

O-334-04

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2299670
IN THE NAME OF CECIL JONES HIGH SCHOOL**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 91218 IN THE NAME OF BANNER LIMITED**

TRADE MARKS ACT 1994

**IN THE MATTER OF application No 2299670
in the name of Cecil Jones High School**

And

**IN THE MATTER OF opposition thereto under No 91218
in the name of Banner Limited.**

Background

1. On 3 May 2002, Cecil Jones High School applied to register a trade mark in Class 25 in respect of the following specification of goods:

Clothing, footwear, headgear.

2. The mark applied for is as follows:



3. On 6 November 2002, Banner Limited filed notice of opposition against the application, the grounds being in summary:

Under Section 5(2)(b) because the mark applied for is similar to the opponent's earlier trade mark registrations, and is sought to be registered for goods that are identical.

Under Section 5(4)(a) by virtue of the law of passing off.

4. Details of the earlier marks relied upon by the opponents are shown as an annex to this decision.

5. The applicants filed a Counterstatement in which they deny the ground on which the

opposition is based.

6. Both sides request that costs be awarded in their favour.

7. Only the opponents filed evidence in these proceedings. The matter came to be heard on 21 June 2004, when the applicants were represented by Mr Mark Foreman of Rouse & Co, their trade mark attorneys. The opponents were not represented but made written submissions which I have taken into account in my decision.

Opponents' evidence

8. This consists of a Witness Statement dated 17 December 2003, and comes from Kenneth Colin Scates, Non-Executive Chairman of Banner Limited, the opponents. Mr Scates confirms that all of the information contained within his statement comes either from his own knowledge or the records of the company to which he has had full access since 1977.

9. Mr Scates says that since at least the 1950s his company has made continuous use of the trade mark PEGASUS and the flying-horse device in relation to clothing, and that the marks are currently in use in the UK in relation to a range of leisurewear including swimwear, t-shirts, sweat shirts, fleeces, shorts, etc. Exhibit KS1 consists of examples of labels and packaging. The exhibit consists of a plastic bag, presumably used for packaging, bearing the device of a flying horse with the words PEGASUS LEISUREWEAR beneath, a swing-tag bearing the same logo, and a sew-in and adhesive labels bearing the word PEGASUS. There is nothing by which to date the exhibit.

10. Mr Scates gives details of his company's turnover for the years 1993 to 2003, which ranges from a peak of £1,774,000 in 1993, to £1,173,000 in 2001, the last full year prior to the relevant date. He refers to exhibit KS2, which consists of documentation relating to sales of shorts, trousers, shirts, briefs and boxer shorts in the years 1995 and 2002, both prior to the relevant date. He refers to his company as trading with a large number of companies and in various catalogues, mentioning in particular JD Williams, Littlewoods and Great Universal Stores catalogues, Debenhams, British Home Stores and C&A, although he gives none of the useful details such as date of commencement, copies issued, etc. Mr Scates refers to exhibit KS3 which consists of photocopies illustrating the promotion of PEGASUS branded products in a catalogue, but apart from a reference to Spring/Summer, there is no way of dating the exhibit, nor by which to tell the catalogue from which it came. Exhibit KS4 consists of a fax header sheet dated 23 February 1995, giving instructions on washing 21 gauge knitwear, not specifically PEGASUS, although the name is mentioned as part of the company name.

11. Mr Scates goes on to refer to the promotion of his company's PEGASUS branded goods, saying that they participate in a number of trade exhibitions each year, although not what-where-when. He details the amounts spent promoting products under the brand in the years 1994 to 2003, which ranges from a peak of £35,000 in 1995 to £1,000 in 2000.

12. That concludes my review of the evidence insofar as it is relevant to these proceedings.

Decision

13. Turning first to the ground under Section 5(2)(b). That section reads as follows:

“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.”

14. An earlier trade mark is defined in Section 6 of the Act as follows:

“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.”

15. In my consideration of a likelihood of confusion or deception I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] 45 F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723. It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-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*,
- (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*.

16, The opponents rely on seven trade mark registrations, all of which are “earlier marks” within the meaning above. All are for clothing at large, or particular articles of clothing, which, self evidently must be identical goods to “clothing, footwear and headgear”, the specification of the opposed application. Given that there is complete identity in respect of the goods, and that neither the applicants’ or the opponents’ specifications are limited in any way that would distinguish them, I must assume that notionally they are capable of sharing the same channels of trade, from manufacture to retailer, and the same consumer.

