

O-318-09

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2487556
IN THE NAME OF H YOUNG (OPERATIONS) LTD

AND

OPPOSITION THERETO UNDER NO 97876
BY BLUE MAX GROUP LTD

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IN THE MATTER OF application
No. 2487556 in the name of
H Young (Operations) Ltd and
opposition thereto under No 97876
by Blue Max Group Ltd

Background

1. Application No. 2487556 is for the mark MATCHTEK. The application was filed on 15 May 2008 and stands in the name of H Young (Operations) Ltd (“Young”). The application seeks registration in respect of the following goods:

Class 18

Luggage designed for fishing, including bags, cases, boxes, luggage, sports bags, holdalls, carryalls, ruck bags, rucksacks; parasols, umbrellas and umbrella shelters.

Class 25

Articles of waterproof outer clothing, t-shirts and shirts, fleece and leisure jackets, headwear and footwear; all designed for angling.

2. Following publication of the application in the *Trade Marks Journal* on 5 September 2008, Notice of Opposition was filed on behalf of Blue Max Group Limited (“Blue”). There is a single ground of opposition, under Section 5(2)(b), based on Blue’s Community Trade Mark No. 5479621 for the mark MAXTECH which is protected for *clothing, footwear, headgear* in class 25. The mark has a registration date of 12 September 2007 and thus, whilst it is an earlier mark, it is not subject to the proof of use requirements of Section 6A of the Act.

3. Young filed a counterstatement essentially denying the ground of opposition but admitting that there is similarity in respect of the goods in class 25.

4. Both parties filed evidence and the matter came before me for a hearing on 24 September 2009. Young neither attended nor was it represented though written submissions were filed in lieu of attendance by Murgitroyd & Co, its legal representatives in these proceedings. Blue was represented by Mr Alan Fiddes of Urquhart-Dykes & Lord LLP who also filed skeleton arguments. Young filed a further letter (dated 22 September 2009) pointing out a number of typographical errors in Blue’s skeleton argument.

Evidence

Blue’s evidence

5. Blue’s evidence takes the form of a witness statement by David Fawcus who has been CEO of the company for some fifteen years. Mr Fawcus states that Blue was incorporated in 1987 and is a family run business specialising in the sale of

schoolwear, leisure garments and workwear directly to high street retailers, trade printers and embroiderers. As DF1 he exhibits a copy of the certificate of incorporation for the company.

6. Mr Fawcus states that Blue has used its mark MAXTECH since January 2007 and that it is used “as a brand name for performance and moisture management fabric” used in relation to jackets and football kits. Blue has expanded use to rugby shirts and intends to further expand its product range under the mark. Approximate turnover under the mark along with the quantities of the respective garments sold are given as follows:

Year	Jackets (quantity)	Football kits (quantity)	Total Turnover
2007	£83,694 (7,905)	--	£83,694
To 21 November 2008	£91,373 (7,494)	£28,634 (7,627)	£120,007

7. Mr Fawcus states that approximately £10,000 has been spent on advertising and marketing under the mark since it was first used. He introduces the following exhibits:

- DF2: A swing tag as used in relation to jackets
- DF3: 2007 Brochure showing use of the mark on Blue’s Exmoor range of jackets
- DF4: 2008 Brochure showing use of the mark in relation to jackets and football kits
- DF5: 2009 Brochure
- DF6: Copies of advertisements appearing in 2007 and 2008 editions of “Printwear and Promotion” and “Images” described as “two leading journals for the decorated garment industry”

8. Clearly some of Mr Fawcus’ evidence post-dates the relevant date in these proceedings.

Young’s evidence

9. Young’s evidence takes the form of a witness statement of Michael Derek Robinson who describes himself as the MAP brand manager at Leeda, the UK’s largest distributor of fishing tackle. He explains that Leeda is a division of Young and a wholly owned subsidiary of H Young Holdings PLC. He has been employed by Leeda for some 3 years.

