

O-485-12

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2578524
BY TEAM MAGNUS LTD
TO REGISTER THE TRADE MARK**



IN CLASSES 18, 21, 25 & 28

AND:

**OPPOSITION THERETO UNDER NO. 102260
BY RENO SPORTSWEAR HANDELS GMBH**

BACKGROUND

1. On 14 April 2011, Team Magnus Ltd (“Team”) applied to register the trade mark shown on the cover page of this decision. The application was accepted and published for opposition purposes on 6 May 2011 for the following goods:

Class 18: Trunks and travelling bags; handbags, rucksacks, purses; umbrellas, parasols and walking sticks.

Class 21: Household or kitchen utensils and containers; combs and sponges; brushes; articles made of ceramics, glass, porcelain or earthenware which are not included in other classes; electric and non-electric toothbrushes.

Class 25: Clothing, footwear, headgear.

Class 28: Games and playthings; playing cards; gymnastic and sporting articles; decorations for Christmas trees; childrens' toy bicycles.

2. On 5 August 2011, Reno Sportswear Handels GmbH (“Reno”), filed a notice of opposition directed against all of the goods in Team’s application. Reno’s opposition is based upon a single ground under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) for which it relies upon the following trade mark registrations:

Trade Mark	No.	Application Date	Registration Date	Goods and services relied upon
IGUANA	CTM 3001617	9.1.2003 IC claimed 9.8.2002 (Germany)	20.6.2005	<p>18 - Bags, pouches, suitcases and luggage of all kinds, included in class 18, in particular rucksacks, haversacks, knapsacks, travelling bags, suitcases, sports bags, casual bags, not of leather.</p> <p>20 - Sleeping bags, deckchairs, loungers, mats and air beds, mooring buoys, wickerwork, baskets, tent pegs.</p> <p>22 - Tents, hammocks, awnings and tarpaulins, sails.</p> <p>28 - Sporting articles, roller skates, inline skates, skateboards, sledges, bob-sleighs, skis, ice skates, snowboards, swingboards, surfboards, balls, tennis racquets, tennis bags, golf clubs, golf bags, cricket</p>

				bags, paragliders, hang-gliders.
	M715792	18.5.1999 IC claimed 18/11/1998 (Germany)	29.8.2004	25 - Clothing of all kinds, included in this class, especially leisure wear, sportswear, ski wear and beach wear, clothing of leather, head coverings, especially caps and hats, gloves; footwear, especially sports and leisure shoes; clothing accessories, namely headbands.
	M765164	20.6.2001 IC claimed 22/12/2000 (Germany)	1.03.2002	25 - Clothing of all kinds, as far as included in this class, especially leisure, sports, ski and beach clothing, leather garments, head coverings, especially caps and hats; gloves; garment accessories, namely headbands; footwear, especially sports and leisure shoes.

3. In its notice of opposition Reno said:

“3. The sign in the application shares visual, phonetic and conceptual similarities with all of the earlier trade marks. The sign contains the word IGUANA which is identical to the earlier [CTM] and also contains a representation of an iguana which is visually similar and conceptually identical to the earlier UK designation marks.

4. The application covers goods in classes 18, 21, 25 and 28 which are identical and similar to the goods covered by the earlier registrations...”

4. On 25 October 2011, Team filed a counterstatement which consists, in essence, of a denial of the ground upon which the opposition is based. Having explained the history of the company and its investigations into Reno’s use of its various trade marks, Team explain, inter alia, that following Internet searches:

“...the use of the Iguana and an Iguana character is wide – both for, and outside of, corporate branding and has a large variety of examples in e.g. T-shirts”:

“...the use of the words Life Wear are demonstrably wide spread both for, and outside of, corporate branding”.

Team go on to say:

“When assessing similarities of the marks...it could be argued that the distinctive character of the earlier trade mark is the word Iguana. This on its own is not

distinctive given that it is a word found in the dictionary. Further, as outlined earlier, there are many existing products and services not instantly associated with the Iguana using the word Iguana or a character appearing like an Iguana so it is therefore considered difficult to believe that our mark will create confusion not least when considered as a whole.

From Internet searches it would appear reasonable to conclude that the word Iguana and the phrase "LifeWear" on their own provide little consumer recognition for [Reno] but the phrase "Iguana Life Wear" does. The "phrase Bahamas rock iguana" is significantly different from "Iguana Life Wear" and as such is considered unlikely to confuse the average consumer. Especially so when combined with demonstrably different artwork."

5. Both parties filed evidence and/or submissions during the evidential rounds. Although neither party asked to be heard, Reno filed submissions in lieu of attendance at a hearing. I will to these various submissions as necessary below.

