

O-649-17

**TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO 3158998
BY GECKO SPORTSWEAR LTD
TO REGISTER**



**AS A TRADE MARK
IN CLASS 25
AND OPPOSITION THERETO (UNDER NO. 407645)
BY
GOTTLIEB BINDER GMBH & CO. KG**

Background & Pleadings

1. Gecko Sportswear Ltd ('the applicant') applied to register the trade mark outlined above on the title page on 12 April 2016 in class 25 for **sportswear**. The mark was published on 15 July 2016.

2. Gottlieb Binder GmbH &Co. KG ('the opponent') opposes this application under Section 5(2)(b) of the Trade Marks Act 1994 ('the Act') on the basis of the following specified goods registered under their EU trade mark set out below:

EU TM 011188695	Goods relied on:
<p data-bbox="209 824 456 891">GECKO</p> <p data-bbox="209 994 606 1030">Filing Date: 30 August 2012</p> <p data-bbox="209 1048 746 1084">Date of entry in register: 15 May 2014</p>	<p data-bbox="810 766 1375 909">Class 9 – head protection; helmets for use in sports; gloves, namely protective gloves.</p> <p data-bbox="810 985 1375 1568">Class 10 – elastic bandages; anatomical bandages for joints; knee bandages (orthopaedic); slings (support bandages); orthopaedic articles; wrist supports; muscle building and other invigorating sports and training apparatus; orthopaedic footwear; orthopaedic soles; supports for flat feet; belts for medical purposes; orthopaedic belts' abdominal belts; abdominal corsets.</p> <p data-bbox="810 1644 1366 1899">Class 28- swimming jackets; gloves, namely sports gloves in particular golf gloves, baseball gloves, boxing gloves, fencing gauntlets, goalkeepers gloves, gloves for games.</p>

3. The applicant filed a counterstatement in which it denied the grounds for opposition.
4. The opponent's trade mark is an earlier mark, in accordance with section 6 of the Act, but as it has not been registered for five years or more before the publication date of the applicant's mark, it is not subject to the proof of use requirements, as per section 6A of the Act.
5. The applicant has represented itself in these proceedings and the opponent has been represented by Marks & Clerk LLP.
6. Only the applicant filed evidence. Both parties filed written submissions in lieu of a hearing. I now make this decision from the papers before me.

Preliminary issues

7. In paragraph 6 of its written submissions dated 21 November 2017, the opponent submits that the applicant's evidence should not be admitted under Rule 64(6) of the Consolidated Trade mark Rules as it was filed out of time and was not copied to the opponent at the time it was filed. I would point out that the opponent did not raise the deadline matter with the Tribunal at the time and consider that raising it in its submissions is too late in the proceedings. On reviewing the chronology I note that a Tribunal letter dated 9 June 2017 allowed the applicant until 23 June 2017 to put the evidence in order and refile it. The Tribunal received the refiled evidence on 10 June 2017 within the stated time limit.
8. I further note that the refiled evidence was not initially copied to the opponent due to the applicant's confusion regarding the opponent's email address and that the evidence was subsequently copied by the Tribunal and sent to the opponent. Whilst this is not an ideal situation, it ultimately has no bearing here as I have reviewed the evidence and find that there was nothing relevant within the material provided that assists me in this decision.
9. It suffices to record here that the applicant's exhibit JL4 contained a number of examples of earlier registered 'gecko' trade marks. Other 'gecko' trade marks are

not relevant to the matter before me. I refer to *Zero Industry Srl v OHIM*, Case T-400/06, in which the General Court stated that:

“73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II-4865, paragraph 68, and Case T-29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II-5309, paragraph 71). “

10. Furthermore in exhibit JL1, I have noted the applicant’s submissions regarding the kinds of goods that they currently use their mark on. But the way in which either party currently uses their marks is irrelevant. I must compare the parties’ goods on the basis of notional and fair use of the goods listed in the parties’ specifications. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. stated that:

“78.the court must.... consider a notional and fair use of that mark in relation to all of the goods or services in respect of which it is registered. Of course it may have become more distinctive as a result of the use which has been made of it. If so, that is a matter to be taken into account for, as the Court of Justice reiterated in *Canon* at paragraph [18], the more distinctive the earlier mark, the greater the risk of confusion. But it may not have been used at all, or it may only have been used in relation to some of the goods or services falling within the specification, and such use may have been on a small scale. In such a case the proprietor is still entitled to protection against

the use of a similar sign in relation to similar goods if the use is such as to give rise to a likelihood of confusion.”