10. Mr Robinson states that the mark MATCHTEK was first used in the UK in January 2001 by Leeda in relation to fishing poles, fishing rods, fishing nets and landing net handles and, in 2004, in relation to waterproof clothing. He gives no details of when the mark was first used in relation to the goods covered by the class 18 specification. He gives the following details of total turnover under the mark:

Year	Turnover
2008	£12,000
2007	£42,000
2006	£217,000
2005	£211,000
2004	£278,000

11. Mr Robinson states that approximately 13% of each figure relates to waterproof clothing designed for fishing which, by my calculation, leads to turnover for these goods ranging from £36000 to £1500 for the above periods. As presented, the turnover figures would appear to indicate a declining trade.

12. Advertisements under the mark are said to have been placed in specialist magazines e.g. Match Fishing Magazine, Advanced Pole Fishing Magazine, Angling Times and Improve your Coarse Fishing. It has also been promoted in consumer brochures and on in-store posters and flyers distributed to retailers. The total spent on advertising since 2001 amounts to approximately £20,000 with £3,000 of that figure being spent in each of the years 2006 and 2007 and £6000 in 2008. No details are given of advertising spend in relation to clothing alone, nor to the goods covered by the specification in class 18.

13. Mr Robinson states that goods are distributed to retailers throughout the UK and that he is not aware of any instances of confusion with Blue. He introduces the following exhibits:

- MDR1: Extract from Leeda 2004 catalogue showing use of its mark in respect of waterproof clothing
- MDR2: Examples of the type of clothing sold under the mark along with a MAP 2005 catalogue
- MDR3: Leeda 2007 catalogue showing waterproof clothing
- MDR4: MAP 2008 catalogue showing waterproof clothing
- MDR5: MAP 2009 catalogue showing waterproof clothing and luggage for fishing

14. Again, some of Mr Robinson's evidence post-dates the relevant date in these proceedings.

15. No further evidence was filed by either party.

The objection under section 5(2)(b)

16. This section of the Act 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.

17. In determining the question under Section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel v Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R 77 and *Marca Mode CV v Adidas AG* [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*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question: *Sabel BV v Puma AG*, paragraph 23, 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 he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen B. V.* paragraph 27;
- (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*, paragraph 23;
- (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*, paragraph 23;
- (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 v Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (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*, paragraph 24;
- (g) 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*, paragraph 26;
- (h) 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*, paragraph 41;

- (i) 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*, paragraph 29.

18. In essence the test under Section 5(2)(b) is whether there are similarities in marks and goods which, when taking into account all the surrounding circumstances, would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements and taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed.

Comparison of goods

19. In its counterstatement, Young concedes that similar goods are involved as far as the application in class 25 is concerned. In my view the respective good in class 25 are not just similar, but identical. It is well established that goods can be considered as identical when those covered by an earlier mark are included within a wider term of a later mark, and vice versa (see *Gérard Meric v OHIM Case T-133/05*). As to the application in class 18, Young denies the goods in class 18 are similar to those in class 25 and puts Blue to strict proof. For its part, Blue claims the goods are similar “since these goods are commonly sold in the same outlets as, and are complementary to, the class 25 goods”.

20. For ease of reference, the remaining goods to be compared are:

Blue	Young
<i>Clothing, footwear, headgear</i>	<i>Luggage designed for fishing, including bags, cases, boxes, luggage, sports bags, holdalls, carryalls, ruck bags, rucksacks; parasols, umbrellas and umbrella shelters</i>

21. In determining whether there is similarity of goods, and following the established tests in *Canon (supra)* and in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281 the relevant criteria for assessing similarity between goods are:

- (a) the respective uses of the respective goods;
- (b) the respective users of the respective goods;
- (c) the physical nature of the goods;
- (d) the respective trade channels through which the goods reach the market;
- (e) in the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) the extent to which the respective goods are competitive, taking into account how goods are classified in trade or are complementary.

22. Young comments that its goods are specialist ones sold in the fishing/angling market whereas Blue's are sold, primarily to high street retailers. I do not think this separates the market in any way as, despite the well documented homogenisation of high streets, I have no doubt that specialist stores still appear on them. Furthermore, whilst Blue may have used its mark on relatively limited types of clothing to date and sold it through fairly limited types of outlet, there is nothing to prevent it expanding its range and either selling goods under its mark in a different market or selling its registration to another who may do so. I am required to consider the issue on a notional basis across the whole range of goods as registered and applied for and not just on the goods on which the marks have been used.

