

O/438/11

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO 2 534 586

**IN THE NAME OF BUCKLER TEKSTIL DIZAYN PAZARLAMA VE DIS TICARET
SANAYI LIMITED SIRKETI**

TO REGISTER IN CLASS 25 THE TRADE MARK: ANDREW BUCKLER

AND

OPPOSITION THERETO UNDER NO 100 692

BY BUCKLER LIMITED

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The Background and Pleadings


1. Buckler Tekstil Dizayn Pazarlama Ve Dis Ticaret Sanayi Limited Sirketi (the applicants) applied to register the trade mark ANDREW BUCKLER on 17th December 2009. The application was published in the Trade Marks Journal on 9th April 2010 in respect of the following goods in class 25: *clothing, footwear, headgear.*

2. Buckler Limited oppose the registration on the basis of the following earlier trade marks:

- No 2 166 033: , registered in respect of *articles of clothing; footwear;*



- No 2 368 249: , registered in respect of *articles of protective and safety clothing, footwear and headgear for protection against accident and injury;*

- No 2 445 385: , registered in respect of *articles of protective and safety clothing, footwear and headgear for protection against accident and injury;*

3. The grounds upon which the opposition is based are as follows:
 - Under Section 5(2)(b) of the Trade Marks Act 1994 (“the Act) in that the contested goods are identical and or similar to those of the earlier trade marks. Further, that the respective trade marks are similar. As such, there is a likelihood of confusion;
 - Under Section 5(3) of the Act as the opponent has established a significant reputation in the word BUCKLER in respect of clothing, footwear and headgear in the United Kingdom and that use of the contested trade mark would take unfair advantage and be detrimental to the distinctive character of the opponent’s trade marks.
 - Under Section 5(4)(a) of the Act on the basis of the earlier trade marks, namely those which correspond in appearance to its earlier registered trade marks as displayed above. According to the statement of case, the opponent has acquired a significant goodwill over 12 years of use in the United Kingdom. Use by the applicant of the contested trade mark would amount to a misrepresentation and inevitable damage to the earlier trade mark.
4. The applicants filed a counterstatement denying the grounds of opposition. In particular, the applicants argue that Andrew Buckler is a shareholder of the applicant company, is entitled to use the name Andrew Buckler and its use is therefore in accordance with honest practices in accordance with Section 11(2)(a) of the Act. Further, though it is accepted that the goods overlap, the marks are different visually, aurally and conceptually, so there is no likelihood of confusion. In respect of the goods, it is argued that they operate in different areas of the marketplace. The opponent is put to proof as to any use, goodwill or reputation in respect of its earlier trade marks and so the grounds of opposition under Section 5(3) and 5(4)(a) are also denied. Both sides filed evidence and no hearing was requested. I therefore give this decision following careful consideration of the papers.

The Opponent’s Evidence

5. This is a witness statement, dated 15th December 2010, from Andrew Duncan, a Director of the opponent company. The statement is a mixture of evidence and submissions, the latter which I will not summarise here but will refer to as and when appropriate during my decision. As regards evidence, the following relevant information is contained therein:
 - According to Mr Duncan, the opponent has been using its trade marks since January 1998 in relation to the sale of footwear, clothing and headgear and has also since that time invested heavily in the marketing and promotion of its

brand. Turnover figures and details of advertising spend are provided and are as follows:

Year	Turnover (million)	Advertising spend (thousand)
2002	1.2	19.5
2003	1.18	24.4
2004	1.175	1.36
2005	1.36	29.6
2006	1.42	24.1
2007	1.64	22.3
2008	1.77	20.9
2009	1.70	41.5
2010	2.10	33.31 (estimated)

- Mr Duncan explains that the opponent issues between 17,000 and 20,000 product catalogues each year, examples of which are included in the evidence at Exhibit AD1. I note that these catalogues are dated from 2004 to 2009 and contain examples of use of the earlier trade marks in respect of a range of protective clothing and footwear products as well as some examples of use on headgear which are marketed as being accessories to the aforementioned protective items. Additionally, I note that there is use of the earlier trade marks specifically in respect of non-safety, regular footwear. This non-safety aspect is highlighted in some of the catalogues. Mr Duncan also described thousands of leaflets are distributed at four week intervals, examples of which are included in Exhibit AD2. These are in respect of protective footwear. The opponent also advertises in publications such as The Professional Builder and achieved the “Top Products Award” from that publication in 2004. Exhibit AD3 refers to the award and again, protective footwear is displayed. Mr Duncan refers to exhibitions attended by the opponent and also asserts that the products sold under the earlier trade marks are supplied to around 1,200 stockists in the United Kingdom, covering all the major towns and cities.

