

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

**IN THE MATTER OF APPLICATION No. 1505609
BY GERRARD SPORTS TO REGISTER A MARK IN CLASS 25**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
No. 43619 BY JACK WOLFSKIN
AUSRUSTUNG FUR DRAUSSEN GMBH**

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

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IN THE MATTER OF APPLICATION No. 1505609

**By Gerrard Sports to register a mark in Class 25
and**

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In the matter of opposition thereto under

No. 43619 by Jack Wolfskin

Ausrüstung Får Draussen GmbH

DECISION

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On 30 June 1992 Gerrard Sports applied to register the following mark in Class 25 for swimwear.

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The application is numbered 1505609

On 30 November 1995 Jack Wolfskin Ausrüstung får Draussen GmbH filed notice of opposition to this application. The grounds are in summary

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- (i) under Section 12(1) by reason of a number of registrations standing in their name (see below for details).
- (ii) under Section 11 by reason of the use of these marks
- (iii) under Section 17 in that the applicants cannot claim to be the proprietors of the mark applied for.

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They also ask that the application be refused in the exercise of the Registrar's discretion.

Details of the registrations referred to above are as follows:-

No.	Mark	Class	Journal	Specification
5	1287703	18	5841/05550	Rucksacks, backpacks in the nature of knapsacks; carrying bags included in Class 18, shoulderbags; saddlebags for cycles; but not including any of the aforesaid goods made from or incorporating the skin or fur of animals.
				
	1287704	20	5746/03010	Sleeping bags, all included in Class 20.
				
	1287705	22	5732/02038	Tarpaulins, sails, tents, all included in Class 22.
				
	1287706	25	5841/05567	Articles of clothing, footwear and headgear, all included in Class 25; but not including any of the aforesaid goods made from or incorporating the skin or fur of animals.
				

No.	Mark	Class	Journal	Specification
1287707		28	5813/01282	Sporting articles (other than clothing); protective coverings for all the aforesaid goods; all included in Class 28, but not including any of the aforesaid goods being exercise bicycles.

5 The applicants filed a counterstatement denying the above grounds. In the alternative (and so far as the Sections 11 and 12 objections are concerned) they say that their own use has been such that the application would be entitled to proceed under the provisions of Section 12(2), that is to say honest concurrent use.

10 Both sides ask for an award of costs in their favour. Both sides filed evidence. Neither side has requested a hearing but written submissions were received from Haseltine Lake Trademarks on behalf of the opponents and Appleyard Lees on behalf of the applicants. The latter's letter of 27 January 1999 referred, inter alia, to correspondence between the two sets of trade mark attorneys regarding an earlier, and presumably failed, attempt to achieve a negotiated settlement. In the circumstances I do not intend to take this correspondence into
15 account.

20 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.

Opponent's evidence

25 The opponents filed a declaration by Manfred Hell, their Managing Director.

30 Mr Hell says that his company's pawprint device has been used in the UK (either on its own or in combination with the words JACK WOLFSKIN) since 1983 in relation to sleeping bags, tents, rucksacks, backpacks, t-shirts, shirts, trousers, pants, overtrousers, shorts, hats, caps, gloves, scarfs, warming accessories, underwear, all kind of jackets and functional jackets, pullovers, mats, bike packs, panniers, packsacks, camera bags, raincovers, purses, breastpouches, sweatshirts, belts, day packs, hip bags, travel bags, tarps, fleece clothing, gaiters.

Turnover has been

	Year	£
5	1986	20,000
	1987	180,000
	1988	340,000
	1989	450,000
	1990	550,000
10	1991	910,000
	1992	1,030,000

(I ignore for current purposes sales after the relevant date in these proceedings)

15 Advertising expenditure is said to have been

	Year	£
	1986	2,000
	1987	10,000
20	1988	15,000
	1989	20,000
	1990	25,000
	1991	40,000
	1992	40,000

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The goods have been sold in most major towns and cities through retail outlets and shop chains such as Scout shops as well as by mail order.

