

O-407-12

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2566189  
BY MAMMOTH SPORT LTD TO REGISTER THE SERIES OF TWO TRADE  
MARKS:**

**Mammoth**

**AND**

**MAMMOTH**

**IN CLASSES 9, 10, 20, 24, 25 AND 28**

**AND IN THE MATTER OF OPPOSITION  
THERE TO UNDER NO. 102099  
BY MAMMOET HOLDING B.V.**

## BACKGROUND AND PLEADINGS

1) On 2 December 2010, Mammoth Sport Ltd (“the applicant”) applied under the Trade Marks Act 1994 (“the Act”) for registration of the following series of two marks:

Mammoth

MAMMOTH

2) The application is in respect of various goods in classes 9, 10, 20, 24, 25 and 28, but for the purposes of these proceedings, the only relevant goods are those listed in Class 9, namely:

*Protective sports equipment and clothing*

3) The application was published in the Trade Marks Journal on 25 March 2011 and on 24 June 2011, Mammoet Holding B.V. (“the opponent”) filed notice of opposition against the Class 9 goods of the application (listed above). The grounds of opposition are in summary:

- a) That the application offends under Section 5(2)(b) of the Act because it is in respect of a similar mark and identical or similar goods to the following three earlier marks in the name of the opponent:

Mark and other relevant details	Goods and services relied upon
CTM*3993599  Filing date: 25 August 2004 Registration date: 21 February 2006	<b>Class 9:</b> <i>Protective goggles; protective masks; knee pads; ear plugs; safety tarpaulins; protective footwear; protective helmets; non-reflective and reflective safety clothing; reflective signposts; fire blankets; fire-resistant clothing, footwear and headgear; protective clothing (uniform/workwear), footwear and headgear.</i>
CTM2621746  Filing date: 18 March 2002 Registration date: 29 October 2003	<b>Class 37:</b> <i>Construction, repair, maintenance, servicing, salvaging, installation; hoisting (crane) services.</i>  <b>Class 39:</b> <i>Transport by land, sea and air; vehicle-towing services; warehousing; refloating of ships; rental of warehouses; rental of vehicles for transport by sea and air.</i>

<p>1544049</p>  <p>Filing date: 5 August 1993</p> <p>Registration date: 5 August 1994</p>	<p><b>Class 39:</b> <i>Transportation of goods by road and sea; all included in Class 39.</i></p>
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\*Community Trade Mark

- b) The application offends under Section 5(3) of the Act because due to extensive use of the opponent's marks in respect of all the goods and services listed above, use of the applicant's mark would take unfair advantage of, or be detrimental to the distinctive character or reputation of the opponent's mark.
- c) The application offends under Section 5(4)(a) of the Act because the opponent has used its marks in the UK since as early as 13 April 1982 and in respect of all the goods and services as reflected in its above three registrations.

4) The applicant subsequently filed a counterstatement denying the opponent's claims. The opponent's marks are "earlier marks" as defined by Section 6 of the Act and, because they were registered more than five years before the contested application was published, they are potentially subject to the proof of use provisions set out in Section 6A of the Act. However, the applicant has not put the opponent to proof of use (as can be seen at point 5 of the applicant's form TM8). The consequence of this is that the opponent can rely upon all of the goods and services listed in the table shown at paragraph 3, above.

5) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. Neither side requested to be heard and, consequently, I make my decision following a thorough consideration of the papers on file.

**Opponent's Evidence**

6) This takes the form of a witness statement by Mr Michael Schaap, Manager of the Legal Department of the opponent company. He provides information regarding the significant activities of the opponent in the field of transport, shipping, installation and removal of heavy objects provided, principally, to the petrochemical industry, civil engineering projects, power generation sector and on offshore and marine projects. It has 3,800 staff working in the Netherlands and seventy locations around the world. Mr Schaap provides further detail of these activities but, for the purposes of this decision, I do not need to detail them.

7) Mr Schaap also states that, since 2007, the opponent has supplemented its core activities by designing and producing protective clothing, headgear and footwear. These goods are provided to its employees and contractors and are also available to the public through its website.

