

O-284-05

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 2317090  
IN THE NAME OF A LEVY & SONS LIMITED  
TO REGISTER A TRADE MARK IN CLASS 25**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 91672 IN THE NAME OF  
FL EUROPE HOLDINGS, INC**

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### **BACKGROUND**

1. On 28 November 2002, A Levy & Sons Limited applied to register the trade mark GYMLOCKER in Class 25 in relation to the following specification of goods:

Menswear- more particularly sportswear and casual attire, including shirts, casual tops, shorts, trousers, jackets, tracksuits, hats, underwear, socks, all for wear.

2. On 7 May 2003, Venator Group Retail, Inc filed notice of opposition to the application, FL Europe Holdings Inc subsequently being substituted as opponents. The grounds of opposition are as follows:

- 1. Under Section 5(2)(b)** because the mark applied for and the opponents=earlier marks relied upon are similar, and the goods for which registration is sought are identical to those covered by the opponents=earlier marks.
- 2. Under Section 5(3)** The respective marks are similar and the goods for which the applicants seek registration are dissimilar to the services encompassed by the opponents=earlier CTM-s No. 1131044, 1523497, 1523505, 2053759 and to specific services in Classes 35 and 42 of CTM No.42168.
- 3. Under Section 5(4)(a)** by virtue of the law of passing off.
- 4. Under Section 6(1)(c)** because the opponents=marks are well known within the meaning of Article 6 bis of the Paris Convention.

3. Details of the earlier marks relied upon by the opponents are shown as an annex to this decision.

4. The applicants filed a counterstatement in which they deny the grounds on which the opposition is based.

5. Both sides ask that an award of costs be made in their favour.

6. Both sides filed evidence in these proceedings. The matter came to be heard on 5 July 2005, when the applicants were represented by Mr Reed of Counsel, instructed by Kilburn & Strobe, their trade mark attorneys. The opponents were represented by Mr Simon Malynicz of Counsel, instructed by Grant Spencer Caisley and Porteous, their trade mark attorneys.

### **OPPONENTS= EVIDENCE**

7. First is a Witness Statement dated 10 February 2004, from Jacqueline Helen Simpson, a Trade Mark Attorney with Grant Spencer Caisley and Porteous, the opponents= representatives.

8. Ms Simpson recounts her company having instructed Carratu International Plc to search UK publications published in the period 28 November 1997 to 28 November 2002, for references to the FOOT LOCKER trade mark. Details of the resources searched are shown as exhibit JHS1, and the results of this search are shown as exhibit JHS2. Apart from the occasional comment such as FOOT LOCKER being the world=s leading retailer of athletic footwear and apparel (10 April 2002), FOOT LOCKER being a well known brand name (August 1999), high profile (November 1999) or stating that the business had really taken off in the UK (December 1999), much of this bulky exhibit provides little or no useful evidence. An article dated 2 July 1999 refers to FOOT LOCKER as being relatively unknown in the UK.

9. Ms Simpson refers to the publications which range from mainstream newspapers with national circulation, local publications, and publications from the advertising and retail trades, and goes on to present extracts that she says show the business plans and property acquisitions of the opponents.

10. The second piece of evidence is a Statutory Declaration dated 7 May 2004, and comes from John Arthur Samuels, a self-employed market and social research consultant with over 35 years experience in the market research profession.

11. Mr Samuels recounts that he was asked by Grant Spencer Caisley & Porteous, to examine and comment on a survey conducted in relation to the opposition. A copy of Mr Samuel=s report is shown as exhibit JAS1. The survey was conducted between 30 April and 2 May 2004, well after the relevant date in these proceedings. Mr Samuels goes on to give his professional view on the survey, which he says was well established and professionally executed and achieves a representative sample of the adult population of Great Britain. In summary, Mr Samuels says:

the question asked @What does Foot Locker mean to you?@ was entirely open-ended, the interviewer having a list of coding options into which to categorise the respondents= answers, together with a further category @other@ for those not considered to fall in these codes.@

The interviewer could code an answer more than once if the respondent said more than one thing.

