

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NUMBER 672500
BY GO SPORT SA TO REGISTER A TRADE MARK
IN CLASSES 9, 12, 18, 24, 25 AND 28**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
NUMBER 70119 BY CALZATURIFICO RUGGERI
& PAGNANINI SPA**

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BACKGROUND

1. On 9 March 1998 GO Sport SA applied to protect the following trade mark in the United Kingdom in Classes 9, 12, 18, 24, 25 and 28 under the provisions of the Madrid Protocol on the basis of registration in France:

MARK

SPECIFICATION OF GOODS

- | | |
|----------|--|
| Class 9 | Spectacles, sunglasses, nautical apparatus and instruments. |
| Class 12 | Bicycles, motorcycles, tricycles, carts and golf carts. |
| Class 18 | Leather and imitation leather; animal skins and hides; trunks and suitcases; umbrellas, parasols and walking sticks, whips and saddlery; bags for climbers, school bags, bags for campers, sports bags, hiking bags, backpacks, travelling bags. |
| Class 24 | Fabrics for textile use; bed blankets and table covers, sleeping bags. |
| Class 25 | Clothing and headwear, and especially for sports, ski, football, rugby, dance, beach and after-ski wear; but not including footwear. |

Class 28 Toys, gymnastic and sporting articles (except clothing); Christmas tree decorations.

2. The application was subsequently published in the Trade Marks Journal and on 20 April 1999 Calzaturificio Ruggeri & Pagnanini SpA filed a Notice of Opposition. In summary the grounds were:-

- (i) Under Section 5(1) and/or 5(2) of the Act because the mark applied for is virtually identical and relates to goods identical or similar to those encompassed by the opponents earlier UK trade mark registration No 1542002 for the mark WANNABE, dated 15 July 1993, in relation to "Footwear, shoes, boots, slippers and socks; all for women; all included in Class 25".
- (ii) Under Section 5(3) of the Act because the mark applied for is similar to the opponent's mark and is to be registered for some goods which are not similar to those for which the opponent's mark is registered and that the opponent's earlier mark has a reputation in the United Kingdom so that use of the applicant's mark without due cause would take unfair advantage of or be detrimental to the distinctive character and repute of the earlier mark.
- (iii) Under Section 5(4)(a) of the Act because the use of the mark applied for by the applicant in respect of the goods the subject of the application is likely to be prevented by the law of passing off.

3. The applicant filed a counterstatement denying the above grounds. The opponent has filed evidence and both sides have asked for an award of costs in their favour. The matter came to be heard on 3 August 2001 when the applicant for registration was represented by Ms Reid of Counsel, instructed by Urquhart Dykes & Lord and the opponent by Mr Hacon of Counsel, instructed by Lewis & Taylor.

Opponent's Evidence

4. The opponents filed an affidavit by Attilio Raffaelli dated 24 January 2000 which was subsequently amended by a second affidavit dated 22 March 2000. Mr Raffaelli is the Managing Director of Calzaturificio Ruggeri Pagnanini SpA (the opponent).

5. Mr Raffaelli points out that his company owns numerous world-wide registrations for the trade mark WANNABE in the UK, Italy, Canada, Hong Kong, Sweden, Norway, Taiwan, Ireland, Australia, Denmark, Greece, Brazil and Japan in Class 25 and an International Registration (not covering the UK) in Classes 18 and 25. Details of these registrations are at Exhibit AR1 to his affidavit.

6. Mr Raffaelli explains that the opponent company was formed in 1971 with the primary intention of producing shoes for the younger sector, designed by well known designers. He adds that the trade mark WANNABE was launched in the UK in 1993 for footwear, bags and leather goods and that since 1995 clothing has been sold under the mark in the UK.