6. On 13 November 2012, I wrote to the opponent's professional representatives, Boulton Wade Tennant ("BWT"). I said, inter alia:

"Having reviewed the pleadings, evidence and submissions, I note that in its notice of opposition Reno indicates that it opposes all of the goods in the application for registration.

However, if my understanding of its written submissions dated 20 January and 1 August 2012 is correct, it appears that its opposition is no longer directed at: "umbrellas, parasols and walking sticks" in class 18, all of the goods in class 21 and "playing cards, decorations for Christmas trees and children's toy bicycles" in class 28 (collectively "the named goods").

You are now allowed until Friday 16 November to confirm my understanding of the position is correct..."

7. In a letter dated 16 November, BWT confirmed that the opposition was no longer directed at the goods mentioned above.

EVIDENCE

Reno's evidence

8. This consists of an undated witness statement from Rachael Conroy, a trade mark attorney at BWT. Exhibit RMC01 consists of two pages downloaded from the free encyclopedia *Wikipedia* on 3 January 2012. The page indicates, inter alia, that:

"The Northern Bahamian Rock Iguana...is a species of Lizard of the genus *Cyclura* that is found on the Andros and Exuma islands in the Bahamas. Its

status is vulnerable, with a wild population of less than 5,000 animals, and it can be found on the IUCN Red List.”

9. Exhibits RMC02 and RMC03 consist of pages downloaded on 30 December 2011 from www.snockandrock.com (in relation to the Salomon Brand) and www.surfboards.quiksilver-europe.com (in relation to the Quiksilver brand) respectively. Of these exhibits Ms Conroy says:

“3...which shows that skis, snowboards, helmets and ski clothing are sold under the same brand SALOMON”.

4....which shows that surfboards, wetsuits and clothing are sold under the same brand QUIKSILVER.”

Team’s evidence

10. This consists of a witness statement, dated 23 February 2012, from Alan Moody, a director of Team. Exhibits AJM01 and AJM02 are said to consist of extracts from www.iguana-world.com and www.iguana-world.com which Mr Moody explains provides information on Reno’s products and the company that owns it. While these exhibits suggest that Reno is a company dealing primarily in articles of clothing, as Reno has not been asked to provide proof of use (see paragraph 15 below), these exhibits do not assist Team. Exhibits AJM03 and AJM04 consist of pages downloaded on 23 February 2012 from www.teamiguanasports.com and www.iguanawatersports.com. As these websites relate to undertakings based in Miami Beach Florida and Lake of the Ozarks Missouri (i.e. they are not undertakings located in the United Kingdom) once again they are of no assistance to Team in these proceedings. Exhibit AJM05 consists of a page downloaded on 23 February 2012 from www.m.debenhams.com which shows what is described as a “Boy’s orange iguana print t-shirt.” The t-shirt shown appears to be pink and bears an image of a blue and white iguana wearing sunglasses which is accompanied by the phrase “I is for iguana”. Exhibit AJM06 consists of 3 pages downloaded on 23 February 2012 from www.shop.cafepress.co.uk/iguana. The first page is entitled “Iguana Presents & Gifts” and shows a range of items which Mr Moody notes includes “a range of T-shirts with the word Iguana or a device appearing like an Iguana or incorporating the word Iguana which are available for sale in the UK.” Exhibit AJM07 consists of 3 pages downloaded on the same date and from the same website mentioned in relation to exhibit AMJ06. The first page is entitled “Iguana Bags” which Mr Moody notes shows “a range of bags with the word Iguana or Iguana image available for sale in the UK.” Finally, Mr Moody explains that the trade mark the subject of the application was first used in the UK in the summer of 2011 (i.e. there was no use prior to the date of application).

Reno’s evidence-in-reply

11. This consists of a second undated witness statement from Ms Conroy accompanied by 1 exhibit. As Ms Conroy explains, Exhibit RMC01 consists of a range of invoices

issued by Reno and addressed to TJX UK at an address in Watford. All of the invoices (dated 20 July 2006 (value €25,274), 28 September 2007 (value €12,485), 24 July 2008 (value €32,398), 24 August 2009 (value €39,451) and 17 June 2010 (value €13,968)), identify the range as "Iguana" and appear to be primarily in respect of goods described as "jackets", "pant" and "fleece". In the top left hand corner of each invoice appears a representation of a trade mark substantially the same as no. M715792 (but without the border and background shading and accompanied by the legend "since 1991"); also appearing in the top left corner of each invoice is trade mark no. M765164 underneath which appears text too indistinct to be made out.

