

TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION No 2115595  
BY FLOG INDUSTRIES LIMITED  
TO REGISTER THE MARK  
**FLOG** (stylised word)  
IN CLASSES 25 & 28

AND IN THE MATTER OF OPPOSITION THERETO  
BY H & M HENNES & MAURITZ AB

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5 TO REGISTER A TRADE MARK IN CLASSES 25 & 28

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10 **DECISION**

**BACKGROUND**

15 On 13 November 1996, David Palmer of 48 Beaumont Rd, London, W4 5AP applied under the Trade Marks Act 1994 for registration of the trade mark **FLOG** in respect of the following goods in Class 25:

20 “Golf clothes, shirts, sweatshirts, T-shirts, jackets, pants, trousers, shorts, socks, shoes, vests, hats and caps.”

And in Class 28:

“Golf clubs, bags, tees and balls.”

25 On the 10 February 1997 the mark was assigned to Flog Industries Ltd, 11a Church St., Hemel Hempstead, Hertfordshire, HP2 5AD. For ease of reference the mark is reproduced here:



35 On the 2 July 1997 H & M Hennes & Mauritz AB filed notice of opposition to the application. The grounds of opposition are in summary:

40 i) that the opponents are the registered proprietors of the trade mark L.O.G.G. logo, number 2008705, dated 23 January 1995, for goods in classes 14, 18 & 25 (full details given at Annex A). The mark is reproduced here for ease of reference:



ii) At the time of filing the applicants had no bona fide intention of using the mark and so the application offends against Section 3(6) and 32(3) of the Trade Marks Act 1994.

5           iii) The applicants' mark is similar to the opponents' registered mark and is for identical goods. It therefore contravenes Section 5(2)(b)

10           iv) The applicants' mark is similar to the opponents' trade mark and is to be registered for goods which are not similar, and therefore offends against Section 5(3)

15           v) The opponents' mark is entitled to protection under the Paris Convention as a well-known trade mark. The opponents' mark therefore constitutes an earlier trade mark and the applicants should be refused under Section 5(4) of the Trade Marks Act 1994.

20           The applicants subsequently filed a counterstatement denying all of the grounds of opposition, other than agreeing that the opponents are the registered proprietors of the trade mark as claimed. Both sides ask for an award of costs. Neither party wished to be heard in the matter. My decision will therefore be based on the pleadings and the evidence filed.

#### OPPONENTS' EVIDENCE

25           This takes the form of a statutory declaration by Mr Hakan Bjorkstedt, dated 22 January 1998, who is the legal adviser to H & M Hennes & Mauritz AB, the opponents in these proceedings.

30           In the declaration Mr Bjorkstedt claims that the opponents are "the proprietors of registration No 1557228 L.O.G.G. (Stylised) and Application No 2008705 L.O.G.G. logo (hereinafter referred to as the said trade marks) which has now proceeded to registration."

35           He states that the opponents, together with its subsidiary, (H & M Hennes Ltd), sell clothing and accessories in the UK under various different brands. Regarding the "said trade marks", Mr Bjorkstedt claims that although they are registered for a wide range of goods, to date they have only been used in relation to blouses, jackets, trousers, tops, shirts and outdoor jackets. He also claims that the opponents have built up goodwill under these marks since sales commenced in January 1996.

40           The sales in the said marks are stated to be approx. £4,700,000 in the period January 1996 - 12 June 1997. It is claimed that the goods are sold throughout England, and examples of the use of the trade marks on labels and tags attached to garments are at exhibit HB1. These show use of the mark L.O.G.G. solus and also with the words "Label Of Graded Goods" underneath as illustrated in the pleadings above. The words being picked out in "sand beige" on a "deep red" background, and also with the colours reversed. Additionally, in one instance on a swing tag the words "stretch" and "L.O.G.G." are printed in black on a white background.

45           Finally, Mr Bjorkstedt claims that both the opponents' and applicants' registrations show the marks as printed in white on a black background. He also claims that "the words' LOGG and

FLOG are certainly phonetically similar and could easily be confused by the public. Such confusion would be increased through 'imperfect recollection'." It is Mr Bjorkstedt's opinion that the opponents' trade marks have no significance in the trade other than to denote the goods of the opponents.

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#### APPLICANTS' EVIDENCE

This consists of a statutory declaration by Mr Christopher Boreham, dated 13 May 1998, who is a director of Flog Industries Ltd, a position he has held since 1996.

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Mr Boreham states that the applicants have been using their mark "since November 1996", selling their goods throughout England. He states that turnover has been variable and provides an estimate for 1998 of £100,000. Mr Boreham claims that despite the coexistence of the two marks in the marketplace for eighteen months he is not aware of any confusion, and assumes that similarly the opponents are unaware of any such instances as they do not make any reference to instances of confusion in their evidence.

15

He also claims that the opponents' statement that they have registered application No 1557228 is incorrect as the application is shown on the Trade Marks Registry Optics system as having been withdrawn by the opponents.

