

TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION No 10027  
BY KANGOL LIMITED  
FOR A DECLARATION OF INVALIDITY

IN RESPECT OF TRADE MARK No 2104167  
STANDING IN THE NAME OF KANGO PRODUCTS

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KANGO PRODUCTS

**DECISION**

15 Trade mark registration No 2104167 covers “Hair care products” in Class 3.

The registration with effect from 2 July 1996, is in the name of Kango Products. The mark itself is as follows:




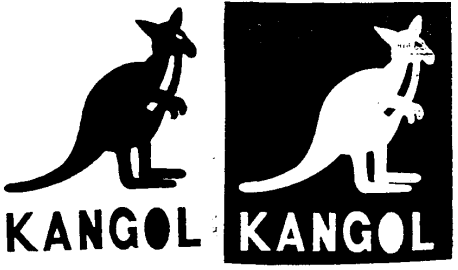
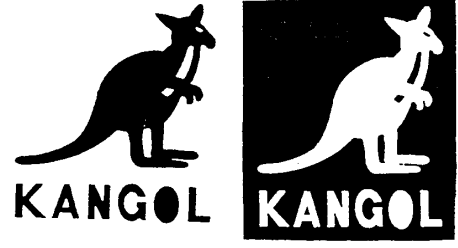
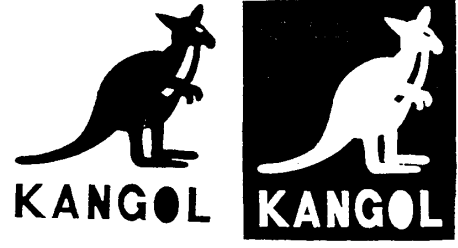
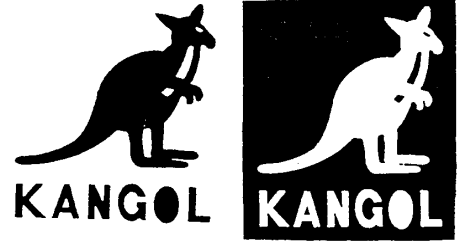


By an application dated 26 February 1998 Kangol Limited applied for a Declaration of Invalidity under the provisions of Section 47 of the Act. The grounds are:

35 i) The applicants are the proprietors of registration No 1559818 KANGOL & KANGAROO device and contend that they have an earlier right in relation to which the conditions set out in Section 5(2)(b) of the Act are satisfied. The applicants therefore seek a Declaration of Invalidity of the said registration in accordance with Section 47(2)(a) of the Act.

40 ii) The applicants are the proprietors of earlier rights, details of which are listed below, in relation to which the conditions set out in Section 5(3) of the Act are satisfied. The applicants therefore seek a Declaration of Invalidity of the said registration in accordance with Section 47(2)(a) of the Act.

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Trade Mark	Number	Date of Registration	Class	Specification
KANGOL	704306	24.6.52	25	Head-gear (for wear).
5 	1246111	13.7.85	25	Headgear (for wear).
10 	1288410	28.10.86	25	Headgear and caps; all for wear; hats included in Class 25.
15 	1322167	23.9.87	25	Articles of outerclothing included in Class 25; but not including footwear.
20 	1554352 Series of two marks	19.11.93	25	Articles of clothing; footwear; all included in Class 25; but not including any such goods made from kangaroo hide, or footwear in the form of kangaroos.
25 	1559818 Series of two marks	21.1.94	3	Soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; all included in Class 3.
30 				
35 				
40				

iii) The applicants have an earlier right in relation to which the conditions set out in Section 5(4)(a) of the Act are satisfied and the applicants therefore seek a Declaration of Invalidity of the said registration in accordance with Section 47(2)(b) of the Act.

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iv) In that the mark the subject of the said registration has been registered in bad faith contrary to Section 3(6) of the Act, the applicants hereby apply for a Declaration of Invalidity in accordance with Section 47(1) of the Act.

