TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 3025723
BY POUNCE LIMITED
TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 25:**

AND

**AN OPPOSITION THERETO (NO. 401650) BY
JACK WOLFSKIN AUSRUSTUNG FUR DRAUSSEN GMBH & CO. KGaA**

Background and pleadings

1. This dispute concerns whether trade mark application 3025723 should be registered**.** The application was filed by Pounce Limited ("the applicant") on 10 October 2013 and it was published in the Trade Marks Journal, for opposition purposes, on 1 November 2013. The mark and the goods[1] for which registration are sought are as follows:

> **Class 25:** Clothing, namely male and female underwear and sleepwear; sportswear namely tennis skirts, shorts and tops; male and female swimming trunks and bikini's; headgear namely sun hats and panama hats; footwear; flip flops, espadrilles and sandals.

2. Jack Wolfskin Ausrustung fur Draussen GmbH & Co. KGaA ("the opponent") opposes the registration under section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). It relies on a single earlier Community Trade Mark ("CTM") registration (no. 3035052) which was filed on 31 January 2003 and which completed its registration procedure on 17 March 2005. The earlier mark and the goods on which the opponent relies are set out below:

> **Class 25:** Clothing, footwear, headgear.

3. Given its date of filing, the opponent's mark constitutes an earlier mark as defined by section 6 of the Act. The earlier mark completed its registration procedure before the five year period ending on the date of publication of the applicant's mark, meaning that the use conditions set out in section 6A of the Act are pertinent. The opponent made a statement of use that the earlier mark has been used for all of the goods relied upon. The opponent said this in relation to the competing marks:

> "The opposed mark and earlier mark are similar. The earlier mark comprises a four-toed animal print orientated at roughly 30'. The opposed mark also incorporates a four-toed animal print orientated at roughly the same angle, alongside its mirror image and above some minor, non-distinctive decoration."

4. The applicant filed a counterstatement denying the opposition. In its counterstatement the applicant did not ask the opponent to prove that it had made

[1] The goods were limited to this after the opposition was filed, but it did not overcome the opponent's concerns.

genuine use of its mark. The consequence of this is that the opponent is able to rely on its class 25 goods as registered. I note that in a set of written submissions dated 6 October 2014 the applicant's representative made a preliminary comment in which its observes that: i) the opponent would have been required to furnish proof of use if the applicant had requested it, ii) the applicant prepared its TM8 without taking professional advice, iii) the opponent's business focus is on "specialist outdoor and sports equipment", and iv) the applicant's specification has been limited (as set out above) to goods which are not specialist outdoor goods. None of these points are pertinent. The fact that the applicant was not professionally represented does not change the fact that proof of use was not requested. It is not as though the applicant (through it's now appointed professional representative) has sought leave to amend its counterstatement to do so. Therefore, any reference to the goods for which the opponent actually trades is an attempt to re-introduce proof of use through the back door. This is not permissible. The opponent is able, as stated above, to rely on all of its goods in class 25. No *de facto* limitation shall be applied. I will, of course, come back to the actual goods registered/applied for later. I also note from the applicant's counterstatement that it sees some relevance in the fact that the opponent's mark was not identified by the trade mark examiner who examined the application as a potential problem; this is not relevant because the matter must be assessed by the tribunal.

5. Only the opponent filed evidence (together with some written submissions). The applicant filed written submissions. Neither party requested a hearing or filed written submissions in lieu of a hearing.

The opponent's evidence

6. The evidence is given by Christopher Morris, a trade mark attorney at Burges Salmon LLP. The purpose of his evidence is to provide three examples taken from the Internet of unrelated undertakings using figurative marks in a repeating manner. He also provides three examples of the opponent's mark being used in a repeating manner.

Section 5(2)(b)

7. Section 5(2)(b) of the Act states that:

> "5.-(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,
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

8. The following principles are gleaned from the judgments of the EU courts in *Sabel BV v Puma AG,* Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,* Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV,* Case C-425/98,

Matratzen Concord GmbH v OHIM, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH,* Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM,* Case C-334/05P and *Bimbo SA v OHIM,* Case C-591/12P.

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, 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, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) 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;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Average consumer and the purchasing act

9. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97.* In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited,* [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

> "60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

10. The conflict relates to clothing products. Such goods are "consumed" by members of the general public. The goods may be tried on and are likely to be inspected for colour, size, style, fitness for purpose etc. All of this increases the potential exposure to the trade mark. That being said, the purchase is unlikely to be a highly considered process as clothing is purchased relatively frequently and, although cost can vary, it is not, generally speaking, a highly expensive purchase. The applicant considers that a high degree of care will go into the selection of clothing, the opponent argues for a low degree. I consider the purchasing process to be a normal, reasonably considered one, no higher or lower than the norm.

