

O-266-11

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2530261
BY
FIGHT STUFF LIMITED
TO REGISTER THE TRADE MARK**



IN CLASSES 25, 28 AND 35

AND

**THE OPPOSITION THERETO
UNDER NO 100235
BY
DEAN ROGERS**

Trade Marks Act 1994

**In the matter of application 2530261
by Fight Stuff Limited
to register the trade mark:**



**in classes 25, 28 and 35
and the opposition thereto
under no 100235
by Dean Rogers**

1. Fight Stuff Limited (“the applicant”) applied to register the above trade mark on 30 October 2009 for the following goods and services in classes 25, 28 and 35¹:

Sportswear, particularly, T-shirts, boxing shorts for Thai Boxing (Muay Thai), boxing shorts.

Sports equipment, particularly, boxing equipment, fitness equipment.

Advertising; business management; business administration; office functions; administrative services.

2. The application was published on 4 December 2009 in the *Trade Marks Journal*, following which a partial opposition was filed by Mr Dean Rogers. The opposition is directed only at the class 25 and 28 goods of the application. Mr Rogers claims that the applications offend sections 5(1), 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). These state:

“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 –

¹ As per 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.

(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.”

(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC), in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

3. Mr Rogers relies upon the following goods of his registered trade mark (number 2416818) for the grounds of opposition under sections 5(1) and 5(2)(b):

Mark: KING BOXING

Class 25: *Clothing, footwear and headgear including tracksuits, track pants, shorts, vests, sport vests, polo shirts, sweatshirts, hoodies, coats, socks, T-shirts, sport shirts, headwear, caps, woolly hats, knitted hats, beanie hats, trainers, training shoes, training boots, boxing boots.*

Class 28: *Games and playthings, sporting goods and equipment for use in boxing, including boxing gloves, punch bags, speed balls, weights, boxing wraps, skipping ropes, focal mitts, kick pads, kickboxing equipment.*

In relation to class 28, Mr Rogers confines his attack to sports equipment, boxing equipment and “fitness equipment that covers skipping ropes, focus pads, kick pads, weights and punchbags”. In relation to the ground of opposition under section 5(3), Mr Rogers relies upon the above trade mark but only in respect of *boxing gloves, headguards²; t-shirts, skipping ropes; boxing equipment*. Mr Rogers claims that the application is identical or similar to his trade mark; that the word KING is prominent in the application, and that the application covers the same goods in classes 25 and 28 as his registration. Mr Rogers claims that he has sold his goods under his trade mark KING BOXING in the UK since 2006. He claims that the application would be detrimental to the sales and reputation of his mark as a high quality brand because he would not be able to control the

² These are in class 9 of Mr Roger’s trade mark registration on which he has not pleaded reliance.

quality of the applicant's goods. He claims that there would be confusion: a purchaser would be looking for "KING" products.

4. Mr Roger's mark was applied for on 16 March 2006 and its registration procedure was completed on 22 May 2009: consequently this is an earlier trade mark which is not subject to proof of use³ because at the date of publication of the application it had been registered for less than five years. The significance of this is that Mr Rogers' registration can be taken into account across the full breadth of the goods relied upon (classes 25 and 28) on the basis of notional and fair use of the terms in his specifications.

5. The applicant filed a counterstatement, denying the grounds. The essence of the counterstatement is as follows. The applicant claims that TOP KING BOXING is a world renowned Thai brand and that the applicant is the official dealer for TOP KING in the UK and Ireland. It claims it is not trying to pass off or copy KING BOXING goods because to do so would be detrimental to the reputation for high quality of its own goods. The majority of the applicant's customers come from a Muay Thai boxing background and want to buy Muay Thai goods; there would be no confusion in the market-place with KING BOXING goods because the product lines and logos of the applicant and Mr Rogers are totally different. The applicant claims that its TOP KING goods are of a higher quality than Mr Rogers' KING BOXING goods and that Mr Rogers is selling "off the back of" TOP KING's success. This is tantamount to a counterclaim and is not something that can be considered in these proceedings, which are based upon whether the application should be registered in the face of the earlier mark relied upon, as per the wording of sections 5(1), 5(2)(b) and 5(3), as quoted above in paragraph 2. No separate claim as to the validity of the earlier mark has been made.

6. Both sides filed evidence. Neither side asked for a hearing, both being content for a decision to be made from the papers on file. Mr Rogers filed written submissions in lieu of a hearing.

Evidence

7. Mr Rogers has provided two witness statements. Some of the content is submission, which I bear in mind in making my decision. A summary of his factual statements follows.

