

**TRADE MARKS ACT 1938 (AS AMENDED) AND  
TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No 1527775  
BY MUSTANG SURVIVAL CORP TO REGISTER  
A MARK IN CLASS 9**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER  
No 43599 BY MUSTANG-BEKLEIDUNGSWERKE GMBH & CO**

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TRADE MARKS ACT 1994**

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**IN THE MATTER OF Application No 1527775 by  
Mustang Survival Corp to register a mark in Class 9**

**and**

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**IN THE MATTER OF Opposition thereto under  
No 43599 by Mustang-Bekleidungswerke GmbH & Co**

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**DECISION**

On 23 February 1993 Mustang Engineered Technical Apparel Corp applied for the following  
mark:

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in respect of a specification of goods which reads:

"Wet suits, life jackets, life vests and harnesses, buoyancy aids, industrial, commercial  
and recreational flotation garments and devices; all included in Class 9."

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The application is numbered 1527775 and claims an international priority date of 15 October  
1992. The application was later assigned to Mustang Survival Corp.

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On 30 November 1995 Mustang-Bekleidungswerke GmbH & Co filed notice of opposition to  
this application. In summary the grounds are:

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- (i) under Section 12(1) by reason of a number of registrations standing in the  
name of the opponents (see Annex for details)
- (ii) under Section 11 having regard to the use of the opponents' mark MUSTANG.  
In particular the opponents say that use is liable to be prevented by virtue of  
their passing-off rights

(iii) under Section 17 in that the application was made in bad faith.

The applicants filed a counterstatement denying the above grounds.

5 Both sides ask for an award of costs in their favour.

Both sides filed evidence. Neither side has asked for a hearing. Acting on behalf of the Registrar and after a careful study of the papers I give this decision.

10 By the time this matter came to be decided, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. In accordance with the transitional provisions set out in Schedule 3 to that Act however, I must continue to apply the relevant provisions of the old law to these proceedings. Accordingly all references in the later parts of this decision are references to the provisions of the old law.

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### **Opponents' evidence**

The opponents filed three statutory declarations as follows:

20 Heiner Sefranek - dated 4 November 1996

John Richard Hicklin - dated 8 November 1996

Christopher Scotney - dated 15 November 1996

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Mr Sefranek does not say what position he holds but has been associated with the opponent company for 22 years. He is fully conversant with the English language.

30 Mr Sefranek starts by giving details of his company's marks (see Annex) and notes that the applicants, in addition to the current application in Class 9, have an application in Class 25. He says that his company is the only one which has registered and used a trade mark comprising the word MUSTANG in connection with clothing, footwear and headgear.

35 Mr Sefranek says that it is common in the industry for manufacturers of floatation garments to also produce and market outdoor and sports clothing such as anoraks, jackets, T-shirts and other clothing under a single trade mark. Examples of such trade marks used on both floatation garments as well as clothing include: O'Neil, Body Glove, Musto, Henri Lloyd, Yak and Gill [Gul?]. He exhibits (MBG-1) copies of extracts from catalogues which show use of these trade marks on both protective and outerwear clothing.

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He adds that floatation garments are commonly sold in the same stores as and displayed alongside clothing including in sailboat chandleries, canoeing shops, surf shops and water ski shops.

45 He also exhibits (MBG-2) a copy of a brochure by Mustang Engineered Technical Apparel (the previous applicants) showing use of the trade mark MUSTANG SURVIVAL on both floatation garments and outerwear clothing. He says his company produces and sells items of

outerwear clothing under the MUSTANG trade mark of a similar type to some of those represented in exhibit MBG-2. He suggests that members of the public would consider them to be items of clothing which might be described as spray jackets, sailing jackets and pants and fishermans vests.

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He also notes that some of them are described as including 'floatation systems'. It is not, therefore, clear whether these are clothing for the purposes of Class 25 or floatation garments as described in the Class 9 application. He believes that the public would be confused.