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The registered proprietor filed a counterstatement defending the registration and denying the applicants claims. Both sides ask for an award of costs.

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Both sides filed evidence in these proceedings and the matter came to be heard on 20 December 1999 when the applicants were represented by Mr Parker of Clifford Chance. The Registered Proprietor was not represented but sent in a letter which restated the views expressed in their evidence.

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#### APPLICANTS' EVIDENCE

This consists of eight statutory declarations. The first, dated 31 March 1999, is by Rachael Elizabeth Ambrose, a registered trade mark attorney acting on behalf of the applicants.

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Ms Ambrose provides a history of the company and the KANGOL trade mark which was first used in 1938. The name was derived from the first three letters of ANGora and the last two from WOol together with the letter K which some claimed came from the last letter of silK. She claims that the name is distinctive and that over the years the applicants have extended their interests to cover many products, some of which are still produced by associate companies.

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Ms Ambrose states that in the 1980's customers in the USA were asking for "kangaroo" hats and so the kangaroo device was added to the name and registered as a trade mark. She also claims that the applicants' products have become high fashion items with major celebrities wearing their headwear.

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Ms Ambrose claims that the KANGOL trade mark is well known worldwide. She states that in 1997 sales of headgear alone reached £25 million, and that together with licensed products annual sales under the trade marks exceeds £60 million. At exhibit REA2 are newspaper and magazine articles, dated between November 1993 and August 1998, which show the applicants' trade marks in use on hats and clothing. The pictures and articles emphasise that the hats in particular are an item of fashion wear, with numerous celebrities being shown wearing the product with the trade mark clearly visible.

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Ms Ambrose states that in 1992 the applicants were approached by a Japanese company to license the Kangol brand, and a broad range of products were launched including clothing, footwear, bags and other accessories such as cosmetics. Since then, she claims, other licenses have been agreed in Europe, North America and other countries. Annual sales for 1998 are said to be £36 million (wholesale). At exhibit REA4 are copies of brochures, most of which show use on headwear, although there are two leaflets and a small brochure showing a few bags & purses with the Kangol

& device trade mark on them. Most of these brochures are not dated, those that are show a date of 1998.

5 At exhibit REA5 is a schedule of KANGOL, KANGOL & DEVICE trade marks registered in other countries.

Ms Ambrose states that “The applicants make all effort to maintain the strength of the trade marks and prevent dilution of the brands and corporate identity.” She compares the marks of the applicant and registered proprietor and claims that they are similar. She claims that the words “T-Tree “ and “shampoo” should be disregarded as they are descriptive of the product. This leaves, she claims, the words “KANGO and a kangaroo device” to be compared with the applicants’ KANGOL and kangaroo device.

Ms Ambrose also claims that:

15 “The similarity is increased by the positioning of the word KANGO in combination with the T-TREE SHAMPOO identifier at the base of the KANGO trade mark to give the overall impression of an L shape within the mark, thereby distilling an overall sense of the KANGOL word.”

Further, Ms Ambrose claims that:

20 “This overall impression is further heightened by the inclusion of two kangaroo devices in the KANGO trade mark similar to the applicants’ kangaroo device. The kangaroo devices are conceptually identical as they are not representations of live creatures; they are caricatures of kangaroos in which the animal’s features have been embellished to make the trade mark more appealing.”

Whilst acknowledging that there are other trade marks in Class 3 on the UK Trade Marks Register which have a kangaroo device, Ms Ambrose claims that none of these other marks have a kangaroo device in combination with a word similar to Kangol. Also she claims that the other marks have lifelike representations of kangaroos and “may therefor be differentiated on this basis.”

Ms Ambrose also claims that:

35 “It is seen as a natural progression for companies who produce goods in Class 25 to launch ranges of personal care products, and therefore the purchasing public may well consider the KANGO trade mark is that of the applicants.