17. Whilst marks should be compared as a whole, it is inevitable that in any comparison reference will be made to the various constituent parts of which marks are composed, and rightly so where there is a particularly distinctive or dominant element. Marks also have to be considered in relation to the goods for which they are, used or intended to be used, in this case clothing. Whether bottom end, off-the-shelf items, or exclusive, designer fashion, the purchaser will want to see the item, and will make the selection with a critical eye, ensuring that the correct size, colour, style, etc, and quite often, label is selected. Clearly more care will be given in the purchase of larger items such as suits, dresses and coats where the consumer will be concerned about how well the item fits or suits them. In the *React* trade mark case [2000] RPC 285, Mr Simon Thorley QC, sitting as the Appointed Person considered the question of the importance of the eye and the ear in the selection of clothing, stating:

“There is no evidence to support [Counsel’s] submissions that, in the absence of any

particular reputation, consumers select clothes by the eye rather than by placing orders by word of mouth. Nevertheless, my own experience tells me it is true of most casual shopping. I have not overlooked the fact that catalogues and telephone orders play a significant role in that trade, but in my experience the initial selection of goods is still made by eye and subsequent order usually placed primarily by reference to a catalogue number. I am therefore prepared to accept that a majority of the public rely primarily on visual means to identify the trade origin of clothing, although I would not go so far as to say that aural means of identification are not relied upon.”

18. Whilst *React* indicates that in a case such as this it is the visual similarity of the respective marks that is of primary importance, it does not say that I should give no weight to the question of aural and/or conceptual similarity.

19. Of the opponents’ seven marks, three are for the word PEGASUS, two for the word PEGASUS with a stylised image of a horse with wings, one for the image of the horse on its own, the final mark being the words FLYING HORSE.

20. Mr Foreman put it to me that not everyone would know that PEGASUS is the name of a winged horse, or even recognise the image of a winged horse as being PEGASUS; I have no evidence one way or the other. If it is a point upon which the opponents rely, the onus is upon them to establish that the consumer would be availed of this knowledge. That said, the consumers of clothing must encompass persons from all backgrounds and walks of life, and I do not consider it unreasonable to assume that a proportion would know of PEGASUS, but without an idea of how significant this number would be, this does not take matters much further forward. The position therefore, is that to an indeterminate number of consumers the word PEGASUS may bring to mind a winged horse and send out the same conceptual message as that of the device element of the applicants’ mark. In the case of the opponents’ marks composed of or incorporating the image of a horse with wings, and the one comprising the words FLYING HORSE, these would all convey a similar conceptual idea as the mark applied for.

21. Insofar as a number of the opponents’ marks either consist of or incorporate the image of a horse with wings there must be some visual similarity. However, as Mr Foreman pointed out, the depiction in the opponents’ version is stylised, whereas the applicants use a more “true-to-life” depiction, at least of a horse. There is also the fact that the applicants’ mark includes the letters C.J.H.S. further moving the marks apart to the extent that I would say that they are visually distinguishable.

22. It is generally accepted that a consumer will refer to a composite mark by the word element, which means that five of the opponents’ earlier marks that consist of, or incorporate the word PEGASUS are likely to be known or referred to as “PEGASUS” marks, and the remaining word mark as the FLYING HORSE, mark. The remaining device mark could be described as the “winged horse” mark, and conversely, if the viewer knows of the mythical winged horse, also as a PEGASUS mark. It is of course possible that the consumer aware that PEGASUS is some mythical winged horse could use this knowledge and describe these marks as “winged horse” marks.

23. The question of how the applicants' mark would be referred to orally is somewhat more difficult to answer. Although there is a textual element it is composed of separated letters rather than words, so would a consumer refer to it as the "CJHS" mark? Those who know the meaning of the letters (Cecil Jones High School) may well use the letters as their point of reference, and may even fill in the blanks and use the full name. However, in the case of the consumer with no knowledge of the relevance of the letters, I cannot be certain that this would be the case.

24. There is no suggestion that the opponents' earlier marks, be it the word PEGASUS, the device of the winged horse, or the words "FLYING HORSE" are lacking in distinctive character. There is no connection that I can see with any characteristic of clothing. There is no evidence that tells me whether there are other traders using the words PEGASUS or FLYING HORSE as trade marks in relation to the same or similar goods. They are not the invention of the opponents and it seems possible that other traders may be using the same or similar marks, but I cannot assume that this is competing use. Whilst the image of a winged horse is nothing new, it seems to me that the stylisation of the opponents' version is such that it is likely to be distinctive to them.

25. There is no mention of any use having been made of the trade mark FLYING HORSE, and no details have been provided. I do not therefore need to consider whether that mark has become any more distinctive by virtue of use.

26. Mr Scates states that the opponents have used PEGASUS and the "flying horse device" trade marks since at least the 1950s, and "are currently used in relation to a range of leisurewear". This is a somewhat ambiguous statement and leaves open the question of whether the opponents have been using the mark in the UK since that date, and if so, in connection with what goods? Given that some of the opponents' marks date from 1939 to 1953, it seems more likely than not that there has been use in the UK, from the date given by Mr Scates, and in respect of at least some of the goods for which they are registered, that is, articles of clothing. But of course, the mere fact that a trade mark has been registered is not proof that it has been used, and I do not consider that I can or should use their existence as a basis for inferring use.

