

O-353-03

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION NO 759948
AND A REQUEST BY C.I.T. – COMERCIO INTERNACIONAL TEXTIL
LDA TO PROTECT A TRADE MARK IN CLASS 25**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO 70717 BY
INTERSPORT INTERNATIONAL CORPORATION GMBH**

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BACKGROUND

1. On 6 June 2001 C.I.T.-Comercio Internacional Textil Lda (C.I.T.), on the basis of a Portuguese registration, requested protection in the United Kingdom for the following trade mark in respect of “clothing, footwear, headgear” (Class 25):

The logo for McKensey Golf - and Freeware. The word "McKensey" is written in a large, bold, italicized serif font. Below it is a thick horizontal line. Underneath the line, the words "Golf - and Freeware" are written in a smaller, elegant cursive script.

2. The United Kingdom Trade Marks Registry considered that the request satisfied the requirements for protection in accordance with Article 3 of the Trade Marks (International Registration) Order 1996 and particulars of the international registration were published in accordance with Article 10.

3. On 10 December 2001 Intersport International Corporation GmbH filed notice of opposition to the conferring of protection in the UK on this international registration. The opponents are the proprietor of the mark MCKINLEY, an international registration (No. 684505) which has been protected in the UK from 15 November 1997. The protection extends to six classes (12, 18, 20, 22, 25 and 28). It will be sufficient for present purposes to record that the Class 25 specification reads:

“Clothes, shoes, gloves and knitted caps, fishing boots, articles of clothing for hiking, mountain touring, mountain climbing, hunting, fishing and horse riding.”

4. The opponents claim to have used their mark in relation to the Class 25 goods since 1999.

5. On the basis of these facts and circumstances the opponents raise objection to the conferring of protection under Section 5(2)(b) and 5(4)(a) of the Act.
6. CIT filed a counterstatement denying the above grounds.
7. Both sides ask for an award of costs in their favour.
8. Both sides filed evidence. The parties were reminded of their right to be heard or to offer written submissions.
9. Neither side has asked to be heard or filed written submissions though I note that the evidence filed includes what amounts to submissions. Acting on behalf of the Registrar and with the above material in mind I give this decision.

Opponents' Evidence

10. The opponents' filed a witness statement by Jürg Stucki, the Chief Executive of IIC-Intersport International Corporation GmbH. He firstly exhibits (JS1) an excerpt from his company's Trade Mark Manual showing, inter alia, a list of the products on which the mark McKINLEY is to be used. I note that these include clothing and footwear items.
11. Mr Stucki also exhibits (JS2) excerpts from his company's reports for the years 1996-2000 showing the number of shops offering his company's goods. However, he adds that the supporting sales figures should be disregarded as they do not reflect sales of McKINLEY products alone.
12. The number of shops offering goods appears to fluctuate over the period from 313 in 1996 to 420 in 1999 and falling back slightly to 346 in 2000. It is not clear how many of these shops offer the McKINLEY brand products. Also included in Exhibit JS2 are sheets showing the comparative importance of the company's main brands. These include Etirel, Crazy Creek, Tecno, Pro Touch and Firefly as well as McKinley. McKinley is shown to have grown in relative importance over this period. I infer that the comparative figures represent the global position rather than being specific to the UK market.
13. Turning more specifically to the UK market the value of goods sold under the brand McKinley is given as follows:

	2000	2001	2002
Clothing	84'200	101'500	96'400
Footwear	-	51'200	95'000
TOTAL	84'200	152'700	191'400

These figures are in Swiss francs and represent ex-factory prices (end consumer prices are said to be at least 2.5 times higher).

14. Photographs showing examples of the clothing are exhibited at JS3. The goods are sold through the medium of sports shops that offer a wide range of sports goods, sports clothing and sportswear. The remainder of Mr Stucki's statement is in the nature of submissions. I take these into account in reaching my own view of the matter.

Other evidence

15. The other evidence filed in this action (witness statements by Mark Roland Foreman on behalf of C.I.T. and Victoria Jane Martin on behalf of Intersport) also consists in large measure of submissions. Again I propose to deal with this as necessary in my decision below rather than recording it at this point.

Decision

16. The first ground of objection is based on Section 5(2) of the Act which reads:

“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.”

Sub-paragraph (b) applies here. The mark relied on by the opponents is an earlier trade mark within the meaning of Section 6(1)(a) of the Act.

17. I also take account of 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] RPC 117, and *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77.

