

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NUMBER 2160143
BY HALFORDS LIMITED TO REGISTER A TRADE
MARK IN CLASSES 14, 18 AND 21**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 49227 BY KIPLING NV**

TRADE MARKS ACT 1994

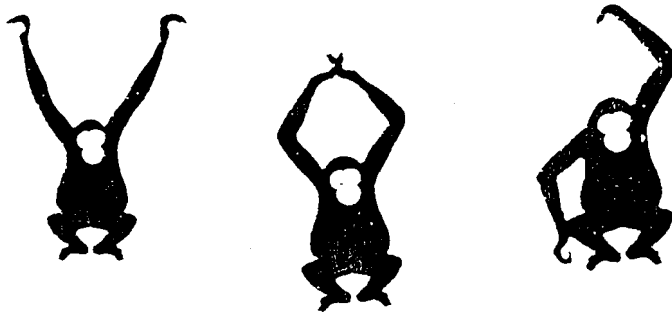
**IN THE MATTER OF Application number 2160143
by Halfords Limited to register a Trade Mark
in Classes 14, 18 and 21**

and

**IN THE MATTER OF Opposition thereto
under number 49227 by Kipling NV**

BACKGROUND

1. On 7 March 1998 Halfords Limited applied to register the following trade mark:



Application for a series of three marks.

in Classes 14, 18 and 21 for the following specifications of goods:-

Class 14:

Clocks, watches, parts and fittings therefor.

Class 18:

Rucksacks; toolbags; duffle bags; holdalls; non-metallic straps; bags all for use with cycles and motorcycles; bags for wear; key fobs; suitcases; shoulder bags; sports bags; umbrellas; mobile telephone carriers and cases.

Class 21:

Brushes, cloths, sponges, dusters and skins of chamois, all for cleaning purposes; steel wool; cooking pots and pans; non-metallic utensils and holloware (including water bottles); non-electric kettles, water carrying utensils for camping and picnicking, and picnic trays; glass fibre cloths and mats, for use in the repair of motor vehicle bodies and of the like; spectacles holders, cup holders; picnic baskets and containers; fitted picnic baskets and containers.

2. The application was subsequently accepted by the Registrar and published in the Trade Marks Journal. On 25 November 1998 Stevens Hewlett & Perkins on behalf of Kipling NV filed a Notice of Opposition. In summary the grounds were:-

- (i) Under Section 3(1)(c) of the Act in that it consists exclusively of signs or indications which may serve in trade to designate the kind, quality and origin or other characteristics of the goods.
- (ii) Under Section 3(6) of the Act to the extent that the application was made in bad faith in respect of the application as filed.
- (iii) Under Section 5(2)(b) of the Act because the trade mark applied for is confusingly similar to UK trade mark registrations 1367448, 1367449, 1367450 and 1578841 in Classes 16, 18, 25 and 18 respectively, owned by the opponent and registered for the same goods and similar goods and also European Community Trade Mark applications (now registrations) 165811 and 165845 in Classes 14, 16, 18, 24, 25 and 28. Details of these registrations are at Annex One to this decision.
- (iv) Under Section 5(3) of the Act because the trade mark applied for is similar to the above mentioned trade marks owned by the opponent and is to be registered for some goods which are not similar to those for which the opponent's marks are registered and these earlier trade marks have 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 marks.
- (v) Under Section 5(4) of the Trade Marks Act 1994 in that the opponent's mark is entitled to protection under Article 6 ter of the Paris Convention as the opponent is a national of a Convention Country and has registered the opponent's marks and variations thereof in a substantial number of countries throughout the world and has made extensive use of the mark in a number of countries.

3. On 22 February 1999 the applicants through their agents, Wynne-Jones, Laine & James, filed a counterstatement denying the above grounds. Both sides asked for an award of costs in their favour and have filed evidence. The matter came to be heard on 26 September 2001 when the applicant for registration was represented by Mr Hicks of Counsel, instructed by Wynne-Jones, Laine & James and the opponents by Ms Clark of Counsel instructed by Stevens Hewlett & Perkins.

OPPONENT'S EVIDENCE

4. This consists of two statutory declarations, one each from Antonie and Gram Jonathan Kraines dated 3 August 1999 and 18 August 1999.

5. Mr Gram is the President of Kipling N V with whom he had been associated since November 1992. He states that his company is the proprietor of United Kingdom trade mark registrations 1367448, 1367449, 1367450 and 1578841 and refers to Exhibit AG 1 to his declaration which comprises copies of a print out showing details of these registrations, from which it can be seen that each mark includes the device of a monkey, either with a long tail or in the form of a rounded great ape. He adds that his company is the applicant for Community Trade Marks No. 165811 and 165845 (now registered) and refers to Exhibit AG2 to his declaration which contains details of these marks.

6. Next, Mr Gram states that, in addition to those in the UK, registrations exist for various forms of Kipling and a monkey device in many jurisdictions of the world, which he then goes on to list. Exhibits AG 3 and AG 4 to his declaration contain print out copies of registration certificates or journal extracts in which registration of the marks is published, and a list providing details of registration numbers, countries and classification in relation to the overseas registrations.