8. He states that he has been using the mark since October 2006 on T-shirts and since April 2007 on boxing bag gloves, boxing shorts, boxing gloves, focus pads, a 'corner mens jacket' and a 5ft punch bag. Exhibits 1 to 7 show examples of such use. Mr Rogers KING BOXING goods are sold throughout the UK to individuals, clubs and trade retailers, such as Fighting Fit City Gym

³ See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

(Birmingham), The Boxing Clinic (London), Bobby Quinn, Muay Thai Boxing Academy (Scotland), Gumshield Boxing Supplies (London) and Boxfit UK (Essex) (exhibits 8 and 9 show web pages from these outlets, although they are dated after the relevant date, which is the date on which the applicant's trade mark application was made), Hook & Jab Centre (Warrington), TKO Kickboxing Club, Mike Jones Boxing Club (South Wales), Sittingbourne ABC Boxing Club, Westree ABC Boxing Club, Ramsgate ABC Boxing Club, Herne Bay Judo Club, Semtex Gym Muay Thai, Dynamite Kickboxing Club, Frome ABA Boxing Club and UK Warriors Gym Muay Thai. Mr Rogers states that the goods are also sold via his own online store, a print from the home page of which is shown at exhibit 10 (dated after the relevant date).

9. Mr Rogers states that the KING BOXING mark has been advertised extensively in magazines and at events. An example from Fighters Magazine December 2007 is shown at exhibit 11 and a photograph of the KING BOXING stand at a Seni show in April/May 2007 is shown at exhibit 12. The Seni show is for enthusiasts of boxing, kickboxing, Muay Thai and other martial arts. Mr Rogers states that the evidence shows that the mark is used on Muay Thai products and also states that there has been evidence that the applicant's mark has been confused with his own mark on eBay. Mr Rogers has filed a witness statement from Mr Colin Payne dated 27 April 2011, who is an instructor and owner of the TKO Kickboxing Academy in Kent. Mr Payne states that he recommends KING BOXING boxing equipment for its quality, but that over the past year some of his students had purchased TOP KING BOXING products believing them to be KING BOXING products.

10. Mr Rogers states that many top sportmen and women use his KING BOXING goods. Some of these are shown in the exhibited pictures wearing KING BOXING boxing gloves, such as David Haye, WBA World Heavyweight Champion using KING BOXING pads in October 2009, and November 2010; Savannah Marshall ABA Champion, 2009 EU Champion shown in the Daily Telegraph in August 2009 and James Deagle ABA Champion, Olympic Gold Winner, professional boxer pictured in June 2009.

11. The applicant's evidence comes from Mr Robert Stansfield, who is the applicant's director and a UK distributor for Top King Boxing Co Ltd in Thailand. Mr Stansfield's witness statement follows the format of Mr Rogers' witness statement. He lists the goods for which he is seeking registration, exhibiting pictures and claiming first use of them in August 2009: boxing gloves, Muay Thai shorts, bag gloves, focus pads, corner mens jackets, shin guards and T-shirts. Mr Stansfield states that TOP KING BOXING products are sold throughout the UK and the world. Examples of UK sellers of his products are FightStoreMMA.co (Newcastle), FightShop.com (Manchester), MuscleBoundUK.net (Scotland) and RawMuayThai.co.uk (Westcliffe-on-Sea); web prints from the online shops of these are exhibited. Mr Stansfield gives as examples of some of the clubs he has been supplying with TOP KING BOXING products as Diesel Gym (London),

SDF (Sheffield), St Helen's Muay Thai, Thaitans Muay Thai (Redditch), K-Star Muay Thai (Birmingham), Alex Foreman (Liverpool) and Belfast Muay Thai. Mr Stansfield states that the goods are also sold via his own online store, a print from the home page of which is shown at exhibit 19.

12. Mr Stansfield states that the mark has been advertised extensively and that TOP KING BOXING sponsors top ranked Muay Thai fighters, such as Julie Kitchen (13 times world champion), Liam Harrison (3 times world champion), Imran Khan (twice world champion) and Andrew Thrasher (twice world champion). Pictures of these fighters are shown on the TOP KING BOXING website.

Decision

13. Section 5(1)

For a mark to fall foul of section 5(1), it must be identical to an earlier mark for identical goods or services. The Court of Justice of the European Union ("CJEU") stated in *LTJ Diffusion SA v Sadas Vertbaudet SA* Case C-291/00:

"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."