12. That concludes my summary of the evidence filed to the extent that I consider it necessary.

DECISION

13. Section 5(2)(b) of the Act reads as follows:

"5(2) A trade mark shall not be registered if because -

(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, or

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

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

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered."

15. In these proceedings Reno is relying upon the 3 trade marks shown in paragraph 2 above, all of which constitute earlier trade marks under the above provisions. Given the interplay between the date on which Team's application for registration was published i.e. 6 May 2011 and the dates on which Reno's earlier trade marks completed their

registration procedure, Reno's registrations are, in principle, subject to proof of use, as per The Trade Marks (Proof of Use, etc) Regulations 2004. However, by Team answering "NO" to question 5 of the counterstatement i.e. "Do you want the opponent to provide proof of use?", it is not necessary for Reno to provide evidence to show that they have actually used the trade marks upon which they rely in these proceedings. As a consequence, Reno can rely upon all of the goods for which its earlier trade marks are registered/protected.

Section 5(2)(b) – case law

16. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* -BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the CJEU cases mentioned) on the basis indicated below:

The CJEU cases

Sabel BV v Puma AG [1998] RPC 199; Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc [1999] RPC 117; Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V. [2000] F.S.R. 77; Marca Mode CV v Adidas AG & Adidas Benelux BV [2000] E.T.M.R. 723; Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-6/01; Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH C-120/04; Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P.

The principles

(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 nature of the purchasing process

17. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods and then to determine the manner in which these goods will be selected by the average consumer in the course of trade. In its submissions Reno said:

“The goods at issue here are not of a specialist nature and will be purchased by members of the general public. They are not highly considered purchases and no more than an average degree of consideration will be deployed by the average consumer when selecting the goods.”

18. In its submissions Team said:

“g. We believe that the average consumer can differentiate products based on price, look, colour, texture, place of manufacture, size, target market as well as where the product is purchased...”

And:

“b. [Reno] have incorrectly assumed that [Team] will sell its range through trade channels (high street store outlets). This is incorrect. As previously stated...[Team] sells its goods through its website, through its catalogues and through consumer shows, mainly horse trials. Therefore [the parties’ products] will not appear in the same store, let alone side by side.”

19. In its further submissions Reno said:

“Furthermore, [Team’s] target consumer market and channels of trade are irrelevant since neither the application or the earlier registrations are limited in any way...”

20. The goods at issue in these proceedings are (broadly speaking) bags, clothing, playthings and sporting articles. Such goods will be sold in, inter alia, traditional retail outlets on the high street, through catalogues and on the Internet. As neither party’s specifications are limited in any way, I must, as Reno argues, keep all of these trade channels in mind. The average consumer of the goods at issue is a member of the general public who is likely, in my view, to select the goods by predominantly visual means (although I think more expensive items in each category may be the subject of some research and/or discussions with sales staff (where possible) prior to selection)). In this respect, I note that in *New Look Ltd v OHIM Cases - T-117/03 to T-119/03 and T-171/03*, the General Court (GC) said this about the selection of clothing:

“50. Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

21. As to the degree of care the average consumer will display when selecting clothing, in the same case the court said:

“43 It should be noted in this regard that the average consumer’s level of attention may vary according to the category of goods or services in question (see, by analogy, Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26). As OHIM rightly pointed out, an applicant cannot simply assert that in a particular sector the consumer is particularly attentive to trade marks without supporting that claim with facts or evidence. As regards the clothing sector, the Court finds that it comprises goods which vary widely in quality and price. Whilst it is possible that the consumer is more attentive to the choice of mark where he or she buys a particularly expensive item of clothing, such an

approach on the part of the consumer cannot be presumed without evidence with regard to all goods in that sector. It follows that that argument must be rejected.”

22. While I accept that the average consumer’s level of attention is likely to be heightened when selecting, for example, an article of technical clothing for use in skiing, it is also, in my view, likely that the same average consumer’s level of attention will diminish when selecting, for example, an inexpensive pair of socks. While these examples demonstrate that the average consumer’s level of attention will vary considerably depending on the cost and nature of the item at issue, I think that when selecting even routine items of clothing the average consumer is (as Team argue) likely to be conscious of factors such as the size, colour, material and price of the item concerned. Overall, I think the average consumer is likely to pay at least a reasonable degree of attention to the selection of articles of clothing.

