

O-341-07

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION  
NO. 2401757 IN THE NAME OF CAROL ANNE GWYNNE  
TO REGISTER THE TRADE MARK CAS AS A SERIES OF THREE MARKS  
IN CLASSES 18 AND 25**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 94112 IN THE NAME OF GROTTO S.P.A**

## **Trade Marks Act 1994**

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No. 2401757 in the name of Carol Anne Gwynne  
to register the trade mark CAS as a series of three marks  
in classes 18 and 25**

**and**

**IN THE MATTER OF opposition thereto  
under No. 94112 in the name of Grotto S.p.A**

### **BACKGROUND**

1. On 16 September 2005, Carol Anne Gwynne made an application to register the trade mark CAS as a series of three marks, the second and third marks in the series being Cas and cas.

2. The application has been made in Classes 18 and 25 in respect of the following specifications of goods:

- |          |                                                                                                                                                                                                                                                                                                                                                      |
|----------|------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| Class 18 | Leather and imitations of leather, and goods made of these materials; straps of leather for bags; trunks and travelling bags; bags; handbags, shopping bags, travel bags, beach bags, purses, wallets, belts, briefcases, articles of luggage, suitcases, cases, vanity cases, tote bags, shoulder bags, sling bags, backpacks, rucksacks, satchels. |
| Class 25 | Articles of clothing, footwear, headgear; shoes, sandals, boots, heels; belts for wear.                                                                                                                                                                                                                                                              |

3. On 3 February 2006, Grotto S.p.A filed notice of opposition to the application, the ground of opposition being as follows:

- |                              |                                                                                                                                                                                                                                                                                                                              |
|------------------------------|------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| <b>Under Section 5(2)(b)</b> | because the mark applied for is similar to the opponent's earlier trade marks, and is sought to be registered in respect of goods that are identical and/or similar to the goods for which these earlier trade marks are registered or pending, such that, there exists a likelihood of confusion on the part of the public. |
|------------------------------|------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|

The opponents rely on four earlier marks, details of which are shown as an annex to this decision.

4. The applicant filed a counterstatement in which she denies the ground on which the opposition is based. Both sides ask that an award of costs be made in their favour.

5. Only the opponents filed evidence, which, insofar as it may be relevant I have summarised below. The matter came to be heard on 14 June 2007, when the opponents were represented by Mrs Gill Smaggasgale of W P Thompson & Co, their trade mark attorneys. The applicant was not represented but during the course of the proceedings filed a letter containing submissions on the opponents' evidence and the substance of the case. I shall take this fully into account in my decision.

### **Opponents' evidence**

6. This consists of two Witness Statements dated 30 October 2006, and 1 December 2006, both from Gillian Helen Smaggasgale, a trade mark attorney with W P Thomson & Co, the opponent's representatives in these proceedings.

7. In her first Statement, Mrs Smaggasgale refers to the earlier marks relied upon by the opponents in these proceedings, details of which are shown as Exhibit GHS1. Mrs Smaggasgale goes on to conduct an analysis focussed on what she sees as the aural, visual and conceptual similarities of the respective marks. Exhibits GHS2 and GHS3 consist of an extract from an on-line dictionary concerning the root identity of the letters C and G, and extracts from various dictionaries giving definitions for the word CAS, respectively. Mrs Smaggasgale states that the latter shows that there is no general acceptance of CAS as being a short form of the girl's names as suggested by the applicant in her Counterstatement.

8. Mrs Smaggasgale goes on to assert that the evidence shows that CAS and Gas are so similar that they must be confusingly similar. In support she refers to Exhibit GHS4, which consists of a print of the results of a search undertaken with a search engine using the search term "cas clothing". Ms Smaggasgale refers to the second of the hits from [www.clogs.co.uk](http://www.clogs.co.uk) that has the heading "Buy Gas Clothing online here", and the extract from that site shown as part of the Exhibit. Mrs Smaggasgale puts this forward as "actual evidence of confusion between GAS and CAS."

9. The remainder of Mrs Smaggasgale's Statement consists of submissions on matters relating to the substance of these proceedings, rather than evidence of fact. As such I do not need to summarise it, but will take these fully into account. Exhibit GHS5 consists of Extracts from the opponents' website, Mrs Smaggasgale stating that it shows "substantial use of the mark" owned by the opponents. Although taken after the relevant date the prints contain historical references to campaigns dating back to 1998. There are references such as Robbie Williams wearing a GAS branded jacket at the 2005 Brit Awards held in February of that year. There are also references to GAS sponsoring high profile sporting events, particularly motorcycle racing which is reflected in some of the clothing, bags, key chains and pass-holders sold under the mark. This Exhibit shows GAS being used alongside the "tick" device and also as a word on its own.

