

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2233269  
BY ADEMIR VOLIC TO REGISTER A TRADE MARK IN CLASS 9**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER NO 51673 BY  
NEW YORKER S.H.K. JEANS GMBH**

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### **BACKGROUND**


1. On 20 May 2000 Ademir Volic applied to register the following trade mark


The image shows the trademark logo for 'Fishbone'. The word 'Fishbone' is written in a bold, black, sans-serif font. A small 'TM' symbol is positioned at the top right of the word.

in Class 9 of the register for a specification of “Storage devices adapted to hold audio tapes, video tapes or CD discs”.

2. The application was accepted by the Registrar and published in the Trade marks Journal.

3. On 8 November 2000 Wildbore & Gibbons on behalf of New Yorker S.H.K. Jeans GmbH filed a Notice of Opposition under Section 5(1) or Section 5(2) of the Act because the mark applied for is alleged to be identical or confusingly similar to the following earlier international registered trade marks (protected in the UK) owned by the opponent and is to be registered of the same or similar goods and there exists a likelihood of confusion on the part of the public:-

| NUMBER | MARK  | DATE OF PROTECTION IN THE UK | GOODS   |
|--------|---|------------------------------|---|
| 702660 |  | 9 May 1999                   | Class 9 - Pre-recorded audio and audiovisual media  |
| 726262 | FISHBONE  | 19 February 1999             | <p>Class 9 - Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; domestic electric apparatus and instruments (included in this class); apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, electronic data carriers, sound carriers of all kinds; automatic vending machines and mechanisms for coin operated apparatus; cash registers, calculating machines, data processing equipment and computers; eye glasses and their parts, particularly sunglasses, sports glasses, ski glasses, protective eye pieces; frames for eye glasses; lenses for eye glasses, cases for eyes glasses; protective helmets, helmet visors, protective face shields for protective helmets, protective sports equipment, especially protective gloves, headgear for boxing and ice hockey, headgear for horseback riding; none of the aforesaid being antennae or similar goods to antennae.</p> |

|        |   |                  |  |
|--------|---|------------------|--|
| 726263 |  | 19 February 1999 | Class 9 - Scientific, nautical, surveying, photographic, cinematographic, optical, weighting, measuring, signalling, checking (supervision), life saving and teaching apparatus and instruments; domestic electric apparatus and instruments (included in this class); apparatus for recording, transmission or reproduction of sound images; magnetic data carriers, electronic data carriers, tone carriers of all kinds; automatic vending machines and mechanisms for coin operated apparatus; cash registers, calculating machines, data processing equipment and computers; eye glasses and their parts, particularly sunglasses, sports glasses, ski glasses; protective helmets, helmet visors, protective face shields for protective helmets, protective sports equipment, especially protective gloves, headgear for boxing and ice hockey, headgear for horseback riding; bicycle speedometers; none of the aforesaid goods being antennae or similar goods to antennae. |
|--------|---|------------------|--|

4. The applicant, through its Agent Johnson, Sillett, Bloom, filed a counterstatement denying the grounds of opposition, claiming use of the mark FISHBONE in the UK in relation to the goods applied for since about 1993. However, no evidence relating to such use was filed.

5. Both sides asked for an award of costs in their favour and the opponent filed evidence. Neither party requested a hearing.

### **Opponent's Evidence**

6. This consists of a witness statement by Michael Gerloff which is dated 29 November 2001. Mr Gerloff is a member of the management of New Yorker S.H.K. Jeans GmbH (the opponent) which, he says, together with other New Yorker companies make up the New Yorker group, one of the leading textile retailers in Germany and Austria and which first commenced trading in 1971.

7. Mr Gerloff explains that the New Yorker group has more than 350 branches in central Europe and he goes on to detail the group's turnover. However, Mr Gerloff confirms that the

company has yet to open retail outlets for its products in the UK. Mr Gerloff goes on to state that his company has licensed use of the FISHBONE trade mark in the United Kingdom to J&K Henderson Ent's, Limited which has sold FISHBONE wristwatches in the UK since 1999. He explains that his company have the intention to market pre-recorded audio and visual tapes and discs and points out that the opponent's earlier registrations include pre-recorded audio and audiovisual media.

8. This completes my summary of the evidence filed and I now turn to the decision.

## DECISION

9. The grounds of opposition are based upon either Section 5(1) and/or Section 5(2) of the Act, depending upon whether the respective marks are identical or similar. In my view, the opponent's prior registrations are not identical to the mark in suit. Registration No's 702660 and 726623 contain a device element and while the opponent's remaining registration, No. 726262 merely comprises the dictionary word FISHBONE, it is presented in upper case, whereas the mark in suit presents the word "Fishbone" with the word or element "Fish" emboldened and the word or element "bone" lightened and this stresses that the word is made up of the two words or elements ie "Fish" and "bone". The difference is slight, but it follows that the marks cannot be viewed as identical. Accordingly, I believe Section 5(2) of the Act to be the relevant ground.

10. Section 5(2) of the Act reads as follows:-

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

- (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,

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

11. An earlier right is defined in Section 6, the relevant parts of which state:-

"6.-(1) In this Act an "earlier trade mark" mean:-

- (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,"

12. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik 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.

