

O-337-16

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 3022359
BY MR KULDIP SINGH PALAK
TO REGISTER THE FOLLOWING TRADE MARK IN CLASSES 9 & 25:**

**RHINO
*tec***

AND

**OPPOSITION THERETO (NO. 401833) BY
RHINO RUGBY LIMITED**

Background and pleadings

1. This dispute concerns whether the following trade mark should be registered for the following goods:

The logo consists of the word "RHINO" in a large, bold, black, sans-serif font. Below it, the word "tec" is written in a smaller, black, italicized, sans-serif font.

Class 9: Safety helmets; hard hats; protective ear coverings; earmuffs; eyeglass shields; shields for protecting the faces of workmen; face-protection shields; anti-glare visors; protective face-shields for protective helmets; ear phones; disposable latex gloves for laboratory use; gloves for protection against injury; fire resistant gloves; optical glasses; optical lenses; toe caps; all of the aforesaid goods being for protection in industrial, construction, manufacturing and/or welding applications; visors for the protection of welders; welding helmets; parts and fittings for all the aforesaid goods.

Class 25: Jackets, gaiters, aprons, caps and gloves; all being articles of workwear for use in industry, construction, manufacturing and welding.

The above specification is the result of a restriction made during the course of the proceedings.

2. The mark was filed on 17 September 2013 by Mr Kuldip Singh Palak (“the applicant”) and it was published for opposition purposes on 6 December 2013.

3. Rhino Rugby Limited (“the opponent”) oppose the registration of the mark under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), claiming that there is a likelihood of confusion with three earlier trade marks it owns. The opponent also initially pleaded under sections 5(3) and 5(4)(a) of the Act, but such grounds were struck out as no evidence was filed in support of them. The details of the three earlier marks relied upon are as follows:

UK trade mark registration 2471901 for the mark: **RHINO PURE RUGBY**

The mark was filed on 9 November 2007 and registered on 30 September 2011. It is registered for the following goods:

Class 18: Rugby products comprising goods of leather and imitation leather, luggage, bags, umbrellas, sports bags, kit bags, ball bags, wallets and purses intended to be sold or purchased for use in connection with the game of rugby.

Class 25: Rugby clothing (but not including footwear) and rugby headgear intended to be sold or purchased for use in connection with the game of rugby.

Class 28: Sporting articles and equipment; physical training equipment and apparatus; rugby training equipment including scrummage training machines, tackle bags, contact pads, body pads, rucking nets, training poles, grid markers, protective pads and body supports; rugby ground equipment including goal posts, post padding, flags and poles; kicking tees and rugby balls.

UK trade mark registration 2535347 for the mark: **RHINO**

The mark was filed on 24 December 2009 and registered on 27 July 2012. It is registered for the following goods:

Class 25: Rugby clothing (but not including footwear) and rugby headgear intended to be sold or purchased in connection with the game of rugby; none of the aforementioned relating to the rugby league football team known as Leeds Rhinos

European Union trade mark registration 4622155 for the mark:



The mark was filed on 11 October 2005 and registered on 14 June 2012. It is registered for the following goods:

Class 18: Goods of leather and imitation leather; luggage; bags; umbrellas; sports bags; kit bags; ball bags; wallets and purses; all these goods being rugby products.

Class 25: Clothing and headgear; all these goods being rugby products.

Class 28: Sporting articles and equipment; physical training equipment and apparatus; rugby training equipment including scrummage training machines, tackle bags, contact pads, body pads, rucking nets, training poles, grid markers, protective pads and body supports; rugby ground equipment including goal posts, post padding, flags and poles; kicking tees and rugby balls; all these goods being rugby products.

4. It should be noted that none of the earlier marks were registered more than five years prior to the date of publication of the applicant's mark. The consequence of this is that there is no requirement for the opponent to prove that its earlier marks have been used and it may, therefore, rely on them for their specifications as registered; section 6A of the Act refers. The main points made by the opponent in its statement of case are that:

- i) The applicant's mark predominantly comprises the word RHINO which is identical to the main distinctive element in the earlier marks.
- ii) The addition of TEC does nothing to distinguish and "may even reinforce the likelihood that consumers will believe that the opposed mark is in some

way associated with the earlier trade marks as perhaps a sub brand thereof”.

