

TRADE MARKS ACT 1994

IN THE MATTER OF application no. 2106919
by Esteban Lledo Garcia to register a trade mark in Class 25

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and

IN THE MATTER OF opposition thereto under
No. 46463 by Ocean Pacific Apparel Corp.

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DECISION

On 5 August 1996 Esteban Lledo Garcia applied to register a trade mark in Class 25 for
"Footwear". The application is numbered 2106919 and a representation of the mark is set out
below.

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On 20 February 1997 Ocean Pacific Apparel Corp. filed notice of opposition to this application.
The grounds of opposition are in summary:-

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- (i) the trade mark applied for is similar to the opponent's earlier trade marks and is therefore not capable of distinguishing the goods of the applicant from those of other undertakings; registration should therefore be refused under Section 3(1) (a) of the Trade Marks Act 1994;
- (ii) the trade mark is similar to the opponent's earlier trade marks and is sought to be registered in respect of the same or similar goods; registration would, therefore, be contrary to the provisions of Section 5(2) of the Act;
- (iii) by reason of the earlier use by the opponents of their earlier trade marks use by the applicant of the trade mark in suit is liable to be prevented by the law of passing off and should therefore to be refused under the terms of Section 5(4) of the Act;

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The earlier trade marks relied upon by the opponents are as follows:

MARK

APPLICATION/REGISTRATION NUMBER

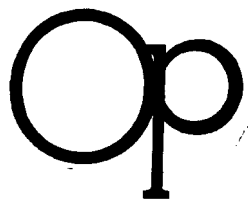
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1226869



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1409608



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1479597

OP PRO

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2114815

(series of two)

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The applicants filed a counterstatement and denied all of the grounds of opposition though I note

here that they admit that the opponents are the proprietors of the application and registrations referred to above. They also put the opponents to proof in respect of earlier use of the mark.

Both sides seek an award of costs.

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The opponents filed evidence in support of the grounds set down in their notice of opposition and asked the Registrar to give a decision on the basis of the papers filed, without recourse to a hearing. Acting on the Registrar's behalf and after a careful study of the papers I now give this decision.

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The opponents' evidence consists of a Statutory Declaration dated 20 October 1997 by Kathleen Huber Hoffman, Vice President Brand Management of Ocean Pacific Apparel Corp. She states that she is authorised to make the declaration. Ms Hoffman explains that the predecessors of the opponents Ocean Pacific Sunwear Limited first adopted the trade mark, from the initial letters of Ocean Pacific in 1972 and since then the opponents have used the trade mark OP throughout the world in relation to a wide range of clothing, footwear and accessories. At Exhibit KHH1 she provides several brochures showing use of the mark in relation to these goods. The brochures are dated from Spring 1993 through to Spring-Summer 1997, Ms Hoffman explains that the 1997 brochures would have been available at the end of 1996.

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Ms Hoffman provides turnover figures relating to the wholesale value of sales of these goods worldwide as follows:

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YEAR	£
1993	61,956,250
1994	48,440,000
1995	56,895,625

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Figures are also provided in respect of the wholesale value of sales in the United Kingdom:-

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YEAR	£
1987	3,875,000
1988	2,501,250
1989	1,687,500
1990	1,933,750
1991	2,647,500
1992	1,463,125

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Ms Hoffman goes on to explain that since 1992 sales figures for the United Kingdom are incomplete as the UK licensee at the time wound down its activities and the UK market began to be served from outside the UK particularly from the licensee in Italy where no figures specific to the UK are available.

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Expenditure figures in respect of advertising and promotional activities are not available but Ms Hoffman states that licensees were required to spend 2% to 3% of net sales on advertising. Sales

have taken place throughout the United Kingdom, mainly in department stores and sporting goods stores.

At Exhibit KHH2 are produced photocopies of the advertisements which appeared in Trade Mark Journals in respect of the applications and registrations of which the opponent is the proprietor and which are referred to in the grounds of opposition.