40 In this respect I refer to such clothing and accessories designers as Calvin Klein, Yves Saint Laurent, Giorgio Armani, Chanel, Christian Dior and the success of their ranges of fragrances and associated products.”

At exhibit REA6 Ms Ambrose provides copies of pages taken from the Internet at a single site which shows fragrances being offered under the names of the designers mentioned above. Ms Ambrose continues:

45 “Often the goods are sold under a different trade mark than the house mark. It is therefore

likely that if a purchaser were to see the KANGO trade mark, they would expect the goods sold thereunder to be those of the applicants. It has now become customary for clothing designers to sell Class 3 goods to complete the image of the purchaser. ”

5 At exhibit REA7 is a newspaper article referring to the proposed launch of a line of cosmetics and perfumes by the clothing designer Paul Smith, dated 13 December 1998.

10 Finally, Ms Ambrose claims that “many retailers have launched their own ranges of toiletries, cosmetics and haircare products. For example, Next, French Connection, The Gap and Miss Selfridge, all well known clothing retailers, sell such goods.”

At exhibit REA8 is a Next Christmas Catalogue for 1998 which shows class 3 goods such as shampoo, shower gel, soap etc.

15 The second statutory declaration, dated 13 November 1998, is by Emma Georgiou, the shopping / fashion editor of Select Magazine. Ms Georgiou claims that she is aware of fashion and has a good knowledge of the various brands in the market place. She claims that:

20 “Many people are aware of the applicants’ reputation in headwear, and may assume that they have launched a diffusion line in which their logo has been subtly modified. For example, I know that Dolce & Gabbana’s diffusion range is known by the different trade mark of D&G and the public may also expect Kangol to modify their logo in launching a range of cosmetics or hair care products.”

25 The third statutory declaration, dated 30 March 1999, is by Shelly Vella, the fashion Director of Company Magazine. She states that:

30 “The trade mark Kangol is well established and very recognisable, especially in the youth market who will wear the logo to the front as a sign to identify the brand which they are wearing. Since I started in the industry, Kangol Limited have branched out to other accessories, namely, watches, shoes and so on, and therefore I can imagine the progression into cosmetics or any other products would be easily made.”

35 The applicants have filed statutory declarations from Philip John Price a DJ and also the following Trade Mark Attorneys and Agents, Debra Parsons, Alasdair Lennie Macquarrie, Thomas Louis Brand and Alistair Robertson Gay. However, I find their evidence of no assistance and therefore have not recorded their views on the confusibility of the marks.

40 REGISTERED PROPRIETOR’S EVIDENCE

This consists of a statutory declaration, dated 8 July 1999, by Jane Hunter, a director of Kango Products Limited.

45 Ms Hunter claims that the marks in question are not similar as “the typography, phonetics of the spoken word, and visual kangaroo images are in no way similar.” She claims that the concept of the registered proprietor’s mark was developed to give the brand an authentic Australian ‘outback’

image. It is, she says, representative of symbolic aboriginal art, inspired by the centuries old drawings of aborigines.

5 In contrast Ms Hunter claims that the applicants' mark is a modern and lifelike interpretation of a kangaroo. She states "the difference could be likened to the comparison between a Byzantine image of Christ and one by a renaissance artist. No art historian would confuse them, nor a member of the public." She also claims that the fonts used by each party very different with the font used on the mark in suit being hand drawn.

10 Ms Hunter claims that although sharing the first five letters the marks are phonetically different to each other and that conceptually the word KANGO would be seen as a shortened version of kangaroo. A list of companies who use the name KANGO (and varieties of it) is provided along with the goods they provide. The marks are used for a range of products, none however are used on goods in Class 3.

15 Ms Hunter claims that the proprietors' product has received a number of write ups in magazines and yet none of the editors or buyers with whom the proprietors have dealt with have confused the products. At exhibit four are extracts from various national magazines showing advertisements and editorial coverage of the proprietors products, however these are all dated in 1997 (after the relevant date).

