

O/245/12

**TRADE MARKS ACT 1994**

**CONSOLIDATED PROCEEDINGS IN THE MATTER OF APPLICATIONS  
2531546 & 2531547  
BY KONFIDENCE LIMITED FOR THE TRADE MARKS:**

**konfidence**

**&**

**Konfidence** 

**AND**

**OPPOSITION THERETO (NOs 100308 & 100364) BY THE SPORTS HQ LTD**

## THE BACKGROUND AND THE PLEADINGS

1) Applications 2531546 & 2531547 were filed by Konfidence Limited (“KL”) on 12 November 2009. Application 2531546 was published on 18 December 2009 and application 2531547 on 1 January 2010. The marks and the goods<sup>1</sup> (which are the same for each application) for which registration is sought are:

2531546: konfidence

2531547: The logo for 'Konfidence' features the word 'Konfidence' in a bold, blue, sans-serif font. To the right of the text is a stylized blue graphic of a dolphin or shark leaping out of the water, with a curved line above it suggesting motion or a splash.

**Class 09:** Buoyancy aids, floatation aids, swim jackets, float jackets and float suits.

**Class 25:** T-shirts, shorts, suits, hoodies and hats primarily designed to provide sun protection; beachwear, namely T-shirts, shorts, suits, hoodies and hats primarily designed to provide sun protection; wetsuits; swimwear.

**Class 28:** Games and playthings, namely, water sports toys and equipment; inflatable and foam sporting articles

2) The Sports HQ Limited (“HQ”) opposes the registration of the above applications. Its oppositions were filed on 18 March 2010 and 31 March 2010 respectively, both being based on grounds under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Three earlier marks<sup>2</sup> are relied upon under sections 5(2)(b) and 5(3), namely:

i) UK registration 1073130 for the mark CONFIDENCE which was filed in 1977 and registered in 1978 in respect of golf clubs.

ii) Community Trade Mark (“CTM”) registration 355446, which was filed on 15 October 1996 and registered on 24 November 1998 for the mark:



in respect of:

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<sup>1</sup> The goods set out above are a limited version of the goods as filed, following a TM21 filed on 6 December 2012.

<sup>2</sup> Which also correspond to the signs relied upon under section 5(4)(a) of the Act.

**Class 25:** Golfwear, including knitwear, shirts and trousers, socks, waterproofs and golf shoes.

**Class 28:** Golf clubs, golf bags, golf trolleys; parts and fittings for the aforesaid; golf club head covers, golf balls.

iii) CTM 4824603, which was filed on 23 December 2005 and registered on 15 February 2012 for the mark



in respect of:

**Class 28:** Fitness apparatus; golf clubs, golf bags, golf trolleys; part and fittings for the aforesaid; golf club head covers; golf balls; golf gloves; games and playthings; gymnastics and sporting articles not included in other classes.

3) All three marks constitute earlier marks as defined by section 6 of the Act. The first two of the earlier marks completed their registration procedures before the five year period ending on the date of publication of the opposed marks; the consequence of this is that the use conditions apply to the marks, as per section 6A of the Act. However, CTM 4824603 was only registered in 2012 (after the publication of the opposed marks) and, as such, the use conditions do not apply to it; this mark may, therefore, be taken into account for its specification as registered.

4) KL filed counterstatements denying the grounds of opposition. KL asked HQ to provide proof of use in respect of its earlier marks which are subject to the use conditions. Both sides filed evidence. Neither side requested a hearing. Written submissions have been made by both parties at certain points during the proceedings which I will bear in mind.

## **THE EVIDENCE**

### **Witness statements of Mr Simon Millington**

5) Mr Millington is HQ's Chief Executive Officer. He has provided three witness statements, one about the proceedings in general, the other two focusing on proving use of its two earlier marks that are subject to the use conditions. The majority of the second two statements refer back to the evidence in the first statement, so I will begin with this. The following emerges from Mr Millington's evidence:

- i) The oppositions were originally lodged, jointly, by Mr Millington and his wife Suzanne Millington, but are now being pursued by HQ. This is because HQ took an assignment of the earlier marks during the course of the proceedings. The Millingtons' own 100% of HQ's share capital.
- ii) The business (as first operated by the Millingtons) began in 2000. It focuses on the sale of sporting and fitness goods. The main distribution centre is in Alvechurch, Worcestershire. There are also distribution centres in Australia and the USA, as trade is also undertaken there.
- iii) The CONFIDENCE marks were first used in 1967 in relation to golf clubs. The owner of registration 1073130 at that time was World Class Products, a US corporation. HQ purchased this trade mark and the relevant UK part of the business (from a company called B&W Golf-Quip Limited) in 2005 and then filed CTM 355446. HQ assigned the marks to the Millingtons in 2008 which were then re-assigned back to HQ in 2011. Various database extracts are provided relating to these trade marks and changes of ownership.
- iv) HQ owns various other trade marks, details of which are provided. There is no need to detail them as I can only consider the marks which are pleaded in the proceedings before me.
- v) In 2005, when HQ purchased the business, the marks were being used in the UK in relation to golf clubs, golf bags and golf trolleys.
- vi) Claims of use since 2005 are made and a computer print-out (Exhibit 3) lists various goods sold between January 2005 and December 2009, together with corresponding turnover in respect of goods sold under the CONFIDENCE and "CONFIDENCE logo" marks. The goods include: suitcases, dumbbells, golf gloves, golf balls, putting mats, an abdominal trainer, golf trolleys, golf clubs, golf sets, golf bags, waterproof golf suits, golf umbrellas, exercise bikes, rowing machines and steppers.
- vii) Website statistics for the period commencing October 2006 to June 2011 are provided. They relate to visits to the website by way of identified search terms. The terms include the word CONFIDENCE plus descriptive terminology such as golf clubs, luggage, tents, suitcases, exercise bikes etc. Totalling all the "visits" identified (which may not be unique visits) there are less than 60,000 in the time period.
- viii) Exhibit 5 consists of an extract from a sales database (wholesale customers) from June 2005 to June 2011. Some sales are made to customers outside the UK but some of those listed are in the UK.

Goods sold include golf tees, golf balls, golf sets, golf trolleys, elliptical trainers, heart rate monitors, fleeces and exercise bikes.

- ix) Statements about turnover are provided and annual reports exhibited in support. The turnover of the business has ranged between £2.7 million in 2005 to over £12 million in 2010. This is not broken down by product type. One third of this is said to relate to goods sold under the CONFIDENCE trade marks (just under £10 million in the six year period referred to); a little over £4.5 million is said to have been turned over for the current year. In terms of unit sales, this is said to be 118,000 between August 2009 and July 2010 and a similar amount the following year.
  - x) Redacted invoices are provided from 2005 to 2009, showing various “Confidence” goods including: golf apparatus, tents, waterproof suits, roll neck sweaters, elliptical trainers, golf shoes, exercise bikes, abdominal trainers, fleeces, polo shirts, ladies shirts and towels.
  - xi) A large number of website prints are provided in Exhibit 11 showing products sold which mirror what has been set out above. It is stated that these are examples of promotions; what they show are certain special offers and price reductions etc.
  - xii) It is stated that over £1.5 million has been spent (since 2005) on promoting the website. Whether promoting the website is anything other than having one is not explained. There is no evidence that the existence of the website or the business has been specifically advertised to the public. Two thirds of this spend is said to relate to the CONFIDENCE marks.
  - xiii) Confidence goods (of the type set out) are sold on websites such as Amazon and eBay. Various prints are provided in support of this.
  - xiv) Emails are sent to customers advertising products, two examples of this are provided.
  - xv) In going through the above summarised evidence, the marks used are either CONFIDENCE as a plain word or CONFIDENCE as per CTM 4824603. I have struggled to find any form of use as per registration 355446.
- 6) The other witness statements of Mr Millington bring little new to the table in terms of evidence of fact.

Witness statement of Andrew Regan

7) Mr Regan is KL's Managing Director; the following emerges from his evidence:

- i) KL was incorporated in 1998. Its initial product was a "Konfidence" jacket which is a swimming aid for babies and children.
- ii) It is stated that between 2000 and 2010 the business grew steadily to include a range of leisure and beach wear for adults and children designed for sun protection together with a wider range of wetsuits and swimwear.
- iii) Toys such as floats, diving toys and plastic animal character toys are also sold.
- iv) Dates of first use are given as: 1999 (swim jackets/float suits), 2003 (wetsuits), 2000 (sun protection clothing), 2001 (swimwear) and 2007 (water toys/playthings and floats).
- v) A list of sales channels are given which include direct marketing, trade fairs and baby shows, holiday companies, health clubs and retail outlets.
- vi) Turnover figures have ranged between just under £½ million in 1994 to just under £1 million in 1998. Advertising spend has ranged between £7k and £83k in the same period.
- vii) Various submissions are made which I will bear in mind but not summarise here. It is stated that when KL first started trading, HQ had no relevant earlier rights as it was associated wholly with golf. No instances of confusion have been found.
- viii) Various promotional materials and invoices are provided in support of the use put forward.

Witness statement of Clare Jackman

8) Ms Jackman is KL's trade mark attorney. She highlights HQ's claim that its business is conducted online via e-commerce. She contrasts this to KL who she says sell predominantly through direct marketing and trade shows (although she adds that the goods are also sold through its own website). She provides various *Google* searches from which a search for "confidence clothing" failed to bring back Konfidence (and the same for a search for confidence alone) and that a search for Konfidence only brought back hits relevant to KL. Ms Jackman also

provided a set of written submissions which I will bear in mind and will comment upon further if necessary.