8) At Exhibit MS13, Mr Schaap provides a copy of the opponent's Workwear Brochure for 2008-9 and also a "current brochure" (dated 2008-9). Both these brochures appear to be bilingual, containing text in both Dutch and English. Exhibit MS15 consists of copies of six invoices, four of which are addressed to an unknown trader in the West Midlands. The other two invoices are addressed to separate traders, also in the UK. All are dated before the filing date of the application, with the earliest being dated March 2008. Mr Schaap states that these invoices relate to "workwear" and "other merchandising items". The total of these six invoices is in the region of €25,000.

### **Applicant's Evidence**

9) This takes the form of a witness statement by Mr John Tuton, Managing Director of the applicant company. He states that the applicant's mark has yet to be used in respect of Class 9 goods. He also provides a number of submissions that I will keep in mind, but not detail here.

### **Opponent's Evidence in reply**

10) This consists of a witness statement by Ms Katherine Cameron, Registered Trade Mark Attorney and a Partner at RGC Jenkins & Co., the opponent's representatives in these proceedings. The majority of this statement is in the form of submissions countering Mr Tuton's submissions mentioned above. Once again, I will keep these in mind, but not detail them here.

## **DECISION**

### **Section 5(2)(b)**

11) Section 5(2)(b) reads:

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

(a) ...

(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."

12) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the Court of Justice of the European Union (CJEU) in *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] FSR. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] ETMR 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 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 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; *LIMONCELLO*

### ***Comparison of goods and services***

13) In assessing the similarity of goods and services, it is necessary to apply the approach advocated by case law and all relevant factors relating to the respective goods and services should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23:

‘In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.’

14) Other factors may also be taken into account such as, for example, the distribution channels of the goods concerned (see, for example, *British Sugar Plc v James Robertson & Sons Limited (TREAT)* [1996] RPC 281).

15) The opponent's best case appears to lie with its Class 9 goods covered by its earlier CTM 3993599. The table below shows the respective goods:

Opponent's goods	Applicant's goods
<i>Protective goggles; protective masks; knee pads; ear plugs; safety tarpaulins; protective footwear; protective helmets; non-reflective and reflective safety clothing; reflective signposts; fire blankets; fire-resistant clothing, footwear and headgear; protective clothing (uniform/workwear), footwear and headgear.</i>	<i>Protective sports equipment and clothing</i>

16) The opponent submits that its *protective goggles; protective masks; protective footwear; protective helmets* are similar or identical to the applicant's *protective sports equipment*. When considering this, it is necessary to understand what would be understood by the term "equipment" and whether this can include goggles, masks, footwear and helmets. "Equipment" is defined as "the necessary items for a particular purpose"<sup>1</sup>. Upon an ordinary meaning of this definition it is self-evident that the opponent's goggles, masks, footwear and helmets are all items for the purpose of protecting. Further, and more importantly, the consumer upon seeing *protective goggles; protective masks; protective footwear; protective helmet* is likely to collectively describe them as protective equipment. Such protective equipment includes protective equipment for sporting purposes. Consequently, I find that these goods are covered by the applicant's *protective sports equipment*. The goods are, therefore, identical.

17) Even if I am wrong in my conclusions, detailed in the above paragraph, and *protective goggles, protective masks, protective footwear and protective helmets* would not be collectively described as "equipment", they are still similar to a good degree with the applicant's *protective sports equipment*. They still share the same purpose and may share the same trade channels, even if their nature and methods of use may differ.

18) In respect of the applicant's *protective sports clothing*, the opponent's best case appears to reside with its *fire-resistant clothing*. Both of these terms could include clothing of the type worn by participants in motorsports and other similar sports. Consequently, identical goods are involved. Further there is a good deal of similarity between the applicant's *protective sports clothing* and the opponent's *protective footwear*. They share a very similar purpose and method of use and, insofar as the opponent's goods relate to sport, are likely to be sold in the same outlets.

<sup>1</sup> "equipment". Oxford Dictionaries. April 2010. Oxford Dictionaries. April 2010. Oxford University Press. 08 October 2012 <<http://oxforddictionaries.com/definition/english/equipment>>.

19) In light of my findings detailed above, I have already identified the opponent's best case. Consequently, I will not continue with an assessment of similarity of the applicant's goods with other goods of the opponent, despite the opponent making submissions on this.

