

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 80033
BY CARSTEN SPORTS LIMITED FOR A DECLARATION
OF INVALIDITY IN RESPECT OF REGISTRATION
No 2115577A STANDING IN THE NAME OF
BENETTON GROUP SPA**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 80033
by Carsten Sports Limited for a Declaration of
Invalidity in respect of registration No 2115577A
standing in the name of Benetton Group SpA**

DECISION

1. The following series of marks is registered under No 2115577A for the specification of goods and services set out in the Annex to this decision:



2. The proprietor's claim the colours red, yellow, green and blue as an element of the second mark in the series but nothing turns on this point.

3. The registration has a filing date of 13 November 1996 and a priority date of 31 October 1996.

4. By application dated 17 August 2001 Carsten Sports Limited applied for this registration to be declared invalid. They are the proprietors of the following registration which, they say, is an earlier trade mark within the meaning of Section 6(1)(a) of the Act.

No	Mark	Class	Specification
1491130	FORMULA 1	28	Golf clubs; golf club components; heads, shafts, and grips, all for golf clubs; golfing apparatus; bags adapted to carry sporting articles; golf gloves, golf head covers, golf practise nets and mats, golf club stands; all included in Class 28.

5. They express the objection in the following terms:

"The registered proprietors trade mark contains the prominent use of FORMULA 1 which is identical to the Applicants trade mark and is registered for identical, similar and dissimilar goods. The Applicants contend that the registration in suit offends against the provisions of Section 47(2)(a) of the Act because the registration in suit is registered for goods identical and similar to those for which the earlier trade mark is protected and therefore there exists the likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark so that the conditions set out in s.5(2)(b) obtain.

With reference to the above sub-paragraph, the Applicants contend that the similar goods¹ are as follows:

S	Class 9	teaching apparatus and instruments and computer software, where these are related to golf
S	Class 16	printed matter relating to golf
S	Class 25	clothing articles, footwear and headgear relating to golf
S	Class 35	advertising services relating to golfing articles or services, management services where these relate to golfing articles or services

and that the identical goods are:

S	Class 25	clothing, where this includes golf gloves
S	Class 28	sporting articles being related to golf; sporting articles where these are bags adapted to carry sporting articles."

6. They ask that the registration be declared invalid in respect of the above-mentioned goods.
7. The applicants filed a counterstatement denying the above ground and offering a number of submissions in relation to the marks and the goods.
8. Both sides ask for an award of costs in their favour.
9. Both sides filed evidence. Neither side has asked to be heard. Written submissions have been received from Murgitroyd & Company on behalf of the registered proprietors.
10. Acting on behalf of the Registrar and with the above material in mind I give this decision.
11. The evidence filed in these proceedings is as follows:

Applicants' evidence in chief:

¹ For the actual specification of the mark under attack reference should be made to the Annex of this decision.

Applicants' evidence in chief:

Statutory Declaration by Stephen Mark Waine with exhibits SMW1 - SMW3

Proprietors' evidence in support:

Witness Statement by Jacqueline McKay with exhibits JMK1 - JMK4

Applicants' evidence in reply:

Witness Statement by Joanne Marie Ling with exhibit A.

12. I do not propose to offer the normal evidence summary as the above material consists almost exclusively of submissions. I will take these into account at appropriate points in my decision. Ms McKay's evidence also includes a number of assertions bearing on public awareness of the registered proprietors' brand. However the claims are insufficiently particularised and substantiated for me to be able to draw any meaningful conclusions.

13. The action is based on Sections 47(2) and 5(2)(b) of the Act which read:

"47.-(1)

(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 right in relation to which the condition 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,

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

14. It is not, I think, disputed that the applicants' mark is an earlier trade mark within the meaning of Section 6(1)(a).

Distinctive character of the applicants' mark

15. The distinctive character of the earlier trade mark is a factor that must be taken into account, *Sabel BV v Puma AG* [1998] ETMR 1. As no evidence has been filed bearing on use of the applicants' mark, I can only base my consideration on the inherent characteristics of the mark in the context of the goods for which it is registered. The registered proprietors suggest that FORMULA 1 is a very weak mark given its strong sporting connotations. They support that view by reference to a disclaimer of the words 'Formula One Grand Prix Team' in a third party mark which is registered for articles of clothing.

