

O-408-16

TRADE MARKS ACT 1994

**IN THE MATTER OF THE APPLICATION BY
KNOCKOUT CLOTHING LTD
UNDER NO. 3109503 FOR THE TRADE MARK
Knockout Clothing**

AND

**IN THE MATTER OF OPPOSITION NO. 405310 THERETO BY
OLIVER BERND FREIER GmbH & Co KG**

The background and the pleadings

1) On 19 May 2015 Knockout Clothing Ltd (“the Applicant”) filed application no. 3109503 to register the following mark:

Knockout Clothing

The application was published for opposition purposes on 21 August 2015 in respect of the following goods:

Class 25: *Athletic clothing; Athletics vests; Athletics wear; Beanies; Body warmers; Body warmers [clothing]; Boxing shoes; Casual clothing; Casual jackets; Casual shirts; Casualwear; Children's headwear; Clothes for sports; Clothing; Clothing, footwear, headgear; Clothing for gymnastics; Clothing for martial arts; Combative sports uniforms; Flat caps; Gymwear; Hats; Head wear; Headgear for wear; Headwear; Hooded pullovers; Hooded sweatshirts; Hooded tops; Jackets; Jackets (Stuff -) [clothing]; Jogging bottoms [clothing]; Jogging pants; Jogging tops; Jumpers; Jumpers [pullovers]; Jumpers [sweaters]; Leg warmers; Leggings [leg warmers]; Leggings [trousers]; Legwarmers; Long sleeve pullovers; Men's and women's jackets, coats, trousers, vests; Menswear; Outerclotthing; Peaked headwear; Peaks (Cap -); Polo knit tops; Polo shirts; Polo sweaters; Pullovers; Short trousers; Shorts; Shorts [clothing]; Short-sleeve shirts; Short-sleeved or long-sleeved t-shirts; Short-sleeved shirts; Sport shirts; Sports caps and hats; Sports jackets; Sports shirts; Sports vests; Sportswear; Sun hats; Sun visors; Sun visors [headwear]; Sweat bottoms; Sweat pants; Sweat shirts; Sweat shorts; Sweaters; Sweatpants; Sweatshirts; Sweatshorts; Tee-shirts; Track pants; Track suits; Tracksuit bottoms; Tracksuit tops; Tracksuits; Trousers for sweating; Trousers shorts; T-shirts; Vest tops; Vests; Wearable garments and clothing, namely, shirts.*

2) On grounds under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) Oliver Bernd Feier GmbH & Co KG (“the Opponent”) opposes the registration of the Applicant’s mark for all the goods for which the Applicant seeks registration.

3) For the purposes of its claim the Opponent relies on the following trade marks (“the earlier marks”) and respective goods:

1. **International Registration designating the EU (“IR (EU)”) No. 485679**, which was registered with designation of the EU on 9 May 2014 and granted protection in the EU on 7 April 2015 for the mark **KNOCK-OUT**; the goods relied on in respect of this designation are as follows:

Class 25: *Clothing for men, women and children; sportswear.*

2. **IR (EU) No. 633135**, which was registered with designation of the EU on 12 September 2014 and granted protection in the EU on 7 December 2015 for the mark **KNOCK OUT**; the goods relied on in respect of this designation are as follows:

Class 25: *Clothing for women and men, including woven and knitted clothing, and clothing made of leather and imitation leather, in particular blouses, shirts, T-shirts, sweatshirts, jackets, pullovers, tops, bustiers, trousers, skirts, twin sets, suits, coats, underwear, swimwear, headgear, scarves, headbands, jogging, and fitness clothing, gloves, belts for clothing, shoes, ties, socks, stockings, tights.*

4) The Applicant filed a notice of defence and counterstatement, denying the grounds of opposition, and requesting proof of use of the earlier designations. It was informed by the Registry that since the Opponent’s earlier designations had completed their registration procedure within a period of five years prior to the publication of the contested mark, the Opponent was not required to file such evidence. Neither party filed evidence. The Opponent filed written submissions, dated 22 March 2016, in the evidence rounds. In these submissions, in addition to the earlier designations specified above the Opponent also relied on its European Union Trade Mark No 1812933. However, this mark had not been pleaded or relied on in the Opponent’s notice of opposition and statement of grounds, and so will be disregarded in my decision. The Opponent was represented by Novagraaf UK. The

Applicant was not professionally represented. Neither side requested a hearing. I therefore give this decision after a careful review of all the papers before me.

The law

5) Section 5(2)(b) of the Act reads as follows:

“5(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”.

6) I have taken into account the guidance provided by the Court of Justice of the European Union (“CJEU”) in a number of judgments. The following principles are gleaned from the decisions in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(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;

(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 be dominated by one or more of its components;

(f) however, it is also 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 creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of the goods and services

7) In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“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 intended purpose and their method of use and whether they are in competition with each other or are complementary”.

8) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) 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;
- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

9) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

10) The following goods all fall within the ambit of *clothing for men, women and children* in The Opponent’s IR (EU) No. 485679, and are thus identical under the guidance in *Merica*:

Athletic clothing; Athletics vests; Beanies; Body warmers; Body warmers [clothing]; Casual clothing; Casual jackets; Casual shirts; Casualwear; Clothes for sports; Clothing; Clothing, footwear, headgear; Clothing for gymnastics; Clothing for martial arts; Combative sports uniforms; Hooded pullovers; Hooded sweatshirts; Hooded tops; Jackets; Jackets (Stuff -) [clothing]; Jogging bottoms [clothing]; Jogging pants; Jogging tops; Jumpers; Jumpers [pullovers]; Jumpers [sweaters]; Leg warmers; Leggings [leg warmers]; Leggings [trousers]; Legwarmers; Long sleeve pullovers; Men's and women's jackets, coats, trousers, vests; Outerclathing; Polo knit tops; Polo shirts; Polo sweaters; Pullovers; Short trousers; Shorts; Shorts [clothing]; Short-sleeve shirts; Short-sleeved or long-sleeved t-shirts; Short-sleeved shirts; Sport shirts; Sports jackets; Sports shirts; Sports vests; Sweat bottoms; Sweat pants; Sweat shirts; Sweat shorts; Sweaters; Sweatpants; Sweatshirts; Sweatshorts; Tee-shirts; Track pants; Track suits; Tracksuit bottoms; Tracksuit tops; Tracksuits; Trousers for sweating; Trousers shorts; T-shirts; Vest tops; Vests; Wearable garments and clothing, namely, shirts.

11) The Applicant’s specification and the Opponent’s specification in IR (EU) No. 485679 both contain the identical term *sportswear*. I consider that the Applicant’s

athletics wear and *gymwear* are broad enough terms to include items of footwear and headgear in class 25, but that the Opponent's *sportswear* is also broad enough to include both these and the Applicant's *boxing shoes* in its ambit. These are thus all identical.

12) I also consider that the Opponent's *clothing for men, women and children* is a broad enough term to cover items of footwear and headgear. In addition to the Applicant's goods already discussed in paragraph 11, therefore, the following would also fall within the ambit of the Opponent's *Clothing for men, women and children*, and are thus identical:

Children's headwear; Flat caps; Hats; Head wear; Headgear for wear; Headwear; Menswear; Peaked headwear; Peaks (Cap -); Sports caps and hats; Sportswear; Sun hats; Sun visors; Sun visors [headwear].

If I am wrong in thinking that the Opponent's *clothing for men, women and children* is broad enough to cover these items, however, the goods in any case have at least a medium level of similarity. Footwear, headgear and clothing serve the same basic purpose, all are intended for wear by humans, all serve as protection from the elements and as articles of fashion, and all are as such often found in the same departments of large department stores and in the same retail outlets. Although footwear in particular is sometimes sold in separate retail outlets, consumers, when seeking to purchase clothes, will expect to find footwear and headgear in the same department or shop and *vice versa*. Moreover, many manufacturers and designers will design and produce footwear and/or headgear as well as clothing. Retail outlets regularly provide clothing, footwear and headgear under the same trade mark¹.

The average consumer and the purchasing process

13) The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood

¹ I am reinforced in this view by the comments of the General Court in *Giordano Enterprises Ltd v Office for OHIM* at paragraph 20: "As the Court has held in previous cases, in view of the sufficiently close links between the respective purposes of 'clothing' and 'footwear', which are identifiable in particular by the fact that they belong to the same class, and the specific possibility that they can be produced by the same operators or sold together, it may be concluded that those goods may be linked in the mind of the relevant public." The Court concluded that: "... 'clothing' and 'footwear' must therefore be regarded as similar within the meaning of Article 8(1)(b) Regulation No. 40/94".

of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

14) The average consumer of all the Applicant's goods in Class 25 will consist of the general public. The same is true of all the Opponent's goods in Class 25. Clothing footwear and headgear are regular consumer purchases. The goods concerned are not specialist ones and, although their cost can vary, they are not, generally speaking, highly expensive purchases. Overall, consumers will normally pay a reasonable degree of attention, neither higher nor lower than the norm, when selecting the goods. The purchasing of all these goods is a predominantly visual process, so visual aspects of the marks take on more importance, but aural aspects will not be ignored in my comparison of the marks.