20

Regarding the opponents' comments on the similarity of the two marks, Mr Boreham comments that they are dissimilar for the following reasons:

25

"The applicants' logo begins with an inverted F whereas the opponents' trade mark begins with the letter L. The opponents' trade mark also ends with a double GG and is punctuated with full stops. In addition it includes an explanation as to the meaning of the acronym L.O.G.G., ie. 'Label Of Graded Goods'. The argument that the consumers would be confused between these two marks is non- sensical."

30

That concludes my review of the evidence. I now turn to the decision.

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#### DECISION

I first consider the ground of opposition under Section 3(6) which is as follows:

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

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In my view the opponents have offered no evidence to support this pleading, therefore I do not consider this ground proven.

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Next, I turn to the ground of opposition under Section 5(2)(b) which is as follows:

*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 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.”

I have to determine whether the marks are so similar that there exists a likelihood of confusion on the part of the relevant public. In deciding whether the two marks are similar I rely on the decision of the Court of Justice of the European Communities (ECJ) in the Sabel v Puma case C251/ 95 - ETMR [1998] 1-84. In that case the court stated that:

“Article 4(1)(b) of the directive does not apply where there is no likelihood of confusion on the part of the public. In that respect, it is clear from the tenth recital in the preamble to the Directive that the appreciation of the likelihood of confusion ‘depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified’. The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case.

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 the 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.

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.”

I also have regard to the approach adopted by the European Court of Justice in Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc. (case C-39/97) (ETMR 1999 P.1) which also dealt with the interpretation of Article 4(1)(b) of the Directive. The Court in considering the relationship between the nature of the trade mark and the similarity of the goods stated:

“A global assessment of the likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between these goods or services. Accordingly, a lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the marks, and

5 *vice versa. The interdependence of these factors is expressly mentioned in the tenth recital of the preamble to the directive, which states that it is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion, the appreciation of which depends, in particular, on the recognition of the trade mark on the market and the degree of similarity between the mark and the sign and between the goods or services identified.*"

10 The opponents' registration for Class 25, "Articles of clothing", clearly encompasses the applicants' goods in the same class. I also regard the opponents' goods in Class 18 "bags (game)" to be similar to the applicants' goods in Class 28 "Golf bags". The applicants remaining goods in Class 28 (Golf clubs, tees and balls) are clearly not similar to any goods for which the opponents' mark is registered. It is my opinion that the remaining goods in Class 28 (golf clubs, tees and balls) are so far removed from those of the opponents that even if the two trade marks were identical (which they are not) that they do not form an obstacle under the provision of  
15 Section 5(2).

I turn therefore to consider whether taking into account the fact that the goods covered by the application are the same or similar to the goods of the opponents, the trade marks themselves are similar.  
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25 Visually the two marks have common elements in that they both contain the letters' LOG and both have four letters. However, the applicants' mark begins with the letter F albeit printed backwards, followed by the letters LOG, whereas the opponents' mark starts with the letters LOG and has an additional G on the end. The marks are further differentiated by the punctuation between the letters of the opponents' mark indicating that it is an acronym not a normal word. This is emphasised by the provision of the meaning underneath. They therefore convey a different image.

30 Assuming that the opponents' mark is seen as a word, then phonetically, apart from the sound of the F in the applicants' mark, the marks are identical. However, in such short words differences assume greater significance, particularly when at the beginning of the mark. It is accepted that the public attributes greater importance to the beginning of a word in identifying a sign than it does to the following components of the word Even allowing for imperfect recollection it is my view that the marks are unlikely to be confused aurally. If, as seems more likely, the opponents' mark is pronounced as four distinct letters then the two mark are not confusable.  
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The applicants' mark FLOG has a meaning as it is a well known slang term meaning to sell. The opponents' mark it seems to me seeks to impart a sense of quality, almost implying that it conveys official sanction to the product. Conceptually the marks convey different images.  
40

45 The opponents have provided evidence that they had sold certain clothing articles (blouses, jackets, trousers, tops, shirts and outdoor jackets) under the mark prior to the material date, 13 November 1996. The opponents have provided sales figures relating to the period January 1996 - June 1997 showing sales of £4.7 million. Although this period extends beyond the material date, it is reasonable to conclude that a significant proportion of the sales would have occurred prior to 13 November 1996. The sales figures in the context of the clothing industry are not vast but cannot be regarded as *de minimis*.

By comparison the applicants have sold relatively few items. Even accepting the estimate for 1998 of £100,000 turnover in the mark (no split is offered between classes 25 & 28), this is minuscule in terms of the clothing market. Therefore the absence of evidence of confusion cannot be taken as indicative that confusion would not occur.

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The opponents' best case is for items of clothing in Class 25. The goods are identical. However, considering the overall impression of the marks it is clear that the differences, visual, aural and conceptual are sufficient to ensure that there is no likelihood of confusion. The opposition under Section 5(2) fails.

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I next turn to the ground of opposition under Section 5(3) which is as follows:

*5 (3) A trade mark which -*

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*(a) is identical with or similar to an earlier trade mark, and*

*(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,*

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*shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.*

25

I have already decided that the marks are not similar when considering Section 5(2). Therefore the opposition under Section 5(3) fails.