- Finally, Mr Duncan makes reference to customers of the opponent who had contacted it following exposure to the applicant's products to enquire as to whether they originated from the opponent.

The applicant's evidence

6. This is comprised of two witness statements. The first is from Andrew William Buckler, a director and shareholder of the applicant company. The statement is a mixture of evidence and submissions, the latter of which I will not summarise here, but will refer to as and when appropriate during my decision. As regards evidence, the following relevant points are contained therein:
 - Mr Buckler explains that he is a mens fashion designer and created and launched the BUCKLER and ANDREW BUCKLER clothing range in 2001. Since then, clothing, footwear and headgear under the ANDREW BUCKLER brand name has been sold internationally including the UK. It has been sold in UK stores such as Harrods, Harvey Nichols and Selfridges. There is evidence of what Mr Buckler refers to as a "flagship" store in London, details of which are shown at Exhibit AB1. I note that this appears to be operating under the term BUCKLER.
 - Press coverage of the opening of the London flagship store is shown at Exhibit AB3; coverage in national newspapers is demonstrated in Exhibit AB2 and AB3 and Exhibit AB4 contains a price list, details of products sold in the UK in the Autumn/Winter 2007 season, together with examples of invoices;
 - Mr Buckler explains that the approximate total turnover and advertising spend under the ANDREW BUCKLER mark in the UK over the last four years is as follows:

Year	Turnover (£ thousand)	Advertising spend (£ thousand)
2007	110,000	20,000
2008	270,000	35,000
2009	140,000	5,000
2010	125,000	5,000

- According to Mr Buckler, products are also sold through the website www.andrewbuckler.com ; clothing collections have been shown at, for example, London Fashion Week and at a number of international trade shows. According to Mr Buckler, this demonstrates that the applicant's

products operate at the high end of the fashion market as opposed to those of the opponent which are exclusively in respect of safety wear.

- Finally, at Exhibit AB5 shows examples of celebrities wearing the applicant's products in the UK and internationally.
7. The second witness statement is from Iain Richard Connor, a solicitor at Pinsent Masons LLP who is the applicant's representatives in these proceedings. This statement is comprised of submissions which I will not summarise here but which have been fully taken into account in reaching this decision.

Opponent's evidence-in-reply

8. These are witness statements, dated 24th and 29th June 2011 from Bill Tennant, a trade mark attorney of Tennant IP, the opponent's representatives in these proceedings. The statements are overwhelmingly comprised of submissions which will not be summarised here but which have been taken fully into account. The evidence contained therein is as follows:
- An extract contained within Exhibit BT1, from the Electoral Roll Search on the Directory Enquiries website showing that 41 people in Scotland and 80 people in London have the surname BUCKLER;
 - Exhibit BT2 contains letters from customers (the same customers are referred to in Mr Duncan's witness statement above) who state they saw the applicant's products on sale in clothing outlets and that on seeing them, telephoned the opponent to enquire as to whether they originated from the opponent.

DECISION

Likelihood of Confusion – Section 5(2)(b)

Preliminary remarks

9. The applicant argues that the contested trade mark is its own name and so it is entitled to use it in accordance with honest practices, as outlined in Section 11(2)(a) of the Act. Section 11(2)(a) reads as follows:

11 (1) A registered trade mark is not infringed by the use of another registered trade mark in relation to goods or services for which the latter is registered (but see section 47(6) (effect of declaration of invalidity of registration)).

(2) A registered trade mark is not infringed by -
(a) the use by a person of his own name or address.

(b)

(c)

provided the use is in accordance with honest practices in industrial or commercial matters.