20 Ms Hunter states that the applicants have not yet marketed any products in Class 3, but claims that when they do their products will be competing with other designer ranges such as Armani, Hugo Boss etc whereas their product retails at £2.99 and is targeted at the mass market. She also points out that no instances of confusion have been shown by the applicants.

25 Ms Hunter also comments on the evidence supplied by the opponents, but as these are all subjective views they are not relevant.

30 That concludes my review of the evidence. I now turn to the decision.

## DECISION

35 The request for the declaration of invalidity is made under the provisions under Section 47(1) & (2) of the Act. These state:

40 *47.- (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).*

45 *Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.*

*(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

5 (b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier mark or other earlier right has consented to the registration.

10 The applicants grounds are, in this case, based upon Sections 3(6), 5(2)(b), 5(3) & 5(4).

I shall deal first of all with the ground of the application for the declaration of invalidity based upon Section 5(2)(b) of the Act. This reads:

15 “5.(2) A trade mark shall not be registered if because -

(a)...

20 (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 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.”

25 An earlier right is defined in Section 6, the relevant parts of which state

6.- (1) In this Act an ‘earlier trade mark’ means -

30 (a) a registered trade mark, international trade mark (UK) or Community trade mark 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,

35 (b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), or

40 (c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well known trade mark.”

45 The applicants trade mark in Class 3, 1559818, has a registration date of 21 January 1994. It is therefore an “earlier trade mark”. Under Section 72 of the Trade Marks Act 1994 the registrations 1559818 and 2104167 are, prima facie, valid. There is no attack on the validity of the applicants registration number 1559818.

The onus is on the applicants to show that registration 2104167 is invalid. Even though there is no evidence that the earlier trade mark has been used the tribunal must assume that it has been



used or at least consider whether there is a likelihood of confusion if the earlier mark comes into use. I look to the ORIGINS case [1995] FSR 280 at page 284 where Jacob.J. stated:

5 “It is queried whether the plaintiffs ever will use their mark. If they do not the defendant asks ‘how can there ever be a likelihood of confusion on the part of the public?’ In my judgement this point is misconceived. Section 10 of the Trade Marks Act presupposes that the plaintiff’s mark is in use or will come into use. It requires the court to assume the mark of the plaintiff is used in a normal and fair manner in relation to the goods for which it is registered and then to assess a likelihood of confusion in relation to the way the defendant uses its mark, discounting external added matter or circumstances. The comparison is mark for mark..”

15 The correct approach to the interpretation of the expression “a likelihood of confusion on the part of the public” as used in Article 4(1)(b) and Section 5(2) was considered by the Court of Justice of the European Communities (ECJ) in Case C251/ 95 *Sabel BV v. Puma AG, Rudolf Dassler Sport* [1998] RPC 199. The way in which the presence or absence of a “likelihood of confusion” should be assessed was identified in paragraphs 23 and 24 of the judgement of the court at page 223:

20 *“Article 4(1)(b) of the directive does not apply where there is no likelihood of confusion on the part of the public. In that respect, it is clear from the tenth recital in the preamble to the Directive that the appreciation of the likelihood of confusion ‘depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified’. The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case.*

30 *Global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The wording of Article 4(1)(b) of the Directive - “there exists a likelihood of confusion on the part of the public” - shows that the perception of the marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.*

40 *In that perspective, the more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either per se or because of the reputation it enjoys with the public.”*

45 I also find the following observations of Geoffrey Hobbs QC (sitting as the Appointed Person) in BALMORAL trade mark [1999] RPC 297 useful in relation to the approach to be adopted:

“The tenth recital to the Directive and these observations of the Court of Justice indicate

that an objection to registration under section 5(2) of the Act should be taken to raise a single composite question: are there similarities (in terms of marks and goods or services) which would combine to create a likelihood of confusion if the “earlier trade mark” and the sign subsequently presented for registration were used concurrently in relation to the goods or services for which they are respectively registered and proposed to be registered?”

