

O-236-07

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2354920  
BY THE DRUNKEN MONKEY LIMITED TO REGISTER  
A SERIES OF TRADE MARKS IN CLASSES 41 & 43**

**AND**

**IN THE MATTER OF OPPOSITION No. 92907  
BY NINE DOTS LLC**

## TRADE MARKS ACT 1994

**IN THE MATTER OF Application No. 2354920  
by The Drunken Monkey Limited to register a series  
of trade marks in Classes 41 & 43**

**and**

**IN THE MATTER OF Opposition No. 92907  
by Nine Dots LLC**

### BACKGROUND

1. On 2 February 2004 The Drunken Monkey Limited applied to register the following series of three marks:

the drunken monkey  
THE DRUNKEN MONKEY  
The Drunken Monkey

2. Nothing turns on the fact that it is a series application. The application is in respect of the following services.

#### **Class 41**

Organisation, arrangement and conducting of entertainment events; club entertainment services; discotheque services; night club services; party, ball and event planning (entertainment) and organisation; provision of information, advice and consultancy in relation to all the aforementioned.

#### **Class 43**

Provision of food and drink for consumption both on and off the premises; food preparation and planning services; catering services; restaurant services; banqueting services; bar, cafe, coffee shop and cafeteria services; cocktail lounge services; food cooking services; restaurant and bar management services; provision of information, advice and consultancy in relation to all the aforementioned services.

3. On 28 October 2004 Nine Dots LLC filed notice of opposition to this application. It is the proprietor of CTM No 2586477, **drunknmunky**, for a specification of goods in Class 25 that reads “clothing, footwear, headgear; t-shirts, shirts, sweatshirts, hats, jeans, pants, trousers, blouses, shorts, belts; accessories for all of the aforesaid goods”.

4. On the basis of this registration, which has a filing date of 20 February 2002 (and is thus an earlier trade mark), objections are raised under Section 5(2)(b) and 5(3) of the Act. The following submission is contained in the statement of grounds:

“In particular it is submitted that it is common for nightclubs and bars to have t-shirts and other clothing products associated with them, and/or produced

under licence. On this basis, and bearing in mind the nature of the trade mark in question here, it is submitted that members of the public may assume an economic connections between the two trade marks and therefore be confused.”

5. Use of the earlier trade mark is claimed from at least as early as 20 February 2002 for Section 5(3) purposes. The opposition is said to be against all the goods (services) of the application.

6. The applicant filed a counterstatement denying the grounds of opposition and putting the opponent to proof of the reputation claimed in support of the Section 5(3) claim.

7. Only the opponent has filed evidence. The matter came to be heard on 30 July 2007 when the applicant was represented by Mr M Engelman of Counsel instructed by Guy Selby-Lowndes and the opponent by Mr J Stobbs of Boulton Watt.

### **Opponent’s evidence**

8. This consists of a witness statement by Christian Stewart of Siesta which he refers to as his company. He does not say what position he holds but does say that he has been employed by Siesta for more than five years. It seems that Mr Stewart and/or Siesta has been the opponent’s UK distributor for over five years. The witness statement is not dated. I should say at this point that these and a number of other deficiencies in Mr Stewart’s statement are the subject of a witness statement by Julius Stobbs which seeks to correct the position. He confirms that Mr Stewart is a Director and shareholder of Siesta; that Siesta is Siesta Clothing Limited and that the original witness statement was signed by Mr Stewart on 4 November 2005. I comment further on these matters under ‘preliminary point’ below.

9. Mr Stewart says that the DRUNKNMUNKY mark has been used continuously in the UK since September 2001 and all products bear the mark. During that time total turnover has been approximately £3 million equating to some 600,000 units at a value of about £5 each. Annual advertising expenditure is said to be £50,000 and has been spent on placing advertising material in trade journals, leaflets, attending exhibitions along with retail store advertising. The goods have been sold in a wide range of areas in the UK. In London goods are distributed to all House of Fraser stores (since 2002), Selfridges and JJB Ikon stores. Products have also been distributed to the high street stores Cult Clothing and Westworld since 2001. Clothing sold under the DRUNKNMUNKY brand is also sold through a wide variety of sites on the internet including through ebay, Cult Clothing and the opponent’s own site. In support of these claims Mr Stewart exhibits the following:

CS1 - an extract from [www.chicksrule.co.uk](http://www.chicksrule.co.uk) illustrating t-shirts (as worn by Dido).