10. The key point here is that Section 11(2)(a) refers to trade mark infringement, which is not the issue of these proceedings. The so-called “own name” defence cannot amount to a right to registration which is what the applicant appears to be arguing here. As such, its claim must be set aside.

Proof of Use

11. In opposition proceedings, earlier marks for which the registration procedure was completed before the five year period ending with the date of publication of the applied for mark may only be relied upon to the extent that they have been used (or that there are proper reasons for non-use)¹.

12. The applicant’s mark was published on 9th April 2010. The opponent’s rely on three earlier trade marks. No 2 166 033 completed its registration procedure on 4th January 1999 and No 2 368 249 on 24th December 2004 therefore, the proof of use regulations do apply to these marks. These earlier marks will, consequently, be considered for its specification to the extent for which use of the trade mark can be proven. However, the remaining earlier trade mark No 2 445 385 completed its registration procedure on 27th July 2007 and so in respect of this trade mark, the proof of use provisions do not apply. As such, this trade mark will be considered for its specification as it is registered.

13. In relation to proof of use, the relevant legislation reads:

“6(A) (2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

¹ 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.

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

14. The relevant period for the purposes of demonstrating genuine use is the five year period ending on the date of publication of the contested trade mark application. This is, therefore, 10th April 2005 to 9th April 2010.

Assessment of the opponent’s evidence of use

15. In this regard, I note that the earlier trade mark No 2 368 249 which is subject to the proof of use regulations do not further advance the opponent’s case than No 2 445 385 which is not subject to the regulations. Both the marks and goods are identical (albeit in the case of No 2 368 249 the earlier trade mark is a series, one of the series appearing in the colour red, though nothing turns on this fact). As such, I will only assess the evidence of use in respect of the earlier trade mark No 2 166 033.

16. In respect of earlier trade mark No 2 166 033, the evidence must demonstrate that there has been use of the trade mark in respect of the goods, upon which the opposition is based, namely the following:

Class 25:

Articles of clothing; footwear.

17. I have already listed the evidence filed above and so will not repeat here. I note from the catalogues and leaflets filed, that the overwhelming majority of use is upon safety wear and protective clothing. As such, even though turnover figures and details of advertising spend are provided, there is no differentiation as to product type and so I cannot ascertain whether any of

these figures relate to regular clothing and/or footwear, that is, those items that do not have a safety or protective function.

18. However, in a number of the catalogues included at Exhibit AD1, I note specifically, that non-safety footwear is displayed. Further that this is not merely a token item such as a sole pair of boots, but that there is a variety of different types and styles of boots for the consumer to choose from. These are clearly listed and marketed as “non-safety” in the catalogues and appear across a range of dates, in 2004, 2005, 2007 and 2009. To my mind, the evidence filed, though not particularly exhaustive, does demonstrate that the earlier trade mark has been used in respect of class 25 goods. However, the evidence does not show that there has been genuine use across the whole range of class 25 goods for which the earlier trade mark is registered. For example, there is no clear use in respect of regular articles of clothing (over and above those that have a safety wear/protective function). This leaves “footwear” at large and in this respect, I bear in mind the guidance in the judgment of the General Court in T-126/03 ‘ALADIN’, particularly the following:

“If a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories relating to which the goods or services for which the trade mark has actually been used actually belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition”.

19. In my view, the category of footwear is broad enough for it to be possible to identify within in a number of sub-categories as there is a wide range of differing types of goods, all of which can correctly classified within the broader category of footwear, for examples, shoes, boots, slippers, sandals. The opponent has demonstrated genuine use in respect of a variety of boots and so in examining this opposition, I will take into account the term *boots* only.

The law

20. Section 5(2)(b) of the Act reads:

“5.-(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.”

21. In reaching my decision I have taken into account the guidance provided by the Court of Justice of the European Union (“CJEU”) in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *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, Case C-3/03 *Matrazen Concord GmbH v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05). In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10) Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases:

"(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 the purchasing act

22. The case-law informs me that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting goods or services can, however, vary depending on what is involved (see, for example, the judgment of the General Court ("GC") in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)).