23. I therefore go on to consider the matter further taking into account the relevant criteria as set out above.

24. *Clothing, footwear and headgear* are items which are intended to be worn on the person to cover and/or protect the wearer from the elements. They are made from a wide variety of materials and fabrics appropriate to the specific article. The goods for which registration is sought in class 18 may be made from the same or closely similar materials but *luggage designed for fishing, including bags, cases, boxes, luggage, sports bags, holdalls, carryalls, ruck bags and rucksacks*, are intended to provide a means of (temporary) storage as well as a means of transport for any number of items from one place to another. Thus these respective goods have different functions. Like *clothing etc., parasols, umbrellas and umbrella shelters* also provide a person with protection from the elements although they differ from *clothing etc.* in that they do not provide that protection by being worn.

25. All of the respective goods may be used by the general public though all of the goods in class 18 which are *designed for fishing* are more likely to be used by those who actually take part in the popular activity of fishing.

26. In *El Corte Inglés SA* (T-443/05) the Court was required to make a comparison between goods in classes 25 and 18. It stated:

“49. Goods such as shoes, clothing, hats or handbags may, in addition to their basic function, have a common aesthetic function by jointly contributing to the external image (“look”) of the consumer concerned.

50. The perception of the connections between them must therefore be assessed by taking account of any attempt at coordinating presentation of that look, that is to say coordination of its various components at the design stage or when they are purchased. That coordination may exist in particular between clothing, footwear and headgear in class 25 and the various clothing accessories which complement them such as handbags in class 18. Any such coordination depends on the consumer concerned, the type of activity for which that look is put together (work, sport or leisure in particular), or the marketing strategies of the businesses in the sector. Furthermore, the fact that the goods are often sold in the same specialist sales outlets is likely to facilitate the perception by the relevant consumer of the close connections between them and strengthen the perception that the same undertaking is responsible for the production of those goods.”

27. In my view, manufacturers of leisure and sporting goods increasingly make co-ordinated ranges of clothing and luggage and I see no reason why this should not also apply to those goods designed for fishing. Indeed Young's own evidence shows both clothing and luggage to be available in more than one, co-ordinating, colour. The goods are used together and sold in the same specialist outlets (again, as shown by Young's own evidence) and, to that extent, are complementary goods. As regards *parasols, umbrellas and umbrella shelters*, I have no evidence that these are regarded, either in the trade or by the purchasing public, as part of any coordinated range and, in my view, these are not complementary goods.

28. In summary, I find that *luggage designed for fishing, including bags, cases, boxes, luggage, sports bags, holdalls, carryalls, ruck bags and rucksacks* are similar to a moderate degree to the goods of the earlier mark in class 25. I find there is no similarity in respect of *parasols, umbrellas and umbrella shelters*. The respective goods in class 25 are identical.

Relevant public and the purchasing act

29. Each of the respective goods may be bought by businesses for onward retail and by individual members of the public with those goods designed for use in fishing being more likely to be bought by those who fish. They are all relatively common items, though in my view, the goods covered by the specification in class 18 are not likely to be an everyday purchase for most people. The goods may be sold through more general stores (whether in person or via the Internet) but may also be sold through more specialist retailers such as sports (whether of a general or specific nature) and leisure outlets. Wherever bought, purchasers are likely to take a reasonable, though not necessarily the highest, degree of care during the purchasing act to ensure the product meets requirements.

Comparison of marks

30. When assessing the similarity of the marks, I must do so with reference to the visual, aural and conceptual similarities between them, bearing in mind their dominant and distinctive components (*Sabel BV v Puma AG*, para 23). For ease of reference I set out the respective marks:

Young's application	Blue's earlier mark
MATCHTEK	MAXTECH

31. Whilst each of the respective marks is presented as a single word, and recognising that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details, each naturally breaks down into two parts.

