

O-062-05

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2341753  
BY JALF BROS LIMITED  
TO REGISTER THE TRADE MARK:**

**RAiNYSEASON**

**IN CLASS 25**

**AND**

**THE OPPOSITION THERETO  
UNDER NO 92245  
BY  
OUTDOOR LEISUREWEAR LIMITED**

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by Jalf Bros Limited  
to register  
the trade mark:  
RAiNYSEASON  
in class 25  
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by Outdoor Leisurewear Limited**

### **BACKGROUND**

1) On 23 August 2003 Jalf Bros Limited, which I will refer to as Jalf, applied to register the trade mark **RAiNYSEASON** (the trade mark). I have reproduced the trade mark as published and will deal with it on this basis. However, box 2 of the application form shows the words RAINY SEASON written in free hand in block capitals, there is a dot over the i but it is not certain that this signifies a stylisation. Box 3 of the application form states that the trade mark is a word or words without any particular representation. The application was published for opposition purposes in the “Trade Marks Journal” on 7 November 2003 with the following specification:

*clothing, footwear, headgear.*

The above goods are in class 25 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) On 14 January 2004 Outdoor Leisurewear Limited, which I will refer to as Outdoor, filed a notice of opposition. Outdoor is the owner of United Kingdom trade mark registration no 2337718 of the trade marks:

### **RAINY DAYS**

**RAINY  
DAYS**

(a series of two). The application for registration was filed on 14 July 2003. It is registered for the following goods:

*articles of outer clothing; leisurewear; sportswear; underclothing; casual wear; footwear and headgear; caps and hats.*

The above goods are in class 25 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15

June 1957, as revised and amended. Outdoor claims that the respective trade marks are similar. It claims that there is a likelihood of confusion and registration of the trade mark should be refused under section 5(2)(b) of the Trade Marks Act 1994 (the Act).

3) Outdoor claims that it has made extensive use of the trade mark RAINY DAYS since July 2001 and by reason of such use has generated a considerable reputation and goodwill in the RAINY DAYS trade mark sufficient to found an action in passing-off. Outdoor claims that it will prove that Jalf, being well known to Outdoor, has adopted in addition to a similar trade mark an identical get-up for its RAINYSEASON trade mark, such that the same amounts to an actionable passing-off. Outdoor claims that registration of the application would be contrary to section 5(4)(a) of the Act.

4) Outdoor states that at the date of application, 23 August 2003, Jalf was aware of Outdoor's reputation and goodwill attaching to its RAINY DAYS trade mark. The adoption of the trade mark would take unfair advantage of or be detrimental to the distinctive character or repute of the RAINY DAYS trade mark thereby rendering the application as being made in bad faith. Consequently, registration of the application would be contrary to section 3(6) of the Act.

5) Outdoor requests a refusal of the application and an award of costs.

6) Jalf filed a counterstatement. It states the following:

- Jalf has used the trade mark RAINYSEASON in relation to clothing, rainwear, casual wear jackets in the United Kingdom since 1992. It states that it can prove this.
- The trade marks Rainy Days and RAINYSEASON have almost the same meaning. Rainy is dominant in both of these marks. The registration of trade mark application no 2337718 (Outdoor's trade mark) offends against the Act.
- Jalf previously claimed that it had first used Rainy Days in 1994, then 1999-2000 and now July 2001. Outdoor has changed its statement three times.
- Jalf has previously supplied clothing to Outdoor. Outdoor was aware of the trade mark prior to the filing of United Kingdom trade mark application no 2337718.

7) Jalf seeks the registration of the application and an award of costs.

8) Only Outdoor filed evidence.

9) Both sides were advised that it was believed that a decision could be made without recourse to a hearing. However, the sides were advised that they retained their rights to a hearing. Neither side requested a hearing. No written submissions were received.

## **EVIDENCE**

10) This consists of a witness statement by Gary William Anthony Johnston. Mr Johnston is a trade mark attorney acting for Outdoor. He states that where he makes

statements of fact, those facts have been gained from his personal knowledge and/or were provided to him by Outdoor. Parts of his statement are submission rather than evidence of fact and I will say nothing about those parts.

11) Mr Johnston states that the trade mark RAINYDAYS was adopted by Jalf in February 2002. He exhibits at GWAJ1 an example of a RAINYDAYS branded kagoul. The transparent packaging, a label upon the garment and a swing ticket all bear the trade mark RAINYDAYS. He states that the approximate turnover of garments sold since first use up to 23 August 2003 amounts to £500,000. He states that the goods were sold to established customers and to the wholesale and independent trades.

