

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 2213538
BY STEPHEN ILLES**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No 50910
BY HEAD SPORT AG**

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IN THE MATTER of Application No 2213538
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Background

1. On 6 November 1999, Stephen Iles applied under the Trade Marks Act 1994 to register the trade mark shown below, for a specification of goods which reads:

Class 25

Clothing



2. The application is numbered 2213538.

3. The application was accepted and published and on 17 August 2000, Head Sport AG, filed notice of opposition to the application. The statement of grounds accompanying the notice of opposition set out two grounds of opposition, these can be summarised as follows:

- (a) under section 5(2)(b) of the Trade Marks Act 1994 in that the trade mark the subject of the application is similar to the opponents' earlier trade mark HEAD and covers goods identical or similar to the goods for which the earlier trade mark is protected; and
- (b) under section 5(4)(a) having regard to the opponents' goodwill and reputation in the earlier trade mark, the application is liable to be prevented by the law of passing off.

4. The applicant filed a counterstatement denying the grounds of opposition. Both sides seek an award of costs. The matter came to be heard on 9 August 2001. The applicant, Mr Iles represented himself, the opponents were represented by Mr John Symonds of Brookes Batchelor. Both parties filed evidence in the proceedings.

Opponents' Evidence

5. The opponents filed three witness statements. One, dated 17 August 2000 is from Georg Kröll, Vice President of International Licensing of Head Sport AG. He says that the facts given in the witness statement are from his own knowledge with the exception of the sales values. Those for the United Kingdom are derived from returns provided by Sportline, a division of H Young (Operations) Limited, who were his company's licensees in the United Kingdom during the period 1997 to 1999. He states that although the documents exhibited to his statement have been extracted from his company's archives, he confirms that articles of clothing, footwear and headgear described or illustrated in certain of the documents were promoted and marketed by Sportline in the United Kingdom during the years stated. At GK1 he exhibits a copy of the license agreement with Sportline. He notes that the agreement confirms that a license was granted under a number of UK trade marks including number 1502616 in Class 25 for the word HEAD alone which is registered in relation to "articles of outer clothing; footwear; sportswear...but not including headgear. Mr Kröll states that the word HEAD is his company's principal trade mark which is used in connection with all of its goods.

6. Mr Kröll says that his company has been famous for many years as a source of sporting goods and clothing, footwear and headgear of extremely high quality, particularly in the fields of tennis and skiing. In certain instances these goods have been manufactured by or under the auspices of licensees, but he states that his company has consistently applied strict quality control procedures in connection with manufacture. Use of his company's trade mark has served as a guarantee of quality. He says that the fame of his company's HEAD trade mark may be illustrated by the fact that it has been seen on equipment used by famous sports personalities and on clothing worn by them at international sporting events, particularly in the tennis and skiing fields. He states that the trade mark HEAD is used on the goods either alone or in conjunction with his company's so called "ski-tip logo". He states that his company has actively promoted and required its licensees to promote the trade mark HEAD and as a result HEAD has become one of the best known trade marks in the international sports goods field. Wholesales values for sales of clothing, footwear, and headgear for the United Kingdom are stated as:

1997	£3,400,000
1998	£4,100,000
1999	£3,000,000

7. Mr Kröll states that in the UK, Sportline placed regular advertisements during the years 1997-1999 in a number of periodicals including lifestyle magazine. Sportline built up a database of customers to allow mail shots, they also supplied retailers with point of sales materials. In the case of goods relating to tennis, these sales aids focussed especially on pre-Wimbledon window displays. At GK2 he exhibits a report from Sportline on their Winter 1997 activities. At GK 3 he exhibits illustrations of various types of clothing which were marketed by Sportline during Autumn -Winter 1997 in the ski leisure field. He refers in particular to the illustrations on pages 7 and 8 showing knitted caps and jackets bearing the