10. Exhibit GHS6 consists of extracts taken from the GAS website that specifically relates to the UK. The first page shows use of GAS with the tick and mentions the GAS store in London. The page also shows that the site contains a function that will find the locations of GAS stores in the UK. The second to fourth pages come from the "Listings" section of a site called "WireImage". As a banner headline dating from 22 April 2004, the site mentions the

opening of a GAS store in London. The remainder of the Exhibit refers to store openings, sponsorships and other corporate events. None of this can be pinned to a particular year. The foot of each page contains the mention “Grotto S.p.A 2001-02. All rights reserved.” which to my mind indicates that the site has been available from that date, but that does not necessarily mean the same of the information it carries. It would, however, be reasonable to infer that the corporate look of the site which uses the “tick and GAS” name has been present since the creation of the site.

11. Mrs Smaggasgale says that in addition to sales via their flagship store, the opponent’s products are also sold through other websites and stores, details of which are provided as Exhibit GHS7. The Exhibit shows the opponents’ GAS branded goods to be sold in high street stores, catalogues and websites, but not that this was the case at the relevant date. Exhibit GHS8 includes a print from the Rubbermag.com website that contains details of the launch of Honda GAS fashion and accessory collection for 2004/2005. It also refers to GAS as having been a sponsor of Repsol Honda MotoGP since 1998. A print from the Biker 24/7 website contains similar details, and articles dating from October 2004 relating to the GAS JEANS merchandise collection. Exhibit GHS9 consists of various news announcements relating to the opponents and their GAS branded products; all post-date the relevant date and cast no light backwards.

12. In her second Witness Statement, Mrs Smaggasgale provides a register extract for CTM882548, noting that this confirms registration took place on 20 November 2000, within five years of the publication of the acceptance of the application in suit. Ms Smaggasgale confirms that the picture of Robbie Williams shown as part of Exhibit GHS5 was taken at the 25<sup>th</sup> Annual Brit Awards held on 10 February 2005. She further confirms that the reference to the opponents’ sponsorship of Southport Weekender in 2002 involved the extensive display of the opponents’ mark. Mrs Smaggasgale mentions that the International Motorcycle and Scooter Show referred to in Exhibit GHS7 included a fashion show that took place 6 times daily, and included the GAS Autumn/Winter 2004/05 collection.

13. Mrs Smaggasgale goes on to refer to Exhibit GHS11, which consists of a collection of invoices dating from October 2000 to February 2001, by which Grotto S.p.A provided clothing to Gas Clothing UK Ltd. The invoices do not mention GAS in the product information, but the “tick and GAS” mark is shown in the top right-hand corner. Exhibit GHS12 consists of a photograph of a shirt, the trade mark GAS being shown on the pocket, and a “partial listing of invoices for sales of this product in the period 2000 to 2003”, Mrs Smaggasgale saying that the code 12 appearing in the column Tipo Doc relates to sales in the UK. Exhibit GHS13 consists of an extract from the opponent’s Autumn/Winter collection 96/97. Mrs Smaggasgale says that although the opponents’ store was not open at that time, the catalogue was distributed in the UK. The GAS trade mark can be seen on a rucksack, beret and a boot, the Exhibit also including an invoicing list for products, Mrs Smaggasgale highlighting the coding for UK sales. Exhibit GHS14 consists of an extract of the opponents’ Spring/Summer 2000 and Autumn/Winter 2000/2001 Basic Collections, the final page of the latter having a list that confirms the opponents’ have a representative in the UK. That concludes my summary of the evidence insofar as it is relevant to these proceedings.

