

O-373-10

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2463221
BY
HIGHLAND WOOLLEN COMPANY LIMITED
TO REGISTER THE TRADE MARKS**



(A SERIES OF TWO)

IN CLASS 25

AND

**THE OPPOSITION THERETO
UNDER NO 97070
BY
NORDICA S.P.A.**

Trade Marks Act 1994

**In the matter of application 2463221
by Highland Woollen Company Limited
to register the trade marks:**



**(a series of two) in class 25
and the opposition thereto
under no 97070
by Nordica S.p.A.**

1. On 6 August 2007, Highland Woollen Company Limited (which I will refer to as 'Highland') applied to register the above series of trade marks. Following examination, the application proceeded to publication in the *Trade Marks Journal* on 8 February 2008 for a goods specification of '*Clothing; headgear; footwear; accessories (clothing); gloves; scarves; mittens; waterproof clothing and outdoor clothing*' in class 25¹. Although a series of two, I will refer throughout this decision to both marks as if the application was for a single mark since the only difference is that the device in the top mark is represented in red; however, colour does not affect the determination to be made in this case.

2. Nordica S.p.A. (which I will refer to as 'Nordica') filed notice of opposition to all the goods of the trade mark application. Nordica claims that registration of the trade mark would be contrary to sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ('the Act').

3. Section 5(2)(b) states:

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

....

(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,

¹ 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.

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

Nordica relies upon all of the goods of its three earlier trade marks to support this ground, as follows:

i) 2147619 Community Trade Mark ('CTM')



Application date: 16 March 2001
Priority date: 8 November 2000 (Italy)
Registration date: 25 February 2005

Class 9: Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus.

Class 18: Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.

Class 25: Clothing, footwear, headgear.

Class 28: Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees.

ii) CTM 5956032

NORDICA

Application date: 31 May 2007
Registration date: 7 March 2008

Class 18: *Luggage and leather goods, bags, satchels, handbags and bags for sports use and for transporting and storing sports equipment and clothing, sports travel bags for transporting and storing sports equipment and clothing, travel bags, ski boot holders, waist packs, rucksacks, schoolbags, overnight bags, wallets and purses.*

Class 25: *Walking boots, after-ski boots, ski gaiters, hockey shoes, boots, shoes, slippers, sportswear, headgear, classic clothing and leisurewear, special footwear for sporting activities and in particular footwear for resistance sports.*

Class 28: *Ski-racks, ski poles, rackets, ski bindings, skis, sleds, gymnastic and sporting equipment and fittings therefor.*

iii) 1113101 (UK registration)

The logo for Nordica, featuring the word "NORDICA" in a bold, italicized, sans-serif font. The letter "N" is significantly larger and more prominent than the other letters, and the entire word is set against a light, circular glow.

Application date: 23 April 1979
Registration date: 20 January 1982²

Class 25: *Footwear being articles of clothing*

This registration carries the following disclaimer:

“Registration of this mark shall give no right to the exclusive use of a letter “N”.

4. Nordica states that the goods of the application are identical and similar to those of its own earlier marks and that the marks are similar, leading to a likelihood of confusion. It relies on the same three earlier rights in relation to its ground of opposition under section 5(3) of the Act, which states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or

² *WIS/ Trade Mark [2006] RPC 17, Geoffrey Hobbs QC, sitting as the Appointed Person: “In an Official Notice entitled ‘Date on which a mark is actually entered in the Register’ printed at pp. 1536, 1527 of Issue No. 5725 of the Trade Marks Journal published on 1 June 1988 it was confirmed that, prior to June 1986, the date of the Trade Marks Journal in which the fact of registration was recorded in the list of ‘Trade Marks Registered’ was the date of actual registration.”*

international trade mark (EC), in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

Under this ground, Nordica claims that Highland’s mark is similar to its own marks in which it has a reputation and that Highland’s mark will cause unfair advantage of, or be detrimental to the distinctive character or repute of its earlier marks.

5. Section 5(4)(a) of the Act states:

“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

(b)

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.”

Nordica claims it has established a substantial reputation and goodwill under the mark NORDICA through use in the UK and the Community for many years, which predates Highland’s date of application. It states that it has used NORDICA on footwear and ‘other goods’ since at least April 1979. The pleading is rather vague as to what goods have been used, where and when.