7. Mr Gram asserts that the trade mark showing the word Kipling with the device of a monkey is well known. He goes on to say that, not only does a monkey appear as part of the trade mark, but three dimensional monkeys are attached to the goods and these come in different models and sizes. Mr Gram refers to Exhibit AG 5 which comprises extracts from various catalogues showing products particularly bags, supplied by the opponent from which either the device of a monkey or the three dimensional monkey can be seen. He then draws attention to Exhibit AG 6 consisting of examples of furry monkeys used as mascots, each bearing the Kipling and Monkey Logo. Mr Gram adds that a collection of watches has been advertised in the UK since September/October 1998, which, I should point out, is after the relevant date for these proceedings.

8. Mr Gram contends that the huge impact of the Kipling monkey device and the monkey mascots can be exemplified by two articles, copies of which are at Exhibit AG7 to his declaration. The first article has been taken from Fashion Weekly and appeared in the issue dated 21 September 1989 which, he explains, preceded a trade exhibition held in Harrogate in the UK. Mr Gram states that the article reflects the high attendance at the Kipling stand at a trade exhibition called Fashion Pays which was held at Brussels and makes specific mention of "Monkey Mascots" being given away at the exhibition. He adds that the article features a photograph of one of his company's typical shop fronts bearing the Kipling monkey device, which includes the Covent Garden store, London. The second article forming part of Exhibit AG7 is an extract taken from the Sunday Times Style Section dated 29 June 1997. The article closes by the author stating that Kipling bags (which come with monkey mascots) are widely available in the UK, including Selfridges and Harvey Nichols.

9. Mr Gram adds that Kipling's products have been sported by famous actors and actresses and at Exhibit AG10 to his declaration is an extract taken from Movieline Magazine, dated May 1997, mentioning a Kipling garment bag in relation to Bonnie Hunt and Renee Zellweger

10. Mr Gram explains that in all window displays of his company's products, enormous emphasis is given to the monkey trade mark and he draws attention at Exhibit AG9 to his declaration which is a copy of the 1995 Sales Manual for the United Kingdom, intended for

every distributor and retailer of the opponent's goods. The Manual encourages use of the Kipling Monkey soft toy in window displays.

11. Mr Gram concludes that the public seeing a monkey used in connection with the goods specified in the application in suit would associate the product with his company and that registration of the applicant's mark could result in confusion.

12. The second statutory declaration filed on behalf of the opponents is by Jonathan Kraines who is the Operations Director of Pelham Leathergoods Limited and who has been involved in the luggage and leather goods industry for ten years. His company acts as the distributor in the United Kingdom for Kipling N V, the opponents.

13. Mr Kraines explains that from 1988, when the Kipling products were first introduced into the United Kingdom, great emphasis was placed upon the association of a monkey with Kipling goods. He states that the KIPLING and monkey device mark has been used on backpacks, small leather goods, handbags, shoes, holdalls, clothing and luggage, that the items retail to the public at prices starting at £9.99 and going up to around £250. He adds that sales of products bearing the mark are made direct to retail outlets and also from the "flagship" stand-alone Kipling shop in Covent Garden. Photographs of the Covent Garden store are at Exhibit JK 1 to Mr Kraines' declaration. He adds that products bearing the KIPLING and monkey device mark are generally available throughout the United Kingdom.

14. Mr Kraines provides the following approximate sales figures (exclusive of VAT), for products bearing the Kipling and monkey device mark:

YEAR	VALUE (£)
1994	145,091
1995	296,906
1996	417,233
1997	432,477
1998	299,765 (to end of July)

15. Next, Mr Kraines says that a public relations company is employed on a monthly retainer to promote goods sold under the mark and a monthly fee of £400 plus expenses, generally averaging at about £100 per month, are put towards this cost. The mark has appeared in many magazines and newspapers in promotion and articles and these include national newspapers, in addition to trade and fashion magazines. At Exhibit JK 2 to the declaration are copies of cuttings from some of these publications and Mr Kraines states that some of the articles focus upon the association of monkeys with the Kipling brand eg the Sunday Times Style Section of 29 June 1997 which contains a feature noting that monkey mascots are given away with KIPLING BAGS.

16. Mr Kraines explains that all N V Kipling promotional matter and labels (a sample of which is at Exhibit JK 3) show either the monkey mascot or the KIPLING and monkey device

trade mark and the monkey mascot itself (Exhibit JK 4) bears the KIPLING and monkey device trade mark.

17. Mr Kraines concludes that a monkey device in relation to luggage, accessories and leather goods is associated with KIPLING and that use by another party could lead the public to consider that there was an association as to the source of goods.

APPLICANT'S EVIDENCE

18. This consists of three statutory declarations by Andrew John Caddell, Lynda Jane Illing and Brian Kenneth Charles Dunlop respectively.

19. Mr Caddell's declaration is dated 19 May 2000. He is the Managing Director of Bagmaker Limited, a position he has held since the formation of the company in February 1996. Prior to that he worked as a Marketing Manager in the Pharmaceutical Industry.