The section 5(1) ground of objection is plainly unsustainable owing to the presence in the application not only of the word TOP (in addition of KING BOXING), but also the presentation of the words, the crown and the 'flame' devices which means that the marks cannot be considered as identical. As this ground of opposition fails, I will go on to look at the ground under section 5(2)(b).

14. Section 5(2)(b)

The leading authorities which guide me in this ground are from the CJEU: *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, *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; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, 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.*,

(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*,

(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*,

e) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

f) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*.

(g) 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*,

(h) 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*,

(i) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(j) 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*,

(k) 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 and Adidas Benelux BV*,

(l) 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.*

15. Comparison of goods

In comparing the respective specifications, all relevant factors should be considered, as per *Canon* where the CJEU stated at paragraph 23 of its 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, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

If goods and services fall within the ambit of terms within the competing specification, they are considered to be identical (see *Gérard Meric v Office for Harmonization in the Internal Market (OHIM)*, General Court (“GC”), case T-133/05, at paragraph 29:

“In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

16. Class 25

Application: *Sportswear, particularly, T-shirts, boxing shorts for Thai Boxing (Muay Thai), boxing shorts.*

Mr Rogers has cover, *inter alia*, in his registration for clothing, shorts and t-shirts. The application includes sportswear, which is covered by the more general category of *clothing* in Mr Rogers’ specification. The application also covers t-shirts, the identical term also appearing in Mr Rogers’s specification. Boxing shorts and boxing shorts for Thai Boxing (Muay Thai) are covered by the more

general categories of clothing and shorts in Mr Rogers' specification. All the class 25 goods in the application are therefore identical with the class 25 goods of Mr Rogers' earlier registration.

17. Class 28

Application: *Sports equipment, particularly, boxing equipment, fitness equipment.*

Mr Rogers has cover, *inter alia*, for sporting goods and equipment used in boxing. The application covers sports equipment, which is identical in scope to *sporting goods*, and boxing equipment which is identical to *equipment for use in boxing*. Fitness equipment would appear to be a sub-set of sports equipment and is, in that respect, identical⁴. All the class 28 goods in the application are identical with the class 28 goods of Mr Rogers' earlier registration.

18. Average consumer and the purchasing process


The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect, but his level of attention is likely to vary according to the category of goods. The average consumer for clothing and sporting goods is the general public. For the specific goods relating to boxing, including Thai boxing, the average consumer may be more specialist and may therefore pay a greater degree of attention than would be the norm for clothing and sporting goods, but not the very highest degree of attention. Overall a reasonable level of attention will be paid to the purchase of clothing and sporting goods, the purchase of which will be primarily visual, but oral use of the mark may also play a part.

19. Comparison of trade marks

The authorities direct that, in making a comparison between the marks, I must have regard to each mark's visual, aural and conceptual characteristics. I have to decide which, if any, of their components I consider to be distinctive and dominant, without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

⁴ As regards the application's fitness equipment, Mr Rogers' notice of opposition limits his attack to "fitness equipment that covers skipping ropes, focus pads, kick pads, weights and punchbags". As there has been no limitation of the term fitness equipment in the application away from these specific goods, the opposition is effectively against the term fitness equipment as the specific goods are included in the general term, as per *Gérard Meric*.

20. The marks to be compared are:

Mr Rogers' mark	Application
KING BOXING	

Mr Rogers' mark is composed of two word elements, one of which (BOXING) merely denotes clothing and sporting goods for boxing. This element is neither dominant nor distinctive: the dominant distinctive element of Mr Rogers' mark is KING. KING is the prominent constituent of the application: it is central in its position, and is much larger than the other words, TOP and BOXING. The crown element and the 'flame' devices are also dominant distinctive elements, but to a lesser degree than KING. Both marks therefore share the same dominant distinctive element, although I do not ignore the other elements of the application as they are far from negligible.

21. Visually, there is more to the applicant's mark than there is to Mr Rogers' mark. The visual points of similarity are KING and the word BOXING, although the latter is proportionately small in the application. Two elements of the application are therefore the same as the entirety of Mr Rogers' mark. Owing to the embellishments present in the application, the visual similarity between the marks is of a reasonable rather than a high degree. However, aurally the devices cannot be factored into this comparison because they are 'silent'. The only aural difference between the marks is the word TOP: the remainder of the marks are aurally identical. Taking into account the fact that the word TOP will be heard first in the application so that the comparison is between TOP KING BOXING and KING BOXING, there is a good deal of aural similarity between the marks.

