

O-446-14

TRADE MARKS ACT 1994

**TRADE MARK APPLICATION NO. 3023015
BY EWA ZELAZKO
TO REGISTER THE TRADE MARK**

Gladiator
DESIGNED FOR FIGHTERS

IN CLASSES 5, 25 AND 28

AND

**THE OPPOSITION THERETO UNDER NO. 401373
BY PFANNER SCHUTZBEKLEIDUNG GMBH**

Background and pleadings

1. Ewa Zelazko applied for the trade mark shown below on 20 September 2013, in classes 5, 25 and 28:



2. The application was published on 18 October 2013 and was subsequently opposed by Pfanner Schutzbekleidung GmbH (“the opponent”) on the basis that there is a likelihood of confusion, under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) with the opponent’s earlier protected International Registration (“IR”), 1163004, which designated the UK on 30 November 2012, with protection being conferred on 24 January 2014. The IR is for the mark GLADIATOR, and the opponent relies upon the following goods:

Class 9: *Protective helmets; protective garments for work, **except shirts**; knee pads for workers; protective masks.*

Class 25: *Outerwear and underclothing for ladies, gentlemen and children, **except shirts**; ready-made clothing, **except shirts**; tricot clothing, **except shirts**; pullovers, sweaters, coats, overcoats, underclothes; shoes, boots, leisure time shoes; working shoes, alpine shoes, hiking shoes, winter boots, shoes and boots made from rubber, PVC or foamed materials; insoles for shoes (not for orthopedic use); headgear, hats, caps; belts; gloves, **shirts**, jackets; trousers, ties, earmuffs, headbands; scarves, socks, stockings, pantihoses; rain clothing, **except shirts**, raincoats, rain proof jackets, rain proof trousers; winter clothing, **except shirts**; hiking clothing, **except shirts**; clothing for motorists motorcyclists, bicyclists and bikers; trekking clothing, **except shirts**; overalls; tippets; sweat absorbing underclothing; outerwear and underclothing for sports, **except shirts**.*

3. “Except shirts” is an exclusion which appears in the protected specification in all the places which I have emboldened, but which the opponent has omitted from the list of goods which it relies upon in its notice of opposition¹. The effect of omitting the exclusions which operate on its protected goods is to widen the scope of protection. This is not permissible. Consequently, I will consider the goods relied upon with the exclusions which apply to the protected goods.

4. Omitting the exclusion which widens the scope of the goods relied upon is one thing, but the opponent has made matters worse by actually inserting as a term the very item of clothing which has been excluded. It has inserted ‘shirts’, which does not appear as a term in the specification of its protected goods. I do not know why the opponent has couched its relied-upon goods in this way, but it seems to me that

¹ Statutory form TM7.

this is an action which it should not have pursued. In short, the exclusions will operate in this opposition decision and I will not take into account shirts because the opponent does not have cover for shirts (and has, in fact, excluded them).

5. The opposition is directed at the following goods of the application:

Class 25: *Clothing; t-shirts; shorts; hoodies; tracksuits; hats; footwear; headgear.*

Class 28: *Head guards; sporting articles; shin guards.*

6. Mr Zelazko filed a counterstatement, denying a likelihood of confusion between the marks and putting the opponent to proof that it has made genuine use of its earlier mark within the five year period ending on the date on which the application was published, as per section 6A of the Act. This request for proof of use is misconstrued because the IR had been protected for less than five years on the date on which the opposed application was published. The consequence of this is that the opponent may rely upon the notional breadth of the goods listed in its notice of opposition, subject to the caveats I have detailed in paragraphs 3 and 4 above. Mr Zelazko states that Gladiator will not be used on its own, but will always be used with the words “Designed for Fighters”, so there will be no confusion. He claims that the size and type of font was created especially for him. Mr Zelazko states that his clothing is solely for martial arts, such as boxing head guards and boxing gloves, not helmets or casual gloves. He states that the parties’ goods will not be sold through similar trade channels. His martial arts shin guards are not similar to the opponent’s knee pads for workers; he states that they do not protect the same body parts and the purposes and trade channels are different.

