

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2117094
BY NICOLETTE ANN CARTER TO REGISTER
A MARK IN CLASSES 25 AND 28**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
No 47231 BY SARA LEE INTERNATIONAL BV**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2117094
by Nicolette Ann Carter to register a mark in
Classes 25 and 28**

and

**IN THE MATTER OF Opposition thereto under
No 47231 by Sara Lee International BV**

DECISION

On 29 November 1996 Nicolette Ann Carter applied to register the following mark:



for specifications of goods which read:

Class 25 - Clothing, footwear, headgear.

Class 28 - Fishing tackle.

The application is numbered 2117094.

On 22 July 1997 Sara Lee International BV filed notice of opposition to this application. In summary the grounds are as follows:-

- (i) under Sections 3(1)(a)(b)(c) and (d) in that the mark applied for lacks distinctiveness in relation to underwear, "Nix" being the phonetic equivalent of "knicks" denoting knickers.
- (ii) under Section 3(3) in that, arising from the above, the mark is of such a nature as to deceive the public.
- (iii) under Section 3(4) in that the mark would be misleading if used on goods other than knickers and would, therefore, offend against the Trade Descriptions Act.

(iv) under Section 3(6) in that the nature and scope of the applicants' business is such that it does not and cannot justify the use or intention to use in relation to all the goods applied for.

5 (v) under Section 5(2) in that the mark is similar to a number of earlier trade marks (see Annex A for details) and is to be registered for identical or similar goods and there exists a likelihood of confusion.

10 The applicants filed a counterstatement denying the above grounds. Both sides ask for an award of costs in their favour.

Only the opponents filed evidence in these proceedings. Neither side has requested a hearing. Acting on behalf of the Registrar and after a careful study of the papers I give this decision.

15 Opponents' evidence

The opponents filed a statutory declaration dated 6 January 1998 by David George Minto, their professional representative in trade mark matters.

20 He reiterates the position outlined in (i) of my summary of the statement of grounds. He supports the view thus expressed as follows:-

25 "..... the trademark applied for lacks distinctiveness in relation to goods such as underwear, since it will be understood to describe and denote knickers and similar articles of underwear, in view of the long-established and common usage of "knicks" (and phonetic equivalents of "knicks") to identify this type of product. There is now produced and shown to me marked "Exhibit DGM.1" a photocopy of the entry in 'A Dictionary of Slang and Unconventional English' (Eric Partridge: 4th edition, revised 1951, reprinted 1956) indicates that "knicks" means 'womens drawers' and is an
30 abbreviation for 'knickers' (which is itself defined as a colloquial abbreviation of 'knickerbockers')."

35 He goes on to comment on the Section 5 position by reference to the similarities between the mark applied for and the words KNICKS and NICKS in Class 25 and considers that the registrations concerned should have been cited against the application at issue. In particular he points out that the KNICKS and device registrations were obtained on the basis of consent from the proprietors of the NICKS marks.

40 That concludes my review of the evidence.

Section 5(2) of the Act reads:-

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

45 (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

- (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,

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

The term earlier trade mark is itself defined in Sections 6(1) and (2). So far as is relevant to the current proceedings these read:-

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“6.-(1) In this Act an “earlier trade mark” means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

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(b)

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(c)

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

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I also have regard to the following passage from *Sabel BV v Puma AG* 1998 RPC 199 in relation to the test to be applied:-

30 “The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case.

The global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The wording of Article 4(1)(b) of the Directive - “... there exists a likelihood of confusion on the part of the public ...” - shows that the perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.

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In that perspective, the more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either *per se* or because of the reputation it enjoys with the public.”

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I note also that in relation to the above passage and the tenth recital to the Directive Mr Hobbs QC, sitting as the Appointed Person in BALMORAL Trade Mark (an appeal against the Registrar's decision in relation to application No 2003949 - unreported at the time of writing) indicated that:-

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“..... an objection to registration under Section 5(2) of the Act should be taken to raise a single composite question: are there similarities (in terms of marks and goods or services) which would combine to create a likelihood of confusion if the “*earlier trade mark*” and the sign subsequently presented for registration were used concurrently in relation to the goods or services for which they are respectively registered and proposed to be registered?”

I bear these comments in mind in my overall assessment of the position.