12) Mr Johnston states that the two sides know each other very well. He states that Jalf has for many years sourced products for Outdoor, including branded products. He states that at the time of the application Jalf was aware of Outdoor's reputation and goodwill in the trade mark RAINYDAYS, particularly for the sale of kagouls. Mr Johnston exhibits at GWAJ2 a copy of an invoice from Jalf to Outdoor. The handwriting is not very clear but it would appear to be dated 23 March 2003 and to be for forty adult jackets at £7.65 each, before VAT. Mr Johnston states that business relationships became strained in early 2003, at about the time that Jalf introduced the trade mark RAINYSEASON. Mr Johnston exhibits at GWAJ3 an example of a RAINYSEASON kagoul. The label on the product and the swing label are in the same get-up as those shown for the RAINYDAYS kagoul. The trade mark upon the transparent wrapping is in the same get-up as for the swing label and garment label, not as for the wrapping of the RAINYDAYS kagoul. The letter i is not in a different case. On the packaging and garment label the words RAINY and SEASON are not conjoined, although upon the swing label they are.

## **DECISION**

### **Likelihood of confusion – section 5(2)(b) of the Act**

13) According to section 5(2)(b) of the Act a trade mark shall not be registered if because:

“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.”

Section 6(1)(a) of the Act defines an earlier trade mark as:

“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”

14) In its counterstatement Jalf effectively challenges the validity of Outdoor's trade mark registration. Section 72 of the Act states:

“In all legal proceedings relating to a registered trade mark (including proceedings for rectification of the register) the registration of a person as proprietor of a trade mark shall be prima facie evidence of the validity of the original registration and of any subsequent assignment or other transmission of it.”

There is, therefore, a presumption of validity. There is no indication that any action has been launched against Outdoor's registration, nor has Jalf filed any evidence to support its claims. Outdoor's registration is quite clearly an earlier trade mark in the terms of section 6(1)(a) of the Act and a valid one for the purposes of this opposition.

15) In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117 and *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77 and *Marca Mode CV v Adidas AG and Adidas Benelux BV* [2000] ETMR 723.

### **Comparison of goods**

16) The goods of the application are:

*clothing, footwear, headgear.*

The goods of the earlier trade mark are:

*articles of outer clothing; leisurewear; sportswear; underclothing; casual wear; footwear and headgear; caps and hats.*

*Footwear and headgear* are rehearsed in both specifications and so are identical. *Articles of outer clothing; leisurewear; sportswear; underclothing* overlap with *clothing* at large. In *Galileo International Technology LLC v Galileo Brand Architecture Limited* BL 0/269/04 Professor Annand, sitting as the appointed person, stated:

16. I believe that overlapping specifications satisfy the test for identical goods or services in section 5(1) of the TMA. There is no necessity for such specifications to co-extend.

Consequently, the remaining goods of the application are identical.

**17) I find that the respective goods are identical.**

## Comparison of trade marks

18) The trade marks to be compared are:

Earlier trade marks:

Trade mark of the application:

**RAINY DAYS**

**RAiNYSEASON**

**RAINY  
DAYS**

I will compare Jalf's trade mark with the upper trade mark of the series.

19) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Sabel BV v Puma AG*). 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*). Consequently, I must not indulge in an artificial dissection of the trade marks, although taking into account any distinctive and dominant components. The average consumer 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 and he/she is deemed to be reasonably well informed and reasonably circumspect and observant (*Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*). "The analysis of the similarity between the signs in question constitutes an essential element of the global assessment of the likelihood of confusion. It must therefore, like that assessment, be done in relation to the perception of the relevant public" (*Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02).

20) Both trade marks include the word rainy, although the application presents the letter i in this word in lower case. The second elements of the trade mark are neither visually nor phonetically similar. Season and days, however, both refer to periods of time. In its counterstatement Jalf states:

"The trademarks Rainy Days and RAINYSEASON are almost the same meaning. Rainy is dominant in both of these trade marks. The registration of application no 2337718 offends against the Trade Marks Act 1994".

Whatever my views on the similarity between the respective trade marks, I cannot ignore the statement of Jalf which is clearly an admission against interest. For reasons no doubt relating to its view of Outdoor's trade mark, Jalf effectively states that there is a likelihood of confusion and that the respective trade marks are similar. The counterstatement of Jalf was not the result of professional advice, as far as I can see. However, that an unrepresented side makes statements that it might have been advised not to make, if professionally advised, does not mean that the statements can be ignored. This is an inter partes matter and if both sides consider that there is a clash between the trade marks I cannot see that I can refuse to accept this.

## Conclusion

21) In *Premier Brands UK Ltd v Typhoon Europe Ltd & Another* [2000] ETMR 1071 Neuberger J stated:

“In my judgment, in the absence of argument or evidence to the contrary, the way in which the proprietor actually uses the mark can be said, at the very least *prima facie*, to be the paradigm case of its use in a normal and fair manner.”

