

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 2149974
BY M J L HOLDINGS LIMITED**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No 48540
BY KICKERS INTERNATIONAL B.V.**

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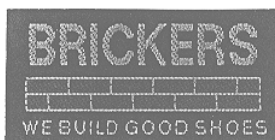
**IN THE MATTER OF Opposition thereto under No 48540
by Kickers International B.V.**

BACKGROUND

1. On 4 November 1997 M J L Holdings Limited applied under the Trade Marks Act 1994 to register the trade mark shown below for a specification of goods which reads:

Class 25

Footwear.



The application is numbered 2149974.

2. The application was accepted and published and on 11 May 1998 Kickers International B.V. filed notice of opposition to the application. The grounds of opposition as set out in the accompanying statement of grounds ran to some thirteen paragraphs, however, shortly before the hearing on 19 January 2001, the opponents filed a letter indicating that they wished to withdraw several of the grounds of opposition. In an Official letter dated 24 January 2001 it was indicated that the withdrawal of various paragraphs would be allowed. Therefore, the grounds of opposition as at the date of the hearing can be summarised as follows;

- (i) under section 5(2)(b) in that the opponents are the registered proprietors of the following trade mark registrations; numbers 2152413, 1073957, 1067562, 1054447, and 2160101, all in Class 25.
- (ii) under section 5(4)(a) in that the trade mark KICKERS has been used extensively in the United Kingdom and the opponents have built up a substantial goodwill and reputation in connection with the KICKERS trade mark.

3. The applicants filed a counterstatement denying the grounds of opposition. Both sides seek an award of costs.

4. The matter came to be heard on 30 January 2001. The applicants were represented by Mr William Tennant of Jordans Limited. The opponents were represented by Mr Michael Edenborough, instructed by Haseltine Lake.

Opponents' Evidence

5. The opponents' evidence consists of two statutory declarations by James Clifford Setchell, an affiliated member of the Institute of Trade Mark Attorneys and employed at Haseltine Lake Trademarks, the opponents' representatives in this matter.

6. Mr Setchell's first statutory declaration is dated 23 February 1999 and at Exhibit JCS1 he exhibits a copy of data taken from the OPTICS database of the Trade Marks Registry on the 22 February 1999 showing details of the opponents' earlier trade marks.

7. Mr Setchell's second statutory declaration is dated 14 July 1999. In this he states that he instructed a firm of investigators to ascertain whether or not the trade mark the subject of the application was in use by the applicant. He says investigations showed that the trade mark was in use in respect of a range of boots and shoes and their investigators made a test purchase of a pair of children's shoes size 11. At JCS1 he exhibits photographs of different views of the right-hand shoe of the pair referred to above and a left-hand shoe of a pair of KICKERS shoes of the type sold in the United Kingdom by the opponents' licensee. He notes that both shoes are sized 11. The exhibit shows various views of both shoes: a front top view, a top side view, an inside view, and an outside view.

Applicants' Evidence

8. The applicants' evidence consists of a single statutory declaration by Mr Michael John Luff, the Managing Director of MJL Holdings Limited, the applicants in this matter. The statutory declaration is dated 8 October 1999.

9. Mr Luff states that he has been Managing Director of his company for fifteen years and that he is well acquainted with all aspects of his company's business. Mr Luff states that he has read the statement of grounds filed by the Trade Mark Attorneys acting on behalf of Kickers International B.V. and the statutory declarations filed by Mr James Setchell.

10. Mr Luff explains that his company devised the trade mark BRICKERS WE BUILD GOOD SHOES together with a brick wall device, hereinafter referred to as the trade mark, to denote shoes of good quality and durability with the obvious analogy to the strength of bricks in mind. He says that every single pair of BRICKERS shoes which have been made since the original production have all had the same logo printed on the in-sock label and it is his company's intention that this will continue in the future. At MJL 1 he exhibits a copy of the in-sock label which shows the trade mark the subject of the application. Mr Luff goes on to make various comments regarding a comparison of the respective trade marks but I need not summarise these.

