

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No 2174897  
BY COURTESY SHOES LIMITED  
TO REGISTER THE TRADE MARKS:**



**IN CLASS 25**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER No 49912  
BY C & J CLARK INTERNATIONAL LIMITED**

**TRADE MARKS ACT 1994**  
**IN THE MATTER OF Application No 2174897**  
**by Courtesy Shoes Limited**  
**to register the trade marks:**

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**in class 25**  
**and**

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**IN THE MATTER OF Opposition thereto under No 49912**  
**by C & J Clark International Limited**

**Background**

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On 13 August 1998 Courtesy Shoes Limited applied to register the trade marks:

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The application was originally for a series of four trade marks. However, after an objection by the examiner under Section 41(2) the applicant deleted two of the trade marks. The applicant claimed that the light grey shading of the lower trade mark represents red. Unfortunately the colour claim in respect of the lower trade mark was not published. (This omission will be rectified, if appropriate, at the termination of the opposition proceedings.) The application was made in respect of the following goods: *articles of clothing, headwear and footwear; parts and fittings thereof* in class 25.

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On 24 June 1999 C & J Clark International Limited filed notice of opposition to this application.

The opponent stated that he is the registered proprietor of the following United Kingdom trade mark registrations:

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- Registration no 401594 of the trade mark **K** in respect of: *boots and shoes* in class 25.
- Registration no 813989 of the trade mark:

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in respect of: *articles of footwear and parts thereof* in class 25

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- Registration no 813990 of the trade mark **K** in respect of: *articles of footwear and parts thereof* in class 25

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The opponent claimed that the respective trade marks are similar and encompass identical or similar goods; consequently registration of the application in suit would be contrary to Section 5(2)(b) of the Act. The opponent also stated that he had made significant use of his earlier registration and that the trade mark has acquired an extensive reputation and goodwill in the United Kingdom. Consequent upon this he believed that registration of the application in suit is liable to be prevented by the law of passing off and so would be contrary to Section 5(4)(a) of the Act. The opponent also stated that he was entitled to claim that the trade mark **K** is a well-known trade mark under the Paris Convention in respect of *boots, shoes, articles of footwear and parts thereof*. The opponent sought an award of costs.

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The applicant filed a counterstatement denying the above grounds and seeking an award of costs.

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Both parties filed evidence. They both agreed that a decision could be made on the basis of the papers filed. Consequently a decision will be taken from a careful study of the papers.

Acting on behalf of the Registrar I duly give the following decision.

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### **Opponent's evidence**

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The opponent's evidence consists of a statutory declaration by Judith Enid Derbyshire, who is the company secretary of the opponent, dated 21 January 2000.

Ms Derbyshire stated that the trade mark "K" was first used in relation to footwear in 1865. She

exhibited an extract from a book entitled “K Shoes - The First 150 Years 1842-1992”. She stated that the letter “K” is distinctive of footwear and bags supplied by the opponent and that the opponent, consequently, enjoys an extensive goodwill in the trade mark “K”. Ms Derbyshire stated that the trade mark “K” has been used extensively in relation to boots, shoes, sandals and all types of footwear and parts and fittings therefor and all types of bags and parts and fittings therefor. She referred to worldwide registrations of her trade mark. Ms Derbyshire gave separate sales figures for footwear under the trade mark “K” in the United Kingdom and worldwide for the years 1986-1999 inclusive. The figures for pairage sales in the United Kingdom were as follows:

	<b>Year</b>	<b>Pairage (000s)</b>
10	1986	3,298.3
	1987	3,213.2
	1988	3,255.6
	1989	3,359.6
15	1990	3,352.6
	1991	3,160.8
	1992	2,233.2
	1993	1,562.9
	1994	1,306.2
20	1995	860.6
	1996	1,172.0
	1997	1,236.0
	1998	1,792.0
	1999 to date	1,581.0

Ms Derbyshire referred to sales in respect of bags. She gave figures for units sold but was unable to identify how many were sold under the “K” trade mark. Consequently these figures cannot have a bearing upon the instant proceedings.