7. The opponent is represented by its trade mark attorneys, Harrison Goddard Foote LLP. Mr Zelazko represents himself. Neither side asked for a hearing. The opponent filed evidence and written submissions during the evidence rounds, but chose not to file written submissions in lieu of a hearing. Mr Zelazko did not file evidence, filed submissions during the evidence rounds, and did not file any submissions in lieu of a hearing. I make this decision after a careful reading of all the papers before me.

Evidence

8. The opponent’s evidence comes from Rosemary Barker, the opponent’s trade mark attorney. Ms Barker refutes Mr Zelazko’s statement that shin guards and knee pads for workers protect different body parts. Ms Barker states that knee pads which have extensions to cover and protect the shins are frequently used by carpet layers, roofers and plumbers. Ms Barker has filed Exhibit RAB which consists of internet prints from March 2014 showing a ProFlex kneepad with a shin guard, sold by egodyne.com, and an Impacto Knee and Shin Combination sold by thesafetysupplycompany.co.uk.

Decision

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

“(2) A trade mark shall not be registered if because –

(a)

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

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

10. The following principles are gleaned from the decisions 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.

The principles

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may 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 great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks 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

11. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where 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.”

12. ‘Complementary’ was defined by the General Court (“GC”) in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-325/06*:

“82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking...”

13. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited* (“Treat”) [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

14. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J said:

"... 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) (IP TRANSLATOR)* [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."

In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

"I should add that I see no reason to give the word "cosmetics" and "toilet preparations"... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context."

15. The competing specifications are shown in the table below.

Earlier mark	Application
<p>Class 9: <i>Protective helmets; protective garments for work, except shirts; knee pads for workers; protective masks.</i></p> <p>Class 25: <i>Outerwear and underclothing for ladies, gentlemen and children, except shirts; ready-made clothing, except shirts; tricot clothing, except shirts; pullovers, sweaters, coats, overcoats, underclothes; shoes, boots, leisure time shoes; working shoes, alpine shoes, hiking shoes, winter boots, shoes and boots made from rubber, PVC or foamed materials; insoles for shoes (not for orthopedic use); headgear, hats, caps; belts; gloves, jackets; trousers, ties, earmuffs, headbands; scarves, socks, stockings, pantihoses; rain clothing, except shirts, raincoats, rain proof jackets, rain proof trousers; winter clothing, except shirts; hiking clothing, except shirts; clothing for motorists</i></p>	<p>Class 25: <i>Clothing; t-shirts; shorts; hoodies; tracksuits; hats; footwear; headgear.</i></p> <p>Class 28: <i>Head guards; sporting articles; shin guards.</i></p>

<i>motorcyclists, bicyclists and bikers; trekking clothing, except shirts; overalls; tippets; sweat absorbing underclothing; outerwear and underclothing for sports, except shirts.</i>	
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16. As per the judgment of the GC in *Gérard Meric v OHIM* Case T-133/05, goods can be considered as identical when the goods of the earlier mark are included in a more general category, included in the specification of the trade mark application. Vice versa, if the goods of the application are included in a more general category included in the specification of the earlier mark, they must be identical. For this reason, Mr Zelazko's *clothing* is identical to the opponent's goods in class 25. Mr Zelazko's *shorts; hoodies; tracksuits* are all encompassed by the opponent's wide term *ready-made clothing, except shirts, and outerwear and underclothing for sports, except shirts* so are identical. Mr Zelazko's *hats; footwear; headgear* encompass or are identically worded to the opponent's *shoes, boots, leisure time shoes; headgear, hats, caps*, and so these goods are also identical.

17. In class 25, this leaves Mr Zelazko's *t-shirts*. A t-shirt is not the same as a shirt: in the UK, a shirt is more of a buttoned, collared garment. Mr Zelazko's *t-shirts* are covered notionally by the opponent's *ready-made clothing, except shirts* and so are identical. Even if I am wrong about this, and t-shirts are covered by the excluded *shirts*, t-shirts are similar to a good degree with other items covered by the opponent's specification, such as sweatshirts and tops.

