps, all for use with cases, boxes and bags; sun shades; camera cases; travel garment covers; parts and fittings for all the aforesaid goods; all included in Class 18.

b) The opponent states that the marks applied for are similar to the opponent's earlier registration and that the goods applied for in Class 18 are identical and/or similar to those for which its' mark is registered. The opponent states that the application offends against Section 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994.

5) On 13 June 2008 and 8 July 2008, the applicant filed counterstatements which denied the opponent's claims. The applicant puts the opponent to strict proof of use.

6) Both sides filed evidence and both parties seek an award of costs in their favour. The matter came to be heard on 17 August 2010. At the hearing, the opponent was represented by Mr Malynicz of Counsel instructed by Messrs Marks & Clerk, the applicant was not represented, nor did they file written submissions.

OPPONENT'S EVIDENCE

7) This consists of a witness statement, dated 16 April 2009, by Glenn Rogers a Director of the opponent company a position he has held for five years, having been involved with the company for over twenty five years. Initially the company was called Jack Rogers & Co Ltd but changed its name to Design Go Ltd on 26 March 2004. He states that "Since 1978 my company or its predecessor in business has traded under the following GO brands as set out below:"

1978-1988	GO-Travel Aids.
1989-1998	GO-The Travel Products Company.
1999-2002	Design GO –Travel Emporium.
2003-current day	Design GO.

8) At exhibit GR2 & GR3 he provides copies of invoices, advertisements, product packaging, labels, tags and products from 1984 to the present which shows the evolution of the GO brand as set out above. Although not individually dated it is clear from the above changes to the mark what time frame the item fits into. Throughout the dominant feature is the GO element which is usually in a stylised form (see paragraph 28) and is significantly larger than the other words used as tag lines or as a prefix such as "design". The difference in size is so marked that it would be difficult to read anything other than the word GO from a distance of more than two or three feet. Mr Rogers provides the following annual sales figures for the UK under the GO mark:

YEAR	SALES £
2002	8,765,308
2003	8,977,616
2004	9,742,626
2005	9,919,219
2006	8,786,988
2007	8,194,385
2008	7,634,727

9) At exhibits GR4 and GR5 Mr Rogers provides examples of advertisements and press releases which have appeared in various magazines, trade journals, newspapers and on the internet and which include photographs of the actual products and packaging. On the products the only mark visible is the word "GO" whilst on the stands used in shops the words "the travel products company" can also be read. The advertisements are dated 1997 and 1998. Clearly, one photograph of a stand in a shop is after the company name was changed to Design Go Ltd as this name is stated in the caption, but on the stand the only word visible is "GO". The newspaper articles/press releases all refer to the "GO" company or range of products. These are dated 25 April 2002, 21 June 2002, 4 August 2002 and 7 March 2002 and are taken from the Edinburgh Evening News, The Shetland Times, The Sunday Times and The Times Business Section. Mr Rogers states that his company spends approximately £250,000 per annum on advertising. He states that the mark is used throughout the UK and worldwide.

APPLICANT'S EVIDENCE

10) The applicant filed a witness statement, dated 29 June 2009, by Hazel Bradbury their Trade Mark Attorney. She states that the applicant has used the marks applied for since 1997 and that the applicant has 700 retail outlets throughout the UK and Ireland serving over 130 million customers a year. She states that in the twelve years that the applicant has been using the marks applied for there have been no instances of confusion with the opponent's goods or marks. She states that the marks applied for consist of the prominent words "Explore" and "Play" coupled with the word "Go" which merely acts as a verb to accompany the terms "explore" and "play". Ms Bradbury provides, at exhibit HB2 copies of other "GO" trade marks which have been registered. Although all of the thirteen marks listed are registered in relation to Class 18 goods a number of the marks are significantly different to those of both parties in the instant case. These include marks such as "Change 'N Go"; "La.go.go."; "L'eau-Go"; "On the go"; "Let's Go"; "Class 'N Go". She states that many businesses use the word "GO" as part of their trade name. At exhibit HB3 she provides a copy of an extract from Yellow Pages. In the exhibit a number of company names have been highlighted, presumably as these were felt to be of greatest relevance. However, these include the following companies a number of whom, from the listing, appear to be in different fields of activity to the opponent or have names significantly different or both.