20. Mr Caddell explains that his company was formed to supply a wide range of bags to both the promotional and retail markets in the UK. Bagmaker designs these bags and subcontracts their manufacture. Mr Caddell states that he has made considerable efforts to research the bag market in which he maintains a professional interest, including an interest in general brand marketing.

21. Mr Caddell states that his interest in the bag market coupled with his interest in brand marketing meant that he had come across Kipling bags (though not any other Kipling products) prior to any involvement in this opposition. He states that he was familiar with the prominent Kipling star logo and associated this with their bags. Mr Caddell adds that he was totally unaware of any connection of monkeys with the Kipling bags.

22. Mr Caddell was surprised to learn that the opponents regard the "gorilla-like mascot" as a branding device. In his opinion this device is intended to function as a key ring, would be seen by most purchasers as a free gift which can be removed from the bag. In his view it is unusual in the extreme for an important branding device to be designed to be removed in this way.

23. Mr Caddell goes on to state that he does not believe the Kipling monkey device to be well known in the UK as his experience in the bag market is that Kipling bags are not identified by the monkey devices and their dominant branding device is the Kipling star logo. Furthermore Mr Caddell is not impressed by the sales figures provided by the opponent which he states, relate to a wide range of products and do not demonstrate a large volume of sales.

24. Mr Caddell concludes that in his, experience, of the bag market and in marketing Kipling have no effective reputation in any form of monkey trade mark in connection with bags and luggage in the UK.

25. Ms Illing's declaration is dated 19 May 2000. She is the Legal Services Controller for Halfords Limited, a position she has held for fifteen years. She states that one of her

responsibilities is the protection and clearance of trade marks and she takes a particular interest in third party marks. Up until the opposition proceedings, Ms Illing was unaware of the opponents and their trade marks.

26. Ms Illing visited the KIPLING shop in Covent Garden on 2 March 1999 and she expresses her surprise about its small size. She adds that the shop sold predominantly bags but that other products such as wallets, purses, key rings, credit card holders and watches were also for sale. Ms Illing states that the KIPLING and monkey device mark was very “low down” on the list of prominence and the most noticeable trade marks in use was a circular mark incorporating a central star with the word KIPLING above and below it.

27. The third declaration contained in the applicant’s evidence is by Mr Dunlop and is dated 22 May 2000. He is a Chartered Patent Agent, a member of the Institute of Trade Mark Attorney and a partner in Wynne Jones, Laine & James, the applicant’s representatives.

28. Mr Dunlop states that he was completely unaware of N V Kipling, its trade marks or products prior to his firm receiving correspondence in relation to the opposition proceedings. However, prior to the relevant date he was aware of a range of fleeces and related products manufactured and sold under the name STONE MONKEY and if he had seen a monkey alone on clothing any association he would have made would have been with STONE MONKEY. He then draws attention to the then current catalogue of STONE MONKEY, at Exhibit B1 to his declaration, and states that their logo is quite distinct both from the logo of the present application and the monkey device which the opponents use in association with their trade mark Kipling. Exhibit BD 1 also includes details of a STONE MONKEY trade mark registration in Class 25 (No 1546255).

29. Mr Dunlop has carried out a brief internet search (after the relevant date) under the name MONKEY and has found that he could purchase products from companies known as RED MONKEY, GLASS MONKEY and MONKEY and that RED MONKEY and GLASS MONKEY use a monkey logo. Examples are at Exhibit B2 to Mr Dunlop’s declaration. He adds that his firm had carried out a search in relation to monkey and ape logos and the results of this search and one for monkey marks are attached at Exhibit BD 6 which shows a number of “monkey marks” co-existing on the register in Classes 9 and 25.

30. Mr Dunlop is critical of the evidence filed on behalf of the opponents, particularly in that the turnover figures are cover all products sold by the opponent, including those outside the scope of the classes applied for. He had inspected the web site of N V Kipling and notes that the company has 40 shops worldwide of which fifteen are in Belgium and only one in the United Kingdom.

Opponent's Evidence in Reply

31. This comprises four statutory declarations from Peter William Cornford, Jonathan Kraines, Patrick de Meersman and Iain Porter, dated 20 November 2000, 22 January 2001, 22 January 2001 and 19 January 2001 respectively.

32. Mr Cornford is a Registered Trade Mark Attorney and a Member of the Institute of Trade Mark Agents and is acting on behalf of the opponents. He takes issue with many of the points raised by Mr Dunlop on behalf of the opponents and fails to see the relevance of Mr Dunlop's points in relation to the STONE MONKEY mark, as, among other reasons, that mark is in relation to clothing, use of the logo is outside the relevant date and the mark is visually very different from the mark in suit and the opponent's marks. Furthermore, in relation to Exhibit BD2 Mr Cornford states that the exhibits do not show use at the relevant date of a device of a monkey in relation to the relevant goods. Regarding the search carried out by Mr Dunlop's firm in relation to monkey and ape logos, Mr Cornford states that there are no registrations for relevant monkey devices for goods relevant to the application in suit.