11. In addition the applicant, in his evidence, has made further submissions which I have noted and will refer to as necessary.

Decision

12. Section 5(2)(b) of the Act is 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.

13. The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *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.

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;

(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 Goods

14. The goods to be compared are:

Opponent's goods	Applicant's goods
<p>Class 9 – head protection; helmets for use in sports; gloves, namely protective gloves.</p> <p>Class 10 – elastic bandages; anatomical bandages for joints; knee bandages (orthopaedic); slings (support bandages); orthopaedic articles; wrist supports; muscle building and other invigorating sports and training apparatus; orthopaedic footwear; orthopaedic soles; supports for flat feet; belts for medical purposes; orthopaedic belts' abdominal belts; abdominal corsets.</p> <p>Class 28- swimming jackets; gloves, namely sports gloves in particular golf gloves, baseball gloves, boxing gloves, fencing gauntlets, goalkeepers gloves, gloves for games.</p>	<p>Class 25: Sportswear.</p>

15. With regard to the comparison of goods and services, in *Canon*, the CJEU 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”.

16. 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.

17. In its written submissions, the opponent submits that the applicant’s class 25 goods are,

“...identical with, or at the very least are similar or complementary to, the goods falling within classes 9, 10 and 28 of the Opponent’s earlier trade mark”.

18. As the opponent does not have class 25 goods as part of its registration, I do not find the goods of other classes can be considered identical but I agree that I must consider the issues of similarity and, if relevant, complementarity in my comparison.

19. Taking first the opponent's class 9 goods namely *head protection; helmets for use in sports; gloves, namely protective gloves*, I note that *head protection* and *gloves, namely protective gloves* are not limited to use in sports but are broad terms which will cover all types of protective headwear and gloves including those for use in sports. On that basis and with reference to the list given above in paragraph 16, I would say that the users of protective wear for sports are likely to be the same as those users of *sportswear*, the nature of the contested goods is that of something worn for participation in sport and the trade channels through which the goods reach the market could be the same. It is not uncommon for companies to provide both the sportswear (being the garments) and the kit (being the equipment) required to participate in sports. Taking these factors into account I find the opponent's class 9 goods to be highly similar to the applicant's class 25 goods.

20. With regard to the opponent's class 28 goods namely *swimming jackets; gloves, namely sports gloves in particular golf gloves, baseball gloves, boxing gloves, fencing gauntlets, goalkeepers gloves, gloves for games*, the same reasoning as I have outlined above will apply. The users, nature and trade channels for these class 28 goods are likely to be same as for the applicant's class 25 goods. On this basis I find the goods to be highly similar.

21. With regard to the specific term *muscle building and other invigorating sports and training apparatus* in the opponent's class 10 specification, I find this term to be closer in nature to the applicant's class 25 goods, being sports based training apparatus. The users, nature and channels of trade are likely to be same and on this basis I find the goods to be highly similar.

22. Turning to the opponent's remaining class 10 goods namely *elastic bandages; anatomical bandages for joints; knee bandages (orthopaedic); slings (support bandages); orthopaedic articles; wrist supports; orthopaedic footwear; orthopaedic soles; supports for flat feet; belts for medical purposes; orthopaedic belts' abdominal*

belts; abdominal corsets, I note that these are goods for medical purposes, specifically for use in orthopaedic medicine. There may be some crossover of user perhaps needing these goods for sports injuries, but I do not find the nature of the goods or the trade channels are likely to be the same as for the applicant's goods, given their prime purpose is for use in orthopaedic treatment. Overall I do not find the goods to be similar.

Average consumer and the purchasing process

23. I must now consider who the average consumers is for the goods and how they are purchased. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood 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*.

24. 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.”

25. The average consumer for the contested goods would be the general public. Items of sports clothing and kit vary in price and quality. Ordinarily I would expect a normal level of attention to be paid by the consumer when selecting such goods. The purchasing act will be mainly visual and will likely be based on the aesthetic appeal and suitability for sports participation. It is most likely that goods will be selected after perusal of racks/shelves in retail establishments, or from images on Internet websites

or in catalogues. However, I do not discount aural considerations playing a part if guidance is sought, say on a product's particular suitability, from a retailer or supplier prior to purchase.

Comparison of the marks

26. The marks to be compared are:

Opponent's mark	Applicant's mark
<p>GECKO</p>	

27. 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 CJEU 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.”