In support of this he exhibits:-

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- MH1 - details of the company's registrations
- MH2 - invoices dated 1983 to demonstrate the length of use
- MH3 - a 1995 brochure (this places it after the relevant date)
- MH4 - data sheets from Whitehead Media Consultants showing advertising schedules
- 35 MH5 - sample advertisements

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Applicants' evidence

The applicants filed a statutory declaration by Malcolm Hill who says he trades as Gerrard Sports. He says the mark applied for has been used since October 1990 with turnover up to the relevant year being:-

Year	£	
1990	300	
1991	1,500	
1992	1,500	No breakdown is given up to the application filing date

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Advertising expenditure is said to have been £15,000 between 1990 and 1997 (again no breakdown is given). A selection of brochures is exhibited (MH1). Mr Hill says no instances of confusion have come to light. Mr Hell subsequently filed a further declaration commenting on the applicant's use. I take this to be in effect a challenge to the applicant's claim that they should be allowed to proceed under the provisions of Section 12(2) in the event that I find against them under Section 11 and 12(1). I bear Mr Hell's comments in mind in this respect.

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That completes my review of the evidence.

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In their written conclusions the opponents' attorneys helpfully indicated that the Section 17 ground was not being pursued. That ground, therefore, falls away and I need say no more about it.

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The matter falls to be decided under Sections 11 and 12 of the Act. These Sections 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:-

5 (Under Section 11) Having regard to the user of the opponents' marks (the paw device with or without the words JACK WOLFSKIN), is the tribunal satisfied that the mark applied for, 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 persons?

10 (Under Section 12) Assuming user by the opponents of their marks (that is to say the marks of the registrations referred to at the start of this decision) in a normal and fair manner for any of the goods covered by the registration of those marks, is the tribunal satisfied that there will be no reasonable likelihood of deception amongst a substantial number of persons if the applicants use their mark normally and fairly in respect of any goods covered by their proposed registration?"

15 I will deal with Section 12 first. As noted at the start of the decision the opponents have registration in Classes 18, 20, 22, 25 and 28. Two of these registrations are for device marks. The remaining registrations are for the same device combined with the words JACK WOLFSKIN.

20 The standard test in relation to comparison of marks is that propounded by Parker J in Pianotist Co's application (1906) 23 RPC 774. The relevant passage reads:-

25 "You must take the two words. You must judge of them both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of these trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering all

30 those circumstances, you come to the conclusion that there will be a confusion - that is to say - not necessarily that one will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public, which will lead to confusion in the goods - then you may refuse the registration, or rather you must refuse the registration in that case."

35 The test requires a degree of adaptation where device marks are involved but the underlying considerations still hold good. The opponents' case rests on the claim that the applicants' mark, like the opponents', contains a pawprint. A careful analysis reveals stylistic differences between the respective devices most notably the additional elements on the opponents' device which are, I assume, intended to represent the tips of an animal's claws. In other respects (including the orientation of the marks) I find the devices to be remarkably similar. It might be argued that the applicant's mark without the claw element could be seen simply as an abstract device. But I find that proposition in itself inherently unlikely and any remote possibility of such a view being taken of the mark is dispelled by the presence of the words PAW brand.

40 These words give expression to, and reinforce the idea of, the mark.

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Had the matter rested there and given that the opponent's Class 25 registration covers articles of clothing at large (thus including swimwear) I would have concluded without further ado that the opposition had been successful. However, it will be noted that the opponents' device mark is only separately registered in Classes 20 and 22 in respect of goods which could not conceivably be said to be of the same description as swimwear. The other registrations including the most relevant one in Class 25 are for the composite mark which combines the paw device with the words JACK WOLFSKIN.

The question, therefore, arises as to whether the mark applied for so nearly resembles the opponent's composite mark as to give rise to a risk of confusion. It is well established that marks should be considered as wholes and not unduly dissected into their component elements. Equally, however, I must have regard to the essential and distinguishing features which go to make up the marks - see for instance the following passages from *Saville Perfumery Ltd v June Perfect Ltd*, 1941 RPC 147 at page 162 lines 1-9.