CS2 - an ebay advertisement for a beanie hat. The advertisement carries a start time of 1 July 2005 18:32:05 BST.

- CS3 - examples of cult.co.uk's and the opponent's own website offering goods for sale.
- CS4 - other website material said to illustrate the high profile of DRUNKNMUNKY clothing.
- CS5-7 - articles or photographs said to show that the brand has become commonly worn by famous people including Rio Ferdinand (of Manchester United) and, by report, David Beckham, Dido, Jay-Z, Linkin Park and Pharrall.

10. That completes my review of the evidence.

### **Preliminary point**

11. Mr Engelman's skeleton argument raised a number of issues going to the validity of the opponent's evidence. The background to this is that there was an interlocutory hearing on 31 May 2006 which resulted in the hearing officer allowing the opponent a period of one month to correct certain deficiencies in Mr Stewart's witness statement. As will be apparent from my evidence summary the mechanism by which the necessary corrections were achieved was a witness statement by Mr Stobbs. The hearing officer's decision was recorded in his letter of 1 June 2006 and was subsequently the subject of a statement of grounds dated 24 July 2006. There was no appeal against that decision. The applicant's professional representative, nevertheless wrote to the Registry on 14 December 2006 indicating that it did not wish to file evidence of its own but "proposes to contest the validity of the documents filed purporting to be evidence". The nature of the intended challenge (in the absence of an appeal against the hearing officer's decision) was not further elucidated at least until Mr Engelman's skeleton argument for the substantive hearing.

12. So far as I can see the directions given by the hearing officer were complied with in the timescale set so I can see no basis for re-opening those issues. In the event I think it is fair to say that Mr Engelman's residual concern was more to do with the weight to be attached to the evidence rather than the form or substance of what had been submitted. In particular it is said that the supplementary/corrective information contained in Mr Stobbs' evidence should really have been supplied by Mr Stewart himself. It is not, however, disputed that the hearing officer agreed to accept a witness statement from Mr Stobbs attesting to the various deficiencies that had been identified. To the extent that this has resulted in hearsay evidence I accept that it is a matter of the weight to be accorded. In this case the issues that fell to be clarified or corrected were:

- the date on which Mr Stewart's witness statement was signed
- the correct identification of the name of his company
- his position in that company
- a number of typographical errors
- the reversal of the designations of two exhibits.

13. It is not suggested that the evidence filed to correct these omissions and clerical errors is in any way wrong or that Mr Stobbs was not in a position to supply the

information concerned. Furthermore, I cannot see that having the matter dealt with this way means (and bearing in mind the nature of the points to be corrected) that I should give less weight to the evidence.

14. As matters turned out Mr Stobbs did not rely heavily on the evidence for reasons which I will explain in due course. Its main residual value from his standpoint was to demonstrate the nature of the target market/average consumer for his client's goods.

### **Section 5(2)(b)**

15. Section 5(2)(b) reads as follows:

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

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
- (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.”

16. An objection under Section 5(2)(b) requires me to consider whether there are similarities in the marks and similarities in the goods and services that cumulatively, lead to a likelihood of confusion. The leading guidance from the European Court of Justice is contained in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* and *Adidas Benelux BV* [2000] E.T.M.R. 723.

17. The principles derived from the ECJ cases summarised above have underpinned the approach to issues of similarity and likelihood of confusion for some time now. There has, however, existed a debate as to whether any degree of similarity (in marks and/or goods and services) is sufficient to find that the marks and/or goods/services are similar and thus engage the need to consider the (cumulative) likelihood of confusion test or whether there is a threshold level of similarity that must be crossed before the Court or tribunal needs to consider the interdependency principle and whether there is a likelihood of confusion. The competing arguments have recently been given full consideration by Mr Justice Lindsay in *esure Insurance Limited and Direct Line Insurance plc*, [2007] EWHC 1557(Ch). It will suffice for present purposes to record that he said:

“I would hold there to be some form of threshold, albeit a low one”  
(paragraph 46 of the judgment).

and

“Once that low threshold test I have described is passed then the fact-finder is, in my judgment, obliged to go on to consider whether, in consequence, there is a likelihood of confusion – see *Soffass* para 31. That is not to say that any party can safely decide to assert no more, as to similarity, than that so low a threshold has been exceeded because similarity and the likelihood of confusion are so inter-related that proof of a higher degree of similarity may conduce to a greater willingness in the fact-finder to hold that there is, on the facts, a likelihood of confusion.” (paragraph 48).