- iii) The applied for class 25 goods are the same or closely similar to goods contained in the earlier marks.
- iv) The class 9 goods are also the same or similar. It is added that the goods may move through the same channels of trade, to the same end users, and have a common purpose.
- v) The earlier marks have a reputation.
- vi) The above leads to a likelihood of confusion.

5. The applicant filed a counterstatement denying the claims. The main points made by the applicant in his counterstatement are that:

- i) It is accepted that RHINO is the predominant part of the applicant’s mark, but it is not accepted that TEC does nothing to assist in distinguishing.
- ii) It is not admitted that all of the applied for class 25 goods are the same or similar.
- iii) It is denied that the class 9 goods are similar to goods of the earlier marks.
- iv) The opponent is put to proof on its claim to a reputation.
- v) Having regard to the differences in marks and goods, there is no likelihood of confusion

6. Both sides have been professionally represented throughout the proceedings, the applicant by Silverman Sherliker LLP, the opponent by Sanderson & Co. Neither side filed evidence, although the opponent did file a set of written submissions dated 18 January 2016. Neither side asked to be heard, but both filed written submissions in lieu of a hearing.

7. During the proceedings the opponent requested security for costs due to the applicant having failed to pay a costs award made against him in previous proceedings. The Tribunal directed that security for costs in the sum of £1500 was appropriate in such circumstances, however, the parties came to some form of agreement, by way on undertakings, in relation to this matter so I need say no more about this.

Section 5(2)(b)

8. Section 5(2)(b) of the Act states that:

“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,

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

9. The following principles are gleaned from the judgments of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

(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 be dominated by one or more of its components;

(f) however, it is also 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 greater 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 creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

10. When making a comparison, all relevant factors relating to the goods in issue should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23 of its judgment:

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

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

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

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

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

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

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

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

12. In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v OHIM* Case T- 325/06 it was stated:

“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).”

13. In relation to complementarity, I also bear in mind the guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case B/L O/255/13 *LOVE* where he warned against applying too rigid a test:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in Boston is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to Boston.”

14. In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade”¹ and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning². I also note the judgment of Mr Justice Floyd (as he then was) in *YouView TV Limited v Total Limited* where he stated:

“..... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IPTRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of "dessert sauce" did not include jam, or because the ordinary and natural description of jam was not "a dessert sauce". Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

15. This is the type of case where a detailed assessment of the competing goods is required. I will begin with the class 25 goods which read:

Jackets, gaiters, aprons, caps and gloves; all being articles of workwear for use in industry, construction, manufacturing and welding.

16. I will come back to the other classes covered by the earlier marks, but for the time being I will compare the opponent’s class 25 specifications which read:

¹ See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

² See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

UK 2471909 - Rugby clothing (but not including footwear) and rugby headgear intended to be sold or purchased for use in connection with the game of rugby.

UK 2535347 - Rugby clothing (but not including footwear) and rugby headgear intended to be sold or purchased in connection with the game of rugby; none of the aforementioned relating to the rugby league football team known as Leeds Rhinos

EU 4622455 - Clothing and headgear; all these goods being rugby products.

17. Before making a comparison, it is useful to make some observations about the scope of the respective specifications. This is because the applicant makes much of the limitations applied to the specifications, whereas the opponent submits that the limitations have little impact because whether an item of clothing is for workwear, or whether it is for rugby, the inherent nature of the garment in question may be no different. The opponent also submits that the term workwear is broad because work could relate to anything, even the world of professional sportspeople.

