

O-265-09

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2468311
BY JUSTIN DEAKIN TO REGISTER THE TRADE MARK**

DUSKIN

IN CLASS 25

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 96934
BY JACOBS & TURNER LTD**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No. 2468311
By Justin Deakin to register the trade mark
DUSKIN in Class 25**

and

**IN THE MATTER OF Opposition thereto under No. 96934
by Jacobs & Turner Ltd**

BACKGROUND

1) On 2nd October 2007 Justin Deakin of 6 Tinshill Avenue, Leeds, West Yorkshire LS16 7BD (hereafter “Deakin”) applied to register the following trade mark:

DUSKIN

2) The application is in respect of “ clothing, footwear and headgear” in class 25.

3) On 25th January 2008 the application was published for opposition purposes and on 24th April 2008, Jacobs & Turner Ltd of Vermont House, 149 Vermont Street, Kinning Park, Glasgow G41 1LU (hereafter “Jacobs”) filed notice of opposition. The opposition is solely based on grounds under Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”).

4) Jacobs rely on two earlier registrations, firstly, Community Trade Mark (“CTM”) 1127745. The details of this trade mark are:

Trade Mark	Filing and registration dates	Specification
DUOSKIN	25 th March 1999 and 4 th October 2000 respectively	Class 24 Fabrics; textiles; linings; textile piece goods

5) The details of the second earlier mark, being UK registration 2192864, are:

Trade Mark	Filing and registration dates	Specification
DUOSKIN	25 th March 1999 and 3 rd December 1999	Class 24 Fabrics; textiles; linings; textile piece goods, all consisting of a single layer.

6) In their statement of case, Jacobs say their respective marks have been used on fabrics, textiles, linings and textile piece goods, all for the use in the manufacture of clothing. They are concerned that Deakin's use of the mark DUSKIN for clothing, footwear and headgear will cause confusion in the marketplace as the marks only differ by a single letter, O, in the middle. They wrote to Deakin on 9th April seeking amicable settlement but this was rejected.

7) Deakin, who is unrepresented, filed a counterstatement on 9th July 2008 saying that his mark was applied for clothing, footwear and headgear and the use was different to that of Jacobs. He says he has used "both sections of his name and will be using it [the trade mark applied for] as a diffusion line for footwear and possibly clothing in conjunction with his main project."

8) Jacobs did not file any evidence. Deakin's submission dated 17th April 2009 was apparently intended to be filed as evidence but did not comprise a witness statement or statutory declaration, and accordingly could not be accepted into proceedings as evidence in accordance with rule 64 of The Trade Marks Rules 2008. An invitation to correct matters was extended to Mr Deakin but in the event he did not take up the invitation. In all respects however the material received in 17th April 2009 from Mr Deakin was not evidence of fact but submission and I will therefore treat it as such. The registry's case worker, by letter 4th June 2009, confirmed to both parties that the intended evidence will be treated as submission.

9) Neither party asked to be heard. Jacobs filed a written submission dated 15th July 2009 and Deakin's intended evidence is, as I have said, being treated as submission. Both submissions will be taken into account in my decision. Both parties ask for an award of costs. I make this decision after careful consideration of the papers.

DECISION

Section 5(2) (b)

10) The opposition is founded upon Section 5(2) (b) of the Act. This reads:

“(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, the relevant parts of which state:

“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,

12) Of potential relevance to a ground of opposition under Section 5(2) are the provisions that relate to proof of use. Section 6A(1) details the circumstances where these provisions apply:

“6A Raising of relative grounds in opposition proceedings in case of non-use

(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.”