## DECISION

14. The opposition is founded on Section 5(2)(b), which 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.”

15. An earlier trade mark is defined in Section 6 of the Act as follows:

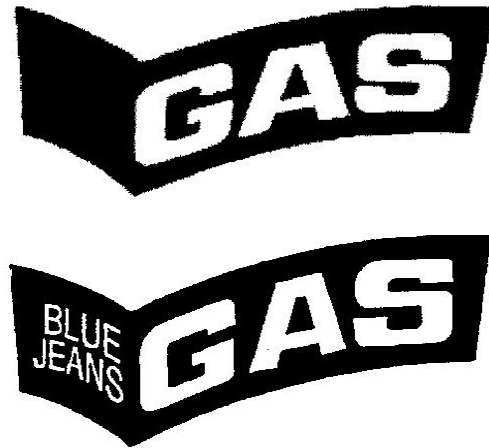
“6.- (1) In this Act an “earlier trade mark” means:

(a) a registered trade mark, international trade mark (UK), 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,”

16. In my determination of the likelihood of there being confusion or deception I will take into account the case law of 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] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723. The guidance provided by these cases has been set out in many decisions and is well know. Therefore, I do not propose to set this out in detail.

17. The opponents rely on four earlier trade marks, all but one of which achieved registration no more than five years prior to the date on which the application in suit was published. In the case of the mark that became registered more than five years prior to the publication of the application, the provisions of Section 47(2)(A) introduced under The Trade Marks (Proof of Use, etc.) Regulations 2004 apply. For the reasons that I give below I do not intend to base my decision on that mark, and accordingly, see no need to consider whether, and to what extent, that mark satisfies the requirements of Section 47(2)(A).

18. One of the opponent’s earlier marks is for the word GAS in plain script. A second mark consists of the word GAS contained within a solid black “tick”, the remaining two consisting of the words “GAS” and “BLUE JEANS” contained within the same “tick”. The three marks within the “tick” device look as follows:



19. As far as I am aware, and there is no evidence to the contrary, GAS is a word with no relevance for the goods for which it has been registered; it is a word with a strong distinctive character. It is, in my view also the dominant element within these marks. A “tick” device is not the most distinctive of figurative elements, and whilst it clearly contributes to the visual impact of the marks, it acts more of a backdrop to the textual elements than as a clear distinguishing feature, and particularly so in the second version. Self-evidently the words “BLUE JEANS” are wholly descriptive and will be regarded as such by the consumer. It is generally accepted that in marks composed of figurative and textual elements, it is the words that will be used as the point of reference by the consumer, that is unless the words are obviously no more than a description of the goods, such as in BLUE JEANS. To my mind the opponent’s marks should all be considered as GAS marks.

20. As I have said, the dominant and distinctive element of the composite marks is the word GAS, and if there is any similarity in the appearance of these earlier marks and the marks CAS/Cas/cas, it rests in this word. Two of the opponent’s earlier marks, for the word GAS, and the word GAS within a tick include goods in Classes 18 and 25, the same classes covered by the application. The other two composed of the tick device with the words GAS and BLUE JEANS cover one or other of the classes of the application. Mrs Smaggasgale quite sensibly submitted that the opponent’s best case rests on their word mark for GAS, and if they do not succeed in respect of this they are unlikely to do so in respect of the other marks. The caveat I would add to this would have been that this may change if it turned out that through use the composite marks had acquired a level of distinctiveness and reputation in excess of the word GAS solus. On my assessment that is not the position.

21. Some of the goods at issue here are articles of clothing. In his decision sitting as the Appointed Person in the *React* trade mark case [2000] R.P.C. 285, Mr Thorley 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.”

22. This case indicates that how the goods are obtained, be it by self selection or request from an assistant is a material consideration. The decisions in *Claudia Oberhauser v OHIM (Fifties)* [2003] E.T.M.R. 58, and *Criminal Clothing Ltd v Aytan’s Manufacturing (UK) Ltd*, [2005] EWHC 1303 also indicates that 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 is an important consideration. However, the matter must be assessed by a consideration of all relevant factors. So although the selection of clothes, and I would also say goods such as handbags, luggage, belts, etc, is a visual act that places most importance on the appearance of marks, this does not negate the need also to consider and balance the aural and conceptual similarities.

23. On a visual comparison there is obviously some similarity between GAS and CAS. They are the same length, have the second and third characters in common, and share a similarity in the shape of the first letter. On a quick, casual inspection it could be said that these marks could be visually similar, but the consumer is considered to be reasonably observant and circumspect. Taking into account the fact that these are very short words where small differences have a disproportionate impact, I consider these words to be visually distinct.

24. Considering now these marks from the point of view of their appeal to the ear. Both start with a strong consonant. The syllable that follows may sound the same in both marks but the dominance of the hard first consonant gives the words a different sound. In my view these are aurally different marks.

