

O-336-04

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2031730B
BY BAUER NIKE HOCKEY INC
TO REGISTER THE TRADE MARK:**

BAUER

IN CLASSES 18, 25 AND 28

AND

**THE OPPOSITION THERETO
UNDER NO 49627
BY
EDDIE BAUER, INC**

Trade Marks Act 1994

**In the matter of application no 2031730B
by Bauer Nike Hockey Inc
to register the trade mark:**

BAUER

**in classes 18, 25 and 28
and the opposition thereto
under no 49627
by Eddie Bauer, Inc**

BACKGROUND

1) On 21 June 1995 Canstar Sports Inc applied to register the above trade mark (the trade mark). The application now stands in the name of Bauer Nike Hockey Inc, which I will refer to as BNH. Prior to being in the name of BNH it was in the name of Bauer Inc. The application was divided. Application no 2031730B was published for opposition purposes in the "Trade Marks Journal" on 6 January 1999 with the following specification:

sports bags, bum bags, shoulder bags and backpacks;

pants, tops, gloves, jerseys and underwear, all for use in skating and hockey; caps, T-shirts and warm-up jackets;

bags adapted for carrying ice hockey, hockey, roller skate and in-line skate equipment.

The above goods are in classes 18, 25 and 28 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended. The publication advised that the application had proceeded to publication on the basis of honest concurrent use with trade mark registration nos 1495576 (twice) and 1522624.

2) On 1 April 1999 Eddie Bauer, Inc, which I will refer to as EBI, filed a notice of opposition to the application. EBI states that it owns various United Kingdom trade mark registrations which are similar to the trade mark and which are for identical or similar goods in classes 18 and 25. Consequently, there is a likelihood of confusion and registration of the application would be contrary to section 5(2)(b) of the Trade Marks Act 1994 (the Act). EBI's opposition is based upon ten trade mark registrations/applications. Of these one was withdrawn before registration and three were filed on the same date as the application or afterwards (see Staiger trade mark [2004] RPC 33 re applications made on the same date). Consequently, EBI case rests upon six trade mark registrations:

- Registration no 1522621 of the trade mark **EDDIE BAUER**. It is registered for the following goods:

printed matter; printed publications; catalogues; mail order catalogues; all included in Class 16.

The registration includes the following disclaimer:

“Registration of this mark shall give no right to the exclusive use of the word "Bauer".”

- Registration no 1522622 of the trade mark:



It is registered for the following goods:

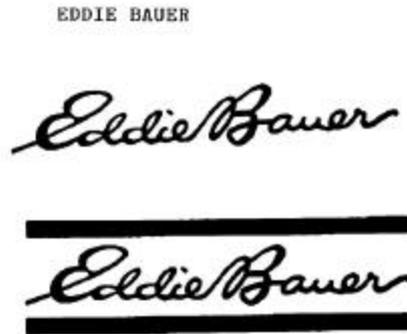
furniture; mattresses; cots; pillows; sleeping bags; parts and fittings for all the aforesaid goods; all included in Class 20.

The registration includes the following disclaimer:

“Registration of this mark shall give no right to the exclusive use of the word "Bauer".”

Despite appearances to the contrary this is not a registration for a series of trade marks.

- Registration no 1522623 of the trade mark:



It is registered for the following goods:

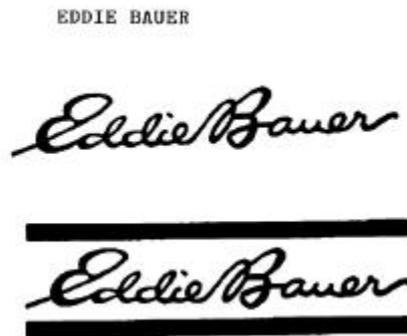
bed clothes; bed linen; bed covers; blankets; wool blankets; quilts; all included in Class 24.

The registration includes the following disclaimer:

“Registration of this mark shall give no right to the exclusive use of the word "Bauer".”

Despite appearances to the contrary this is not a registration for a series of trade marks.

- Registration no 1522624 of the trade marks (a series of three):



It is registered for the following goods:

nightwear; coats, shirts; rainwear, hats, caps; skirts, dresses; socks; men's and women's jackets and slacks, belts; underwear; trousers; gloves; boots and shoes of leather and rubber and combinations thereof, sandals, slippers; parkas and

sweaters and/or cardigans; children's jackets, women's jumpers; down vests (outwear); men's and women's swimwear; all included in Class 25.