22. In relation to conceptual similarity, that is to say what the meaning is of the marks, they are similar to a high degree, notwithstanding the embellishments or device elements. BOXING denotes a class of goods (goods for use in boxing). KING is a well known dictionary word meaning male monarch. Both marks have this concept; it is slightly laudatory – these are the 'king' of boxing goods. This meaning is shared and, indeed, reinforced in the application by the presence of the crown device. KING is also a surname, so the concept in the earlier mark could also be boxing goods sold by someone named KING. Both marks contain

the word BOXING, hence they are both KING BOXING marks. The word TOP in the application does not detract from the high degree of conceptual similarity because it simply denotes quality, 'top' being a synonym for best. Taking all these factors into consideration, the marks are similar to a reasonably high degree.

23. Distinctiveness of Mr Rogers' mark

It is necessary to consider the distinctive character of the earlier mark because the more distinctive it is, either by inherent nature or by use (nurture) the greater the likelihood of confusion⁵. The distinctive character of Mr Rogers' trade mark must be assessed by reference to the goods for which it is registered and by reference to the way it is perceived by the relevant public⁶. Although Mr Rogers has provided some evidence of the mark in use before the relevant date, this is scant and there are no turnover figures and/or customer numbers to show the extent of use. The evidence falls a long way short of establishing use which would entitle it to an enhanced level of distinctive character so I have only the mark's inherent distinctiveness to consider. BOXING denotes a class of goods for which the registration has cover and so has no distinctiveness for these goods. KING is a dictionary word and a surname. It does not describe or even allude to any characteristic of Mr Rogers' goods, although it is a common surname. Overall, KING BOXING is distinctive to a good degree.

Likelihood of confusion

24. In deciding whether there is a likelihood of confusion between the marks, I must weigh the various factors I have identified and also bear in mind the principle of interdependency, whereby a lesser degree of similarity between the services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon*). I have found identity between the respective goods. It cannot assist the applicant that it refers to Muay Thai boxing in its specification as the remainder of the goods are unlimited and so are identical to the unlimited goods of Mr Rogers. Further, Mr Rogers is entitled to use his mark on Muay Thai goods, whether or not he is currently, because he has cover for all types of clothing and sporting goods. In fact, his evidence shows that he has been or is still offering Muay Thai boxing goods.

25. I bear in mind the whole mark comparison and the dominant and distinctive elements within the marks. I should guard against dissecting the marks so as to distort the average consumer's perception of them; the average consumer perceives trade marks as wholes and rarely has the opportunity to compare marks side by side, relying instead upon the imperfect picture he has of them in

⁵ *Sabel BV v Puma AG* [1998] RPC 199.

⁶ *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

his mind. Both marks share the same dominant distinctive component, the meaning of which is capable of immediate grasp, the concept of a male monarch. Although the application contains the embellishments to the sides and the crown device (which reinforces the meaning of King) KING is the dominant and most noticeable part of the mark. The conceptual hook in the average consumer's mind which will be remembered is 'KING'. 'Top' KING BOXING is a natural brand extension or a variation in the marks which would cause the average consumer to expect the undertaking responsible for each mark to be economically connected. Even in relation to boxing goods, for which a higher level of attention may be paid, there will be a perception that the same undertaking is offering the goods under a more elaborate/plainer version of its mark. The similarities between the marks, combined with the identical goods offered under both marks, will give rise to indirect confusion. Not only do I consider that there is a likelihood of confusion, but I consider that confusion would be inevitable.

26. The opposition succeeds under section 5(2)(b); the mark is refused for the goods in classes 25 and 28 and may proceed to registration for the class 35 services, which were not opposed.

27. There is, strictly, no need for me to assess whether Mr Rogers would also be successful under section 5(3), but I will comment here that his evidence would be insufficient to meet the test for reputation required by that ground, as set out in *General Motors Corporation v Yplon SA* [1999] E.T.M.R. 950:

“24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector.

25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

26. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.”

Costs

28. Mr Rogers has been successful and is entitled to an award of costs which are on the basis of contribution rather than compensation. I bear in mind that Mr Rogers has not incurred the costs of having to employ a professional legal advisor and I therefore reduce by 50% what I otherwise may have awarded (except for recompensing Mr Rogers for the opposition fee). Following the published scale⁷, the costs breakdown is:

Preparing a statement and considering the other side's statement	£150
Preparing evidence and submissions	£250
Opposition fee	£200
Total:	£600

29. I order Fight Stuff Limited to pay Dean Rogers the sum of £600. 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 01 day of August 2011

**Judi Pike
For the Registrar,
the Comptroller-General**

⁷ As per the scale in Tribunal Practice Notice 4/2007.