7. Mr Raffaelli states that his company has a total annual turnover in the foregoing goods under the mark WANNABE of approximately £45 million and of this turnover, approximately 1% is accounted for by sales in Italy and approximately 99% by sales throughout the world. Substantial amounts of goods under the mark are sold in particular to the following countries:-

COUNTRY	SALES AS APPROXIMATE PERCENTAGE OF TOTAL SALES	
Germany	1%	(one per cent)
UK	55%	(fifty five per cent)
France	5%	(five per cent)
Japan	30%	(thirty per cent)
Other Countries	8%	(eight per cent)

8. In relation to his company's strategy of using well known designers, Mr Raffaelli explains that his company has forged an association with the designer Patrick Cox and that the goods sold under the mark WANNABE are designed by Patrick Cox. He says that Patrick Cox arranges directly for the manufacture of all clothing items other than footwear and for the majority of leather goods which have been sold under the trade mark WANNABE in the UK. At Exhibit AR 2 to his affidavit are copies of internet pages referring to Mr Cox, the goods under the trade mark and Mr Cox's association with the company.

9. Mr Raffaelli states that the goods sold under the mark WANNABE have been sold continuously and in particular through flagship Patrick Cox stores in London and Manchester. Furthermore, they have been sold through departmental stores and independent retailers in the following UK locations:-

Blackpool	Manchester	Liverpool
Southport	Chester	Newcastle-upon-Tyne
Durham	Darlington	Middlesborough
Leeds	Bradford	Sheffield
Derby	Leicester	Northampton
Birmingham	Lincoln	Cambridge
Norwich	Chelmsford	Bath
Salisbury	Bournemouth	Plymouth
Slough	Winchester	Chichester
Luton	London	Surrey
Guildford	Brighton	Kent
Edinburgh	Glasgow	Swansea
Cardiff	Belfast	

10. Mr Raffaelli explains that the mark WANNABE has been used on labels attached to the goods, swing tickets, shoe horns, point of sale promotional material, advertisements, booklets

and brochures. At Exhibit AR 3 to his affidavit are copies and photographs of the foregoing.

11. In relation to sales of footwear, leather goods/bags in the UK under the mark WANNABE which are manufactured by his company. Mr Raffaelli states that the total sales of such goods during the past 5 years is as follows:-

YEAR	TOTAL SALES IN STERLING
1995	Over 2.3 million
1996	Over 3.2 million
1997	Over 3.5 million
1998	Over 4.7 million
To September 1999	Over 3.5 million

He adds that his company has spent a considerable sum annually on advertising aimed at the general public to raise their awareness of the mark WANNABE including promotion of the mark via the Internet and a continuous and extensive magazine advertising campaign through publications such as *Arena Homme, Elle, Vogue, Marie Claire, Wallpaper, The Face, Harpers & Queen, Scene, The File, FHM, Red*. Exhibit AR 4 to his declaration comprises a brochure of the company which is made available to the trade and which explains and evidences advertising strategy. He confirms that advertising relates to footwear and items of clothing other than footwear.

12. Next, Mr Raffaelli states that the sums spent on advertising the mark WANNABE in the UK during the past 4 years are as follows:-

YEAR	TOTAL IN STERLING £
1996	Over 100 thousand
1997	Over 150 thousand
1998	Over 170 thousand
To September 1999	Over 350 thousand

13. Mr Raffaelli claims that the mark WANNABE has been widely advertised among the general public and especially the young fashion conscious members of the public at whom the advertising is primarily directed. At Exhibit AR5 to his affidavit, are examples of the magazine advertising in the UK which the company commissioned during 1996 to 1999 to promote the mark.

14. The opponent has also filed a witness statement by Claudia Sodano dated 4 July 2000. Ms Sodano is the International Wholesale Manager for Cobblers Limited, trading as Patrick Cox.

15. Ms Sodano explains that her company has an agreement with the opponent whereby the designer Patrick Cox designs for her company and the opponent manufactures a range of footwear under the trade mark WANNABE. Her company retails this range of footwear in

the UK and abroad under the trade mark and has done so continuously since 1993. Additionally, under agreement Patrick Cox designs a range of bags/leather goods under the trade mark which are sold in the UK and abroad. Ms Sodano confirms that the opponent has manufactured approximately 3.4 thousand items of bags/leather goods which have been sold in the UK under the mark WANNABE but states that this figure only accounts for a proportion of total sales of such goods by her company and figures for total sales of such goods during 1995-1997 are as follows:-

YEAR	TOTAL GLOBAL SALES IN STERLING
1995	500,000
1996	700,000
1998	1,900,000

She explains that UK sales are approximately 40% of total global sales per year and at Exhibit CS 2 to her statement are copies of designs of bags and leather goods with certain items of clothing.