HEAD trade mark without the ski-tip logo but with additional wording so as to appear as HEAD=MAX, and SPORTS.TECHNOLOGY/HEAD/AUSTRIA. Mr Kröll says that GK4 shows clothing in the “outdoor exploration range”. He notes that caps and jackets are marked:

The
HEAD
EXPLORATION

8. He goes on to say that this range of clothing was marketed in the United Kingdom in conjunction with HEAD EXPLORATION footwear. Mr Kröll then refers to various exhibits attachment to his statement. These are:

- GK5 which he says are designs from the 1997 ladies exercise and leisure range;
- GK6 which he states consists of promotional literature for the trade describing and illustrating the “97 apparel range” of polo shirt, socks, shorts, tennis dresses and skirts and vest tops for sale in the United Kingdom. These he says emphasise the logo “Be What You Are” combined with the trade mark HEAD. The slogan incorporates the “ski-tip logo” which forms the letter “A” of the word “ARE”.
- GK7 also shows examples of the logo shown in GK6. This is the 1997 Winter Directory published by Sportline. It describes and illustrates the Head Exploration range including pants, jackets, fleeces, roll necks, shirts and sweaters.
- GK8 which is a copy of the Sportline UK trade price list effective in August 1997 for Spring and Summer 1998 listing types of clothing referred to above, and also including additional items such as tracksuits, T-shirts, sweaters, jogging pants and cropped and tunic tops.
- GK9 which he says illustrates clothing which became available in the UK in 1998 and includes photographs showing the prominence given to the trade mark HEAD across the chests of several shirts and also the use of HEAD on collars and at other locations and again in the form HEAD=MAX.
- GK10 he says are further examples of the 1998 range
- GK11 he says are drawings showing clothing to be available for delivery in the UK from August 1998. He refers to use of the mark HEAD in the form HEAD=MAX and also HEAD PERFORMANCE and HEAD 1950. Reference is also made to a number of “subsidiary trade mark” including RIENNA, REALITY, FIGHTER, GLOBE, VEEMOK, TRUST, BASE and MYSTERY. Mr Kröll concludes that regular buyers of HEAD clothing have been accustomed to see the word HEAD and other marks in close proximity.
- GK12 is the spring-summer 1999 tennis court catalogue published in the UK by Sportline and he says shows the continuation of the ranges shown in other exhibits along with socks, raptops.
- GK13 illustrates various point of sale material supplied by Sportline to retailers
- GK14 is a typical advertisement published by Sportline during the period 1997 to early 1999 listing UK stockists and offering a “Free Gift from Head” to enable Sportline to establish its data base to allow direct mailshots to prospective customers
- GK15 consists of extracts from periodicals and articles in the press, published or available in the UK during the years 1996 - 1998. The exhibits includes extracts from

Harpers, Sports Trader, Daily Mail Ski Magazine, The Good Ski Guide, Tennis, Maxim, The Skier and Snowboarder, Mens Heath, Stuff for Men, ACE and the Coventry Evening Telegraph. This last advertisement is in conjunction with the EXSL exhibition in September 1997. Mr Kröll also makes reference to the skiers Stock and Klammer being involved with its ski division.

- GK16 is a copy of Sportline's Mountain Sports price list for Autumn and Winter 1999. This gives details of jackets, pants and shell suits by model name, the examples referred to include, 7th Heaven, Wizard, Off Limits.

9. Mr Kröll states that use of his company's trade mark very prominently in connection with marketing and promoting clothing of a variety of types and particularly for sports activities and leisure use. Although the mark is most often used alone, he states that in some instances HEAD is also used in close proximity to other words and indicia. In such circumstances, Mr Kröll submits that customers become accustomed to seeing the trade mark HEAD used in conjunction with other marks or words. In his view, it follows that use of the word RUSH in close proximity to his company's principal trade mark HEAD could easily be taken by its customers to refer to a range of goods. Mr Kröll makes various comments concerning the possible meaning of the word rush and its possible application to ski wear.

10. Mr Kröll concludes by making various comments concerning the mark applied for, its components and similarity to his company's trade mark and the likelihood of confusion. I need not summarise these.