Witness statement of Jeanette Wood

9) Ms Wood is a trade mark attorney who has worked with HQ in this matter. Her evidence is, essentially, a critique of Mr Regan's evidence and her own submissions on the issues before the tribunal. I do not consider it necessary to detail any of this here.

**THE PROOF OF USE PROVISIONS**

10) Although one of the earlier marks is not subject to proof of use, the other two are. As they may, potentially, put HQ into a better position, it is, therefore, necessary to decide whether these earlier marks may be relied upon and, if so, in respect of what goods. The use conditions are set out in section 6A(3) of the Act as follows:

“...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.”

11) Section 100 is also relevant which reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

12) When considering whether genuine use has been shown, I bear in mind the leading authorities on the principles to be applied namely: the judgments of the Court of Justice of the European Union (“CJEU”) in *Ansul BV v Ajax Brandbeveiliging BV* [2003] R.P.C. 40 (“*Ansul*”) and *Laboratoire de la Mer Trade Marks C-259/02* (“*La Mer*”). The position<sup>3</sup> was helpfully summarized by Ms Anna Carboni, sitting as the Appointed Person, in BL O-371-09 *SANT AMBROEUS*:

“42. The hearing officer set out most of the key extracts from *Ansul* and *La Mer* in his decision, so I shall not reproduce them here. Instead, I try to

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<sup>3</sup> Which also took into account the guidance set out in *Silberquelle GmbH v Maselli-Strickmode GmbH* Case C495/07, [2009] ETMR 28.

summarise the “legal learning” that flows from them, adding in references to *Silberquelle* where relevant:

(1) Genuine use means actual use of the mark by the proprietor or a third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely “token”, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] - [23].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine

commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25].”

13) There are two separate relevant periods, these are as follows:

- i) In relation to 2531546: 19 December 2004 to 18 December 2009.
- ii) In relation to 2531547: 2 January 2005 to 1 January 2010.

14) Save for two weeks at either end, the periods are virtually identical. I will bear the overlap in mind, but nothing is likely to turn on the difference in relevant periods.

15) HQ has provided evidence demonstrating the nature of its business. The turnover figures and other information demonstrate a real business interest in the goods that it provides. It is certainly not token or internal use. In relation to the goods it provides, I have no doubt that such use constitutes genuine use in the terms set out in *Ansul*. There are, though, two issues of concern. The first relates to the goods upon which use is shown and the second is whether both marks which are subject to proof of use have been used. I will deal with the latter point first.

16) At paragraph 5 (point xv), I highlighted that the use put forward by HQ shows use of the word CONFIDENCE without any form of stylization and, also, use of a logo version of the mark as represented by CTM 4824603. Clearly, the use of the plain word constitutes use in relation to earlier mark 1073130 which consists of a plain word. However, there is no use of the other mark (CTM 355446) in the form in which it is registered, namely:



17) Nevertheless, I must bear in mind that section 6A(4)(a) states that: “..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..”. The question that arises is whether the plain word which has been used constitutes what I will describe as a “variant mark”. The relevant case-law on this issue focuses on the alteration of distinctive character. For example, the Court of Appeal dealt with this issue in *Bud/Budweiser Budbrau* [2003] RPC 25; of relevance are the statements of Lord Walker of Gestingthorpe where he stated:

“43. ...The first part of the necessary inquiry is, what are the points of difference between the mark as used and the mark as registered? Once those differences have been identified, the second part of the inquiry is, do they alter the distinctive character of the mark as registered?”

44. The distinctive character of a trade mark (what makes it in some degree striking and memorable) is not likely to be analysed by the average consumer, but is nevertheless capable of analysis. The same is true of any striking and memorable line of poetry: 'Bare ruin'd choirs, where late the sweet birds sang' is effective whether or not the reader is familiar with Empson's commentary pointing out its rich associations (including early music, vault-like trees in winter, and the dissolution of the monasteries).

45. Because distinctive character is seldom analysed by the average consumer but is capable of analysis, I do not think that the issue of 'whose eyes? - registrar or ordinary consumer?' is a direct conflict. It is for the registrar, through the hearing officer's specialised experience and judgement, to analyse the 'visual, aural and conceptual' qualities of a mark and make a 'global appreciation' of its likely impact on the average consumer, who: 'Normally perceives a mark as a whole and does not proceed to analyse its various details.' The quotations are from para [26] of the judgement of the Court of Justice in Case C-342/97 *Lloyd Schuhfabrik Meyer GmbH v Klijsen Handel BV* [1999] E.C.R. I- 3819; the passage is dealing with the likelihood of confusion (rather than use of a variant mark) but both sides accepted its relevance."