33. Mr Kraines has filed a second statutory declaration on behalf of the opponent. He explains that as of August 2000 he ceased to act as Kipling's exclusive UK distributor and he is now independent of the Kipling organisation. Mr Kraines makes a number of points:-

- (i) He believes Kiplings London shop opened in March 1998
- (ii) The turnover figures provided in his previous declaration would have included a small amount of footwear but were principally in relation to bags. They were wholesale figures.
- (iii) He contends that the Kipling monkey range enjoys a reputation far beyond its sales figures because it is positioned at the upper or "designer" end of the market and is sold in shops such as Selfridges Harrods and Harvey Nicholls, is used by celebrities, and has been publicised through "features" in high quality publications such as Girl About Town magazine (November 1991), Mens Health magazine (July/August 1996), The Evening Standard Magazine (August 1996), The Guardian (June 1997), The Sunday Times Style Section (June 1997), Health and Fitness magazine (January 1998) and Harrods Magazine (pre March 1998).

34. Mr De Meersman is the Group Legal Counsel of Kipling Belgium NV. He states that Kipling's monkey and mascot trade mark have high public recognition and that prior to the date of application many UK persons would have come across the mark on airlines, ferries, duty free shops, overseas shopping destinations and trade fairs.

35. Iain Porter is the Retail Manager of the firm Porters which is a retail outlet at the Royal Shopping Centre, Manchester and who since 1982 has specialised in the sale of luggage and leather goods. He has been involved in the business of selling travel goods and baggage since 1987. Mr Porter's comments are made in response to Mr Caddells and Ms Illing's declarations made on behalf of the applicant.

36. Mr Porter states that Kipling have always taken great pains to ensure that "the monkey trade mark and mascot" are vehicles to drive sales of the goods and he adds that retailers like himself have been used to receiving detailed instructions from Kipling on how to display goods. He refers to Exhibit IP1 to his declaration which is a 1997 Sales Manual which he states, shows that the monkey trade mark and mascot are given great prominence. Mr Porter

confirms that bags displayed in his outlet have at all times given prominence to the monkey trade mark and mascot, since they were first stocked in 1988.

37. Mr Porter states that many customers come into the shop and ask for Kipling goods by reference to the monkey e.g. "The bag with the monkey". He is not aware of coming across any other bag with a monkey trade mark. Mr Porter adds that in 1997 his company sold about 860 Kipling bags bearing the monkey trade mark and carrying the monkey mascot.

Applicant's Additional Evidence (Rule 13(11))

38. This consists of a witness statement by Brian Kenneth Charles Dunlop, dated 4 July 2001, in which Mr Dunlop draws attention to the advertisement of trade mark application number 2232475 in The Trade Marks Journal of 30 May 2001, details of which are at Annex 2 to this decision. Mr Dunlop notes that application 2232475 has been accepted alongside the application in suit, that the applicant for registration is Kipling Switzerland AG and that the registrations cited against the mark in suit by the opponents now stand in the name of Kipling Switzerland AG with the assignments to that company being effective from 31 May 2000.

39. This concludes my summary of the evidence filed in this case. I now turn to the decision.

DECISION

40. Prior to the hearing Ms Clark withdrew the ground of opposition under Sections 3(1) and 3(6) of the Act.

41. 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."

42. 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,

43. 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.

44. The opponent relies upon six registrations; three of which (numbers 1367448, 1367449 and 1367450 in Classes 16, 18 and 25 respectively) are identical with each other and comprise the word KIPLING and the device of a monkey with a long tail; a fourth (European Community registration No. 165845 in Classes 14, 16, 18, 24, 25 and 28) consists of virtually the same mark as 1367448, 1367449 and 1367450, the only difference being that the monkey's tail (while still long) is shorter in comparison; the fifth (registration number 1578841 in Class 18) comprises the device of a monkey or ape; and the sixth European Community Registration 165811) comprises a three dimensional representation of a monkey or ape attached to a chain or key ring, with a label containing the word KIPLING and the device of a long tailed monkey also attached. The opponent claims a reputation in these marks.

45. The reputation of a mark is an element to which importance may be attached in Section 5(2) considerations. At the hearing Mr Hicks was highly critical of the opponent's evidence on this point. He submitted that the opponents' sales were low considering the goods at issue, as was the spend on advertising/promoting the mark, that details relating to sales were vague, that much of the evidence post dated the application date e.g. the opponents Covent Garden store (the only UK store) did not open until after the relevant date and that the opponents primary trade mark was the word KIPLING or on their 'Basic range' of products the word KIPLING and a 'star' logo. Mr Hicks pointed out that according to Mr Kraines evidence on behalf of the opponent sales of goods bearing the opponent's trade marks amounted to £432,477 (wholesale figures) in 1997 (the last full year prior to the relevant date) and that these sales would have included a small amount of footwear but were principally in relation to bags. Furthermore, Mr Hicks drew my attention to the opponent's sales figures quoted by Mr De Meersman (the Group Legal Counsel of Kipling Belgium NV) who in paragraph 6 of his statutory declaration states that:-

"I should say a little about "Monkey News" mentioned in Paragraph 4 above. This was the news sheet for the worldwide fan club. Everyone who bought a Kipling bag with a monkey mascot was invited to send back their swing ticket to register for automatic membership which included a once or twice yearly edition of Monkey News. The edition ran from 1989 to 1996. Our company's records showed that virtually everyone in the period who bought a bag did become a member and received the newsletters. I estimate that 10-12% of the 10,000 membership came from the UK, which means that a large quantity of Monkey News newsletters were in the UK in the period."