On the Go Ltd: Security services and equipment; **Go Ltd:** Dry lining; **On the Go:** Greeting card shops; **Going Places:** luggage and bags; **Go Go Designs:** Work wear, embroidery services; **Team a Go-Go:** Office furniture, office fitting and refurbishment; **Go Go Go Ltd:** Entertainments; **Go Fish Design & print:** Printers and lithographers; **Go Ballooning:** Hot air balloons; **Airports 2 Go:** Airport transfers, Mini Bus Hire; **Art 2 Go UK Ltd:** Promotional items and incentives, uniforms and staff wear, work wear, T shirt printers; **Pizza Go Go:** Pizza delivery & take away; **Going Going Gone:** Courier Service.

11) Ms Bradbury also claims that the proof of use provided does not support use of the opponent's registered trade mark instead it shows use of the mark "Design Go" where the word "GO" is highly stylised. At exhibit HB5 she provides extracts from the opponent's and third party websites which all show references to "Design Go" in relation to their opponent and their products.

OPPONENT'S EVIDENCE IN REPLY

12) The opponent filed a second witness statement by Mr Rogers, dated 4 November 2009. He states that he believes that there has been no confusion between the two parties as the applicant has used the mark upon wheeled bags which his company is not known for. He disputes the claim by the applicant that his company has not used the "GO" trade mark over the past five years. He states that from 2004 until 2008 (calendar years) his company sold just over eleven million products where the word "GO" was the dominant element on the product. At exhibit GR7 (a) & (b) he provides copies of pages from catalogues for the years 2004-2008 which, he states, shows use of the mark "GO". Exhibit 7a consists of photographs of goods and their packaging in which the term "DESIGN GO" can be seen on the packaging. These include a backpack, a tote bag and a shoulder bag, and pouches for CDs, phones and passports, luggage

labels and a variety of money belts and wallets. The term DESIGN GO is being used in a similar manner to that shown in the exhibits to his earlier statement where the word DESIGN is in very small print in contrast to the dominant word GO. The term is also visible on some of the articles or on zippers on the articles. Again the word "GO" is dominant. On the majority of the items the word "GO" is the only term featured, either on the zipper or on the item by way of a badge or embossing. Exhibit 7(b) consists of further photographs of goods and packaging. Again the "DESIGN GO" term can be seen on much of the packaging and goods. The goods include camera pouches and bags, travel bags including duffle bags, money bags, belts and holders. All of the goods and packaging have the term "Design GO" shown on them in such a way that the term "Design" is very difficult to read from even a short distance and the term "GO" dominates.

13) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

14) I turn first to the ground of opposition 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."

15) 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."

16) The opponent is relying upon its trade mark listed in paragraph 4 which is clearly an earlier trade mark. It was registered on 17 July 1992 and is therefore subject to The Trade Marks (Proof of Use, etc) Regulations 2004, paragraph six of which states:

"6A Raising of relative grounds in opposition proceedings in cases of non-use.

(1) This section applies where-

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if-

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes-

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

17) In the instant case the publication dates of the applications were 28 December 2007 and 7 March 2008. Therefore, the relevant periods for the proof of use are 29 December 2002-28 December 2007 (2459476) and 8 March 2003-7 March 2008 (2459479). I must first consider

whether the opponent has fulfilled the requirement to show that genuine use of the mark has been made. The guiding principles to be applied in determining whether there has been genuine use of a mark are *Ansul BV v Ajax Brandbeveiliging BV* [2003] R.P.C. 40 and *Laboratoire de la Mer Trade Mark* [2006] F.S.R. 5. From these cases I derive the following main points:

- genuine use entails use that is not merely token. It must also be consistent with the essential function of a trade mark, that is to say to guarantee the identity of the origin of goods or services to consumers or end users (*Ansul*, paragraph 36);
- the use must be ‘on the market’ and not just internal to the undertaking concerned (*Ansul*, paragraph 37);
- it must be with a view to creating or preserving an outlet for the goods or services (*Ansul*, paragraph 37);
- the use must relate to goods or services already marketed or about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns (*Ansul*, paragraph 37);
- all the facts and circumstances relevant to determining whether the commercial exploitation of the mark is real must be taken into account (*Ansul*, paragraph 38);
- the assessment must have regard to the nature of the goods or services, the characteristics of the market concerned and the scale and frequency of use (*Ansul*, paragraph 39);
- but the use need not be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39);
- an act of importation could constitute putting goods on the market (*Laboratoire de la Mer*, paragraph 25 referring to the earlier reasoned order of the ECJ);
- there is no requirement that the mark must have come to the attention of the end user or consumer (*Laboratoire de la Mer*, paragraphs 32 and 48);
- what matters are the objective circumstances of each case and not just what the proprietor planned to do (*Laboratoire de la Mer*, paragraph 34);
- the need to show that the use is sufficient to create or preserve a market share should not be construed as imposing a requirement that a significant market share has to be achieved (*Laboratoire de la Mer*, paragraph 44).

18) The opponent has provided printouts from catalogues for the calendar years 2004-2008 inclusive at exhibits GR7 (a) & (b). In his statement Mr Rogers states that during this time his company sold over eleven million items under the “GO” trade mark. He states that the items shown within exhibit GR7 have all been sold during the period 2004-2008. In his first witness

statement Mr Rogers provided turnover figures but these were not restricted to only class 18 products. He also stated that approximately £250,000 per annum is spent on advertising the trade mark "GO". The opponent gave no details as to whom the catalogues were sent, the extent of the distribution, or any details of sales volumes or turnover figures specific to Class 18. I attach less weight to the advertising and newspaper articles which were prior to the relevant period, but which nevertheless add to the total picture. There has been no challenge to the assertion of Mr Rogers that during the relevant periods the items illustrated in his exhibits were sold in the UK. However, the applicant does challenge whether the opponent has used the mark as registered or one which is acceptable under Section 46(2). Whilst I would criticise the level of evidence provided, I am willing to accept that the evidence provided just scrapes over the bar of what is acceptable to meet the proof of use requirement, with the proviso that the mark used is judged to fall within section 46(2). On this basis I am willing to accept that the opponent has used its mark on a variety of bags including shoulder bags, backpacks and holdalls, pouches for CDs, cameras and passports, luggage labels and a variety of wallets, money bags and belts.

19) When considering what specification should be used in the comparison test I take into account the guidance in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 in relation to determining what constitutes a fair specification, namely:

"29 I have no doubt that Pumfrey J. was correct to reject the approach advocated in the Premier Brands case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s.10 (2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for "motor vehicles" only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for motor bikes under s.10 (1). That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is envisaged that the proprietor seeks to enforce his trade mark against use in relation to pedal cycles. His chances of success under s.10 (2) would be considerably increased if the specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to "dig deeper". But the crucial question is--how deep?

30 Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox's Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox's Orange Pippins?

31 Pumfrey J. in *Decon* suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion

under s.10 (2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.”

20) The comments of Mr Justice Jacob (as he then was) in *Animal Trade Mark* [2004] FSR 19 are also relevant.

“20 The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pernicky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for three holed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) "three-holed razor blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.”

21) The registered specification is as follows:

Class 18: Laundry bags; harness straps and belts; elasticated straps and cords, all for luggage; folding cases; shoulder bags, backpacks, holdalls, beach bags, shoe bags, holsters; money belts, money bags; pouches, purses, wallets, credit card holders; saddle bags adapted for use with briefcases; luggage label holders, luggage labels and luggage tags; bandoliers, wheels and combinations of wheels and straps, all for use with cases, boxes and bags; sun shades; camera cases; travel garment covers; parts and fittings for all the aforesaid goods; all included in Class 18.