13) With registration dates in 2000 and 1999 respectively, it is clear that within the meaning of Section 6(1) of the Act, both Jacobs's marks are earlier trade marks. Further, as both completed their registration procedures more than five years before the publication of the contested mark (being 25th January 2008), both are subject to the proof of use requirement set out in section 6A of the Act. However, in his counterstatement Deakin has neither expressly put Jacobs to proof of their use (for which he was required to indicate and answer the questions in the relevant boxes 5 and 6 on the counterstatement form), nor has he otherwise denied that use. In my view the lack of a specific denial or non-admittance of the statements of use, together with the failure of Deakin to answer the questions on the counterstatement form, mean that Jacobs is not required to substantiate its statement of use. **Consequently, the statement of use stands as the goods to be utilised for the purposes of this opposition. Jacobs has declared use in its statement of case for the following “fabrics, textiles, linings and textile piece goods, all for the use in the manufacture of clothing”. It is thus these goods only which will form the basis of the opposition.**

14) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law 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] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). 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 Adidas 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.*,

(k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

(l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*

The average consumer

15) As matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, paragraph 23) it is important that I assess who the average consumer is for the goods at issue, and whether there is anything about the nature of transactions under the respective marks that may lead me to conclude

that the average consumer is other than someone “deemed to be reasonably well informed and reasonably circumspect and observant” (see authority (b) in para 14 above).

16) The average consumer for the goods covered by both Jacobs’s marks will, it must be assumed, be manufacturers of clothing. That is, the trade. There is no evidence from Jacobs that their mark is used in respect of finished garments in such a way that the final purchaser (whoever that may be) will be aware of it, or for that matter, as to the nature and user of those ‘finished’ garments. There is a submission by Jacobs’s attorneys that some clothes are made with detachable linings which may carry the manufacturer’s trade mark, but this is not backed by evidence and as such I do not find this submission to be persuasive. In such a case (absent evidence), it would be wrong to assume that exposure of Jacobs’s mark will inevitably be broader in terms of consumer type than clothing manufacturers.

17) Submissions on behalf of Jacobs say I should have regard to both the man or woman in the street who purchases clothing or fabric and also to traders who may purchase fabrics, textiles or linings to manufacture clothing etc. However, I have already concluded that Jacobs’s goods are limited by the term “all for the use in the manufacture of clothing”, which is contained in the statement of use filed by Jacobs. It must be assumed from Deakin’s specification that it comprises finished goods in class 25, and on that basis I conclude that the average consumer for his goods will be the general public. It is true that wholesalers and retailers will also come into contact with finished clothes and thus comprise an additional average consumer group for Deakin’s goods. But they, like the general public, are not in the main manufacturers which is the group that Jacobs serves. Given these conclusions I do not believe it right to conclude that the average consumer for both parties’ would be the same or drawn from the same pool of people. On the contrary, the average consumers will be different. As I have made that conclusion, the particular levels of attention which may be brought to bear on the respective purchases of both parties’ goods are irrelevant.

Comparison of goods

18) The goods to be compared are:

Deakin’s goods	Jacobs’s relevant goods
Class 25 Clothing, footwear and headgear	Class 24 Fabrics, textiles, linings and textile piece goods, all for the use in the manufacture of clothing

19) In assessing the similarity of goods, it is necessary to apply the approach advocated by case law and to take account of all the relevant factors relating to

the services in the respective specifications. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the ECJ stated at para 23 of the Judgment:

‘In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their end users and their method of use and whether they are in competition with each other or are complementary.’

20) Other factors may also be taken into account such as, for example, the distribution channels of the goods concerned (see, for example, paragraph 53 of the judgment of the Court of First Instance (CFI) in Case T-164/03 *Ampafrance v OHIM – Johnson & Johnson (monBeBé)*).

