

O-219-08

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2430094
BY ELKPARTS LTD TO REGISTER THE
TRADE MARK**



IN CLASSES 25 & 35

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 95008 BY
A&F TRADEMARK INC**





BACKGROUND

1) On 17 August 2006, Edison Limited (now Elkparts Ltd) applied to register the trade mark shown above. Following examination the application was amended, and then accepted and published for Opposition purposes in Trade Marks Journal No.6660 on 24 November 2006 for the following goods and services:

Class 25: Clothing, footwear; headgear; masks.

Class 35: The bringing together, for the benefit of others, of a variety of motoring products and clothing and clothing accessories, enabling customers to conveniently view and purchase those goods in a retail store and/or via a corresponding web site or through mail order catalogues.

2) On 26 February 2007, A&F Trademark, Inc filed a notice of opposition. This consists of grounds based upon sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (as amended) (the Act), under which they rely on the following trade marks:

Trade Mark	No.	Application date	Registration date	Classes
	2406453	14.11.2005	20.10.2006	3, 14, 18, 25 & 35
	2406461	As above	As above	As above
	E4729356	8.11.2005	6.11.2006	As above
	E4731139	As above	12.9.2006	As above

3) Full details of the goods and services covered by these registrations can be found in the Annex to this decision.

4) I note that: (i) the trade marks the subject of registration Nos: 2406453 and E4729356 are identical to one another, as are registrations Nos: 2406461 and E4731139, and (ii) that while the application is said to fall foul of section 5(2)(b) in respect of all the above registrations, the grounds based on sections 5(1) and 5(2)(a) are said only to apply insofar as registration Nos: 2406453 and E4729356 are concerned.

5) On 27 November 2007, the applicant filed a counterstatement in which they say *inter alia*:

“2. Contrary to the Opponent’s allegations, the Applicants Mark is not identical with either of UK Trade Mark Registration No. 2406453 or Community Trade Mark Registration No. 004729356 as there are clear differences between the marks that are unlikely to go unnoticed by the average consumer.

3. The Applicant does not accept that the services of the Applicant’s mark are similar to: “Advertising; business management; business administration; office functions.””

6) Neither side filed evidence in these proceedings. Nor did they wish to be heard but both provided written submissions which I shall refer to as and when they are relevant to my decision.

DECISION

7) On 1 July 2008 the applicant requested that its specification be amended by the deletion of Class 25 in its entirety.

8) The opponent indicated that this amendment was not sufficient to allow the opposition to be withdrawn. I note that the opponent’s Class 35 has a specification which reflects the Nice Classification Class heading. However, the opponent has not contended in its grounds of opposition that its services in this class are identical to those of the applicant but has merely stated that they are similar. In its skeleton arguments, dated 1 July 2008, the opponent announced that it was seeking to “amend” its OHIM specification from the Class heading to read “Advertising; business management; business administration; office functions; including retail store services, mail order catalogue services and on-line retail store services featuring clothing, footwear, fashion accessories, personal care products, jewellery and bags”.

9) The opponent contends that OHIM practice is summarised in Communication No. 4/03 of the President of the Office dated 16 June 2003 which states that “the use of all the general indications listed in the class heading of a particular class constitutes a claim to all the goods or services falling within this particular class”. Thus, they contend, their registered specification covers all services included in Class 35. However, the UK Trade mark Registry takes a different view on this issue. At paragraph 4.1.9 of Chapter 2 of the Trade Marks Registry’s Work Manual it states:

“4.1.9 Interpreting the WIPO class headings

The use of WIPO class headings as statements of goods or services may lead to confusion concerning the scope of protection provided. In the context of the Nice International Classification, it is clear that the headings to the classes are intended to convey general indications relating to the fields to which goods or services belong (see General Remarks, Nice Classification 8th edition, page 3).

When a class heading is used as a specification, it loses its capacity to function as a class heading and becomes part of an application or registration as a statement of goods or services. It follows that the question of what a class heading includes or does not include is irrelevant and interpretation of the statement of goods or services may only be made by reference to the goods or services included in that statement.

It is a common misunderstanding that a WIPO class heading always includes all the goods or services in a particular class and some applicants may be misled into thinking there is no need to be specific when making an application. For instance, the heading for Class 15 is “Musical instruments”. The goods “stands for musical instruments” are also proper to this class but are not covered by the scope of the heading. Likewise the heading for Class 12, “Vehicles; apparatus for locomotion by land, air or water” makes no reference to “Repair outfits for inner tubes.” In Class 20, the item “sleeping bags for camping” is not covered by “furniture”.

10) The opponent contended, that if the amendment was seen as a change in its specification then changes to specifications were taken into account in opposition cases before the Registry. This is correct in so far as they relate to restrictions to the specification as a result of a request by one of the parties or as a result of non-use in trade marks over five years old. However, a specification cannot be expanded once a mark is registered. A new application would need to be filed which would then have a different date to the original filing and so might not be a prior right.