11. The opponents also filed a witness statement by Mr John Francis Symonds dated 18 September 2000. Mr Symonds refers to a request by the Marketing and Information branch of the Patent Office for permission from his clients to use the "ski-tip logo" in connection with a quiz on an undergraduate training package.

12. The opponents also filed a witness statement dated 24 July 2000 by Mr David Gilbert, Managing Director of Gilbert and Pollard Sports Limited. His company has been in business since 1976 as a specialist distributor of a number of high profile brands of sportswear and he states that he has been aware of goods being distributed in the United Kingdom under the trade mark HEAD for at least 13 years. Mr Gilbert states that in March 1999 HEAD sportswear was being distributed by its exclusive licensee Sportline. In about May 1999 he states that his company decided that it would be of benefit to be able to add HEAD clothing to his company's range. Negotiations were commenced and they obtained the sportswear contract for the UK in January 2000. Mr Gilbert then makes various comments concerning the trade mark the subject of the application, I need not summarise these.

Applicant's Evidence

13. The applicant's evidence consists of a witness statement by Mr Stephen Illes, the applicant. Mr Illes states that he is the proprietor of Screentech Design, a screen printing company supplying quality printed clothing to businesses in the South West of England.

14. Mr Illes states that his company has been trading for six years and has built up an excellent reputation for supplying leisurewear to a wide range of businesses including various

high profile surf and leisure companies. He says that the decision to produce his own range of surf and leisurewear was a natural progression of his business.

15. Mr Illes gives reasons for his choice of trade mark. He states that he wanted his clothing to appeal to young people in the 15-35 years age bracket and the most popular clothing for this age group, particularly in Cornwall, is surf and leisure wear. At first he thought of using the name Rush Clothing, however, a search revealed that there was a company with that name already registered in Class 25.

16. Mr Illes explains the inspiration behind the name RUSH came from the phrase Adrenaline Rush which persons participating in extreme sports or activities would experience. He wanted a trade mark which conveyed the same meaning and he states that HEADRUSH was the obvious choice as it is a word that is widely used and recognised throughout youth culture.

17. At exhibit 1 Mr Illes supplies examples of the word HEADRUSH in use. This includes a copy of a HEADRUSH CD album available in the United Kingdom and also internet sites hits which include the word HEADRUSH. At exhibit 2 Mr Illes refers to other trade marks on the register in Class 25 which include the word or syllable HEAD. He notes that the list shows some 46 clothing companies which incorporate the word HEAD. In the light of the apparent acquiescence of HEAD in these companies' use of the word HEAD, Mr Illes states that he does not understand how the opponents can claim that use of his trade mark would damage the goodwill or reputation in the opponents' trade mark.

18. Mr Illes states that the word HEADRUSH is extremely prominent in the market and that anyone seeing the work HEADRUSH would not think of the opponents but of music or the literal meaning of the word. He says that the element RUSH in the word HEADRUSH would have more prominence than the word HEAD.

19. Mr Illes acknowledges that the opponents have a reputation and prominence in the market for sporting equipment, bags and footwear but he is not aware of any use on sports clothing, as such, he suggests that it is not widely available in the UK. Mr Illes states that he telephoned various sports shops in Cornwall; none supplied HEAD clothing and gave Mr Illes the name of HEAD's distributor GPS. At exhibit 3 Mr Illes exhibits a copy of the Sportline Brochures sent in response to his enquiry. They all show use on rackets, bags and shoes and are dated 1999 and 2000. Mr Illes states that he telephoned GPS who stated that they did not produce clothing brochures. Mr Illes states that he accessed the HEAD Website and that this did not contain any mention of clothing.

