

O-354-04

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 769067
BY RTL DISNEY FERNSEHEN GMBH & CO KG TO REGISTER A
TRADE MARK IN CLASSES 09, 14, 16, 21, 25, 28, 35, 38, 41 AND 42**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No. 70791
BY FINEST BRANDS INTERNATIONAL LIMITED**

TRADE MARKS ACT 1994

IN THE MATTER OF Application No. 769067

**by RTL Disney Fernsehen GmbH & Co KG to register a trade mark
in Classes 09, 14, 16, 21, 25, 28, 35, 38, 41 and 42**

and

IN THE MATTER OF Opposition thereto under No. 70791

by Finest Brands International Limited

BACKGROUND

1. On 26 June 2001 RTL Disney Fernsehen GmbH & Co KG applied to register the following trade mark (with an international priority date of 17 January 2001) in the United Kingdom under the provisions of the Madrid Protocol on the basis of registration in Germany:



2. Registration was sought in respect of goods and services in Classes 09, 14, 16, 21, 25, 28, 35, 38, 41 and 42 and the Class 25 specification reads as follows:

“Clothing, especially clothes for expeditions and for outdoors, footwear, headgear, accessories for clothing, namely belts, scarves, braces, caps, hats, collars, ties, sandals, slippers, shoes, socks, headbands, suspenders (included in this class).”

3. The application was subsequently published in the Trade Marks Journal and on the 7 May 2002 Finest Brands International Limited filed a Notice of Opposition under Section 5(2)(b) of the Act alleging that the mark applied for is similar to the following earlier trade marks owned by the opponent, covers identical or similar goods in Class 25 and there exists a likelihood of confusion on the part of the public:

Registration No.	Mark	Date Registration Effective	Specification of Goods
1446444	TOGGI (Series of two)	23 October 1990	Class 25 - Weatherproof clothing; wax coats; jackets; shirts; headgear; footwear; all included in Class 25.
2021638	Toggi RoughCountry	25 May 1995	Class 18 - Leather goods all included in Class 18. Class 25 - Weatherproof clothing, wax coats; jackets; shirts; headgear; footwear; belts; all included in Class 25.

4. The opposition is in respect of Class 25 of the application only.
5. On 18 July 2002 the applicant filed a counterstatement.
6. The opponent filed evidence and asked for an award of costs in its favour. The parties were content for a decision to be taken without recourse to a hearing. Neither party forwarded written submissions for the hearing officer's attention.

Opponent's Evidence

7. The opponent's evidence consists of a witness statement by David Simon Moore of Jensen & Son, the opponent's professional advisors in these proceedings.
8. Mr Moore refers to exhibit "DSM 1" to his statement which comprises details of the opponent's earlier trade mark registrations – Numbers 1446444 and 2021638. He makes no submissions.

DECISION

9. Section 5(2) of the Act reads as follows:

“5(2) A trade mark shall not be registered if because -

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
- (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.”

10. An earlier right is defined in Section 6, the relevant parts of which state:

“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.”

11. 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] E.T.M.R. 1, *Lloyd schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

12. 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 BV*;
- (c) the average consumer normally perceives the mark as a whole and does not need to 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 that use that has been made of it; *Sabel BV v Puma AG*;
- (g) account should be taken on the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it was registered; *Lloyd Schuhfabrik Mayer & Co. GmbH v Klijsen Handel BV*.;
- (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) 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*.

13. 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 of the European Court of Justice 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. I must compare the mark applied for and the opponent's registrations on the basis of any use made of the respective marks and also on the basis of their inherent characteristics, assuming normal and fair use of the marks on the relevant goods covered across the width of their respective specifications.

14. No evidence has been filed to demonstrate use of any of the marks before me. The opponent simply relies on the existence of earlier registrations and its case rests upon notional, fair use of those marks.

Identity and Similarity of Goods

15. I turn to a consideration of the respective goods covered by the application in suit and the opponent's earlier registrations. The relevant goods are all clothing items and

footwear in Class 25. It is obvious that the mark applied for covers identical and closely similar goods to those encompassed in the opponent's earlier registrations.

Comparison of Marks

16. I now go on to compare the mark in suit with the opponent's earlier marks. While the opponent has two earlier registrations, it seems to me that the opponent's best case lies with its registration for the word TOGGI (solus) – registration number 1446444. I will limit my comparisons accordingly.