16. Furthermore, Ms Sodano states that under the agreement the designer Patrick Cox has since 1995 designed a range of clothing under the trade mark for her company and, since Spring/Summer 1998, a range of jewellery. She adds that the foregoing goods have been sold continuously under the trade mark in the UK since the aforesaid dates of first use. Also, her company will shortly commence sales of sunglasses under the trade mark both in the UK and abroad. At Exhibit CS 3 of her statement are copies of designs for and items of the aforementioned items of jewellery.

17. In relation to sales of clothing items in the UK, Ms Sodano states that the approximate figures for yearly sales of such goods during the period 1995 to 1997 are as follows:-

YEAR	TOTAL SALES IN STERLING
1995	Over 600 thousand
1996	Over 700 thousand
1997	Over 450 thousand

and in relation to sales of items of jewellery in the UK, the approximate figures for yearly sales of such goods during the period Spring/Summer 1998 - June 2000 are as follows:-

YEAR	TOTAL SALES IN STERLING
1998	Over 5,500
1999	Over 6,500
2000 (first 6 months)	Over 1,000

18. Ms Sodano confirms that goods under the WANNABE trade mark are sold throughout the UK through many different types of retail store, for example, through her company's

stores, through large department stores such as Harrods and Harvey Nichols, and through independent fashion retailers.

19. Ms Sodano goes on to state that her company has promoted goods under the trade mark by attendance at trade fairs and in the UK, has sold footwear under the trade mark at the Clothes Show Live - Birmingham 1995 to 2000. She adds that, due to the fame of Patrick Cox as a designer, the mark also benefits from press coverage and at Exhibit CS 4 to her statement, Ms Sodano provides copies of press articles making mention of the mark and also a letter dated 29 March 1999 from Ms Mimi Spencer, Fashion Editor at the Evening Standard emphasising the link between "the Wannabe name" and Patrick Cox.

20. Finally, Ms Sodano contends that confusion is particularly likely in the present case as nowadays sportswear items are often sold through the same outlets as fashion items and indeed sportswear items are commonly sold as fashion items.

21. This completes my review of the evidence filed in this case. I now turn to the decision.

DECISION

22. At the hearing Mr Hacon made it clear that the grounds being pursued were Section 5(2)(b), Section 5(3) and Section 5(4)(a) and that the opposition was not against the application in its entirety, but rather against only some of the goods applied for. He summarised the position as follows:-

GROUND	RELEVANT GOODS
Section 5(2)(b)	Class 25 - all goods applied for.
	Class 18 - sports bags.
Section 5(3)	Class 25 - all/any goods not deemed similar for the purposes of Section 5(2)(b).
	Class 18 - sports bags (if not deemed similar goods for Section 5(2)(b); trunks and suitcases; bags for climbers; school bags; bags for campers; hiking bags; backpacks; travelling bags.
	Class 9 - spectacles, sunglasses.
Section 5(4)(a)	Class 25 - all goods applied for.
	Class 18 - all goods applied for (except whips and saddlery).
	Class 9 - spectacles, sunglasses.

23. Both parties drew my attention to the previous decision reached by Mr S Thorley QC. (The Appointed Person) dated 6 November 2000, on an appeal from a Registry Decision in relation to an application to register the trade mark WANNABEE in Class 3 and the opposition by Patrick Cox Designs Limited - Trade Mark Application Number 2057858, Opposition Number 46024. These decisions have not been reported. Mr Hacon distinguished the previous opposition from the case in suit, pointing out the differences in the relevant dates, and the differences in the evidence and the goods at issue. I would merely add that while the earlier opposition was decided on its merits at that particular time, the case in suit must be considered on its own merits in light of all the information presently before me.

24. Firstly, I turn to the ground of opposition under Section 5(4)(a) of the Act which states:-

"5.-(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 ..."

25. The law on this common law tort is clearly set out by Geoffrey Hobbs QC, acting as the 'Appointed Person', in *Wild child* [1998] 14 RPC, 455:

"A 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] ACT 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:

- i. that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- ii. 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
- iii. 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 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."