11. Mr Luff states that over ½ million pairs of shoes bearing the trade mark have been sold in the United Kingdom and that sales have been made in all major and minor towns and cities in

the United Kingdom. He gives turnover figures for the years 1997-1999 as follows:

1997 £1.5 million
1998 £5 million (approximate)
1999 £7 million (estimate)

12. Mr Luff states that the mark has been advertised at every major/minor shoe exhibition in the United Kingdom plus the GDS Show in Dusseldorf, Germany which he says is the premier footwear show in the world. He says that the trade mark is intended to denote the production and marketing of quality leather footwear including fashion shoes and also steel toe-capped protective footwear for work use. Mr Luff states that his company's marketing strategy has been to act as an importer using the largest UK wholesalers to distribute the shoes to smaller retailers throughout the United Kingdom. He goes on to say that this is not the method used by KICKERS as their market is aimed more at the branded sports shop than to individual shoe shops. At MJL2 he exhibits six shoe catalogues in the name of Kidderminster Footwear, Patrick's Shoes and L J and R Footwear. Mr Luff states that these are three of the biggest wholesalers in the United Kingdom and none of them supply or do business with Kickers International B.V., for wholesale distribution. Mr Luff states that examples of his BRICKERS range of footwear are included in the catalogue. I was taken to these catalogues in some detail by Mr Edenborough and I will summarise my findings as part of my decision.

13. Mr Luff states that the wide range of shoes marketed under the BRICKERS trade mark are demonstrated in these catalogues and it is clear that no attempt has been made to imitate the look or image of KICKERS shoes. Mr Luff then refers to the declaration of Mr Setchell dated 14 July 1999. Referring to JCS1, the photographs of the BRICKERS and KICKERS shoes, he notes that the tag on the lace of the KICKERS shoe is in the shape of a flower whereas the BRICKERS tag is in the shape of a B denoting BRICKERS. Mr Luff states that the use of tags is commonplace in the shoe industry and he points to examples in the catalogues referred to at MJL 2. He notes also that there are many other shoe designs which are similar to his own and to KICKERS. Mr Luff states that there are in fact over 150 factories in Portugal which are traditional manufacturers of this type of handmade footwear and supply several other UK or European companies with similar type shoe designs. Mr Luff concludes by stating that they are not comparing tags or shape or design of the shoe in this matter. He says that the opponents' opposition is based solely on the trade mark KICKERS and the evidence filed in support of the opposition does not in his view support the grounds of opposition contained in their statement of grounds.

Opponents' Evidence in reply

14. The opponents filed a further statutory declaration dated 4 April 2000 by Mr Setchell. Mr Setchell's evidence is directed at the comment in Mr Luff's declaration that KICKERS are aimed at the branded sports shop rather than individual retail shoe shops. Mr Setchell states that on 13 March 2000 he made a trip into Bristol city centre where he visited various shoe shops where he saw KICKERS footwear on display. These included, SOLE TRADERS, SAXONE, RAW and DEBENHAMS. Mr Setchell also refers to the Winter 1999/2000 edition of the Littlewoods catalogue where he notes that KICKERS footwear is shown in the section entitled "footwear". Extracts from the catalogue are attached at exhibit JCS1.

Opponents' and Applicants' Evidence under Rule 13(8)

15. The opponents in this matter sought leave to file further evidence in exercise of the Registrar's discretion under rule 13(8) of the Trade Mark Rules 1994 (as amended). The Registrar gave leave for such evidence to be filed and the opponents filed a statutory declaration by Mr Hugh Sweeney, dated 15 September 1999, the Marketing Manager for Airborne Footwear Limited, a position he has held since 1995.

16. Mr Sweeney states that he is responsible for the promotion and marketing of footwear under the trade mark KICKERS in the United Kingdom. He says his company's business is based solely on the manufacture, promotion and sales of goods under the trade mark KICKERS in the UK and that it has been the exclusive licensee for footwear under the trade mark KICKERS since 1990. In 1992 he says his company was appointed as the exclusive licensee for clothing manufactured and sold under the trade mark in the United Kingdom.