23. In relation to general items of clothing, the case law² informs me that it is the visual impression of the marks that is the most important bearing in mind the manner in which such goods will normally be purchased. This would normally be from a clothes rail, a catalogue or a web site rather than by oral request. Notwithstanding that protective clothing has a defined function over and above aesthetics normally associated with purchasing clothing, it seems to me that this rationale in relation to visual impressions is also applicable to protective clothing. Having said that, and bearing in mind the protective nature of the clothing, other factors may also come into play. Consumers may orally

² See, for example, *Société provençale d'achat and de gestion (SPAG) SA v OHIM* Case T-57/03 and *React Trade Mark* [2000] RPC 285.

request items of this nature as a result of, for example, a recommendation from another consumer or from reading a critic's review. Aural considerations, therefore, should not be ignored.

24. In respect of the class 25 goods, the average consumer will be the public at large, who in my view will display a medium degree of attention during the purchasing process and so can be seen to be reasonably well informed and reasonably observant and circumspect. As regards the class 09 goods these have a protective function and are specifically designed to prevent accident or injury. Bearing this in mind, I consider that the level of attention that will be displayed to be higher than normal.

Comparison of goods

25. In terms of the comparison to be made, all relevant factors relating to the goods in the respective specifications should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* 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.”

26. Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

“(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

27. In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade”³ and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning⁴. Finally, when comparing the respective goods, if a term clearly falls within the ambit of a term in the competing specification then identical goods must be considered to be in play⁵ even if there may be other goods within the broader term that are not identical.

Preliminary Remarks

28. The applicant argues that the parties operate in different areas of the marketplace, with its goods targeted at the high end of the fashion market and those of the opponent exclusively targeted in respect of safety wear and protective clothing. It may be true that this description represents the core business of each of the parties’. However, the correct comparison to be made is between the respective specification as applied for and as registered (and in respect of one earlier trade mark, for which genuine use has been shown). This distinction, as described by the applicant is not reflected in the specifications as they currently stand and indeed, nor can they be. In this regard, I am mindful of the guidance provided by the following cases:

a) In *McQUEEN CLOTHING CO Trade Mark Application* [2005] RPC 2, where, at paragraph 31, Geoffrey Hobbs (sitting as the appointed person), stated:

“When assessing the objections to registration in the present case, it is necessary to assume normal and fair use of the marks for which registered trade mark protection has been claimed. The context and manner in which the marks have actually been used by the applicant and the opponent in relation to the goods of the kind specified may be treated as illustrative (not definitive) of

³ See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

⁴ See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

⁵ See *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)(OHIM)* Case T-133/05 (“*Gérard Meric*”).

the normal and fair use that must be taken into account”.

b) The General Court (GC) in *Saint-Gobain SA v OHIM* (Case T-364/05) stated:

“67..... Furthermore, it is important to reiterate that the comparison between the goods in question is to be made on the basis of the description of the goods set out in the registration of the earlier mark. That description in no way limits the methods by which the goods covered by the earlier mark are likely to be marketed.”

c) In *Devinlec Développement Innovation Leclerc SA v OHIM* Case T-147/03, the GC stated:

“104 Consideration of the objective circumstances in which the goods covered by the marks are marketed are fully justified. The examination of the likelihood of confusion which the OHIM authorities are called on to carry out is a prospective examination. Since the particular circumstances in which the goods covered by the marks are marketed may vary in time and depending on the wishes of the proprietors of the trade marks, the prospective analysis of the likelihood of confusion between two marks, which pursues an aim in the general interest, that is, the aim that the relevant public may not be exposed to the risk of being misled as to the commercial origin of the goods in question, cannot be dependent on the commercial intentions, whether carried out or not, and naturally subjective, of the trade mark proprietors.”

29. The net effect of these cases is that I must consider the specifications of as registered/for which use has been shown. A specification cannot reflect the relative expense of the goods as marketed, nor can it reflect the exact market targeted by the goods. The guidance also makes clear that circumstances can change in that a trade mark registration can be used in an altogether different market from that which was first envisaged. In any event, I note from the opponent’s evidence that its marks have been used in respect of non-safety, regular footwear. I am not persuaded by the applicant’s argument. My analysis of the specifications must be based on the earlier terms as registered and/or for which use has been shown.