6. Highland filed a counterstatement, denying all the grounds and putting Nordica to proof of use in respect of 1113101. Highland denies that Nordica has established a substantial reputation and goodwill in NORDICA (stylised and word only) and puts it to strict proof. Both sides filed evidence and written submissions. Neither side requested a hearing, both being content for a decision to be made from the papers on file.

Evidence

7. Nordica’s evidence

The majority of Nordica’s evidence is in the form of a witness statement by Mr Ruggero Zanatta. Mr Zanatta is Nordica’s Chief Executive Officer, a position he has held since 2003. He states that the history of Nordica can be traced back to the 1940s when, from a trading base in casual footwear, Nordica started selling ski boots, cross-country ski shoes and climbing boots. The boots were used by

high profile skiers in World Championship and Olympic skiing events in the 1950s. Paragraph 4 of Mr Zanatta’s statement indicates that it was in the 1960s and 1970s that Nordica accounted for 30% of the global production of ski footwear, producing 2 million pairs of boots and shoes per annum, although a magazine exhibited at RZ5 refers to this figure being achieved in the 1980s and 1990s. Mr Zanatta states that NORDICA goods have been sold across the UK, listing towns and cities the length and breadth of the UK. The following ‘approximate’ figures are given for goods sold under Nordica’s trade marks, ‘in particular’ NORDICA; i.e. they are not specified as relating solely to NORDICA, but could relate to other trade marks, as below:

YEAR	NET SALES (EUROS)
2000	500,928.41
2001	624,086.91
2002	497,260.93
2003	396,393.77
2004	492,051.00
2005	601,891.00
2006	890,312.00
2007	1,160,877.39

8. Mr Zanatta also exhibits (RZ3) a selection of invoices from Nordica to TKC Sales Limited, Nordica’s UK distributor. Two trade marks appear at the top of each invoice, NORDICA and ROLLERBLADE, but it is not possible to tell from the items on the invoices which mark is connected to which goods, nor what the goods are. I can cross-reference some of the items, such as ‘speedmachine’ and ‘olympia’ to exhibit RZ4, but the literature in this exhibit shows that these names are used both on skis and ski boots. I cannot say, therefore, what the items on the invoices are. I note that some of the invoices, for instance pages 26, 32, 36 and 53 of the exhibit, say:

“This invoice relates to the supply of NORDICA and/or ROLLERBLADE material in accordance with the existing supply agreement...”

9. Mr Zanatta gives an advertising figure of £14,300, but this is not particularised as to publicity in relation to NORDICA (Mr Zanatta says it includes goods sold under the mark NORIDCA) or as to when the publicity occurred. He exhibits pages from catalogues at RZ4, most of which are dated after the date of application (6 August 2007). Some of the names appear on the invoices in exhibit RZ3, several of which are dated before the date of application; however, as noted above, the same names, such as SPEEDMACHINE and OLYMPIA are applied to the skis as well as the ski boots. The stylized NORDICA mark appears in the catalogue text and on the pictures of the boots themselves. Several pages in this exhibit are devoted to feedback and test reports in the Daily Mail newspaper and on the Ellis Brigham website by skiers using NORDICA *skis*, after the relevant date. RZ5 is an internal marketing manual from 2006, priced in

Euros, showing retailers how NORDICA goods can be displayed and promoted in shops. The goods shown are skis, ski boots, ski accessories, t-shirts, sweaters, coats, hats, aprons, bags, mugs, tissues, DVDs, CDs, pens, mousemats and diaries. Of the catalogues in exhibit RZ6, only one (2006/2007) falls firmly before the date of application and this shows skis and ski boots. The sizing for the boots in this catalogue is not recognisably UK footwear sizing, although a later catalogue indicates the availability of UK sizes.

10. Mr Zanatta states that Nordica has advertised its NORDICA branded goods in major UK national newspapers and magazines. He also says Nordica has advertised its goods (I assume he means NORDICA goods) via the *Daily Mail Ski and Snowboard* magazine, *Full-Line* magazine, *Ski and Board* magazine, *Snow* magazine and *Racer Ready* magazine, although these are not shown as exhibits and there are no dates. Mr Zanatta also states that Nordica has promoted its goods through retail trade shows with its UK distributor, including the last five occurrences of the annual London Ski Show, Birmingham Ski Show and Manchester Ski Show. At RZ7, Mr Zanatta exhibits a copy of a decision dated 28 November 2008 by the Office for Harmonization in the Internal Market (OHIM), the body responsible for Community Trade Marks. Mr Zanatta states that the decision (in Italian) shows that NORDICA was found to be well known for sporting articles in Class 25. I have looked at the translation of the decision which Nordica has filed (regularised by a declaration from the translator, Mr Manuela Bruscolini,) and note that OHIM's Opposition Division found that NORDICA "benefits from a certain notoriety" in Spain and Austria in relation to clothing and sporting goods items related to winter sports. The evidence filed related to those two countries only.