17. Mr Sweeney states that the trade mark KICKERS has been in continuous use in the United Kingdom in respect of clothing and footwear since the early 1970s. He says that the approximate annual turnover under the trade mark in relation to footwear and clothing during the period 1990 to 1997 distributed and sold in the United Kingdom is as follows:

<u>Year</u>	<u>Approximate Turnover £</u>
1990	14,604,000
1991	9,255,000
1992	9,045,000
1993	17,409,000
1994	38,940,000
1995	61,337,000
1996	82,340,000
1997	81,610,000

18. Mr Sweeney states that the promotion and marketing of clothing and footwear under the trade mark in the United Kingdom is organised and paid for by his company. He says his company accounts only provide a global advertising expenditure for the marketing of both clothing and footwear and accessories under the trade mark in the United Kingdom. He therefore gives approximate advertising expenditure on all promotional activities in relation to the trade mark during the period 1993 to 1997 as follows:

<u>Year</u>	<u>Approximate Advertising Expenditure in £</u>
1993	389,500
1994	680,900
1995	957,000
1996	1,705,000
1997	2,460,000

19. At HS 1 he exhibits a copy of a media plan dated 13 December 1995 for the year 1996 from his company's media planning and buying agency Ogilvy and Mather. He also exhibits examples of advertisements which appeared in the national press in 1996 and copies of posters used in out-door advertising sites such as bus shelters and adshells. Mr Sweeney states that the media plan shows the extent of the national advertising campaign for the trade mark during the year 1996. He says the plan shows the number of advertising sites within major towns for 4 or 6 sheet poster advertising and a list of several well-known publications within which advertisements promoting footwear under the trade mark would be published. Mr Sweeney states that his company has also exhibited goods under the trade mark at exhibitions within the United Kingdom since 1990. He gives a list of exhibitions from 1991 through to 1997 these include exhibitions at Earls Court, Olympia, NEC Birmingham, BIC Bournemouth, Blackpool and Arena London. At HS 2 he exhibits a number of photographs from his company's exhibition stands used at the 40 Degrees Exhibition of 1997 held in London.

20. Mr Sweeney states that the trade mark KICKERS is a highly successful brand both for clothing and footwear in the United Kingdom and that the brand KICKERS has won several footwear industry awards over the period 1995 to 1998 as follows:

1995 Supplier of the Year	-	Littlewoods
1996 Most Improved Supplier in Footwear	-	Grattan
1996 Menswear and FHM Footwear Brand of the Year		
1997 Most Improved Supplier in Footwear	-	Grattan
1997 Shoe and Leather News UK Footwear Brand of the Year		
1997 Most Improved Supplier in Footwear	-	Grattan

21. At HS3 Mr Sweeney exhibits extracts taken from a market survey report entitled "Kickers Brand Audit Research: Presentation of Qualitative and Omnibus Findings". He says that this research was commissioned by his company in 1996 and shows the results of a survey of a section of the public carried out between 2 and 5 December 1996 in Glasgow, Manchester and London. He notes that on page 28 of the Report, the diagram indicates that a majority of those interviewed owned a pair of Kickers, Caterpillar, Nike, Reebok or Dolcis shoes. He says the research also shows that there was a high awareness of the current KICKERS advertising in December 1996 amongst those interviewed. Mr Sweeney also draws attention to page 80 of the Report under the title "Brands Would Ever Consider Buying" where he notes that the status of KICKERS shoes against other brands such as Doctor Martin's, Timberland and Caterpillar. He notes that 23% of males and 26% of females interviewed cited KICKERS as a brand of footwear they would consider buying.

22. Mr Sweeney states that throughout the period 1990 to the present, his company has marketed and sold its goods under the trade mark through a number of footwear retailers located throughout the United Kingdom including Scotland, Wales and Northern Ireland including retailers located in various principal towns and cities. Mr Sweeney gives a list of towns and cities which covers the whole breadth of the United Kingdom. Mr Sweeney goes on to state that by virtue of his company's extensive promotion in sales of footwear and clothing under the trade mark during the period 1990 to 1997. He believes that the trade mark has established itself as one of the leading brands in the United Kingdom in respect of clothing and footwear and enjoys a substantial reputation for quality footwear amongst footwear manufacturers, retailers and customers in the United Kingdom.

23. In reply, the applicants filed a single statutory declaration by Mr Michael Luff, dated 22 December 1999. He states that in his view there is nothing in the statutory declaration of Mr Sweeney which supports the contention that the respective trade marks are confusingly similar and no evidence has been filed to demonstrate that confusion has arisen by the public or the trade or that such confusion is likely. Mr Luff concludes by stating that the opponents have not substantiated any of their grounds of opposition and consequently the opposition should be dismissed.