22) Adopting the above authorities when considering the evidence filed it is my view that the specification should be reduced to the following:

Class 18: Folding cases; shoulder bags, backpacks, holdalls, beach bags, shoe bags, holsters; money belts, money bags; pouches, purses, wallets, credit card holders; luggage labels and luggage tags; camera cases; all included in Class 18.

23) I now turn to consider whether the marks used by the opponent can be regarded as use of the mark registered. Section 46(2) states:

“46. (2). For the purposes of subsection (1) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.”

24) In considering this issue I take into account the comments in the Court of Appeal in *Bud and Budweiser Budbrau Trade Marks* [2003] RPC 25 at 43, in which Walker LJ said:

“The first part of the necessary inquiry is, what are the points of difference between the mark as used and the mark as registered? Once those differences have been identified, the second part of the inquiry is, do they alter the distinctive character of the mark as registered?”

25) As Mr Malynicz pointed out:

“That case is helpful as a general statement of the approach, but it should be remembered that it was concerned with, essentially, whether capitalisation/ stylisation and device elements could affect the question of whether the use was use of the mark as registered. Here the question is slightly different. What is the position, where, as here, some of the evidence shows use of the word DESIGN either alongside, or below, or above, or within, the word GO?”

26) He then provided what he felt was the answer by referring me to Case T-353 *Esber SA v. OHIM*, of 30 November 2009 (as yet unreported). In this case, the issue was whether there had been proof of use in relation to the mark COLORIS. The General Court said this, at paragraphs 28-33:

“28 The applicant alleges, first, that the complex forms of the earlier word mark COLORIS used in the evidence are different signs which alter its distinctive character for the purposes of Article 15(2)(a) of Regulation No 40/94. In that regard, it should be noted that the distinctive character of the word element ‘coloris’ is not disputed by the parties.

29 The complex signs used in the evidence differ, essentially, from the earlier word mark as a result of the presence of the word elements ‘global coloring concept’ and ‘gcc’ together with the image of a globe and, sometimes, the additional word element ‘colorants & technologies’ below the sign. It is therefore necessary to examine whether those variations are capable of affecting the distinctive character of the earlier word mark.

30 In that regard, it must be noted that the assessment of the distinctive or dominant character of one or more components of a complex trade mark must be based on the intrinsic qualities of each of those components, as well as on the relative position of the

different components within the arrangement of the trade mark (see Case T135/04 *GfK v OHIM – BUS (Online Bus)* [2005] ECR II 4865, paragraph 36 and the case law cited).

31 In the present case, the words ‘global coloring concept’ constitute one long word element, and are always juxtaposed with the term ‘coloris’ and positioned below it. In the evidence submitted, the size of the letters in those words is never greater than that in the term ‘coloris’. In contrast, in a number of items of evidence those words are appreciably smaller than the term ‘coloris’, and their position is thus clearly secondary. In addition, they are words with a general meaning. Furthermore, the word ‘coloring’ refers to the goods concerned and, consequently, has a certain descriptive character.

32 Similar considerations apply to the word element ‘gcc’. That element is also always juxtaposed with the term ‘coloris’ and positioned below it, and its size is not predominant in relation to that of the term. In addition, it does not have an obvious meaning or a particular inherent quality, and the fact that it is an acronym of ‘global coloring concept’ does not alter that assessment.

33 In the light of those considerations, it must be concluded that the word elements which accompany the earlier word mark COLORIS do not affect its distinctive character.”

27) Paragraph 36 of Case T135/04 *GfK v OHIM – BUS (Online Bus)* [2005] ECR II 4865 referred to above states:

“36. Secondly, so far as concerns the reference “Betreuungsverbund für Unternehmer und Selbständige e.V., it must be noted that the assessment of the distinctive or dominant character of one or more components of a complex trade mark must be based on the intrinsic qualities of each of those components, as well as on the relative position of the different components within the arrangement of the trade mark (see, to that effect, Case T-6/01 *Matratzen Concord v OHIM – HuklaGermany (MATRATZEN)* ECR II-4335, paragraphs 33 to 35).”