18. The opponent's specifications cover what I will call rugby clothing and headwear. Whilst the specifications may not be worded in exactly the same way, the essence is the same. However, simply because the term clothing is used as part of the specifications does not mean that the term is a broad one because the rugby qualification must be taken to have some form of limiting effect. By way of example, jeans would not fall within the specification because such garments have nothing to do with rugby. In terms of what the specification does cover, it would, for obvious reasons, cover rugby shirts and shorts. It should also be noted that rugby shirts would include both professional items that a rugby player may wear, but would also cover more casual types of rugby shirt. I also consider that the specification would cover items which one may wear whilst rugby training such as tracksuits, hoodies/fleeces and even jackets and gloves for cold weather training. Other items would include training t-shirts and even undergarments such as compression/support trunks. In terms of headwear, this would not include items such as scrum caps

because such items fall in class 9 not in class 25. However, the terms would cover items that might be used for training.

19. The applicant's specification covers various specific items of clothing (jackets, gaiters, aprons, caps and gloves) which are qualified as items of workwear for use in particular fields (industry, construction, manufacturing and welding). The first point to note is that none of these items are for protective purposes as such goods fall in class 9 not class 25. The goods must therefore be relatively normal garments. I accept the opponent's submission that being workwear does little to change the inherent nature of the garment, neither does the identified field. I will now go through the applied for goods term(s) by term(s):

Jackets; all being articles of workwear for use in industry, construction, manufacturing and welding.

To put matters simply, a jacket is a jacket. Whilst it is possible for certain qualifications to impact on the nature of an item covered by a specification, here, it is quite possible for a jacket worn for rugby training to be highly similar in nature to a jacket for workwear in the listed fields. The main purpose of a jacket in either scenario is to provide an extra layer of insulation from the cold/wet. In terms of channels of trade, I have no reason to believe that workwear is sold only in specialist shops which means that they could be sold through general clothing outlets. Such outlets could also sell clothing for sporting purposes. The goods are highly similar even when the qualifications are taken into account.

Gaiters; all being articles of workwear for use in industry, construction, manufacturing and welding.

A gaiter is an item of clothing which covers the leg (or the lower part of the leg). The main purpose is normally to prevent water/mud ingress to the clothing below. There is nothing equivalent in the field of rugby as far as I know. The specific nature and purpose is different to rugby clothing. There is nothing to suggest that the channels of trade would overlap. The users could

overlap, but only in the sense that someone who may purchase rugby clothing could also purchase gaiters for work use. The points of similarity are superficial in the extreme. I consider the goods to be dissimilar. If I am wrong on this then any similarity must be extremely low.

Aprons; all being articles of workwear for use in industry, construction, manufacturing and welding.

An apron is an item of clothing worn around the torso, normally to prevent the soiling of the clothes that are worn below it. I consider that the assessment I have made with regard to gaiters is applicable here. I consider the goods to be dissimilar. If I am wrong on this then any similarity must be extremely low.

Caps; all being articles of workwear for use in industry, construction, manufacturing and welding.

The assessment I made in relation to jackets is equally applicable here as caps (or similar items) could be used in connection with rugby. The goods are highly similar even when the qualifications are taken into account.

Gloves; all being articles of workwear for use in industry, construction, manufacturing and welding.

In terms of the goods of the earlier marks, gloves could be used both in the playing of, and training for, rugby. They could be used for improving grip or keeping the hands warm. There is, therefore, little difference in terms of inherent nature and purpose. Bearing in mind the findings I have already made, the goods are highly similar even when the qualifications are taken into account.

20. I have considered whether the earlier marks' specifications beyond class 25 assist the opponent further. For the most part they do not. The only exception may be in relation to gaiters. This is because the class 28 specification of earlier mark 2471901 covers sporting articles without any form of qualification. The consequence

of this is that the term would cover fishing apparatus. The reason why this may put the opponent in a better position is because gaiters are a common type of clothing used in the field of fishing. However, one must bear in mind that the applicant's gaiters are not for fishing purposes and it is likely, in this case, that the channels of trade would be markedly different to fishing apparatus. Further, the nature and purpose will differ. The goods do not compete. Whilst there would be complementarity between gaiters for fishing and fishing apparatus, the same would not apply to gaiters as workwear in industry, manufacturing etc. Therefore, whilst I have considered the potentially better position, I still find that the goods are not similar, or if I am wrong on that then any similarity must be extremely low.