24. That concludes my review of the evidence.

DECISION

25. As stated above, shortly before the Hearing, the opponents withdrew several of the grounds of opposition. As such the only remaining grounds relate to Section 5(2) and Section 5(4) of the Trade Marks Act 1994. These sections read as follows:

"5.-(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."

"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 -

(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)

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."

26. I will consider first the opponents ground of opposition under Section 5(2)(b). I was referred to and take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schufabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723. 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* page 224;

(b) the matter must be judged through the eyes of the average consumer of the

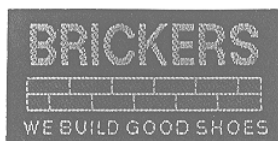
goods/services in question; *Sabel BV v. Puma AG* page 224, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schufabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* page 84, paragraph 27.

- (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* page 224;
- (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* page 224;
- (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* page 7, paragraph 17;
- (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* page 8, paragraph 24;
- (g) 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* page 224;
- (h) 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* page 732, paragraph 41;
- (i) 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* page 9 paragraph 29.

27. Under section 5(2), the opponents sought to rely on two of their trade marks, registration numbers 1054447 and 1073957. Both are earlier trade marks within the definition of section 6 of the Trade Marks Act 1994 and both cover boots and shoes. As such I do not think that it is material which of their two trade marks I consider. The specification on 1054447 is perhaps the broader of the two so I shall consider the opposition under section 5(2) in relation to that trade mark. It was common ground between the parties that the goods covered in the application were identical or very similar to those covered by the opponents' earlier registrations. Therefore, the matter falls to be determined on a comparison of the trade marks. This is a global test as set out above, taking into account the fact that a lesser degree of similarity between the trade marks may be offset by a greater degree of similarity (or identity) between the goods.

28. For ease of reference I reproduce the applicants' and the opponents' trade marks below:

Applicants' trade mark



Opponents' trade mark

KICKERS

Class 25

Footwear

Class 25

Boots, shoes slippers and sandals and parts and fittings included in Class 25 for all the aforesaid goods, but not including any such goods for sports wear.

29. In considering the question under section 5(2), Mr Edenborough invited me to find that the opponents' trade mark had acquired added distinctiveness through the use that had been made of it. In particular, he drew attention to the turnover figures; advertising expenditure; advertising; exhibitions; awards and the survey all referred to in Mr Sweeney's statutory declaration. The turnover figures show an annual turnover in excess of £82 million in 1996, the year prior to the date of the application in suit. The figures for 1994 and 1995 show approximate turnover figures in excess of £38 million and £61 million respectively. Although, as Mr Tennant pointed out, the figures given by Mr Sweeney are for clothing and footwear and no breakdown of the figure for footwear is given.

30. The figures for advertising expenditure are also global figures for both clothing and footwear but again substantial sums are involved. Mr Edenborough took me to exhibit HS1 to Mr Sweeney's declaration and the reference to the number of poster sites used in 1996. The figure shown is 1189 poster sites for the relevant period. He also referred to advertising campaigns in the media and fashion magazines referred to on page 3 of exhibit HS1 showing advertisements in the following magazines; LOADED, THE FACE, SKY, SELECT and FHM all in 1996. Examples of the advertisements are also exhibited at HS1, all these show advertisements for footwear.

31. In paragraph 7 of his statutory declaration, Mr Sweeney refers to various exhibitions at which he says that his company has exhibited goods under the trade mark. The list covers a range of exhibitions over a period of 6-7 years. Some of the exhibitions, for example the British Footwear Exhibition which the opponents attended in 1991-3, presumably relate to footwear, whereas others, for example, Premier Mens could I assume include clothing and footwear. At HS2 the opponents exhibit photographs said to be from the 40 Degrees Exhibition in 1997. The photographs show both footwear and clothing under the trade mark KICKERS.

32. Finally, I mention the survey referred to at paragraph 9 of Mr Sweeney's declaration. Mr Edenborough made only passing reference to the content of the survey exhibited at HS3 and

to the fact that at paragraph 9 Mr Sweeney states that 23% of males and 26% of females state that they would consider buying KICKERS footwear. I think that Mr Edenborough was right not to make too much of the survey. I am given no indication as to the sort of questions that were asked or the manner in which those surveyed were selected. As such, I do not think that I can place too much weight on the results.