11. Nordica has also filed a witness statement from Mr Matthew Woodruffe, who is the managing director of TKC Sales Limited, Nordica's distributor in the UK. He states that his company has distributed goods under the mark NORDICA in the UK in the last five years (his statement is dated 3 August 2009). Mr Woodruffe repeats Mr Zanatta's statement regarding ski trade shows. There are no exhibits attached to Mr Woodruffe's statement.

12. The final piece of evidence from Nordica is a second witness statement from Mr Zanatta. For the most part, this is not evidence of fact but is a critique of some of Highland's evidence. I will not summarise it here but will refer to it as necessary and I will bear its contents in mind in coming to a decision. As to factual content, Mr Zanatta lists a number of marks which include a 'Nordic' element which Highland states co-exist; Mr Zanatta refers either to agreements reached with some of the proprietors, or gives reasons why Nordica has or has not opposed each mark.

13. Highland's evidence

This is in the form of a witness statement, dated 27 November 2009, from Mr Asif Mohammed Rasul who has been Highland's managing director since 2002. He has been a partner or managing director of companies involved in clothing retail for over twenty years. Mr Rasul mentions three other companies of which he is a partner or managing director: Country Outlet Limited, TF Trading Limited and The Firm of Top Fashion. He states that "NORDIC ALPINE logos 1 and 2" are held by Highland and have been used by the other three companies since at least 2003 on clothing and footwear, in addition to using the plain words NORDIC ALPINE, operating from nineteen outlets in the UK. NORDIC ALPINE logo 2 is the subject of the opposed application, which Mr Rasul states has been used since at least 2005. NORDIC ALPINE logo 1 is trade mark registration No. 2367757A (registration date 5 August 2005), in use since at least 2003:



Class 25: Clothing; headgear; footwear; accessories (clothing); gloves, scarves, mittens, waterproof clothing and outdoor clothing.

A map showing the general location of the outlets in which the goods are sold is shown at exhibit AMR2, although more specific information is not given:

- Six locations in the Scottish Highlands
- Four locations in Perthshire
- One location in Argyle and Bute
- Two locations in the Loch Lomond National Park
- One location in Strathclyde
- One location in the Lake District National Park
- One location in the Yorkshire Dales National Park
- Two locations in the Peak District National Park

14. Mr Rasul gives combined turnover figures (approximate to within 5%) for both logos and the plain words NORDIC ALPINE:

Year	£
2003	100,000

2004	250,000
2005	500,000
2006	800,000
2007	1,127,538

The unit sales figures of clothing under the stylised marks (logos 1 and 2) and the plain words NORDIC ALPINE are:

Year	Unit Sales
2003	8,000
2004	20,000
2005	40,000
2006	131,250
2007	151,216

Advertising of the stylised marks and plain words NORDIC ALPINE have been undertaken by way of posters displayed in all the retail outlets, newspaper articles and over the radio. Exhibits AMR3 and 4 show radio station invoices and advertisement scripts for the local radio stations Radio Clyde, Radio Tay and Scottish Real Radio. Mr Rasul states that these advertisements referred to NORDIC ALPINE goods, alongside advertising two other trademarks which he uses. The approximate advertising figures which Mr Rasul says are attributable to the NORDIC ALPINE marks are:

Year	£
2003	20,000
2004	30,000
2005	50,000
2006	70,000
2007	70-90,000

Exhibit AMR5 includes large posters which show the mark applied for ("logo 2") alongside scenic detail and people walking, climbing or cycling. Mr Rasul states that the posters have been displayed prominently in all his retail outlets throughout the last five years. Photographs from the inside of one of his stores in West Central Scotland, taken on 16 December 2006 and exhibited at AMR6, show these large posters displaying the mark applied for. Mr Rasul explains that this use of logo 2 is typical of the use of in all his outlets, which all carry the same stock. He states that the data from a detector which measures footfall in his outlets shows that 5,550,000 visits were made to his Scottish stores and 6,525,000 visits to his English stores in 2007. Mr Rasul says that these visitors would have seen the NORDIC ALPINE branded clothing and the posters.