### ***The average consumer***

20) Matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, paragraph 23), who is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*, paragraph 27). The degree of care and attention the average consumer uses when selecting goods and services can, however, vary depending on what is involved (see, for example, the judgment of the GC in *Inter-Ikea Systems B.V. v. OHIM*, Case T-112/06).

21) The respective goods are essentially protective sports clothing and equipment and protective clothing and equipment more generally. The General Court (GC) has identified the importance of visual comparison when considering the purchasing act in respect of clothing (see for example Joined Cases T-117/03 to T-119/03 and T-171/03 *New Look Ltd v OHIM (NLSPORT et al)* [2004] ECR II-3471 at [49]-[50] and Case T-414/05 *NHL Enterprises BV v OHIM (LA KINGS)* [2009] ECR II.). When such goods are for the purpose of protecting the wearer, then a higher level of attention is likely to be required than ordinary items of clothing, but nonetheless, the purchase is likely to still be primarily visual in nature as the items will need to be tested for fit and size. The same can be said for protective equipment such as goggles, masks, helmets and footwear. Whilst the level of attention paid during the purchasing process is likely to be higher than for ordinary clothing, it will nonetheless still not be of the highest order as these goods are not of the highest value.

### ***Comparison of marks***

22) In light of identifying the opponent's case as being those represented by its earlier CTM 3993599, I will restrict my consideration of the marks to a comparison of this CTM to that of the applicant's marks. For ease of reference, the respective marks are:

<b>Opponent's mark</b>	<b>Applicant's marks</b>
	Mammoth
	MAMMOTH

23) When assessing the extent of similarity between the respective marks, I must do so with reference to their visual, aural and conceptual similarities bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*, para

23). The applicant's marks consist of a single word and, self-evidently, this word in the dominant and distinctive element. The opponent's mark consists of a device of an *Elephantidae*-type animal at the start of the mark and being of roughly the same height of the letters of the word element, MAMMOET. These two elements are presented within a red, rectangular background. The distinctive word element, being seven letters long, dominates the mark, however, the device element is also a distinctive element that must be considered in the comparison. The background colour assists in giving the mark its overall appearance and, not being negligible, cannot be ignored in the comparison of marks.

24) In considering a visual comparison of the marks, both the opponent's mark and the two marks of the applicant all contain a single seven letter word that begins with same first five letters "MAMMO". They differ in that the last two letters are "ET" in the opponents mark and "TH" in the applicant's marks. Further, the opponent's mark has additional features that are absent in the applicant's marks, namely white letters on a red background and a device of an *Elephantidae*-type animal. Finally, the first of the applicant's marks is presented with a capital first letter with the remaining letters in lower case. I do not consider that this introduces any material difference that would require me to reach a different decision regarding visual similarity when considering whether this mark or the applicant's second mark to that of the opponent's. Taking all of the above, I conclude that the respective marks share a moderate to moderately high level of visual similarity.

25) From an aural perspective, the opponent's mark consists of two or three syllables, the first of which is likely to be pronounced as MAM. There is less certainty regarding the second part of the mark, that may be pronounced in a number of possible different ways by the English speaking UK consumer, namely as a single syllable MOOT or MOAT or as the two syllables MO-A or MO-ET. Which pronunciation dominates will depend, in part, by the consumer's level of knowledge of other languages but, in an absence of such knowledge, it is likely to perceive the mark as being MAM-MOAT or MAM-MO-ET. The applicant's marks are likely to be pronounced as the two syllables MAM-MOTH or MAM-MUTH. Taking all of this into account, I conclude that the respective marks share a reasonably high level of aural similarity.

26) Conceptually, the applicant's marks will be instantly understood as meaning "a large extinct elephant"<sup>2</sup> It is a description that is likely to be easily and instantly understood by the consumer. The opponent's mark includes a word that has no meaning in the English language and Mr Tuton, in his witness statement, submits that this is significant. However, because of the presence of the *Elephantidae*-type animal device and the similarity of the word to the English word MAMMOTH, it is likely that the mark, when viewed as a whole, will be perceived as a foreign

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<sup>2</sup> "mammoth". Oxford Dictionaries. April 2010. Oxford Dictionaries. April 2010. Oxford University Press. 08 October 2012 <<http://oxforddictionaries.com/definition/english/mammoth>>.

reference to a mammoth. The consumer may not know which language the word MAMMOET originates, but it is sufficient that the consumer makes the link to a mammoth in order for me to find that the marks will be perceived as being conceptually identical.