33. Although Mr Tennant's criticism of the turnover and advertising figures is well founded, the evidence shows consistent and significant turnover, advertising and appearances at exhibitions throughout a 6-7 year period. The example of advertisements in the evidence and the photographs of the exhibition, show that the trade mark has been used in relation to footwear over a long period of time. I am of the view that taking all these factors together, I am entitled to find that the trade mark KICKERS has a reputation within the United Kingdom in relation to footwear. Therefore, when assessing the likelihood of confusion this is a factor that I should take into account. Mr Tennant made reference to the preface to Kerly's Law of Trade Marks and Trade Names 13th Edition where Mr Justice Jacob questions the assertion made by the ECJ in *Canon* that the more distinctive a trade mark the more likely it is that a similar mark is likely to confuse. Mr Jacob states that the observation is peculiar and that the reverse is true. Mr Pumfrey describes the statement made in *Canon* as a 'very surprising proposition'; *Daimlerchrysler AG v Javid Alavi* (unreported 26 January 2001) at paragraph 80, but he accepts that it is the law.

34. In opposition proceedings, if neither party has made use of their trade mark then under section 5(2), the Hearing Officer must consider notional and fair use of the opponents' trade marks as they appear on the register and the applicants' trade mark as applied for; *Reactor* [2000] R.P.C. at page 288. Here both parties have made use of their respective marks. Mr Edenborough took me through a careful analysis of the applicants' evidence pointing out the way in which the applicants' products are marked and he invited me to take this into account when considering notional and fair use. The applicants' use would in his view be a factor under section 5(2) but would have greater prominence under section 5(4). From an analysis of the applicants' evidence, it seems clear to me that the applicants use the word BRICKERS solus on their products. In addition, they use the trade mark as applied for on their products. In particular, I find that the applicants use the word BRICKERS in a number of ways. It should be noted that each of the examples given does not appear on each shoe. However, the word BRICKERS solus is used:

- as a general descriptor in catalogues; see page 31 of the Kidderminster Autumn 1998 catalogue at MJL2
- on an oval plate on the side of the shoe; catalogue number 576 in the Kidderminster Autumn 1998 catalogue but more clearly visible at exhibit JCS1 to Mr Setchell's second statutory declaration.
- on a tab on the lace; again at exhibit JCS1
- on the eyelets of the shoe; exhibit JCS1
- around the heel of the shoe; page 34 of the Kidderminster Autumn 1998 brochure catalogue number 658.
- on the side of the sole of the shoe; Patrick Shoes Catalogue 1999 at page 6 catalogue number 8224.

35. In addition, the evidence shows that the trade mark the subject of the application is used:

- on the tongue of the shoe embossed in the leather; see exhibit JCS1; and
- as a label on the inside of the shoe; see exhibit JCS1 and also exhibit MJL1

36. Mr Edenborough suggested that the applicants were seeking to mirror the way in which the opponents use their trade mark on their products. In addition, he noted that when the trade mark was applied to the tongue of the shoe, this could be obscured by the lacing. I will refer to this point below. Further, Mr Edenborough referred to page 16 of an undated Kidderminster catalogue. On this page in a square box the word BRICKERS appears to be used with the ® symbol.

37. In response to questions as to the relevance of all these factors, Mr Edenborough suggested that they were all factors that should be considered when reaching my decision. They were all “adding straws. Eventually one straw will break the camel’s back”. Whilst I am prepared to accept that when considering notional and fair use of the trade mark as applied for I should consider the way in which the trade mark has been used by the applicants. That does not in my view take me to the point where I should consider use of the word BRICKERS solus or the various ways in which it is used on the applicants’ products or the fact that the word seems to appear with the ® symbol. The trade mark applied for is as set out above and it is not for the word BRICKERS solus. If the opposition fails and the trade mark is registered, the applicants would have rights under the provisions of section 10 of the Act in respect of the trade mark applied for.

38. In my view the most that I can take away from the evidence is that notional and fair use of the trade mark the subject of the application would include use of the trade mark as applied for in which the word BRICKERS was the dominant element of that mark; in my view use is shown when the trade mark is used on the tongue of the shoe such that the other elements of the mark may be obscured by the lacing, see exhibit JCS1, or the velcro fastening strap on product number MC10, see page 6 of Patrick Shoes’ catalogue 1999.