46. From the above Mr Hicks deduced that between 1989 and 1996 the opponent's only sold around 150 bags a year in the UK. Furthermore, Mr Porter's declaration on behalf of the applicant is of limited assistance in relation to their sales in the UK in that he states that his company sold around 860 of the opponent's bags in 1997. However, he provides no sales details prior to this date and no details of the total number of bags sold by his company in 1997.

47 In my view, Mr Hicks criticisms are well founded.

48. While I have no evidence before me on the total market for bags in the UK nor any information in relation to the opponent's market share in the UK, it seems to me that the market must be a substantial one in that most persons own bags e.g. for holidays, shopping, work, school or leisure activities and that such bags are bought or replaced on a reasonably regular basis. Mr Porter, in paragraph 7 of his declaration filed on behalf of the opponent's, states that most sales from the opponent's range are around the £50 mark. On this basis it seems to me reasonable to infer that even in 1997 and early 1998 the opponent's sales must have formed a very small part of the total UK market for bags.

49. The opponents argue that the opponent's business is in "Designer goods" ie. high fashion, expensive, highly desirable goods and thus their repute may exceed that he be expected by actual sales, due to their exclusive nature. The example of Louis Vuitton was given. However, the opponents have not provided any independent evidence to substantiate this assertion. Indeed, it seems to me that the evidence demonstrates that while the goods may be targeted towards the young and fashion conscious, they are not particularly expensive in relative terms and have particular appeal and are marketed towards children as well as adults e.g. the Disney's Big Time Magazine at Exhibit JK1 to Mr Kraines first statutory declaration refers.

50. Turning to the promotion of the opponent's marks, a public relations company has been employed on a monthly fee of £400 plus expenses, averaging at about £100 a month. While some articles and features about the opponent, some of which refer to their monkey marks, have appeared in a number of periodicals during the relevant period, I have no independent evidence as to their impact or any evidence relating to public perception on the repute of the marks. In their evidence the opponents have made particular reference to an article in The Guardian dated Jun 4 1997 (Exhibit JONK 2 to Mr Kraines second declaration) but, as Mr Hicks pointed out, this article includes the statement that "Kipling fever has not yet reached the UK."

51. While the opponent is able to demonstrate use of their KIPLING and monkey device trade marks in relation to Class 18 as a secondary mark and while the mark the subject of their 3 dimensional registration is attached to bags sold (I have no evidence as to whether or not it is perceived as a trade mark by the public in use), in my view they have not demonstrated an enhanced reputation in their marks in the UK for the purpose of these proceedings. I must therefore compare the mark applied for and the opponent's registrations on the basis of notional and fair use.

52. In essence the test under Section 5(2)(b) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion, I am guided by the recent judgements of the European Court of Justice mentioned earlier in this decision. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural or conceptual similarity between the marks, evaluating the importance to be attached to those different elements, taking into account the category of goods in question and how they are marketed.

53. The marks at issue contain devices of monkeys or apes. The mark applied for consists of a series of three marks, comprising a frontal silhouette of an ape but with the outline of a face shown (in relief) without features. In two of the representations both arms are raised and in the remaining representation one arm is raised. The opponent's marks consists of the word KIPLING together with the silhouette of a monkey on all four legs, in profile, the monkey possessing an extremely long tail which ascends over the word KIPLING (registrations number 1367448, 1367449, 1367450 and 165845) which I shall refer to as the first mark. The second mark consists of a cartoon like drawing showing a frontal view of an "upright" ape with a smiling face, toes but no legs, with arms "at the side" (registration number 1578841) and the third mark (registration number 165811) comprises a three dimensional representation of an upright ape with a smiling face toes but no legs, with arms "at the side", on a chain or keyring and with a label attached showing a representation of the opponent's first mark. It is, of course, possible to over analyse marks and in doing so shift away from the real test which is how the marks would be perceived by customers in the normal course and circumstances of trade and I must bear this in mind when making the comparisons.

54. In the current case I find *Sabel BV v Puma AG* (mentioned earlier in this decision) to be of particular assistance. It states that where there is a similarity between two pictorial marks, one of which includes a text, the inclusion of a textual element in one of the marks does not in itself preclude a finding of likelihood of confusion (para 64(3)); that the registration of a trade mark may be opposed on the basis that the ideas conveyed by the pictorial elements of two trade marks are similar, provided that it is established that there is a likelihood of confusion (para 64(4); and it is not enough, because the idea behind the marks is the same, that there is a risk the public will associate the two marks, in the sense that one will simply bring the other to mind, without a likelihood of confusion (para 64(2)).

55. Turning firstly to a visual comparison of the applicant's mark and the opponent's first mark (registration numbers 1367448, 1367449, 1367450 and 165845), I find their overall impact to be different. The word appearing in the opponent's mark is an important and "eye-catching" feature and while both marks contain silhouettes of primates, they have a very different appearance with the applicant's mark being a frontal view of an ape with a blank face and the opponent's silhouette being of a monkey on "all fours" with an extremely prominent tail.