20. Mr Illes refers to the way in which the opponents' evidence shows their trade mark in use. He states that the examples show use of HEAD with the ski-tip logo or with the physical size of the word HEAD in significantly larger font than the accompanying text or, in the case of HEAD=MAX, the two words are separated with the equals sign. Mr Illes states that the combined effect of these factors serves to highlight the distinguishing feature of the mark in issue, namely that although the public may well associate the distinct individual word mark HEAD with the opponents, by their constant use of the mark in isolation there is currently no confusion with the other 46 registered HEAD based marks used in the clothing market. Similarly there will be no confusion in respect of use of the mark HEADRUSH CLOTHING.

21. Commenting on the suggestion by Mr Kröll that customers would think that the applicant's trade mark referred to a range of HEAD clothing, Mr Illes notes that the applicant's trade mark is one word HEADRUSH. Mr Illes makes further comments in support of his view that there would be no confusion. He suggests that HEAD=MAX would be more likely to be confused with HEADWORX one of the trade marks shown on the register. In addition, Mr Illes notes that the exhibits at GK11 show artists drawings of the garments which do not show that they ever entered production.

22. Mr Illes concludes by referring to the evidence showing trade marks on the register which include the element HEAD. He notes also that the stylised text on his trade mark has never been used by the opponents.

Further Evidence

23. The opponents did not file any evidence in reply. However, on 17 July 2001, they sought leave to admit a further witness statement by Mr John Symonds under the provisions of rule 13(11) of the Trade Mark Rules 2000. The registry indicated that a decision as to whether this evidence should be admitted would be taken as a preliminary point at the main hearing. The evidence of Mr Symonds is dated 17 July 2001. The purpose of the evidence is to introduce an extract from the latest 2001 edition of the Collins Concise Dictionary. Exhibit JFS5 consists of the relevant pages of the dictionary which show that the word HEADRUSH does not appear in the 2001 edition. At the hearing, Mr Illes did not seek to oppose the introduction of this witness statement and I allowed the witness statement of Mr Symonds to be admitted into the proceedings.

24. That conclude my review of the evidence.

Decision

25. The grounds of opposition refer to sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994. The relevant provisions read as follows:

“5.- (1)

(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.”

(3).....

(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.

26. 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 -

- (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,”

27. I will deal first with the opponents’ ground of opposition under section 5(2)(b). In determining the question under section 5(2), 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] R.P.C. 117, *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 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* 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 132, 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;
- (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;
- (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 133 paragraph 29.

28. Reference was also made by Mr Symonds to the following registry decisions; *Swiftcall* SRIS O/198/01; *Leatherwood* SIRS O/185/98; *Fruitcake* SIRS O/085/98; *Speedmaster* O/038/98. Mr Illes questioned whether Mr Symonds could make reference to these decisions or whether they should be treated as new evidence in the proceedings. These are previous cases decided by the registrar in opposition proceedings and it is open to a party to proceedings to refer to previous decisions of the registry or the Courts. This list of decisions was set out by Mr Symonds in his skeleton argument which was filed with the Office and copied to Mr Illes on 6 August 2001. Even so, I do not find these cases to be particularly helpful. The list set out above and derived from the case law of the ECJ is the same as that set out by the registrar's Hearing Officer in *Swiftcall*. Under section 5(2), the test is a composite one, involving a global appreciation taking into account a number of factors. As such, each case may turn on its own facts and the most that I can take from these cases is the approach that I should adopt when addressing the question before me. With these comments in mind I proceed to consider the opponents' case under section 5(2)(b).

29. The opponents' trade mark 1502616 is an earlier trade mark within the definition of section 6 of the Act. For convenience, I reproduce the opponents' and applicant's trade marks below:

Opponents' trade mark

HEAD

Applicant's trade mark



Class 25

Articles of outer clothing; footwear, sportswear, all included in Class 25 but not including headgear.