### **Similarity of marks**

18. The applicant concedes that there is some similarity between the competing marks (nothing turns on the fact that the application is for a series of three marks). The area of debate at the hearing was, therefore, over the extent of the similarity. Mr Stobbs considered that the competing marks were almost identical or at least very similar whereas Mr Engelman argued that there was a limited degree of visual, oral and conceptual similarity. The basis for this view of the matter on Mr Engelman’s part is that the middle ‘n’ of **drunknmunky** would be taken by the average consumer to be a substitution or abbreviation for the word ‘and’. It would, thus, be seen as drunk and monkey. The rationale for this reading of the mark was said to be that consumers are accustomed to seeing ‘n’ as an abbreviation for ‘and’ (the example given being ‘fish n chips’) whereas they are not so used to seeing ‘n’ as a contraction of the ‘en’ in adjectival endings of words.

19. I consider Mr Engelman’s approach to be a strained interpretation and one which is unlikely to reflect how consumers will approach the word. ‘Drunk’ may be used as either an adjective or a noun but neither reading of the word sits easily with an interpretation of the ‘n’ as a conjunction. It is far more likely in my view that consumers will see the opponent’s mark as a normal adjective and noun combination albeit in contracted form, hence drunken monkey.

20. Mr Engleman’s other point was that I should not ignore the presence of the definite article in his client’s mark. I accept that this is so as far as it goes. But it does not go very far. In my view there are strong visual, oral and conceptual similarities between the marks. They are similar to a high degree.

### **Distinctive character of the earlier trade mark**

21. This resides primarily in the unusual notion of a drunken monkey. The contraction and misspelling contributes some slight additional distinctiveness. But in an age where ‘text speak’ is common and deliberate misspellings are sometimes used in advertising I do not attach a great deal to this point beyond the fact that it makes for a slight visual quirkiness. I have no doubt that the earlier trade mark is highly distinctive in relation to the goods of the specification.

22. Mr Stobbs’ skeleton argument made the case that the opponent was entitled to claim a reputation in its mark as a result of use and the high profile nature of the brand. Given the inherent strength of the mark it was not necessary for him to pursue

the enhanced distinctiveness claim in submissions. However, I will comment briefly on the evidence.

23. Mr Stewart's witness statement refers to total turnover of approximately £3 million since September 2001. His statement was made in November 2005 and it is not clear whether the claimed turnover relates to the position at that date or the material date of 2 February 2004. Sales are said to have been "steady" since first use but to have "picked up since the larger high street stores have started selling products bearing the DRUNKNMUNKY trade mark". In the case of House of Fraser this has been since 2002. No dates are given in relation to other stores groups.

24. The exhibits, as described in general terms above, do not greatly assist in determining the opponent's reputation in the UK at the material date. Most of the exhibits contain material that appears to have been drawn from websites at the time the evidence was being compiled and may or may not be a fair reflection of the position at or before 2 February 2004. Exhibit CS1 may or may not predate the filing of the application under attack. Exhibit CS2 appears to be a secondary trade on ebay and does not tell me where the beanie hat product was first sold. Exhibit CS3 cannot be readily dated. Exhibits CS4 and 6 appear to be primarily of US origin or reflect the position in markets outside the UK. Exhibits CS5 and 7 which purport to show the brand being worn by personalities (Rio Ferdinand and Jay-Z) show a monkey device mark but not the word that is the subject of the opponent's earlier trade mark.

25. It was also part of Mr Stobbs' case that the brand's notoriety has been enhanced by famous people being spotted wearing clothing featuring the mark. The image is said to be that of a "super-popular urban street wear company".

26. There may be some force to the argument that turnover, advertising expenditure and other traditional indicators of a company's market presence may not tell the whole story. Certain brands may well enjoy a reputation that goes beyond what might be expected from such measures alone. High profile clients and the publicity surrounding celebrity customers may contribute to a brand's reputation in the perceptions of consumers.