15. Mr Rasul exhibits a number of invoices at AMR7 from his import supplier which show items such as jackets, fleeces and kagools; they appear to relate to

logo 1 and the plain words NORDIC ALPINE because Mr Rasul refers specifically to these marks in connection with his use of the importer, Wilson Imports. Exhibit AMR8 includes a stocklist from 2006 from which it is possible to cross-reference, for example, a ladies' coat called 'Abbey', to a label in exhibit AMR10 which shows the mark as applied for. This also appears on an invoice in AMR9, dated 17 April 2007, from Mr Rasul's Chinese supplier. A 'Cuba' men's jacket appears on an invoice from the Chinese supplier dated 25 April 2007 and on a 'logo 2' label in AMR10. Several of the invoices and much of the stock lists in AMR8 fall after the relevant date. Photographs of clothing and labels bearing the three variations of the NORDIC ALPINE trade marks are shown in AMR11; there are no dating references but they can be cross-referenced to the stock lists in AMR8. Of those before the date of application, the stock lists for 2004 and 2006 can be cross-referenced to pictures in AMR11 of a ladies' fleece and coat, respectively, although only the coat ('Julia') shows the mark as applied for. Also shown in AMR11 and appearing on an invoice in AMR9, dated 2 July 2006, are walking boots ('Sylvania', 1400 pairs).

16. Exhibit AMR14 includes extracts from the following websites:

www.britishnordicwalking.org.uk
www.walking.visitscotland.com/usefulinfo/nordic_walking.com

The first of these says:

"We are the only UK Nordic Walking Instructor training body endorsed by INWA (the International Nordic Walking Federation)"

The second says:

Want to get fitter for the hills? Don't like gyms? Try Nordic walking – an exciting new approach to fitness...Nordic walking is fitness walking using specially designed walking poles...Originating in Finland – as a way for cross-country skiers to train in summer, Nordic walking has taken off all over Europe."

17. Mr Rasul states that he has not encountered any instances of confusion with Nordica's marks. He has filed 'state of the register evidence' and the results of his search on the Internet for the combination 'NORDIC' and 'CLOTHING', limited to the UK. This refers to other NORDIC signs in use in the clothing trade. This is the evidence which Nordica has countered (see paragraph 12 of this decision) with reasons for the co-existence.

Decision

18. Section 5(2)(b)

The leading authorities which guide me in this ground are from the European Court of Justice (ECJ): *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, *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 for 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.*

19. Highland has applied for its mark in class 25 only. Of the three marks which Nordica relies upon, two had been registered for less than five years at the date on which the application was published (CTMs 2147619 and 5956032), one of which is the word-only mark NORDICA. Both of these registrations cover a range of goods in class 25. The third mark, (UK 1113101) which is registered in respect of *footwear, being articles of clothing* is subject to the proof of use provisions³. As this specification is narrower and the mark is essentially the same as the stylised CTM 2147619, I will concentrate on a comparison between the two CTMs and the application, without it being necessary to assess whether there has been genuine use of 1113101 within the relevant five year period, nor to assess whether there is any effect caused by the disclaimer carried by 1113101.

20. Comparison of goods

Nordica relies, for the section 5(2)(b) ground, upon all the goods of its earlier registrations which include class-wide specifications in classes 9, 18 and 28. Given that the marks relied upon also cover class 25, I do not propose to make a comparison of goods between the class 25 goods of the application and the class 9, 18 and 28 goods of the earlier registrations, but will instead confine my comparison to Nordica's class 25 goods in CTMs 2147619 and 5956032 against the class 25 goods of the application.

³ See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

21. The respective class 25 specifications are:

i) CTM 2147619

The logo for NORDICA, featuring the word "NORDICA" in a bold, italicized, sans-serif font.

Clothing, footwear, headgear.

ii) CTM 5956032

NORDICA

Walking boots, after-ski boots, ski gaiters, hockey shoes, boots, shoes, slippers, sportswear, headgear, classic clothing and leisurewear, special footwear for sporting activities and in particular footwear for resistance sports.

iii) Application



Clothing; headgear; footwear; accessories (clothing); gloves; scarves; mittens; waterproof clothing and outdoor clothing

The specification of CTM 2147619 is replicated entirely in the first three items of the application. Further, the remaining goods of the application (*accessories (clothing); gloves; scarves; mittens; waterproof clothing and outdoor clothing*) are all clearly clothing and so fall within the ambit of the earlier mark's specification; in the case of *accessories*, these are qualified as clothing. The goods of the application are identical to those of CTM 2147619. The specification of CTM 5956032 includes footwear items, the term 'headgear, and the terms 'sportswear' and 'classic clothing and leisurewear'. Since these fall within the ambit of "clothing, headgear and footwear" (the first three terms in the application's specification), the goods of CTM 5956032 and the goods of the application are identical, as per *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM)*, Case T-133/05⁴.