The registered proprietor has applied for their mark to be registered for “hair care products” in Class 3. The applicants have mark number 1559818 registered for “Soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; all included in Class 3”. Clearly there is a considerable degree of similarity between the specifications, and the registered proprietors goods are identical to “hair lotions”.

The Registered proprietors’ mark and the applicants series of two marks are reproduced below to aid comparison

Registered Proprietors’ Mark



Applicants’ Marks (1559818)



The registered proprietors’ mark consists of the words “KANGO” and “T-Tree shampoo” plus two highly stylised kangaroo devices and two abstract designs. The applicants’ series of two marks are identical in consisting of the word “KANGOL” and a kangaroo device, one being a positive image (black on white) the other the negative version (white on black).

Visually, although the fonts used are different, the dominant feature of each mark are the words KANGO and KANGOL. These differ only to the extent that that the applicants’ mark has an “L” at the end. The device elements in the registered proprietors’ mark are stylised. Some people would recognise them as kangaroos, others would not. The fact that KANGO is similar to and, according to the proprietor’s witness, a shortened version of the word kangaroo would increase the likelihood of the devices being seen as such by the average consumer. The marks are visually similar.

Phonetically, the first syllables of the words are identical, the second syllables differ in that whereas the applicants’ mark ends with an “GOL” sound, the registered proprietor’s mark ends in a “GO” sound. It is accepted that the ends of words tend to be slurred, and that it is the beginnings of words which are the most important for the purposes of this kind of comparison. The marks are similar to the ear.

Conceptually the marks both have images of a kangaroo, and a word which reflects this imagery. The registered proprietor has made the point that whereas KANGO is a shortened version of the word kangaroo, the applicants’ trade mark, KANGOL, has no meaning. However, the applicants’

trade mark has a clear kangaroo device included within it and this sends out its own message which will condition the average consumers perception of the word KANGOL. The average consumer would, in my opinion, see the mark KANGOL as alluding to kangaroo (as KANGO does).

5

I believe that paragraph 26 of the European Court of Justice's decision in *Lloyd Schufabrik* ( at page 198) is of assistance. It is re-produced below:

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“26. For the purposes of that global appreciation, the average consumer of the category of products concerned is deemed to be reasonably well-informed and reasonably observant and circumspect (see, to that effect, Case C-210 / 96 *Gut Springenheide* and *Tusky* (1968) E.C.R. 1-4657, paragraph 31). However, account should be taken of the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks but must place his trust in the imperfect picture of them that he has kept in his mind. It should also be borne in mind that the average consumer's level of attention is likely to vary accordingly to the category of goods or services in question.”

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The conceptual similarity between the trade marks is an important factor in judging the likelihood of confusion through imperfect recollection, especially where, as in this case, there are also visual and phonetic similarities. The combined effect is that the marks convey a similar overall impression. The relatively low cost of hair care products is another factor which points towards a likelihood of confusion as it suggests that marks on the products will not be subject to a detailed and careful scrutiny before they are purchased.

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The marks are very similar and the goods are identical. When considering the question of the likelihood of confusion I conclude that:

1) there is a likelihood of the marks being confused in speech through the slurring of KANGOL or KANGO, and

2) there is a likelihood of confusion, visually and aurally through imperfect recollection.

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Registration of number 2104167 was therefore made contrary to Section 5(2) of the Act. The application for a declaration of invalidity under Section 47(2) therefore succeeds.

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Given my finding above there is no need to consider the other grounds for invalidity.

As the applicants have been successful, they are entitled to a contribution towards their costs. I order the Registered Proprietor, to pay the applicants the sum of £635

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Dated this 7 day of February 2000

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George W Salthouse  
For the Registrar  
The Comptroller General