26. 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."

27. Thus, to succeed in a passing off action, it is necessary for the opponents to establish that at the relevant date (9 March 1998); (i) they had acquired goodwill under their mark, (ii) that use of the applicant's mark would amount to a misrepresentation likely to lead to confusion as

to the origin of their goods; and (iii) that such confusion is likely to cause real damage to their goodwill.

28. The evidence shows that use of the opponent's mark is typically in the following form:-



The name Patrick Cox is used with the WANNABE mark, no doubt as part of the opponent's strategy to associate the designer with the goods being sold.

29. At the hearing, Ms Reid drew attention to the overall differences between the applicants mark and the opponent's mark as used which, she submitted showed clear differences, especially as the words Patrick Cox amounted to a dominant element. However, it seems to me that the WANNABE element within the opponent's mark (as used) is significant and is very similar indeed and in aural use identical, to the mark in suit. Furthermore, as Mr Hacon pointed out this element is distinctive and the public are aware that the market place is full of marks that exist in association with each other e.g. Ford and Mondeo, Cadburys and Milk Tray, which may make it likely that the customer will regard the product as emanating from a single trade origin, particularly if the source of origin possesses a reputation.

30. I now go on to consider the goodwill or reputation attaching to the opponent's mark at the relevant date and from the evidence submitted I have no doubt that a reputation for footwear exists amongst the relevant customer base. My attention was drawn to the high profile advertising campaign and supporting articles about the WANNABE product (examples of which are in Exhibits AR 5 and CS 4 to the evidence filed) as well as to the extent of sales in the UK. However, the position in relation to other products is less straightforward.

31. In relation to clothing and leather goods/bags, Mr Hacon drew my attention to the UK sales figures provided by Ms Sodano in her declaration which show that for the years 1995, 1996 and 1997 total sales of clothing amounted to £1,750,000 and total sales of leather goods and bags amounted to £760,000. Mr Hacon also pointed out that from the evidence filed many relevant advertisements were in relation to clothing being sold under the mark, e.g. in the following magazines:

MAGAZINE

DATE OF PUBLICATION

The Face

March, April, September, October 1996
March, April 1997

Elle	October 1996, September 1997
Wall Paper	September/October 1996, March/April 1997
Vogue	October 1997
Frank	October 1997
Marie Claire	October 1996, September 1997

In contrast, I noted that there was little evidence indeed of advertisements relating to bags/leather goods in the UK and I have been provided with no details of how sales in Class 18 are broken down e.g. between bags, belts, wallets, key fobs etc.

32. During the Hearing Mr Hacon also took me to several magazine articles about the reputation of the mark and while, as stated earlier, those assist in relation to establishing the reputation in footwear, they do not, in my view, really assist in establishing a reputation in clothing or bags/leather goods. For her part, Ms Reid submitted that the opponent's evidence in relation to sales of clothing and bags/leather goods did not demonstrate how the goods were sold and through what outlets. In her view, their sales were probably limited to the Patrick Cox shops in London and Manchester.

33. On the evidence before me, it is apparent that the opponent, since 1995, has achieved a good degree of sales in clothing under the mark and has promoted their mark in relation to clothing in high profile life style magazines. The likely customer for the opponents goods is likely to be relatively affluent and fashion conscious. Furthermore, in my view footwear and clothing are associated products in that they are both for wear, are fashion items, are sometimes sold through the same outlets and sometimes, particularly in the case of high fashion or sports/active wear, share the same origin.

34. In essence, the question I have to address is whether the relevant public seeing the applicant's mark used on clothing would be likely to believe the goods were being offered by the opponent. In my view, the answer, on balance, is yes. The respective marks are similar and the addition of the words "Patrick Cox" in the opponent's mark is likely to lead the relevant public to believe the goods emanated from the opponent given the opponents goodwill and reputation in footwear, their use and promotion of their mark in relation to clothing and the relatively close association between clothing and footwear. I would add that, where the parties are in the same field of activity, if there is confusion between the products there will be damage.