11. In terms of how the goods will be selected, this will normally be via self-selection from a rail or shelf (or the online equivalents) or perhaps chosen from catalogues/brochures. This suggests a process of visual selection, a view which has been expressed in previous cases[2].

Comparison of goods

12. The applicant's specification, following its limitation, reads:

> **Class 25:** Clothing, namely male and female underwear and sleepwear; sportswear namely tennis skirts, shorts and tops; male and female swimming trunks and bikini's; headgear namely sun hats and panama hats; footwear; flip flops, espadrilles and sandals.

13. The opponent's specification in class 25 reads:

> **Class 25:** Clothing, footwear, headgear.

[2] See, e.g. *New Look Ltd v OHIM* – Joined cases T-117/03 to T-119/03 and T-171/03 (GC)

14. Goods can be considered as identical when the goods of the applied for mark fall within the ambit of broad terms in the earlier mark[3]. In this case, the opponent's specification covers all types of clothing, footwear and headgear even if those goods named by the applicant are not specifically identified by the opponent. **The goods of the applicant are identical to goods of the opponent.**

Distinctive character of the earlier trade mark

15. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). In *Lloyd Schuhfabrik Meyer & Co. GmbH* v *Klijsen Handel BV,* Case C-342/97 the CJEU stated that:

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee* v *Huber and Attenberger* [1999] ECR I-0000, paragraph 49).
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> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

16. The opponent has provided no real evidence showing that the distinctiveness of its mark has been enhanced through use. All it has provided are some examples of its mark being used in a repeating manner. The use does not assist in terms of enhancing distinctiveness. From an inherent perspective, the opponent's figurative mark makes no real allusion to the goods relied on. There is no evidence that such devices are commonly used in the trade. I consider that the earlier mark has at least a reasonable degree of inherent distinctive character.

Comparison of marks

17. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and

[3] See, for example, *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-133/05 – "*Meric*")

conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

> ".....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

18. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The marks are:

The applicant's mark	**The opponent's mark**
	

19. The overall impression of the opponent's mark is based upon its sole element, the device of a paw print. The applicant's mark has more to it. It has a device element composed of two paw prints, a line underneath which tapers at the ends, and three dots underneath that. However, on account of its size and general impact, the paw prints have a greater relative weight in the overall impression than the other elements. The other elements are not negligible so will not be ignored in the comparison.

20. In terms of the visual similarities, the opponent submits:

> "Visually, the respective signs are similar. The Earlier Mark comprises a four-toed wild animal paw print, orientated at roughly 30". The Opposed Mark incorporates a very similar wild animal paw print - the paws in both signs have a broadly triangular/trapezium shaped pad, with an indent at its base, and two parallel sets of toes, one set of slightly smaller toes at a lower level (to the left and right) and one slightly larger, placed set higher and centrally - orientated at roughly the same 30" angle, alongside its mirror image.
>
> The narrow ellipse and three spots on which the paws sit are of an exceedingly low level of distinctiveness and are largely irrelevant for the purposes of a visual comparison."

21. The applicant submits:

"Visually, the marks at issue are different. The mark applied for contains multiple elements including two paw prints close together and pointing towards each other (in a somewhat pigeon - toed configuration), a very narrow oval underneath the paw prints and three spots underneath the narrow oval. In contrast, the Opponent's mark consists only of one element, being one paw print.

8. Furthermore, the paw prints of the mark applied for includes four single "toe-like" elements rather than the four double toe elements each including a portion representing a toe pad and a smaller end portion representing a nail or claw. The mark applied for contains nothing which remotely resembles the "claws" of the earlier mark relied upon by the Opponent.

9. The opponent goes into detail about *various* aspects of the paws at issue. The impression left by the Opponent's earlier mark is that it emulates a life-like paw print of an animal having claws, this being so because it has discrepancies at the bottom of the paw and in the middle, and individual claw impressions, as if a real animal has left the print mark. The use of a single paw also gives the impression of the track (perhaps in the snow) of an animal on the move. The mark applied for, in contrast, is not so life-like and contains two cartoon style paw prints in an unrealistically close relationship (even for a stationary animal) within a mark containing additional features. Contrary to the Opponent's submission, the narrow oval and three spots are important features of the mark applied for and cannot be disregarded. That combined with the fact that there are two paws as opposed to one, result in one being left with a different overall impression when comparing the mark applied for to the earlier mark."