13. 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*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, 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 Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* 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*, paragraph 23;
- (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*, paragraph 23;
- (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*, 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*, 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*, paragraph 26;
- (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*, 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*, paragraph 29.

14. In essence the test under Section 5(2) is whether there are similarities in marks and goods and/or services which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the

recent judgements of the European Court of Justice mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods and/or services the category of goods and/or services in question and how they are marketed. As I have no evidence to demonstrate use of the respective marks in the UK in relation to the relevant goods, I must compare the mark applied for and the opponent's registrations on the basis of their inherent characteristics assuming normal and fair use of the marks on the goods covered within the respective specifications.

15. Turning to a comparison of the respective goods I have to decide whether the goods covered by the application are the same or similar to the goods covered by the opponent's registrations. While the goods specified by the applicant are relatively precise, it seems to me that "storage devices adapted to hold audio tapes video tapes or CD discs" in Class 9 could encompass two general categories of product - firstly, storage device for electronic media in which the media has yet to be added eg magnetic discs for data storage and cassettes adapted for the storage of audio or video tape(s); secondly, storage containers (not in the nature of furniture) adapted for CD's and audio or video tapes eg racks and wallet pouches. The specifications of opponent's registrations (in particular No's 72662 and 72663) are widely drafted in that they include a wide range of electronic apparatus.

16. In determining whether the services covered by the application are similar to the goods and services covered by the opponents trade mark I have considered the guidelines formulated by Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 (Pages 296, 297) as set out below-

"The following factors must be relevant in considering whether there is or is not similarity:-

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of services;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in particular they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors."

17. Whilst I acknowledge that in view of the CANON-MGM judgement by the European Court of Justice (3-39/97) the Treat case may no longer be wholly relied upon, the ECJ said the factors identified by the UK government in its submissions (which are listed in TREAT) are still relevant in respect of a comparison of goods and/or services.

18. I go on to consider the first category of goods which I believe to be covered by the applicant's specification ie storage devices for electronic media (discs and cassettes) in which the media eg encoded data or tape remains to be added and have no doubt that these goods are identical to goods included within the opponent's registration ie "magnetic data carriers", "electronic data carriers", and "sound carriers of all kinds" as the applicant's goods falling within the first category are, in short, carriers for magnetic or electronic data.

19. Next, I turn to a consideration of the applicant's second category of goods ie storage containers such as CD wallets and racks for keeping CD's or tapes. I have no evidence before me on the point, but it seems to me that the uses and physical nature of such goods is different from the electronic apparatus covered by the opponent's specifications. Storage containers included in this second category are not, by their nature, data carriers and they cannot be adapted to this function. Their basic purpose is to keep goods in a tidy and orderly manner. Furthermore, although goods such as CDs and audio/ video tapes could share the same channels of trade and retail outlets as CD wallets or tape racks, they are not in competition and are not alternative purchases. In my view any similarity between these goods is slight.

20. I now go on to compare the mark in suit with the marks comprising the opponent's earlier registrations. The mark applied for consists of the dictionary word FISHBONE with the word/element FISH emboldened and the word/element BONE lightened. This goes to stress that although the word FISHBONE has its own meaning it is made up of the dictionary words "Fish" and "Bone". The opponent's registrations comprise the word FISHBONE (No. 726262) and also the word FISHBONE followed by the device of a fish (showing its skeleton or bones behind its head), the totality being within a border (No's 702660 and 726623). The opponent's marks have no reference to their goods and possesses a high distinctive character.

21. Turning firstly to a comparison of the mark in suit with the opponent's registration No. 726262, I have no doubt whatsoever that the marks are very closely similar in a visual context and in aural use they would be identical. Furthermore, the marks are very closely similar on a conceptual basis in that FISHBONE is an obvious dictionary word. While I do not consider registration No's 702660 and 726623 place the opponent in any stronger position given that the device element makes for an additional difference with the mark in suit, I also believe these registration to be similar to the applicant's marks as the device helps to re-inforce the word FISHBONE.

22. In assessing the degree of similarity between the respective marks and whether it is likely to give rise to a likelihood of confusion I must consider the average customer for the goods and the possibility of imperfect recollection.

23. The range of goods covered by the applicant's and opponent's specifications is sufficiently wide enough to encompass specialist customers and the general public. However, it seems to me that those goods of the applicant which I have previously categorised as



storage devices for electronic media eg cassettes adapted for the storage of audio or video tape, are likely to be purchased by trade or specialised customers and while this could mitigate against confusion occurring in relation to this category of goods, it does not follow that there is no likelihood of confusion in respect of these goods as all relevant circumstances must be taken into account.

## **CONCLUSION**

24. On a global appreciation after taking into account all relevant factors, the close similarity between the mark in suit and the opponent's registrations (in particular registration No. 726262) and the existence of identical and/or similar goods within the respective specifications, makes, I believe, for a likelihood of confusion on the part of the relevant public. The opposition succeeds under Section 5(2)(b) of the Act.

## **COSTS**

25. The opponent is entitled to a contribution towards costs and I therefore order the applicant to pay the opponent the sum of **£900**. 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 17 Day of September 2002**

**JOHN MacGILLIVRAY**  
**For the Registrar**  
**The Comptroller General**