56. While the applicant's mark has a primarily visual identity, I go on to consider aural use and a comparison of the applicant's mark and the opponent's first mark on this basis. Both marks contain silhouettes of primates which could both be described as monkeys, although it seems to me that the applicant's mark has the look of an ape as opposed to a monkey. Furthermore, the opponent's mark contains the prominent word KIPLING which in aural use is likely to be used by the public to indicate the opponent's mark. I also need to bear in mind the goods of interest to the applicant. While I have no evidence before me on the point, it seems to me that clocks and watches in Class 14, bags in Class 18 and picnic carriers in Class 21 are likely to be selected by the eye rather than by merely placing word of mouth orders. Clocks are often items for the home which will be chosen with care to match their future surroundings; watches are often fashion items chosen on their look; bags are usually selected with care with features, such as dimensions, holding capacity, pockets, material, fasteners and weight, being subjected to physical inspection or visual confirmation prior to purchase and it

seems to me that the same considerations would apply to the selection of picnic baskets and picnic containers. I do not overlook the fact that catalogues and telephone orders may play a significant role in the trade of these goods, but it seems to me that the initial selection of the goods will be made by the eye with the subsequent order usually placed primarily by reference to catalogue number. I therefore consider that the aforementioned goods are likely to be purchased primarily through visual means.

57. Finally, I turn to a conceptual comparison of the marks bearing in mind that the applicant's mark appeals primarily to the eye while both marks contain a similar concept - the silhouette of a primate, there are noticeable differences in the silhouettes and the presence of the prominent word KIPLING in the opponent's mark lends the mark a surnominal conceptuality in that word KIPLING will be taken (and remembered) as a strong indicator of origin.

58. I now consider the comparison of the applicant's mark with the opponents second mark, registration 1578841. On a visual comparison, both marks consist of frontal views of apes but while the applicants mark consists of a silhouette with the outline of a face shown (in relief) without features, the opponent's mark has a cartoon like quality and a smiling face which is a striking element within the mark. In my view the respective marks look very different.

59. While both marks have a primarily visual identity I go on to consider aural use. Both marks contain devices of apes and the opponents' case is that the differences in detail will not be distinguished in oral use. There is some strength in this proposition but it must be borne in mind that both marks are primarily intended as visual identifiers or indicators, that the opponent has not established that the device of a monkey or ape, per se, is distinctive of its goods and that the applicant's goods are primarily selected by the eye ie. on a visual basis - see the comments in paragraph 55 of this decision (above).

60. On a conceptual comparison, both marks consist of ape devices but in my view, the "blank face" within the applicant's mark and the cartoon like "smiling face" within the opponent's mark are both strong conceptual elements which are likely to affix themselves in the mind.

61. I now turn to the comparison of the mark in suit with the opponents 3 dimensional registration number 165811. It seems to me that the differences between these marks are similar to the differences between the applicant's mark and the opponents second mark (registration number 1578841) in that the opponents 3 dimensional mark also possesses a striking smiling face. However, in addition the three dimensional mark is on a chain and bears a label containing the opponent's first trade mark, which in my view, further distinguishes the respective marks in their totalities.

62. I must now go on and take into account the goods covered by the specifications of the respective marks. In relation to the applicant's Class 18 specification it was common ground at the hearing that the same and similar goods were covered by the opponent's registrations number 1367449 and number 165845 (the opponent's first mark), registration number 1578841 (the opponent's second mark) and 165811 (the opponent's third mark). Furthermore, in relation to the Class 14 application it was common ground that the same and similar goods

were covered by the opponent's registration numbers 165845 (the opponent's first mark) and 165811 (the opponent's third mark).

63. The application in suit also includes goods falling within Class 21 and I need to consider whether these goods are similar to goods included within the opponent's registrations.

64. In determining whether the goods covered by the application are similar to the goods covered by the opponents' earlier trade mark 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.

65. Whilst I acknowledge that a 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.

66. In the opponent's submission, the following goods are similar in relation to the applicants Class 21 specification:-

Applicant's Goods

Opponent's Goods with earlier Registration Reference

c) Class 21
Water carrying utensils for camping and picnicking, picnic baskets & containers, fitted picnic baskets & containers.

Travelbags, shopping bags, bags, rucksacks, backpacks, holdalls (157841) trunks & travelling bags (165845)

Spectacle holders

Pocket wallets & purses

(1367449), (157884), (165845), (1165811)

67. Firstly, I will consider the "spectacle holders" position and I take the view that given the specialist nature and purpose of such goods the use and users of the goods will differ from the use and users of pocket wallets and purses. Furthermore, it seems to me that the respective goods are not in competition as such and when they are sold in the same store, they are usually sold in different areas of the store, or where they are brought together in the same department ie. leatherware, they are likely to be found on different shelves. I do not believe spectacle holders to be similar goods to pocket wallets and purses. Turning now to a comparison of the applicant's "camping and picnicking" goods in Class 21 with the opponent's bags and holdalls in Class 18, I believe the position to be finely balanced. The respective goods are both used for carrying purposes. The applicant's goods are adopted/intended to carry food, liquid and eating utensils. The opponent's goods have a more general function and while they could carry food etc. it is not their intended purpose and accordingly the respective goods are not really competitive. Furthermore, camping and picnicking containers and baskets are specialised goods and although they may sometimes be sold through the same specialised retailers e.g. camping and outdoor outlets, as rucksacks etc. they are usually sold in separate areas of the shop. Overall, I do not consider the respective goods to be similar.