30. The earlier goods are:

Class 09:

Articles of protective and safety clothing, footwear and headgear for protection against accident and injury.

Class 25:

Boots


The contested goods are:

Clothing, footwear, headgear.

31. The contested goods are *footwear* of which the earlier *boots* are a specific example. Bearing in mind the above case law principles already described, it is clear that these goods are identical.
32. In respect of the contested *clothing* the earlier *boots* serve the same purpose. They are each intended for wear by humans, both as protection from the elements and as articles of fashion, and are as such often found in the same retail outlets and so the channels of distribution coincide. Consumers, when seeking to purchase clothes will expect to find footwear in the same department or shop and *vice versa*. Moreover, many manufacturers and designers will design and produce both products. This is especially true of retail outlets which will often provide footwear and clothes under the same trade mark. The goods are, therefore, similar.
33. By extension, in relation to the contested *headgear*, these are also intended to be worn as protection from the elements and as articles of fashion. They are also found in the same retail outlets and are aimed at the same end user. There is also therefore a degree of similarity between these and the earlier *boots*. In addition, I note that the other earlier trade mark relied upon includes headgear, albeit with a protective function. However, this does not alter the fact that the goods will coincide in nature as each are headgear. Further, it cannot be ruled out that the choice of protective headgear can also include an aesthetic fashion element. The end users may differ as may the distribution channels. However, in my view, there remains at least a degree of similarity between them.

Comparison of the marks

34. The respective trade marks are displayed below:

	ANDREW BUCKLER
Earlier trade marks	Contested trade mark

35. The earlier trade marks are comprised of the verbal element BUCKLER encased in a graphical representation of a belt complete with a buckle in the centre of the letter "C". The contested trade mark is word only. They coincide in that they each contain the element "BUCKLER" which is clearly visible in each. Further, the letters BUCKLER in the earlier trade marks are fairly standard block capitals with no particular stylisation. They differ in the respective graphical presentation of the earlier trade marks and the additional

word ANDREW in the contested trade mark. Though there are visual differences, there are also similarities and so I consider them, overall to be similar to a low to moderate degree.

36. Aurally, the marks coincide in respect of BUCKLER and differ in respect of the additional ANDREW in the contested trade mark which has no counterpart in the earlier trade marks. I consider them to be similar aurally to a relatively high degree.
37. Conceptually, the contested trade mark is likely to be understood as a person's full name. The surname BUCKLER may also be immediately grasped in the earlier trade mark, though this is, in my view, a relatively unusual surname and so this proposition is far from certain. The earlier trade mark may also be viewed as an invented term. However, it is also possible that because of the graphical presentation of the mark, a play on words in respect of a belt buckle, a "buckler" will be the ultimate message understood. These possibilities lead to several potential outcomes as regards conceptual similarity. Firstly, where the surname BUCKLER is grasped in the earlier trade mark, the marks are conceptually similar. Secondly, if it is viewed as an invented term, then the situation is that one mark has a meaning and the other does not and so they are conceptually dissimilar. Thirdly, if it is seen as a play on words in respect of a belt buckle, then each of the signs potentially has its own, very distinct meanings. This of course also leads to conceptual dissimilarity.
38. In terms of conceptual comparison, I note that in *Case T-292/01 Phillips-Van Heusen v OHIM – Pash Textilvertrieb und Einzelhandel (BASS) (2003) ECR* at paragraph 54, the CFI stated:
- “Next, it must be held that the conceptual differences which distinguish the marks at issue are such as to counteract to a large extent the visual and aural similarities pointed out in paragraphs 49 and 51 above. For there to be such a counteraction, at least one of the marks at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately....
The fact that one of the marks at issue has such a meaning is sufficient – where the other mark does not have such a meaning or only a totally different meaning - to counteract to a large extent the visual and aural similarities between the two marks.”
39. The ECJ reached the same conclusion, expressed in similar terms, in the *Picasso and others v DaimlerChrysler AG Picarro/Picasso case (C- 361/04P)*.
40. The counteraction described in the above case law can, therefore, be taken into account when considering whether there exists a likelihood of confusion, which will be considered further below.