Also of relevance are the comments of Sir Martin Nourse; he stated at paragraph 12:

"Mr Bloch accepted that, in relation to a particular mark, it is possible, as Mr Salthouse put it, for the words to speak louder than the device. However, he said that it does not necessarily follow that the entire distinctive character of the mark lies in the words alone. That too is correct. But there is yet another possibility. A mark may have recognisable elements other than the words themselves which are nevertheless not significant enough to be part of its distinctive character; or to put it the other way round, the words have dominance which reduces to insignificance the other recognisable elements...."

18) I also take note of the comments of Mr Arnold QC (sitting as the Appointed Person) in *NIRVANA Trade Mark* (O/262/06) and in *REMUS trade mark* (O/061/08). In these cases Mr Arnold undertook a thorough analysis of the relevant case law, including judgments of the CJEU and the GC, and he then put forward the following questions, the answers to which will assist in determining whether a variant form of use represents an acceptable variant (the text is from *NIRVANA* but it is also adopted in *REMUS*):

"33. .... The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the subquestions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all...."

19) The above case-law deals with the section 46(2) concept of variant marks. This is equally applicable in the context of proof of use, bearing in mind the analogous provision set out in section 6A(4)(A) of the Act. In terms of variant marks, I also note that Ms Anna Carboni (sitting as the Appointed Person) in *Orient Express* (BL O/299/08) considered that the question as to whether an element of a composite mark was an independent and distinctive element was an unnecessary addition to the variant mark test – she stated:

"71. But I do not regard his comment about the words maintaining an "independent distinctive role" within the composite mark as being a necessary step in the process. It seems to me that, whether or not the word element of a composite mark has an "independent distinctive role" may be relevant to the question of whether section 46(2) needs to be considered at all, but it is superfluous to the test laid down in *BUD* or the guidance given in *NIRVANA* and *REMUS*."

20) In summary, Ms Carboni's reference to whether section 46(2) needed to be considered at all related, in the circumstances before her, to whether part of a composite mark functioned as a trade mark in its own right. That is certainly not the case before me and it is necessary, therefore, to consider the variant mark test. To that extent, the matter boils down to the impact of the stylization of the registered mark. The mark clearly reads as the word Confidence. There is no disguise or difficulty in seeing that. The word has, though, been produced in a particular script. However, whilst it may not be a common font of the type seen in word processing packages, it looks to me to be a fairly typical way of presenting a word in joined up writing. I consider that the stylization has limited value in terms of the distinctiveness of the mark and, therefore, the distinctive character resides in the word itself. Taking this forward, despite the mark as used not having the stylization, the distinctive character of the mark is not altered. The use of the plain word is, therefore, an acceptable variant and may be relied upon.

21) As a side note I should add that I have considered the judgment of the CJEU *Il Ponte Finanziaria SpA* where it was held that it was not permissible to rely on the use of another registered mark to support the use of the mark under consideration. The potential relevance of this is that the plain word, which I have said constitutes a variant mark of the stylized mark, is a mark in its own right and

is relied upon in the opposition. However, the plain word registration covers only golf clubs whereas the stylized mark covers a much broader range of goods. In view of this, the rationale from the CJEU's judgment does not hold true here (save in respect of golf clubs). The next issue relates to the goods and deciding upon fair specifications.

22) In terms of deciding upon a fair description, the description must not be pernickety<sup>4</sup>. It is necessary to consider how the relevant public would likely describe the goods<sup>5</sup>. The General Court ("GC") in *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-126/03 held:

"43 Therefore, the objective pursued by the requirement is not so much to determine precisely the extent of the protection afforded to the earlier trade mark by reference to the actual goods or services using the mark at a given time as to ensure more generally that the earlier mark was actually used for the goods or services in respect of which it was registered.

44 With that in mind, it is necessary to interpret the last sentence of Article 43(2) of Regulation No 40/94 and Article 43(3), which applies Article 43(2) to earlier national marks, as seeking to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services. Thus, when those provisions are applied, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark was registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do this in the light of the goods or services in respect of which genuine use has, of necessity, actually been established.

45 It follows from the provisions cited above that, 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 subcategories 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

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<sup>4</sup> See *Animal Trade Mark* [2004] FSR 19.

<sup>5</sup> See *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32

goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.

53 First, although the last sentence of Article 43(2) of Regulation No 40/94 is indeed intended to prevent artificial conflicts between an earlier trade mark and a mark for which registration is sought, it must also be observed that the pursuit of that legitimate objective must not result in an unjustified limitation on the scope of the protection conferred by the earlier trade mark where the goods or services to which the registration relates represent, as in this instance, a sufficiently restricted category."