The distinctiveness of the earlier mark

15) The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark (on the basis either of inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

16) I have no evidence of acquired distinctiveness to consider. This leaves the question of inherent distinctiveness. It is invented words which usually have the highest level of inherent distinctive character. The word “Knockout”, whether spelt with a hyphen or as two words (or, for that matter, one) will be seen by the average consumer as an expression which refers to elimination from, for example, a sporting tournament and, in particular, to the defeat of an opponent in boxing by rendering him senseless. It could also carry metaphorical overtones suggestive of something making an arresting impression, but it is not directly laudatory. Nor is it descriptive or allusive of the goods covered by the mark. Accordingly, the earlier marks have a normal degree of distinctive character.

Comparison of the marks

17) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

It would be wrong, therefore, to dissect the trade marks artificially, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

18) The marks to be compared are shown below.

The contested mark	The earlier mark IR (EU) No. 485679	The earlier mark IR (EU) No. 633135
Knockout Clothing	KNOCK-OUT	KNOCK OUT

The Applicant submits:

“Firstly, the opponent’s mark “KNOCK OUT” or “KNOCK-OUT” is all Capital Letters and two distinct words, namely “KNOCK” and [space] “OUT” or “KNOCK” and [hyphen] “OUT”.

The contested mark is clearly distinguishable from that in three ways:

- i. firstly, the contested mark is not ‘capitalised’ but lower case;*
- ii secondly, it contains Knockout as one word (not two); and*
- iii. thirdly (and most importantly) it is followed by the word Clothing”.*

19) There may be some among the relevant public who have firm views on the orthographical principles governing whether a particular expression should be written as two words, one word, or two words conjoined by a hyphen. Even these persons, however, will be aware that these are matters on which judgment may vary. Moreover, they will certainly be used to observing that actual everyday practice in this area, especially in commercial contexts, is inconsistent and varies widely. For this reason, I do not consider that these are points which will engage the average consumer’s attention – or which, even if they are noticed at the time, will be retained in the memory.

20) The earlier marks consist exclusively of the words KNOCK-OUT and KNOCK OUT which, by virtue of being the sole components of the respective marks, constitute their dominant and distinctive element.

21) The contested mark consists of the words Knockout Clothing, in lower case with initial capitals. However, I bear in mind that since the earlier marks are word marks, registered in block capitals, notional and fair use of them would include use in differing ordinary typefaces, including that of the contested mark, and in upper and lower case letters. The distinctive weight of the contested mark lies heavily on the word “Knockout”. The word “Clothing” is descriptive of the goods covered by the Applicant’s specification and will be seen by the average consumer as such.

22) Although not negligible in the overall visual impression of the mark, the word “Clothing” will receive limited attention when the mark is encountered visually, the focus lying heavily on the initial word Knockout. Viewing the contested mark as a whole, there is a reasonably high degree of visual similarity with the earlier marks

23) Aurally, I consider it is uncertain that the word “Clothing” will normally be articulated in trade, because it will be perceived as a description of the Applicant’s products and the mark can be referred to more simply by its distinctive dominant element, “Knockout” (which would make the marks aurally identical). Even where the word “Clothing” is included in oral use, however, I consider that there is still a reasonably high degree of aural similarity between the marks.

24) The word “Clothing” adds a conceptual element not present in the earlier mark. The word “Knockout”, which describes the concept which I have already discussed in paragraph 16, will be understood in exactly the same way in the contested mark and both earlier marks. There is a reasonably high degree of conceptual similarity between the marks.

Likelihood of confusion

25) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

26) I have found a reasonably high degree of visual, aural and conceptual similarity between the competing marks, and at least a medium degree of similarity between their respective goods and services. I have also found the earlier mark to have a normal degree of inherent distinctive character. The word “Clothing” in the contested mark will be regarded as descriptive. Even bearing in mind my findings on the average consumer, the purchasing process, and the reasonable degree of attention with which purchases will be made, I think it likely that the differences in the

competing marks will go unnoticed by a significant portion of the relevant public, who will thus directly confuse them. Even on the assumption that the differences are registered, however, they will not in any case be perceived as indicating a different trade origin from that of the earlier mark; rather, in the light of the strongly dominant and distinctive word “Knockout”, and the descriptive nature of the word “Clothing”, the contested mark will be seen simply as a variant of the earlier marks. The average consumer will believe that the respective goods come from the same or economically linked undertakings. Thus, even where the differences between the marks are noticed, there remains in any case a likelihood of indirect confusion in respect of all the services of the contested mark. **Accordingly, the opposition succeeds in its entirety.**

Costs

27) Oliver Bernd Freier GmbH & Co KG has been successful and is entitled to a contribution towards its costs. I hereby order Knockout Clothing Ltd to pay Oliver Bernd Freier GmbH & Co KG the sum of £800. This sum is calculated as follows:

<i>Opposition fee</i>	£100
<i>Preparing a statement and considering the other side’s statement</i>	£300
<i>Written submissions</i>	£400

The above sum should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 25th day of August 2016

Martin Boyle

For the Registrar,

The Comptroller-General