In this case evidence has been filed to show that Jalf uses its trade mark in the same get-up as Outdoor uses it. Taking into account that the letter i is not in lower case, it strikes me that the form used does represent use in a normal and fair manner and does represent the paradigm use. (Even more so, if my reservations about the form of the trade mark as published are well founded.) In comparing the two garments exhibited I immediately found myself confused as to which one was that of Jalf and which one that of Outdoor; and I had the advantage of both trade marks before me, unlike the average consumer, and I was specifically seized with the issue of similarity and a likelihood of confusion. I consider that the confusion of the hearing officer is a reasonable indication that the public are likely to be confused also. Of course, Jalf claims that there would be confusion.

22) In considering the issue of likelihood of confusion I have to consider various factors, including:

- the distinctiveness of the earlier trade mark;
- the degree of similarity between the trade marks;
- the degree of similarity between the respective goods;
- the nature of the respective goods and the subsequent purchasing decision;
- the average consumer for the services involved;
- that trade marks are seldom compared directly and the potential purchaser may be prey to imperfect recollection;
- any claim to reputation.

However, in this case, I also have to take into account that both sides consider that there is a likelihood of confusion. RAINY DAYS clearly alludes to goods for use in relation to rain. However, it stands together as a phrase. Both specifications also encompass goods that will not have any necessary relationship to wet weather and so for such goods the earlier trade mark will have greater distinctiveness than in relation to wet weather goods. The respective goods are identical. The goods are not “bags of sweets”. In my experience purchasers of clothing are often brand conscious. However, this is not always the case. The goods displayed in this case would appear to be more aimed at the utilitarian purchaser than the style slave. Some of the goods of the specification could encompass goods for which there would be a careful purchasing decision, others where relatively little notice will be taken. This will depend more on the expense of the goods than their nature or purpose. The average consumer for the goods is the public at large. The evidence does not support an enhanced penumbra of protection owing to reputation.

23) Taking into account the identity of the goods, the nature of the purchasing decision, the statements of Jalf, the similarities between the trade marks and the dissimilarities (see *Croom's Trade Mark Application* [2005] RPC2) and the average consumer for the respective goods, **I come to the conclusion that there is a likelihood of confusion and that the application should be refused in its entirety.** This case is unusual as the core to the dispute appears to be which side had rights to its trade mark first and from this whether the earlier trade mark of Outdoor is valid. Both sides appear to agree that there is a likelihood of confusion and in such an situation I cannot see that I can come to a different conclusion. I have already dealt with the validity of the earlier trade mark; based upon that validity and the position of the two sides the outcome of the case was inevitable. I cannot come to a conclusion as to which side used its trade mark first and I do not need to. The earlier right of Outdoor is a fact and the effect of that fact is its success. I cannot come to a conclusion as to who chose the get-up used for the trade marks first. However, I do not see that that is relevant. My deliberation is whether taking into account normal and fair use there is a likelihood of confusion; it is not an issue for me as to whose goods will be confused for whose goods. The likelihood of confusion is the issue.

24) I cannot see that Outdoor could do any better, on the basis of its evidence, under section 5(4)(a) than under section 5(2)(b) and so I see no need to decide upon this ground of opposition. The ground of opposition under section 3(6) is, in my view, contingent on the findings in relation to section 5(2)(b) and 5(4)(a) and so again I see no need to make a decision upon this ground of opposition. However, on the basis of the evidence before me I would not be sanguine as to the success of Outdoor in relation to these other grounds. It has the intrinsic weakness of being written by a third party who effectively states that he is giving hearsay evidence; which is obviously acceptable but the weight attached to it must be limited. I do not consider that the evidence satisfies the criteria, in relation to passing-off, set out by Pumfrey J in *South Cone Inc. v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19. Professor Annand, sitting as the appointed person, in *Loaded* BL0/191/02 accepted that other evidence could satisfy the requirements to establish the requisite goodwill. However, in the absence of direct evidence from Outdoor, the absence of any invoices and promotional material, I do not consider that the evidence would establish the requisite goodwill at the material date. Equally, I do not consider that the evidence is strong enough to establish a basis for a claim of bad faith. All the evidence shows me is that there has been a business relationship between the two sides and that the trade marks have been used in the same get-up. The actual goods exhibited do not even show any indication that they are the products of either side; although I consider that this a reasonable inference to be made.



## **COSTS**

**25) Outdoor Leisurewear Limited having been successful is entitled to a contribution towards their costs. I order Jalf Bros Limited to pay Outdoor Leisurewear Limited 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 10th day of March 2005**

**David Landau  
For the Registrar  
the Comptroller-General**