23. In my view, many of the same considerations mentioned above also apply to the goods in classes 18 and 28 i.e. the purchasing act is likely to be predominantly visual with the degree of care taken varying depending on the cost and importance of the item at issue. For example, insofar as class 18 is concerned, one would expect the average consumer to pay quite a high degree of attention when selecting a handbag costing thousands of pounds or a technical rucksack for use in extreme conditions, and a much lower degree of attention when selecting a purse for everyday use. Similarly, the average consumer is likely, in my experience, to pay quite a high degree of attention to the selection of some sporting articles such as golf clubs and a no higher than average degree of attention to the selection of relatively inexpensive board games.

Comparison of goods

24. The leading authorities on how to determine similarity between goods and services are considered to be *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117 and *British Sugar Plc v James Robertson & Sons Ltd (Treat)* [1996] R.P.C. 281. In the first of these cases the CJEU accepted that all relevant factors should be taken into account including the nature of the goods/services, their intended purpose, their method of use and whether they are in competition with each other or are complementary. The criteria identified in the *Treat* case were:

- (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.

25. In reaching a conclusion I will also keep in mind the decision of the GC in *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05 i.e.

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

26. In relation to complementary goods and services the comments of the Court of First Instance (now the General Court) in *Boston Scientific Ltd v OHIM* case T-325/06 are relevant:

“82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057; Case T-364/05 Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-757, paragraph 94; and Case T-443/05 El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños) [2007] ECR I-0000, paragraph 48).”

27. The competing goods are as follows:

Team's goods	Reno's goods
Class 18: Trunks and travelling bags; handbags, rucksacks, purses.	18 - Bags, pouches, suitcases and luggage of all kinds, included in class 18, in particular rucksacks, haversacks, knapsacks, travelling bags, suitcases, sports bags, casual bags, not of leather.
Class 25: Clothing, footwear, headgear.	20 - Sleeping bags, deckchairs, loungers, mats and air beds, mooring buoys, wickerwork, baskets, tent pegs.
Class 28: Games and playthings; gymnastic and sporting articles.	

	<p>22 - Tents, hammocks, awnings and tarpaulins, sails.</p> <p>28 - Sporting articles, roller skates, inline skates, skateboards, sledges, bob-sleighs, skis, ice skates, snowboards, swingboards, surfboards, balls, tennis racquets, tennis bags, golf clubs, golf bags, cricket bags, paragliders, hang-glidiers.</p> <p>25 - Clothing of all kinds, included in this class, especially leisure wear, sportswear, ski wear and beach wear, clothing of leather, head coverings, especially caps and hats, gloves; footwear, especially sports and leisure shoes; clothing accessories, namely headbands.</p>
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Class 18

28. The “travelling bags” and “rucksacks” in Team’s specification find identically worded terms in Reno’s CTM registration no.3001617 and are identical. The “handbags” and “trunks” in Team’s application would be encompassed by the word “bags” and the phrase “suitcases and luggage of all kind” in the same registration and are, on the principle outlined in *Meric*, also identical. That leaves “purses”. Comparing “purses” with “bags” in its specification, in its submissions, Reno said:

“The users of the goods would be the same general public and the goods are complementary to one another...it is common to purchase matching purses and bags, or a purse for the purpose of fitting within a particular bag”.

29. In my view, the competing goods are not complementary in the sense identified in *Boston Scientific* i.e. “one is indispensable or important for the use of the other.” However, given that bags (particularly handbags) and purses may have the same users, the same physical nature, similar but not identical uses, may be sold in close proximity to one another in, for example, department stores and may, to a limited extent, be in competition with one another, results, in my view, in quite a high degree of similarity between them.

Class 25

30. “Clothing” and “footwear” in Team’s application are identical to the “clothing of all kinds included in this class especially...” and “footwear, especially...” in Reno’s registration no. M715792. As the “head coverings, especially caps and hats...headbands” in Reno’s registration mentioned above would be encompassed by the word “headgear” in Team’s application, the goods are, on the principles outlined in *Meric*, identical.


