o/992/22

IN THE MATTER OF TRADE MARK APPLICATION NUMBER 3591582
BY GLOBAL TRADEMARK SERVICES LIMITED
TO REGISTER THE TRADE MARK:

IN CLASS 25

AND

AN OPPOSITION THERETO UNDER NUMBER 425363
BY C. & J. CLARK INTERNATIONAL LIMITED

DECISION OF THE APPOINTED PERSON

Introduction

1. This is the Appeal of the Opponent, C & J Clark International Limited ('Clarks'), the well-known shoe maker and retailer, against the decision of the Hearing Officer, Ms E Venables dated 29 April 2022.

2. The contested mark is

3. It is applied for by Global Trade Mark Services Limited ('GTM'), a company controlled by a Mr Jim Dear who represented them in the Opposition. Mr Dear did not appear before me but supported the decision of the Hearing Officer for the reasons she gave, supplemented by some written submissions. I should say that the mark applied for is one of a set of trade marks which Mr Dear has applied for through GTM, each one representing a player from the Glasgow Celtic football team which won the European Cup in 1967 (known as the 'Lisbon Lions'). John Clark played centre back in this team. Mr Dear says the purpose of the trade marks is at least partly to raise money for the players or their families. None of this is of course relevant to the legal issues I have to decide but it puts the application into context.

4. By the time the contested mark came before the Hearing Officer, it had been restricted by GTM to remove the goods of most interest to Clarks (footwear) and also included another attempt to limit the registration by including the 'target market' of the goods. The scope of goods applied for was therefore as follows:

   Class 25 *Clothing, headgear; to be sold only to the target market of online supporters of a Scottish Football Club.*

5. The Hearing Officer rejected the target market restriction, applying the guidance of the European Court of Justice in *Koninklijke KPN Nederland NV v Benelux Merkenbureau (POSTKANTOOR)* Case C-363/99 and the application of that guidance

by Arnold J in *Omega SA (Omega AG) (Omega Ltd) v Omega Engineering Incorporated* [2012] EWHC 3440 (Ch). This decision seems to me entirely correct and is not challenged by GTM.

6. This left the goods of the contested mark as

Clothing, headgear

7. Clarks opposed the registration under s5(2) (similar mark, similar goods 'likelihood of confusion' both direct and indirect) and under s5(3). They relied on a number of earlier registrations for the word

CLARKS

8. They were required to prove use under s6A of the Trade Marks Act 1994 in order to be able to rely on those registrations in these proceedings. The Hearing Officer ultimately found that the widest category of goods for which use had been proved was

Footwear

9. Footwear is a category of goods covered by Clarks' earlier registrations 900167940 and 912953584. These two registrations were therefore treated as the basis for the Opposition, insofar as they were registered for *Footwear.*

10. Clarks did not challenge this limited finding of use.

11. Not surprisingly, the Hearing Officer held that CLARKS had a strong reputation in the UK and therefore that the distinctiveness of the earlier marks had been enhanced 'to a high degree' but only in relation to footwear.

12. The Hearing Officer approached this Opposition in a conventional way, setting out the law in a way which has not been challenged in this Appeal, and proceeding to consider the various matters relevant to her Decision. I will not set out all the elements of her reasoning, but the thrust of it can been seen from paragraph 76 which is said in the context of the allegation of 'indirect confusion' but I think was the underlying basis of all her decisions to reject the Opposition under s5(2) and s5(3):

Although the earlier mark is highly distinctive in its sector (footwear), the name CLARK is so common as a name that outside of the opponent's immediate area of interest it is far more likely that it will be seen as a coincidence that two entities incorporate the same name, rather than it being a variant used by the opponent. Given the presentation of the contested mark as a sporting badge against the word-only CLARKS and the medium degree of similarity between the goods, that is enough, even bearing in mind the highly distinctive nature of the earlier mark for footwear, for the consumer not to be confused: it is simply (a) someone else called CLARK using the mark or (b) about someone else called CLARK, not the opponent.

The Appeal

13. On behalf of the Appellant, Mr Tritton alleges that the Hearing Officer's decision is undermined by a series of errors of principle which I shall take in turn.