27. The evidence for that here is contained in paragraph 13 of Mr Stewart's witness statement along with Exhibits CS5 to 7. However, as I have already indicated CS5 shows Rio Ferdinand wearing a monkey device baseball hat but without the word **drunkmunky** (a stylised monkey is another of the opponent's brands). CS7 is a cropped photograph which again shows the monkey device but it is impossible to say whether it also features the word. CS6 is a US website piece with a 2005 copyright date which devotes a single paragraph to **Drunkmunky** linking the name to five 'celebrities'. It does not inform me as to the position in the UK.

28. In summary the distinctiveness of the **drunkmunky** brand rests on the inherent qualities of the word. The use claimed does not further enhance the opponent's position. But, for the reasons already given, it is an unusual and striking mark with a very strong claim to distinctive character.

## Similarity of goods and services

29. I have been referred to a number of authorities notably the *Canon* case and *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281. *Canon* says that:

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

30. *Treat* also refers to users and channels of trade and I regard it as well established that these are also relevant criteria to be included in the non-exhaustive list provided in *Canon*. Mr Engelman also referred me to *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] F.S.R. 267 regarding the need to construe words in context and *Treat* for the additional guidance that it is important to recognise how the product is, as a practical matter, regarded for the purposes of trade.

31. Against this background of case law Mr Stobbs submitted that the goods are complementary to the applicant’s services and that the end users are the same. More than that, he said the type of people who would be customers for the applicant’s trendy clothing brand would be exactly the sort of people who frequent bars, night clubs, discotheques etc. Furthermore he submitted that it is:

“...very common for nightclubs, bars, restaurant and/or cocktail lounges to have t-shirts and other clothing products associated with them, and/or produced under licence. A few of the more widely known examples are Planet Hollywood, Hardrock Café, Ministry of Sound, Cream, Pacha.”

32. Mr Engleman’s position was that the respective goods and services differed on almost all of the *Canon/Treat* points. He conceded that the users could be the same but only at a superficial level

33. The parties’ sets of goods and services are set out at the start of this decision. In general terms the comparison is between clothing on the one hand and a range of entertainment services and food and drink services on the other. Nightclubs and bars were the particular examples used for illustrative purposes at the hearing but I bear in mind that the applicant’s services are not restricted in this way.

34. It does not require detailed analysis to establish that on most of the *Canon/Treat* criteria the goods and services are completely different. Their nature is different, one being a physical item (a piece of clothing), the other not. The intended purposes are different, one being to clothe the other to entertain or sustain through food and drink. Their methods of use must be different to the extent that this criterion is applicable to these sorts of goods and services. They cannot be in competition with one another. They do not represent alternative choices as it were.



35. That brings me to the points of comparison that Mr Stobbs considered to be most favourable to his case. Dealing firstly with complementarity, there has been a number of recent judgments from the Court of First Instance giving guidance on how to approach the issue and demonstrating the application of the key principles. In *Mülhens GmbH & Co. KG v OHIM*, Case T-150/04 it was held that:

“36 In order to give rise to a degree of similarity for the purposes of Article 8(1)(b) of Regulation No 40/94, this aesthetically complementary nature must involve a genuine aesthetic necessity, in that one product is indispensable or important for the use of the other and consumers consider it ordinary and natural to use these products together (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraphs 60 and 62).

37 However, the existence of an aesthetically complementary nature between the goods at issue, such as that referred to in the previous paragraph, is not enough to establish similarity between those goods. For that, the consumers must consider it normal that the goods are marketed under the same trade mark, which normally implies that a large number of producers or distributors of these products are the same (*SISSI ROSSI*, paragraph 63).”

36. In *Alecansan, SL v OHIM*, Case T-202/03, the CFI noted (without disapproving) the position adopted in the OHIM Opposition Guidelines:

“46 As regards the complementary nature of the goods and services, it must be pointed out that, according to the definition given by OHIM in point 2.6.1 of Part 2, Chapter 2, of the Opposition Guidelines of 10 May 2004, goods or services are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for the production of those goods or for the provision of those services lies with the same undertaking (see also to that effect Case T-85/02 *Díaz v OHIM* [2003] ECR II-4835, paragraph 36).”

37. In *El Corte Inglés SA v OHIM*, Case T-443/05, the Court considered the application of the established principles in the context of clothing and bags and leather goods holding that:

“49 Goods such as shoes, clothing, hats or handbags may, in addition to their basic function, have a common aesthetic function by jointly contributing to the external image (‘look’) of the consumer concerned.