23) I also note the comments of Mr Geoffrey Hobbs QC, sitting as the appointed person, in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited* BL O/345/10, where he stated:

"However, that does not appear to me to alter the basic nature of the required approach. As to that, I adhere to the view that I have expressed Page 23 of 68 in a number of previous decisions. In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

24) The position in respect of 1073130 is straightforward given that this mark is registered in relation to golf clubs only and genuine use has clearly been made of the mark in relation to such goods. This earlier mark may be relied upon for its goods as registered. In relation to CTM 355446, the goods as registered are:

**Class 25:** Golfwear, including knitwear, shirts and trousers, socks, waterproofs and golf shoes.

**Class 28:** Golf clubs, golf bags, golf trolleys; parts and fittings for the aforesaid; golf club head covers, golf balls.

25) From my evidence summary I noted use on a range of goods. However, the use in relation to exercise equipment (such as rowing machines), suitcases etc does not assist as such goods are not covered by the registration. I will therefore focus upon:

golf gloves, golf balls, putting mats, golf trolleys, golf clubs, golf sets, golf bags, waterproof golf suits, golf tees, fleeces, golf apparatus, waterproof suits, roll neck sweaters, golf shoes, polo shirts, ladies shirts.

26) In relation to class 25, the goods as registered are all identified as golf wear with certain items then being specifically identified. Golf clothing is a far narrower term than clothing per se and from the used goods it is clear that a number of items of golf wear have been sold. I believe that such goods would be characterised as golf wear by the relevant public. This would represent a fair specification. Given that the specifically listed goods all fall within this broad term the earlier mark may be considered for its specification as registered.

27) In relation to class 28, golf clubs, bags, trolleys and balls have been sold. That leaves golf club head covers and parts and fittings of clubs, bags and trolleys for which no specific use has been made. With no specific use then such specific terms should not be retained. The earlier mark may be relied upon in respect of:

**Class 25:** Golfwear, including knitwear, shirts and trousers, socks, waterproofs and golf shoes.

**Class 28:** Golf clubs, golf bags, golf trolleys; golf balls.

### **SECTION 5(2)(B)**

28) 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.”

29) In reaching my decision I have taken into account the guidance provided by the 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 conflict**

30) The following table sets out the marks and the goods in conflict:

KL's marks and goods	HQ's marks and goods
<p>i) konfidence</p> <p>&amp;</p> <p>ii) </p> <p><b>Class 09:</b> Buoyancy aids, floatation aids, swim jackets, float jackets and float suits.</p> <p><b>Class 25:</b> T-shirts, shorts, suits, hoodies and hats primarily designed to provide sun protection; beachwear, namely T-shirts, shorts, suits, hoodies and hats primarily designed to provide sun protection; wetsuits; swimwear.</p> <p><b>Class 28:</b> Games and playthings, namely, water sports toys and equipment; inflatable and foam sporting articles</p>	<p>i) </p> <p><b>Class 28:</b> Fitness apparatus; golf clubs, golf bags, golf trolleys; part and fittings for the aforesaid; golf club head covers; golf balls; golf gloves; games and playthings; gymnastics and sporting articles not included in other classes.</p> <p>ii) CONFIDENCE</p> <p><b>Class 28:</b> Golf Clubs</p> <p>iii) </p>

	<p><b>Class 25:</b> Golfwear, including knitwear, shirts and trousers, socks, waterproofs and golf shoes.</p> <p><b>Class 28:</b> Golf clubs, golf bags, golf trolleys; golf balls.</p>
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### The average consumer

31) 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 GC in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)).

32) The goods of both parties strike me as ones for which a reasonable (no higher or lower than the norm) degree of care and attention will be deployed in their selection. Even though the cost of the particular items can vary, they do not, generally speaking, equate to highly considered purchases. If there is any variance from that then it would be in relation to items such as golf clubs and items such as floatation aids. The former may have a higher than average degree of care and attention because a golfer will put a lot of time and thought into the clubs to be purchased, the latter may have a higher than average degree of care and attention due to safety implications; neither, however, strike me as selections which have the highest degree of consideration. I also consider that the goods are ones bought via visual selection, although, aural similarity will not be ignored completely.

