

O-289-03

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2287063  
BY CAPI LIMITED TO REGISTER A TRADE MARK IN CLASS 25**

**AND**

**IN THE MATTER OF OPPOSITION No. 90307  
BY HEAD SPORT AG**

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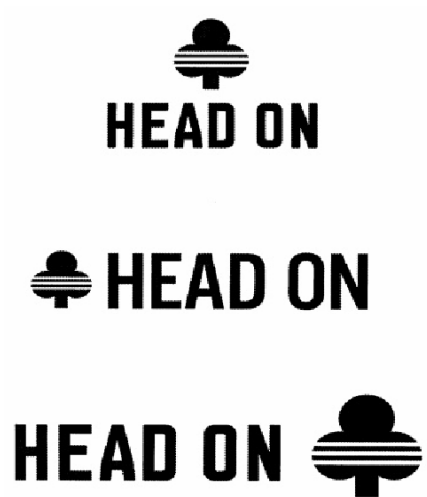
**IN THE MATTER OF Application No. 2287063  
by Capi Limited to register a Trade Mark in Class 25**

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**Background**

1. On 30 November 2001 Capi Limited applied to register the following series of three marks for 'clothing, footwear and headgear':



The application is numbered 2287063.

2. On 9 April 2002 Head Sport AG filed notice of opposition to this application. They are the proprietors of the trade mark HEAD registered in Class 25 under No. 1502616 for "articles of outer clothing; footwear; sportswear; all included in Class 25; but not including headgear". This registration has a filing date of 2 June 1992 and so is an earlier trade mark within the meaning of Section 6(1) of the Act. They contend that the mark(s) for which registration is sought is similar to their earlier trade mark and is tendered for registration in respect of identical and similar goods. Registration would, they say, be contrary to the provisions of Section 5(2)(b) of the Act.

3. The opponents also say that they have supplied clothing and other goods under the mark HEAD since before 1992 and have thereby established a valuable goodwill. Accordingly they say that registration would be contrary to the provisions of Section 5(4)(a) of the Act, in that use of the applied for mark is liable to be prevented by the law of passing off.

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

5. Having reviewed the case, I indicated to the parties that I considered a decision could be reached on the basis of the papers filed. The parties were nevertheless reminded of their right to be heard or to offer written submissions. Neither side has asked to be heard. Written submissions have been received from Jordans Ltd on behalf of the applicants (under cover of their letter of 20 August 2003). Acting on behalf of the Registrar and with the above material in mind I give this decision.

### **Opponents' evidence**

6. This comes in the form of a witness statement by George Kröll, Vice President, International Licensing of Head Sport AG. He says that his evidence comes from his own knowledge save for sales values, which have been derived from returns provided by Sportline, a division of H Young (Operations) Ltd, the opponents' licensees during the period 1997 to 1999.

7. Mr Kröll says that wholesale sales values of clothing, footwear and headgear for the United Kingdom were as follows:

1997	£3,400,000
1998	£4,100,000
1999	£6,600,000
2000	£9,100,000
2001	£11,998,000

(In the light of Mr Kröll's statement regarding the source of sales figures, it is not clear where the last two years' figures have been derived from).

In the United Kingdom, Sportline are said to have placed regular advertisements during the years 1997, 1998 and 1999 in a number of periodicals, including lifestyle magazines such as Loaded, FHM and GQ, and also magazines for sports enthusiasts including ACE, Squash Player and Fall Line. In addition, by offering free gifts to members of the public who responded to advertisements, Sportline built up a data base of customers to allow mail shots to skiing and tennis enthusiasts. They also supplied retailers with point of sale materials, including mobiles, show cards, posters and banners.

8. Exhibited at GK2 is a copy of a report received from Sportline relating to their Winter 1997 activities and setting out their appreciation of the brand position and range overview.