⁴ "29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in

22. Average consumer and the purchasing process

Following the above approach, I will consider this in relation to the goods in class 25. While the respective specifications of the parties specify some types of clothing (such as outdoor, waterproof or ski clothing), they are not limited to certain types of clothing. I have to assess the average consumer across the notional width of the specifications. The average consumer is the general public who pays a reasonable amount of attention to purchasing clothing; they may try on the goods (particularly if footwear) for size and may have a stylistic or colour preference. Buying clothes is a visual activity⁵; the public is increasingly brand conscious and the visual appearance of the trade mark and where it is placed on the clothing or footwear item is of some importance to many purchasers. The level of attention of a consumer of clothing may vary depending on cost and the occasion; in general, clothing is a reasonably (but not very) considered purchase.

23. Comparison of trade marks

The authorities direct that, in making a comparison between the marks, I must have regard to each mark's visual, aural and conceptual characteristics. I have to decide which, if any, of their components I consider to be distinctive and dominant, without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

24. The marks to be compared are:

Nordica's marks	Highland's mark
CTM 2147619:  CTM 5956032 NORDICA	 

a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

⁵ See *Société provençale d'achat and de gestion (SPAG) SA v OHIM* Case T-57/03, paragraph 66, and *React Trade Mark* [2000] RPC 285.

Both of Nordica's marks consist of the word NORDICA. In the case of the word-only mark, NORDICA is the sole element of the mark and so is the dominant element. Nordica's stylised mark is also made up of the single word NORDICA. The stylisation is in the form of the forward slanting typeface and from the upward stroke of the N forming an arrow device. However, this aspect of the mark is not proportionately large compared to the remainder of the mark. It does not form the dominant element; there is also nothing out of the ordinary about the slanting typeface, so this does not represent a dominant or distinctive element of the stylised mark. Although I do not ignore the stylised aspects, the dominant and distinctive element of Nordica's marks is the word NORDICA itself.

25. Highland's mark is a composite mark consisting of the words NORDIC ALPINE in an unremarkable typeface and a device located centrally above the words. All these elements are super-imposed on a solid dark rectangular background. The device occupies a considerable proportion of the mark. It is an invented, distinctive device. Nordica submits that the most dominant and distinctive part of the mark is the verbal element and that it is difficult to determine the nature of the device element, which it says could be a stylised letter N or a globe device. There is no requirement that for a device to be distinctive its nature must be capable of categorisation. I consider that the word combination shares an equal proportion of the mark compared to the device, so that neither element is dominant.

26. The only elements in the parties' marks which share any similarity are NORDICA and NORDIC; ALPINE and the device are completely alien to Nordica's marks while the upward arrow is alien to Highland's mark. Since Nordica's word-only mark covers identical goods to those of Highland's mark, I can limit my comparison between the word-only earlier mark and the application. Nordica has submitted that NORDICA is visually similar to NORDIC ALPINE not only by virtue of the fact that NORDIC is identical to NORDICA except for the final 'A', but that the second word in Highland's mark starts with an A. However, there is a clear split between the words NORDIC and ALPINE, so that the A of ALPINE is clearly separate to NORDIC. NORDIC is visually very similar to NORDICA: NORDIC forms the first six letters of Nordica's seven-letter mark. NORDIC is also the first word of the two words in Highland's mark. I must bear in mind that the assessment of the level of similarity between the marks is a comparison of the whole of the marks because dismemberment will not take place as part of the normal purchasing process; the average consumer normally perceives a mark as a whole and does not analyse its details. The NORDIC element accounts for approximately a third of the visual impact of the application which includes a prominent device. Consequently, viewed as a whole, there is a low level of visual similarity between NORDICA and Highland's mark.

27. NORDICA is three syllables long while NORDIC has two syllables. In the UK the stress will fall upon the NOR syllable in pronunciation in both marks.