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The opponents have referred to a number of marks consisting of or containing the word or element NICKS or KNICKS which in their view should constitute a barrier to the application in suit. So far as the Class 25 goods are concerned it is impossible to draw any distinction between the goods as they are clearly identical. I do not think I need consider each of the registrations in turn. No 1216764 for the word NICKS is closest to the mark applied for and has a broad specification of goods. If the opponents do not succeed on the basis of this registration they are unlikely to be in a stronger position in relation to the other registrations referred to in their statement of grounds. Visually I find that the marks create somewhat different impressions not least because they are both relatively short words where minor differences can sometimes have a marked impact on the overall perception of the marks. Against this I bear in mind that a -CKS ending is sometimes replaced with -X in casual usage. Phonetically I regard the marks as being indistinguishable and there must be a real danger of confusion arising from oral recommendations or requests. Conceptually it seems to me that NICKS, if it signifies anything might be seen as the shortened (and possessive) form of the name Nicholas or Nicola. NIX can have a meaning of its own denoting ‘no’ or ‘nothing’ but as these are, I think, American usages I cannot be certain that any such distinguishing meaning will be apparent to customers in this country. The applicant has not commented on the derivation of her mark but as Nicolette is one of her forenames it seems to me that it may well be a shortened form of her name (bearing my above comments in mind). Taking all these factors into account I consider that there is a likelihood of confusion if the applicant's mark were to be used concurrently with the earlier trade marks. The opposition, therefore, succeeds in relation to the Class 25 goods.

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The applicant has also applied in Class 28 for ‘fishing tackle’ and I must, therefore, consider whether a likelihood of confusion arises in the context of the three Class 28 marks referred to by the opponents. I regard fishing tackle as being contained within the broad term sporting articles. The latter term appears in the specification of No 1534910 which also has an earlier filing date. However 1534910 is shown as being a pending mark and does not, therefore, meet the requirement of Section 6(2). No request has been made to suspend the opposition until the determination of that case so I do not propose to consider it further. No 1442250 also contains the term sporting articles but is qualified by “all relating to the game of basketball”. I do not consider fishing tackle to be in conflict with any items falling within this

specification. No 1230451 covers, inter alia, “bags adapted for carrying ... sporting articles ...”. This would in my view cover bags, holdalls etc adapted for carrying fishing tackle but it cannot reasonably be said to be in conflict with other items of fishing tackle. The opposition, therefore, succeeds to a limited extent in relation to the Class 28 goods. I will consider the overall effects of the Section 5 opposition later in this decision.

In the light of my above findings the application will not be able to proceed in respect of goods in Class 25. It is unnecessary, therefore, to give other than brief consideration to the Section 3 grounds which relate principally to Class 25. The Section reads:-

“3.(1) The following shall not be registered -

- (a) signs which do not satisfy the requirements of section 1(1),
- (b) trade marks which are devoid of any distinctive character,
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

(2) A sign shall not be registered as a trade mark if it consists exclusively of -

- (a) the shape which results from the nature of the goods themselves,
- (b) the shape of goods which is necessary to obtain a technical result, or
- (c) the shape which gives substantial value to the goods.

(3) A trade mark shall not be registered if it is -

- (a) contrary to public policy or to accepted principles of morality, or
- (b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).

(4) A trade mark shall not be registered if or to the extent that its use is prohibited in the United Kingdom by any enactment or rule of law or by any provision of Community law.

(5) A trade mark shall not be registered in the cases specified, or referred to, in section 4 (specially protected emblems).

(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

The opponents have raised objections based on Section 3(1)(a)(b)(c) and (d), 3(3), 3(4) and 3(6). With the exception of the Section 3(6) objection the grounds are all based on the central contention that “Nix” is phonetically equivalent to “knicks” which in common usage denotes “knickers”. In these circumstances I do not propose to consider the grounds individually as they stand or fall collectively depending on my finding in relation to the underlying proposition.

I have recorded above the opponents’ arguments in support of their case. I note that they have had to draw on a Dictionary of Slang and Unconventional English to support their claim. I do not say that this is in itself fatal to their case but it seems to me to result in a somewhat fanciful approach to the matter. Clearly no such objection was taken in respect of the registrations relied on in other respects by the opponents. The mark at issue before me is at least one further remove from attracting the objection raised. I have speculated above on the possible signification (if any) that the word NIX might convey. Whilst I have not drawn firm conclusions on the point the other possible meanings seem more probable than the one the opponents would have me accept. The opposition, therefore, fails insofar as it is based on this objection.