9. Mr Kröll also exhibits:

- GK3 - a set of illustrations of various types of clothing which were marketed by Sportline during Autumn-Winter 1997 in the ski leisure field. He draws attention to knitted caps and jackets bearing the HEAD mark with additional wording such as HAD=MAX [HEAD=MAX?] SPORTS.TECHNOLOGY/HEAD/AUSTRIA and AUSTRIA 1950 HEAD;
- GK4 - Clothing in the 'outdoor exploration range' from the same period showing certain caps and jackets marked THE HEAD EXPLORATION;
- GK5 - designs from 1997 from the ladies' exercise and leisurewear range;
- GK6 - a copy of Sportline's Spring-Summer 1999 Court Sports catalogue giving details of rackets, footwear, bags and clothing sold under the HEAD trade mark;
- GK7 - a series of extracts from periodicals published or available in the United Kingdom during the years 1996 to 1998, in the form of advertising features or articles relating to HEAD products. The exhibit includes extracts from Harpers, Sports Trader, Daily Mail Ski Magazine, The Good Ski Guide, Tennis, Maxim, The Skier and Snowboarder, Mens Health, Stuff for Men, Ace, and the Coventry Evening Telegraph, this last in conjunction with the EXSL exhibition in September 1997.

10. The remainder of Mr Kröll's witness statement is largely submissions. I bear these comments in mind in coming to my own view of the matter below.

### **Applicants' evidence and opponents' evidence in reply**

11. The applicants filed a witness statement by Bill Tennant of Jordans Limited, their professional representatives in this matter. He submits dictionary evidence showing the meaning of the phrase "head-on" and print-outs of some 16 marks on the Trade Marks Register incorporating the word HEAD. This material is, in turn, commented on in a witness statement by Jane Martin, filed on behalf of the opponents. I propose to deal with these submissions in my decision below.

### **Decision**

12. The relevant part of the statute reads:

"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.”

13. In determining the question under Section 5(2), I have been referred to and 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] RPC 117 and *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77.

14. In their counterstatement the applicants concede that the goods at issue are the same or similar but deny that the marks are similar. The matter, therefore, turns critically on my view on the marks themselves.

15. This is a convenient point at which to review the submissions made by the parties in relation to the considerations I should bear in mind in comparing the respective marks. The opponents submit that the applied for mark contains their earlier trade mark as a prominent and unmistakable element; HEAD is the first element that will be noted by the public; notwithstanding the presence of the trefoil device (which itself varies in relative size and positioning) words speak louder than devices; oral references to the applied for mark may not refer to the device element at all; and that HEAD ON is presented as two separate words rather than in hyphenated form.

16. The applicants submit that the words HEAD ON carry a different connotation to the word HEAD alone; the trefoil device creates a memorable visual element; visual considerations are of particular importance in relation to clothing (*REACT Trade Mark* [1999] RPC 529 and [2000] RPC 285); the element HEAD is included in many trade marks on the Register in respect of clothing suggesting that customers will be able to differentiate one from another (*GLOBE-DIAL Trade Mark*, O/403/99). I have also been referred to three oppositions by the current opponents where they were unsuccessful in opposing the marks HEADRUSH CLOTHING (and device), BULLHEAD and STONEHEAD.

17. The visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by those marks, bearing in mind their distinctive and dominant components, *Sabel v Puma* paragraph 23. The matter must be judged through the eyes of the average consumer of the goods/services in question, *Sabel v Puma*, paragraph 23; the average consumer is deemed to be reasonably well informed and reasonably circumspect and observant but rarely has the chance to make direct comparisons between marks. Imperfect recollection must, therefore, be allowed for, *Lloyd Schuhfabrik v Klijsen Handel*, paragraph 27.

18. The opponents' earlier trade mark is the word HEAD solus. It is a well known dictionary word, but noting the exclusion to the specification, appears to have no obvious descriptive connotations in relation to the goods. It is a mark of average distinctive character, in my view,

based on its inherent claims. To the extent that the evidence summarised above is intended to demonstrate an enhanced degree of distinctive character, I do not think it is of material assistance to the opponents in establishing an enhanced reputation in relation to the generality of the specification (and of the household name standard referred to in *DUONEBS Trade Mark*, O-048-01). If the opponents are entitled to make such a claim, it can only be in relation to tennis and ski wear rather than clothing at large.