The application was advertised before acceptance and proceeded to advertisement on the basis of honest concurrent use with registration no B1071688

- Registration no 2023636 of the trade mark **EDDIE BAUER**. It is registered for the following goods:

organisers and organiser covers;

goods made of leather, imitation leather or leather type materials; bags and cases; briefcases; purses; handbags; duffel bags; luggage; wallets; cheque book covers; backpacks; tote bags; but not including sports bags and bags adapted for carrying sporting articles.

The above goods are in classes 16 and 18 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

- Registration no 2023643 of the trade mark:

The image shows a handwritten signature in black ink that reads "Eddie Bauer". The signature is written in a cursive, flowing style with a prominent 'E' and 'B'.

It is registered for the following goods:

articles of outerclothing.

The above goods are in class 25 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

The application was published on the following basis:

“Proceeding because of prior rights in Registration No 1522624 (6109,291)”.

- 3) EBI seeks refusal of the application in respect of the goods in classes 18 and 25 of the specification and an award of costs.
- 4) BNH filed a counterstatement in which it denies the grounds of opposition. BNH seeks the dismissal of the opposition and an award of costs.
- 5) Only BNH furnished evidence.

6) Both sides were advised that it was believed that a decision could be made without recourse to a hearing. However, the sides were advised that they retained their rights to a hearing. Neither side requested a hearing. BNH furnished written submissions which I have taken into account in reaching my decision.

EVIDENCE

Evidence of BNH

Witness statement of Philip Dean Towler

7) Mr Towler is a trade mark attorney. His witness statement adduces into the proceedings a statutory declaration and accompanying exhibits filed by John Raymond Cawston to demonstrate honest concurrent use with trade mark nos 1522624, 2023636, 2023638 and 2023643 in respect of the application at ex parte stage.

Statutory declaration of John Raymond Cawston

8) Mr Cawston is managing director of Fagans Ltd. Mr Cawston states that Fagans Ltd has been a distributor of the goods of Bauer Inc, formerly Canstar Sports Inc, in the United Kingdom since 1977. Mr Cawston states that he believes that the trade mark has been used in the United Kingdom since 1966. He states that the trade mark has been used continuously in relation to the following goods:

ice skates, roller skates and replacement parts therefor (since 1976);

in-line skates and replacement parts therefore (since 1987);

replacement parts for ice skates, roller skates and in-line skates such as blades, blade runners, blade holders, goal skate cowling, wheels, bearings, brakes, liners, insoles and laces (since 1976);

equipment for skating, equipment for hockey, equipment for players, goal tenders and referees, in particular jerseys, socks and stockings, helmets, honey pucks (since 1976);

other equipment, in particular gloves, pants (since 1990);

hockey sticks (since 1991);

protective equipment such as shoulder pads (since 1989);

shin guards (since 1990);

elbow pads, knee pads, wrist guards, guard gloves (since 1991);

clothing such as underwear, garter belts, suspenders, caps, hats, t-shirts, rink suits, gym suits, jogging suits, sports shoes, compression shorts, tights, racing shirts, warm-up jackets, sports shoes, shower sandals (since 1976);

sports bags, fanny packs, duffle bags (since 1976);

friction tapes for hockey sticks and hockey equipment (since 1976).

9) Mr Cawston exhibits at JC1 copies of the following brochures: Bauer European Collection 95, Bauer Ice Hockey Collection 97 and Bauer Goalie Collection 97. The vast majority of the goods shown are specifically designed for use in ice hockey. Mr Cawston states that the approximate annual turnover figures for the sale of Bauer goods in the United Kingdom is as follows:

1984	£92,000
1985	£46,000
1986	£54,000
1987	£202,000
1988	£1,046,000
1989	£1,438,000
1990	£1,178,000
1991	£1,104,000
1992	£956,000
1993	£2,006,000
1994	£3,068,000
1995	£5,786,000
1996	£10,338,000
1997	£7,992,000

The above figures represent estimated retail value.