It is common practice to have open-ended questions and pre-coded answer categories, but one possible weakness of this approach is that the number of codes is too few or too restricted to encompass a full range of answers. He does not consider this to be the case with this survey.

A second possible weakness is that there can be an *order effect* whereby the code options at the top of the list is selected more frequently. This is more common where the respondent is choosing from the list of codings, and less commonly where it is professional interviewers who select the coding. He gives reasons why he considers the survey results have not been affected by order effect.

The results can be taken to indicate that the person has the FOOT LOCKER brand in mind.

Respondents were allowed to give more than one response, and it is not possible to get at the total number of people who had FOOTLOCKER in mind as some may have said *ASHOP* and *ASHOES*. The total proportion of respondent who gave a response indicating FOOTLOCKER amounts to 38%, grossing up to 17.5 million of the adult population.

Awareness of FOOT LOCKER is greater amongst the 16-34 year old target group, with awareness being substantially higher in Greater London where the chain has its strongest representation of outlets.

He does not consider the question asked to be leading or biased.

12. The final evidence is an Affidavit dated 8 September 2004, and comes from Robert McHugh, Vice President, FL Europe Holdings Inc a position he has held for one year, and Vice President of Foot Locker, Inc, the parent corporation. Mr McHugh says that he has been employed by Foot Locker, Inc, for six years.

13. Mr McHugh says that Foot Locker, Inc. was launched in the US in 1974, and is one of the world's leading retailers of sports shoes and clothing. His company has continuously used the trade mark FOOT LOCKER in the UK since 1991 when it acquired an existing chain of stores and renamed it FOOT LOCKER, and now has 50 shops located throughout the UK. Mr McHugh says that the trade mark FOOT LOCKER is used on all of his company's shop signs, exhibit RM1 being a CD-Rom containing pictures of approximately 50 shop fronts, exhibit RM2 being a CD-Rom containing an overview of the company that produces the FOOT LOCKER signage including the location of the shop for which the sign is being produced. Exhibit RM3 consists of council planning approvals for 24 FOOT LOCKER stores in the UK.

14. Mr McHugh says that the FOOT LOCKER trade mark is used throughout the shops on tags, shoe care products, packaging, plastic bags and on the labels of clothing. Exhibits RM4 and RM5 consist of examples of this use. The exhibits show the words Foot Locker placed below the upper torso of a human figure wearing a sports jersey, this use being in relation to laces and socks. There is nothing that places this as originating prior to the relevant date.

15. Mr McHugh gives details of the worldwide sales of goods by his company, in the years 2000 to 2002, expressing the UK share in percentages, which extrapolate to \$43,560,000 in 2000, \$87,580,000 in 2001 and \$90,180,000 in 2002. He says that his company uses various means of advertising and promoting its goods, mentioning several magazines and newspapers, in cinemas, on radio, television and in posters placed in locations including on Oxford Street, London. Exhibit RM6 consists of a list of advertisements placed by the opponents in the period October to December 1999. The list mentions a wide range of publications and is stated to relate to FOOT LOCKER promotion of various branded sports goods such as Adidas or Reebok training shoes, or FOOT LOCKER sportswear. Exhibit RM7 consists of examples of advertisements, all show the FOOT LOCKER and Torso logo, usually in conjunction with the brand of the manufacturer. None of the advertisements show when or where they were placed. Exhibit RM8 consists of prints of the opponents' website taken on the 8 April 2004.

16. The remainder of the Witness Statement consists of submissions on the case. Whilst I have not summarised them I will take them fully into account in making my decision.

#### **APPLICANTS' EVIDENCE**

17. This consists of a Witness Statement dated 10 November 2004 from Jonathan Levy, Director of A Levy & Son Limited, a position he has held since 1997.

18. Mr Levy gives the history of his company, a copy of the year end 2003 Annual Report being shown as exhibit JL-1. He states that his company's stores carry stock which accounts for approximately one third of designer brands, the remainder being own-label.