11) To my mind the proposed amended specification would be an expansion. It is clear from the original grounds of opposition that the opponent believed that the applicant’s services in Class 35 were only similar to its goods and services in classes 25 & 35. I therefore regard this argument as to the effect of the proposed amendment to the specification as an amendment to the grounds pleaded. Had the enlarged specification been in place prior to the application being filed the applicant might have chosen to withdraw immediately or indeed might have defended its application in an entirely different manner. I shall therefore regard the opponent’s specification in class 35 to be restricted to that which is shown in the attached annex.

12) The grounds of opposition are based upon sections 5(1), 5(2)(a) and 5(2)(b) of the Act. These read as follows:

“5. - (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(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) An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.-(1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) 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 these proceedings the opponent is relying on the four registered trade marks shown in paragraph 2 above, all of which have application dates prior to that of the application for registration; they clearly qualify as earlier trade marks under the above provisions. The application was published for opposition purposes on 24 November 2006; given their dates of registration, the opponent’s earlier trade marks are not subject to The Trade Marks (Proof of Use, etc) Regulations 2004.

15) I turn first to the objections based on sections 5(1) and 5(2)(a) of the Act. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA* [2003] FSR 34, the ECJ said in relation to what constitutes an identical trade mark:

“51 There is therefore identity between the sign and the trade mark where the former reproduces, without any modification or addition, all the elements constituting the latter.

52 However, the perception of identity between the sign and the trade mark must be assessed globally with respect to an average consumer who is deemed to be reasonably well informed, reasonably observant and circumspect. The sign produces an overall impression on such a consumer. That consumer only rarely has the chance to make a direct comparison between signs and trade marks and must place his trust in the imperfect picture of them that he has kept in his mind. Moreover, his level of attention is likely to vary according to the category of goods or services in question (see, to that effect, [Case C-342/97 Lloyd Schuhfabrik Meyer \[1999\] E.C.R. I-3819](#) at para.[26]).

53 Since the perception of identity between the sign and the trade mark is not the result of a direct comparison of all the characteristics of the elements compared, insignificant differences between the sign and the trade mark may go unnoticed by an average consumer.

54 In those circumstances, the answer to the question referred must be that Art.5(1)(a) of the Directive must be interpreted as meaning that a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

16) Given my comments at paragraph 4 above, the respective trade marks to be considered under these grounds are as follows:

Applicant's Trade Mark	Opponent's Trade Mark
	

17) I have considered the guidance provided in paragraph 54 of the ECJ's decision in the context of this case. Having done so, I have come to the conclusion that given the various differences between the devices of the two parties, for example, the posture, the positioning of the legs, the differences in the animals bodies, and the manner in which the antlers are depicted, that the respective trade marks can not be considered to differ so insignificantly that the differences may go unnoticed by an average consumer. Consequently, the objections based on sections 5(1) and 5(2)(a) of the Act are dismissed.

18) I now turn to the objection based on section 5(2)(b) of the Act. In reaching a decision I take into account the following cases: *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Matratzen Concord GmbH v. OHIM* [2004] ECr I-3657, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* [2005] ECr I-8551 and *OHIM v. Shaker di L. Laudato & C. Sas* [2007] ECR I-4259.

19) In essence the test under section 5(2)(b) is whether there are similarities in marks and goods and 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 judgments 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 services, the category of goods and services in question and how they are marketed. Furthermore, I must compare the applicant's mark and the mark relied upon by the opponent on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods and services covered within the respective specifications.

20) The effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act was considered by David Kitchen Q.C. sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchen concluded at paragraph 17 of his decision:

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the

principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in *Reed Executive & Ors v Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

21) The opponent has shown no use of its mark. I have to consider whether the opponent’s mark has a particularly distinctive character arising from the inherent characteristics of the mark. In my opinion, the opponent’s mark is inherently distinctive for its Class 35 services, namely advertising; business management; business administration; office functions. With regard to its Class 25 goods, broadly clothing, the mark is still distinctive, but might be considered for certain goods such as gloves and belts to be indicative of the hide from which the item is sourced.

22) I have to determine who is the average consumer of the goods and services in question. The average consumer for the opponent’s services, as set out in paragraph 21 above will be businesses. The average consumer for the opponent’s goods will be the general population. The applicant’s services, can broadly be said to relate to the retailing of clothes and motoring products either in a store, via a web site or through mail order catalogues. The average consumer will be both the general population and businesses. To my mind, items such as clothing and motoring parts are not purchased without some care and consideration. Consumers will want to ensure that the size is correct, check the fabric that the items is made from, or in the case of motor products ensure that it is the alright to use on their particular vehicle or meets their safety needs. I must also take into account imperfect recollection.

