

O-253-11

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION 2540830  
BY JIT INTERNATIONAL TRADE COMPANY LTD TO REGISTER THE TRADE  
MARK**

**DENKER**

**IN CLASS 25**

**AND IN THE MATTER OF OPPOSITION  
THERE TO UNDER NO 100594  
BY D&K S.r.l**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF Application No 2540830**

**By JIT International Trade Company Ltd to register the trade mark**

**DENKER**

**and**

**IN THE MATTER OF opposition thereto under No 100594 by D&K S.r.l**

**BACKGROUND AND PLEADINGS**

1. On 3<sup>rd</sup> March 2010, JIT International Trade Company Ltd (hereafter, "JIT") of 66 Corporation Road, Grangetown, Cardiff, CF11 7AW applied to register the mark DENKER in Class 25 for, "clothing, footwear, headgear".
2. The application was allocated number 2540830 and was published in the Trade Marks Journal on 9<sup>th</sup> April 2010 and on 9<sup>th</sup> June 2010 D&K S.r.l (hereafter, "D&K") of Via Bezzacca, 2, 1-50139 Florence, Italy lodged an opposition against all the goods specified above.
3. D&K has opposed on the sole basis of section 5(2)(b), citing the following earlier mark:

Mark. Filing and registration dates	Goods and services relied upon under section 5(2)(b)
M718576  <b>DEKKER</b>  Date of international registration: 19 <sup>th</sup> May 1999  Date of designation in the UK: 18 <sup>th</sup> June 2009	Class 25  Clothing, knitwear, lingerie, shirts, footwear, belts.

4. D&K say, as far as the goods are concerned, that clothing and footwear in JIT's specification are identical to the same goods in their specification and headgear is very similar to the goods in their specification. As far as the marks are concerned, neither has a meaning and so this renders them both

neutral in terms of conceptual impact. Phonetically, the marks are similar. It is generally accepted that clothing is selected visually and this makes the visual similarity the most important factor. The respective marks are both six letters long and both begin with the letters, “DE..”, and end with “...KER”. Only the third letter is different. The very close visual and phonetic similarity of the marks renders them similar. In a global assessment, given the identity or similarity of the respective goods, there is a likelihood of confusion.

5. JIT filed a counterstatement denying likelihood of confusion. It says the respective marks are completely different, visually, phonetically and conceptually. It notes the visual and phonetic differences and says that, conceptually, ‘DENKER’ means, in German, ‘thinker’, ‘the nation of poets and philosophers’, according to Collins German Dictionary & Grammar. Thus, its mark at least will have some conceptual resonance.
6. As to the goods, its main products are childrens’ garments, but the opponents are clothing, knitwear, lingerie, shirts, footwear and belts. These are not the same. It also says it has invested a lot of money in ‘promoting the publicity of DENKER’ and has used the logo on all of its products, photographs of which are produced at attachment 2 to the counterstatement.
7. No evidence was filed by either party but submissions were received from the opponent which I shall take into account below. No hearing was requested by either party and so I give my decision based upon a careful reading of the papers.

## **DECISION**

### **Section 5(2)(b)**

8. The opposition is founded upon Section 5(2) (b) of the Act. This reads:

“(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.”

9. D&K’s mark is an protected international trade mark(UK) which has a date of application earlier than that of JIT’s application. Perhaps I should say that, as

an international mark designating the UK it is not, strictly speaking, appropriate to talk of D&K's mark as having a 'date of application' in the sense a domestic application may have. By virtue, however, of Section 6(1)(a) of The Trade Marks Act 1994 and Section 3 of The Trade Marks (International Order) 2008, it is plain that, as from the date of its designation in the UK, it is to be accorded the same rights as if it were a mark registered under domestic provisions. Moreover, given its date of designation in the UK is within 5 years of the publication of the application, it is not subject to proof of use requirements.

10. In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the Court of Justice of the European Union ("CJEU") in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P* (LIMONCELLO). It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, 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, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either *per se* or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) 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;

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.

### ***The average consumer and nature of the purchase***

11. The average end consumer for both parties' products, in a notional sense, will be the clothes buying general public. The average consumers for the respective marks will thus be identical.