39. Mr Edenborough also argued that the dominant element of the applicants’ trade mark is the word BRICKERS. The element “WE BUILD GOOD SHOES” was in his view a strap line, an advertising puff and the device element was a small weak motif. Again, I accept the general thrust of his submissions, except that I would say that the device element is a fairly strong element of the mark. In any case, I do not think that it takes me any further than the point stated above where I accept that I should consider BRICKERS to be the dominant element of the mark. However, in so doing, I bear in mind the fact that the applicants’ trade mark must be considered as a whole. Therefore, I proceed to consider the likelihood of confusion on that basis taking into account the fact that I have found that the opponents’ trade mark has a highly distinctive character because of the reputation it enjoys with the public. That said, I note that I must still find a likelihood of confusion, mere association in that the opponents’ trade mark may be called to mind is not sufficient. Equally, the fact that I have found that the opponents’ trade mark has a reputation does not give me grounds for finding that there is a likelihood of confusion simply because there is a likelihood of association.

40. The consumer of the products in question will be ordinary members of the public. In considering the visual, aural and conceptual similarities of the two trade marks I must take into account the fact that the average consumer rarely has chance to make a direct comparison between the two trade marks but instead must rely upon the imperfect picture of them he/she has kept in their mind, so called imperfect recollection.

41. Visually the two marks are very different. The opponents' consists of the word KICKERS and the applicants' of the word BRICKERS with the words WE BUILD GOOD SHOES and the device element of a brick wall. If I consider use in which BRICKERS is the dominant element of the applicants' trade mark then there are clearly greater similarities between the words BRICKERS and KICKERS. Both end with the same six letters ICKERS. Nevertheless, visually the first two letters BR on the applicants' trade mark are distinguishable from the K on the opponents' trade mark. Further, although I am considering BRICKERS to be the dominant element of the mark I must not forget that there are other elements to the trade mark. These elements are not de minimus and the three elements together create an overall visual impression which leads me to the view that the trade marks are visually different and so there is no likelihood of confusion between them.

42. Mr Edenborough suggested that in use, the trade mark on the tongue may be twisted such that only the ICKERS element is visible. That may be so, but in my view the purchase of a shoe is a fairly careful process, it is not a casual purchase. The purchaser will select the shoe and pick it up to inspect it; trying it on for size and fit. If the trade mark on the tongue was twisted in the way that Mr Edenborough suggests, the purchaser would, during the process of selection see the trade mark as a whole; both on the tongue and in the in-sock label. Therefore, whilst not discounting the possibility of hasty confusion brought about by the scenario put forward by Mr Edenborough, I am of the view that such hasty confusion would be dispelled quickly during the process of selecting the product.

43. I now turn to consider the likelihood of aural confusion. Mr Tennant, referring to the decision of Mr Simon Thorley in *Reactor*, suggested that the selection of shoes was primarily by the eye; *Reactor* at page 289. In *Reactor* Mr Thorley was dealing with clothing but I accept that as a general proposition, the same is true of footwear. Therefore, I must in taking into account the likelihood of aural confusion, bear in mind the fact that the primary use of trade marks in the purchasing of footwear is a visual act

44. Aurally the applicants' trade mark will be referred to as BRICKERS and the opponents' trade mark as KICKERS. The applicants accepted that this was the opponents' strongest point. The last six letters of the two words are clearly the same ICKERS. However, it was accepted under the Trade Marks Act 1938 that the beginning of words is more important with the ending of words tending to become slurred; *London Lubricants Limited's Application (TRIPCASTROID)* 42 1925 R.P.C. 264 at page 279. The beginning of the two words are different BRICK and KICK both ordinary words of the English language. Mr Edenborough submitted that they were both hard consonants not sibilant. That is so but KICKERS has a strong double K sound compared to the softer BRIC of the applicants' mark.

45. The opponents did not seek to argue that the marks were conceptually similar. The applicants' trade mark BRICKERS appears to be meaningless in relation to shoes. The other

elements of the mark “WE BUILD GOOD SHOES” and the device element all point back to the BRICK element of the applicants’ trade mark. This in my view gives a strong conceptual link between the three elements of the applicants’ trade mark. The opponents’ trade mark calls to mind kicking. As such there is no conceptual similarity between the two trade marks. The overall conceptual link between the three elements of the applicants’ trade mark would, it seems to me, make a strong impression on the mind of the consumer. This together with the fact that there is no conceptual link between the applicants’ and the opponents’ trade marks, would, in my view, weigh against any likelihood of confusion through imperfect recollection.