16. The applicants, on the other hand, say that FORMULA 1 is not purely descriptive adding that it may be so in relation to cars and motorsport but not in relation to golf equipment.

17. I favour the applicants' view of the matter. The use of Formula 1 outside the context of motor sport may produce desirable associations with the image that motor racing enjoys but it does not necessarily render the word and numeral combination descriptive in relation to other goods and services. There may be other reasons why Formula 1 might be said to lack, or be low in, distinctive character eg goods which may be formulated in some way or be referred to using the word formula. There is no evidence before me that the goods of the earlier trade mark (golfing apparatus) are referred to in this way. I, therefore, consider that the earlier trade mark has an average (but not enhanced) degree of distinctive character.

Similarity of marks

18. The visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by those marks bearing in mind their distinctive and dominant components, *Sabel BV v Puma AG*, [1998] ETMR1. The matter must be judged through the eyes of the average consumer of the goods/services in question, *Sabel v Puma*, paragraph 23. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant but rarely has the chance to make direct comparisons between marks. Imperfect recollection must, therefore, be allowed for, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] FSR 77.

19. The average consumer for the goods objected to is likely to be the public at large. The Class 35 services are more likely to be required by businesses, clubs, associations etc.

20. For ease of reference I set out below the parties' marks:

Applicants' mark

FORMULA 1

Registered proprietors' marks



21. I have already commented on the distinctive character of the applicants' mark. The registered proprietors' marks are made up of a number of elements. Ms McKay, in her Witness Statement, notes that they have a number of features not found in the applicants' mark, notably the words BENETTON and RACING TEAM, the device on the right hand side and the orientation of the elements. Ms Ling, for the applicants, submits that the applicants' entire mark appears in the proprietors' marks and is a distinctive and dominant component of those marks. The stylisation of the words in the proprietors' marks is, in her view, negligible and the words RACING TEAM are a subordinate element and likely to be overlooked. In her view FORMULA 1 will be perceived as a sub brand of BENETTON and result in confusion with the applicants' mark.

22. I find the 10 ROYAL BERKSHIRE POLO CLUB TRADE MARK case, [2001] RPC 32 page 643, to be of assistance in determining my approach to the issue before me. In that case the composite mark 10 ROYAL BERKSHIRE POLO CLUB applied for in respect of Class 3 goods was opposed by the proprietors of the mark POLO (registered for identical goods). It will be convenient to record the Appointed Person's reasons for allowing the applicants' appeal:

"30 When considering whether the use of the applicant's mark was liable to cause confusion at the relevant date it is necessary to beware of approaching that question with knowledge that there is a question, when the real task is to determine what impression the use of that mark would make upon people in the ordinary course of trade in goods of the kind specified in the application for registration: see *Marengo v Daily Sketch and Sunday Graphic Ltd* (1948) 65 RPC 242, HL, at page 250 per Lord Simonds.

31 Approaching the matter in that way, I am satisfied that the use of the word POLO as part of the applicant's mark does not capture the distinctiveness of the opponent's earlier trade marks. I do not think that people exposed to the use of the applicant's mark would notice that it contained the word POLO

without also noticing that it contained the words ROYAL BERKSHIRE and CLUB. The message of the mark comes from the words in combination and that is not something that I would expect people to overlook or ignore in the ordinary way of things.