28. It would be wrong, therefore, artificially to dissect the trade marks, 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.

29. The opponent's trade mark consists of a single word **GECKO** presented here in plain block capitals. The overall impression of the mark and its distinctiveness rests solely in that word.

30. The applicant's mark is a composite word and device arrangement whereby the tail of the gecko lizard device forms the initial letter of the stylised word **Gecko** which in turn is presented above the word **SPORTSWEAR**. The opponent's submits that,

“The word element “SPORTSWEAR” of the applicant's mark is wholly descriptive in relation to sportswear, and as such the average consumer will disregard this word element and focus on the dominant element **GECKO** in the mark applied for.”

I agree with the opponent on this particular submission. The word ‘sportswear’ is descriptive of the goods, leaving **GECKO** and the device as the dominant and distinctive element. In marks which consist of both words and devices, it is a general rule of thumb that the words will speak louder than the devices. I consider that rule to be applicable in this case. Although the device here is significant in terms of its size, position and stylisation and will make a substantial visual impact, the mark is likely to be referred to by the **GECKO** word element.

31. In a visual comparison, the point of similarity is the word **Gecko**. It is the whole of the opponent's mark and one of the two word elements of the applicant's mark. The applicant's mark also has the additional descriptive word **SPORTSWEAR** and the device. As previously outlined the gecko lizard device make a significant visual impact and is an intrinsic part of the word element given that it forms part of the lettering making up the word. Overall I find there to be a medium degree of similarity.

32. In an aural comparison, the opponent's mark will be given its usual pronunciation when spoken and the **GECKO** word element of the applicant's mark will be pronounced identically. In addition it is possible that consumers will also pronounce the **SPORTSWEAR** word element of the applicant's mark. The applicant's device element is unlikely to be vocalised at all. Taking these factors into account I find there to be a high degree of aural similarity.

33. In a conceptual comparison, the same message will be brought to mind from both marks, being that of a gecko lizard. The lizard device, albeit presented here in a stylised form, in the applicant's mark will further reinforce the gecko lizard concept. The descriptive word **sportswear** in the applicant's mark will bring to mind its natural meaning. I have already agreed that this is a wholly descriptive word in relation to sportswear goods, and that as such the average consumer will disregard this word element and focus on the dominant element GECKO. In effect, therefore, the marks are conceptually identical.

Distinctive character of the earlier mark

34. In *Lloyd Schuhfabrik Meyer* 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).”

35. The opponent has not filed any evidence to indicate that the earlier mark enjoys any enhanced distinctiveness, therefore I only have the inherent position to consider. The opponent’s mark consists of an ordinary dictionary word which is not descriptive of the goods it is registered for. On that basis, I find that there is an average level of inherent distinctiveness.

Likelihood of confusion

36. I must now draw together my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors and those outlined in paragraph 13:

- a) The interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon*).
- b) The principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*).
- c) The factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer*).

37. Confusion can be direct (when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related). In terms of indirect confusion, this was dealt with by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 where he noted that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark”.

38. So far I have found that the contested goods are highly similar and that the goods are primarily purchased visually by a member of the general public who will be paying a normal level of attention during the purchasing process. In addition I have found that the earlier mark has an average level of inherent distinctiveness and that the contested marks are visually similar to a medium degree, aurally similar to a high degree and conceptually identical.

39. Based on the marks and the goods before me and taking into account the assessments I have made, I conclude that there is a no likelihood of direct confusion, i.e. one mark being mistaken for another. But I do find that there is likelihood of indirect confusion as even if the consumer does not mistake one mark for the other, they are, at the very least, likely to believe that the respective goods come from the same or economically linked undertakings.

Conclusion

40. The opposition succeeds under section 5(2)(b) of the Act for all the goods claimed.

Costs

41. As the opponent has been successful, it is entitled to a contribution towards the costs incurred in these proceedings. Using the guidance in Tribunal Practice Notice 2/2016, I make the following award:

£100 Official fee for filing the Notice of Opposition

£200 Preparing the Notice of Opposition

£400 Preparing submissions and considering the other side's submissions & evidence

£700 Total

42. I order Gecko Sportswear Ltd to pay Gottlieb Binder GmbH & Co. KG the sum of £700. This sum is to be paid within 14 days of the expiry of the appeal period or within 14 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 18th day of December 2017

June Ralph

For the Registrar,

The Comptroller General