

O-136-11

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO. 2520344
IN THE NAME OF UK URBAN SPORT
IN RESPECT OF THE FOLLOWING TRADE MARK IN CLASS 25**

A large, bold, black serif logo consisting of the letters 'U' and 'K' intertwined. The 'U' is on the left and the 'K' is on the right, with their stems overlapping in the center.

AND

**THE APPLICATION FOR A DECLARATION
OF INVALIDITY THERETO UNDER NO. 83674 BY
DARREN HENNESSY**

TRADE MARKS ACT 1994

**In the matter of registration no. 2520344 in the name of:
UK Urban Sport**

and

**the application for a declaration of invalidity thereto
under no. 83674 by Darren Hennessy**

The background and the pleadings

1. Trade mark registration no. 2520344 was filed on 6 July 2009 by UK Urban Sport ("Urban"), the name in which it currently stands registered, having completed the registration process on 25 December 2009. The mark and the goods for which it is registered are shown below:



Class 25: Clothing, Footwear, Headgear.

2. On 26 December 2009, Mr Darren Hennessy applied to have the registration declared invalid. Mr Hennessy had originally filed his objections to registration on Form TM7, including grounds under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act"). Since Form TM7 is only for use when opposing trade marks prior to registration, Mr Hennessy re-filed his application for a declaration of invalidity on Form TM26(1), which is the correct form for this purpose. The previously filed ground under section 5(4)(a) was not included as a ground of invalidity on Form TM26(1). Consequently, the two pleaded grounds in this action are as follows:

- (i) Under section 47(2)(a) of the Act, that there is a likelihood of confusion under section 5(2)(b) of the Act with Mr Hennessy's earlier mark, 2442089, registered for *clothing, footwear, headgear*.

UK

Section 5(2)(b) states:

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

....

(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.”

Mr Hennessy’s pleaded case is a partial attack in that he relies upon his ‘clothing and headwear’ goods to attack Urban’s ‘clothing and headwear’, but not Urban’s registration for footwear, which is not, therefore, subject to the application for a declaration of invalidity.

(ii) Under section 47(2)(a) of the Act, the registration is attacked under section 5(3) of the Act, which states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC), in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

Mr Hennessy again pleads reliance on his ‘clothing and headwear’ goods of 2442089 to attack Urban’s ‘clothing and headwear’. Mr Hennessy claims that the character and similarities between the trade marks causes a potential conflict in the marketing, branding and sales of clothing bearing his trade mark. He considers this to be unfair competition.

3. Mr Hennessy’s mark completed its registration process on 29 June 2007. As his mark had been registered for less than five years at the date of the application for a

declaration of invalidity, there is no requirement for Mr Hennessy to prove use of his trade mark¹.

4. The proceedings were joined when Urban filed a counterstatement, denying both grounds. As these proceedings concern an application for invalidity under sections 5(2)(b) and 5(3) of the Act, the registrar invoked rule 62(1)(c) of the Trade Mark Rules 2008, requiring the parties to attend a hearing, as per Tribunal Practice Notice 6/2009. The registry attempted to serve on both parties, by recorded delivery, written notice of the appointment details of the hearing, at the addresses recorded on the register of trade marks; both parties' written notices were returned undelivered by Royal Mail. Consequently, several attempts to reach the parties by telephone were made (telephone numbers which were recorded on the Forms TM26(l) and TM8, and also telephone numbers recorded on the case file minute sheet, dating from contact made by Urban to the Intellectual Property Office during the course of the proceedings). The hearing before me was set for 9.30am on Friday 1 April 2011. Only Mr Hennessy attended; he had received, after all, written notice of the hearing. Although Urban did not attend, I was satisfied that all measures had been taken to ensure Urban was given notice of the hearing. At the hearing, Mr Hennessy relied only upon the section 5(2)(b) ground because he said he is still trying to establish his business; consequently, the ground under section 5(3) was withdrawn as his mark does not yet have the required level of reputation to satisfy that ground².

Evidence

5. Only Mr Hennessy filed evidence. His witness statement is a mixture of fact and submission. It is only appropriate in an evidence summary to record statements of fact, although I bear in mind Mr Hennessy's submissions, both written and oral, in reaching my decision.

6. Mr Hennessy's witness statement is dated 9 November 2010. He states that his mark was first used in the UK in 2005; it has been used on headwear, caps and hats. Mr Hennessy makes reference to other trade marks of his which are not registered; however, these are not relied upon in the proceedings (there is no section 5(4)(a) ground), so I will say no more about them.

7. Mr Hennessy exhibits photographs of baseball caps which show his mark positioned above the visor of the cap. He states that he registered the domain name ukbaseballcaps.co.uk in September 2005 and has marketed a limited range of baseball caps. Since 2007, Mr Hennessy has displayed his caps "at various times" on a 'myspace' page and also on 'facebook'; he states that the myspace webpage has had close to 100,000 views.

8. Mr Hennessy states that he knew Mr Shaw, who signed the counterstatement on behalf of Urban, in 1993. He states that he has had no contact with him since then because the friendship ended. Mr Hennessy states that, until he saw the counterstatement, he had no knowledge of the person(s) representing Urban. The

¹ See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

²As per *General Motors Corporation v Yplon SA* [1999] E.T.M.R. 950.

remainder of Mr Hennessy's evidence refers to the content of the original counterstatement regarding creation and ownership of the mark. This counterstatement was subsequently amended before it was formally admitted; the content in the original counterstatement is not in the proceedings (the admitted counterstatement consists of a bare denial of the grounds) and therefore Mr Hennessy's references to it are not relevant.