10 Mr Hicklin is a partner in John Hicklin Agencies, which he describes as a competitor to the opponent company. He says he has no connection or association with the opponents other than that he distributes jeans for JOOP! GmbH and that the opponents manufacture jeans for JOOP! GmbH. He has 20 years experience in the fashion industry. He associates the various MUSTANG marks with the opponents. When he learnt of the application in suit he says his  
15 initial reaction was that the applicants must be associated with the opponents or have obtained a licence from them.

Like Mr Sefranek he says he is aware of various trade marks which are used on floatation garments as well as articles of clothing such as O'Neill, Fanatic, Henri Lloyd, Quicksilver, Yak  
20 and Crewsaver. He exhibits (JH-1) extracts from magazines in support of this point along with catalogues from Yak and Crewsaver. He says he understands that Crewsaver Ltd who distribute CREWSAVER and YAK clothing in the UK also distribute the applicants' goods.

He says that floatation garments are commonly displayed and sold alongside outdoor clothing.  
25 He is aware of a number of shops which sell floatation garments alongside articles of clothing, such as: Ocean Sports, Fun Sport, The Loft, Climax Sports, Harbour Sports. He says that pages 36, 37, 43, 65 (WINDSURF Magazine) and 60, 65 (BOARDS Magazine) of the magazines marked Exhibit JH-1 support this view.

30 Mr Scotney is the Managing Director of Christopher Scotney Ltd, a competitor of the opponents. He too is experienced in the clothing and fashion industry. His evidence covers much the same ground as Mr Hicklin. I do not, therefore, propose to record it in detail. Suffice to say that he too exhibits (CS-1) extracts from magazines and catalogues (Musto, Henri Lloyd and Windsurf) to show the use of trade marks on floatation garments and  
35 outerwear clothing.

### **Applicants' evidence and further evidence**

40 The applicants filed declarations dated 19 June and 7 August 1998 by Robert Askew, the Vice President of Government Programs of Mustang Survival Corp.

Mr Askew says that the company was founded in Canada in 1967 and has from the first specialised in safety clothing. The logo that is the subject of the current application has been used since 1992. In relation to this country he goes on to say:

"My company first entered the UK market in 1972. My company's products were sold in the UK through our distributor at the time, Protector Safety, who were based in London. This company imported my company's flotation coats and suits.

5 In 1973, we had significant sales to two off-shore North Sea clients, Brown and Root and J. Ray McDermott, the latter who purchased over \$150,000.00 worth of Mustang flotation suits.

10 In 1977, we moved our distribution of our products in the UK to a new distributor, Cosalt. They had initial success in selling the suits and coats, although not on a grand scale. The company decided to discontinue selling our brand of products in the early 1980s.

15 Aim Safety of Bournemouth became our military sales agent including sales in aviation and distributor for commercial products in 1991. This company imported into the UK small quantities of suits and coats during the years 1991 to 1994. However, due to a feeling in my company that Aim Safety were too limited in their resources and financial position to benefit my company, we transferred the Distribution Licence to Crewsaver Limited of Gosport in 1994.

20 Crewsaver Limited are best known to [for] their inflatable life jackets and my company entered into a very successful relationship, which allowed us to manufacture Crewsaver life jackets under licence from Crewsaver Limited for the North American market. Crewsaver in turn sold Mustang products in the UK although sales never  
25 exceeded £10,000.00 per year.

30 As Crewsaver did not seem to be making great efforts to sell the Mustang Survival products in the UK, my company terminated the relationship with them in 1996 and have sold products through a new distributor, Survival Systems International of Great Yarmouth since that date. This company sold £13,000.00 of Mustang Survival products in the UK during 1997."

More recently it seems that the company has launched its own UK sales offices and  
35 <distribution resources'.

Mr Askew says the company has invested in many trade shows over the past seven years. They have had a stand at every SASMEX (Safety at Sea Conference) in the UK during that period and have also advertised in the Safety at Sea magazine along with many press releases.