32. The word MATCHTEK consists of the word MATCH and abbreviation TEK. Match is a well known dictionary word meaning to co-ordinate with (something). But I am also aware that it has a descriptive meaning in relation to fishing in that Match Fishing is a competition whereby anglers, either as individuals or clubs, gather together and compete to catch as many fish as possible within a given time period, the winner being the individual or club with the largest catch. Both TEK and TECH

are well recognised abbreviations for the common words technology or technological with MAX being the commonly used abbreviation of the word maximum. Both MATCHTEK and MAXTECH are invented words and in my view the two parts of each mark are of equal dominance with the distinctiveness resting in the marks as wholes.

33. To the extent that each of the respective marks begins with the letters MA, contains the letters TE at the start of the second parts of the marks and is of similar, though not equal, length, there is a reasonable degree of visual similarity between them. Aurally, the degree of similarity is much higher with a high degree of assonance between the first parts of each mark and identical sounding second parts. Young's mark may bring to mind something with technical properties which is designed either to match (co-ordinate) with something else or is for use in a match (competition). Blue's mark may bring to mind something incorporating the greatest degree of technological properties. The common reference to these technological properties in both marks gives them some degree of conceptual similarity.

Distinctiveness of the earlier trade mark

34. A further factor to be taken into consideration is that of the distinctiveness of the earlier trade mark based on either its inherent qualities or on any enhanced distinctiveness because of the use made of it. The more distinctive the earlier mark, the greater the likelihood of confusion (*Sabel BV v Puma AG*, paragraph 24).

35. The evidence of use filed by Blue is not extensive. The mark is said to have been used since January 2007 in relation, firstly, to jackets and, at a later date, on football kits. Turnover in the first year of use in relation to jackets was approximately £83,694. Whilst turnover for jackets and football kits in 2008 is given as £120,007, I am not provided with any information which would allow me to determine how much of this relates to a period prior to the relevant date. Whilst the figures provided are far from insignificant, in the context of the clothing market as a whole, they are likely to be extremely small. I have no specific figures for advertising spend before the relevant date. And whilst I have been provided with a copy of Blue's 2007 brochure, I do not know whether and, if so where, it was distributed. Whilst the earlier mark has a reasonable degree of inherent distinctiveness I am unable, on the basis of the evidence before me, to find that that distinctiveness has been enhanced to any material degree through its use.

Likelihood of confusion

36. In reaching a decision on whether there is a likelihood of confusion, I must make a global assessment based on all relevant factors. With the exception of *parasols, umbrellas and umbrella shelters*, which I found not to be similar, I have found that identical and similar goods are involved. I have also found the respective marks to have some degree of similarity from a conceptual perspective, a reasonable degree of similarity from a visual perspective and a higher degree of aural similarity. That being so, and considering all relevant factors including imperfect recollection where members of the public, who rarely have a chance to make a direct comparison between marks but must rely instead on the imperfect picture of them kept in the mind, I consider the average consumer would be likely to mistake one mark for the

other and be confused as to the economic origin of the goods sold under the respective marks. The opposition based on section 5(2)(b) of the Act therefore succeeds in respect of all goods in both classes 18 and 25 with the exception of *parasols, umbrellas and umbrella shelters*.

Costs

37. Blue has largely succeeded in its opposition and is entitled to an award of costs in its favour. In its notice of opposition, Blue requested costs “to take into account the costs and inconvenience already incurred by the Opponent to oppose the Applicant’s previous application for this mark”. At the hearing, Mr Fiddes accepted my view, which was supported by the submissions of Young, that as the earlier proceedings were entirely separate from the current matters before me, and were in any event subject to their own award of costs at the relevant time, they cannot form part of my consideration here and that I should award costs from the usual scale.

38. I therefore award costs to Blue on the following basis:

Filing Notice of Opposition	£200 & £200 fee
Considering counterstatement	£200
Preparing and filing evidence and considering Young’s evidence	£300
Preparation for and attendance at the hearing	£300
Total	£1200

39. I order H Young (Operations) Limited to pay Blue Max Group Limited the sum of £1200. 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 13th day of October 2009

**Ann Corbett
For the Registrar
The Comptroller-General**