Decision

9. The leading authorities which guide me in this ground are from the Court of Justice of the European Union (CJEU): *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, *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 for 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.*

10. Average consumer and the purchasing process



The average consumer of clothing and headgear is the general public, who is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The level of attention will vary according to the particular nature of the goods being purchased (see the judgment of the General Court (GC) in *Inter-Ikea Systems BV v OHIM*, Case T-112/06); the level of attention of a consumer of clothing (and headgear) may vary depending on cost and the occasion; in general, clothing is a reasonably considered purchase as items may be tried on, but not highly considered (as with specialist or technical goods) and, in general, clothing is not highly expensive. The attention paid to the appearance of the clothing/headgear means that the purchasing act will, primarily, be visual³.

11. Comparison of goods

Both parties' specifications (clothing and headgear) are expressed in identical terms; therefore, the goods are identical.

12. Comparison of trade marks

The authorities direct that, in making a comparison between the marks, I must have regard to each mark's visual, aural and conceptual characteristics. I have to decide which, if any, of their components I consider to be distinctive and dominant.

Mr Hennessy's mark	Urban's mark
	

³ See *Société provençale d'achat and de gestion (SPAG) SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-57/03*, paragraph 66, and *React Trade Mark* [2000] RPC 285.

13. Although both marks consist of the letters UK, the configuration of both marks means that they consist of single elements. The marks do not separate into comparative distinctive and dominant components. Because both marks are for the letters UK, which per se have no distinctive character, more focus will be paid to the form of stylisation. Visually, the fonts differ in that the horizontal caps on the letters, and the letters themselves, are thicker and bolder in Mr Hennessy's mark compared to Urban's. However, the difference in the fonts is not substantial. Mr Hennessy's mark is formed by an elision (at the hearing, he called it interlocking) of the U with the K, with the base of the K being slightly lower than the U. In Urban's mark, the base of the K is also slightly lower than that of the U. In Urban's mark, the U and the K are not elided; instead, they overlap as the K is superimposed. However, despite the differences in fonts and 'elision', both marks are clearly 'UK' marks and the overall visual impression is of a conjoined U and K, with the base of the K represented as slightly lower than that of the U. The marks are, visually, highly similar. This analysis of both marks clearly being 'UK' marks means that they will be pronounced as UK; aurally, they are identical. Furthermore, they both share the meaning or concept of being UK marks, UK being immediately apparent to the average consumer as an abbreviation for United Kingdom. The meaning, or concept, of the marks is also identical.

14. Overall, there is a high degree of similarity between the marks.

15. Distinctiveness of Mr Hennessy's mark

It is necessary to consider the distinctive character of Mr Hennessy's mark because the more distinctive it is, either by inherent nature or by use (nurture) the greater the likelihood of confusion⁴. The distinctive character of a trade mark must be assessed by reference to the goods or services in respect of which registration is sought and by reference to the way it is perceived by the relevant public⁵. Mr Hennessy's evidence is insufficient to support a claim to an enhanced distinctive character through use; I therefore approach the earlier mark on the basis of its inherent distinctive character. Of themselves, the letters UK are not distinctive because they are the well-known abbreviation for United Kingdom. However, there is an element of creative configuration in the earlier mark which gives the mark a degree of distinctiveness which, although not high, is of a reasonable level.

16. Likelihood of confusion

In deciding whether there is a likelihood of confusion between the marks, I must weigh the various factors I have identified and also bear in mind the principle of interdependency, whereby a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa (*Canon*). The goods are identical. I should guard against dissecting the marks so as to distort the average consumer's perception of them; the average consumer perceives trade marks as wholes and rarely has the opportunity to compare marks side by side, relying instead upon the imperfect picture he has of them in his mind. I have found

⁴ *Sabel BV v Puma AG* [1998] RPC 199.

⁵ *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

that the marks are identical aurally and conceptually and that they are highly similar visually. Although it is possible in a side by side comparison to discern differences in the way in which the U and the K are conjoined, the overall impression is highly similar. Even though the distinctive character of Mr Hennessy's mark is not high, there can still be a likelihood of confusion where marks of a relatively weak distinctive character are concerned where other factors in the global comparison combine to lead to such a conclusion. In this case, where the goods are identical, the average consumer will rely upon his imperfect visual picture of the configuration of 'UK', the impression of which is highly similar. The goods will be purchased visually and without a great level of attention. The potential for imperfect recollection of one mark for the other is therefore high.

17. Bearing in mind the above analysis and the conclusions I have drawn, there is a likelihood of confusion. The application for invalidation succeeds under section 5(2)(b) of the Act.

Outcome

18. In accordance with section 47(6) of the Act, registration 2520344 is deemed never to have been made in respect of 'clothing; headgear'. It will remain on the register for 'footwear' as the application for a declaration of invalidity was partial in nature and did not attack 'footwear'.

Costs

19. Mr Hennessy has been successful and is entitled to an award of costs. It is the registrar's practice to award costs to litigants-in-person at half the rate that he awards them where a party has had legal representation. I therefore award costs on the following basis⁶:

Preparing a statement and considering the other side's statement:	£100
Official fee for filing Form TM26(l):	£200
Attending hearing	£300
Total:	£600

⁶ As per the scale in Tribunal Practice Notice 4/2007. I have not made an award for evidence as the section 5(3) ground was not pursued; reputation of the earlier mark was of no relevance; there was no evidence from Urban to consider; and the majority of the evidence referred to the content of the original counterstatement, which did not form part of the proceedings.

20. I order UK Urban Sport to pay Darren Hennessy the sum of £600. 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 18 day of April 2011

**Judi Pike
For the Registrar,
the Comptroller-General**