

O-101-07

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 2355899
IN THE NAME OF HIP DESIGNS LIMITED
TO REGISTER A TRADE MARK IN CLASSES 3,16, 18, 20, 21, 24, 25, 28, 29, 30 & 32**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 93493 IN THE NAME OF
JC AB**

Trade Marks Act 1994

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in the name of Hip Designs Limited
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**IN THE MATTER OF opposition thereto
under No. 93493 in the name of JC AB**

BACKGROUND

1. On 14 February 2004, Hip Designs Limited made an application to register the trade **MARVIN** in Classes 3,16, 18, 20, 21, 24, 25, 28, 29, 30 & 32. The mark is in the following stylised form:



2. On 13 June 2005, JC AB filed notice of opposition to the application in respect of the goods covered by Classes 18, 25 and 28, which are as follows:

- 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 25** Clothing, footwear and headgear.

- Class 28** Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees

3. The ground of opposition is:

- Under Section 5(2)(b)** because the mark applied for is similar to the opponents' earlier marks, and is sought to be registered in respect of goods that are identical or similar to those for which these earlier marks are registered, such that there exists a likelihood of confusion.

4. Details of the earlier marks relied upon by the opponents in these proceedings can be found as an annex to this decision.

5. The applicants filed a counterstatement in which they deny the ground on which the opposition is based. Both sides ask that an award of costs be made in their favour.

6. Both sides filed evidence which insofar as it may be relevant to these proceedings I have summarised below. Neither side took up the offer of an oral hearing, instead electing to have a decision from the papers on file. After a careful study of the evidence and submissions therein, I now go on to give my decision.

Applicants' evidence

7. This consists of a Witness Statement dated 20 February 2006, from Matthew Gardner, a Trade Mark Agent employed by The Trade Marks Bureau. The Witness Statement consists of submissions on the merits of the opposition, and exhibits two cases in support. Whilst I do not consider it to be either necessary or appropriate that I summarise this as evidence, I will take their contents fully into account in my determination of this case.

Opponents' evidence in reply.

8. This consists of a Witness Statement dated 27 April 2006, from Benjamin Britter, a Trade Mark Attorney of David Keltie Associates. Given the nature of the evidence to which it is in reply, it is perhaps not surprising that Mr Britter's Statement also consists of submissions on the merits of Mr Gardner's arguments, accompanied by information that, amongst other things, shows Marvin to be a boys name, details of the popularity of the name seemingly in the US, details of "Teutonic baby names for boys" and "American Baby Names" for boys. I do not consider it to be either necessary or appropriate that I summarise this as evidence, but I will take their contents fully into account in my determination of this case.

9. That concludes my summary of the evidence insofar as it is relevant to these proceedings.

DECISION

10. The opposition is founded on Section 5(2)(b). That section reads as follows:

“5.-(2) A trade mark shall not be registered if because –

(a)

(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.”

11. An 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 or international trade mark (EC) 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.”

12. In my consideration of a likelihood of confusion or deception I take into account the guidance provided by the European Court of Justice (ECJ) 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 B.V.* [2000] 45 F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [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*,
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, 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.*,
- (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*,
- (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*,
- (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*,
- (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*,
- (g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,
- (h) 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*,

- (i) 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 and Addidas Benelux BV*,
- (j) 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.*

13. The opponents rely on five earlier trade mark registrations, all of which achieved registration within five years prior to 11 March 2005, the date on which the application in suit was published. This being the case, the provisions of Section 47(2)(A) introduced under The Trade Marks (Proof of Use, etc.) Regulations 2004 do not apply.

14. The opponents' earlier marks are for the word "MARWIN", "Marwin Stars", "Marwin Heroes", "MARWIN SWEETHEARTS" and "MARWIN & FRIENDS", in each case represented in a plain font. Taking into account the fact that there is no evidence that any of these marks have been used, and that if there is any potential for confusion, it is because of the word MARWIN, it seems to me that the opponents' best case must rest in their registration for the word MARWIN on its own. This also has the widest statement of goods for Class 18, and where covered, includes a range of goods in Classes 25 and 28 equal in scope to any of their other marks.