A somewhat different issue is raised under Section 3(6). The opponents say that “the nature and scope of the applicants’ business is such that it does not and cannot justify either use of or an intention to use the trade mark applied for in relation to all the goods applied for”. The applicant could in my view have done more than simply deny the claim and put the opponents to proof. Equally the opponents do not indicate that they have undertaken any enquiries to support the statement made. On balance the opponents do not succeed on this point but it is perhaps somewhat academic in the light of the outcome of my findings under Section 5.

As grounds for refusal exist only in respect of certain goods the application will be allowed to proceed to registration if, within one month of the end of the appeal period for this decision, the applicant files a Form TM21 amending her specification as follows:-

Class 28 - Fishing tackle but not including bags and any goods similar to bags.

The application will be refused so far as the remainder of the specification is concerned.

If the applicant does not file a TM21 restricting the specification as set out above the application will be refused in its entirety.

The opposition having been partly successful the opponents are entitled to a contribution towards their costs. I order the applicant to pay them the sum of **£535**.

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Dated this 2 day of December 1998

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M REYNOLDS
For the Registrar
the Comptroller-General

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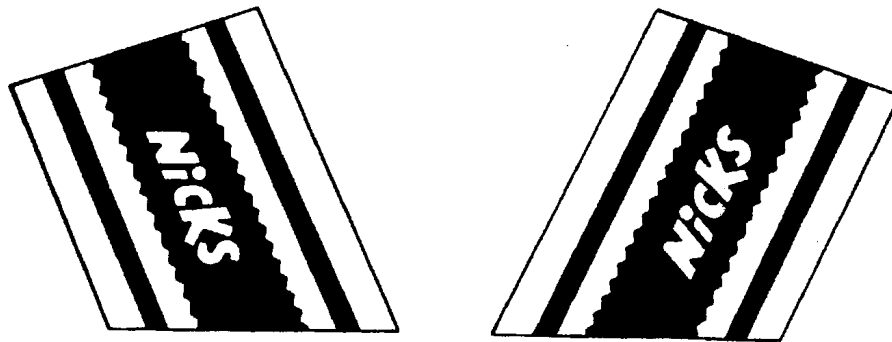
ANNEX A

No	Mark	Class	Journal	Specification	
5	1181603	NICKS	25	5490/2907	Footwear being articles of clothing
10	1216764	NICKS	25	5562/0898	Articles of clothing for men and boys; footwear being articles of clothing
	1234123		25	5638/2425	Articles of outerclothing; footwear being articles of clothing

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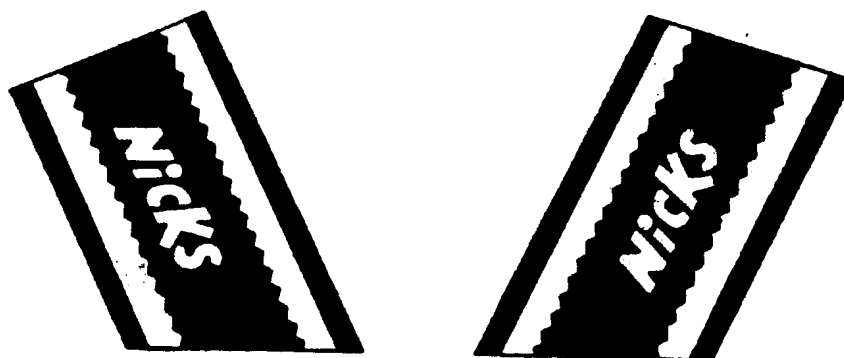
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	1234125		25	5638/2425	Articles of outerclothing, footwear being articles of clothing
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1457784

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5966/1621 Articles of outer clothing;
footwear; all included in Class 25

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1534909

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6137/10056 Clothing, footwear and headgear;
and parts and fittings for all the
aforesaid goods; all included in
Class 25

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1230451

NICKS

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5597/3272 Bags adapted for carrying
gymnastic or sporting articles and
parts and fittings therefor
included in Class 28

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1442250

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6057/8368 Games and articles for playing
cards; playthings; gymnastic and
sporting articles; all relating to the
game of basketball; all included in
Class 28; but not including bags
or goods of the same description
as bags and not including card
games

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Computer games and video games, and cartridges, discs, machines, tapes therefor, and other games; playthings; gymnastic and sporting articles; ornaments and decorations for Christmas trees; parts and fittings for all the aforesaid goods; all included in Class 28.

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