18. The question for consideration under Section 5(2)(b) is whether there are similarities in terms of the marks and goods in issue that would have combined to give rise to a likelihood of confusion if, at the relevant date, the earlier and later marks had been used concurrently in the United Kingdom in relation to the goods in issue. In applying the principle of interdependency a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods (*Canon v MGM*, paragraph 17).

19. I will consider the goods first. The matter can be dealt with fairly briefly as it is clear that the respective sets of goods are either identical or closely similar. C.I.T.'s 'clothing,

footwear, headgear' must be identical to 'clothes, shoes knitted caps' in Intersport's registration. Furthermore, the opponents' articles of clothing for dedicated purposes (mainly outdoor pursuits) must be held to be a subset of the goods covered by C.I.T.'s application and hence identical.

20. In comparing the marks I must have regard to:

- their distinctive and dominant components (*Sabel v Puma*, paragraph 23);
- their visual, aural and conceptual similarities (*Sabel v Puma*, paragraph 23);
- the fact that the average consumer rarely has the chance to make direct comparisons but must rely upon an imperfect picture of the marks in his mind (*Lloyd Schuhfabrik*, paragraph 27);
- the fact that the average consumer is deemed to be reasonable well informed, circumspect and observant (*Lloyd Schuhfabrik*, paragraph 27).

21. The opponents' earlier trade mark is the word MCKINLEY. Its character can only, therefore, reside in that word but I must consider both its inherent and any acquired distinctiveness. I take the word to be a surname according to its normal signification but I have been given no information as to how common it is. It does not strike me as being either particularly common or particularly uncommon. The word may also have been chosen so as to create an association with Mount McKinley. I note that in use (Exhibit JS3 for instance) the word is frequently used with a device of a mountain hence reinforcing any intended allusion (the goods too include mountain climbing and other outdoor clothing). However the earlier trade mark relied on is not a composite mark but the word MCKINLEY alone. I have no basis for according it other than an average degree of distinctive character based on its inherent qualities. However, Mr Stucki has provided evidence of use. There is somewhat limited information on trade under the mark in the UK. The opponents, quite properly, acknowledge that the sales figures in JS2 cover more than the MCKINLEY brand and must be disregarded. The information given on the number of retail outlets is suggestive of a trade of some substance but it is not clear whether all the shops stock the MCKINLEY brand.

22. The material date in these proceedings is 6 June 2001. Sales of goods under the MCKINLEY brand are given for the years 2000 to 2002. No breakdown is given of the 2001 figures to show the position before and after the material date. The figures are given in Swiss francs. At the time of writing there are just over 2 Swiss francs to the pound. By any standard this points to a modest level of trade in clothing and footwear by the material date (even allowing for the retail mark-up). No information is given on market share. I have difficulty in accepting that the opponents' trade could have made a significant impact on the clothing market or even any more specialised sub-set thereof such as outdoor clothing.

23. In *DUONEBS Trade Mark*, BL O/048/01, Mr S Thorley QC, sitting as the Appointed Person, in dealing with the question of the reputation attaching to a mark said:

“In my judgment, I believe what the ECJ had in mind was the sort of mark which by reason of extensive trade had become something of a household name so that the propensity of the public to associate other less similar marks with that mark would be enhanced. I do not believe that ECJ was seeking to introduce into every comparison required by Section 5(2), a consideration of the reputation of a particular existing trade mark.”

24. I conclude that the opponents’ mark is not entitled to benefit from any claim to an enhanced reputation as a result of the use made of it.

25. So far as the applied for mark is concerned Mr Foreman, who has given evidence for the applicants, suggests that it employs a distinctive font together with the words “Golf – and Freeware” in addition to the word McKENSEY. He submits that the term ‘Freeware’ is not descriptive of clothing per se but rather is a fanciful term alluding to casual clothing that may be worn freely (and by implication contributes to the character of the mark). The latter point is resisted by Ms Martin, the opponents’ professional representative, who submits that the term would appear to describe articles of clothing that permit freedom of movement and in particular a golf swing. The latter explanation is not implausible but I simply have no evidence on the point one way or the other. What I can say is that McKENSEY is the visually dominant element of the mark. The sub-text “Golf – and Freeware” is presented as a clearly subordinate strap-line. If Freeware is intended to contribute to the overall distinctive character of the mark it may not be immediately obvious to the average consumer and it does not detract significantly from the pre-eminent position of McKENSEY in the mark. C.I.T.’s mark is said to have been in use in relation to golf clothing since June 2000 but I have not been given information as to the extent of that trade. Nor have I been told how common McKENSEY is as a surname, assuming that is what it is or is likely to be taken to be.