19. Mr Levy states that his company's main brand is BLUE INC, GYMLOCKER being a minor brand that they do not intend to use separately. Details of his company's use are shown at exhibit JL-1, which depicts a shop front bearing the name BLUE INC, and tags and labels bearing the name GYMLOCKER placed above BLUE INC and a STAR device.

20. Mr Levy gives the locations of his company's stores, and details of the way in which the trade mark is used.

21. That concludes my summary of the evidence insofar as it is relevant to these proceedings.

#### **DECISION**

22. I turn first to consider the ground under Section 5(2)(b). The relevant part of the statute reads:

**A5.**-(2) A trade mark shall not be registered if because -

(a) **YYYYYYYY.**

(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.®

23. An earlier trade mark is defined in Section 6 of the Act as follows:

**A6.**- (1) In this Act an **earlier trade mark**® means **B**

(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,®

24. I take into account the well established guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723. It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG*, paragraph 22;

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* paragraph 27;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;

(h) further, 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; *Marca Mode CV v. Adidas AG*, paragraph 41;

(i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc.*, paragraph 29.

25. In any analysis it is inevitable that reference will be made to the elements of which a mark is composed, and rightly so, for the case law requires consideration to be given to the distinctiveness and dominance of the component parts. However, it must be remembered that the consumer does not embark on a forensic analysis of trade marks and it is the marks as a whole that must be compared.

26. In their Statement of Grounds the opponents cite a large number of marks that are, or incorporate the words FOOT LOCKER. In his submissions Mr Malynicz referred to what he called a specimen mark, CTM 42168 for the words FOOT LOCKER *simpliciter* that is registered in Class 25 in respect of clothing, footwear and headgear. This seems to me to be an eminently sensible approach, for if they do not succeed in respect of the objection based on this registration, they will be in no better position with regard to the remaining marks.

27. The applicants are seeking to register the mark GYMLOCKER in Class 25 in respect of menswear- more particularly sportswear and casual attire, including shirts, casual tops, shorts, trousers, jackets, tracksuits, hats, underwear, socks, all for wear. The term clothing listed in the opponents' earlier mark encompasses clothing of all types, and accordingly identical goods to those of the application. There is nothing that would serve to separate the respective goods in trade and I must therefore proceed on the basis that they notionally share the same channels of trade, from manufacturer to retailer, are offered for sale in the same way, and to the same consumer.

28. In the *REACT* trade mark case [2000] RPC 285, it was accepted that the selection of clothes is essentially a visual act. I believe it follows that in determining the question of the similarity or otherwise of the respective marks I should adopt a more critical eye in considering how similar they look, but this does not mean that I should disregard how they sound to the ear, or the message that they convey.

29. There is no evidence to assist me, but as far as I am aware, the applicants' mark GYMLOCKER is not a word that exists in the English language, but is the amalgamation of the two ordinary English words GYM and LOCKER. Whether or not the consumer knows

that GYMLOCKER is a real word, and whilst I accept that consumers may well perceive marks as a whole, there are instances where the fact that a mark consists of two or more words joined together is sufficiently obvious so as to be apparent to the consumer. In my opinion the mark applied for is one such mark. The opponents' earlier mark is the word FOOT LOCKER, self-evidently sharing the word LOCKER so if only to that extent there is some visual similarity. But bearing in mind that the difference in the respective marks is in their beginning, which is generally accepted as being of most significance, and that the difference is a complete word, the marks are, I believe, visually and aurally distinguishable.

30. There is no evidence that GYMLOCKER is a word existing in the English language, and it is my belief that it is an invention created by conjoining the two ordinary words GYM and LOCKER. These words hang together and as a whole convey the idea of a locker that would be used or available at a gymnasium. From the evidence it is apparent that the opponents' mark FOOT LOCKER, albeit presented as a single word, is a term that describes a piece of luggage in the form of a trunk. Mr Malynicz submitted that this is a North American expression that is not commonly used in the English language. The extract from the Scotland on Sunday publication forming part of exhibit JHS2 uses the word FOOTLOCKER. That the article goes on to give an explanation of what a footlocker is lends support to Mr Malynicz's view that it is not in common use in the UK. Notwithstanding this, and the fact that a footlocker is a trunk, the word conjures up the vision of a locker and sends out a similar idea to that of the applicants' mark, but when balanced against my finding that the marks are not visually or aurally similar, I reach the view that as a whole the respective marks are different.