28) From the above it is clear that the important issues are the prominence, the position and size of the additional wording as well as its distinctiveness. During the relevant period the opponent used the following mark:



29) The opponent has used the above mark on most of its packaging and goods during the relevant period. However, it has also used the “GO” part of the above mark *solus* upon the goods themselves. There are therefore two questions. Firstly whether the stylised version of the word “GO” is use of the mark as registered, and secondly whether the use of the whole of the mark

above is use of the mark registered. The mark is registered in plain capital letters with absolutely no stylisation.

30) To my mind there are very few points of difference between the word “Go” in the mark at paragraph 30 and the mark as registered. The letter “G” has a very small almost triangular device within the letter, but it is still very obviously the letter “G”. The letter “O” has a small slice taken out from it but again it is very obviously a letter “O”. There is a degree of stylisation but to my mind this does not affect the perception of the mark. I cannot conceive that any consumer would fail to register this part of the mark as the word “GO”. To my mind the points of difference are very slight and they do not alter the distinctive character of the mark. Therefore, the use of this part of the mark where it appears on its own on the goods is sufficient to be considered use of the registered trade mark. Whilst this might be regarded as settling the matter I will go on to consider the use made of the whole of the mark above.

31) Turning now to the use of the whole of the mark at paragraph 28 the differences between this and the mark as registered are clearly the word “DESIGN” and the stylisation to the word “GO”. There is a considerable size difference when used on the packaging and goods which is not apparent given the magnification used to make the mark readable in the decision. I also accepted the contention that the word “DESIGN” will be viewed as descriptive. I also accept that it could be seen by a number of consumers as a secondary mark to the main house mark “GO”. To my mind the dominant element of the mark at paragraph 28 is the word “GO”. I therefore find that the opponent has shown genuine use of their registered trade mark.

32) The opponent’s earlier mark is therefore protected for the following goods “Folding cases; shoulder bags, backpacks, holdalls, beach bags, shoe bags, holsters; money belts, money bags; pouches, purses, wallets, credit card holders; luggage labels and luggage tags; camera cases; all included in Class 18.” This is the specification which will be used in the comparison test. In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law 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] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). 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) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,

(h) 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*,

(i) 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 and Adidas Benelux BV*,

(j) 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.*,

(k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

(l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*

33) In essence the test under section 5(2)(b) is whether there are similarities in marks and goods 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 judgments 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, the category of goods in question and how they are marketed. Furthermore, I must compare the applicant's mark and the mark relied upon by the opponent on the basis of their inherent characteristics assuming normal and fair use of the marks on the goods previously outlined.

34) The effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act was considered by David Kitchin Q.C. (as he was then) sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchin concluded at paragraph 17 of his decision:

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in *Reed Executive & Ors v. Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become more distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

35) The applicant contends that the opponent's registered mark is not particularly distinctive and referred me to what is usually termed state of the register evidence. In *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 28 Jacob J. said:

“It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, see e.g. *MADAME Trade Mark* [1966] RPC 541 and the same must be true under the 1994 Act.”

36) In *Digipos Store Solutions v Digit International* [2008] RPC 24 Mr Alexander Q.C acting as a Deputy Judge of the High Court commented:

“63 That was said in the context of a case where absolute grounds were relied on as the basis for refusing registration. However, in the present case, this material is not relied on in support of an argument that a mark which shares characteristics with those already registered should, for that reason, also be registered: the register is not relied on for its precedent value, in my judgment, rightly so. The register is not in this case deployed to show actual use of the marks recorded there either: for that purpose too, it would be of

limited, if any, evidential value. Instead, the register is relied upon to show that, as a matter of fact, a significant number of traders have expressed the intention of using (and *may* be using) the prefix DIGI- as part of a mark in relation to class 9 goods which (one is invited to infer, in the absence of detailed specifications) involve a digital or computer-related element. It does not seem to me to be illegitimate, as a matter of principle, to deploy material of this kind for that limited purpose and, for that purpose, it is of some value as part of a larger body of material.”