15. On a visual comparison, it is clear that there are marked similarities in the appearance of MARWIN and MARVIN. The difference is the substitution of a letter "W" for a letter "V". These letters have a similar "arrowed" appearance, which if taken with the fact that they appear in the body of words that are in all other respects identical, leads me to the position that the respective marks are very similar in look.

16. In the Statement of Case, the opponents contend that MARWIN and MARVIN are phonetically very similar. They say that there is "...an identical sequence of syllables, rhythm and intonation", and that "...the prevalence of the German language in the United Kingdom which has resulted in the relevant public becoming aware that the letter 'W' is frequently pronounced as the English letter 'V'". In their evidence, the opponents restate the "German" connotation, but that they consider the respective marks to be similar "...even when the letter 'W' in the Opponents' earlier marks is pronounced in the English language..."

17. In support of their "German" pronunciation argument the applicants refer to the decision of the Registrar's Hearing Officer in the *Jowat Lobers und Frank GmbH & co kg and Norton Company* (BL 0/184/02). The Hearing Officer summarised the argument as follows:

"21. Ms Bucks then refers to Mr Thomson's comments on the comparison of the marks. In particular, Ms Bucks refers to Mr Thomson's comments that the evidence regarding German pronunciation is irrelevant as the opposition relates to the UK and says that this is an oversimplification. Ms Bucks says that as the applicants' mark is owned by a German company, "It only stands to reason that the manufacturers would apply a German pronunciation through its trade channels." Furthermore, Ms Bucks

says that "even to non-German speakers, many would be aware of the basis of German pronunciation if only from television."

18. In his decision, the Hearing Officer came to the following view:

“38. Turning to aural comparisons I note the opponents' emphasis on the applicants' goods having a German producer. However, I do not consider this affects the matter one way or the other. I have to consider how the average consumer in the UK market is likely to pronounce the mark on first seeing it. In my view the mark JOWATHERM does not have an obvious Germanic "feel". Even if it did, the British public is notorious for mis-pronouncing such words. The household names VOLKSWAGEN and BRAUN spring to mind. From my own knowledge these well known German owned products are not pronounced in the correct German manner (VOLKS WAGGON and BRAUN respectively and not the more correct VOLKSVAHGEN and BROWN). With this in mind I consider it most unlikely that the UK public will pronounce the applicants' mark in the correct German way other than on rare occasions, even if they were aware of the German origin of the goods. Therefore, in oral use I consider the applicants' mark is likely to be pronounced in the way described by the applicants or, using my own comparison, JOWA to rhyme with TOWER. It is well established that beginnings of words tend to be emphasised and carry more weight. As such I consider the difference between JOWA and NOVA is sufficient to distinguish the marks aurally when compared as wholes.”

19. One obvious difference in this case is that the opponents are not German, but as stated by the Hearing Officer, even if they were I do not consider that this is a material consideration. Purchases are often made by reference to the trade mark and without the consumer knowing or even caring about where they come from. Focussing on the word itself, there is nothing that I can see that would encourage anyone to see MARWIN as a German word and therefore lead them into enunciating it with the letter 'V' in place of the 'W'. But in any event, I am not sure that this line of argument leads anywhere, for if the consumer seeing MARWIN thought it was Germanic and pronounced it as MARVIN, why should they not see MARVIN in the same way and say it as MARWIN?

20. To my mind the "Germanic" argument is no more than a smokescreen obscuring the real argument, which is that whether foreign or English, the natural inclination of a native English speaker is to pronounce a word by reference to its phonetic values. The first syllable of the respective marks is identical, and the second is extremely close in sound. When spoken as a whole, the words MARWIN and MARVIN will sound very similar, particularly taking into account the fact that regard is seldom paid to each letter and syllable, and the tendency to slur the endings.

21. The opponents have sought to establish that it is a boys name, and there is evidence from the Internet that shows this to be the case. The Exhibit from the "baby name finder" provided by iVillage.co.uk states that MARVIN is a boy's name of Teutonic origin and that a nickname for boys with this given name is MARWIN. Pages from the baby names finder section of the Baby Magic website (<http://www.babynamesfinder.co.uk>) list both MARVIN and MARWIN as boy's names but also that MARWIN is a form of MERVIN. There is no evidence that tells me how commonplace the name MARVIN is within the UK. From my

own lack of knowledge I would suspect that it is not that commonplace and that there will not be many people within the UK who will know or have heard of MARWIN in the context of a given name for boys. To my mind the UK consumer will see this as an invented word of unknown derivation. For these reasons I do not consider the respective marks to have any conceptual similarity.