12. Being personal items, clothes are generally purchased with some degree of consideration and case law recognises that buying clothes is also predominantly a visual activity, as supported by, eg General Court ("GC") Case T-57/03 *SPAG SA v OHIM* and *REACT* Trade Mark [2000] RPC 285. This does not mean of course that, in my later analysis, phonetic and conceptual comparisons can be ignored, or even downplayed, but the public is used to selecting clothing by sight, whether that be in a traditional high street retail environment, online or through other means such as a catalogue. These observations will be factored into my considerations below, as and when appropriate.

### ***Comparison of marks***

13. The case law makes it clear I must undertake a full comparison, taking account of visual, phonetic and conceptual similarities and dissimilarities,

from the perspective of the average consumer. Marks need to be considered in their totalities and taking account of overall impression (see authorities (c), (e) and (f) above in para 10), given recognition to distinctive and dominant elements.

### **Visual comparison**

14. JIT's mark is a single, six letter word, DENKER. D&K's mark is also a single, six letter word, DEKKER. The respective words start with the same letters, "DE..." and end with the same three letters "...KER". The only difference is that JIT's mark has an 'N' instead of a 'K' in the middle. Taking the similarities and dissimilarities into account, I find the respective marks to be visually similar to a high degree.

### **Phonetic comparison**

15. JIT's mark will be pronounced 'DEN-KER', whereas D&K's mark will be pronounced 'DECK- ER'. I find that the respective marks are, taking the similarities and dissimilarities into account, phonetically similar to a high degree. This is because the only difference between them occurs in the middle of the word and this can be easily masked or misheard in normal speech.

### **Conceptual comparison**

16. By conceptual similarity, it is meant 'semantic' conceptual similarity. JIT says 'DENKER' has a meaning in German – that of 'thinker', 'the nation of poets and philosophers'. Unfortunately the German dictionary which provides evidence of this meaning has been omitted from the counterstatement but I nonetheless accept this to be true. The difficulty with this submission however, is the test is not what may be evidenced from a foreign dictionary that matters, but what the average clothes buying, English- speaking consumer in the UK may perceive to be the semantic underlying 'concept'<sup>1</sup>. It is dangerous to impute such knowledge of the German language to the average English speaking consumer. I do not believe the word 'DENKER' would be seen by the relevant consumer as a German word, meaning, in English, 'thinker'. On the contrary, my view would be that it would be seen as an invented word.
17. As for D&K's mark 'DEKKER', I believe this also would also be seen as an invented word. It is possible it would be seen as a name, as in the late DESMOND DEKKER, Jamaican musician. However, that again, would be to impute knowledge to the average consumer which may not be present. It is far safer to conclude that DEKKER would also be regarded by the relevant consumer as an invented word.

---

<sup>1</sup> See, eg Para 37 of BL O/048/08 'CHORKEE' – a decision of the Appointed Person

18. On that basis, there can neither be conceptual similarity nor dissimilarity as neither mark would convey any precise meaning or otherwise be seen to be derived from any known meaning or other reference.

### **Overall similarity of marks**

19. I need to bring my individual findings above into an overall assessment of similarity of marks, bearing in mind of course I have recognised that the selection of clothes is primarily a visual selection, but without ignoring or downplaying phonetic or conceptual comparisons. Taking all factors into account I find the respective marks are similar to a high degree.

### **Comparison of the goods**

20. In assessing the similarity of the goods, it is necessary to apply the approach advocated by case law and to take account of all the relevant factors relating to the services in the respective specifications. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at para 23 of the Judgment:

‘In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature and their method of use and whether they are in competition with each other or are complementary.’

21. Other factors have been identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281, such as the nature of the users and the channels of trade.

22. It is important to recognise that even though the factual evidence on similarity is non-existent, I nevertheless have the statements of case, submissions and am able to draw upon commonly known facts. Mr Geoffrey Hobbs QC sitting as the Appointed Person, said in *Raleigh International trade mark* [2001] R.P.C. 11, at para 20, that such evidence will be required if the goods or services specified in the opposed application for registration are not identical or self-evidently similar to those for which the earlier trade mark is registered. But where there is self-evident similarity, and especially in relation to everyday items, evidence may not be necessary.