- 32 The applicant's mark would naturally be understood to represent that the ROYAL BERKSHIRE POLO CLUB was directly or indirectly responsible for the goods to which it was applied. The presence of the numeral 10 in the applicant's mark adds to the individuality of the mark (whether or not it is appreciated that 10 is the highest handicap a polo player can have). Abbreviations and approximations would, in my view, be likely to centre on the words ROYAL BERKSHIRE because they contribute more than the other words to the identification of the club named in the mark.
- 33 The word POLO functions adjectivally in the context of the applicant's mark whereas the opponent's earlier trade mark registrations envisage use of the word POLO in a manner that would, most likely, be perceived as a noun. Adjectival use of a word is distinguishable from use of the same word as a noun and the resulting differences of perception may be sufficient to preclude a likelihood of confusion cf *The European Ltd v. The Economist Newspaper Ltd* [1998] F.S.R. 283, CA, at page 293 per Hobhouse L.J. I think that is the case here. In my view the semantic content of the marks in issue is (and was at the relevant date) insufficiently similar or analogous to give rise to the mistaken belief that POLO brand toiletries and ROYAL BERKSHIRE POLO CLUB toiletries come from the same undertaking or economically-linked undertakings."

23. I should add by way of a footnote to the above that the applied for mark had the words POLO CLUB presented in a different typeface from the words ROYAL BERKSHIRE and in, arguably, a more visually prominent lettering. The precise form of presentation can be seen on page 646 of the RPC in question.

24. With the guidance from the ECJ cases and 10 ROYAL BERKSHIRE POLO CLUB in mind, I turn to my views on the marks before me. The word and numeral FORMULA 1 are given equal prominence to the word BENETTON. The applicants are right, in my view, to point out that the words RACING TEAM are subordinate in terms of their presentation but not so much so, I think, that their presence would go unnoticed within the totality of the marks. The combination of words indicate that the BENETTON FORMULA 1 RACING TEAM is directly or indirectly responsible for goods or services supplied under the mark. The device element too is not to be ignored. It is perhaps best described as abstract in nature but suggestive of a flag or pennants. It may further reinforce the connection with motor racing but I do not place particular reliance on such a connection being made.

25. In common too with the 10 ROYAL BERKSHIRE POLO CLUB case the word and numeral FORMULA 1 function adjectivally to describe the nature of the RACING TEAM. The proprietors' marks take their character from the totality of the words, numeral and device. Basing a comparison on the element common to both parties' marks involves an artificial

dissection of the registered proprietors' marks. Notwithstanding the presence of an identical element, the overall visual, aural and conceptual comparison leads me to the view that the respective marks are different in character.

Similarity of goods

26. In the light of my finding in relation to the marks I do not propose to comment exhaustively on the respective sets of goods. However, in deference to the evidence/submissions filed by the parties I will record the main points made and my own view of the matter.

27. The applicants' position is that:

- the term sporting articles in the proprietors' specification must include the applicants' specific goods;
- clothing articles would be considered similar if such products relate to golf and the playing of golf. It is suggested that special clothes to play golf are standardly worn by golfers throughout the world;
- several clothing companies are associated with golf products and golf apparel. Tommy Hilfiger and Ralph Lauren produce clothing specifically for golf players (Exhibit SMW1);
- the proprietors have links to golf including the granting of licenses to use the name BENETTON on golf clubs;
- some sports companies now manufacture not just sports clothing but also casual clothing. Examples are said to be Nike, Adidas and Slazenger (Exhibit SMW3);
- in relation to the proprietors' Class 9 goods it is submitted that computer software could relate to golf software and golf games and that teaching apparatus and instruments could relate to golf;
- the same is said to be true of the Class 16 goods and the Class 35 services.

28. The registered proprietors' main evidence/submissions are that:

- the applicants' goods are specialist items and attract a discerning audience;
- the Registry's cross-search list (Exhibit JMK4) suggests that the Registry does not generally see similarity between the respective sets of goods.

29. Mr Justice Jacob set out the test for assessing similarity of goods and services in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 at page 296. The matter was

considered in *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc* [1999] RPC 117. In its judgment in the CANON case the ECJ stated:

"23. 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 end users and their method of use and whether they are in competition with each other or are complementary."

30. It seems to me that the applicants are indisputably correct in saying that the registered proprietors' Class 28 specification covers identical goods in as much as it contains the broad term 'sporting articles'. The goods of the applicants' own specification are simply a sub-set of goods within the broad term.