### Comparison of goods

#### KL's class 28 goods

33) The goods applied for by KL are defined as either types of games and playthings or types of sporting articles, albeit named types of such goods. The strongest earlier mark in so far as the goods comparison is concerned is CTM 4824603. This earlier mark includes “games and playthings” and “sporting articles” at large and, so, the applied for goods fall within the ambit of the earlier mark’s goods. **The goods applied for in class 28 must be considered identical to the goods of CTM 4824603.**

34) I must bear in mind that the other marks may, nevertheless, need to be considered, particularly when one bears in mind the interdependency principle. To that extent, I must bear in mind that both the other earlier marks include golf equipment in class 28. However, the playthings and the sporting articles are named as “water sports toys and equipment” and “inflatable and foam sporting

articles". Golf is not a water sport. Neither is golf played with inflatable or foam articles. Being sporting in nature is, in my view, too superficial a degree of similarity. The purpose/exact trade channels are not the same neither are the goods competitive or complementary. The goods are not similar. The earlier mark's class 25 specification is even further away. **HQ's earlier marks CTM 355446 and UK registration 1073130 do not assist with its 5(2)(b) opposition against class 28 of the applied for marks.**

KL's class 9 goods

35) The goods applied for in class 9 can be used for swimming, for example, assisting with the floatation of the swimmer or a person learning to swim. I see no relationship with golf equipment or golf wear and, therefore, **HQ's earlier marks CTM 355446 and UK registration 1073130 do not assist with its 5(2)(b) opposition against class 9 of the applied for marks.**

36) That leaves CTM 4824603 and its broad terminology that includes games, playthings and sporting articles at large. It is noted that the goods covered by the applied for marks in class 9 now actually fall in class 28 due to a recent change of classification by the World Intellectual Property Organization. However, this does not mean that the earlier mark's class 28 term "sporting articles" should be taken to include such goods. This is because the goods did not fall within that class when the earlier mark was applied for or, indeed, when the later marks were applied for (which is the relevant date for the assessment of whether there exists a likelihood of confusion). There is judicial support for this in *Reed Executive plc and Reed Solutions plc v Reed Business Information Ltd and Reed Elsevier (UK) Ltd, totaljobs.com Ltd* [2004] ETMR 56 where Jacob LJ stated:

"46. Before coming to that I must deal with the date point. I do so briefly because I do not consider that the case turns on this. Mr Howe contends that a specification of goods or services cannot change its meaning with time. Mr Hobbs submits that it can – if the "core" nature of the service changes with time, then the meaning changes too.

47. I have no doubt that Mr Howe is right. One can test the point best by reference to a registration qualified by the words "included in this Class". From time to time, though rarely, the class in which a particular kind of article is put is changed by international agreement. If that happens it is inconceivable that the trade mark owners' rights could be changed. "Included in Class X" must mean "included at the time of registration."

37) Further support can be seen in *GE Trade Mark case* [1969] RPC 418 and in *Avenet Incorporated v. Isoact Limited case* [1998 FSR 16], in which Jacob J. said:

“It is settled, at least at first instance,.....one has to look at the Trade Mark Registry practice to see whether the registrar in practice at the time of registration included the particular service or goods within that class (see GE Trade Mark 1969 RPC 418 at 458).”

38) In view of the above, the goods are not identical. Nevertheless, it is still necessary to consider whether any types of playthings or sporting articles in class 28 are similar to the class 9 goods applied for. KL’s submissions focus on the specificity of its goods which it contrasts to the goods of the earlier mark. KL’s approach can be seen in the following statement from its written submissions:

“...the fact that some of the respective goods may technically overlap or conflict, is negated when the specifications are considered as a whole. A clear impression is conveyed, which is borne out by a review of the parties’ evidence, that here are two businesses with different product ranges, which are clearly not in competition with one another and whose goods can hardly be said to be complementary.”

HQ’s submissions focus on the fact that both sets of goods can be used for sporting/fitness purposes.

39) KL’s approach to the matter is not correct. Even though its goods may tie quite clearly to its business, HQ’s goods do not. HQ’s mark, as I observed earlier, covers playthings and sporting articles at large. The earlier mark is not subject to proof of genuine use. There is, therefore, no reason to limit the scope of those terms to those for which HQ’s evidence relates. Neither is there reason to limit the scope of those terms on the basis that there are other more explicit terms (golf and fitness equipment) in the specifications. I must consider matters on a notional basis bearing in mind what the earlier mark is registered in respect of. It is registered in respect of playthings and sporting articles at large and the assessment I must make must be based on such terminology.