Although the final 'A' syllable in NORDICA is a soft sound, I do not believe it will be lost when heard. There is a good deal of similarity aurally between NORDICA and NORDIC. Highland's mark also contains the word ALPINE, which is not present in the earlier mark. Comparing NORDICA aurally with the whole of Highland's mark and bearing in mind that NORDIC will be the first word spoken, there is, overall, a moderate level of aural similarity between the marks.

28. Nordica submits that ALPINE is low in distinctive character for a number of the goods in the application, such as gloves, scarves, mittens, waterproof clothing and outdoor clothing but does not elaborate on the reason why it says so. Highland, in its counterstatement, refers to NORDIC being a geographical designation which is well known for winter sports. There is no further explanation as to the geographical location which Highland states is designated as Nordic. Highland states that NORDIC is descriptive of clothing for Nordic winter sports. There is no further explanation of what 'Nordic winter sports' are. The evidence which relates to Nordic walking shows that the activity does not appear to be restricted to wintertime.

29. Collins English Dictionary (2000 Edition) gives the following definition for Nordic:

"Of or relating to, or belonging to a subdivision of the Caucasoid race typified by the tall blond blue-eyes long-headed inhabitants of N Britain, Scandinavia, N Germany, and the Netherlands. [C19: from French *nordique*, from *nord*]."

Chambers 21 Century Dictionary (2001 Edition) defines Nordic as:

"1. relating or belonging to Scandinavia or its inhabitants.
2. Germanic or Scandinavian in appearance, typically tall, blond and blue-eyed.
3. (**nordic**) denoting a type of competitive skiing with cross-country racing and ski-jumping.
[19c: from French *nordique*, from *nord* north.]"

The third definition in Chambers links to the evidence from Highland (paragraph 16 above): "Nordic walking is fitness walking using specially designed walking poles...Originating in Finland – as a way for cross-country skiers to train in summer, Nordic walking has taken off all over Europe." In Mr Zanatta's second witness statement, he states that Nordic walking was previously known as ski walking and consists of walking with poles, similar to ski poles. Mr Zanatta further states that:

"The general public and average consumer will recognise and know the term 'Nordic walking' as a kind of physical activity."

30. The first and second definition of Nordic which is given in the Chambers dictionary accords with my own impression of the word and its concept and would, I consider, be the meaning of Nordic which the general public would be aware of. I would not stretch this general awareness of Nordic to the competitive skiing definition. However, Nordica itself has stated that the general public will recognise and know the term 'Nordic walking' as a kind of physical activity. Nordica has accepted Highland's evidence to this effect. I bear in mind that Highland's mark does not consist of the words 'Nordic Walking' so there will not be an immediate conceptual link to Nordic walking. The goods are not walking poles but are clothing items. There is no evidence that particular clothing needs to be worn when partaking in Nordic walking, or Nordic skiing.

31. The other word in Highland's mark is ALPINE. In my view, this word is commonly understood by the general public in the UK as relating to the European mountain range known as the Alps. Collins Dictionary gives a definition as:

“adjective

1. of or relating to high mountains.
2. (of plants) growing on mountains above the limit for tree growth.
3. connected with or used in mountaineering in medium-sized glaciated mountain areas such as the Alps.
4. Skiing of or relating to racing events on steep prepared slopes, such as the slalom and downhill. Compare nordic.
5. noun a plant that is native or suited to alpine conditions.”

I note that Alpine also describes a type of skiing. Nordica has not referred to this in its submission that ALPINE is low in distinctive character in relation to some of Highland's goods, so I cannot say whether it had this in mind or a more general application of the goods to usage at high altitudes.

32. Given that the primary meaning for the general public in the UK for NORDIC is Scandinavia/n and that ALPINE relates to the European Alps, the two words do not naturally hang together as a description. There is a separate quality to them. Having said that, both words evoke associations with cold, snow and mountains. The device is without any conceptual significance. The significance of Highland's mark as a whole is that there is a conceptual hook both of Scandinavia and of the Alps.

33. The earlier mark, NORDICA, is not an English dictionary word. The 'A' ending gives the word something of the quality of a feminine name, but it is not a name in the UK. There could be an evocative association with the meaning of Nordic which may be affected by the context of its use (if in relation to Nordic walking or skiing or clothing designed for resisting the cold). However, I consider that NORDIC is not such an everyday word that its inclusion within NORDICA will be immediately apparent. I think it is much more likely that for the average UK

consumer it will be seen as an invented word. For goods unrelated to walking and skiing the conceptual similarity is likely to be non-existent. For goods connected to walking and skiing there is more likely to be a conceptual link, although since Nordic is not a particularly distinctive concept for walking and skiing goods this similarity does not bring the marks significantly closer together. It follows that the conceptual similarity of the marks is low.