“In the present case, for example, the evidence makes it clear that traders who have to deal with a very large number of marks used in the trade in which they are interested, do not, in practice, and indeed cannot be expected to, carry in their heads the details of any particular mark, while the class of customer among the public which buys the goods does not interest itself in such details. In such cases the mark comes to be remembered by some feature in it which strikes the eye and fixes itself in the recollection. Such a feature is referred to sometimes as the distinguishing feature, sometimes as the essential feature, of the mark.”

and again at page 162 lines 18-20

“Now the question of resemblance and the likelihood of deception are to be considered by reference not only to the whole mark, but also to its distinguishing or essential features, if any”.

With these considerations in mind it seems to me that as regards the opponents' Class 25 registration:-

- the words JACK WOLFSKIN would probably be seen as the dominant element of the mark but

- the device of a silhouette of an animal's pawprint is also an essential and visually striking feature of the mark.

- the device is not so overpowered by the words that the overall effect is diminished within the context of the mark as a whole.

- given the way in which clothing is sold the visual appeal of the device could be of equal importance to the words in attracting customer's attention and possibly also in the ordering of goods.

Having come to the above view it is , I think, a natural consequence that another silhouetted paw device appearing in the market for what (within the notional context of the Section 12 test) could be identical goods is likely to cause confusion. The opposition, therefore, succeeds under Section 12.

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That is not the end of this matter as the applicants have entered a counterclaim that, in the event of my finding as I have under Section 12, they are entitled to proceed under the honest concurrent use provisions of Section 12(2). Before I go on to consider that matter I will deal briefly with the Section 11 position by saying that I do not find the opponents' evidence convincing. My reasons are:

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- the evidence suggests that the opponents are outdoor equipment and clothing suppliers. The fact that they advertise in magazines such as 'The Great Outdoors', 'Climber and Hill Walker', 'Country Walking' etc lends support to this view as does the brochure at MH3.

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- the turnover figures are not broken down in such a way that allows a view to be formed on the importance to the business of the various goods areas.

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- the invoice evidence is both very limited in scope and leaves me in some doubt as to the goods involved.

- the data sheets and advertising schedules give no information on the goods being promoted.

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Whilst it is the case that the test under Section 11 is not restricted to goods of the same description I find it inherently unlikely that confusion will arise amongst a substantial number of people if the applicants use their mark on swimwear given the specialised nature of the opponents' use in the outdoor clothing and equipment market. The opposition fails under Section 11.

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This brings me to the applicants' claim under Section 12(2), this reads:-

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"12.-(2) In case of honest concurrent use, or of other special circumstances which in the opinion of the Court or the Registrar make it proper so to do, the Court or the Registrar may permit the registration by more than one proprietor in respect of:-

a. the same goods

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b. the same description of goods or

c. goods and services or descriptions of goods and services which are associated with each other,

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of marks that are identical or nearly resemble each other, subject to such conditions and limitations, if any, as the Court or the Registrar, as the case may be, may think it right to impose.

The main matters for consideration under Section 12(2) were laid down by Lord Tomlin in the PIRIE case 1933 RPC 147. They are:

- (i) the extent of use in time and quantity and the area of trade;
- (ii) the degree of confusion likely to ensue from the resemblance of the marks, which is, to a large extent, indicative of the measure of public inconvenience;
- (iii) the honesty of the concurrent use;
- (iv) whether any instances of confusion have been proved;
- (v) the relative inconvenience which would be caused if the mark in suit was registered, subject if necessary to any conditions and limitations.

I do not propose to comment on the individual criteria as it seems to me that the applicants' claim is extremely weak taking the position at the material date in these proceedings, that is to say 30 June 1992. At that point in time the applicants had less than two years' use and sales (assuming a pro rata amount for the first half of 1992) of only some £2500 of goods. The substantiating material is similarly thin consisting of one brochure which is some 2 years or so after the relevant date and two other items that so far as I can see are undated. This evidence is wholly insufficient to found an honest concurrent use claim.

The opposition is thus successful by virtue of my finding under Section 12(1). The opponents are entitled to a contribution towards their costs. I order the applicants to pay the opponent's £635.

Dated this 17 day of November 1999

**M REYNOLDS
For the Registrar
the Comptroller General**