40 He exhibits (MJ1) an example of the international brochure issued by the company, showing the products manufactured.

He says that MUSTANG SURVIVAL has been a brand for personal survival products. The company has no intention of entering the mainstream clothing market. He adds:

5 "My company's ambition is aimed at industries and pursuits which require safety clothing of this nature. Therefore, my company's reputation well exceeds its sales in such markets in the UK. Mustang is well known by the regulatory community, military, RNLI and coast guards. It is also well known by yachtsman and fisherman. Much of its reputation goes back to the success of my company and [in] other parts of the world and the relatively close knit community which exists in these markets."

10 He goes on to refer to negotiations between the parties regarding a possible co-existence agreement in North America and Europe. He is not aware of any instances where confusion has arisen and regards the respective products as being very different as well as having different consumer bases and channels of distribution.

15 In a further declaration Mr Askew details his past experience of working for various organisations in this country. During the course of his employment with UK firms he obtained Mustang Survival Corp's floatation suits for technical analysis. The suits were obtained from Mustang Survival Corp's distributors at the time. He says that from his working experience (from 1973 to 1981) he knew that the applicant's products were well known to industry in this country.

20 **Opponents' evidence in reply**

Two further declarations have been filed by Teresa Anne Bucks and Peter Pytiak.

25 Ms Bucks is a partner in Boulton Wade Tennant, the opponents' professional representatives. She notes the applicants' claims and speculates that the use referred to is intended to prove prior or concurrent use alongside her clients' registrations. She further notes that the application has been assigned and says that use of the trade mark by the new proprietors is not use by the original applicant and is not relevant to these proceedings.

30 Mr Pytiak is the Export Manager of the opponent company. He responds to Mr Askew's declarations. His main points are:

35 S the only evidence supplied by Mr Askew in support of his claims is a brochure which post dates the filing date of the application

S the applicants have shown intermittent use only and low levels of sales

40 S a further snapshot of the opponents' own use is given for the years 1986 and 1989 along with company brochures for 1985, 1986 and 1989 (Exhibit PP1)

S information is supplied on the opponents' international advertising budget along with a typical advertising schedule (PP4), examples of advertisements placed (PP5), and photographs from exhibition attendance (PP6)

S Mr Askew comments on the similarity of the way in which the parties' marks are used (PP2 and PP3) and the fact that the applicants' goods are not exclusively survival products but include items which are more in the nature of fashion or sports type clothing.

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That completes my review of the evidence.

I go on to consider the grounds of opposition. These are principally under Sections 11 and 12 of the Act which read as follows:-

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"11. It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.

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12.-(1) Subject to the provisions of subsection (2) of this section, no trade mark shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of:-

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- a. the same goods
- b. the same description of goods, or
- c. services or a description of services which are associated with those goods or goods of that description."

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The reference in Section 12(1) to a near resemblance is clarified by Section 68(2B) of the Act which states that references in the Act to a near resemblance of marks are references to a resemblance so near as to be likely to deceive or cause confusion.

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The established tests for objections under these provisions are set down in Smith Hayden and Company Ltd's application (Volume 1946 63 RPC 101) later adapted, in the case of Section 11, by Lord Upjohn in the BALI trade mark case 1969 RPC 496. Adapted to the matter in hand, these tests may be expressed as follows:-

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**(Under Section 11)** Having regard to the user of the mark MUSTANG (and device) is the tribunal satisfied that the mark applied for, MUSTANG SURVIVAL (and device), if used in a normal and fair manner in connection with any goods covered by the registration proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of person?

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**(Under Section 12)** Assuming user by the opponents of their mark, MUSTANG in a normal and fair manner for any of the goods covered by the registration of that mark, is the tribunal satisfied that there will be no reasonable likelihood of deception amongst

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a substantial number of persons if the applicants use their mark MUSTANG SURVIVAL and device normally and fairly in respect of any goods covered by their proposed registration?

5        Note: I have framed the Section 11 test on the basis of the predominant use by the opponents which is the word MUSTANG in conjunction with the device of a horse. See also my comment below in relation to the nature of the opponents' claim.