34. The effect of my assessment that there is a low degree of visual similarity, a moderate level of aural similarity and a low level of conceptual similarity means that, overall, the similarity between the marks is of a low degree.

35. Distinctiveness of Nordica's marks

It is necessary to consider the distinctive character of the NORDICA marks because the more distinctive they are, either by inherent nature or by their use (nurture) the greater the likelihood of confusion⁶. The distinctive character of a trade mark must be assessed by reference to the goods or services in respect of which registration is sought and by reference to the way it is perceived by the relevant public⁷. As said earlier, I believe NORDICA will be perceived foremost as an invented word which means that it possesses a good degree of inherent distinctive character. If used in relation to skiing clothing or by those partaking in Nordic walking, it could be suggestive of 'Nordic', but this is not a particularly distinctive concept for such goods given that Nordic describes particular forms of walking and skiing. In relation to the goods, which include but are not limited to clothing for skiing or Nordic walking, as an invented word it has a good capacity to distinguish Nordica's goods from those of other undertakings.

36. The evidence of use which Nordica has filed does not improve its position. There is little, if any, use of NORDICA on clothing other than ski boots. It is not possible to state with certainty whether the turnover figures relate to NORDICA marks or to another mark (ROLLERBLADE) and how much of the evidence relates to skis rather than ski boots. The advertising figures are particularly modest given the claims to fame of NORDICA (they are also undated). There are too many gaps and unanswered questions in the evidence to allow for a conclusion that the distinctiveness of NORDICA has been enhanced to any significant extent through use, even for ski boots as I am unable to tell from the evidence what relates to ski boots as opposed to skis (and vice versa).

Likelihood of confusion

37. Highland has pointed to a number of marks on the register which supports its position that 'Nordic' is a common element in clothing marks and that their co-

⁶ *Sabel BV v Puma AG* [1998] RPC 199.

⁷ *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

existence shows that the public can distinguish between them. Nordica has sought to explain its own co-existence with these marks. I also note that some of the regions in which Highland sells its goods coincide with some of the specific locations of sale of Nordica's goods (the Lake District/ Keswick and Kendal, Perthshire/ Perth, and the Scottish Highlands/Fort William). Absence of confusion has been the subject of judicial comment and a registry tribunal practice notice, TPN 4/2009; it seldom has an effect on the outcome of a case brought under section 5(2)(b) of the Act. There is no knowing whether the same people have been exposed to both marks and if they were confused; they may have been confused but did not know it, or they may have been able to distinguish between the marks of the parties (and the marks of the various third parties Highland cites, which may not even be in use).

38. In deciding whether there is a likelihood of confusion between the marks, I must weigh the various factors I have identified, including the principle of interdependency, whereby a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon*). I have found that the goods are identical, that the marks are similar to a low to moderate degree and that the earlier mark is inherently distinctive. I bear in mind the whole mark comparison, the dominant and distinctive elements within the marks, and the effect which a primarily visual purchasing process has upon the weight of these elements. In *Quelle AG v OHIM* Case T-88/05, the GC said:

“68 Therefore, in the global assessment of the likelihood of confusion, the visual, phonetic or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (Case T-129/01 *Alejandro v OHIM – Anheuser Busch (BUDMEN)* [2003] ECR II-2251, paragraph 57, and *NLSPORT, NLJEANS, NLACTIVE and NLCollection*, paragraph 53 supra, paragraph 49). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing marks are marketed. If the goods covered by the marks in question are usually sold in self-service stores where consumers choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any phonetic similarity between the signs (*NLSPORT, NLJEANS, NLACTIVE and NLCollection*, paragraph 53 supra, paragraph 49).”