Class 28

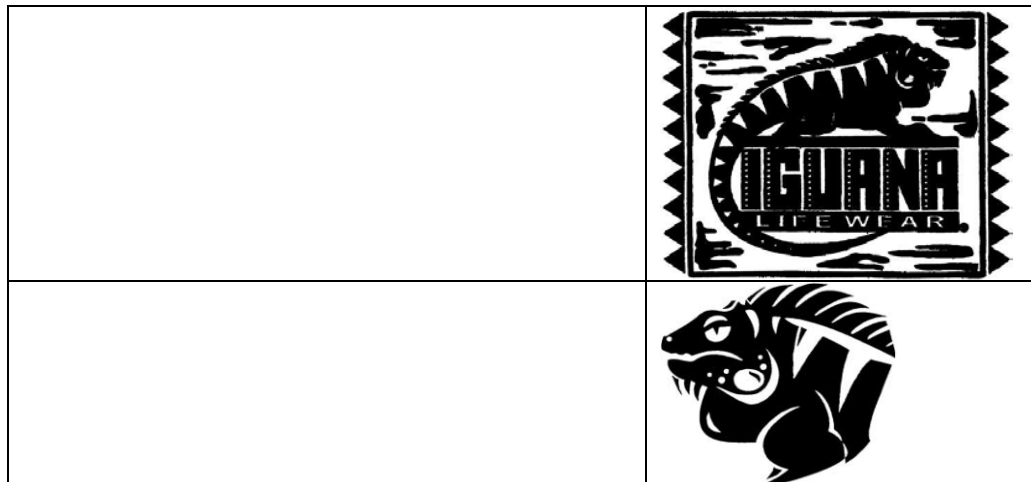
31. The “Gymnastic and sporting articles” in Team’s application are (given that the phrase “sporting articles” would include “gymnastic articles”) identical to the “sporting articles” in Reno’s CTM registration no. 3001617. That leaves “games and playthings” in Team’s application to consider. These are broad terms that include a wide range of differing goods. For example, the term “games” would include electronic games, board and parlour games as well as bowls, dart and hockey games. Similarly, the term “playthings” would include educational playthings, playthings for babies, sandboxes, scale model vehicles, sledges and trains sets.

32. As the “games” in Team’s application would include games based upon a range of sports (for example hockey), the respective users may be the same, the games may utilise similar accessories (such as hockey sticks and balls) and as both may involve varying degrees of physical activity, there is, having applied the case law mentioned above, I think, a degree of similarity between “games” at large and the “sporting articles” in Reno’s registration. However, there is, in my view, no similarity between Reno’s “sporting articles” (or any of its other goods) and a range of named goods that would fall within the term “games”, such as board and parlour games. As the term “playthings” at large in Team’s application would include, for example, the “balls” and “sledges” in Reno’s registration, on the *Meric* principle, those parts of the competing specifications must be considered identical. However, much like games at large, the term playthings at large includes a range of named goods, for example, scale models, train sets etc. which would not be similar to any of Reno’s goods. I will return to this point when I consider the likelihood of confusion.

Comparison of trade marks

33. The trade marks to be compared are as follows:

Team’s trade mark	Reno’s trade marks
	IGUANA



34. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as a whole and does not pause to analyse their various details. In addition, he/she rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he/she has kept in his or her mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant elements of the respective trade marks and, with that conclusion in mind, I must then go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

Distinctive and dominant components

35. In its counterstatement Team describes its trade mark in the following terms:

“Our multicolour cartoon figure...The figure has nautical connotations, peering through a porthole with water bubbles and webbed fingers. Bahamas rock iguana is a markedly more specific name than Iguana both in sound and in associations...”

36. Team’s trade mark consists of a number of elements i.e. the word BAHAMAS ROCK IGUANA presented in upper case and accompanied by devices of a star before and after the words (all presented in green), a stylised representation of the head and upper body of what is obviously intended to be an iguana (presented in the same colour green), a circular device the outermost parts of which are presented in various shades of green, and which has a background presented in blue containing six circular elements presented in white. Although it contains a number of elements, it is, in my view, the words BAHAMAS ROCK IGUANA and the stylised device of an iguana that are, by virtue of their size and positioning, the dominant elements of Team’s trade mark.

37. Reno relies on three earlier trade marks. As trade mark no. CTM 3001617 consists exclusively of the word IGUANA presented in upper case, there can be no distinctive and dominant elements, the distinctiveness lying in the trade mark as a whole. In addition, as per the decision of the CJEU in Case C-196/11 P, *Formula One Licensing*

BV v OHIM, Global Sports Media Ltd, it is not permissible (despite Team's arguments) to regard the earlier mark as having no distinctive character.

38. In its submissions Team describes Trade mark no. M715792 thus:

“A square shaped, black and white picture with serrated edgings containing the words Iguana Life wear wrapped inside the realistic looking tail and body of a severe looking Iguana”.

39. In my view, and as Team accepts, the trade mark consists of a realistic device of an iguana presented in black and white below which appears above the word IGUANA presented predominantly in black upper case letters in a stylised but unremarkable font, below which appears the words LIFE WEAR presented in white in upper case letters. These elements are enclosed in a square border with a predominantly white background with what Team describes as “serrated edgings”. The device of an iguana and the word IGUANA are, once again, by virtue of their size and positioning the dominant elements of the trade mark. In its counterstatement, Team argue that the words LIFE WEAR are “demonstrably wide spread both for, and outside of, corporate branding”. Not only (given their size and positioning) do the words LIFE WEAR lack dominance, but on Team's own argument, they also lack distinctive character; I shall proceed on this basis.