19. The applied for mark relies for its distinctive character on both the words and device. I agree with the submissions made on the applicants' behalf that the device makes a notable contribution, albeit that it varies in position and relative proportions (to the words) in the three marks of the series. The respective submissions differ in the approach I should adopt to the words HEAD ON, with the applicants contending that words constitute a phrase with a meaning of its own and the opponents pointing to the fact that it is two separate words and not the hyphenated expression as it appears in dictionaries. The latter is a technically correct view of the matter, but given that correct punctuation is not always observed, there is probably scope for more than one view of the matter.

20. With these considerations in mind, I turn to my own views on whether the applicants' mark captures the distinctive character of the opponents' earlier trade mark. Self evidently it contains the whole of the earlier trade mark, but that cannot be determinative of the matter in itself - see, for instance, the approach adopted by the Appointed Person in *10 ROYAL BERKSHIRE POLO CLUB Trade Mark*, [2001] RPC 32 at page 653. However, on any view of the applied for mark, HEAD is a prominent and distinctive element and one that will be relied on in both visual appreciation of, and oral references to, the mark. ON is both a shorter and arguably less distinctive element, but not one that would be ignored or overlooked. The key issue is, therefore, whether the combination HEAD ON and device creates a sufficiently different impression that the average consumer would not be confused if the respective marks were to be used in relation to identical or similar goods.

21. Making the best I can of the matter, I find that the composite nature of the applied for mark is sufficient to avoid one mark being mistaken for the other. But the presence and prominence of the common element HEAD, allied to the fact that I am not confident the words will be distinguished on the basis that they constitute the expression 'head-on' leads me to the view that an association will be made between the marks. According to *Canon v MGM*:

“..... the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 4(1)(b) of the Directive (see *SABEL*, paragraphs 16 to 18).”

22. In this context the trefoil device may simply be seen as a corporate device or an additional/supplementary mark with which the consumer was not previously familiar. It does not alter my prima facie view of the matter.

23. The likelihood of confusion is, nevertheless, a matter of global appreciation taking account of all relevant factors (*Sabel v Puma*, paragraph 22). The applicants have referred to two

additional circumstances – the state of the register evidence and the unsuccessful outcome of certain other opposition cases in which the opponents were involved.

24. In relation to the first of these points I was referred to the following passage from *GLOBE-DIAL Trade Mark*:

“Ms Christensen drew my attention to the many trade marks on the Register which include the word GLOBE. For example GLOBETRAK and GLOBEX both in Class 38. Whilst no evidence was put forward as to whether and how these trade marks are used it does to my mind suggest that GLOBE is a word which is in common usage in the market place in respect of the services covered by the applicants’ and opponents’ trade marks. It would be fair therefore to infer that customers are accustomed to the use of the word GLOBE in respect of these services and can differentiate one trade mark from another through other elements.”

25. The services in question in that case were telecommunications where a word indicative of wide or global coverage might be expected to be in use. It does not necessarily follow that inferences can be drawn about the public’s likely reaction to words which are not descriptive or allusive in character simply on the basis of state of the register material (see *Torreomar Trade Mark* [2003] RPC 4 at paragraph 25). In the absence of evidence, as to the public’s exposure to marks consisting of, or incorporating, the word HEAD and their ability to differentiate between them on the basis of other elements, I decline to accept that I should be guided by the state of the register material.

26. I am also unpersuaded that the opponents’ failure in oppositions to the marks HEADRUSH CLOTHING (and device), BULLHEAD and STONEHEAD is of relevance to the case before me. Each case must be determined on its own merits. The mark now before me is quite different in character to those referred to above.

27. In summary, I find that there is an association between the marks, which will cause the public to wrongly believe that the goods offered for sale under the respective marks come from the same or economically linked undertakings. In those circumstances, there is a likelihood of confusion within the meaning of the section. The opposition succeeds under Section 5(2)(b).

28. In the circumstances, it is unnecessary to go on and consider the Section 5(4)(a) ground and I decline to do so. The opponents are entitled to a contribution towards their costs. I order the applicants to pay them the sum of £1400. 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 24th day of September 2003**

**M REYNOLDS  
For the Registrar  
the Comptroller-General**