31. Whilst the word FOOT in FOOT LOCKER could be taken as an indication that the trunk is for storing footwear, as can be seen from the Scotland on Sunday extract, it is not a reference to feet or footwear, but rather that the trunk is usually kept at the end or foot of a bed. But even if FOOT LOCKER is capable of describing a locker for storing footwear, the mark is not a reference to a characteristic of footwear or clothing and in my view FOOT LOCKER is distinctive for, and capable of individualising the opponents' goods in the market.

32. The opponents claim to have been using the trade mark FOOT LOCKER in the UK since 1991, when they acquired and renamed an existing chain of stores that had been trading under the name Freedom Sportsline Limited. Mr McHugh states the company's business to be the retailing of sportswear specialising in footwear, and at the date of making his Affidavit in September 2004, had 50 retail outlets trading throughout the UK. I do not know how many shops the opponents had at the relevant date.

33. Turnover figures for worldwide sales in the years 2000 to 2002 have been provided. The figures relating to UK sales have been expressed as a percentage of total sales, and equate to \$43,560,000 in 2000, \$87,580,000 in 2001, and \$90,180,000 in 2002. The opponents do not say why specific figures for UK sales have not been provided, or how the percentages were calculated. As Mr Reed pointed out, expressing the sales in terms of a whole percentage point without indicating whether they were rounded up, or down, could give a misleading impression of the true figure and has a potential for a large margin of error. Mr Reed also criticised these figures because they do not say whether the stated currency is US\$ or what. That may well be the case, but given that the opponent is a US company it would not be



unreasonable to infer that they are the currency of their home country. They have not, however, provided a basis on which I can convert these dollars into , sterling and put them into the context of the market for the goods. As they are I consider the sales figures to be an unsafe indicator of the extent of the opponents=penetration into the UK market.

34. There is no evidence showing use of the mark that goes back to the date of first use claimed, in fact there is not a single piece of evidence showing how the opponents use the mark that can be conclusively placed as originating prior to the relevant date. Exhibit JHS2, comprises a large collection of press extracts that mention or relate to the activities of the opponents. Many are from publications specifically for the retail and advertising trade, and consequently would not have been seen by the public at large. There are a number of references in some national and regional publications in which the writer gives a personal account of having purchased training shoes from FOOT LOCKER, or that refer to customers seeking to return faulty trainers. Whilst this is an indication that they have carried on a trade in sports footwear, there is not one piece of evidence relating to an actual sale of such goods.

35. The examples of the marks shown on the swing tags, labels and packaging (Exhibits RM4 and RM5) show the words Foot Locker placed below the upper torso of a human figure wearing a black and white striped sports jersey, this use being in relation to laces and socks. Exhibit RM1 contains images of the signage used on the opponents=retail outlets. From this it can be seen that the signs are used in different forms, including FOOTLOCKER (as one word) on its own, to the word in conjunction with the A torso@ as described above, and the word with a geometric shape decorated with the striped design of the shirt. Whilst the exhibit does not say when each sign was first used, or even where, given that the extract from Retail Week (exhibit JHS2) dated 31 May 2002 gives the number of FOOT LOCKER outlets as 47, all but a few must have been in use prior to the relevant date, although it does not establish in what form.