21. I next turn to consider the class 9 goods, most of which are qualified as "...being for protection in industrial, construction, manufacturing and/or welding applications". In my view, and in contrast with the class 25 goods, the limitations have greater potential for limiting the type of goods one is considering, as will be seen in my comments below.

Safety helmets; hard hats; all of the aforesaid goods being for protection in industrial, construction, manufacturing and/or welding applications

Bearing in mind that these are helmets/hard hats for protective purposes in the industrial, construction etc. fields, I can see no real similarity to rugby clothing. This applies also to rugby headgear in class 25, particularly when one bears in mind that the class 25 goods are not for protective purposes anyway. In relation to the other classes of the earlier mark, whilst acknowledging that protective pads are covered in the class 28 specification, such pads are for sporting purposes and do not conflict with the applied for goods as specified. Whilst there may be complementarity between a protective pad for sporting purposes in class 28 and a protective helmet for sporting purposes in class 9, the same does not apply for the helmets/hard hats specified here. The goods are not similar.

Protective ear coverings; earmuffs; all of the aforesaid goods being for protection in industrial, construction, manufacturing and/or welding applications

Such goods are clearly very different in nature, purpose and channels of trade to rugby clothing. I see nothing closer in the other classes of the earlier marks. The goods are not similar.

Eye-glass shields; shields for protecting the faces of workmen; face-protection shields; anti-glare visors; protective face-shields for protective helmets; all of the aforesaid goods being for protection in industrial, construction, manufacturing and/or welding applications

Such goods are clearly very different in nature, purpose and channels of trade to rugby clothing. I see nothing closer in the other classes of the earlier marks. The goods are not similar.

Ear phones; all of the aforesaid goods being for protection in industrial, construction, manufacturing and/or welding applications

I can see no reason whatsoever to consider ear phones to be similar to rugby clothing, nor to any of the goods covered by the class 18 or 28 specifications of the earlier marks. The goods are not similar.

Disposable latex gloves for laboratory use; all of the aforesaid goods being for protection in industrial, construction, manufacturing and/or welding applications

I can see no reason whatsoever to consider such goods to be similar to rugby clothing (even to gloves for playing/training for rugby), nor to any of the goods covered by the class 18 or 28 specifications of the earlier marks. The goods are not similar.

Gloves for protection against injury; fire resistant gloves; all of the aforesaid goods being for protection in industrial, construction, manufacturing and/or welding applications

I have already observed that rugby clothing would include within its ambit gloves for playing/training for rugby. However, the purpose of the gloves is different on account of the protective/fire resisting role they play in class 9 particularly bearing in mind the fields of use. Although they are all gloves, the nature may be somewhat different also, as will the channels of trade. I consider any similarity to be low.

Optical glasses; optical lenses; all of the aforesaid goods being for protection in industrial, construction, manufacturing and/or welding applications;

I can see no reason whatsoever to consider such goods to be similar to rugby clothing, nor to any of the goods covered by the class 18 or 28 specifications of the earlier marks. The goods are not similar.

Toe caps; all of the aforesaid goods being for protection in industrial, construction, manufacturing and/or welding applications;

I can see no reason whatsoever to consider such goods to be similar to rugby clothing, nor to any of the goods covered by the class 18 or 28 specifications of the earlier marks. The goods are not similar.

Visors for the protection of welders; welding helmets;

Such goods are clearly very different in nature, purpose and channels of trade to rugby clothing. I see nothing closer in the other classes of the earlier marks. The goods are not similar.

Parts and fittings for all the aforesaid goods

Although one is considering parts and fittings for the preceding terms not the preceding terms per se, I consider that the parts and fitting rest and fall with the comparisons already made

Average consumer and the purchasing act

22. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

23. In terms of the class 25 goods of the application, although specified as workwear for use in a particular field, I accept that even though the goods sometimes be purchased from specialist suppliers of workwear, the nature of the goods (which may be little (or no) different from everyday items of clothing) means that they could also be sold through general clothing retailers. However, the applied for goods in class 9 are likely to be sold exclusively through specialist outlets or, perhaps, outlets which also sell trade based goods such as building materials etc. The class 25 goods will be selected with an average level of care and consideration. The class 9 goods will be selected with greater care, although not of the highest level. The goods are likely to be selected from websites, brochures or physical premises. This suggests that the visual impact of the marks will take on more importance.