27) In summary, I have found that the respective marks share a moderate to moderately high level of visual similarity, a reasonably high level of aural similarity and are conceptually identical. This combines to give a reasonably high level of similarity overall.

### ***Distinctive character of the earlier trade mark***

28) I must consider the distinctive character of the earlier mark because the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG* [1998] RPC 199). The distinctive character of the earlier mark must be assessed by reference to the goods for which it is registered and by reference to the way it is perceived by the relevant public (*Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91).

29) The opponent's mark consists of a word that has no meaning relevant to the goods (that represent its best case), other than to possibly allude to their large or strong nature. Consequently, it is endowed with a reasonably high level of inherent distinctive character, but not the highest level that may, for example, be endowed in a word perceived as having no meaning.

30) The opponent has stated that it has produced a range of workwear that is worn by its employees and contractors and that it is also available to the public via its website. However, the only disclosed sales in the UK amounts to a total of about €25,000. This is a very small amount when considering the likely size of the UK market for protective work wear. I must, therefore, conclude that the mark's inherent level of distinctive character has not been enhanced through use.

### ***Likelihood of confusion***

31) I must adopt the global approach advocated by case law, with the factors assessed so far having a degree of interdependency (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, paragraph 17). I also take into account that marks are rarely recalled perfectly with the consumer relying instead on the imperfect picture of them he has in kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*, paragraph 27).

32) The earlier mark is reasonably highly distinctive and the respective marks share a reasonably high level of similarity. The opponent's mark contains the prominent word MAMMOET. This word is not likely to be immediately understood by the average English speaking UK consumer. However, the mark also contains a device of an *Elephantidae*-type animal. In my view, it is likely that a

combination of this likeness of a mammoth, together with the similarity of the word MAMMOET to the English word MAMMOTH, will lead the consumer to believe that MAMMOET is a foreign word meaning MAMMOTH. The English speaking consumer may not know which language MAMMOET originates from, but this will not impact upon the impression created by the mark as a whole.

33) When factoring this into the overall assessment, together with the fact that I have found that all of the applicant's goods are identical to certain of the opponent's goods, I find that the average consumer is likely to believe that the goods originate from the same or linked undertaking.

34) Even if I am wrong in my conclusion that the opponent's *protective goggles*, *protective masks*, *protective footwear* and *protective helmets* can collectively be described as "equipment" and, therefore, would not be considered identical to the applicant's goods, they would still be similar to a high extent. Consequently, confusion would still be likely.

35) Further, if the applicant wished to circumvent my finding that its *protective sports clothing* is identical to the opponent's *fire-resistant clothing* by proposing a suitable limit to its specification, this would not assist. This is because I have also found that *protective sports clothing* is also similar to a good degree with the opponent's *protective footwear*. Consequently, I also find that the opposition, insofar as it relates to the applicant's *protective sports clothing* also succeeds where the opponent relies upon its "next best case" of *protective footwear*.

36) In summary, I find that there is likelihood of confusion with all of the applicant's goods and, accordingly, the opposition, insofar as it is based upon Section 5(2)(b) of the Act, is successful in its entirety.

### **Section 5(3) and Section 5(4)(a)**

37) In light of my finding in respect to the grounds based upon Section 5(2)(b), it is not necessary for me to go on to consider the grounds based upon Section 5(3) or Section 5(4)(a).

### **COSTS**

38) The opposition having been successful, the opponent is entitled to a contribution towards its costs. I take account of the fact that no hearing has taken place and that both sides filed evidence, but that this was largely un-influential on the outcome. I award costs on the following basis:

Notice of Opposition (inc. Official fee) and statement of case in reply  
£600

Preparing and filing evidence and considering other side's evidence  
£500

TOTAL

£1,100

39) I order Mammoth Sport Ltd to pay Mammoet Holding B.V. the sum of £1,100. 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 18th day of October 2012**

**Mark Bryant  
For the Registrar,  
the Comptroller-General**