36. Many of the extracts in JHS2 that contain a reference to the nature of the opponents= business describe them in terms such as AUS footwear retailer@, AUS footwear specialist@ and the Alargest retailer of training shoes in the world@, indicating that the opponents reputation is primarily that of a retailer of sports footwear. This would be consistent with the results of the survey in which, of the respondents that were aware of the opponents and their products, most associated them with Ashoes@, Asports footwear@ or Atrainers@, and corresponds with the information contained in Doc 129 of JHS2 which states that in December 2000, footwear accounted for two-thirds of FOOT LOCKER sales with apparel and accessories accounting for the remaining one-third. Whilst some of the references in the exhibit indicate that the opponent has sold training shoes, the difficulty I have is that I do not know what the apparel and accessories said to have been sold actually are; are they just the laces and sock earlier referred to?

37. Part of the opponents=evidence consists of the results of a survey intended to establish the consumer awareness of FOOT LOCKER. Mr Reed referred me to the decision in *Imperial Group plc v Philip Morris Ltd.* [1984] RPC 293. In that case Whitford J gave consideration to the principles involved in considering the evidential value of surveys, observing that if a survey is to have validity the following criteria should be met:

- (a) the interviewees must be selected so as to represent a relevant cross-section of the public,
- (b) the size must be statistically significant,
- (c) it must be conducted fairly,
- (d) all the surveys carried out must be disclosed including the number carried out, how they were conducted, and the totality of the persons involved,
- (e) the totality of the answers given must be disclosed and made available to the defendant,
- (f) the questions must not be leading nor should they lead the person answering into a field of speculation he would never have embarked upon had the question not been put,
- (h) the exact answers and not some abbreviated form must be recorded,
- (i) the instructions to the interviewers as to how to carry out the survey must be disclosed,
- (j) where the answers are coded for computer input, the coding instructions must be disclosed.

38. The applicants have not questioned the fairness of the survey. Mr Samuels confirmed that the technology used to manage the survey was very sophisticated and ensured a representative sample of the population throughout Britain was obtained, which to my mind satisfies the first three points.

39. The opponents=representatives provided a copy of the results (JAS1) to Mr John Arthur Samuels, a market and social research consultant who was asked to give his opinion on the conclusions to be drawn from the survey. Whilst there is no dispute that Mr Samuels is eminently qualified to provide useful expert evidence on the structure, and conduct of survey, and the interpretation of the outcomes, Mr Reid had a number of criticisms of the survey that are of a purely factual nature where the assistance of an expert would not be required.

40. Mr Reid mentioned that the actual answers given had not been recorded or disclosed. There can be no argument with this. The opponents do not exhibit the exact answers given by the interviewee, nor have they made this information available to the applicants. Instead they have filed a report summarising the responses as coded by the interviewers. Whilst a list of the codes used has been provided, as Mr Reid stated, there is no information on how the coding categories were selected, and no details of the instructions given to the interviewer, either on conducting the interview or how to record the responses. Mr Samuels confirmed that where a respondent gave more than one answer, all would have been recorded but it would not be possible to ascertain this from the data in the report, or which answer was given first.

41. In cross-examination, Mr Samuels explained that the results summarised in JAS1 had been obtained in an omnibus survey, which meant that each person contacted had been asked to complete a series of short questionnaires on behalf of a number of clients, potentially from different market sectors. He confirmed that the question relating to FOOT LOCKER would have been but one of the questions asked by the interviewer, and whilst there is no evidence relating to what else they were asked, Mr Samuels accepted that there may well have been questions related to other brands. Mr Reid suggested that this meant that by the time the question relating to FOOT LOCKER was asked the respondent would have been aware that some of the questions were directed at brands. Mr Samuels did not dispute this, but stated that the computer rotated the order in which questions were asked, which means that if Mr Reid is correct, some respondents may have been directed towards thinking of brands.

42. Mr Reid considered that the question asked 'What does Foot Locker mean to you?' directed the person being asked into speculating where they otherwise would not have. Mr Samuels took the view that the question was entirely open-ended. Whitford J stated that it is very difficult in connection with an exercise such as this to think of questions which, even if they are free from the objection of being leading, are not in fact going to direct the person answering the question into a field of speculation upon which that person would never have embarked had the question not been put. Other than perhaps where the question is related to a topic with which the respondent may have already encountered, such as a story in the news, where they may well have already given the matter some consideration and formed a view, this must be the case. I doubt whether any of those questioned had ever given the meaning of FOOT LOCKER any thought until they were asked to do so.