10) Mr Cawston states that the goods have been advertised in “Harpers”, “Sports Trader”, “Sports Update”, “Ice Hockey News Review”, “Wembley Ice Hockey Championship Programmes”, local papers such as the “Bournemouth Evening Echo” and evening newspapers such as “The Evening Standard” and “Time Out” (sic). Exhibited at JRC2 are what Mr Cawston describes as “copy specimens” of advertising. There are three pages, none of which have any indication of publication or date. One page refers to Bauer’s in-line skates, one (a very poor copy) seems to show someone wearing skis, the final page shows in-line skates. Mr Cawston states that there have been miscellaneous promotions such as at Burger King and Lloyds Bank. He states that the goods have been advertised on radio stations, including Radio Glasgow, 2CR (Two Counties Radio) and Capital FM. Mr Cawston states that the total annual advertising expenditure has been approximately 1% of turnover. Mr Cawston states that the goods have been exhibited at the annual trade fair EXSL from 1980-1995 as well as at various other exhibitions such as Clothes Show Live (December 1994), Fitness Expo (April 1994 and 1995) and Capital FM Extra (May 1995). Mr Cawston states that the goods are sold throughout the United

Kingdom to “quality” sporting retailers and ice rinks. He states that reference to the goods have appeared in magazine articles. He exhibits a copy of an article from “Sports Trader” of June 1995. The article deals with in-line skates and roller hockey equipment. At JR4 Mr Cawston exhibits copies of a recent brochure relating to in-line skates and a Bauer In-Line 98 Brochure.

DECISION

Likelihood of confusion – section 5(2)(b) of the Act

11) According to section 5(2)(b) of the Act a trade mark shall not be registered if because:

“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.”

Section 6(1)(a) of the Act defines an earlier trade mark as:

“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”

In determining the question under section 5(2)(b), 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 and *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77 and *Marca Mode CV v Adidas AG and Adidas Benelux BV* [2000] ETMR 723.

Comparison of goods

12) In its submissions BNH concedes that the goods encompassed by registration nos 2023636, 1522624 and 2023643 are identical or similar to the goods of the application.

Comparison of trade marks

13) As the first of the series of trade mark registration no 1522624 and the trade mark the subject of registration no 2023636 are the words EDDIE BAUER, with no stylisation, I consider that these represent EBI's best chance of success. The signature form of the trade mark, without proof of education of the public, raises issues as to how it will be seen. There is certainly no certainty that the surname will be read as Bauer. So, the trade marks I will compare are as follows:

Application:



Earlier registrations:

EDDIE BAUER

14) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Sabel BV v Puma AG*). 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*). Consequently, I must not indulge in an artificial dissection of the trade marks, although taking into account any distinctive and dominant components. The average consumer 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 BV*). "The analysis of the similarity between the signs in question constitutes an essential element of the global assessment of the likelihood of confusion. It must therefore, like that assessment, be done in relation to the perception of the relevant public" (*Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02).

15) There is some stylisation of the word Bauer in the application, it is in a mixture of upper and lower case letters. However, I do not consider that it can be denied that it will be seen as the word Bauer. There is a clear coincidence in the presence of the word Bauer and both trade marks. In EBI's trade mark the Bauer element, owing to the presence of the well-known forename Eddie, is likely to be seen as a surname. Bauer might, or might not, be seen by the average United Kingdom consumer as a surname on its own. However, I consider that faced with a forename before Bauer the natural reaction will be to see Bauer as a surname and the whole as a personal name. Custom and habit will determine perception.

Conclusion

16) Is there a likelihood of confusion owing to the common presence of the word Bauer? BNH states that there has been on confusion in the market place. However, this tells me little. BNH has been using its trade mark in relation to ice skating and skating goods. Mr

Cawston states that the goods have been sold to “quality” sporting retailers and ice rinks, a limited market. There is also no clear indication as to the extent of sales of individual goods. A lot of the goods that Mr Cawston identifies in his declaration are not under consideration in this opposition eg protective equipment, hockey sticks and skates, which from the evidence would appear to be the core of BNH’s business. There is also no evidence that EBI has been using its trade mark. BNH’s evidence does not show concurrent use of its trade mark and that of EBI but use of its trade mark; and for many goods that are not in conflict. As Jacob J stated in *Origins Natural Resources Inc v. Origin Clothing Limited* [1995] FSR 280:

“It sticks in one's gullet to think that a trade mark proprietor is better off *vis-à-vis* a competitor claiming honest concurrence because he has not used his mark than if he has.”