22. In his decision in the *React* trade mark case [2000] R.P.C. 285, Mr Simon Thorley QC sitting as the Appointed Person stated:

“There is no evidence to support Ms Clark’s submission that, in the absence of any particular reputation, consumers select clothes by eye rather than by placing orders by word of mouth. Nevertheless, my own experience tells me it is true of most casual shopping. I have not overlooked the fact that catalogues and telephone orders play a significant role in this trade, but in my experience the initial selection of goods is still made by eye and subsequent order usually placed primarily by reference to a catalogue number. I am therefore prepared to accept that a majority of the public rely primarily on visual means to identify the trade origin of clothing, although I would not go so far as to say that aural means of identification are not relied upon.

23. Although specifically mentioning clothes, the guidance is applicable to any goods that are usually obtained by self-selection. Whilst the circumstances in which the relevant goods and trade marks are encountered by the consumer, particularly at the point at which the purchase is made are an important consideration, the matter must be assessed by applying an assessment of all relevant factors.

24. In summary, I find MARWIN and MARVIN to be similar in look and sound, but not in idea. A finding of similarity is not dependent upon there being a match in all three aspects, and when weighing these factors, particularly in relation to the goods at issue which are of the type more usually purchased by personal selection, I find that these marks are similar.

25. In the case of goods that are traditionally adorned with forenames, such as mugs and bracelets the perception of relevant consumers will be that the name appearing on the item is no more than decoration. In such use a forename will be devoid of distinctive character. In relation to other goods, unless there is another reason, a forename will be considered distinctive and capable of functioning as a trade mark. Other than in the circumstance mentioned above, there is no evidence that MARWIN has any relevance for the goods for which it has been registered. Even in the case of mugs, bracelets, etc., given that I do not consider it likely that the public will recognize MARWIN as a forename, I would take it to be distinctive for such goods. There is no evidence that the opponents (or indeed the applicants) have made any use of their mark. This being the case, there is no basis on which I can infer that the mark has become any more distinctive through its exposure to the public, or that they have established any reputation.

26. The opponents’ objection is directed towards Classes 18, 25 and 28 of the application. These classes of the opponents’ earlier mark, and the application contain the following goods:

| Opponents’ earlier mark CTM 1337484 - MARWIN | Application |
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| Class 18 - Bags, rucksacks, purses, wallets, belts, briefcases, leather and imitations of leather; travelling bags; umbrellas. | 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 25 - Clothing, footwear, headgear. | Class 25 -Clothing, footwear and headgear |
| Class 28 - Games and toys; gymnastic and sporting articles not included in other classes; decorations for Christmas trees (not lighting articles or confectionery). | Class 28 - Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees. |

27. Self-evidently, the opponents’ registration and the application cover the same goods classes, and very much the same goods. Both of the specifications for Class 18 specifically mention “leather and imitations of leather”, “travelling bags” and “umbrellas”, so in respect of these goods there can be no doubt; they are identical. The applicants’ specification also mentions “parasols” which is another form of umbrella, so in respect of this item I do not consider there to be any argument that the specifications overlap in respect of this item.

28. The remaining goods covered by this class of the application consist of “goods made of these materials and not included in other classes”, “animal skins”, “hides”, “trunks”, “walking sticks”, “whips”, “harness” and “saddlery”. Linking the expression “...and goods made of these materials...” to the preceding qualification “leather and imitations of leather” delivers a specification that would encompass any goods found in Class 18 that are made of these materials. It therefore follows that this term must contain identical and/or similar goods to those contained within the corresponding class of the opponents’ earlier mark. Whilst “bags” and “trunks” may be different in nature; bags generally being soft/flexible whereas trunks are rigid, these are goods for the same use/purpose, that meet in the channels of trade, the retail end in particular, and are competitive/complementary products. There can be no doubt that the end user is notionally capable of being the same. In my view, the bags contained within the opponents’ specification, and the “trunks” within the applicants’ specification should be considered to be similar products.