Finally, I turn to the ground of opposition under Section 5(4) which states:

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*“5. (4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -*

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*(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or*

*(b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.*

40

*A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”*

45

In deciding whether the mark in question “FLOG” offends against this section, I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the WILD CHILD case (1998 14 RPC 455). In that decision Mr Hobbs stated that:

5            “The question raised by the Grounds of Opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the Applicant from those of other undertakings (see Section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Art.4(4)(b) of the Directive and Section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the Applicant in accordance with the law of passing off.

10            A helpful summary of the elements of an action for passing off can be found in Halsbury’s Laws of England 4th Edition Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in Reckitt & Colman Products Ltd - v - Borden Inc [1990] RPC 341 and Even Warnik BV - v - J. Townend & Sons (Hull) Ltd [1979] AC 731 is ( with footnotes omitted) as follows:

15            ‘The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

20            (2) that there is a misrepresentation by the defendant ( whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

25            (3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

30            Whilst I have accepted that, at the relevant date, the opponents’ may have had some goodwill / reputation in the market, the opponents have failed to show that there has been a misrepresentation by the applicants or that they would be likely to suffer any damage. Under Section 5(2) I have already found that there is no likelihood of confusion between the marks, even for identical goods. I therefore find that the opposition under this section fails.

The opposition having failed the applicants are entitled to a contribution towards their costs. I order the opponents to pay them the sum of £435

35            Dated this 3 day of March 1999

40            George W Salthouse  
For the Registrar  
The Comptroller General



## Annex A

### Class 14

Alarm clocks, amulets (jewellery), anchors (clock and watch-making), ashtrays of precious metal for smokers, barrels (clock and watch-making), baskets of precious metal, for household purposes, boxes of precious metal, boxes of precious metal for sweetmeats, cabarets (trays) of precious metal, candelabra (candlesticks) of precious metal, candle extinguishers of precious metal, candle rings of [precious metal, candlesticks of precious metal, cases (cigar) of precious metal, cases (cigarette) of precious, cases (needle) of precious metal, cases for clock and watch-making, cases for watches (presentation), chain mesh purses of precious metal, chains (watch), chronographs (watches), chronometers, chronometrical instruments, chronoscopes, cigar boxes of precious metal, cigar cases of precious metal, cigar holders of precious metal, cigarette cases of precious metal, cigarette holders of precious metal, clock cases, clock hands (clock and watch-making), clocks, clocks and watches, electric, clockworks, coffee services of precious metal, containers (household) of precious metal, containers (kitchen) of precious metal, cruet stands of precious metal, of oil and vinegar, cruets of precious metal, cuff links, cups of precious metal, dials (clock and watch-making), dials (sun), dishes of precious metal, earrings, epergnes of precious metal, flasks of precious metal, goblets of precious metal, gold (objects of imitation), household utensils of precious metal, ivory (jewellery), jewel cases of precious metal, key rings (trinkets and fobs), kitchen containers of precious metal, kitchen utensils of precious metal, links (cuff), movements for clocks and watches, napkin holders of precious metal, napkin rings of precious metal, necklaces (jewellery), nutcrackers of precious metal, ornamental pins, paste jewellery (costume jewellery), pearls made of ambroid (pressed amber), pins (ornamental), plated articles (precious metal plating), purses of precious metal, salad bowls of precious metals, salt cellars of precious metal, salt shakers of precious metal, saucers of precious metal, silver plate (plates, dishes), snuff boxes of precious metal, soup bowls of precious metal, statues of precious metal, straps for wrist watches, sugar bowls of precious metal, tankards of precious metal, tea caddies of precious metal, teapots of precious metal, tie clips, tie pins, tobacco jars of precious metal, tokens (copper), toothpick holders of precious metal, trays of precious metal for household purposes, trinkets (jewellery), watch bands, watch cases, watch chains, watch crystals, watch glasses, watch springs, watch straps, watches, works of art of precious metal.

### Class 18:

Animal skins, attache cases, bags (game), bags (garment) for travel, bags (net) for shopping, bags for climbers, bags (envelopes, pouches) of leather for packaging, bandoliers, beach bags, boxes of leather (hat), boxes of leather or leatherboard, boxes of vulcanised fibre, briefcases, canes, card cases (note-cases), cases of leather or leatherboard, cattle skins, chain mesh purses, not of precious metal, collars for animals, covers (umbrella), dog collars, handbags, handles (suitcases), hat boxes of leather, haversacks, key cases (leatherware), leather leashes, leather thongs, muzzles, parasols, pocket wallets, purses, satchels (school), school bags, shoes (linings of leather for), sling bags for carrying infants, tool bags of leather (empty) travelling bags, travelling trunks, (luggage), umbrella handles, umbrella or parasol ribs, umbrella rings, umbrella sticks, umbrellas, valises, vanity cases (not fitted), walking-sticks, wallets (pocket).

### Class 25:

Articles of clothing.