(1) Misapprehending the significance of the various components of the conteseted mark

14. Mr Tritton contended that the Hearing Officer had erred in failing to recognise that the word CLARK 'dominated' the contested mark. In this respect he cited the decision of the General Court in Case T-353/20 AC Milan v EUIPO and in particular the comments on the response of the average consumer to the badge of the AC Milan football club

In particular, Mr Tritton quoted the following passage

[83] First of all, it should be borne in mind that, in accordance with the case-law referred to in paragraph 55 above, where a trade mark is composed of word and figurative elements, the former are, in principle, more distinctive than the latter, since the average consumer will more easily refer to the goods at issue by citing the name of the trade mark than by describing its figurative element.

[84] In the first place, as regards the dominant elements of the sign which constitutes the mark applied for, it must be considered, as did the Board of Appeal, that the figurative element will not be overlooked by the relevant public, in particular in view of its size and position, and therefore that it is not negligible in the overall impression produced by that sign. Although the figurative element does not go unnoticed, the attention of the relevant public will not be focused on that element. The attention of the relevant public will be drawn to the word element consisting of the letters 'ac' and the word 'milan', because they are reproduced in capital letters and in a stylised font, and the element which they form is considerably longer than the figurative element. According to the case-law, when the word element of a trade mark is substantially longer than the figurative element of that mark, it attracts the attention of the average consumer more by virtue of its greater size (see judgment of 8 July 2020, Scorify v EUIPO (SCORIFY), T-328/19, not published, EU:T:2020:311, paragraph 60 and the case-law cited).

15. The Hearing Officer dealt with the overall impression of the contested mark in the present case in the following passage of her Decision:

60. The contested mark is figurative and comprises the word CLARK, a shield-shaped device (half of which is solid green and the other half green and white stripes), a silhouette device of a person (seemingly running or kicking) and, surrounding these elements, a thin, green outline of a shield. The word CLARK is presented in a green, bold font. I disagree with the opponent that the figurative elements have no trade mark value and should be disregarded. The green, shield-shaped device, the silhouette and the word CLARK all play a fairly equal role in the overall impression of the mark, with neither element dominating. The shield outline surrounds and brings together the other elements, but given its decorative nature and peripheral position, plays a lesser role in the overall impression.

16. I can see nothing in her analysis which is objectionable in law, nor indeed anything inconsistent with the approach in AC Milan. The mark must be considered as a whole, and (unlike the mark in AC Milan) it is an integrated device, with the word CLARK incorporated into the badge, using the same colours as the badge, and even partially obscured by the running/kicking silhouette figure. The graphic elements are much larger than the verbal element. I agree that the two visual elements and one verbal element identified by the Hearing Officer play a fairly equal role in the overall impression of the mark with no element dominating.

17. I do not believe there is any real value in challenging a decision about whether particular elements of a mark are dominant or negligible by reference to other decisions about different marks. In the AC Milan case cited above, it may be noted that the graphic element and the word elements were entirely separate. Furthermore, the General Court placed considerable emphasis on the fact the word was 'longer' than the graphic element and therefore would attract attention. There is clearly no general rule that a verbal element in a mark which is a combination of verbal and graphic elements should always be treated as 'dominant'. It all depends on the way the different elements are arranged. This is illustrated by the fact that in another (earlier) AC Milan case T-28/18, the General Court considered the following mark

and concluded that the OHIM Board of Appeal had been correct to find the graphic element as being visually dominant, with the word element MILAN merely being 'not

negligible'. In the later AC Milan case, the General Court did not consider that there was anything inconsistent between the two findings.

(2) Failing to consider the significance of the figurative elements in the context of 'sporting' footwear, clothing and headgear

18. The argument seemed to be that because the silhouette figure appears to be running or (as Mr Tritton contended) is about to kick an invisible ball, and the badge is of the kind one might expect of a sporting team, those elements of the mark are of less trade mark significance in relation to 'sporting clothing and headgear' and thus play a more subordinate role in the mark in relation to this notional sub-category of goods covered by the mark.

19. The argument proceeds that the earlier marks are registered for 'footwear' and thus would cover specifically sports footwear, in particular football boots. If the contested mark were used in respect of football shirts, the sporting elements would be discounted by the average consumer and there would be more likelihood of confusion.