29. The “hides” and “animal skins” of the applicants’ specification are capable of falling within the description of “leather” contained within the opponents’ specification, so again, identical goods are involved. To my mind, “walking sticks” and “umbrellas” may be different in nature, and whilst they may have a different “primary” use, an umbrella may be used as a form of walking stick when not being used for protection from the rain. They meet in the channels of trade, may reach the consumer through the same retail outlet, and whilst not competitive, may be considered to be complementary products. The end user is notionally capable of being the same. In my view, the walking sticks contained within the applicants’ specification, and the “umbrellas” within the opponents’ specification should be considered similar goods.

30. This leaves “whips”, “harness” and “saddlery”. The term “saddlery” would include items such as “saddlebags” which would be covered by the term “bags” within the opponents’ specification. Apart from this, these goods are somewhat different to the goods of the opponents’ earlier mark. However, they are all “leather goods”, and in places such as Tack shops, and Saddlers may be sold alongside items such as bags, walking sticks, purses/wallets. I see no reason why they should not originate from the same manufacturing source and reach the same end users. Whilst not competitive goods, they are complementary items and closely allied to other leather goods. I consider “whips”, “harness” and “saddlery” to be similar goods to those contained within the opponents’ specification.

31. Turning to the specifications for Class 25. The applicants and the opponents both list their goods as “Clothing, footwear, headgear” without any form of qualification. This being the case, I do not see that there can be any argument that in respect of the goods in Class 25 of the application, the opponents’ earlier mark notionally covers the same goods.

32. The overlap in the goods contained within the respective specifications in Class 28 is also plain to see. The applicants’ specification covers “games”, “gymnastic and sporting articles” and “decorations for Christmas trees”, without any limitation as to their nature, use, etc.,. These terms are specifically mentioned in the specification of the corresponding class of the opponents’ earlier mark, again without any limitation, so notionally the goods covered by Class 28 of the respective marks must be identical.

33. In *New Look Ltd v OHIM (NL Sport)* [2005] E.T.M.R. 35, a decision of the Court of First Instance (CFI), it had been held that it was wrong to regard the average consumer in the clothing market as displaying a particularly high level of attention at the point of purchase, for just as clothing varies in price, the attentiveness of the consumer will also vary. The CFI went on to add the caveat that this could not be presumed in the absence of evidence with regard to all goods in that sector.

34. There is nothing particularly surprising about the contention that consumers may be more careful when buying expensive goods, but that does not mean that they will lack circumspection or be less observant when seeking out less expensive items. There are also other factors such as being “fit-for-purpose”, attaining the desired effect, or the need for care, such as in the case of pharmaceuticals that will influence the attentiveness of the consumer regardless of their cost. But in any event, the goods covered by the respective marks are ordinary, everyday items that have not been subjected to any form of limitations, such as by market sector, they notionally cover those from high-end designer labels costing hundreds if not thousands of pounds, to mass-market lines found in high street shops and supermarkets. When taken in conjunction with the guidance in *Lloyd* and *New Look*, this means that the degree to which the consumer will be circumspect and observant ranges from “reasonably” to “highly”.

35. Balancing all of the facts and factors, and particularly taking into account the possibility of confusion through “imperfect recollection”, I come to the view that when circumstances such as the similarity in the respective marks, the identity in respect of the goods, the notional overlap in consumer and trading circumstances are taken into account, it seems to me that should the registered proprietors use their mark in relation to the goods for which it is registered, that this will lead the public to believe, and wrongly so, that the respective goods come from the same or linked undertakings. There being a likelihood of confusion, the

opposition under Section 5(2)(b) succeeds in respect of all goods covered by Classes 18, 25 and 28 of the application.

36. In summary, I find that the opposition against Classes 18, 25 and 28 of the application succeeds. The applicants have one month from the date of this decision in which to appeal against this decision. In the event of there being no appeal, the application will be refused in respect of all goods within these classes, and the application will proceed to registration for the goods contained within the remaining classes.

37. The opposition as founded having been successful, the opponents are entitled to a contribution towards their costs. I therefore order that the applicants pay the opponents the sum of £1,95 0 towards their costs. This sum 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 5th day of April 2007

**Mike Foley
for the Registrar
the Comptroller-General**