10      I will deal firstly with Section 12. For this purpose I propose to base my consideration on the opponents' registration No 907716 for the mark MUSTANG solus. The opponents will not be in any better position on the basis of their other registrations. Although the applicants' mark is a composite one consisting of the words MUSTANG SURVIVAL and the device of a seahorse I have little doubt that the word MUSTANG would be seen as one of the essential  
15 features and would be the element by which it would be known and referred to. In their counterstatement the applicants suggested that the parties' marks were distinguishable though I note that Mr Askew refers to his company's mark as MUSTANG or MUSTANG SURVIVAL. Notwithstanding the composite nature of the mark applied for I find that it resembles the opponents' mark MUSTANG in one of its essential elements such that there is a  
20 likelihood of confusion.

Turning to the goods themselves the opponents base their case on the fact that there is a conflict between the goods applied for (wet suits, flotation garments etc) and articles of clothing in Class 25. They have filed evidence suggesting that a number of traders span both  
25 categories and that commercial outlets will or can stock both sets of goods. The applicants say that that is going too far, that their goods are sold as survival products and that they have no intention of entering the mainstream clothing market.

The standard test for deciding if goods are of the same description is that laid down in  
30 Jellinek's application (63 RPC 59). The Court's guidance is that consideration should be given under three headings viz - the nature of the goods, the purpose of the goods and their respective channels of trade. As noted in the Registry's Work Manual (Chapter 10) - "In practice, if it is considered that the respective goods coincide in respect of two headings then this is sufficient to justify a finding that the goods are of the same description. (See the  
35 Floradix case 1974 RPC 583)."

As a general rule the Registry regards all items of clothing as being of the same description whether designed to protect the wearer or not. However that broad approach must of necessity be adjusted in the light of the particular circumstances concerned. Thus some types  
40 of protective clothing for use in highly specialised environments would have insufficient in common with other types of clothing to be considered goods of the same description on the basis of the above test. Each case must be considered on its merits.

For the purpose of the Section 12 test I must consider notional use of the opponents' mark in  
45 relation to any of the goods in their specification. In the case of registration No 907716 this would cover a very wide range of outerclothing including, for instance, protective clothing for use in inclement weather conditions and protective clothing (wet suits and the like) for use by

yachtsmen, surfers and other water sport enthusiasts. The opponents' specification would not include clothing for protection against accident or injury or specific items such as protective clothing for diving (such goods are appropriate to Class 9). Nevertheless it will be clear from the above that the dividing line between Class 9 and Class 25 goods can be a fine one.

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The applicants' goods include for instance wet suits which could be appropriate to either Class 9 or 25 depending on their precise purpose. The applicants' exhibit MJ1 shows a range of floatation suits and foul weather gear (suits, vests, bibs, coats etc). Some of these items appear to be aimed at what one might call the professional market such as coast guards, commercial fishermen, offshore workers and 'serious sailors'. Others are targeted at leisure sailors and sports users such as jet ski riders, fishermen etc.

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As the opponents have pointed out, also included in the applicants' brochure are items such as bomber jackets, hats etc which from their appearance would not be out of place as casual/leisurewear on land. The conclusion I draw from all this is that the nature and purpose of the applicants' goods (assuming they are indeed appropriate to Class 9) are very close to their counterparts in Class 25.

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Much is made in the opponents' evidence about the number of firms and commercial outlets offering both wet suits/floatation garments and other types of outerclothing. The applicants have not succeeded in casting doubt on this position. I am persuaded that the evidence supports the opponents' claim in relation to channels of trade. The opponents refer also to the fact that at one time the applicants had a co-pending application filed on the same date in Class 25 for "Outerwear clothing; hoods, vests, trousers; industrial and commercial floatation clothing; recreational floatation clothing; inflatable floatation clothing; protective, safety and survival clothing; waterproof clothing; wet suits". Although that application stands refused (and may in any case have given rise to classification issues) it suggests that the applicants were well aware of the difficulty of separating out the various types of protective clothing between the two classes.

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In summary I find that the marks are confusingly similar and on the basis of the Jellinek test the goods also are similar. The opposition succeeds under Section 12(1).