40. Insofar as trade mark no. M765164 is concerned, this consists of a device element no one part of which is more dominant than another; consequently, the distinctiveness lies in the totality. In its submissions Team argue that it would be seen as “a device with a reptilian head...” That, in my view, is a fair characterisation of the trade mark. In addition, whilst Reno argues that it contains a visual representation of an iguana, absent any other prompt, I agree with Team that it “cannot, objectively, be seen to be that of an Iguana...and does not contain the word Iguana”.

41. A good deal of Team's evidence and submissions deals with the distinctiveness or otherwise of the word IGUANA and the device of an iguana in relation to goods in classes 18 and 25; I have already commented on how I am required to approach the registration of the word IGUANA in trade mark no. CTM 3001617 in paragraph 37 above. Having commented on exhibits AJM03 and AJM04 i.e. use outside of the jurisdiction (and, in my view, trade mark use in any case), in its submissions, Reno says of the evidence which originates from the UK:

“[Team] has managed to find a few examples of iguanas on bags and on some items of clothing within the jurisdiction. However, the parties behind these items are clearly not seeking to use the iguana to indicate the trade origin of the products. This is different from the intention of [Reno] who clearly wants to use the sign applied for to indicate the origin of its products...”

42. Exhibits AJM05 to AJM07 were all downloaded on 23 February 2012 i.e. some 10 months after the material date in these proceedings i.e. the date of Team's application

for registration. While that alone may not be fatal to Team's argument, the fact that these exhibits relate to only three undertakings i.e. bluezoo (sold by Debenhams) and cafepress, and bearing in mind that these undertakings use the word iguana and the device of an iguana in a decorative rather than in a trade mark sense, results, in my view, in this evidence falling a long way short of establishing that at the material date the word iguana and the device of an iguana ought to be considered lacking in distinctive character for any of the goods for which Reno's trade marks are registered.

43. I therefore find that: the words BAHAMAS ROCK IGUANA and the stylised device of an iguana are both distinctive and dominant elements of Team's trade mark, and that both the word IGUANA alone (in CTM no. 3001617) and the word IGUANA and the device of an iguana are the distinctive and dominant elements of no. M715792.

44. I will approach the comparison of the trade marks with those conclusions in mind. However, as trade mark no. M765164 does not contain the word iguana and as I agree with Team that it would not be seen as an iguana, this trade mark is not, in my view, visually, aurally or conceptually similar to Team's trade mark in any way and as such, I need say no more about it.

Visual similarity

45. Although Team's trade mark is presented in colour, as Reno's trade marks are presented in black and white this does not, for the reasons given by Mann J *in Specsavers International Healthcare Ltd v Asda Stores Ltd* (No. 2) [2011] FSR 1, assist in distinguishing the competing trade marks. The only similarity between Team's trade mark and CTM no. 3001617 is the word IGUANA, which, in my view, results in the competing trade mark being similar to only a low degree.

46. Insofar as Reno's trade mark no. M715792 is concerned, both parties' trade marks contain the word IGUANA and representations (albeit very different representations) of what is clearly intended to be an iguana. The significant differences in presentation results, once again, in the competing trade marks having only a low degree of visual similarity.

Aural similarity

47. It is well established that where words appear in a composite trade mark, the average consumer will refer to the trade mark by the word elements. Team's trade mark will be referred to by the average consumer as BAHAMAS ROCK IGUANA and Reno's trade marks as IGUANA and (possibly) IGUANA LIFE WEAR, although given the relative size of the word elements it is debatable, particularly bearing in mind Team's submission to the effect that LIFE WEAR is non-distinctive, if the average consumer would articulate the words LIFE WEAR. Regardless, the presence in both parties' trade marks of the word IGUANA results, in my view, in a reasonable degree of aural similarity between them, and a somewhat lesser degree of aural similarity if the words LIFE WEAR are articulated.

Conceptual similarity

48. The concept both parties' trade marks will create in the average consumer's mind is one relating to iguanas. Although I am now aware that Team's trade mark relates to a specific type of iguana, I doubt that this fact would be known to the average consumer of the goods at issue in these proceedings. Of course if it were, then the concept both parties' trade marks would convey would still focus on iguanas, albeit that Team's trade mark would relate to a sub-set of the lizard identified in Reno's trade marks. If, as I suspect, the average consumer would not be familiar with the Bahamas Rock Iguana, and as these words will not, in my view, create an identifiable concept in the mind of the average consumer beyond that of an iguana, the competing trade marks are, as a result, conceptually similar to a high degree.