43. Mr Reid also criticised the survey because it was carried out some 18 months after the relevant date, the inference being that normal business activities such as advertising would have had an effect on the recognition of the brand, and accordingly, it would be unsafe to accept the results as being representative of the position as at the material date. In cross examination, Mr Samuels gave an explanation of some factors that would need to be taken into account in determining whether this was the case, inter alia, the 'recognition' starting point; the lower this is, the greater the effect and vice-versa. The extracts at JHS1 indicate that by the relevant date in these proceedings, FOOT LOCKER was a familiar name on the high street. Taking Mr Samuels comments on board, it would seem that the advertising between the relevant date and the date on which the survey was carried out is likely to have had a minimal impact on the brand recognition, but nevertheless may have had some.

44. Taking all of the above into account, I come to the view that whilst the survey seems to indicate a reasonable degree of awareness amongst those questioned, it cannot be taken as having clearly established this to be the case.

45. On my assessment of the evidence, the position is that the opponents say that they have been using the name FOOT LOCKER since 1991 but have not provided a single piece of evidence from that date. Whilst it is clear from exhibit JHS2 that they have been using the name prior to the relevant date, the exhibit does not establish in what form, and apart from some comments relating to goods such as training shoes and sportswear, in relation to what. Statements that go to the opponents' reputation in the UK market are anecdotal with no indication of their basis. At best the evidence suggests that the opponents' mark FOOT

LOCKER has a reputation, but too much is left to be inferred with too many unanswered questions. If the opponents claim that their mark has become sufficiently well known to have enhanced its distinctive character such that it is deserving of a wider penumbra of protection, they must provide cogent evidence and not leave it to be inferred from a pot-pouri of information. But even if the opponents did have a reputation, as stated in *Marca Mode*, that a mark has a reputation does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense.

46. It seems to me that whatever the opponents case, it relies on the premise that the consumer will either pick out the word LOCKER from the mark applied for, and through imperfect recollection will confuse it with FOOT LOCKER, or that they will see GYMLOCKER as a brand extension. In the *Sabel* case it was stated that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. This must, of course be considered in the context of the individual distinctiveness and dominance of the component parts. In this case the ALOCKER element of both marks hang together so that neither is dominant. There is some evidence that in addition to FOOT LOCKER the opponents have also been using another mark LADY FOOT LOCKER, but this is just the same mark with a gender indication; there is no evidence that they have used other ALOCKER@marks so as to create the idea of a brand family in the minds of the consumer. Nor do I consider it likely that the consumer will make a connection because of a conceptual connection between the sporting goods for which FOOT LOCKER has a reputation, and the sporting connotations of the word GYM in the applicants=mark.

47. Taking all of the factors into account and adopting the global approach advocated, I take the view that this is as far as the opponents=case gets. Use of GYMLOCKER for the goods listed may bring to mind FOOT LOCKER, but I do not consider that the consumer will be confused into wrongly believing that the goods come from the same or economically linked undertakings, or that there is a likelihood of confusion. The objection under Section 5(2) is dismissed accordingly.

48. Turning to the ground under Section 5(4)(a). That section reads as follows:

**A5.**-(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark.@

49. Mr Geoffrey Hobbs QC sitting as the Appointed Person in the *Wild Child* case [1998] RPC 455 set out a summary of the elements of an action for passing off. The necessary elements are said to be as follows:

**AA** helpful summary of the elements of an action for passing off can be found in *Halsbury's Laws of England* (4th Edition) Vol. 48 (1995 reissue) at paragraph 165. The

guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v Borden Inc* [1990] RPC 341 and *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1979] A.C. 731 is (with footnotes omitted) as follows:

"The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

- (1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and
- (3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal, definition of 'passing off', and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House."

Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

"To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action."@

50. The date at which the matter must be judged is not entirely clear from Section 5(4)(a) of the Act. This provision is clearly intended to implement Article 4(4)(b) of Directive 89/104/EEC. It is now well settled that it is appropriate to look to the wording of the Directive in order to settle matters of doubt arising from the wording of equivalent provisions of the Act. The relevant date may therefore be either the date of the application for the mark in suit (although not later), or the date at which the acts first complained of commenced **B** as per the comments in *Cadbury Schweppes Pty Ltd v The Pub Squash Co Pty Ltd* [1981] RPC 429.

51. In *South Cone Incorporated v Jack Bessant, and others*, [2002] RPC 19, Pumfrey J stated.

A27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirement of the objection itself are considerably more stringent than the enquiry under S.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's* application (OVAX) (1946) 63 RPC 97 as qualified by *BALI Trade Mark* [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed at the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of

possibilities that passing off will occur.@

52. In my assessment of the ground under Section 5(2)(b), I highlighted various weaknesses in the opponents' evidence relating to their claim to a reputation in the UK. The best that it gets is in exhibit JHS2, which is comprised of a large collection of extracts from articles in various publications that mention or relate to the activities of the opponents. Many are from publications for the retail and advertising trade, and consequently would not have been seen by the public at large. There are a number of references in some of the press extracts forming part of exhibit JHS2, in which the writer gives a personal account of having purchased training shoes from FOOT LOCKER, or that refer to customers seeking to return faulty trainers. Whilst this is an indication that they have carried on a trade in sports footwear, there is not one piece of evidence relating to an actual sale of such goods. The only evidence relating to goods other than sports footwear consists of general references to apparel and accessories, but again, no explanation of what these goods are, or a shred of evidence that establishes there to have been a sale.

53. Taking the best possible view of the evidence, the most that can be said is that it indicates that the opponents probably have a goodwill and reputation in respect of training shoes/sports footwear. Given that such goods are worn by men and that the mark applied for covers menswear at large, it follows that the opponents' reputation and goodwill extends to goods covered by the applicants' mark.

54. What evidence there is that shows how the opponents actually use the mark indicates that this is overwhelmingly in conjunction with various graphical elements. I have already given my view that I do not consider the words FOOT LOCKER to be a similar trade mark to GYMLOCKER, and use with a logo moves the respective marks even further apart. The extracts in exhibit JHS2 refer to the opponents by the name FOOT LOCKER solus, but that is hardly surprising given that in composite marks it is the words that speak. Whilst this indicates that the opponents are likely to be known by the word alone it is not possible from the evidence to quantify this. Whilst some of the shop-front signage appears to have used the word on its own, the evidence does not establish this to have been the case prior to the relevant date. It is the composite versions of the mark that the consumer will most likely have encountered in use in trade.

55. Given that, at least in part, identical goods are involved, then the manner in which the trade is carried on by the respective parties must be the same, as would be the consumers of the goods in question.

56. Taking all of the above into account, I come to the position that even if I were to accept that the opponents have established that they have a reputation and goodwill, it is only in respect of sports footwear such as training shoes. But given the differences in the mark for which that reputation/goodwill exists, be it FOOT LOCKER solus or the composite version, there will be no misrepresentation by the applicants' use of GYMLOCKER in respect of any of the goods for which they seek to register the mark, that will or is likely to lead the public to believe that those goods are goods of the opponents. That being the case I do not see how the opponents will suffer damage by the applicants' use and the ground under Section 5(4)(a) is also dismissed.

57. The next objection is founded under Section 5(3) of the Act. That section reads as follows:

5(3) A trade mark which -

- (a) is identical with or similar to an earlier trade mark, and
- (b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.@

In *Pfizer Ltd v Euro Food-Link (UK) Ltd* ((ChD) [1999] 22(4) IPD 22039) Mr Simon Thorley QC sitting as a Deputy High Court Judge said:

"What is necessary is that the trade mark proprietor should prove the required reputation and should then satisfy the Court that the defendants use of the sign is:

- (a) without due cause; and
- (b) takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark."