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In the light of the above finding I do not need to consider the Section 11 position in detail. I will simply comment that the opponents' own use appears to be predominantly on jeans although exhibit PP2 illustrates a number of other items such as sweaters and T-shirts as well as some accessories. I am not persuaded on the basis of the evidence before me that the opponents' actual use is in relation to goods which would clash with the applicants' Class 9 specification. I note too that the opponents refer to a passing-off right as the basis for their Section 11 case (a rather higher test than the BALI one set out above). The opponents would not in my view succeed under Section 11.

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Ms Bucks speculates in her declaration that Mr Askew's evidence may be intended to establish an honest concurrent use claim and offers legal arguments as to why the use referred to would not be relevant. Mr Pytiak also comments on the applicants' use. The applicants have not expressly made any claim in relation to Section 12(2) though Mr Askew suggests that the 'MUSTANG SURVIVAL' name is quite well known' and that 'my company's reputation well

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exceeds its sales ...'. The applicants have changed distributors a number of times, the highest volume of sales appears to go back to 1973 and my impression is that in more recent times sales have been intermittent and at a low level. However there is simply insufficient substantiating detail to come to a clear view. An honest concurrent use claim could not in my  
5 view succeed at the material date in these proceedings (15 October 1992).

Finally there is the claim that the application was filed in bad faith. The applicants claim to be a long established company in Canada and have made efforts over the past twenty years to enter the UK market. It is not unreasonable that the applicants should want to protect their  
10 interests in the UK market. The parties appear to be aware of each others' activities and it is said that the opponents have in the past tried to negotiate a co-existence agreement with the applicants in other jurisdictions. None of this suggests that the application was filed in bad faith. Rather it seems to me that these are two companies which have adopted their marks  
15 independently for their respective areas of trade but find themselves in potential competition at the margins of their respective businesses. The Section 17 attack fails.

As the opponents have been successful under Section 12(1) the opposition as a whole succeeds. The opponents are entitled to a contribution towards their costs. I order the  
20 applicants to pay the opponents the sum of £635.

Dated this 8 day of October 1999

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M REYNOLDS  
For the Registrar  
the Comptroller General

Details of the opponents' registrations are as follows:

5	No	Mark	Class	Journal	Specification
10	907716	MUSTANG	25	4737/0965	Articles of outerclothing, but not including boots, shoes, slippers, sandals, gloves, men's ties, or men's scarves, or any goods of the same description as any of these excluded goods.
15	995732		25	4930/0332	Articles of outerclothing, jeans, being articles of clothing, shorts, overalls, jackets, shirts and blouses, but not including boots, shoes, slippers, sandals, gloves, men's ties, men's scarves or any goods of the same description as any of these excluded goods.
25	1509083	MUSTANG	3	5978/3722	Perfumes; toilet waters; soaps; skin cleaners, shower gels, hair and body shampoos; bath salts (not for medical purposes), cosmetic preparations for the bath or the shower; cosmetic preparations for skincare; deodorants and anti-perspirants for personal use; make-up preparations, make-up powder, rouge, eyebrow cosmetics, eyebrow pencils, eye make-up, lipsticks, lotions and creams for cosmetic purposes, face masks; hair conditioners, hair lotions and creams, hair dyes and colourants; shaving cream, shaving foam, shaving gel; preshave and aftershave lotions; all included in Class 3.
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	1519863	MUSTANG Premium	25	6054/7814	Articles of clothing; jeans, shorts, overalls, jackets, shirts and blouses; all included in Class 25.
5	1523245	MUSTANG SilkIndigo	25	6053/7637	Articles of outer clothing made from silk or silk-like materials; all included in Class 25; but not including boots, shoes, slippers, sandals, gloves, men's ties or men's scarves, or any goods of the same description as any of these excluded goods.
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15	1552119		25	6113/1251	Articles of outer clothing; headgear; belts; footwear; all included in Class 25.



30 Only the first three appear to have filing dates which are before the priority date claimed by the applicants. A further application referred to by the opponents stands refused.

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