Distinctive character of Reno's earlier trade marks

49. I must now assess the distinctive character of Reno's trade marks. The distinctive character of a trade mark can be appraised only, first, by reference to the goods for which it is registered and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

50. I have already commented on, and dismissed, Team's argument that, on the basis of the evidence provided, the word iguana and the device of an iguana were, at the material date in these proceedings, lacking in distinctive character for the goods at issue (I have also commented on the approach the law requires me to adopt in relation to the word IGUANA in CTM no. 3001617). Although Reno have provided 5 invoices dated between 2006 and 2010 indicating that a range of what appear to be predominately jackets, pants and fleeces have been sold to a company called TJX UK based in Watford, there is no indication who TJX UK are or their relationship to Reno. In addition, I noted, inter alia, that while the product range was identified in the invoices as "Iguana", one of the trade marks which appear on the invoices is somewhat different to the trade mark the subject of registration no. M715792 and that the other trade mark appearing on the invoices the subject of registration no. M765164 contained additional text which could not be read. However, even if all of these points were resolved in Reno's favour, 5 invoices over a period of five years disclosing sales totalling some €120,000 would not, given the obvious size of the market for clothing in the UK, have built upon the inherent qualities of Reno's trade marks in relation to its goods in class 25 in any case, let alone in relation to the other goods for which Reno's trade marks are registered and for which no use has been provided. Bearing all of the above in mind, I find that Reno's trade marks are possessed of a normal level of inherent distinctiveness which, on the basis of

the evidence provided, has not (insofar as the use only relates to goods in class 25) been built upon to any appreciable extent by the use made of them.

Likelihood of confusion

51. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to factor in the distinctive character of Reno's trade marks as the more distinctive these trade marks are the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision I concluded that:

- the average consumer of the goods at issue is a member of the general public who is likely to select the goods by predominantly visual means and whose level of attention will vary from no higher than average in relation to some goods (boards games for example) to quite high in relation to the selection of, for example, technical rucksacks/clothing and some sporting articles;
- the goods in class 18 are identical or similar to quite a high degree;
- the goods in class 25 are identical;
- the goods in class 28 are in part identical, in part similar, and in part dissimilar;
- the words BAHAMAS ROCK IGUANA and the stylised device of an iguana are the distinctive and dominant elements of Team's trade mark;
- the distinctiveness of Reno's trade mark CTM no. 3001617 lies in the trade mark as a whole;
- the word IGUANA and the device of an iguana are the distinctive and dominant elements of Reno's trade mark no. M715792;
- Reno's trade mark no. M765164 is not visually, aural or conceptually similar to Team's trade mark;
- Reno's remaining trade marks have only a low degree of visual similarity to Team's trade mark;
- Reno's remaining trade marks have (at best) a reasonable degree of aural similarity to Team's trade mark;

- Reno's remaining trade marks and Team's trade mark are conceptually similar to a high degree;
- Reno's remaining trade marks are possessed of a normal level of inherent distinctive character which, insofar as class 25 is concerned, has not, on the basis of the evidence provided, being improved upon.

52. Having assessed the degree of visual similarity between the competing trade marks as low, and the degree of aural similarity as (at best) reasonable, and having concluded that the average consumer will select the goods by primarily visual means, this may suggest there is no likelihood of confusion. However, in reaching a conclusion I note that in *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, in which the CJEU said:

“29. In the context of consideration of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see *Matratzen Concord*, paragraph 32).

30. However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.

31. In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.

32. The finding that there is a likelihood of confusion should not be subject to the condition that the overall impression produced by the composite sign be dominated by the part of it which is represented by the earlier mark.

33. If such a condition were imposed, the owner of the earlier mark would be deprived of the exclusive right conferred by Article 5(1) of the directive even where the mark retained an independent distinctive role in the composite sign but that role was not dominant.

34. This would be the case where, for example, the owner of a widely-known mark makes use of a composite sign juxtaposing this mark and an earlier mark which is not itself widely known. It would also be the case if the composite sign was made up of the earlier mark and a widely-known commercial name. In fact, the overall impression would be, most often, dominated by the widely-known mark or commercial name included in the composite sign.

35. Thus, contrary to the intention of the Community legislator expressed in the 10th recital in the preamble to the directive, the guarantee of the earlier mark as an indication of origin would not be assured, even though it still had an independent distinctive role in the composite sign.”