46. The issues in this case have been clouded by the way in which the applicants appear, from the evidence, to use the word BRICKERS on their shoes. Whether the various ways in which this word is used is intended to call to mind or mirror the way in which the opponents use their trade mark is not an issue that I can determine, nor is it in my view an issue that should have any bearing on the outcome of the opposition under section 5(2)(b).

47. Mr Hobbs Q.C., sitting as the Appointed Person in *Balmoral Trade Mark* [1998] R.P.C. 297 at page 301, found that section 5(2) raised a single composite question. Adapted to this case it can be stated as follows: are there similarities (in terms of marks and goods) which would combine to create a likelihood of confusion if the applicants’ trade mark BRICKERS “WE BUILD GOOD SHOES plus device and the opponents’ trade mark KICKERS were used concurrently in relation to the goods for which they are respectively registered and proposed to be registered?

48. Taking all the factors into account and in particular, taking account of the distinctiveness of the opponents’ trade mark, the identity (similarity) of the goods for which registration is sought and imperfect recollection, I am of the view that the question posed above must be answered in the negative. In so finding I have considered the question of the likelihood of visual, aural and conceptual confusion in the context of the goods for which registration is sought. In that context, whilst not discounting the possibility of some aural confusion, I am of the view that this does not amount to a sufficient likelihood of confusion for the purposes of section 5(2)(b).

49. In my view, use of the applicants’ trade mark may call to mind of the opponents’ trade mark but this would be a mere calling to mind. It seems to me that there would be no likelihood of confusion nor do I find that the public would wrongly believe that the goods came from the same or economically linked undertakings. As such, I find that there is no likelihood of confusion within the meaning of section 5(2)(b) of the Trade Marks Act 1994. The opponents’ ground of opposition under section 5(2)(b) is therefore dismissed.

50. I go on to consider the opponents’ ground of opposition under section 5(4)(a). The test for determining whether the opponents have succeeded under this section has been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *WILD CHILD Trade Mark* [1998] RPC 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

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

- (2) that there is a misrepresentation by the applicants (whether or not intentional) leading or likely to lead the public to believe that goods offered by the applicants are goods of the opponents; and
- (3) that the opponents have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the applicants' misrepresentation.

51. As stated above, I am satisfied from the evidence that the opponents' have a reputation and goodwill in the trade mark KICKERS in relation to footwear. In considering the question of misrepresentation, I return to Mr Edenborough submissions on notional and fair use. Clearly under section 5(4)(a) the opponents must rely on the use that they have made of their trade mark. As set out above, Mr Edenborough invited me under section 5(4)(a) to take account of the way in which the applicants use the word BRICKERS on their shoes. The applicants were in his view seeking to mirror the use made by the opponents of the trade mark KICKERS. Again I should state that I do not have to decide the point nor in my view is it relevant to the test that I must apply under section 5(4). When considering whether the application should be refused under this head I must consider whether, as at the date of the application, the use of the trade mark the subject of the application could have been prevented by the law of passing off. That involves a consideration of the trade mark as used by the opponents against the trade mark as applied for, not BRICKERS solus. As with the test under section 5(2)(b) I accept that under section 5(4)(a) I should take into account the fact that use of the applicants' trade mark could include use in which the BRICKERS element is the dominant element of the trade mark. However, even taking this into account, and for the same reasons given above in relation to section 5(2)(b), I am not satisfied that the two trade marks are sufficiently close such that use of the applicants' trade mark would amount to misrepresentation.

52. In these circumstances, the question of a likelihood of confusion under section 5(4)(a) is no different to that under section 5(2); per Mr Thorley Q.C., sitting as the Appointed Person in *Boehringer Ingelheim KG v. Dallas Burston Healthcare Limited* (unreported 0-048-01 at paragraphs 26-31), the opponents' ground of opposition under section 5(4)(a) is therefore dismissed.

53. The applicants have been successful and are therefore entitled to a contribution towards their costs. I order the opponents pay the applicants the sum of £935. 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 11 day of April 2001

S ROWAN
For the Registrar
the Comptroller-General.