21) It is true that textiles and fabrics, e.g. cotton or woollen fabrics are used for manufacturing clothing articles. However, this mere fact is insufficient to establish similarity between them. As required by the case law referred to, other factors need to be considered, in particular the relevant public and the needs the products are intended to satisfy. On both counts, textiles, fabrics and linings and clothing are not similar. As I have already said in relation to the average consumer, textiles, fabrics and linings are intended for professionals in the trade who will work them into finished products such as clothing. On the other hand, clothing articles are ready to be used and destined, as such, for a much broader public, namely people in need of new clothes. As to the purpose, textiles, fabrics and linings are used as components to make other products, while clothing articles serve the purpose of dressing up persons. Furthermore, such finished or semi-finished goods cannot be regarded as complementary. I should explain that the European Courts have developed the concept of goods being complementary, in the sense that they are closely connected, so that one is indispensable or important for the use of the other, and as a result consumers may think that the same undertaking is responsible for the production of both goods (see eg Court of First Instance (“CFI”) case T-169/03 *Sergio Rossi v OHIM*). As I have already said the respective average consumers in this case are not the same and therefore the concept of complementarity cannot apply here. Furthermore, the respective goods cannot be said to be in competition with each other. And finally, neither would their distribution channels or their sale outlets be the same.

22) I should remind myself however that in para 16 above, in submissions on behalf of Jacobs, special mention is made of ‘linings’. The submission is that it is reasonably common for some items of clothing to have detachable linings and such linings may, quite properly, carry the manufacturer’s trade mark. As I have also said, absent evidence on this point I do not find the submission persuasive.

23) Taking things in the round, I conclude that the respective goods are not similar, or if they are, it is only at the lower end of similarity.

Comparison of marks

24) The respective marks are as below:

Jacobs's mark	Deakin's mark
DUOSKIN	DUSKIN

25) In conceptual terms, the DUOSKIN mark will, I believe, be taken to comprise two identifiable elements, DUO and SKIN. This is because in relation to the goods of Jacobs's specifications, I think it highly probable that the concept the consumer will take to underlie the word DUOSKIN is that the textile, fabric or lining is double layered in some way. This is irrespective of whether it is in fact. There is no obvious concept behind the word DUSKIN. It may possibly be seen as a name but this is conjecture and it would be equally plausible that it would be seen as an invented word. I am not convinced by Deakin's submission of 17th September 2009 that it would in some way be seen as relating to 'night fall'. If the goods concerned were, eg sleep related, that may be the case, but for clothing, footwear and headgear I am not convinced. Nonetheless I agree that the single letter difference in this case makes for conceptual dissonance. The proper finding here, and the one I make, is that the marks are conceptually different. I find support for this in, eg the CFI case T-112/06, *Inter-Ikea Systems BV v OHIM* where the CFI said at paras 70 and 71:

“70 It should be pointed out in that regard that, according to the case-law, there can be no conceptual similarity between a mark which conveys no clear meaning in any of the official languages of the European Union and another mark of which the verbal element generally carries actual meaning for the public of the Community (see, to that effect, Case T-355/02 *Mühlens v OHIM – Zirh International(ZIRH)* [2004] ECR II-791, para 46, and Case T-3/04 *Simonds Farsons Cisk v OHIM – Spa Monopole(KINJI by SPA)* [2005] ECR II-4837, para 53).

71 Accordingly, it must be held that the conflicting signs are conceptually dissimilar.”

26) Visually, the marks differ with the letter 'O' in the middle of Jacobs's mark which is absent in Deakin's mark. On the face of it this single letter difference would suggest a high level of visual similarity. The words both start with the same letters 'DU' and end with the same letters 'SKIN'. That said, taking account of my finding in relation to conceptual difference between the two marks, I believe that Jacob's mark will be as the two words DUO and SKIN conjoined. On the other hand Deakin's mark has no such natural meaning and will then be seen as a single word. As such, the conceptual identity of the respective marks impacts upon their visual impression,

resulting in a lower level of visual similarity than a single letter difference may have at first suggested. Accordingly I find that the respective marks share only a reasonable level of visual similarity.