23. The relevant goods to be compared are:

JIT's goods	D&K's goods
<p><b>Class 25</b></p> <p>Clothing, footwear, headgear</p>	<p><b>Class 25</b></p> <p>Clothing, knitwear, lingerie, shirts, footwear, belts</p>

24. Plainly, 'clothing' and 'footwear' are identical in the respective specifications. JIT also has 'headgear' which is not expressly covered in D&K's specification. Some types of headgear may well constitute 'clothing' in the sense, eg it protects against the elements or is purchased as a fashion article to match an outfit, and thus fulfils, at least, a complementary role to clothing. Accordingly, in the latter role especially, not only are the end users identical but so also is the respective purpose (fashion item) of the goods. Moreover, the distribution channels are sometimes identical and their sales outlets or the retail departments from which they are sold are often either the same or closely connected. On that basis, I find that headgear is identical or highly similar to clothing.<sup>2</sup> I also note D&K has 'knitwear' in its specification and this too may include certain items of headgear, such as a bobble hat for example.

25. At this point I need to address JIT's submission that its clothing is childrens' clothing specifically. It is well established<sup>3</sup> that what matters here is a notional comparison based upon each parties' specification and not what each party may actually use its respective marks upon. I would just note that even if JIT's specification had been limited to children's clothing for example, this would not have prevented a finding of identity, given that D&K's specification covers clothing at large.

26. So, to bring my findings together, I find that all of JIT's Class 25 goods are either identical to or, in the case of headgear, identical or highly similar to D&K's goods.

***Likelihood of confusion***

27. Before proceeding to bring all my findings together in an overall global assessment, I need to make an assessment of the distinctive character of the

---

<sup>2</sup> A finding consistent with the approach taken by OHIM, see, eg Opposition B 1 678 724 dated 17<sup>th</sup> March 2011 (*Brova BV v Fabio Manfredi*)

<sup>3</sup> See, eg *Origins Natural Resources Inc v Origin Clothing Ltd* [1995] FSR 280 at page 284, which although referring specifically to section 10 of the Act, nevertheless applies also to the likelihood of confusion test I am required to undertake in this case.



earlier mark. An invented word having no derivation from known words is, in its inherent characteristics, very high on the scale of distinctiveness, KODAK being the prime example.

28. The earlier mark is the word, DEKKER. It would be seen, as I have said, as an invented word bearing no relation to the goods upon, or in relation to which, it would be used. On that basis I find it to have a very high level of inherent distinctiveness. There is no evidence from D&K as to the use they have made of their mark and so I cannot find that the level of inherent distinctiveness is enhanced through use.
29. At this point I need to remind myself of my various findings and bring them together in a global assessment taking, of course, into account, the doctrine of imperfect recollection, namely that consumers rarely have the opportunity to compare marks side by side.
30. I have found that the respective goods are identical or highly similar. I have made observations on the respective average consumers, namely that they are also identical and I have found the purchasing process to involve considered purchasing, through primarily visual means. Finally, I have found the respective marks to share a high level of similarity. Needless to say that in making a global assessment, it is not a 'tick box' exercise, whereby if I find more factors in one parties favour, it inevitably wins. All factors must be weighed in the evaluation of likelihood of confusion.
31. Nonetheless, in all the circumstances **I find there is a likelihood of confusion in this case and the opposition succeeds in its entirety.**
32. I should mention that I have considered also arguments put by JIT in their counterstatement to the effect that they have invested a lot of money in their logo and that the opposition is in some way 'unreasonable' on the part of the opponent. The question of the investment by the applicant in their logo is not a factor in my assessment of likelihood of confusion.

### **Costs**

33. D&K has been totally successful in its opposition. Accordingly, it is entitled to a contribution towards its costs and neither party sought costs off the normal scale. In the circumstances I award D&K S.r.l the sum of £700 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

1. Statutory fee for filing opposition - £200
2. Considering counterstatement- £ 200
3. Filing written submissions - £300

Total £700

34. I order JIT International Trade Company Ltd to pay D&K S.r.l the sum of £700. The sum should 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 21<sup>st</sup> day of July 2011**

**Edward Smith  
For the Registrar,  
the Comptroller-General**