35. I do not lose sight of the fact that the Section 5(4)(a) ground is also pleaded in relation to the applicant's Class 18 and Class 9 specifications - paragraph 22 of this decision refers. However, as mentioned earlier in this decisions, there has been a good deal less use and promotion of the opponent's mark in relation to bags/leather goods in Class 18 and there has been no use before the relevant date in relation to sunglasses and spectacles. Furthermore, I believe the association between footwear and the goods covered by the applicant's Class 18 specification (which does not include handbags or purses) and the relevant Class 9 goods ie.

sunglasses and spectacles to be less close, as a matter of degree, than the association between footwear and clothing. Overall, on balance, I do not believe the opponent's goodwill will extend to the Class 18 and 9 goods specified in the application.

36. To conclude, the opposition under Section 5(4)(a) is successful in relation to Class 25 of the application but does not succeed in relation to Classes 18 and 9.

37. Next, I turn to the ground of opposition under Section 5(2)(b) which reads as follows:-

"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 right is defined in Section 6, the relevant parts of which state:

6.-(1)

- (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,"

I take into account the 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.

38. In essence the test under Section 5(2)(b) is whether there are similarities in the marks and goods which would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally and I need to address the visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements, taking into account the category of services in question and how they are marketed.

39. At the hearing, it was common ground that the mark applied for and the opponent's registered mark are similar and I would add that in aural use they would be identical. The only differences between the marks is that the applicants mark has an additional letter e at the end and that the letter b, which forms the sixth letter of that mark, possesses an element of stylisation as its ascender doubles as an exclamation mark. Furthermore, there are no significant conceptual differences in the marks in my view.

40. The opponents claim a reputation in their mark. On this point, Ms Reid submitted, correctly in my view, that in use the opponent's mark is typically used in the following form:-



However, the public are aware that the market place is full of marks that exist in association with each other and given the inherently distinctive nature of the word "Wannabe" when used as a trade mark, that "Patrick Cox" is likely to be seen either as a reference to the designer and/or an indication of a trade origin and given the nature of the reputation in WANNABE ie. its association with Patrick Cox, I consider the mark to have a reputation in footwear, in particular men's loafers. In my view this reputation would extend to women's footwear, in particular women's loafers (women's footwear being goods for which the opponent's mark is registered).

41. In this case I accept that similar marks are involved and the opponent's mark possesses a reputation for footwear. However it was held in *Marca Mode v Adidas AG* (2000) ETMR 723:

"The reputation of a mark, where it is demonstrated, is thus an element which, amongst others, may have a certain importance. To this end, it may be observed that marks with a highly distinctive character, in particular because of their reputation, enjoy broader protection than marks with a less distinctive character (*Canon*, paragraph 18). Nevertheless, the reputation of a mark does not give grounds for presuming the existence of a likelihood of confusion simply because of the existence of a likelihood of association in the strict sense."

42. I now go on to take into account the goods covered by the specifications of the respective marks. As I have already found for the opponent under Section 5(4)(a), in relation to Class 25, I have limited my comparisons to the relevant goods covered by Class 18 in the application ie. sports bags - see paragraph 23 of this decision. In my determinations on this point I have considered the guidelines formulated by Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* (1996) RPC 281 (Pages 296, 297) as set out below:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or services;
- (d) The respective trade channels through which the goods or services reach the market;

- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

43. Whilst I acknowledge that in view of the CANON - MGM judgement by the European Court of Justice the TREAT case may no longer be wholly relied upon, the ECJ said the factors identified by the UK government in its submissions (which are listed in TREAT) are still relevant in respect of a comparison of goods and services.

44. Mr Hacon contended that in modern trading conditions sports bags are fashion items that could be deemed fashion accessories and sold complimentary to or in association with footwear.