31. The other goods and services objected to are in Classes 9, 16, 25 and 35. On the basis of the limited argument and evidence before me I am unable to accept that the items identified in Class 9 (teaching apparatus and instruments and computer software, Class 16 (printed matter) and Class 35 (advertising and management services) can be said to be similar to the applicants' Class 28 goods. Their nature and purpose must be different. There is no, or insufficient, information on whether channels of trade coincide. To the extent that the proprietors' goods and services could be golf related, they might be complementary and share the same users at a general level. But the connection is too tenuous to find overall similarity.

32. The applicants have directed most of their evidence to the Class 25 goods where there is some evidence to suggest that the clothing and golfing goods markets have points of overlap. The process is a two way one with leading fashion brands being directed at the golf clothing market (Ralph Lauren and Tommy Hilfiger) and sports equipment companies such as Adidas and Slazenger entering the sports clothing market. The applicants suggest that the possibility of confusion exists in retail outlets for golfing products. There may be some force to this argument but under Section 47 the material date is the filing date of the application under attack. I must therefore, take a view of the matter based on circumstances prevailing in the marketplace at that time (October 1996). Whether the current trading circumstances described and evidenced by the applicants is a fair reflection of the position in October 1996 is not clear. I am inclined to think that items of clothing which might be said to be exclusively or strongly associated with the sport of golf (golf shoes and plus fours are the obvious examples) should be considered similar to the applicants' golf gloves within the CANON/TREAT test. The case for a wider range of casual clothing to be considered similar is less easy to see even accepting that golfers wear a range of casual clothing. At least I am not persuaded that I can make such a finding as at October 1996.

Likelihood of confusion

33. In *RALEIGH INTERNATIONAL Trade Mark*, [2001] RPC 11, page 202, Mr Hobbs QC, sitting as the Appointed Person said:

"Similarities between marks cannot eliminate differences between goods or services;

and similarities between goods and services cannot eliminate differences between marks. So the purpose of the assessment under section 5(2) must be to determine the net effect of the given similarities and differences."

34. In the light of my views on the marks themselves, it follows that there can be no likelihood of confusion even if the registered proprietors' marks are used on identical goods. The application for invalidity fails accordingly.

35. The registered proprietors are entitled to a contribution towards their costs. I order the applicants for invalidity to pay them the sum of £1500. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 30 day of July 2002

M REYNOLDS
For the Registrar
the Comptroller-General

Specification of registration No. 2115577A

Class: 03

Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; none being for use with vehicles; dentifrices.

Class: 08

Hand tools and implements (hand operated); cutlery; forks and tablespoons; side arms; razors.

Class: 09

Photographic, cinematographic apparatus and instruments; life-saving and teaching apparatus and instruments; apparatus for recording, transmission and reproduction of data, sound or images; cash registers; data processing equipment; computers and computer software.

Class: 11

Apparatus for heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes.

Class: 12

Motor cars, motor racing cars, motorcycles, cycles; parts and fittings for all the aforesaid goods; all included in Class 12.

Class: 14

Precious metals and their alloys and goods in precious metals or coated therewith, jewellery, precious stones; watches and other chronometric instruments.

Class: 16

Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding materials; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except apparatus); plastic materials for packaging (not included in other classes); playing cards; printers' type; printing blocks.

Class: 18

Leather and imitations of leather and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.

Class: 20

Furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother of pearl, meerschaum and substitutes for all these materials, or of plastics.

Class: 21

Household or kitchen utensils and containers (not of precious metal or coated therewith); combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes.

Class: 24

Tissues and textile articles in general and in particular bed and table covers.

Class: 25

Clothing articles, footwear and headgear; but not including stockings, socks or tights.

Class: 27

Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; wall hangings (non-textile).

Class: 28

Games and playthings, gymnastic and sporting articles, not included in other classes; decorations for Christmas trees.

Class: 34

Tobacco; smokers' articles; matches.

Class: 35

Advertising services; advertising services relating to the trade and sale in the field of clothing articles and footwear, perfumery, optical goods, stationery, watches, leather goods, sporting articles, games and playthings; management services in relation to shops of clothing articles and footwear, perfumery, optical goods, stationery, watches, leather goods, sporting articles, games and playthings.