24. In terms of the earlier marks, the class 25 goods comprise rugby clothing. Such goods will mainly be sold through sports shops or the sportswear area of a larger store. However, some rugby clothing, rugby shirts for example, may be sold in the general clothing area as, effectively, an item of casual wear. The class 28 goods will be sold through sports shops/sportswear area, as will the class 18 goods, although some of the class 18 goods could also be sold through shops/areas which sell luggage type articles. For all of the goods of the earlier mark, I consider that an average level of care and consideration will be adopted during the purchasing process, with the selection process being via primarily visual means.

Comparison of marks

25. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

26. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

27. The applicant accepts that the word RHINO is its predominant element in his mark. There is greater debate between the parties as to the role TEC plays. It is clearly not negligible in the overall impression so it must not be ignored in the comparison. It plays a weaker role than RHINO but its impact should not be reduced to insignificance or near insignificance. I would say that the stylisation of the mark plays a weaker role again.

28. In terms of the earlier marks, they comprise the following:



29. In terms of the first mark identified above, the word RHINO strongly dominates the overall impression on account of the position of the word and the secondary feel that resonates from PURE RUGBY given its highly suggestive/descriptive language. In the second mark, RHINO is the only element that contributes to the overall impression. In terms of the figurative mark, the word and the device element make a roughly equal contribution to the overall impression.

30. Each of the above three marks is to be compared with:



31. Conceptually, the primary hook of all the marks will be based upon the word RHINO, the name of a well known animal. Whilst the addition of TEC in the applicant's mark and PURE RUGBY in one of the earlier marks introduces an additional and differing concept, I still consider there to be a high degree of conceptual similarity. Whilst the applicant did submit that RHINO in his mark is likely to be conceptualised on the basis of the slang word for money, I consider this to be highly improbable.

32. Aually, the applicant's mark will be articulated as RHI-NO-TEC. Two of the earlier marks will be articulated as RHI-NO, the third as RHI-NO-PURE-RUG-BY. Bearing in mind the overall impressions of the marks, and the simialirties and differences in the articulations, I consider that there is a high degree of similairty with the two earlier marks which will be articulated as RHI-NO, with a slightly lesser degree of similarity (but still reasonably high) with the other earlier mark.

33. Visually, despite the addition of TEC in the applied for mark, and its stylisation, I consider that the common presence of the word RHINO results in there being a high degree of visual similairty with the early RHINO mark. There is slighly less visual similarity (but still reasonably high) with the RHINO PURE RUGBY mark and less again with the figurative mark (which I assess at a medium level of simialirty).

Distinctive character of the earlier mark

34. 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). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been

registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

35. The opponent filed no evidence so I have only the inherent characteristics of the earlier marks to consider. All of the marks comprise, or contain, as a dominant element (or equally dominant element) the word RHINO. Whilst this word may give rise to some very mild suggestive connotations of strength etc., a characteristic for which rhinos are known, I still consider that the earlier marks have a medium degree of inherent distinctive character. The figurative aspect of one of the earlier marks may improve its distinctiveness, but as this aspect does not coincide with the applicant’s mark, this is not pertinent.

Likelihood of confusion

36. 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. Confusion can be direct (which effectively occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same, but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related). In terms of direct confusion, this was dealt with by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 where he noted that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

37. I will consider first the goods in class 9. I found the following goods not to be similar to any of the goods of the earlier marks:

Safety helmets; hard hats; protective ear coverings; earmuffs; eyeglass shields; shields for protecting the faces of workmen; face-protection shields; anti-glare visors; protective face-shields for protective helmets; ear phones; optical glasses; optical lenses; toe caps; all of the aforesaid goods being for protection in industrial, construction, manufacturing and/or welding applications; visors for the protection of welders; welding helmets; parts and fittings for all the aforesaid goods