68. On a global appreciation, taking into account all the relevant factors, I come to the following conclusions in relation to the Section 5(2)(b) ground:-

- (i) The applicants Class 18 specification of goods includes goods identical to and similar with the opponent's registrations number 1367449, 165845, 1578841 and 165811 - which encompass the different marks of the opponent.
- (ii) The applicants Class 14 specification of goods includes goods identical to and similar with the opponent's registration number 165845 (their first mark) and 165811 (their third mark).
- (iii) The applicant's Class 21 specification does not include goods similar to those covered by the opponent's registrations.
- (iv) The opponent's registrations for their first mark, the word KIPLING and the silhouette of the monkey on "all fours" with a long tail in profile (registrations number 1367448, 1367449, 1367450 and 165845) are not similar to the applicant's mark on either a visual, aural or conceptual basis and taking into account the category of the goods in question and how they are marketed, I believe that there is no likelihood of confusion.
- (v) The opponent's registration for their second mark, registration number 1578841 and their third mark, registration number 165811 look closer to the applicant's mark, particularly when one takes into account aural and conceptual similarities and imperfect recollection. However, the "blank face" within the applicant's mark and the "smiling face" within the opponent's marks are significant as the marks are primarily visual in nature. Furthermore, the goods in question are likely to be purchased through visual means, often after a fairly close visual inspection of the

goods and taking into account the category of goods in question and how they are marketed, I believe that the possibility of confusion is sufficiently remote that it cannot be regarded as a likelihood.

69. On a global appreciation, the opposition under Section 5(2) (b) fails.

70. I now turn to the ground of opposition under Section 5(3) of the Act which states:

5.-(3) A trade mark which -

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

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

71. The term "earlier trade mark" is itself defined in Section 6(1) of the Act, which is set out earlier in this decision.

72. The opponent has a number of registrations for goods which are not identical or similar to the goods specified in the application in suit. However, as I have already found that the opponent's do not have a reputation in the United Kingdom and there is no likelihood of confusion under Section 5(2), the opponent has, in my view, no stronger case under Section 5(3) of the Act and the opposition on this ground fails.

73. Finally, I consider the ground of opposition under Section 5(4) of the Act which at the hearing was pursued in relation to passing off and on the basis that the opponent's marks are entitled to protection as well known trade marks under Article 6 of the Paris Convention and Section 56 of the Trade Marks Act 1994.

74. Section 5(4) reads as follows:

"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, or
- (b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

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

75. The law on the common law tort of passing off 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."

76. 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."

77. Thus, to succeed in a passing off action, it is necessary for the opponents to establish that at the relevant date (7 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.

78. I have previously found that the opponent does not have a reputation in the United Kingdom and that use of their trade marks which form the basis of this opposition, actual or on a fair and notional basis will not result in a likelihood of confusion under Section 5(2). Accordingly, it seems to me that the necessary misrepresentation required by the tort of passing off will not occur. The ground of opposition based on passing off therefore fails.

79. I turn now to the opponent's claims that their trade marks are entitled to protection as well known marks under Article 6 of the Paris Convention and Section 56 of the 1994 Act.

80. Section 56 of the Act states:-

"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 -

- (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.

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

(2) The proprietor of a trade mark which is entitled to protection under the Paris Convention as a well known trade mark is entitled to restrain by injunction the use in the United Kingdom of a trade mark which, or the essential part of which, is identical or similar to his mark, in relation to identical or similar goods or services, where the use is likely to cause confusion.

This right is subject to Section 48 (effect of acquiescence by proprietor of earlier trade mark).

(3) Nothing in subsection (2) affects the continuation of any *bona fide* use of a trade mark begun before the commencement of this section."

81. Notwithstanding the position in relation to the opponent's goodwill in their marks in the UK, the opponent's claim that their marks are well known in the UK. No evidence is before me on this point other than the assertions of Mr Gram and, in particular Mr De Meersman in their declarations. Mr De Meersman's claims that many UK visitors to overseas destinations will have come across and become familiar the marks relied upon by the opponent are not substantiated and I have no independent evidence on this point. The opponents have not discharged the onus upon them and the opposition under Section 5(4) fails.

82. The applicants are entitled to a contribution towards their costs and I therefore order the opponent's to pay them the sum of £800. 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.

Dated this 2ND day of November 2001

JOHN MACGILLIVRAY
For the Registrar
the Comptroller-General

B1367448 Registered 13 December 1988 Journal 5861, 1098



kipling

Paper, cardboard, paper articles and cardboard articles; bookbinding materials, photographs and stationery; adhesives; artists' materials; paintbrushes; typewriters and office requisites; instructional and teaching materials; plastics materials for packaging; playing cards; all included in Class 16; but not including any such goods relating to Cercopithecidae.