Ms Derbyshire stated that the opponent annually spends approximately £1.3 million in advertising the goods in the United Kingdom and Ireland combined. She stated that advertisements had appeared in various trade journals and other printed publications, including: Daily Telegraph, Sunday Telegraph, The Times, Sunday Times, Daily Mail, Mail on Sunday, You Magazine, The Express, Sunday Express, Irish Independent Saturday Magazine, RTE Guide, Good Housekeeping Magazine.

Ms Derbyshire stated that the opponent produced point of sale material such as leaflets, brochures and catalogues. She stated that for the current year the opponent’s budget was £849,000 for this type of material. She exhibited a list of the locations of the opponent’s principal outlets. Ms Derbyshire stated that the opponent also attends and participates in exhibitions.

Ms Derbyshire stated that use or registration of other trade marks consisting of or containing prominently the letter “K” will be likely to cause confusion in the minds of consumers.

## **Applicant's evidence**

The applicant's evidence consists of statutory declaration by James Bertram King, who is the trade mark agent of the applicant, dated 25 July 2000.

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Mr King stated that the only matters upon which he would disagree with in the declaration of Ms Derbyshire were in paragraph 12. This paragraph stated that the trade mark "K" is distinctive of the opponent and that use or registration of other trade marks consisting of or containing prominently the letter "K" would be likely to cause confusion in the minds of consumers. Mr King stated that he was well acquainted with "K-shoes" but that in his mind the significant feature of identification and goodwill is in the single letter "K" in a stylised format. He stated that the characteristic of the trade mark to him was the absence of any other matter or "clutter" around the letter "K".

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He stated that the reputation of the opponent only relates to footwear and that the opposition should be construed as only being directed against such goods. He stated that he was not sure for which trade mark the opponent had claimed a reputation. He stated that if it was the letter "K" in any style that it was not distinctive in combination with other letters except the word shoes.

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Mr King exhibited a listing of 339 trade marks which include the letter "K" which encompass goods in class 25. There is no way of clearly ascertaining from this list the status of the trade marks or their exact details. Mr King referred to seven trade marks which he stated included footwear in the specification and in which he asserted the letter "K" was prominently used. He exhibited details of these trade marks derived from Patent Office sources.

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Mr King stated that he had been advised that no instances of confusion between the trade mark of the applicant and those of the opponent had come to the attention of any person employed by the applicant or its subsidiary.

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Mr King asserted that the application in suit must be viewed in its totality and when that is done he could not see that the letter "K" is so prominent to the extent that he would draw any association with the trade mark of the opponent.

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## **Opponent's evidence in reply**

The opponent's evidence in reply consists of a witness statement by Judith Enid Derbyshire, dated 15 January 2001.

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Ms Derbyshire disputed the assertions of Mr King. She referred to registrations of the opponent for the letter "K" in non-stylised form. She stated that the documents previously exhibited showed use of the letter "K" in a non-stylised form. Ms Derbyshire exhibited further brochures to demonstrate use of "K" in a non-stylised form. She referred to trade mark registrations which include other matter with "K". She stated that the opponent enjoyed goodwill and reputation in both the stylised and non-stylised form of the letter "K". Ms Derbyshire stated that the opposition was directed against all the goods of the application in suit.

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In relation to the seven trade marks referred to by the applicant in detail, Ms Derbyshire made comments as to the reasons that they were upon the register along with the trade marks of the opponent.

5 Certain of the evidence furnished by the opponent strikes me as not being evidence strictly in reply, but further evidence in chief. I have included it in a summary of the evidence, however, I have not taken into account in relation to my considerations. In the instant case even if I had taken it into consideration nothing would have changed or turned upon this.

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### **Submissions of the opponent**

The submissions of the opponent rehearsed his earlier statements for the most part and, therefore, I do not consider that it is necessary to repeat them. He also stated that on a global comparison of the respective trade marks that there is a likelihood of confusion.