20. I do not consider that this is a point of any real substance. There is a sleight of hand in this argument. It will be recalled that the Hearing Officer attributed a high reputation to the Clarks shoe business in the UK and therefore gave it a high degree of distinctive character in relation to footwear. However, there was no inquiry at a more granular level. In particular no reputation for football boots or other sporting footwear was established and Mr Tritton accepted there was no evidence of football boot sales. If the case had been run on the basis of a specific risk of confusion between the contested mark used on sports clothing and the earlier mark used on football boots, it would thus not have been legitimate to proceed on the basis that the earlier mark has a high level of distinctive character. This would almost certainly have cancelled out any assistance Mr Tritton could claim from the diminution in the impact of the device element of the contested mark.

(3) Failing properly to compare the marks conceptually

21. The Hearing Officer found a medium level of conceptual similarity between the marks. Obviously both relate to some person or persons called CLARK. But, she found, the graphic elements in the contested mark give rise to another concept:

> *The figurative elements in the contested mark create a conceptual difference; the shield shape and the silhouette of a person running or kicking bring to mind something that is sport- or football-related: it looks similar to a badge you would see on a football kit, for example.*

22. Mr Tritton complained that it was illegitimate to refer to this as a conceptual difference because there was no figurative element in the earlier mark. Thus, he said, the figurative elements in the contested mark should be considered 'conceptually neutral'. I do not understand this. If one mark give rise to a particular concept in the mind of the consumer but the other mark does not, this is a plainly a point of distinction between them.

23. He also complained that the concept of the graphic elements of the contested mark was highly descriptive for a sub-category of goods. This is essentially the same point I dealt with above in relation to point (2).

(4) Failing to assess likelihood of confusion properly

24. Mr Tritton contended that the Hearing Officer was wrong to consider that the figurative elements in the contested mark were enough to avoid confusion. This seemed to be premised on the points I have rejected above, in particular placing too much reliance on the figurative elements of the contested mark and failing to consider the marks in relation to the specific sub-categories of sporting clothing and football boots respectively.

25. I consider that the Hearing Officer applied herself entirely properly to the question of likelihood of confusion, bearing in mind the fact that the goods were not the

same, that the word 'Clark' is one which the public would expect to see different traders using for different goods, and the difference in the overall concept of the marks.

(5) Error in relation to 'indirect confusion'

26. Finally Mr Tritton attacked the Hearing Officer's reliance on the fact that Clark was a very common surname in her reasoning that the public would not assume that goods under the contested mark were from the same source as the earlier mark. He said this was 'muddled thinking' because Clarks was a well-known brand of footwear. I can see no reason to think that the Hearing Officer did not have this well in mind. I agree that the public would be less surprised at the idea of Clarks moving into the field of clothing than (say) the field of agricultural machinery. But this was not the point. The point was that Clark is such a common name that the public, when they see it being used as a trade mark, have no reason to assume that it is being used by the Opponent save in the field in which the Opponent has a reputation.

27. He also complained that the Hearing Officer was wrong to place significance on the figurative elements of the contested mark on the question of indirect confusion because a sporting badge is precisely what you would expect Clarks to incorporate in a sub-brand for (sports) clothing. Again, I do not think this is a valid point. For this purpose we are assuming an average consumer familiar with Clarks shoes coming across the contested mark and thinking 'is this just someone called Clark making clothing, or is it something to do with Clarks shoes?' The incorporation of the name Clark into a distinctive figurative mark which the consumer has never seen before and does not associate with Clarks shoes is plainly a factor which tends to suggest that the mark is independent.

(6) Error in relation to s5(3)

28. Mr Tritton finally alleged that the Hearing Officer had erred in finding that the public would not make a link between the contested mark and the earlier marks. He said

she wrongly concentrated on the differences between the marks rather than the similarities, but I do not see anything wrong in her analysis. She did consider the similarities as lying in the word Clark which she found would be seen by the public as a common name. He also said that her finding of no link was contrary to her earlier finding in [63] when dealing with the s5(2) case that there was a 'conceptual link' between Clark and Clarks. With respect to Mr Tritton, this is a bad point. The word 'link' in [63] is being used to indicate the objective conceptual similarity between the contested mark and the earlier marks. This is a completely different question from whether the average consumer would make a link between the marks (in the sense of the earlier mark being 'brought to mind' by the contested mark) when they were used in the course of trade. That is a global question which takes into account (for example) the fact that they are being used in relation to different goods.

Conclusion

29. I have rejected the various grounds of appeal. I uphold the Hearing Officer's decision and the contested mark should proceed to grant for *clothing, headgear*.

IAIN PURVIS KC
THE APPOINTED PERSON

4 November 2022