I do not ignore aural perceptions in the purchasing process as it is one of the elements of the global comparison, but I bear in mind that clothing is usually more of a visual purchase so that the visual aspect of the similarity between the

marks carries more weight in my comparison than the aural similarity. Visual perception of the mark includes Highland's prominent device element which forms part of the overall perception of the application, as per *Shaker*⁸. The visual perception of the device will militate against imperfect recollection. I also consider that although the NORDICA and NORDIC elements are similar visually, NORDIC is but one element in the overall perception of the mark and it is an element which has a geographical dictionary meaning, unlike NORDICA which, for the UK consumer, is an invented word. Such conceptual differences can counteract visual similarities (as per *Phillips-Van Heusen Corp v OHIM* [2004] ETMR 60). Although I bear in mind that the average consumer perceives trade marks as wholes and rarely has the opportunity to compare marks side by side, relying instead upon the imperfect picture he has of them in his mind, the conceptual dissimilarity of the marks is an important factor reducing the likelihood of imperfect recollection. In making a whole mark comparison, the net differences between the marks outweigh the similarities to the extent that there will be no likelihood of confusion. For goods such as outdoor clothing or skiwear, the latter being an occasional, relatively expensive purchase subject to careful consideration, even if the average consumer did not consider NORDICA to be wholly invented (in that it is evocative of Nordic), he will put the similarity down to coincidence in the use by different undertakings of an evocative reference to cold countries. The coincidence will not be attributed to an economic connection.

39. The opposition fails under section 5(2)(b) of the Act.

Section 5(3) of the Act

40. The relevant date at which the question of reputation must be assessed is the filing date of the application. The reputation that Nordica is required to show is set out in *General Motors Corporation v Yplon SA* [1999] E.T.M.R. 950:

“24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector.

⁸ “41 It is important to note that, according to the case-law of the Court, in the context of consideration of the likelihood of confusion, 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. On the contrary, 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 (see order in *Matratzen Concord v OHIM*, paragraph 32; *Medion*, paragraph 29).

As the Advocate General pointed out in point 21 of her Opinion, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element.”

25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.”

41. Two of Nordica’s earlier marks are CTMs. In *PAGO International GmbH v Tirolmilch registrierte Genossenschaft mbH*, case C-301/07, the ECJ stated:

“Article 9(1)(c) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark must be interpreted as meaning that, in order to benefit from the protection afforded in that provision, a Community trade mark must be known by a significant part of the public concerned by the products or services covered by that trade mark, in a substantial part of the territory of the European Community, and that, in view of the facts of the main proceedings, the territory of the Member State in question may be considered to constitute a substantial part of the territory of the Community.”

(The member state in question was Austria). Consequently, both *General Motors* and *Pago* require that Nordica’s CTMs must be known by a significant part of the public concerned by the products or services covered by the marks, in the relevant territory. In these proceedings, the relevant territory includes, but is not limited to, the UK.

42. The evidence provided by Nordica is ill-directed in a number of respects which are necessary to show the required level of reputation. Much of it is undated, indeterminately dated or post-dates the relevant date. Several of the exhibits are international, without being geographically specific or are marketing materials. Where there is UK use shown I cannot tell how significant the market share is of the Nordica marks; although Mr Zanetta indicates (it is not clear) that in the 1960s and 1970s Nordica accounted for 30% of the global production of ski footwear, producing 2 million pairs of boots and shoes per annum, this does not tell me the position in the relevant (European) territory, nor does it tell me the mark(s) used. It is also 30 years at least before the relevant date. The invoices refer to both NORDICA and ROLLERBLADE goods and the publicity figures are low and undated. In the absence of any corroborative evidence, I cannot rely only upon the OHIM decision which testifies to a reputation in Spain and Austria. I cannot therefore say that at the relevant date that Nordica’s marks were known

by a significant part of the relevant public. Without a sufficient reputation Nordica cannot succeed under section 5(3) of the Act and this ground fails accordingly.

43. Section 5(4)(a)

The principles of the law of passing-off were summarised by Lord Oliver in *Reckitt & Colman Products Ltd v. Borden Inc* [1990] RPC 341 at page 406:

“The law of passing off can be summarised in one short general proposition--no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff. ... Thirdly he must demonstrate that he suffers, or in a *quia timet* action that he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff.”

Nordica relies upon the sign NORDICA under this ground. I have given my conclusion above in relation to the similarity between NORDICA and Highland's mark. Given my findings under section 5(2)(b) for identical goods, Nordica can be in no better position under section 5(4)(a) and this ground also fails.

44. Costs

Highland has been successful and is entitled to an award of costs on the following basis,

Considering the other side's statement and preparing a counterstatement:	£400
Preparing evidence and considering and commenting on the other side's evidence:	£900
Written submissions:	£400

Total:

£1700

44. I order Nordica S.p.A. to pay Highland Woollen Company Limited the sum of £1700. 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 26 day of October 2010

**Judi Pike
For the Registrar,
the Comptroller-General**