

O-084-14

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION NO 1116520  
IN THE NAME OF SCORDIA SPOR TEKSTIL  
URUNLERI SANAYI VE TICARET ANONIM SIRKETI  
IN RESPECT OF TRADE MARK:



AND

AN APPLICATION FOR A DECLARATION OF THE INVALIDITY THEREOF  
UNDER NO 500021 BY COUG & COMPANY INC.

## BACKGROUND

1. Trade mark No. IR1116520 shown above stands registered in the name of Scordia Spor Tekstil Urunleri Sanayi Ve Ticaret Anonim Sirketi (the proprietor). It completed its registration procedure on 13 October 2011, achieving protection in the UK on 6 December 2012. It is registered for goods in classes 18, 25 and 28, but for the purposes of this invalidation the relevant goods for which invalidation is sought is footwear in class 25.

2. On 15 March 2013, Coug & Company Inc. (the applicant) filed an application to have this trade mark declared invalid under the provisions of sections 47(2)(a) and (b) and section 5(2)(b) of the Trade Marks Act 1994 ("the Act") which state:

"47(2) The registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier trade mark in relation to which the conditions set out in section 5(4) is satisfied, unless the proprietor of that earlier trade mark or other earlier right has consented to the registration."

And:

"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, or  
there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or..."

3. The applicant relies upon UK trade mark 1002871 for the mark COUGAR and goods 'boots and shoes'. The mark was registered in class 25 on 5 December 1972.

4. 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) 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,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

5. The applicant's mark is an earlier mark, which is, in principle, subject to proof of use because, at the date of the application for invalidity its marks had been registered for five years.<sup>1</sup> However, at section 5 of its counter statement the applicant has answered “NO” when asked if it requires the opponent to provide proof of use. Therefore I need consider it no further. The opponent is entitled to rely on ‘boots and shoes’ from its class 25 registration.

6. On 10 May 2013, the proprietor filed a counter statement in which denies the grounds of invalidation.

7. The applicant filed written submissions in lieu of hearing and neither party elected to be heard.

### **Section 5(2)(b) case law**

8. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the Court of Justice of the European Union (CJEU) cases mentioned) on the basis indicated below:

### **The CJEU cases**

*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; *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market* (Trade Marks and Designs) (OHIM), Case T-6/01; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04; *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market* (Trade Marks and Designs) (OHIM) C-334/05 P.

### **The principles**

“(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, 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, and whose attention varies according to the category of goods or services in question;

---

<sup>1</sup> 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.

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) 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;

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

### **The average consumer and the nature of the purchasing act**

9. In accordance with the above cited case law, I must determine who the average consumer is and also identify the nature of the purchasing process. The average consumer is reasonably well informed and reasonably circumspect and observant but with a level of attention likely to vary according to the category of goods. The attention paid is likely to vary depending on price and, to some extent, the nature of the goods and the frequency of the purchase.

10. The average consumer for footwear will be a member of the general public. The attention paid is likely to vary depending on price and, to some extent, the nature of the goods and the frequency of the purchase. A pair of specialist hiking boots is likely to afford a higher level of attention to be paid than would be evident during the purchase of a pair of slippers. For the most part the purchase will be a visual one, being made from a shelf, a website or catalogue, though I do not discount an aural element to the purchase, particularly where assistance is requested in store prior to purchase. The consumer will pay a reasonable, but not exceptional, level of attention, to the extent that they will consider, inter alia, size, material, colour.

## Comparison of goods

11. The goods to be compared are as follows:

The applicant's goods	The registered proprietor's goods
<b>Class 25</b> Boots and shoes	<b>Class 25</b> Footwear


12. In comparing the goods, I bear in mind the following guidance provided by the General Court (GC) in *Gérard Meric v OHIM*, Case T-133/05:

*“29. ...goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”*

13. The applicant's goods are included within the broad term 'footwear' in the proprietor's specification. Consequently, in accordance with *Meric*, I find the parties' goods to be identical.

## Comparison of marks

14. The marks to be compared are as follows:

The applicant's mark	The proprietor's mark
COUGAR	

15. In making a comparison between the marks, I must consider the respective marks' visual, aural and conceptual similarities with reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components<sup>2</sup>, but without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

16. The applicant's mark consists of the single word 'COUGAR' in block capitals. No part of the word is stylised or emphasised in any way. Consequently, the distinctiveness lies in the mark as a whole.