17. The respective marks are both invented words. While there is an element of stylisation in the presentation of the mark in suit, it seems to me essentially to comprise the word TOGGO. Both the words TOGGO and TOGGI are five letter words. They share the first four letters.

18. In relation to the goods at issue the word TOGGI appears to me to possess a high degree of distinctive character. It follows that its prenumbra of protection should be wide.

19. The respective marks must be compared as a whole and by reference to overall impression but, as recognised in *Sabel BV v Puma AG* (mentioned earlier in this decision) in any comparison reference will inevitably be made to the distinctiveness and dominance of individual elements. Furthermore, I must be careful not to over analyse the marks as the real test is how customers would perceive the marks in the normal course and circumstances of trade. The average customer rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he/she has kept in his/her mind (*Lloyd Schuhfabrik Mayer & Co. GmbH v Klijsen Handel BV*).

20. Firstly, I go to a visual comparison of the respective marks. As mentioned above, they are of the same length (five letters) and share the first four letters. In my decision, similarity must be considered in the light of the overall impression and notwithstanding the difference in the final letter and the slightly stylised presentation of the word TOGGO, it seems to me that the marks possess obvious visual similarity overall. There is a considerable likelihood of visual confusion.

21. In relation to the aural comparison of trade marks used in respect of articles of clothing, I agree with the view expressed by the Registrar's Hearing Officer in the matter of application no. 2001040 by React Music Limited to register a trade mark in Class 25 and in the matter of Opposition thereto by Update Clothing Limited under No. 45787, (BL O/258/98), when he said:

“There is no evidence to support Ms Clarke's submission that, in the absence of any particular reputation, consumers select clothes by 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 this 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 as far to say that aural means of identification are not relied upon”

22. This view was supported on appeal to the Appointed Person (*REACT Trade Mark* [2000] 8 RPC 285, at 289 lines 22 to 26) and I believe it appropriate to the present case.

23. While in aural use the marks share the same first syllable, the remaining syllable differs. It was accepted under the Trade Marks Act 1938 that the beginning of the words is more important as the endings of the words tends to become slurred – London Lubricants Limited’ Application (TRIPSCASTROID) 42 [1925] RPC 264 at page 279. I see no reason why this should not apply under the Trade Marks Act 1994. However, while aural similarity exists I take the view that the opponent’s case is less strong here than it is in relation to visual similarity.

24. I go now to a conceptual comparison of the marks. Both words contain invented words and it seems to me that any substantial conceptual similarity is not readily identifiable. However, invented words of this nature are far less readily distinguishable than dictionary words with similar appearances but different meanings. Imperfect recollection of the marks may well be a factor.

Relevant Public

25. Customers for clothing and footwear are the public in general. Such goods are necessities as well as being fashion items and are sold through a wide variety of outlets and at a wide range of prices. The goods are not necessarily expensive nor sophisticated purchases but it seems to me that clothing and footwear are usually bought with a reasonable degree of care e.g. as to size, colour, appearance, and after a visual reference. While this is not a “bag of sweets case”, imperfect recollection could nevertheless be a factor as clothing items and shoes are often purchased on an occasional rather than a regular basis.

Conclusion

26. On a global appreciation, taking into account all relevant factors, I have come to the following conclusions:

- (i) The respective marks are visually similar and there is a considerable likelihood of visual confusion;
- (ii) The respective marks are aurally similar but aural similarity is less strong than visual similarity;
- (iii) The respective goods are identical and closely similar;
- (iv) The customer for the goods would be relatively discerning but it would be wrong to presume a particular high level of perspicacity and on behalf of the customer and accordingly, imperfect recollection remains highly relevant.

27. Considering the positioning in its totality I believe there is a likelihood of confusion on the part of the relevant public. In reaching this conclusion I have borne in mind that the average consumer rarely has the chance to make direct comparisons between marks, but must instead rely upon the imperfect picture of them he/she has kept in his/her mind.

28. The opposition is successful under Section 5(2)(b).

29. The application may proceed if, within 28 days of the date of the appeal period, the applicant files a Form TM21 deleting Class 25 from its specification of services.

Costs

30. The opponent is entitled to a contribution towards costs and I order the applicant to pay the opponent the sum of £900 which takes into account that no hearing took place on this case, the applicant did not file evidence and neither party forwarded written submissions. This sum is to be paid within 7 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 2nd day of December 2004

JOHN MacGILLIVRAY
For the Registrar
the Comptroller-General