More recently in *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 Laddie J stated:

“22. It is frequently said by trade mark lawyers that when the proprietor's mark and the defendant's sign have been used in the market place but no confusion has been caused, then there cannot exist a likelihood of confusion under Article 9.1(b) or the equivalent provision in the Trade Marks Act 1994 ("the 1994 Act"), that is to say s. 10(2). So, no confusion in the market place means no infringement of the registered trade mark. This is, however, no more than a rule of thumb. It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place.”

On the basis of the evidence before me I cannot see that BNH’s use of its trade mark assists it. It has used its trade mark in a very specialised area and there is nothing to suggest that EBI has used its trade mark in that area, if at all. Consequently, I do not consider that the use by BNH is indicative that there is not a likelihood of confusion in the market place.

17) The European Court of Justice held that a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*). BNH concedes that the

respective goods are identical or similar. The class 18 specification of registration no 2023636 encompasses all the goods of the application with the exception of *sports bags*. However, the specification includes all other types of bags and so will inevitably encompass similar, indeed highly similar goods. The dividing line between a *sports bag* and a holdall (which would be included in both *bags* and *luggage*) is both fine and blurred. The class 25 goods of the application will be included or overlap with the goods of registration no 1522624 and so are identical (see the decision of Professor Annand, sitting as the appointed person, in *Galileo International Technology LLC v Galileo Brand Architecture Limited* BL 0/269/04 re identity and overlap of goods).

18) The distinctiveness or otherwise of the earlier trade mark has to be taken into account. The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public (European Court of First Instance Case T-79/00 *Rewe Zentral v OHIM (LITE)* [2002] ETMR 91). In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgement of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ETMR 585). In this case Eddie Bauer appears to be a personal name. There is no evidence that Bauer is a common surname or that Eddie Bauer is commonly used in the trade. I am of the view that Bauer in the United Kingdom is an unusual name. I have certainly never come across it before. I can see nothing that would suggest that Eddie Bauer cannot function fully and effectively as a trade mark and indicate trade origin; that it will not clearly identify the goods of one undertaking. As a personal name with an unusual surnominal element I consider that it enjoys a good deal of inherent distinctiveness.

19) EBI has filed no evidence so there is no question of an enhanced penumbra of protection through reputation.

20) I need to bear in mind the average consumer for the goods and the nature of the purchasing process. I also have to take into account that the average consumer rarely has a chance to compare trade marks directly; he or she has to rely on memory and so may imperfectly recollect the trade marks. The nature of the goods in question does not dictate their cost. Clothing and bags can vary from the dirt cheap to the exceptionally expensive. However, in my experience, many purchasers of clothing are brand conscious. So, I consider that a reasonable degree of circumspection will be exercised in relation to the purchasing of clothing. I do not believe, as yet, that the same degree of brand consciousness applies to the class 18 goods of the respective trade marks.

21) In considering the respective trade marks I need to bear in mind their differences as well as their similarities (see the decision of Mr Hobbs, sitting as the appointed person in *Lee Alexander McQueen v Nicholas Steven Croom* BL O/120/04). In the trade mark of

EBI there is the forename and there is the limited stylisation of the word Bauer in the trade mark of BNH. Taking into account the identity/proximity of the goods, the nature of the purchasing decision, the average consumer for the goods, who will be the public at large, I am of the view that there is a likelihood of confusion. I consider that the average consumer is likely to think, especially owing to the unusual nature of the word Bauer, that the goods come from the same economic undertaking; that use of Bauer is use of the surname element of Eddie Bauer. It is common habit to describe people both by their full name and their surname.

22) The application is to be refused under section 5(2)(b) of the Act in respect of all the goods in classes 18 and 25.

23) BNH should file, within one month of the expiry of the appeal period from this decision, form TM21 to amend the specification by the deletion of classes 18 and 25. If form TM21 is not filed within the period set the application will be refused in its entirety. (If an appeal is filed the period for filing form TM21 will be one month from the final determination of the case, if the appeal is unsuccessful.)

COSTS

24) Eddie Bauer, Inc has been successful in this opposition and so is entitled to a contribution towards its costs. I order Bauer Nike Hockey Inc to pay Eddie Bauer, Inc the sum of £700. 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 9th day of November 2004

**David Landau
For the Registrar
the Comptroller-General**