23) I shall first consider the specifications of both parties.




Applicant’s Specification	Opponent’s specification
<p>Class 35: The bringing together, for the benefit of others, of a variety of motoring products and clothing and clothing accessories, enabling customers to conveniently view and purchase those goods in a retail store and/or via a corresponding web site or through mail order catalogues.</p>	<p>Class 25: Clothing, footwear, headgear.</p>
	<p>Class 35: Advertising; business management; business administration; office functions.</p>

24) Insofar as the class 35 element of the application is concerned, the opponents, in their notice of opposition, argue that these services are similar to their goods in class 25, and also to their services in class 35 i.e. “Advertising; business management; business administration; office

functions”. Whilst I note that in their counterstatement the applicant’s dispute the opponent’s latter claim (see paragraph 5 above), they are silent on the similarity between the opponent’s goods in class 25 and their retail services in class 35. This is, in my view, a sensible concession and represents an acceptance on the applicant’s part that there is a relationship between clothing in class 25 and the retailing of such goods in class 35, indeed it does no more than reflect the Trade Marks Registry’s own approach to such conflicts. That being the case, I intend to proceed on the basis that the opponent’s goods in class 25 are likely to be associated with the applicant’s services in class 35, in relation to clothing.

25) However, when considering the retailing of “motoring products” to the opponent’s class 25 goods there is no such association. The goods of the opponent are not at all similar to the services of the applicant. It is also clear that the opponent’s services in class 35 are dissimilar to the applicant’s services in Class 35. Retailing of clothing and/or motoring products are not in any way similar to the opponent’s advertising or business services. Even if I were minded to accept the expanded specification as set out by the opponent this only relates, broadly, to clothing and footwear items. It does not assist the opponent with regard to motor products.

26) I now turn to consider the marks of the two parties. The opponent relies upon all its registrations for this ground. For ease of reference the marks are reproduced below:

Applicant’s Trade mark	Opponent’s Trade Marks	
		

27) Given that both parties trade marks consist solely of devices, the visual similarity between them is clearly a crucial consideration. When considering the objections based on sections 5(1) and 5(2)(a) above I carried out an analysis of the respective trade marks (paragraph 17 refers) and concluded that the grounds of opposition based on the identity of the trade marks should be dismissed. While the respective trade marks clearly share a number of similarities, it is the first of the opponent’s trade marks shown above (the silhouetted version) that, in my view, offers the opponent the best prospect of success. Accordingly I shall base my comparison on this trade mark, for if the opponent fails in relation to this version of its trade mark it is, in my view, unlikely to succeed in relation to the non-silhouetted version of its trade mark.

28) Both trade marks consist of a silhouette of an animal with four legs visible and bearing antlers. Although the posture, the positioning of the legs, the body shapes and the depiction of the antlers differ, both trade marks are, in my view, silhouetted representations of a moose or as it is alternatively known an elk. Overall, I consider there to be a high degree of visual similarity between the respective trade marks.

29) Given my comments above, it is, in my view, highly likely that when referred to by the relevant consumer both trade marks will be described as a moose or elk. Overall, I consider there to be a high degree of oral/aural similarity between the respective trade marks. I also consider there to be a high degree of conceptual similarity between the respective trade marks.

30) The applicant's services with regard to the retail of clothing in Class 35 would be associated with the opponent's clothing goods in Class 25. There is a high degree of visual, aural and conceptual similarity between the marks. Considering the matter globally there is a likelihood of confusion and/or association. The opposition based on section 5(2)(b) of the Act succeeds accordingly.

31) With regard to the applicant's services in relation to motoring products there is a complete absence of similarity with regard to the opponent's clothing goods or advertising and business services. Nor is the average consumer likely to believe that there is an economic link or association between the two parties.

32) The overall effect of my decisions under the various grounds of opposition is that the application will proceed to registration with the following reduced specification:

“Class 35: The bringing together, for the benefit of others, of a variety of motoring products, enabling customers to conveniently view and purchase those goods in a retail store and/or via a corresponding web site or through mail order catalogues.”

COSTS

33) The opposition has mostly succeeded and the opponent is entitled to a contribution towards their costs. I order the applicant to pay to the opponent the sum of £400. 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 4th day of August 2008

**G W SALTHOUSE
For the Registrar
The Comptroller-General**

Annex

With the exception of “animal skins and hides” which appear in the Class 18 specifications of the CTM registrations, the specifications for all four registrations are identical and read as follows:

Class 3: Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.

Class 14: Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments.

Class 18: Leather and imitations of leather, and goods made of these materials and not included in other classes; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.

Class 25: Clothing, footwear, headgear.

Class 35: Advertising; business management; business administration; office functions.