

TRADE MARKS ACT 1994

IN THE MATTER OF

OPPOSITION No. 70901


IN THE NAME OF AMBERES SA

TO TRADE MARK APPLICATION No. 602064

IN THE NAME OF KE-PRO BV

DECISION

1. On 20th November 2001 Ke-Pro BV (*'the Applicant'*) applied for protection of the following trade mark in the United Kingdom under the provisions of the Madrid Protocol on the basis of registration in the Benelux:



SKORPI

2. Protection was requested in respect of the following goods:

Class 14:

Precious metals and their alloys and goods made of these materials or coated therewith not included in other classes; jewelry, precious stones; timepieces and chronometric instruments.


Class 25:

Clothing, footwear, headgear.

Class 28:

Games, toys; gymnastic and sporting articles not included in other classes; Christmas tree decorations.

3. The application was opposed by Amberes SA (*'the Opponent'*) on the basis of the rights to which it was entitled as proprietor of two earlier trade mark registrations:

| Registration No. | Mark | Effective Date | Specification of goods |
|---------------------------------------|---|-----------------------|--|
| UK Registration No. 772654 |  | 31 December 1957 | Class 25: Sweaters, jersey's, undershirts and bathing costumes, all being knitted articles of clothing. |
| Community Trade Mark No. 778217 | ESCORPION | 16 April 1998 | Class 22: Nets and netting. Class 24: Bed covers, bed sets, table linen, white and coloured linen (household linen), bath sheets, towels, knitwear items, mesh (fabric). |

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|--|--|---|
| | | <p>Class 25: Coats, dressing gowns, housecoats, smoking jackets, smocks, trousers, collar protectors, underpants, shirting, undershirts, nightdresses, layettes (outfits), windcheaters, slippers, bodices, shawls, head scarves, jackets, scarves, petticoats, girdles, skirts, gabardines, waterproof clothing, jerseys, kimonos, bed jackets, head and neck scarves of wool, pelisses, pyjamas, ready-made clothing, brassieres, swimsuits, ready-made clothing for women, men and children, lingerie, corsetry, dresses, hats, collars and wristbands (for clothing); stockings and socks; ready-made hosiery, made-up netting.</p> <p>Class 26: Hair nets.</p> |
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4. For present purposes I need only refer to the objection raised under section 5(2)(b) of the Trade Marks Act 1994: it was contended that the marks in issue were too similar to be used concurrently in relation to the goods in issue without giving rise to the existence of ‘*a likelihood of confusion*’ within the meaning of that expression as interpreted by the ECJ in Case C-39/97 Canon KK v. Metro Goldwyn Mayer Inc [1998] ECR I-5507.

5. In a written decision issued on 20th December 2004 (BL O-372-04) Mr. John MacGillivray acting on behalf of the Registrar concluded that the marks in issue were dissimilar to a degree that would enable them to be used concurrently in relation to goods of the kind in issue without any ensuing likelihood of confusion.

6. He was wary of the letter-based approach to similarity urged upon him by the Opponent:

The opponent points out that the applicant's mark shares the letters S, O, R, P and I, with the word ESCORPION, and that the letter K in SKORPI is phonetically identical to the letter C in ESCORPION. The opponent submits that 66% of its mark is subsumed by the applicant's mark. While this is of undoubted relevance, the respective marks must be compared as a whole and by reference to their overall impression. It is, of course, possible to over analyse marks and in doing so shift away from the real test which is how marks would be perceived in the normal course and circumstances of trade.

7. On visual comparison of the marks he found as follows:

The words SKORPI and ESCORPION share the letters S, O, R, P and I. They differ in length, the mark applied for consisting of six letters and the word ESCORPION nine letters. The first two letters of the words and their terminations differ. Furthermore, the letter O within the word SKORPI has a different visual impact from the remaining letters, and in the opponent's UK registration contains the device of a scorpion. As mentioned earlier, my decision on similarity must be based on overall impression and notwithstanding that both marks share a high proportion of letters, the beginnings and terminations of the respective words are, in my view,

conspicuously different so that, in totality the marks look different and would be readily distinguished in visual use.