Class 25

Clothing

Inherent Distinctiveness/Reputation of the Opponents' Earlier Trade Mark

30. Mr Symonds argued that the opponents' trade mark was not only inherently distinctive for clothing, with the exception of headgear, but also that it enjoyed an enhanced reputation with the public as a consequence of the use that has been made of it. Mr Symonds took me to the opponents' evidence and referred me to the level of turnover and the examples of use shown in the various brochures attached as exhibits to Mr Kröll's statement. I note that the turnover figures given are said by Mr Kröll to relate to "clothing, footwear and headgear". The figures given are for the years 1997-1999 and are fairly consistent across that period although, absent further information it is difficult to assess the level of market penetration that these figures represent. Mr Symonds pointed out that most of the use of the trade mark HEAD on clothing related to ski and tennis wear and he argued that it was in these areas that the opponents enjoyed an enhanced level of recognition.

31. Mr Illes, whilst acknowledging the opponents' reputation for sporting equipment, bags and sports shoes, argued that their reputation was confined to those areas and submitted that their evidence did not support a claim to a reputation for clothing at large. He suggested that the examples of the opponents' use on clothing given in their evidence were all brochures and that this did not necessarily show sales. He also suggested that the examples shown in the brochures demonstrated that the opponents use the trade mark HEAD with the ski-tip logo.

32. On the first point I think Mr Illes' views have some weight. It should also be noted that the opponents' sales figures are not broken down into the various categories, such as footwear and clothing. The brochures filed with the opponents' and applicants' evidence show that the trade mark HEAD is used frequently on footwear. However, there are a large number of brochures which also show use on clothing. I think that Mr Symonds was right to class this clothing as ski and tennis wear although there are examples such as GK5 which show use on more general sporting apparel. Where I find that Mr Illes' comments carry less weight is in relation to the use of the ski-tip logo. Whilst it is true that many of the brochures show use of this logo, it is shown alongside the trade mark HEAD used on or in relation to the goods. It is equally true that a large number of the products show use of the trade mark HEAD solus.

33. Whilst the evidence is not without its faults, I am prepared to find that the opponents' trade mark has a recognition in respect of tennis and ski wear. As Mr Symonds noted, that recognition would be amongst users of tennis and ski wear. The trade mark HEAD therefore

does possess a level of inherent distinctiveness and it also enjoys an enhanced level of recognition amongst a specific class of consumer in relation to a specific range of goods. Whilst I have found that the trade mark enjoys an enhanced level of recognition for specific goods I must of course assume use in relation to all the goods for which the trade mark is registered. Equally, it appears that the applicant's trade mark has not been used. However, I must consider notional and fair use of the applicant's trade mark in relation to the goods for which registration is sought.

Identity/Similarity of Goods

34. The opponents' trade mark is registered for certain goods within Class 25. The applicant seeks registration for a specification which reads "Clothing". In so far as the applicant's trade mark covers outer clothing; footwear and sportswear then the goods are identical. The applicant's specification will also cover items of clothing which are not identical with those covered by the opponents' specification. However, it seems to me that to the extent that all the products will be clothing, the goods to a greater or lesser extent will be similar. To conclude on this point, the goods for which the applicant seeks registration are either identical or similar to the goods covered by the opponents' earlier trade mark.

Comparison of the Trade Marks

35. I will now consider the visual, aural and conceptual similarities between the trade marks by reference to the overall impression created by the marks but taking into account their distinctive and dominant components.

36. Visually, the opponents' earlier trade mark is the word HEAD. Mr Symonds suggested that the applicant's trade mark would be read as HEADRUSH. In his view, the word CLOTHING, being purely descriptive for the goods, would be given less weight by the average consumer. He went further and suggested that taking into account imperfect recollection the element CLOTHING would be given even less weight and it was the word HEADRUSH that would be remembered by the consumer. Mr Symonds argued that the applicant's trade mark was set out in a fairly standard format and that his client's trade mark could be presented as white on black. In contrast, Mr Illes pointed out that his trade mark was presented in a box as a whole and that there was a degree of stylisation in the way in which the words were written. It seems to me that there is force in both parties' arguments. The applicant's trade mark does in my view possess a degree of stylisation. Although it is presented as white on black the way in which the trade mark is presented within a box does give it a slightly unusual presentation. That said, Mr Symonds is correct in my view to identify HEADRUSH as the dominant and distinctive component within the applicant's trade mark but I must not disregard the totality of the mark. Taken as such, there is some visual similarity between the two trade marks. The applicant's trade mark contains the totality of the opponents' trade mark HEAD. It is the first four letters of the applicant's mark. The mark would in my view strike the eye as the words HEAD and RUSH written together. In my view, this would be so regardless of whether the member of the public gave the word HEADRUSH any specific meaning (see discussion on conceptual similarity set out below).