25. In the submissions provided by her representatives, the applicant disputes that there is any visual or aural similarity between the respective marks, but to the extent that there may be found to be, this is completely outweighed by the strong conceptual differences between GAS and CAS. In support they refer to *Picasso v Picarro* (Case C-361/04 P). The opponent’s mark GAS is an ordinary English word with a meaning that will be familiar to most consumers as denoting something vapour like, such as that used by cooking and heating apparatus. It has other, less familiar meanings, mostly of American origin. The applicants argue that their mark CAS is often used as an abbreviation or shortened form of the female forename Carol, Carolyn, Caroline or Cassie, but is otherwise “utterly meaningless.” It may well be that some will see it as such an abbreviation; I do not know and there is no evidence to assist me. I consider it to be more likely that the majority of consumers will see it as I do, that is as an invented word. Whatever is the case, the message or idea conveyed by the respective marks will be different.

26. Balancing the points for and against a finding of similarity, I find that these are marks that are not similar.

27. In *New Look Ltd v OHIM (NL Sport)* [2005] E.T.M.R. 35, a decision of the Court of First Instance (CFI), it was 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, but 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. Whilst I have no argument with the contention that consumers may be careful when buying expensive goods, that does not mean that they will lack circumspection or be any less observant when seeking out inexpensive items. But in any event, even though the goods covered by the respective marks are ordinary if not everyday items, as they are not limited to any particular 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”. The lack of any form of limitation to the specifications also means that the channels of trade from manufacture to the retailers will notionally be the same, as will the end consumer.

28. The question of whether the respective goods are similar is relatively easy to answer. Both have goods in Classes 18 and 25. In Class 18 the application covers “leather and imitations of leather, and goods made of these materials; straps of leather for bags; trunks and travelling bags; bags; handbags, shopping bags, travel bags, beach bags, purses, wallets, belts, briefcases, articles of luggage, suitcases, cases, vanity cases, tote bags, shoulder bags, sling bags, backpacks, rucksacks, satchels.” The opponents’ earlier mark includes “leather and imitations of leather and goods made of these materials and not included in other classes” and various specific items such as “trunks and travelling bags”. The general expression “leather and imitations of leather and goods made of these materials and not included in other classes” effectively covers all goods in Class 18 that are made of leather or imitations of this material, including those covered by Class 18 of the application. Identical goods are involved here.

29. The position is the same in respect of Class 25. The application covers “articles of clothing, footwear, headgear; shoes, sandals, boots, heels; belts for wear.” The opponent’s earlier mark is in respect of “clothing, footwear and headgear”. Self-evidently, “articles of clothing” and “clothing” cover identical goods. The same is the case for “footwear”. The “headgear” and “belts” in the application describes a subset of “clothing” so are included in the specification of the opponents’ earlier mark. The remainder of the goods in this class of the application are all items of footwear so are also covered by the opponent’s earlier mark. All of the goods of Class 25 of the application are identical to, and covered by the opponents’ earlier mark.

30. I have already said that GAS is a mark that has a strong distinctive character in relation to the goods in Classes 18 and 25, the goods that are at the centre of this dispute. Having found this mark not to be similar to the applicants’ mark, whether in the same upper case style or some other form, the question of whether the opponents’ have a reputation or have enhanced the distinctiveness of their mark through the use they have made of it is essentially academic. For the record I consider that although lacking in real detail, the evidence in my view shows the opponents to be a high profile brand with a strong reputation for quality clothing and related accessories. Even so, this does not give grounds for presuming a likelihood of confusion, and particularly so given my finding that the respective marks are not similar.

31. Mrs Smaggasgale asserts that the results from an Internet search (Exhibit GHS4) using the search term “cas clothing” is “actual evidence of confusion between GAS and CAS is present.” I do not agree. All that this potentially shows to me is that the parameters on



which the search has been done may well have included letter substitution, placed focus on any single word within the search string, or hit on the use of the opponents' GAS trade mark as a metatag.

32. Taking all of the factors into account and adopting a global approach as the case law requires. I come to the position that I do not consider that there is a likelihood that a member of the public, aware of the opponent's mark and its use and/or its reputation, on seeing the applicant's mark being used in connection with the goods for which registration is sought, will be led into believing that that the respective goods come from the same or an economically linked undertaking. This is my view even when the potential for confusion through an imperfect recollection is taken into account. I find that there is no likelihood of confusion and the opposition under Section 5(2)(b) is dismissed.

33. The opposition having failed, the applicant is entitled to a contribution towards her costs. I therefore order the opponents pay the applicant the sum of £1,750. 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 19<sup>th</sup> day of November 2007**

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