Ms Hoffman goes on to make several points in response to the counterstatement submitted by the applicant. In paragraph 2 of that counterstatement the applicant denies that its own trade mark is similar to any of the applications or registrations owned by the opponent. Ms Hoffman produces at Exhibit KHH3 a copy of the applicant's Statement of Grounds of opposition to the opponent's application 2114815 where the applicant states that there is a similarity between the second mark in the series of application 2114815 and the applicant's mark. Therefore, Ms Hoffman concludes that the applicant considers that the respective trade marks are confusingly similar. At Exhibit KHH4 the opponent produces a copy of a search notice received in respect of an application by the applicant to register a trade mark in Spain. The trade mark, the subject of this application, is shown below. Ms Hoffman maintains that this demonstrates that the applicant's trade mark is intended to be seen as an OP's mark with logo.



As stated above the applicants did not file any evidence in response to the opponent's evidence; I therefore turn to consider the grounds of opposition and deal first of all with the ground under Section 5(2) which states:-

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

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
- (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.

An earlier trade mark is defined at Section 6 which as far as is relevant states:

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

5 (a) a registered trade mark, international trade mark (UK) or Community trade mark 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,

10 (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 I first consider the respective goods sought by the applicant and the earlier trade marks of the opponents.

I note that neither side has suggested that the goods themselves can be differentiated. I think this is undoubtedly true in respect of the opponents’ marks Nos 1409608, 1479597 and 2114815 where, without doubt, the same and similar goods are involved.

20 However, the opponent’s registration 1226869 is different in that this is a registration for “Sporting articles (other than clothing), parts and fittings therefore” in Class 28. The applicant’s mark is proposed for registration in respect of “Footwear” in Class 25. For an assessment of the similarity of these goods I apply the test for similar goods under the 1994 Act, which was formulated by Jacob J in *British Sugar PLC v James Robertson & Sons Ltd* (1966) RPC 281 at page 296, and which he described as “an elaboration on the old judicial test* for goods of the same description”.

30 The matters to be considered are :-

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

35 (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;

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

45 (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.

In applying this test I have only the wording of the respective specifications to guide me, the opponents evidence did not address this particular point. Having said that my conclusions are as follows:-

- (a) The uses of the goods are very different. Footwear is used only as a covering for the feet while sporting articles are for a variety of different uses. The term sporting articles covers "Skating boots with skates attached" but I conclude that their main purpose is to enable one to skate and are not simply an article to be worn on the feet.
- (b) I conclude that in many cases the same people would be involved.
- (c) The physical nature of the goods seems to be very different. Sporting articles, including skating boots with skates attached may well be made from the same materials but generally would be seen as being very different.
- (d) In the absence of any evidence to the contrary I conclude that the trade channels are different.
- (e) I doubt very much that the respective goods would be found on the same shelf or even in close proximity to each other.
- (f) It appears to me that the goods are not competitive in that they could not be substituted for each other. While I have no evidence on the point I cannot believe that the trade would classify the respective goods under similar headings.

* Jellinek's application (1946) 63 RPC at page 70.

It follows from the views I have expressed above that in respect of Registration No 1666869 I do not consider the relative goods to be in any way similar and therefore can no longer be considered a barrier to the registration of this application.

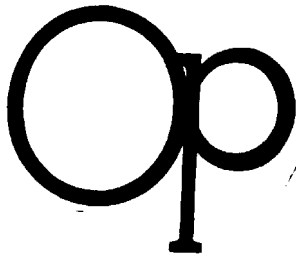
I go on to consider the trade marks of the application and the remaining registrations and application. Since the marks in question are not identical I must address the issue of whether they so nearly resemble each other for there to exist a likelihood of confusion on the part of the public. I have already found that the goods of Registration No 1226869 are not identical or similar to those of the applicants specification. I therefore only need to deal with the remaining application and registrations owned by the opponent and for convenience these are set out below.