Distinctive and Dominant components

41. To my mind, none of the trade marks possess a visually outstanding element which catches the eye first and so there is no real dominant feature present in either.
42. As regards distinctive components, I note that the earlier trade marks are a belt buckle device over which the verbal element BUCKLER appears, with the letter “C” also creating part of the belt buckle. This is clearly a distinctive combination as a whole visually. The mark will be referred to as BUCKLER, which is also clearly distinctive for the goods.
43. As regards the contested trade mark, this is comprised of a very common first name, Andrew, and a relatively unusual surname, Buckler. In this regard, I am mindful of the guidance of the Court of Justice in Case C-51/09 (“Barbara Becker”). Here the Court said:
- “Although it is possible that, in a part of the European Union, surnames have, as a general rule, a more distinctive character than forenames, it is appropriate, however, to take account of factors specific to the case and, in particular, the fact that the surname concerned is unusual or, on the contrary, very common, which is likely to have an effect on that distinctive character. That is true of the surname ‘Becker’ which the Board of Appeal noted is common”.
44. In my view, bearing in mind the above guidance, the surname Buckler, being relatively unusual has more distinctive character than the forename Andrew.
45. The net effect of this is that the respective trade marks coincide in respect of BUCKLER which is distinctive in the earlier trade marks and which is the more distinctive element in the contested trade mark. I have already found the marks to be conceptually dissimilar according to two of three possible scenarios. The impact of this as regards a likelihood of confusion will be considered further below. However, they are visually similar to a low to moderate degree and highly similar aurally. Bearing in mind that the similarity between them is also in respect of a distinctive element, I consider the marks to be similar to a moderate degree.

Distinctiveness of the earlier trade marks

46. The distinctiveness of the earlier trade mark must be assessed. This is important because the more distinctive the earlier marks (based either on

inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24).

47. I have already found the earlier marks to be distinctive. To my mind, the overall presentation of the earlier trade marks and its verbal element BUCKLER is highly distinctive. This is so whether the verbal element BUCKLER is viewed as an invented term or as an unusual surname or even as a play on words for a belt buckle. I note that the opponent claims that its marks are highly distinctive because of the use made of it. However since I have already found the marks to be highly distinctive, I cannot see how the opponent can be in any better position. In respect of its class 25 goods, which form the primary attack of the contested goods, though the evidence demonstrates that there has been genuine use, in my view, it does not achieve any more than this.

Global Assessment – Conclusions on Section 5(2)(b)

Parallel trading

48. The applicant argues that the contested trade mark has acquired a reputation quite distinct from that of the opponent and so this is a factor that should be considered in determining whether there is a likelihood of confusion.

49. Evidence of parallel trading is a factor which could, potentially, assist in deciding whether there exists a likelihood of confusion. This is because if the evidence establishes that the respective marks have actually been put to use in the same market without the consumer being confused regarding economic origin, then this can inform the tribunal's decision. Alan Steinfield QC, sitting as a deputy judge of the High Court, in *Fiorelli Trade Mark* [2007] RPC 18 gave weight to an absence of confusion in the marketplace. However, this approach must also take in account the decisions which advise caution about the circumstances in which it is appropriate to give these factors weight (see the Court of Appeal in *The European Ltd v. The Economist Newspaper Ltd* [1998] FSR 283 at page 291, Laddie J in *Compass Publishing BV v. Compass Logistics Ltd* [2004] RPC 41 at 809 and the Court of Appeal in *Phones 4U Ltd v. Phone 4u.co.uk Internet Ltd* [2007] RPC 5 at paragraphs 42 to 45). In the first of these cases, Millet LJ stated:

“Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark.”

50. Some evidence of use has been provided to this tribunal, which I have already summarised. Bearing in mind the case-law referred to above, for concurrent

trading to play a meaningful role in the assessment of the likelihood of confusion I must be satisfied that the parties have traded in circumstances that provide consumers the opportunity for exposure to both marks and, further that they have been able to differentiate between them without confusion as to trade origin. There has been no evidence to this effect here. Indeed, the applicant has been at pains to stress that the parties operate in quite differing areas of the marketplace. As a result, this factor can be given no weight in determining whether or not there is a likelihood of confusion.