45. In relation to the determinations on this issue I am assisted by a recent Registry Decision (In the matter of Application No. 2001040 by S Oliver Bernd Frier GMBH & Co KG to register a trade mark in Class 18 and 25 and in the matter of Opposition thereto by QS Familywear PLC (1999) RPC 520). In this case the hearing officer commented as follows:-

"In utilising the same test (Jacob J's test in British Sugar) and applying it to this case I shall divide the goods specified under Class 18 of the application for registration into two parts. In doing so I am disregarding the argument put forward at the hearing by the opponents that all items in Class 18 should be regarded as clothing accessories. Mr Moore referred to various shops, such as Miss Selfridge and Next which sell fashion clothing and handbags. He pointed out that outdoor stockists such as Blacks sell outdoor fashion clothing and rucksacks and other leather bags. Finally he referred to sports shops which sold sports fashion clothing and sports bags. I am not convinced that the type of bags sold by sports shops and outdoor stockists could be deemed to be clothing accessories. I therefore propose to deal with the opposition to the Class 18 specification as follows:

- (a) sports bags, shopping bags, toilet bags, keybags, boxes, hereafter referred to as category A goods; and;
- b) Leather goods, leather bags, other leather goods which are not specially made for the things they contain, containers & purses, hereafter referred to as category B goods.

Comparing the category A goods to the opponents' goods registered under Class 25, it is clear that they have different uses and that although they may be the same there is nothing about the nature of the respective goods which suggests that the users will be the same. The physical nature of the goods is very different, as are the trade channels. They are not likely to be found on the same shelf or even in the same sector of a store, and they are not in direct competition.

The descriptions falling in category B cover goods which I regard as clothing accessories, such as hand bags and purses. Comparing these goods to the opponent's goods registered under Class 25, it is clear that the respective uses whilst being correlative or complementary are different. The users will however be the same. The physical make up of the goods is different but the trade channels will probably be the same. The items would be found adjacent to each other if not on the same shelf, whilst the goods are not in competition. The position is finely balanced but they are close enough to be considered similar."

46. Despite Mr Hacon's submissions, I share the view that sports bags and ruck-sacks should not be regarded as clothing accessories and even taking into account modern trading conditions, I am not aware that they are sold as accessories to complement "a look" or outfit and no evidence has been submitted on this particular point.

47. In relation to the determination of similarity between goods in Classes 25 and 18 I find myself in full agreement with the hearing officer's reasoning and conclusions in the above case and accordingly find that the goods specified under Class 25 by the opponent are not similar to the applicant's Class 18 goods and in particular, sports bags. I am fortified in this view in that the opponent does not possess a reputation in sportswear as such.

48. On a global appreciation, taking into account the relevant factors, I come to the conclusion that the opposition under Section 5(2)(b) in relation to Class 18 of the application fails. While the respective marks are similar and the opponent possesses a reputation for footwear, the degree of dis-similarity between the respective goods means that, in my view, there is no likelihood of confusion. While it is possible that some people encountering the applicant's mark on sports bags may be reminded of the opponent's mark it does not follow, given the differences in the relevant goods, that a likelihood of confusion exists amongst the average customer for the goods.

49. Finally, I turn to the Section 5 (3) ground. Section 5(3) states:-

"5.-(3) A trade mark which -

- (f) is identical with or similar to an earlier trade mark, and
- (g) 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."

50. The essential pre-requisites for bringing a case under Section 5(3) are that:

- (a) the earlier mark has a reputation; and

(b) the respective goods/services are dissimilar.

51. As I have already found for the opponent under Section 5(4)(a) in relation to Class 25 the Section 5(3) opposition is relevant to Classes 9 and 18 of the application in suit - see paragraph 22 of this decision. In light of my findings in relation to Section 5(2)(b) I have no doubt that the goods are dissimilar from those covered under the opponent's registration No. 1542002 in Class 25.

52. Earlier in this decision I found that the opponent's reputation, which lies in footwear, was not sufficient to give it actionable goodwill under Section 5(4)(a) of the Act regarding Classes 9 and 18 of the application. I believe that the requirement for reputation under Section 5(3) is a higher threshold but, in any event, I do not consider use of the mark in suit upon the goods specified in Classes 9 and 18 will be parasitic upon the opponent's actual reputation. The case under Section 5(3) fails.

53. The opposition has been partially successful under Section 5(4)(a) of the Act in relation to Class 25 of the application and as the application has been made under the provisions of the Madrid Protocol, refusal exists only in relation to Class 25. As the opponent has only been partially successful and the application is to proceed for all the goods specified in the remaining classes, I make no order as to costs.

Dated this 10 day of September 2001

J MACGILLIVRAY
For the Registrar
the Comptroller-General