40) The reason that the above is important is because such terms cover a wide range of articles. Sporting articles in class 28 would include articles for use in swimming (such as fins and flippers) as well as articles for use in other types of water sports. Furthermore, the term “games and playthings” would include goods such as inflatable paddling pools and inflatable toys for use in the swimming pool. There is a degree of similarity on the basis that all of the goods are for use whilst swimming or for undertaking other water sports and they may be sold through similar trade channels. There is, though, likely to be a difference in nature and the precise purpose. The goods do not compete (you will not choose between a floatation swimming article and the class 28 goods) but there is a degree of complementarity. **Weighing the differences and similarities, I conclude that there is a moderate degree of similarity with the class 28 goods of CTM 4824603.**

KL's class 25 goods

41) The applied for goods are:

“T-shirts, shorts, suits, hoodies and hats primarily designed to provide sun protection; beachwear, namely T-shirts, shorts, suits, hoodies and hats primarily designed to provide sun protection; wetsuits; swimwear”

42) CTM 355446 covers golf wear. I will come back to the terms “suits” shortly, but in respect of the sun protective t-shirts, shorts, hoodies and hats, then there is no reason why such goods could not be used whilst playing the game of golf. Indeed, as golf is an outdoor activity, having sun protective features may be an important characteristic. On this basis the goods would fall within the ambit of golf wear and must be considered identical. Nevertheless, the applied for goods may be sold as something other than golf wear. This is characterized by the fact that the same terms are included in the applied for specification but are named as being “beachwear” – whilst this is so, and whilst this may create a difference in terms of trade channels, the goods, by their very nature, are still sun protective t-shirts, shorts, hoodies and hats; golf wear, as already observed, may include sun protective t-shirts, shorts, hoodies and hats. Therefore, even if defining such goods as beachwear means that they are not identical, they are still, in my view, highly similar.

43) That leaves “suits”, wetsuits and swimwear. I consider the term suits, when the manner of identification in the specification is considered, to mean bathing suits. To that extent, neither suits, wetsuits or swimwear is similar to golf wear. The nature, purpose and channels of trade differ and the goods are neither competitive nor complementary. However, the goods of CTM 4824603 must be borne in mind, such goods covering sporting articles at large. To that extent, such goods have some similarity of purpose to sporting articles for use in swimming and other water sports (such as surfboarding) resulting in **a moderate degree of similarity to the class 28 goods of CTM 4824603.**

44) The above findings render all of the applied for goods similar to goods covered by one or more of the earlier marks. For the sake of clarity, the following is a summary of my findings:

<b>Applied for goods</b>	<b>Goods of the earlier mark(s)</b>
<b>Class 09:</b> Buoyancy aids, floatation aids, swim jackets, float jackets and float suits	There is a moderate degree of similarity with the class 28 goods of CTM 4824603 in so far as they cover sporting articles for use in swimming/other water sports and playthings such as inflatable pools and toys.

<p><b>Class 25:</b></p> <p>i) T-shirts, shorts, hoodies and hats primarily designed to provide sun protection;</p> <p>ii) Beachwear, namely T-shirts, shorts, hoodies and hats primarily designed to provide sun protection;</p> <p>iii) Suits primarily designed to provide sun protection; beachwear, namely suits primarily designed to provide sun protection; wetsuits; swimwear.</p>	<p>i) Identical to the class 25 goods (golfwear) of CTM 355446.</p> <p>ii) Highly similar to the class 25 goods (golfwear) of CTM 355446.</p> <p>iii) There is a moderate degree of similarity with the class 28 goods of CTM 4824603 in so far as they cover sporting articles for use in swimming/other water sports.</p>
<p><b>Class 28:</b> Games and playthings, namely, water sports toys and equipment; inflatable and foam sporting articles</p>	<p>Identical with the playthings and sporting articles of CTM 4824603.</p>

### Comparison of marks

45) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the marks must be assessed by reference to their overall impressions, bearing in mind their distinctive and dominant components. In view of the goods assessment, only two of the earlier marks are significant. The marks that need to be compared are:

KL's marks	HQ's marks
<p>i) konfidence</p> <p>ii) </p>	<p>i) </p> <p>ii) </p>

46) All of the marks feature the word KONFIDENCE/CONFIDENCE as what I regard as the dominant and distinctive element. HQ's mark also has what appears to be a device element incorporating a golf club. I say "appears" because whilst this may be perceived when the mark is considered in relation to

golf equipment, on non golf related items such a perception may not be seen with the result that the device will simply be seen an abstract design. KL, in addition to its word mark, has a mark which also features a dolphin. Neither the dolphin in KL's mark nor the golf club/abstract design are negligible in the context of the marks and, so, even though they may not be the dominate elements, they will still be fully borne in mind in the comparison.

47) In terms of the conceptual and aural comparison, KL's marks are identical to both of HQ's marks. Whether with a K or a C the words CONFIDENCE/KONFIDENCE will be pronounced in exactly the same way (a point KL accepts). In relation to concept, KL argues that CONFIDENCE has a meaning but KONFIDENCE does not. However, even though KONFIDENCE is not spelt correctly, I agree with HQ that it will still be perceived and recognised by the average consumer as a misspelling of that word. The device elements in the marks are unlikely to form the underpinning conceptual hooks and, so, all of the marks' concepts focus on the words confidence/konfidence.