37. As Mr Symonds correctly pointed out, the word HEAD is there for all to see, it is not lost or buried within the applicant's trade mark. However, it also made up of another strong visual element RUSH, it too is there for all to see and the mark is presented as a totality in a slightly

unusual stylised form. Absent any enhanced reputation enjoyed by the opponents' trade mark HEAD, these factors taken together would in my view enable the average consumer, to distinguish between the two trade marks. The visual impact of marks for clothing is an important factor but I do not discount the importance of aural or conceptual similarities.

38. Aurally, the opponents' trade mark would again be referred to as HEAD and the applicant's as HEADRUSH clothing. Again, in my view, the dominant part of the applicant's trade mark will be HEADRUSH and again there is some aural similarity between the trade marks in that both contain the element HEAD. This element occurs at the beginning of the applicant's trade mark and as such will receive more prominence in aural use. Whilst the element RUSH has less aural impact having a soft ending, as with the visual impact, I reach the view that it would still be heard by the average consumer. Consequently, I reach the view that in aural use, and absent any enhanced reputation, the differences between the two marks in suit are sufficient to avoid a likelihood of confusion.

39. Conceptually, the opponents' trade mark consists of the word HEAD. There was a dispute between the parties as to whether the HEADRUSH was a known word which carried a specific meaning. Mr Symonds, referring to the latest edition of the COLLINS CONCISE dictionary, noted that HEADRUSH was not a dictionary word. Mr Illes, referring to the CD attached as an exhibit to his witness statement and the various internet sites, argued that the word was one in common usage, particularly amongst the young. In my view, neither party's evidence is conclusive on this point and in any event, I do not think that it advances the respective submissions any further forward. There may be many words in dictionaries which are not in common usage and whose meaning is obscure to the average consumer. Equally, there will be words that have entered the English language but which have not yet shown themselves to have sufficient staying power to be included in a dictionary. My own view is that even if the meaning of the HEADRUSH, suggested by Mr Illes, is not known to many consumers, a meaning is in my view apparent from the two words HEAD and RUSH. It seems to me that taking these two ordinary English words, both of which in common usage, and putting them together, brings to mind a rush of blood to the head or some exhilarating experience.

40. From my conclusions above, I reach the view that whilst there is some visual, aural and conceptual similarity between the trade marks this would, absent a reputation, be insufficient to result in a likelihood of confusion. I should go on to say that even taking into account the reputation that I have found that HEAD enjoys for tennis and ski-wear, I reach the view that the differences between the trade marks would be sufficient to avoid a likelihood of direct confusion. In so finding, I have taken into account the fact that the applicant seeks registration for some goods which are identical to those for which the earlier trade mark is registered.

41. That is not an end to the matter. Mr Symonds suggested that the opponents' evidence showed that the opponents use the trade mark HEAD together with secondary marks and that customers were accustomed to such use. Mr Symonds referred me to exhibits GK11 and GK16 which in his view showed examples of such use. It seems to me that the evidence of the opponents does show that in respect of tennis and ski-wear, the opponents have used the trade mark HEAD together with another word or phrase. Mr Symonds argued that given such use, an average consumer of tennis and ski-wear, aware of his clients' reputation and use of secondary marks, on seeing the applicant's use of the trade mark HEADRUSH CLOTHING in manner shown on the application would wrongly believe that the goods came from the opponents, or some economically linked undertaking. Mr Symonds case would be at its

strongest if I considered use of the applicant's trade mark on tennis and ski-wear which are both covered by the applicant's specification.