58. The first problem with the opponents=case in respect of this objection is that I do not consider the respective marks to be similar. I have already expressed my view that at its best the evidence Asuggests@that at the relevant date the opponents may have possessed a reputation in the name FOOT LOCKER, but does not Aestablish@this to have been the case. Even if I were considered to have been too harsh and it was accepted that the opponents had a reputation, it can only be in respect of training shoes or sports footwear which are identical and similar goods to those covered by the applicants= mark. The opponents= case is based on the respective goods being dissimilar, and accordingly, I see no way that this ground can succeed. It is dismissed accordingly.

59. I have already stated that I do not consider the opponents=evidence to establish that they have a reputation, and adopting the language of the Paris Convention, I would have to say the same is the case in respect of their claim to FOOT LOCKER being a well known mark. It is my understanding that the Paris Convention does not grant protection to a mark simply because it is well known, but rather that because it is well known there will be a likelihood of confusion with a later right. Given that I do not consider the respective marks to be similar, even if I were to accept the opponents as having established that their mark s well known, I could not find there to be a potential for confusion. On the facts before me I do not see that a ground founded upon a claim to be a well known mark within the meaning of Article 6 bis of the Paris Convention is sustainable.



60. The opposition having failed on all grounds, the applicants are entitled to costs. I order the opponents to pay the applicants the sum of £2,950 as a contribution towards their costs. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 24<sup>th</sup> day of October 2005**

**Mike Foley  
for the Registrar  
the Comptroller-General**



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Trade mark details as at 24 October 2005

## DETAILS FOR COMMUNITY TRADE MARK E1131044

### Mark text:

FOOT LOCKER STREET EXPERIENCE

**UK case status:** Registered

**Original language:** Dutch

**Second language:** English

**Classes:** 36, 41

### Relevant dates

**Filing date:** 08.04.1999

**Publication date:** 03.07.2000

**Registration date:** 24.11.2000

### List of goods or services

**Class 36:**  
Sponsoring of sporting events.

**Class 41:**  
Entertainment; sporting and cultural activities.

### Names and addresses

**Applicant:** FL Europe Holdings, Inc.  
112 West 34th Street, New York, NY, United States of America, 10120

**Representative:** KEESOM & HENDRIKS N.V.  
Delistraat 45, Den Haag, Netherlands, 2585 VX

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\* Please note that the "E" prefix is used purely within the UK and is not part of the Community Trade Mark number.

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Trade mark details as at 24 October 2005

## DETAILS FOR COMMUNITY TRADE MARK E1523497

### Mark text:

FOOT LOCKER RUNNING EXPERIENCE

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**UK case status:** Registered

**Original language:** Dutch

**Second language:** English

**Classes:** 36, 41

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### Relevant dates

**Filing date:** 23.02.2000

**Publication date:** 08.01.2001

**Registration date:** 26.07.2001

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### List of goods or services

**Class 36:**

Financial organization and sponsorship of sporting events.

**Class 41:**

Entertainment, sporting and cultural events.

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### Names and addresses

**Applicant:** Venator Group Retail, Inc.  
233 Broadway, New York, United States, 10279-0003

**Representative:** BUREAU GEVERS  
Brussels Airport Business Park Holidaystraat, 5, Diegem, Belgium, 1831

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Trade mark details as at 24 October 2005

## DETAILS FOR COMMUNITY TRADE MARK E2053759

### Mark text:

FOOT LOCKER SPORTS EXPERIENCE

**UK case status:** Registered

**Original language:** Dutch

**Second language:** English

**Classes:** 36, 41

### Relevant dates

**Filing date:** 23.01.2001

**Publication date:** 27.08.2001

**Registration date:** 04.02.2002

### List of goods or services

#### Class 36:

Sponsoring of sporting events.

#### Class 41:

Entertainment, sporting and cultural activities.

### Names and addresses

#### Applicant:

FL Europe Holdings, Inc.  
112 West 34th Street, New York, NY, United States of America, 10120

#### Representative:

KEESOM & HENDRIKS N.V.  
Delistraat 45, Den Haag, Netherlands, 2585 VX

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