MARK

APPLICATION/REGISTRATION NUMBER

1409608

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1479597

OP PRO

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2114815 (series of two)

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Although this matter is governed by the Trade Marks Act 1994 the principles of comparison of marks remain unchanged and I have considered the matter primarily by reference to the principles enunciated by Parker J in the PIANOTIST case (1906) 23 RPC at Page 777, line 26 et seq:

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"You must take the two words. You must judge of them both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of these trade marks is used in the normal way as a trade mark for the goods of the respective owners of the marks. If, after

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considering all those circumstances, you come to the conclusion that there will be confusion - that is to say - not necessarily that one will be injured and the other will gain

illicit benefit, but that there will be a confusion in the mind of the public, which will lead to confusion in the goods - then you may refuse the registration, or rather you must refuse the registration in that case".

5 Also, I have regard to *Sabel BV v Puma AG* (1998) RPC at page 224, in relation to Article 4(1)(b) of the First Council Directive of 21 December 1988, which corresponds directly with Section 5(2)(b), in which the European Court of Justice in dealing with the issue of comparison of marks said:

10 "That global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The wording of Article 4(1)(b) of the Directive - "... there exists a likelihood of confusion on the part of the public ..." - shows that the perception of marks in the mind of the average consumer of the type of
15 goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details."

I have also born in mind the well established principle that although two marks, placed side by side, may exhibit many and various differences, the main idea left in the mind by both of them
20 might be the same. It was stated by Lord Radcliffe in the case of *De Cordova and others versus Vick Chemical Company* (1951) 68 RPC at page 106, lines 17-23:

25 "The likelihood of confusion or deception in such cases is not disproved by placing the two marks side by side and demonstrating how small is the chance of an error in any customer who places his order for goods with both the marks clearly before him, for orders are not placed or are often not placed, under such conditions. It is more useful to observe that in most persons, the eye is not an accurate recorder of visual details, and that marks are remembered rather by general impressions or by some significant details than
30 by any photographic recollection of the whole".

Much of the evidence filed by the opponents is concerned with the use of the opponents' trade marks within the United Kingdom. The opponents refer to the applicant's trade mark as OP's FOOTWEAR and logo. The applicant, however, refers to his trade mark in the
35 Counterstatement as KOP'S F.O.O.T.W.E.A.R. and device but no submissions have been made which point to any particular differences between the marks. This is, therefore, essentially a matter for the tribunal itself to resolve.

The applicant's mark clearly contains the letters OP's with the letters F.O.O.T.W.E.A.R. underneath but in a smaller font. Although the letters are separated by full stops I consider that these letters will only be seen as forming the word FOOTWEAR and not as individual letters. I am supported in this conclusion by the comments made by Geoffrey Hobbs QC in the, as yet unreported, P.R.E.P.A.R.E. decision:

45 "I do not rule out the possibility that letters which can be combined to form a word may be represented graphically in a manner that will cause people to regard them simply as a string of letters. However that is not likely to occur unless the graphic representation is

effective to counteract the normal human tendency to link letters together to form words. This tendency generally results in the use of acronyms as words when the relevant letters are capable of being used in that way. In the case of an acronym which people will use as a word, the full stops between the letters might as well not exist. The distinction which the Applicants wish me to draw between words and strings of letters cannot realistically be drawn in relation to such acronyms. And the sign P.R.E.P.A.R.E. has all the appearance to my eye of being just such an acronym. I do not consider that it is represented graphically in a manner which would cause people to overlook the word PREPARE and regard the presentation simply as a string of letters. I am satisfied that the grammatical significance of the full stops is swamped by the linguistic significance of the letters and that the sign would accordingly be used and understood by people in the same way as the word PREPARE.”