27. Evidence showing use prior to the relevant date is thin to say the least, consisting of one invoice dating from 2002, and a memoranda dating from 1995 giving details of an order. It refers to clothing, namely menswear, sold under the name PEGASUS. Exhibit KS1 shows the PEGASUS name being used on a sew-in tag and sticky labels, the composite mark on a swing tag and plastic bag. None of these can be dated as originating prior to the relevant date. Exhibit KS3 depicts examples of PEGASUS menswear, namely, sweaters, shorts, T-shirts and polo shirts. These show the PEGASUS name, but nowhere is there any use of the composite mark, the "winged horse" device on its own, or the mark FLYING HORSE.

28. Mr Scates provides figures relating to turnover for the years 1993 to 2003, which range from a peak of £1,774,000 in 1993, to £1,173,000 in 2001, the last full year prior to the relevant date. Although I have no evidence that puts these figures into context, in relation to the clothing market as a whole, it seems to me that whilst not insignificant, they must be quite modest.

29. Mr Scates refers to his company as having traded with a large number of companies, and in various catalogues, mentioning some well known high street retailers and catalogue names. However, he does not provide any of the basic information such as whether this was prior to the relevant date, in relation to what goods, etc, essential in determining whether the use has built or enhanced a reputation. Accordingly this information is of little or no assistance.

30. In relation to the promotion of the mark, Mr Scates provides bald figures on expenditure. He exhibits photocopies illustrating the promotion of PEGASUS branded products in one mail order catalogue, but does not name the catalogue, give any details of the number of copies issued or even whether it was available in the UK prior to the relevant date. Accordingly, this evidence provides little or no useful detail. The same is the case in relation to his company's attendance at trade exhibitions.

31. On my assessment, the evidence suggests that the opponents have used, and are likely to have established a reputation in respect of the word PEGASUS in relation to "menswear", but not that this is the case in respect of their "winged horse" device, whether on its own or with the word PEGASUS. On the evidence before me I have no difficulty in coming to the position that whilst there has been use, it does not establish that the marks have become any more distinctive by virtue of this use, or that they deserve protection beyond the usual penumbra.

32. It seems to me that much of the opponents' case relies upon the consumer fixing, if not the image, then the idea of a winged horse in their mind, and the possibility of confusion arising through imperfect recollection. In relation to the opponents' marks for the word PEGASUS solus, for there to be any confusion through imperfect recollection would require the consumer to have a prior knowledge that PEGASUS is a winged horse. I have no evidence and do not consider that I can assume this is the case. In respect of the opponents' "winged horse" device, there is a clear difference in the stylisation and manner of representation to that of the applicants' version, such that I do not consider that the consumer will confuse one for the other, and the presence of the letters make this even less likely.

33. Taking all of the circumstances into account and adopting the Aglobal@ approach advocated, I come to the view that whilst there is notionally identity in the goods and trade, and some similarities in the respective marks, this at best may cause some consumers to recall the opponents, but I see no reason why this would lead them to believe that the goods of the applicants are those of the opponents, or into speculating whether the applicants and/or their goods are in some way connected with the opponents. Accordingly, the ground under Section 5(2)(b) fails.

34. Turning to the ground of opposition under Section 5 (4) (a) of the Act which states:

“5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an earlier right in relation to the trade mark.”

35. No reference is made to any rule of law other than the law of passing off. Mr Hobbs QC set out a summary of the elements of an action for passing off in *WILD CHILD* [1998] RPC 455. The necessary elements are said to be as follows:

- (a) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (b) that there is a misrepresentation by the defendant (whether or not intentional leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and
- (c) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

36. In my consideration of the grounds under Section 5(2)(b), I determined that the evidence of use provided by the opponents showed that they were likely to have built a reputation in the mark PEGASUS in respect of menswear, but not in relation to the “winged horse” device or their FLYING HORSE word mark. I believe it follows that through the use made, the opponents will also have established a corresponding goodwill in the mark PEGASUS.

37. The mark applied for is not the word PEGASUS, but the image of a winged horse with the letters C.J.H.S placed beneath. Whilst a word mark can describe and be considered similar to an image, for example, BEAR and the image of a bear, in my analysis I expressed my uncertainty as to whether the consumer would make the conceptual link between the word PEGASUS describing a winged horse of Greek mythology, and the applicants' mark. The meaning of the word BEAR will be readily understood by most consumers; it is an everyday word describing a well known animal. Likewise, a reasonably ordinary depiction of a BEAR will be easily recognised. I do not consider that the same can be said of the word PEGASUS. I stated that the onus of establishing this must rest with the opponents; they have not done so. I do not, therefore, consider that I can infer that use of a mark consisting of the image of a winged horse, with or without the letter C.J.H.S, constitutes a misrepresentation likely to lead the public to believe that the goods offered under the mark, are the goods of, or connected to the opponents. Accordingly, I do not see that the opponents will suffer damage as a result of the applicants' use of their mark, and the ground under Section 5(4)(a) is dismissed.

38. The opposition having failed on all grounds, the applicants are entitled to an award of costs. I hereby order that the opponents pay to the applicants the sum of £1,750 as a contribution towards their costs. 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 this case if any appeal against this decision is unsuccessful.

Dated this 8th day of November 2004

**Mike Foley
for the Registrar
the Comptroller General**

ANNEX IS NOT ATTACHED