50 The perception of the connections between them must therefore be assessed by taking account of any attempt at coordinating presentation of

that look, that is to say coordination of its various components at the design stage or when they are purchased. That coordination may exist in particular between clothing, footwear and headgear in class 25 and the various clothing accessories which complement them such as handbags in class 18. Any such coordination depends on the consumer concerned, the type of activity for which that look is put together (work, sport or leisure in particular), or the marketing strategies of the businesses in the sector. Furthermore, the fact that the goods are often sold in the same specialist sales outlets is likely to facilitate the perception by the relevant consumer of the close connections between them and strengthen the perception that the same undertaking is responsible for the production of those goods.

- 51 It is clear that some consumers may perceive a close connection between clothing, footwear and headgear in class 25 and certain ‘leather and imitations of leather, and goods made of these materials and not included in other classes’ in class 18 which are clothing accessories, and that they may therefore be led to believe that the same undertaking is responsible for the production of those goods. Therefore, the goods designated by the mark applied for in class 25 show a degree of similarity with the clothing accessories included in ‘leather and imitations of leather, and goods made of these materials and not included in other classes’ in class 18 which cannot be classified as slight.”

38. In *Assembled Investments (Proprietary) Ltd v OHIM*, Case T-105/05 the Court had to consider the issue in the context of wine glasses and wine and concluded:

- “34 Lastly, it should be stated that there is a degree of complementarity between some articles of glassware, in particular wine glasses, carafes and decanters, on the one hand, and wine, on the other, in so far as the first group of products is intended to be used for drinking wine. However, in so far as wine may be drunk from other vessels and the articles of glassware mentioned above can be used for other purposes, that complementarity is not sufficiently pronounced for it to be accepted that, from the consumer’s point of view, the goods in question are similar within the terms of Article 8(1)(b) of Regulation No 40/94.”

39. None of the above cases deal with a comparison between goods and services of the kind at issue here and it may be the case that different or additional considerations may arise depending on the goods and services concerned. What is apparent, however, from these cases is that complementarity is not to be viewed in too broad a sense. There must be some natural functional or aesthetic bond that leads consumers to think that the goods and services will be marketed, sold or used together. Furthermore, complementarity may not be enough in itself to establish that goods or services are similar. It is one factor amongst many. I can see no natural synergy between the competing goods and services in this case. I, therefore, reject the claim that they are in any meaningful sense complementary.

40. That brings me to the principal focus of Mr Stobbs' submission, namely that the goods and services have a common group of users, namely the young and trendy who will be customers for both the opponent's clothing and the applicant's nightclub, bar etc. services.

41. That argument proceeds on the footing that the consumer groups are defined by the respective sets of goods and services. There may be some force to that submission to the extent that the main audience for nightclub, discotheque and such like services can be expected to be a predominantly youthful one (though even then not exclusively so).

42. So far as the opponent's goods are concerned the specification is not limited by target market or outlets. The claim, therefore, rests on the actual image (said to be popular urban street wear) that the opponent has sought to create through use. It is, thus, based on the opponent's actual trade rather than the notional scope of the audience for clothing at large. In that respect Mr Engelman referred me to the following passage from *Devinlec Développement Innovation Leclerc SA v OHIM*, Case T-147/03 where the CFI rejected the OHIM Board of Appeal's view that the particular circumstances in which the goods covered by the earlier mark were marketed made it possible to rule out any likelihood of confusion. It held that:

“107 It follows that by taking into consideration in the assessment of the likelihood of confusion between the marks the particular circumstances in which the goods covered by the earlier mark are marketed, the temporal effect of which is bound to be limited and necessarily dependent solely on the business strategy of the proprietor of the mark, the Board of Appeal erred in law.”

43. In *Le Spose de Gio*, O-253-05 the Appointed Person, on appeal, also rejected the view that the objection to registration should be resolved on the skewed view that the marks in question would be used in the UK in a context that required familiarity with the Italian language notwithstanding that the actual use position suggested that this might be the case.

44. Bearing in mind the notional range of users I, therefore, take the view that the claim that the goods and services share a common group of consumers is true only in a narrow sense. It may well be the case that some purchasers or prospective purchasers of the opponent's clothing will also be users of nightclub, bar etc. services. But on that basis a very wide range of consumer goods and services share a common audience. It does not in my view advance the opponent's case to any material extent.