37) However, in *GfK AG v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-135/04 the General Court (GC) stated:

“68. As regards the search of the Cedexlex database, the mere fact that a number of trade marks relating to Class 35 contain the word ‘bus’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned. Firstly, the search in question does not provide any information on the trade marks actually used in relation to the services concerned. Secondly, it includes a number of trade marks in which the word ‘bus’ is used descriptively by public transport businesses.”

38) This was a view re-iterated by the GC in *Zero Industry Srl v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-400/06.) In *Digipos* Mr Alexander was not referred to the judgment of the GC in *GfK AG*. I also note that in his judgment Mr Alexander referred to the *Madame* case being an absolute grounds case and appeared to consider this of some significance. The GC cases referred to above are relative grounds cases; clearly the GC considered that the principle of not giving weight to state-of-the-register evidence also applies in cases involving relative grounds issues. As in the *GfK* case mentioned above, no evidence has been provided by the applicant to show that the trade marks identified by them are actually being used in relation to the goods concerned.

39) To my mind the opponent has singularly failed to show that it has a significant reputation in the goods for which its mark has been used. The fact that it has only just cleared the hurdle to show proof of use does not mean that it has established anything other than the most basic reputation. The opponent has not provided turnover figures relating to Class 18 goods only, evidence of market share or any independent trade evidence. Although they have stated that they have sold eleven million items in the years 2004-2008, it is certainly not sufficient for them to enjoy enhanced protection because of reputation. However, I do accept that the opponent’s mark is inherently distinctive for the goods for which it has been used, albeit somewhat low. In saying this I am aware that when the mark was registered it was advertised prior to acceptance. However, I believe that matters have changed somewhat since 1992.

40) I must now determine the average consumer for the goods of the parties. It seems clear that the goods offered by the two parties are aimed primarily at the general public although I accept that the business community will also use the products. However, with regard to the goods in the instant case I do not believe that there is any difference between the business community and the general public in how they will purchase the goods or in the manner in which they will perceive the marks. I will therefore regard the general public as the average consumer. To my mind items

of luggage, bags and the various travel paraphernalia associated with them are not purchased without some degree of care. Even items purchased to aid travelling such as body wallets will be considered for their suitability in relation to material, size, comfort and volume. The average consumer will therefore be reasonably circumspect and observant.

41) I shall first consider the goods of the two parties. The applicant has not made any reference to the goods being similar or dissimilar in its evidence. The two registrations sought by the applicant share identical specifications and so only a single comparison is required. The opponent's specification has been reduced as set out earlier in this decision. For ease of reference, I set out the goods of both parties below:

Applicant's specification	Opponent's specification
Class 18: Leather and imitations of leather, and goods made of these materials and not included in other classes; luggage; trolley cases; holdalls; trunks and travelling bags; rucksacks; backpacks; briefcases; sports bags; bags; umbrellas; wallets; purses; key holders.	"Folding cases; shoulder bags, backpacks, holdalls, beach bags, shoe bags, holsters; money belts, money bags; pouches, purses, wallets, credit card holders; luggage labels and luggage tags; camera cases; all included in Class 18."

42) In carrying out the comparison I will take into account *British Sugar Plc v James Robertson & Sons Ltd* (TREAT) RPC 281. This identified the following as elements to be considered, uses, users, nature, trade channels, where the items are to be found and whether they are in competition. This was endorsed in *Canon*.

43) I also take into account the views of Neuberger J in *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267 stated:

"I should add that I see no reason to give the word "cosmetics" and "toilet preparations" or any other word found in Schedule 4 to the Trade Mark Regulations 1994 anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context. In particular, I see no reason to give the words an unnaturally narrow meaning simply because registration under the 1994 Act bestows a monopoly on the proprietor."