51. I have found the goods to be identical or similar. The marks are similar aurally and visually as already noted. The position conceptually is less clear. It is possible that BUCKLER in the earlier trade marks will be understood as a surname, but in considering the relatively unusual status of the name, I consider this to be fairly unlikely. It is far more likely that the contested trade mark will be seen as a full name whereas the earlier trade marks will either be viewed as an invented term or otherwise as a play on words of a belt buckle in conjunction with the belt buckle device. I must therefore consider the impact, if any, of the counteraction effect of this conceptual difference as outlined in the case law above. In doing so, I also bear in mind the guidance of the General Court in case T-460/07, where it was held that it is possible that conceptual differences do not neutralise visual and aural similarities previously established. Further, in respect of the BASS/PASH and PICARRO/PICASSO cases outlined above, I note that neither involved a situation where the respective trade marks in question coincided in an identical element (which is also a distinctive element).

52. Of course, all this must be considered from the viewpoint of the average consumer, who in respect of the class 25 goods, where identity and similarity of goods have been found, is the public at large. From a visual perspective, the earlier trade mark is clearly a BUCKLER mark. Despite the intertwining of the letter "C" within the belt buckle, BUCKLER can clearly be read. This is also how the earlier trade marks will be referred to aurally. The contested trade mark is Andrew Buckler, but with Buckler being the more distinctive element.

53. I also bear in mind the fact that the relevant public rarely has the opportunity to view trade marks side by side and so relies upon an imperfect picture of them. A consumer who encounters the earlier BUCKLER marks and is later exposed to Andrew Buckler is, in my view, unlikely to consider the presence of the element Andrew in creating a full name as the decisive factor which allows him to distinguish between them. The same applies should the situation be reversed. I believe it to be considerably more likely that the visual and aural impact of BUCKLER will be remembered and relied upon, particularly as the earlier trade marks are highly distinctive. So even though

the element Andrew in the contested trade mark will not be ignored, I am not convinced that in creating a full name it evokes a conceptual idea powerful enough to be immediately grasped in a manner that will effectively counteract the visual and aural similarities. I also take into account of course, that in respect of clothing, visual considerations have heightened importance and these marks are visually similar to a low to moderate degree. In weighing up all of these factors, I am persuaded that the average consumer is likely to either mistake one mark for the other or will otherwise consider them to be used by economically linked undertakings. I consider this to be true even in the event that the consumer will display a higher than average degree of attention during the purchasing process (as is likely to occur in respect of protective headgear which bears some similarity with the contested headgear). The opposition under Section 5(2)(b) therefore succeeds.

Final remarks

54. The opponent has included in its evidence a handful of letters which appear to be from members of the public. Two of these letters describe how the BUCKLER branded goods of the applicant were seen by two members of the public, both of whom then contacted the opponent company to enquire as to whether the goods were from them. The opponent asserts that this is evidence of confusion. However, to my mind, the high point of these letters is that it, at best, suggests that two customers were wondering if the origin of the goods viewed was the opponent. There is no evidence, for example, that they purchased goods in error or indeed made any other clear error as regards origin. Further, in light of my findings above, nothing turns on these letters. The remaining letters simply say that BUCKLER branded goods are sold in particular retail outlets. Bearing in mind my findings as regards the similarity of goods above, I do not consider I need make any further comment as regards these letters.

55. The effect of this is that the opposition, based upon section 5(2)(b) of the Act succeeds in its entirety. The opponent has also opposed on the basis of section 5(3) and 5(4)(a) of the Act. However, I note that I have already decided that there is confusion and that the goods and services are similar. As such, the opponent cannot be in any better position under these grounds and so there is no need to consider them further.

COSTS

56. The opponent has been successful and is entitled to a contribution towards its costs. Neither party sought costs off the normal scale and I am of course mindful that neither party sought a hearing. In the circumstances I award the opponent the sum of £1000 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Statutory fee for filing opposition - £200

Filing notice of opposition and considering counterstatement- £300

Filing evidence and submissions and considering the applicant's evidence - £500

Total - £1000

57. The above 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 7th day of December 2011

Louise White

For the Registrar,

The Comptroller-General