

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 2167825 BY TONY KNIGHT
TO REGISTER A TRADE MARK IN CLASS 25

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO. 50544 BY
PATROL JEANSWEAR LTD

DECISION

Introduction

1. This is an appeal by Mr. Tony Knight (“the Applicant”) from a decision of G.J. Rose’ Meyer, the Hearing Officer acting for the Registrar, dated the 28th November 2001. In that decision the Hearing Officer upheld an opposition by Patrol Jeanswear Limited (“the Opponent”) to an application by the Applicant to register the trade mark in TK. PATROL in Class 25 in respect of fashion clothing, footwear and headgear.
2. The opposition was based on section 5(2), 5(3) and 5(4) of the Trade Marks Act 1994 (“the Act”). The opposition under section 5(2) of the Act was based upon the earlier trade mark WORLD PATROL registered in Class 25 in respect of articles of outer clothing; jeans, jackets, T-shirts, shirts, sweat shirts, all being articles of outer clothing for ladies and men. The Hearing Officer

found that the respective specifications of goods included identical goods and that therefore the issue of a likelihood of confusion rested on a comparison of the marks. Further, the Hearing Officer found that the similarities between the marks was such that there existed a likelihood of confusion, in the sense that potential purchasers of the goods sold under the marks would be likely to believe that the respective goods to which they were applied came from the same or economically linked undertakings. Accordingly, the opposition under section 5(2) succeeded.

3. The Hearing Officer dealt with the objections under section 5(3) and 5(4) of the Act very shortly. The objection under section 5(3) was dismissed on the basis that the goods in question were identical or at least similar. In relation to section 5(4), the Hearing Officer found that, having assessed the evidence carefully, the case under this ground was no stronger than that under section 5(2) and accordingly it was not considered further.

The Appeal

4. On the 6th December 2001, the Applicant gave notice of appeal to an Appointed Person. The matter came on for hearing before me on the 6th September 2002. The Applicant appeared in person. The Opponent was represented by Mr. Marsh of Hoffmann Eitle.
5. The Applicant submitted that the Hearing Officer wrongly decided that the two marks TK. PATROL and WORLD PATROL were so similar as to give rise to a likelihood of confusion. In substance the Applicant submitted that the

Hearing Officer wrongly failed to consider the two marks as a whole and that when properly considered in that way, the two marks were not so similar as to be likely to cause confusion. Moreover, it was submitted that this was further established by the fact that in the fashion clothing industry there are many marks which carry a common element and which co-exist. The Applicant also submitted that the Opponent's earlier trade mark had not been used to any substantial extent by the Opponent and that it conducted business primarily as a manufacturer for other companies which then applied their own labels to the relevant goods.

6. In considering these submissions it is, in my view, important to have in mind that an appeal to an Appointed Person is not by way of rehearing, but rather by way of review. The Hearing Officer had to make a comparison, evaluating the similarity of the marks, the similarity of the goods and all other relevant factors to reach a conclusion about the likelihood of confusion. Hearing Officers are experienced in this exercise. It is now well established that in these circumstances an appellate tribunal should show a real reluctance to interfere with a conclusion by a Hearing Officer in the absence of a distinct or material error of principle.
7. I would also note at the outset that no evidence was properly submitted by the Applicant in these proceedings. Although the Applicant submitted evidence to the Registrar, it was not copied to the Opponent. Despite a number of reminders from the Registrar, the Applicant failed to make the deficiency good

and accordingly, in February 2001, the Registrar wrote to the Applicant notifying him that his evidence would not be admitted in the proceedings.

8. I turn then to the approach and reasoning of the Hearing Officer and the specific criticisms made on this appeal by the Applicant. The Hearing Officer began by setting out aspects of the guidance provided by the European Court of Justice in *Sabel BV v. Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] RPC 117; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel BV* [2000] FSR 77 and *Marca Mode CV v. Adidas AG* [2000] ETMR 723. No criticism was made by the Applicant of this aspect of the decision.

9. The Hearing Officer then proceeded to apply the guidance derived from these cases in the context of the present case. The Hearing Officer took into account the degree of visual, aural and conceptual similarities between the marks and evaluated the relative importance attaching to them, taking into account the goods involved and the circumstances of the market. He considered that from a visual perspective the marks certainly had differences, but nevertheless evidently shared the common element PATROL. He considered that the marks were similar by virtue of the visual force of that shared word PATROL. He also considered that the marks were similar from an aural perspective, again because of the force of the shared word PATROL. Turning to the conceptual impact of the marks, he formed the view that the word PATROL would be understood by the average consumer as a word denoting something about law enforcement. He also considered that in the case of the mark of the

Applicant, the TK element did not add to or alter that concept. He also formed the view that the word WORLD did not significantly alter the conceptual nature of the mark WORLD PATROL in the earlier trade mark. To his mind the word WORLD did not alter the primary meaning of the mark, which relied on the concept created by the word PATROL. The Hearing Officer took all these considerations into account and came to his conclusion that the marks were not so similar as to be likely to cause confusion directly, but that they were so similar that consumers would be likely to think that the goods to which they were applied came from the same or linked undertakings.

10. I am unable to accept the submission made on behalf of the Applicant that the Hearing Officer fell into error. In my judgment the Hearing Officer did consider the two marks as a whole from the visual, aural and conceptual perspective. Account was also taken of the overall impressions created by the marks bearing in mind their distinctive and dominant components. The Hearing Officer concluded that the particularly distinct and dominant component of each of the marks was the word PATROL and that this common element created a likelihood of confusion which was not dispelled by the evident differences between the marks.
11. I also reject the submission that the Hearing Officer should have taken into account the fact that there are other trade marks used in the fashion industry which bear a common element. It seems to me that there are two problems with this submission. First, the Applicant has no evidence in the proceedings of any particular marks which co-exist and the precise circumstances

surrounding their use. Secondly, whilst it is possible that evidence of other similar marks may indicate that the average consumer in a particular field is well used to distinguishing between very similar marks, the matters drawn to my attention by the Applicant do not, in my view, begin to support the proposition that the Hearing Officer fell into error in this case in concluding that the average consumer would be likely to think that goods bearing the marks in issue came from the same or associated businesses.

12. Finally, I turn to consider the submission that the Opponent trades primarily as a trade supplier. In my judgment this does not assist the Applicant either. The Hearing Officer arrived at his decision on the basis of a comparison of the two marks. He did not find that the use of the earlier trade mark was such that it had a particularly distinctive character.
13. In all the circumstances, I consider that the Hearing Officer did not err in principle, nor was he clearly wrong. He was entitled to conclude that the objection under section 5(2) was made out.
14. In my judgment the Hearing Officer rightly rejected the objection under section 5(3). I also believe that he was right to find that the Opponent had no stronger case under section 5(4) than under section 5(2). Accordingly, like the Hearing Officer, I will not deal with it further.

Conclusion

15. The appeal must be dismissed. I order the Applicant to pay to the Opponent the sum of £525 by way of a contribution to its costs, such sum to be paid on a like basis to that ordered by the Hearing Officer.

DAVID KITCHIN, Q.C.

19th September 2002