48) From a visual perspective, the least similar marks are the respective word and device marks. There are differences in terms of the spelling (the K for a C) and the difference created by the differing device elements. The stylization of the words also differs. However, bearing in mind the similarity created by the konfidence/confidence element, which I found to be the dominant and distinctive element of the respective marks, I still consider that there is at least a reasonable degree of similarity. The other marks have higher degrees of visual similarity. KL's device mark compared to HQ's stylized mark has a reasonably high degree of similarity when the similarities and differences are assessed. I consider KL's word mark and HQ's stylized mark to be highly similar when all factors are borne in mind.

### **The distinctiveness of the earlier mark**

49) The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark (based either on inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). From an inherent point of view, the mark is certainly not highly distinctive. The word CONFIDENCE is at least suggestive (but not, alone, outright descriptive) that the goods, in some way, will help to improve the confidence of beginners in particular sports or that the user should have faith or confidence in the quality of the product. The stylization of the earlier stylized mark adds little, but I still consider the mark to be averagely distinctive. The earlier word and device mark, due to the overall figurative nature, creates a mark with a slightly above average degree of distinctiveness.

50) Use of the earlier mark has also been presented. It is fair to say that if the earlier marks have been used to a sufficient level so as to have enhanced their distinctive character, this would be limited to goods such as golf equipment and

fitness equipment such as cross trainers, exercise bikes etc. Given that my findings in relation to goods similarity focuses not on these goods but primarily on other goods which are covered by the broad terms of the earlier marks' specification, I do not consider that such use is particularly relevant.

### **Likelihood of confusion**

51) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

52) In relation to class 28 of the applied for marks, I have found identity of goods with CTM 4824603. This earlier mark is HQ's word and device mark, but, nevertheless, I have still found there to be at least a reasonable degree of visual similarity with KL's word and device mark, with slightly more similarity with KL's word mark, and that they are all aurally and conceptually identical. Even though the common element is a suggestive one (a point KL emphasizes) it is, as I observed earlier, still averagely distinctive. When one bears in mind the concept of imperfect recollection, I have little hesitation in concluding that there is a likelihood of confusion with regard to the opposed class 28 goods.

53) In relation to the class 25 goods, I have found most of them (other than suits [bathing suits], wetsuits and swimwear) to be identical or highly similar to goods covered by CTM 355446. This mark is reasonably high in similarity to KL's device mark and highly similar to KL's word mark from a visual perspective, and they are all aurally and conceptually identical. For similar reasons to that assessed above I find that there is a likelihood of conclusion with regard to these goods in class 25. In terms of suits [bathing suits], wetsuits and swimwear, then I have found a moderate degree of similarity with the goods of CTM 4824603. Bearing in mind the degree of mark similarity as already assessed, together with the other relevant factors, my view is that there is a likelihood of confusion. The goods will be perceived by the average consumer as range of swimming/water sport products which are part of a co-ordinated range.

54) That leaves the class 9 goods for which I found a similar relationship with the goods of CTM 4824603. For similar reasons, I come to the same view that there also exists a likelihood of confusion here. **In summary, the ground of opposition under section 5(2)(b) succeeds against both of the applied for marks in relation to all of the goods sought to be registered.**

55) When reaching the above conclusions I have not ignored the evidence filed by the parties. It has all been borne in mind but I do not regard it as helpful either

way. I have already stated that the use of the earlier marks and any claim to enhanced distinctiveness is not relevant. The reference by Mr Regan to their being no confusion does not assist because the actual use of the parties is not represented by the notional assessments of the marks I have made. Neither does the fact that Internet searches for Konfidence did not find Confidence (and vice versa) as this can hardly be said to represent the average consumer during the purchasing process. These are just some of the points made in the evidence, nothing else it contains takes matters further forward.

### **Other grounds of opposition**

56) I do not consider it necessary to go in to the other grounds of opposition. This is particularly so when one bears in mind where any goodwill/reputation is likely to exist with regard to HQ's mark/signs. I do not consider HQ to be in any better position under either section 5(3) or 5(4)(a) or when this is borne in mind.

### **Costs**

57) HQ has been successful and is entitled to a contribution towards its costs. I hereby order Konfidence Limited to pay The Sports HQ Limited the sum of £2000. This sum is calculated as follows:

*Official fee (£200) x 2*  
£400

*Preparing a statement and considering the other side's statement<sup>6</sup>*  
£400

*Considering and filing evidence*  
£700

*Written submissions*  
£500

58) 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 the 25<sup>th</sup> of June 2012**

**Oliver Morris**  
**For the Registrar,**  
**The Comptroller-General**

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<sup>6</sup> Although not consolidated at this point, I have made only one award due to the statements / counterstatements being virtually identical.