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### **Submissions of the applicant**

20 The applicant rehearsed many of his earlier statements. It is to be noted that much of his earlier evidence is not evidence of fact but mere assertions and opinions and effectively is on a par with his submissions. I, therefore, see no need to repeat his submissions in detail.

The applicant stated that the two tone and colour aspect of the trade mark in colour is significant and adds distinction in that the large letter C predominates.

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### **Decision**

30 The grounds of opposition pursued by the opponent are those under sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994. The relevant provisions read as follows:

Section 5:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

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(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-

45 (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....

The term 'earlier trade mark' is defined in section 6 of the Act as follows:

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

5 (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks."

10 (c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well known trade mark.

### **Preliminary Issue**

#### **15 Well-known trade mark under the Paris Convention**

The opponent has claimed that the letter "K" is a well-known trade mark under terms of *6bis* of the Paris Convention. The opponent has treated this as if it were in itself a ground of opposition. Of course, establishment of a trade mark as being well-known as per *6bis* simply allows that trade mark to be considered in relation to Sections 5(1), (2) and (3) as an earlier trade mark. In the instant case I cannot see how if the opponent had established that he did have a well-known trade mark as per *6bis* that this would improve his position; as he has registrations within the United Kingdom encompassing the relevant goods and the relevant trade marks and which are earlier trade marks.

25 In spite of the otiose nature of the claim to protection under *6bis* I will, for the sake of completeness, deal with issues that arise out of the claim.

Section 56(1) of the Act deals with protection under the Paris Convention:

30 "56-(1) References in this Act to a trade mark which is entitled to protection under the Paris Convention as a well known trade mark are to a mark which is well known in the United Kingdom as being the mark of a person who -

35 (a) is a national of a Convention country, or  
(b) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country,

whether or not that person carries on business, or has any goodwill, in the United Kingdom.

40 References to the proprietor of such a mark shall be construed accordingly.

Section 55(1)(b) defines a convention country as follows:

45 "(b) a "Convention country" means a country, other than the United Kingdom, which is a party to the Convention."

The opponent filed a few advertisements in relation to Ireland. It would be ridiculous to think that this could be considered as proof that he has a real and effective industrial or commercial establishment there. The counterstatement of the applicant stated that he denied that the opponent had a basis to claim that he was from a Convention country. So the applicant had even indicated that the opponent would need to do substantiate his claim under the Paris Convention. Despite this the opponent made many protestations in relation to the Paris Convention but adduced no proper evidence to substantiate that he could claim protection under it.

**The opponent's claim to have a well-known trade mark as per Article 6bis is dismissed owing to the failure to establish that he was a national of a Convention country or was domiciled in or had a real and effective industrial or commercial establishment in a Convention country.**

### **Section 5(2)(b) objection**

In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] R.P.C. 199, *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* page 224;

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG* page 224; 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.* page 84, paragraph

(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* page 224;

(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* page 224;

(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* page 7, 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* page 8, 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* page 224;

5 (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* page 732, paragraph 41;

10 (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* page 9 paragraph 29.

### Reputation

15 The evidence of the opponent demonstrates use in relation to boots, shoes and slippers. No evidence was adduced to show actual use in relation to bags under either trade mark of the opponent.

20 The evidence clearly shows a long and continued use in relation to boots, shoes and slippers. The applicant has made submissions as to which trade mark he considers that the reputation accrues. However, this is more an opinion and an impression than based on the evidence. I consider that the opponent has demonstrated use of the stylised “K”, something with which I believe the applicant agrees. The opponent has also shown use of “K” in a non-stylised format. In exhibit JED5 there is reference to, e.g., “The Lady X range from K”.....” Aquaskips with the K 100%  
25 Waterproof Guarantee”. Other matter that includes “K Shoes” with no stylisation are point of sales counter displays for the Hatia and Josephine brands. The non-stylised form of “K” is also used in many descriptions of products. I also note, in the light of some of the comments of the applicant, that the stylised “K” is used in conjunction with other brand names e.g. AQUASKIPS and AQUATEX.