44) In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T- 325/06 the CFI stated:

"It is true that goods are complementary if 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 (see, to that effect, Case T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685 , paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057 ; Case T-364/05 Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-757 , paragraph 94; and Case T-443/05 El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños) [2007] ECR I-0000 , paragraph 48)."

45) To my mind the applicant's goods "luggage; trolley cases; holdalls; trunks and travelling bags; rucksacks; backpacks; briefcases; sports bags; bags; umbrellas; wallets; purses; key holders" are identical or very similar to the opponent's amended specification of "Folding cases; shoulder bags, backpacks, holdalls, beach bags, shoe bags, holsters; money belts, money bags; pouches, purses, wallets, credit card holders; luggage labels and luggage tags; camera cases; all included in Class 18". Clearly, the applicant's specification of "goods made of these materials and not included in other classes" will also be similar to the opponent's specification. There is a far lower degree of similarity between "Leather and imitations of leather" and the opponent's goods.

46) I now turn to consider the marks of the two parties. For ease of reference these are reproduced below:

Applicant's Trade Marks	Opponent's Trade Mark
GO PLAY	GO
GO EXPLORE	

47) The applicant's marks both contain more than one word or element and are, therefore, composite marks. The *Medion* case acknowledges that the overall impression conveyed to the relevant public by a composite mark may, in certain circumstances, be dominated by one or more of its components. The opponent contended that the words "PLAY" and "EXPLORE" could not be considered the distinctive element of the opponent's mark. Mr Malynicz said:

"...the word GO is clearly independent within the words GO EXPLORE and GO PLAY. This is because neither of these two phrases are in fact grammatically or syntactically correct- they should read "GO AND EXPLORE" or "GO AND PLAY". This ellipsis means that, within these marks, the word GO is separate and independent to the second PLAY/EXPLORE – one first goes and then one explores/plays."

48) Whilst I accept these views I cannot place a great deal of weight on the fact that they are grammatically incorrect given the, unfortunate, absence of such standards in society at large. In certain sections of society the command "go play" may be

However, I do believe that as the first part of the marks the word GO assumes significance. The words PLAY and EXPLORE have a degree of meaning when used in relation to what can broadly be termed bags, as one does tend to use different bags for different reasons. Sports holdalls would be best associated with the image of the word "play" whilst backpacks are associated with exploration.

49) In considering the issues I also take into account the views of Mr S Thorley sitting as the Appointed Person in the *REACT* case [2000] RPC 285 where he said:

"[*Counsel*] ...drew my attention to the fact that in relation to clothing of the type for which the mark is to be registered, anybody using the mark aurally would be informed to some extent of the nature of the goods they were proposing to purchase; they will therefore

know of a mark; and they will know what they want. I think there is force in this in the context of purchasing clothes. The Hearing Officer was prepared of his own experience to hold that the initial selection of goods would be made by eye, and I believe this is correct. I must therefore, in taking into account the likelihood of aural confusion, bear in mind the fact that the primary use of the trade marks in the purchasing of clothes is a visual act.”

50) To my mind the goods of the two parties fall firmly within the category of goods which would be selected visually, whether in a store or whilst looking in a catalogue. Visually the marks share the identical initial word, differing only by the use of an additional word in each of the applicant’s marks. The same would hold true for any aural use. Conceptually the marks are identical in the command to “GO”. The only difference being that the applicant’s mark reflect what to do afterwards. The similarities far outweigh any differences.

51) I take all of the above into account when considering the marks globally. To my mind, the similarities in the marks are such that even when used on goods with a very low degree of similarity, as set out in paragraph 45 above I 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. The opposition under Section 5(2) (b) therefore succeeds.

52) As this finding decides the matter I do not propose to comment on the ground under section 5(4)(a).

COSTS

Preparing a statement and considering the other side’s statement	£300
Preparing evidence and considering and commenting on the other side’s evidence	£800
Prepare for and attend a hearing	£800
Official Fee	£200
TOTAL	£2,100

53) As the opponent has been successful it is entitled to a contribution towards its costs. I order the applicant to pay the opponent the sum of £2,100. 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 8th day of September 2010

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