8. On aural comparison of the marks he found as follows:-

The word SKORPI is a two syllable word while the word ESCORPION is four syllables. Furthermore, the beginnings and endings of the words would be obviously different in oral use. I have little doubt that they sound different overall.

9. On conceptual comparison of the marks he found as follows:

While the opponent's earlier marks may well denote a "scorpion" insect, it does not seem obvious to me that the word SKORPI would necessarily denote the word "scorpion" or a reference to the insect. However, it could do so to some people, and on this basis there may be some conceptual association between the respective marks.

10. Having considered the net effect of the differences and similarities between the marks from the viewpoint of the average consumer of the goods concerned, he concluded that the opposition should be rejected. He ordered the Opponent to pay the Applicant £1,600 as a contribution towards its costs of the Registry proceedings.

11. The Opponent gave notice of appeal to an Appointed Person under section 76 of the Act contending, in substance, that the hearing officer was mistaken in thinking that the marks in issue were not sufficiently similar to give rise to the

existence of a likelihood of confusion in the event of concurrent use for goods of the kind in issue.

12. This contention was developed in argument at the hearing before me. In particular it was maintained on behalf on the Opponent that the marks were conceptually similar to a degree which rendered the visual and aural differences between them insufficient to avoid a likelihood of confusion.

13. I do not doubt that conceptual similarity may diminish the significance of visual and aural differences between words. Nor do I doubt that visual and aural similarities between words may pale into insignificance as a result of conceptual dissimilarity. The look and sound of a word none the less remain determinative in relation to likely conceptions of it.

14. I think that the Opponent's earlier trade marks 'speak Spanish' to those by whom they are likely to be seen and heard. In doing so, they are liable to prompt recollections of the English word SCORPION. The English word SCORPION and its Spanish equivalent ESCORPION have an affinity for one another. And the depiction of a scorpion clearly reveals the meaning of the word ESCORPION in the earlier device mark.

15. The opposed mark, taken as the word SKORPI, tends to look and sound Greek. As noted in the Shorter Oxford English Dictionary, the English word SCORPION is a handed down word derived from the Greek word SKORPIOS:

Old & mod. French from Latin *scorpio(n-)* extension
of *scorpius* from Greek *skorpios*.

And SKORPII is a transliteration of the Greek word for SCORPIONS. So it is possible by a process of analysis, abbreviation and approximation to link the word SKORPI to the Greek and English words for SCORPION.

16. However, that does not appear to me to be a process that would have any bearing on the way in which the word SKORPI was actually likely to be perceived and remembered by people in the United Kingdom who were exposed to the use of it as a trade mark for goods of the kind specified in the application for registration. I think that SKORPI would, in that context, be regarded by the average consumer of the goods concerned as a 'new' word. And I do not think it would, when perceived and remembered from that perspective, carry connotations of the English word SCORPION.

17. For these reasons I consider that the marks in issue are conceptually dissimilar to a degree which adds weight to the visual and aural differences between them.

18. The hearing officer was undoubtedly correct to proceed on the basis that the marks should be assessed and compared without dismemberment or excision. His assessments and comparisons of the visual and aural characteristics of the marks do not appear to me to be open to criticism. The visual stylisation of the word SKORPI as presented for registration is apt to encourage differentiation. I

agree with the hearing officer's conclusion that the objection to registration under section 5(2)(b) of the Act should be rejected.

19. In the result the appeal will be dismissed. Since I have no reason to believe that the Opponent has incurred any separately identifiable costs in respect of it, the appeal will be dismissed with no order as to costs.

Geoffrey Hobbs QC

12th September 2005

Mr John Slater of Messrs Marks & Clerk appeared on behalf of the Applicant.

The Opponent was not represented at the hearing.

The Registrar was not represented at the hearing.