18. Ms Barker's evidence shows that knee guards for workers may incorporate an extension to protect the shin. I think this was as likely at the date of application as on the date of the prints (six months apart). It seems that guards for legs can incorporate various elements to protect more than one part of the lower leg. There is some similarity in nature between knee pads for workers and shin guards; similarity in purpose as they are for protecting at least one part of the lower leg; and similarity in methods of use (strapped around the leg). The users are different, as the opponent's goods are for workers, whereas Mr Zelazko's goods are for sportsmen and women. It seems to be unlikely that a consumer wishing to purchase protection for the lower leg when playing sport would go to a place selling workwear protection, and unlikely that e.g. a carpet layer would go to a sports retailer for lower leg protection. The channels of trade are different. There is low level of similarity between Mr Zelazko's shin guards and the opponent's knee pads for workers. There is a reasonable degree of similarity between Mr Zelazko's shin guards and the opponent's protective helmets, as these could be for sporting purposes (see below). They are likely to be sold side by side in a sports equipment outlet, are both for protection against injury, and may be sold together as part of a package for participation in a particular sport.

19. Mr Zelazko has applied for head guards in class 28. The only head guards which are proper to class 28, according to the *TMClass* classification tool², are karate head guards. All other head protection, including for sporting purposes, is proper to class 9, which begs the question as to whether, with the exception of karate headguards, Mr Zelazko's goods (which he says are for martial arts) are proper to class 9, rather than the applied-for class 28. The opponent's term *protective helmets* covers sports helmets which will be sold in sports shops alongside karate head guards. There is similarity in nature, purpose, users, method of use, channels of trade and the goods may be used as alternatives, introducing an element of competition between the parties' goods. The opponent's *protective helmets* are highly similar to Mr Zelazko's *head guards*.

20. The opponent's term *protective helmets* covers helmets for sporting purposes. Although in different classes, these must be highly similar to Mr Zelazko's *sporting articles* because this is a wide term which covers karate head guards.

Average consumer

21. The average consumer is reasonably well informed and reasonably circumspect and observant, but his level of attention is likely to vary according to the category of goods or services. The average consumer here is the general public. Although I bear in mind that there may be an aural aspect to the purchasing process, the goods will be purchased primarily visually after examination of sales information, such as catalogues or websites, and the goods themselves. Items of ordinary cost will cause some degree of care to be used, but not the highest level of care. The more expensive the goods are, the closer will be the attention paid to the purchase. In addition, factors such as size, comfort and construction play a part in attentiveness.

Comparison of marks


22. 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 Court of Justice of the European Union 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.”

² A classification database to which many countries, including the UK and the World Intellectual Property Organisation, which oversees international classification of goods and services for the purpose of trade mark protection, have signed up.

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.

23. The respective marks are:

Opponent	Applicant
<p>GLADIATOR</p>	

24. I note that the opponent’s IR is registered in word-only form and that Mr Zelazko claims that the stylised font in his mark has been created especially for him.

25. In *Peek & Cloppenburg v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-386/07*:

“27 Furthermore, the Board of Appeal was wrong to take into account the particular font used by the mark applied for in its comparison of the signs at issue. As the applicant is correct to note, since the earlier mark is a word mark, its proprietor has the right to use it in different scripts, such as, for example, a form comparable to that used by the mark applied for (see, to that effect, Case T-346/04 Sadas v OHIM – LTJ Diffusion (ARTHUR ET FELICIE) [2005] ECR II-4891, paragraph 47).”

Mr Iain Purvis QC, sitting as the Appointed Person in *China Construction Bank Corporation v Groupement Des Cartes Bancaires*, Case BL O/281/14, stated:

“It is well established that a ‘word mark’ protects the word itself, not simply the word presented in the particular font or capitalization which appears in the Register of Trade Marks. See for example Present-Service Ullrich GmbH & Co. KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-66/11 at [57]. A word may therefore be presented in a different way (for example a different font, capitals as opposed to small letters, or hand-writing as opposed to print) from that which appears in the Register whilst remaining ‘identical’ to the registered mark.”

26. These authorities mean that I should consider the earlier mark as being the same as the application because either mark could be used in that font. Mr Zelazko states, but shows no evidence, that his font has been created for him, which would mean that it is not a recognised font. Even if this is the case, the prominent, indeed overwhelming, impression created by his mark is the word Gladiator because the strap-line is very small in comparison with the cursive script Gladiator element in his mark. Gladiator has much greater relative weight in the overall impression. The only

impression created by the opponent's mark is the word Gladiator. This creates a high degree of visual and conceptual similarity between the marks. There is a good degree of aural similarity between the marks because the first word which will be spoken in Mr Zelazko's mark is the identical word to the opponent's mark; however, there are additional words which are not present in the earlier mark. The words 'Designed for Fighters' does not alter the conceptual similarity; if anything, it reinforces the idea of those engaged in combat.