---

<sup>2</sup> *Sabel v Puma AG*, para.23

17. The proprietor's mark consists of the word 'cougar' in lower case. In front of the letter 'C' is a black cat head in profile. The final lower case 'r' is elongated. Neither the cat head nor the elongated 'r' prevent the word from being read as the word 'cougar' and it is this word which is the dominant and distinctive element of the mark.

### **Visual similarities**

18. The applicant submits:

*"4.2. Although the later mark has some stylisation, the word "cougar" is very clear in the mark. Fair usage of the earlier mark COUGAR must include "cougar" (i.e. lower case letters) and so it is obvious the marks are virtually identical from a visual point of view."*

19. The differences between the marks rest in the addition of a cat head at the beginning of the proprietor's mark and an elongated 'r' at the end of the word which suggests a tail. The similarity between the marks rests in the fact that the entirety of the applicant's mark and the distinctive and dominant element of the proprietor's mark both consist the word COUGAR. The average consumer is unlikely to notice whether the word is presented in upper or lower case. Taking these factors into account, I find the marks to share a high degree of visual similarity.

### **Aural similarities**

20. Both marks will be articulated as the word 'COUGAR': the marks are aurally identical.

### **Conceptual similarities**

21. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.<sup>3</sup> The assessment must be made from the point of view of the average consumer.

22. The applicant submits:

*"4.4. The marks are from the conceptual point of view identical, as they consist of the same word "cougar". The stylisation of the later mark, namely the head and tail of a big cat, only emphasises the concept of the mark."*

23. The cougar is defined as:

*A North American term for a puma.<sup>4</sup>*

24. While I cannot conclude that the average consumer will be familiar with the exact type of animal, in my view, the average consumer will be familiar with the fact that a cougar is a large cat. Consequently, the marks will both convey the same message. The proprietor's

---

<sup>3</sup> This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.

<sup>4</sup> *Oxford Dictionary of English* (3 ed.), Oxford University Press, 2010

mark simply emphasises the fact by the addition of the cat head at the start of the mark and the elongated letter 'r' at the end of the word, suggestive of a tail. The marks are conceptually identical.

### **Distinctive character of the earlier mark**

25. I must now assess the distinctive character of the opponent's earlier trade marks. The distinctive character of a trade mark can be appraised only, first, by reference to the goods for which it is registered and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

26. No evidence has been filed and I have only the inherent characteristics of the trade mark to consider. The applicant's mark is the word 'COUGAR'. I have already concluded that this will be seen as a large cat. The mark does not have any meaning in respect of the goods and I find it to have a good level of inherent distinctive character.

### **Likelihood of confusion**

27. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind.<sup>5</sup> I must also keep in mind the average consumer for the goods, the nature of the purchasing process and have regard to the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa.

28. I have found the marks to have a high degree of visual similarity and to be aurally and conceptually identical. I have found the earlier mark to have a good level of inherent distinctive character and have found the proprietor's goods to be identical to those of the applicant. I have identified the average consumer, namely a member of the general public and have concluded that the purchase will be primarily visual, though I do not discount an aural element where the consumer seeks assistance in store prior to purchase. The level of attention paid to the purchase will be reasonable to the extent that the average consumer will consider, inter alia, size, colour, fit, material.

29. Taking all of these factors into account, the similarity of the marks are such that in the context of goods which are identical there will, in my view, be direct confusion (where the average consumer believes the respective goods originate from the same or a linked undertaking), Even if I am wrong in this, the similarity between the parties' marks is such that there will be indirect confusion (where the average consumer believes the respective goods originate from the same or a linked undertaking).

---

<sup>5</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*, paragraph 27

## **Conclusion**

30. As a consequence of my decision above, the applicant's request to invalidate the registered proprietor's trade mark has succeeded under section 5(2)(b) of the Act and, under the provisions of 47(6) of the Act. The registration shall be deemed never to have been made in respect of the proprietor's registration for footwear in class 25.

## **Costs**

31. Coug & Company Inc. has been successful and is entitled to an award of costs. Awards of costs are governed by Annex A of Tribunal Practice Notice 4 of 2007. I have taken into account that no hearing has taken place and award costs on the following basis:

Preparing a statement and considering the other side's statement: £ 300

Written submissions: £ 400

Official fee: £ 200

**Total: £ 900**

32. I order Scordia Spor Tekstil Urunleri Sanayi Ve Ticaret Anonim Sirketi to pay Coug & Company Inc. the sum of £900. 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 25<sup>th</sup> February 2014**

**Ms Al Skilton  
For the Registrar,  
the Comptroller General**