53. I begin by reminding myself that Reno’s trade mark CTM no. 3001617 consists exclusively of the word IGUANA, and that the law requires me to assume that this trade mark has some distinctive character. Having applied the guidance in *Medion*, I find that, inter alia, the word IGUANA plays an independent distinctive role in Reno’s trade mark no. M715792 and that, inter alia, the words BAHAMAS ROCK IGUANA plays an independent distinctive role in Team’s application for registration. While I accept that the device elements in the competing trade marks are quite different, the word elements present in the respective trade marks lead the average consumer to treat the differing devices as iguanas, resulting in the high degree of conceptual similarity I have identified above which, in my view, compensates for the low and reasonable degrees of visual and aural similarity. While the differences between the competing trade marks is more than sufficient to avoid direct confusion (i.e. where one trade mark is mistaken for the other), the high degree of distinctive conceptual similarity resulting from the use of the word IGUANA and devices of iguanas, will, when used on goods which are identical or similar, lead, in my view, the average consumer to confuse the trade marks indirectly i.e. they will assume the goods of Team come from an undertaking economically linked to Reno.

Interim decision

54. As a result of the above conclusion, Reno’s opposition succeeds in relation to:

all of the opposed goods in Team’s application in classes 18 and 25 and in relation to “Gymnastic and sporting articles” in class 28.

55. The goods in Team’s application which, in its letter of 16 November, Reno indicated are no longer open to opposition i.e.:

“umbrellas, parasols and walking sticks” in class 18;

all of the goods in class 21;

and

“Playing cards, decorations for Christmas trees and children’s toy bicycles” in class 28,

Will, in due course, proceed to registration.

56. That leaves “games and playthings” in class 28. As I indicated at paragraphs 31 and 32 above, these are broad terms which would include a range of goods which are not similar to any of Reno’s goods. In approaching this matter, I am guided by the approach outlined in Tribunal Practice Notice (TPN) 1 of 2012 entitled “Partial Refusal”, the relevant part of which reads:

“3.2.2. Defended Proceedings

c) If the Hearing Officer considers that the proceedings are successful against only some of the goods/services, but the result of the proceedings cannot be clearly reflected in the application through the simple deletion of particular descriptions of goods/services, or by adding a "save for" type exclusion, then the Hearing Officer may indicate the extent to which the proceedings succeed in his/her own words. The parties will then be invited to provide submissions/proposals as to the appropriate wording for a list of goods/services that reflects his/her findings and after considering the parties’ submissions, the Hearing Officer will determine a revised list of goods/services. Subject to appeal, the trade mark will be, or remain, registered for this list of goods/services.

d) This third approach will be taken when a Hearing Officer considers that there is real practical scope to give effect to Article 13, having due regard to the factors in each individual case. For example, the original specification of the international trade mark registration which was the subject of *Giorgio Armani SpA v Sunrich Clothing Ltd* (cited above) was clothing, shoes, headgear. The successful opposition only opposed the registration to the extent that it covered “men’s and boys’ clothing”, thereby leaving other goods covered by the specification as unobjectionable. Such an outcome could not be reflected in changes to the specification via either the „blue pencilling’ approach or the „save for’ type of exclusion. The specification was reworded and the international registration was eventually protected for a specification reading Clothing for women and girls, shoes and headgear. Generally speaking, the narrower the scope of the objection is to the broad term(s), compared to the range of goods/services covered by it, the more necessary it will be for the Hearing Officer to propose a revised specification of goods/services. Conversely, where an opposition or invalidation action is successful against a range of goods/services covered by a broad term or terms, it may be considered disproportionate to embark on formulating proposals which are unlikely to result in a narrower specification of any substance or cover the goods or services provided by the owner’s business, as indicated by the evidence. In these circumstances, the trade mark will simply

be refused or invalidated for the broad term(s) caught by the ground(s) for refusal. “

57. Team are allowed 21 days from the date of this decision to consider my comments at paragraphs 31 and 32 above and to provide me with submissions/proposals for a list of goods which fall within the broad phrase “games and playthings” which, in its view, do not clash with Reno’s goods in class 28. These submissions should be copied to BWT, who will then be allowed a further 21 days from receipt of Team’s submissions to provide any submissions they may have on Team’s proposals. I will review both parties’ submissions and issue a supplementary decision in which I will also determine costs.

58. The period for any appeal against this decision will run concurrently with the appeal period for the supplementary decision and so will not commence until the supplementary decision is issued.

Dated this 5th day of December 2012

**C J BOWEN
For the Registrar
The Comptroller-General**