Distinctive character of the earlier mark

27. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*³ 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 *Windsurfing Chiemsee 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).”

28. The word GLADIATOR has a reasonable degree of inherent distinctive character. The opponent has not shown that any use it might have made of its mark has increased that level of inherent distinctive character. Invented words usually have the highest level of inherent distinctive character. GLADIATOR is not an invented word, but it is distinctive because it is the name of an archaic type of fighter, redolent of hand to hand combat in the amphitheatres of Ancient Rome. It does not describe modern fighters and so is a word which is distinctive for the goods.

Likelihood of confusion

29. Mr Zelazko submits:

“I believe that “Gladiator” as a word shouldn't be exclusively registered only under one company. The word “Gladiator” is commonly used on a daily basis

³ Case C-342/97

by many different trades therefore it is unfair to exclude it from the market. I believe that it is rightful for me to use the “Gladiator” alongside of other words which creates a one and coherent logo “Gladiator Designed for Fighters”

Precedent exists, with other trademarks in the same class, which allows multiple trademarks to share common words. “Warrior” is one such example as a number of trademarks exist which contain this word. For example; “WARRIOR SPORTS”, “WARRIOR WEAR”, “WARRIOR INTERNATIONAL” and “WILD WARRIOR”. All of them are in class 25.”

30. I have no information about the alleged common use of Gladiator as a trade mark, how GLADIATOR marks are being used and on what goods or services. Mr Zelazko states it is a word used “by many different trades”. The same word can be registered as a trade mark for entirely different goods or services, in different areas of trade, because the different areas of trade do not cause the marks to be confused, e.g. LOTUS for kitchen towel and LOTUS for cars. I do not know what the average consumer’s perception of these marks may be in relation to the various goods; and whether the average consumer is used to distinguishing between them on account of the alleged prevalence of Gladiator ‘marks’⁴.

31. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. One of those principles states that a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*). I have found that the goods range from being identical to reasonably similar. Although Mr Zelazko states that his goods will be used on martial arts, that is not what he has applied for. In *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06, the CJEU stated at paragraph 66 of its judgment that when assessing the likelihood of confusion under Section 5(2) it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered, which means on all the goods for which the application has cover.

32. The earlier mark is also reasonably distinctive. It only consists of the word GLADIATOR, which is by far the most dominant and distinctive element in the application. Even considering the application as a whole, with the strap-line “Designed for Fighters”, the overwhelming impression of the mark is of a Gladiator mark. In relation to the goods, even for shin guards, there is little to distinguish between the marks. Even if the stylisation was taken into account by the average consumer, the conclusion would be that it is another of the opponent’s marks, or that the word only mark GLADIATOR is another of the applicant’s marks, as confusion works both ways. There is a likelihood of confusion.

⁴ See the judgment of the General Court in Case T-285/12 *The Cartoon Network, Inc v OHIM*, paragraph 54 *et seq.*

Outcome

33. The opposition succeeds. The application is refused for the goods which were opposed but may proceed to registration for those which were not opposed, i.e.:

Class 5: Dietary supplements; protein; sport supplements

Class 28: Boxing gloves; martial arts gloves; mma gloves; weightlifting accessories; boxing equipment; martial arts equipment.

Costs

34. The opponent has been successful and is entitled to a contribution towards its costs, according to the published scale in Tribunal Practice Notice 4/2007. The opponent's evidence and written submissions were very brief so I will reduce the scale minimum for these. The breakdown is as follows:

Preparing a statement and considering the counterstatement	£200
Opposition fee	£200
Evidence	£200
Written submissions	£100
Total:	£700

35. I order Ewa Zelazko to pay Pfanner Schutzbekleidung GmbH the sum of £700 which, in the absence of an appeal, should be paid within seven days of the expiry of the appeal period.

Dated this 15th day of October 2014

**Judi Pike
For the Registrar,
the Comptroller-General**