27) Aurally, Jacobs's marks are most likely to be pronounced DUO – SKIN. If pronounced properly, the middle letter 'O' is not likely to be lost or otherwise submerged by the surrounding letters. The elements DUO and SKIN are comprehensible separately, and it is not likely in my opinion that the consumer would pronounce the single word as if there were a break elsewhere, eg DUOS-KIN or DU-OSKIN. Deakin's mark does not clearly comprise separate recognisable elements and therefore would in my view be pronounced as it is written, DUSK-IN or DUS-KIN, rather than DEW-SKIN as is suggested in submissions on behalf of Jacobs. For the word to be pronounced DEW-SKIN, in my opinion it would have to be spelt either as DEWSKIN or DUESKIN. I conclude there is only a low to reasonable degree of similarity in terms of aural comparison.

28) Bringing the visually, aural and conceptual elements together, I find that overall there is only a low level of similarity. The reasonable level of visual and aural similarity is to a large extent counter-balanced by the conceptual dissimilarity.

Use and distinctive character of the earlier trade mark

29) Before I bring my findings together in an overall assessment, I have to consider whether Jacobs's marks have a particularly distinctive character, either arising from the inherent characteristics of the trade marks or because of the use made of them.

30) As there is no evidence of use from Jacobs I have only the inherent characteristics of the earlier mark to consider. I have already said that the word DUOSKIN comprises two recognisable elements as far as textiles, fabrics and linings are concerned, the element DUO and the element SKIN. They have been conjoined in a single word DUOSKIN. Whilst one may say this is an invented word, plainly it is derived from two recognisable elements, neither of which separately would be particularly distinctive as far as textiles, fabrics and linings are concerned. On that basis I conclude that the earlier mark has only a low level of distinctiveness.

Likelihood of confusion

31) The various findings I have arrived at above need now to be factored into an overall assessment of likelihood of confusion. I need to adopt a global approach, which takes into account 'imperfect recollection' on the part of the consumer, as advocated by the ECJ in *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* In making that assessment, I am conscious that neither side has filed any evidence on this case, and particularly no evidence that would establish that the earlier mark is or is likely to be exposed to the same group of consumers as the mark which is the subject of the application. The best the parties could offer on

this question was the unsubstantiated assertion in submissions by Jacobs's attorneys which spoke specifically of detachable linings used in clothing which carry the manufacturer's trade mark. As I have said however, this needed to be proven in evidence to be persuasive.

32) Bringing my conclusions together, in particular, the absence of similarity between the goods, or at best only a low level of similarity, and only a low level of similarity in the marks, I find there is no likelihood of confusion.

33) I would just add, for the benefit of any doubt, my conclusion would have been the same even if, contrary to my finding in relation to the goods, they were found to be more closely similar (or even identical), and/or evidence from Jacobs had been forthcoming in relation to the linings issue. This is because of my finding in this case that there is a low level of similarity between the marks. In this respect, the clear conceptual difference between the marks is particularly telling. Even if the respective goods were to share the same relevant consumer, the differences between the marks are likely to be sufficient to avoid direct or indirect confusion by the relevant consumer.

34) In light of my findings, the opposition to the application under section 5(2)(b) fails in its entirety.

Costs

35) Deakin is successful and is entitled to a contribution towards his costs. I take account of the fact that that the decision has been reached without a hearing taking place. In the circumstances I award Justin Deakin the sum of £400 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

1. Considering Notice of Opposition - £ 100
2. Preparing and filing counterstatement - £100
3. Intended evidence but taken to be submission – £200

Total £400

36) It should be noted that in this breakdown of costs, the sums awarded represent no more than two thirds of what I may otherwise have awarded. This reflects the fact that the applicant has not had legal representation in these proceedings. The Civil Procedure Rules state at Part 48.6:

“48.6-(1) This Rule applies where the court orders (whether by summary assessment or detailed assessment) that costs of a litigant in person are to be paid by any other person.

(2) The costs allowed under this Rule must not exceed, except in the case of a disbursement, two-thirds of the amount which would have been allowed if the litigant in person had been represented by a legal representative.”

37) I order Jacobs & Turner Ltd to pay Justin Deakin the sum of £400. The sum should 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 7th day of September 2009

**Edward Smith
For the Registrar,
the Comptroller-General**