22. In terms of similarities, both marks contain/consist of a paw print made up of a central pad together with what will be seen as four toes/claws. The paw prints are in silhouette form. I feel that this creates a clear degree of visual similarity. However, there are also some differences, differences which reside primarily in the fact that there are two paw prints as opposed to one in the applicant's mark as well as the additional line and dots. I accept that there are additional differences such as the extra nail like element on the toes/claws of the opponent's mark and that the toes/claws are not the exact same shape. However, these are, in my view, less striking differences. Balancing the similarities and differences, I consider there to be a reasonable, but not high, degree of visual similarity.

23. From a conceptual perspective, the concept of the applicant's mark will be that of two paw prints (the other elements play virtually no role in the conceptual impact of the mark). The concept of the opponent's mark is based upon a single paw print. Although there is a difference in the number of paw prints, I feel that this still equates to conceptual similarity of a reasonably high degree. The applicant submits that the opponent's paw print is more life-like and that the average consumer will know the difference between one/two paw prints. The latter point does not remove the conceptual similarity that exists between the marks. The former point is not accepted; I do not see that the paw prints differ between being life-like and cartoon-like.

24. From an aural perspective, neither mark has a verbal element. It is, of course, possible that some consumers will attempt to articulate the mark on the basis of the concept I have outlined. I will bear this in mind, however, this factor is unlikely to be very telling as it is the visual impact of the marks which will take on primary significance and, also, the exact manner of articulation of such figurative marks is difficult to assess.

Likelihood of confusion

25. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG,* paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

26. After referring to the decision of the Court of Appeal in *Specsavers International Healthcare Ltd* & *Ors v Asda Stores Ltd* [2013] and to the decision of Arnold J in *Interflora v. M&S*, the applicant submitted that "the threshold warranting the intervention of the tribunal has not been reached".

27. The opponent submits that it is not uncommon in the fashion trade for businesses to use logos as repeating patterns, indeed, it highlights that the opponent does do this as per the evidence it filed. It submits, therefore, that notional use of its mark could include a side by side repeat which brings its mark even closer to that of the applicant.

28. The applicant states that it: "does not deny that brand owners are entitled [to] use their trade marks in repeating patterns to create attractive decorative elements on their products. However, it is denied that this 'repeating pattern' would be considered by the average consumer as being a trade mark in itself. Rather, the average consumer will recognise that the design is simply the individual trade mark logo being repeated multiple times to create a decorative pattern on the product". It goes on to submit that:

> "The average consumer will recognize that the mark applied for is a set of prints (and not one single paw repeated twice) due to the way in which the pair of paws are positioned and the mark's additional elements, being the long oval which extends the length of both paws and the three spots under the oval. The oval and spots emphasise that the paws are a set which further supports our submission that, when considering the marks as a whole, the additional elements cannot be disregarded."
>
> and that:
>
> "The comparison is between the mark applied for and the earlier mark which has been registered."

29. I agree with the applicant that the comparison is between the marks applied for and registered and that I should not notionally compare a duplicated version of the

opponent's mark. However, this does not mean that confusion is ruled out. The marks still have a reasonable degree of similarity. Despite the applicant's contentions, I consider the actual paw prints to be quite close in terms of the level of detail the average consumer will register. The marks are to be used on identical goods and a reasonable degree of care and consideration will be exercised. The earlier mark also has a reasonable level of inherent distinctive character. The concept of imperfect recollection is, as the opponent submits, an important factor to bear in mind. The average consumer may well forget that one mark consisted of two paw prints, the other only one. Thus, the marks could be imperfectly recalled. The additional differences (the line and dots) play a weaker role in the overall impression and in my view do not do enough to assist the distinguishing process. I come to the view that there is a likelihood of confusion. I should add that even if the average consumer is not directly confused and he/she recalls, for example, that one mark has two paw prints whereas the other has just one, I consider the similarity in the marks (in the paw prints) will be put down to the goods being the responsibility of the same or an economically linked undertaking. The average consumer will regard it as a variant brand of some sort. Although I have not placed much weight on the repeating pattern point, I accept that it is possible that some average consumers may regard the applicant's mark as some form of duplication of the opponent's mark. **There is a likelihood of confusion.**

Costs

30. The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances, I award the opponent the sum of £900 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the other side's statement - £300

Opposition fee - £100

Submissions and evidence - £500

***Total* - £900**

31. I therefore order Pounce Limited to pay Jack Wolfskin Ausrustung fur Draussen GmbH & Co. KGaA the sum of £900. The above sum should 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 17th day of December 2014

Oliver Morris
For the Registrar,
The Comptroller-General