38. If goods are not similar then under section 5(2)(b) there can be no likelihood of confusion. See, for example, *Waterford Wedgwood plc v OHIM* – C-398/07 P (CJEU). Therefore, the opposition fails in relation to the above goods. I should add that even if I am wrong in my finding that there is no similarity between the goods, any similarity that does exist must be extremely low. In this scenario, and despite the similarity that does exist between the marks (as assessed earlier), I would not have found that there exists a likelihood of confusion. The common presence of RHINO would be put down to a coincidental use of an averagely distinctive word by traders in essentially different fields. The average consumer will not assume that the undertaking behind the RHINO rugby clothing (and related sporting articles and class 18 goods) have expanded into the type of goods under consideration, or vice versa. It would be far too great a leap to make. There is no likelihood of confusion, be it direct or indirect.

39. I next consider:

Gloves for protection against injury; fire resistant gloves; all of the aforesaid goods being for protection in industrial, construction, manufacturing and/or welding applications; parts and fittings for all the aforesaid goods

40. I have found a low degree of similarity between the goods, principally on the basis of gloves for rugby purposes being covered by the specification of the earlier mark. However, whilst the goods are all glove like, the nature of the gloves in class 9 is sufficiently different, as is its purpose and channels of trade, to satisfy me that the average consumer will not believe that the undertaking behind the RHINO rugby clothing (and related sporting articles and class 18 goods) has expanded into the

type of goods under consideration, or vice versa. There is no likelihood of confusion, be it direct or indirect.

41. I next consider the class 25 goods, beginning with:

Gaiters; aprons; all being articles of workwear for use in industry, construction, manufacturing and welding

42. As with the goods considered at paragraph 37, I have found these goods not be similar to any goods of the earlier marks. Consequently, there can be no likelihood of confusion. Even if I am wrong in my finding that there is no similarity between the goods, any similarity that does exist must be extremely low. In this scenario, consistent with my earlier findings, there would still be no likelihood of confusion.

43. That leaves:

Jackets; caps; gloves; all being articles of workwear for use in industry, construction, manufacturing and welding

44. I assessed these goods as being highly similar to goods of the earlier mark. In essence, the qualifications had little impact on the inherent nature of the goods themselves. That being the case, and bearing in mind the similarity between the marks as already assessed, I consider that there is a likelihood of confusion. There could be direct confusion in so far as the earlier **RHINO** mark is considered as the difference created by the addition of the word TEC may be lost through the effects of imperfect recollection. However, even if this were not the case, the commonality of the word RHINO, even if the differences were noticed, would lead the average consumer to assume that the goods were the responsibility of the same or a related undertaking. This would arise because RHINO is averagely distinctive, is the dominant element, and its context and conceptual significance is not lost when combined with the word TEC which itself has some suggestive connotations evoking technically advanced products. I uphold the opposition to this extent.

Conclusion

45. The opposition fails, and the application may proceed to registration, for the following goods:

Class 9: Safety helmets; hard hats; protective ear coverings; earmuffs; eyeglass shields; shields for protecting the faces of workmen; face-protection shields; anti-glare visors; protective face-shields for protective helmets; ear phones; disposable latex gloves for laboratory use; gloves for protection against injury; fire resistant gloves; optical glasses; optical lenses; toe caps; all of the aforesaid goods being for protection in industrial, construction, manufacturing and/or welding applications; visors for the protection of welders; welding helmets; parts and fittings for all the aforesaid goods.

Class 25: Gaiters, aprons; all being articles of workwear for use in industry, construction, manufacturing and welding

46. The opposition succeeds, and the application is to be refused, for the following goods:

Class 25: Jackets, caps and gloves; all being articles of workwear for use in industry, construction, manufacturing and welding

Costs

47. It seems to me that the applicant has been the more successful party. Consequently, I will make an award in his favour, albeit a reduced one to reflect the partial nature of the success. My assessment is as follows:

Preparing a statement and considering the other side's statement - £200

Written submissions - £300

Total - £500

48. I order Rhino Rugby Limited to pay Mr Kuldip Singh Palak the sum of £500 within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 25th day of July 2016

Oliver Morris

For the Registrar

The Comptroller-General