The remainder of the mark is, to my mind, simply a device. Whilst I understand that the Applicant refers to the mark as a KOP’s mark I do not agree that it would be seen in such a way. The device element is considerably more than a stylised letter K and in my opinion simply directs the eye to the remaining word elements of the mark and makes the word OP’s more prominent. The word footwear is totally non-distinctive for the goods involved and it is my conclusion that the OP’s element will be seen as the essential feature of the mark. I am reinforced in this by the way in which the applicants trade mark is represented in it’s application for registration in Spain.

Registration 1409608 is clearly a two letter mark. Whilst the two letters are of different font size and there is a small degree of stylisation I consider that this mark would only be seen as the letters OP. Application 2114815 is for a series of two marks, the first of which is identical to the mark of 1409608 to which I have already referred. In the second mark of the series the letter O is different. It is no longer oval in shape but is elliptical. It is still, however, likely to be seen as a letter O and both marks in this application will be seen as OP marks. Registration 1479597 is for the mark OP PRO. It can only be seen as an OP mark with the additional word PRO serving to indicate that the goods are intended for professional use. As I have already found that the applicant’s mark would be seen as essentially an OP’s mark I conclude that there must be very good grounds for reaching the conclusion that, both visually and phonetically, the public would assume a connection between the marks in respect of footwear and be confused if, as in this case, no such connection exists.

My attention has been drawn to Exhibit KHH3 which is a copy of the Statement of Grounds in the applicant’s opposition to the opponent’s application 2114815. The opponent’s Statutory Declaration notes that the applicant believes that there is a similarity between the second mark in the series of application 2114815 and the applicant’s mark. I have not placed a great deal of weight on this evidence but I have taken it into account in this decision. The opposition succeeds under Section 5(2)(b).

This finding effectively decides the matter but in case I should be found wrong in my consideration of the Section 5(2) (b) objection I go on to consider the matter under Section 5(4) based on the opponent’s claim to be able to prevent use of the applicant’s mark under the law of passing off.

The authoritative statement of the elements necessary for a successful passing off action, as set down by Lord Fraser of Tullybelton, is found in the “Advocaat” case (Warninck v Townend) [1980] RPC 31, at pages 105-106. Lord Fraser said:-

- 5 “It is essential for the plaintiff in a passing-off action to show at least the following facts:-
1. That his business consists of, or includes, selling in England a class of goods to which the particular trade name applies;
 - 10 2. That the class of goods is clearly defined, and that in the minds of the public, or a section of the public, in England, the trade name distinguishes that class from other similar goods;
 - 15 3. That because of the reputation of the goods, there is goodwill attached to the name;
 4. That he, the plaintiff, as a member of the class of those who sell the goods, is the owner of goodwill in England which is of substantial value;
 - 20 5. That he has suffered, or is really likely to suffer, substantial damage to his property in the goodwill by reason of the defendants selling goods which are falsely described by the trade name to which the goodwill is attached.

25 On the basis of the evidence filed in these proceedings the opponents qualify under item (1) above. I do not feel it necessary, however, to go into an analysis of the evidence point by point before stating my conclusion that their case is not strong enough since they have clearly not established any of the remaining facts (2 -5). I therefore find that the opponents do not succeed under Section 5(4).

30 The final ground is under Section 3(1)(a). This subsection prevents the registration of signs which do not satisfy the requirements of Section 1(1). The latter reads as follows:-

35 “1.-(1) In this Act a “trade mark” means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.

 A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.”

40 The opponents have not developed this claim in their evidence. To be successful under this section the opponents would need to demonstrate that the mark at issue is incapable of functioning as a trade mark, that it cannot distinguish the goods of one undertaking from those of other undertakings. I do not see that there is anything in the characteristics of the applicants’ mark which renders it open to such an objection. Consequently the opposition under Section 3(1)(a)
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The opponents having succeeded I order the applicants to pay the sum of £535 as a contribution towards their costs.

Dated this 27 day of April 1998.

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A J PIKE
For the Registrar
The Comptroller General

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