42. In contrast, Mr Illes pointed to the number of trade marks on the register in class 25 which contained the element HEAD. His evidence lists these trade marks but it is well established that the fact that there may be such trade marks on the register is not relevant when considering the question under section 5(2). If those trade marks were in use and evidence of such use was before me then that may have been a relevant factor. At the end of his submissions, Mr Illes referred to the evidence relating to the register and to the fact that he had purchased an item of clothing which he wished to show me as evidence of use in the market place. I declined to allow him to show me the article and pointed out to him that the correct approach would have been for him to file this in evidence when he filed his evidence in chief or for him to have sought leave to file it as additional evidence. Mr Illes asked if he could just show me the article but I declined indicating that if he did I would have to disregard it as it was not in evidence in the proceedings.

43. It seems to me that the views put forward by Mr Symonds have some weight. As noted above, the evidence seems to me to support the contention that HEAD use their trade mark with other sub-brands to denote a particular line of products. Given the opponents' reputation it is my view that if the trade mark HEADRUSH CLOTHING were to be applied to tennis and ski-wear, then the relevant consumer would wrongly believe that the goods came from the opponents or some economically linked undertaking. As such, there would be a likelihood of confusion within the meaning of section 5(2)(b) of the Trade Marks Act 1994 in respect of use on such goods.

44. Mr Symonds suggested that if I reached that conclusion then perhaps an amendment could be made to the applicant's specification that would remove the area of conflict. I have found a likelihood of confusion if the applicant's trade mark is used on tennis or ski-wear. As noted, the applicant's specification as currently worded covers such goods but it also covers other goods use on which I have found would not result in a likelihood of confusion. This leaves the difficult problem of trying to identify a specification to address these concerns. The task in my view is made more difficult because there will be some items that may be difficult to place in a specific category.

45. Having considered the matter, I reach the view that the most sensible course of action would be for Mr Illes to amend his specification to "Clothing, none being tennis or ski-wear". Whilst this specification is not without its drawbacks and there may be 'grey' areas where it is not entirely clear whether the product is or is not tennis or ski-wear, it does identify the area in which I have found that the ground under section 5(2)(b) is made out. Mr Illes should be free to use his trade mark in respect of other items of clothing on which the opponents have no reputation.

46. Mr Symonds also sought to rely on his client's ground of opposition under section 5(4)(a). The requirements for this ground of opposition have been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *WILD CHILD Trade Mark* [1998] RPC 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

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

47. The opponents have shown that they have a reputation and goodwill in tennis and ski-wear. The consideration under section 5(4)(a) with regard to misrepresentation are very similar to those under section 5(2)(b). Having regard to the use that has been shown of the trade mark HEAD together with other elements, I reach the view that use of the applicant's trade mark on tennis and ski-wear would result in a likelihood of misrepresentation. In the light of such misrepresentation, I reach the view that third element of passing off, damage, would be present.

Conclusions

48. As I have found that the opponents' grounds of opposition under section 5(2)(b) and 5(4)(a) have succeed in part. The applicant should file a Form TM21 within one month of the expiry of the appeal period from this decision, restricting his specification in Class 25 to the wording shown below. If no Form TM21 is filed, the application will be refused in its entirety. The application should be amended to read:

Clothing, none being tennis or ski-wear.

49. The opponents have only succeeded in part but are entitled to a contribution towards their costs. In the event that the specification is limited as shown above, I order that the applicants pay the opponents the sum of £400-00 as a contribution towards their costs. In the event that no Form TM21 is filed and the application is refused in its entirety then I order that the applicants pay the opponents the sum of £835-00. If there is no appeal, then the appropriate sum is to be paid within one month of the expiry of the period set for filing of the Form TM21. In the event of an appeal then the costs will be payable within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 08 day of November 2001

**S P Rowan
For the Registrar
the Comptroller General**