30 Taking into account the turnover figures, the expenditure on advertising, the long and continued use, the geographical spread of sales, I consider that the opponent has demonstrated that both the stylised and the non-stylised letter “K” enjoy a reputation and goodwill within the United Kingdom in relation to boots, shoes and slippers.

### Comparison of goods

40 The goods encompassed by the specifications of the earlier registrations are: *articles of footwear and parts thereof* and *boots and shoes* in class 25. *Articles of footwear and parts thereof* include *boots and shoes*. The opponent has registrations of the former goods for both the stylised and non-stylised “K”. Therefore, the comparison of goods can deal with both trade marks at the same time.

45 The goods encompassed by the specification of the application in suit are: *articles of clothing, headwear and footwear; parts and fittings thereof* in class 25.

In *Canon* the European Court of Justice held, in relation to the assessment of the similarity of

goods, that the following factors inter alia should be taken into account: their nature, their end users and their method of use and whether they are in competition with each other or are complementary.

5 *Footwear and parts and fittings therefor* are included in the specifications of the earlier registrations; the aforesaid goods are, therefore, identical with the goods of the earlier registrations.

*Articles of clothing* of the application in suit include items of footwear; such as socks, tights etc. In so far as *articles of clothing* include *footwear* the goods are identical.

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In relation to the other goods encompassed by *articles of clothing* and the goods encompassed by *headwear* these are all articles for wear on the body. They are all goods that are for use for protection and/or adornment of the body. It is also common for one shop to sell a range of goods that includes *clothing, footwear* and *headgear*. They, therefore, have the same end users - persons who wish to protect and/or adorn the body - and the same nature - goods for the aforesaid purposes. However, the respective goods are in competition; one is not likely to purchase a pair of shoes in substitution for a shirt. It is possible that a customer will purchase footwear to match a dress or similar article. Such a purchase does not represent an automatic sequitur; there is no symbiotic or essential dependant relationship between the goods. It is, for example, not like the relationship between computer hardware and software. Consequently I do not consider that the respective goods are complementary. Taking into account the end users, the nature of the goods and the common channel of trade I consider that the goods of the application in suit which are not identical are similar to the goods encompassed by the earlier registrations.

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(As *parts and fittings* are simply adjuncts of the respective goods I consider that they too will be similar.)

**Therefore, the respective goods are either identical or similar.**

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## Comparison of the signs

The trade marks to be compared are as follows:

5 Earlier registrations:



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and

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**K**

Application in suit:



25 As stated above the application in suit is for a series of two trade marks. The applicant claims that the light grey shading of the lower trade mark represents red. I will first deal with the non-colour claim trade mark of the applicant.

30 Visually the application in suit includes an array of matter that is absent in the earlier registrations. The form of the letter “K” in the application in suit is not the same as the stylised “K” of the opponent. Other than that all the trade marks under consideration include the letter “K” I cannot see that there is any visual similarity. Indeed, I consider that visually the respective trade marks are very distant. I, therefore, consider that the respective trade marks are not visually similar.

35 The earlier registrations are the letter “K”. In the application in suit the second letter “K” has been reversed. However, owing to the presence of the conjunction and the obvious nature of the reversal I consider that orally it will be referred to as “K and K”. “K and K” is clearly longer than “K”, the repetition of the letter “K” will I believe be very clear to the listener. It might be argued that the application in suit could be referred to as “K C and K”. However, I consider that the overall impression of the trade mark and its stylisation is likely to militate against this. I consider that aurally “K” and “K and K” are not similar. I, therefore, find that aurally the respective trade marks are not similar.

40 I do not think that the letter “K” either in stylised form or non-stylised form has a conceptual association. I, therefore, do not consider that there is a conceptual relationship or similarity between the respective trade marks.

45 **Consequent upon the above I find that the respective trade marks are not similar.**

## Conclusion

In *React (1999) 15 RPC 529* the Hearing Officer held the following:

5 “I am therefore prepared to accept that a majority of the public rely *primarily* on visual means to identify the trade origin of clothing, although I would not go so far as to say that aural means of identification are not relied upon.”