26. With these findings in relation to the nature and distinctive character of the marks in mind I turn to the comparison of their visual, aural and conceptual similarities. Mr Stucki submits that the prominent part of the opposed mark is the name McKENSEY and that McKINLEY and McKENSEY are very similar both visually and phonetically. He does not say why he considers this should be so.

27. Mr Foreman submits that the prefix “Mc” or “Mac” is common in the United Kingdom in surnames as it is the Gaelic word for “son of”. As such, he suggests that a large proportion of Scottish or Scottish originated surnames contain the prefix and it is non-distinctive in the United Kingdom. He goes on to submit that:

“The pronunciation of the words KENSEY and KINLEY are not similar to consumers whose first language is English. Both words commence with the letter “K” and end in “EY” but the letters “ENS” and “INL” are not similar and would not be confused. The composite words are pronounced dissimilarly, with the

emphasis on McKensey as McK-EN-SEA whereas McKinley would be pronounced as follows:- Mc-KIN-LY.”

28. I approach the comparison on the basis that both marks have surnames as their only or dominant feature. In *Buler Trade Mark* [1966] RPC 141 it was said that:

“It seems to me that surnames stand in a different position from the point of view of spelling from ordinary words in the English language, for spelling is a matter of considerable importance in distinguishing one surname from another. One may easily understand the meaning of an ordinary word in the English language, although it is mis-spelt; but if one finds a surname spelt in a way which one does not expect it to be spelt one is immediately put upon inquiry as to whether or not it is the name of some other person than the person to whom one supposes the name to belong.”

29. That was a case under the old law but I see no reason why it would not be equally relevant today as a statement of the importance that is attached to the spelling of surnames and, as a consequence, the care that is likely to be taken in differentiating between surnames even when in most respects they are quite similar in appearance and pronunciation (for instance Smith/Smythe, Davies/Davis, Clark/Clarke).

30. An analysis of the key elements of the marks McKENSEY and McKINLEY reveal that they have the same number of letters and that they start with McK- and end in -EY. At a superficial level that is enough to suggest that they share points of similarity. But given the characteristics of the average consumer (per *Lloyd Schuhfabrik*) I think it unlikely that visual similarity can be said to exist to the point that the marks are distinctively similar. This is not a case where doubts may exist because one surname is an obvious or common misspelling or alternative spelling of the other. They are simply different surnames.

31. Phonetically, too, I find limited similarity. As the applicants suggest, “Mc” prefixes are common and due regard is likely to be paid to what follows when differentiating between surnames with this prefix. It would, in my view, require a high degree of inattentiveness or slurring to render the marks similar.

32. Conceptually it can be said that both marks are, or incorporate, surnames. Both would also be taken as Scottish surnames. But they are different surnames and will be differentiated with the care that is customarily accorded to such names.

33. The likelihood of confusion must be appreciated globally taking account of all relevant factors. The principle of interdependency between similarities in the goods and marks must be borne in mind in reaching a view on the likelihood of confusion. I have found that identical goods are in play. However, having regard to the nature of the marks (surnames) and the care with which consumers (the general public) are likely to approach such marks I find that the net effect of the similarities and differences is that there is no likelihood of confusion. In reaching that view I have endeavoured to make due

allowance for imperfect recollection. The effects of sequential rather than concurrent acquaintance with the marks may have some effect on consumers' recollection of the marks but less so than could be the case with invented words and not so as to change my view of the outcome.

34. The opposition fails under Section 5(2)(b).

35. In the circumstances of this case I do not think it necessary to give full and separate consideration to the ground based on Section 5(4)(a) and the law of passing-off. I can see no basis on which the opponents can succeed under this head when they have failed under Section 5(2)(b). In particular:

- I note that Ms Martin suggests the opponents' overall reputation must be taken into account and that the mark McKINLEY is said to be used in relation to a wider range of goods. However, the evidence only goes to use on clothing and is in any case of limited scope;
- the mark used appears to employ a device of a mountain in addition to the word McKINLEY. Thus there is an additional point of differentiation;
- even taking a generous view that the opponents have substantiated their claim to goodwill they would fail to establish misrepresentation and damage as required by the passing-off test.

36. C.I.T. have been successful and are entitled to a contribution towards their costs. I order the opponents to pay them the sum of **£1000**. 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 17th Day of November 2003

M REYNOLDS
For the Registrar
the Comptroller-General