PROPRIETOR: N V Kipling

1367449 Registered 13 December 1988 Journal 5885, 4617



kipling

Advertised before acceptance. Section 18(1)(proviso)

Bags; purses, wallets, keyholders, credit card holders, handbags, briefcases, rucksacks, suitcases, holdalls; all included in Class 18; but not including any of the aforesaid goods made of monkey skins.

PROPRIETOR: N V Kipling

1367450

Registered 13 December 1988

Journal 5913, 1749



Advertised before acceptance. Section 18(1)(proviso)

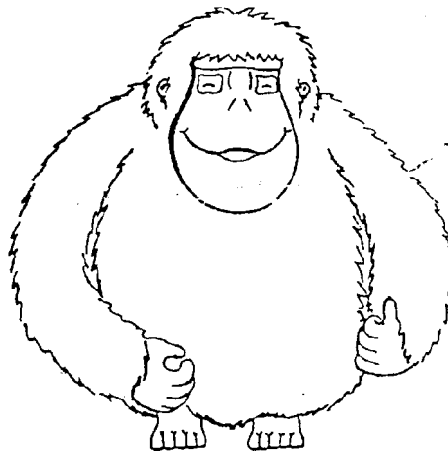
Clothing, footwear, headgear, all included in Class 25; but not including any such goods made from primate skins.

PROPRIETOR: N V Kipling

1578841

Registered 20 July 1994

Journal 6060, 441



Bags; schoolbags; travelbags; sportbags; games bags; garmentbags; waistbags; shopping bags; handbags; make-up bags; toilet bags; purses; wallets; keyholders; credit card holders; briefcases; rucksacks; suitcases; cases for books; backpacks; umbrellas; holdalls; all included in Class 18; but not including any of the aforesaid goods made of monkey skins.

PROPRIETOR: N V Kipling

165811

FILING DATE: 01 APRIL 1996
REGISTRATION DATE: 15 SEPTEMBER 1999



3D (form) type mark

- Class 14:** Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments.
- Class 16:** Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); playing cards; printers' type; printing blocks; pen cases of textile.
- Class 18:** Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; shopping bags, handbags, travelling bags, school satchels, rucksacks, shoulder bags; key cases, of textile; pocket wallets and purses; umbrellas, parasols and walking sticks; whips, harness and saddlery.
- Class 24:** Clothing, footwear except shoes for athletics, headgear, caps.
- Class 28:** Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees.

PROPRIETOR: Kipling Switzerland AG

165845

FILING DATE: 01 APRIL 1996
REGISTRATION DATE: 11 DECEMBER 1998



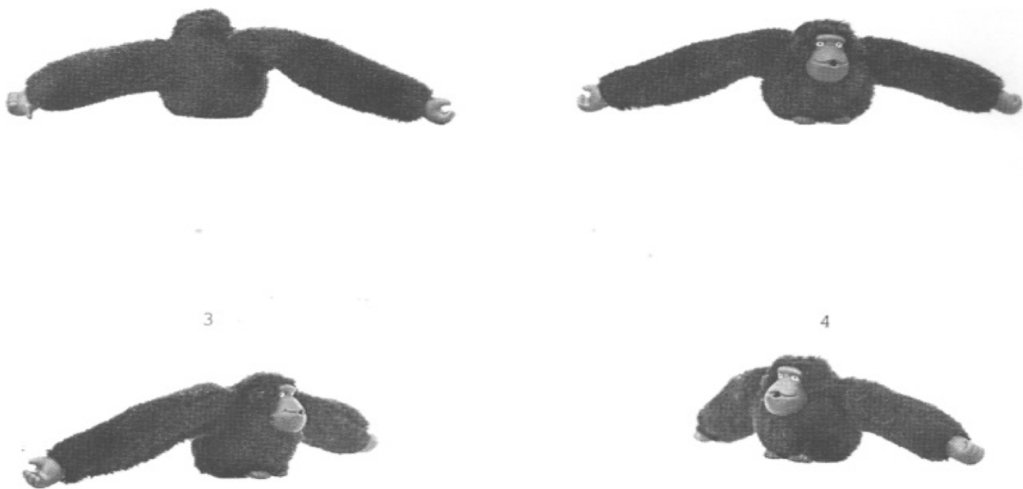
- Class 14:** Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments.
- Class 16:** Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); playing cards; printers' type; printing blocks.
- Class 18:** Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.
- Class 24:** Textiles and textile goods, not included in other classes; bed and table covers.
- Class 25:** Clothing, footwear, headgear.
- Class 28:** Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees.

Official languages: Dutch/French

PROPRIETOR: Kipling Switzerland AG

APPLICATION NO: 2232475
FILING DATE: 8 MAY 2000

MARK



Mark Description:

The trade mark consists of a three dimensional swing ticket attached to the goods, the swing ticket being in the shape of an ape as shown in the representation on the form of application.

Class and Goods:

Class 18:

Leather and leather imitations, umbrellas; travelling cases, suitcases, schoolbags, bags, handbags, travelling bags, backpacks; none of the aforesaid goods being in the shape of apes.

PROPRIETOR: Kipling Switzerland AG