10 In the instant case I consider that there is a very large visual difference between the respective trade marks. Owing to the nature of the goods this clearly of importance when assessing the likelihood of confusion. The trade mark of the applicant if reproduced on a label will be clearly and obviously different from the trade marks of the opponent. I, of course, held that the trade marks are not aurally similar also.

15 It is also important to bear in mind that the public compare trade marks in their entirety; they do not indulge in their dissection.

20 The opponent has demonstrated a reputation in relation to boots, shoes and slippers; a reputation that clearly indicates public recognition of his trade mark. A single letter mark, even in the stylised format of the opponent, is a trade mark that lacks inherent distinctiveness. It is therefore necessary to demonstrate public recognition to show that it has been nurtured into even acting effectively as a trade mark. The opponent has demonstrated this but the nature of his trade mark is such that its penumbra of protection cannot be overly wide. He cannot monopolise a letter of the alphabet in all circumstances.

25 I have taken into account the interdependency principle of goods and signs and the effect of recognition or reputation. However, I do not consider that either assists the opponent. For these to come into play the opponent’s case must first satisfy that basic tenet of the law, that the signs are similar **and** that the goods are similar or identical. The issues of interdependency and recognition come to play at the margins; where for instance there is only a low degree of similarity between the signs. In the instant case I have decided that the signs are not similar.

30 The applicant referred to state of the register evidence. For the most part state of the register evidence proves very little if anything - it is what happens in the market place that is important. The public have to have learnt to discriminate between trade marks with common elements. In the instant case I do not consider that the seven trade marks for which the applicant provided details are on a par with the application in suit.

40 Furthermore in *Treat (1996) RPC 281* Jacob J stated:

“In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led to the Registrar to put the marks concerned on the Register. It has long been held that under the old Act that comparison with other marks on the Register is in principle irrelevant when considering a particular mark tendered for registration, see *e.g. MADAME Trade Mark (1966 RPC 541)* and the same must be true of the 1994 Act. I disregard the state of the register evidence.”

The applicant has also referred to a lack of confusion in the market place. That the applicant might not be aware of confusion does not preclude there having been confusion. The applicant has also failed to supply any details as to the actual turnover and distribution of goods bearing his trade mark. The argument as to confusion in the market place is, therefore, dismissed.

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If the colour claim of the applicant were to have any effect upon the proceedings it would not be to make the respective trade marks closer. Therefore, the opponent could fare no better in respect of the colour form of the trade mark. I will, therefore, say no more about it.

10 **For all the reasons given above the ground of opposition under Section 5(2)(b) is dismissed.**

### **Section 5(4)(a) objection**

15 I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC in the *Wild Child case (1998) 14 RPC 455*. In that decision Mr Hobbs stated that:

20 "The question raised by the Grounds of Opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the Applicant from those of other undertakings (see Section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Art. 4(4)(b) of the Directive and Section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the applicant in accordance with the law of passing off".

25 "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:

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

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(1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

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(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."

45 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. It is clear from Article

4(4)(b) that the earlier right had to have been "acquired prior to the date of application for registration of the subsequent trade mark, or the date of the priority claimed .....". The relevant date is therefore the date of the filing of the application in suit.

5 Misrepresentation is an essential component of the tort of passing off. This depends upon  
confusion and deception brought about by the use or proposed use of an indicia adopted by a  
defendant (in this case, applicant). I have already considered the likelihood of confusion in my  
findings under Section 5(2)(b). The opponents are in no better position under Section 5(4)(a) and  
cannot succeed to a greater extent.

10 **The ground of opposition under Section 5(4)(a) is, therefore, dismissed.**

**The opposition has, therefore, been dismissed in its entirety.**

15 The applicant is entitled to a contribution towards his costs and I therefore order the opponent  
to pay him the sum of £535. This sum is 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.

20 **Dated this 25 day of September 2001**

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30 **D.W.Landau**  
**For the Registrar**