45. The final point I need to touch on is channels of trade. Mr Stobbs' point here was that it is common for clothing to be sold at e.g. events and for nightclubs, bars etc to offer t-shirts and other clothing products for sale. It is said that a few of the more widely known examples are Planet Hollywood, Hardrock Café, Ministry of Sound, Cream, Pacha. Thus, it is said there is an element of commonality in the channels of trade.

46. There is no evidence to support this claim or to indicate how widespread the practice is. In my experience bars and restaurants do not as a matter of common practice sell clothing. I cannot say what the position is in relation to other establishments such as nightclubs and discotheques. It may well be that some clubs, restaurants, such as those mentioned above, do sell t-shirts and other clothing products but they may be the exceptions rather than examples of a widespread practice.

47. A further point arises in that, even to the extent that certain establishments may offer such goods, it seems to me to be as likely to be as an advertising mechanism or means of promoting the underlying services as a trade in such goods in its own right. Pumfrey J. noted in *Daimler Chrysler AG v Javid Alavi (t/a MERC)*, [2001] R.P.C. 42 that on the facts of the case before him:

“ The evidence of sales of clothing under the MERCEDES-BENZ mark suggests that the sales are small. Most of the use of the mark which these sales represent is what can be called “T-shirt use”, that is, use of the logo or mark as decorative embellishment of the clothing, or use of the clothing as a bill-board to advertise the mark.” (paragraph 20).

48. He recognised, however, that evidence might establish a different position:

“ Of course, the goodwill accruing in respect of T-shirt use is always a matter of fact. There is no rule that T-shirt use of a mark primarily used in relation to some other kind of goods altogether, say computers, does not confer on the user a goodwill in relation to T-shirts. It is a question of fact in every case, but one should not blindly accept that this kind of advertising use necessarily gives rise to a protectable goodwill in respect of the substrate which carries the advertisement.” (paragraph 20).

49. The issue before me here is simply whether the factual circumstances are such that I should hold that the goods and services in issue can be said to have shared channels of trade. Absent evidence, I do not accept that establishments offering the services applied for are commonly seen as outlets for clothing. The latter are usually sold through dedicated retail outlets, department and other stores, mail order catalogues etc.

50. Taking all these considerations into account I have come to the clear view that the goods and services in this case are not similar.

51. As an objection under Section 5(2)(b) requires, as an underpinning minimum, similarity in both marks and goods and services I need go no further because the cumulative test is not engaged. If I am wrong in that regard and, say, the consumer overlap is sufficient to trigger the threshold similarity requirement, then I would need to consider whether there is a likelihood of confusion. The earlier trade mark is a highly memorable and distinctive one. I am not prepared to rule out the possibility that consumers who were familiar with the **drunkmunky** clothing brand would be reminded of it if they subsequently encountered the applicant’s services. However, it would in my view be mere association in the sense of a bringing to mind. There is no reason to suppose that consumers would go further than that and attribute a common

trade origin to the respective goods and services. Accordingly, the opposition fails under Section 5(2)(b).

### **Section 5(3)**

52. As amended this reads:

“(3) A trade mark which-  
(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC), in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

53. A useful summary of the factors to be considered in relation to Section 5(3) can be found in *Mango Sport System S.R.L. Socio Unico Mangone Antonio Vincenzo v Diknah S.L.* [2005] E.T.M.R.5.

54. Mr Stobbs’ skeleton argument dealt briefly with this ground but it was not pursued in submissions. However, as I understand it the ground has not been given up. In the light of my finding that the goods and services are not similar, I need to briefly set out what I consider to be the position under this head.

55. The earlier trade mark on which the opponent relies is a Community one. The requirement in these circumstances is that the proprietor must demonstrate a reputation in the European Community. That much is apparent on the face of the relevant part of the UK Act and the comparable provision of First Council Directive 89/104 on which the Act is based (see Article 4(3)). The opponent appeared to recognise the obligation placed upon it in this respect in its statement of grounds where the claim is made that the earlier trade mark has been used extensively “in the UK, and in the Community at large since at least as early as 20 February 2002”.

56. However, Mr Stewart’s evidence in support of the claim goes to trade in the UK rather than the Community. It is difficult to see how it could be otherwise as Mr Stewart’s company is the opponent’s UK distributor. There is no suggestion that he is in a position to report on trade elsewhere in the Community.

57. I referred at the hearing to *Mobis Trade Mark O-020-07*, where Richard Arnold QC, sitting as the Appointed Person, held as follows:

“30. The opponent contends that, where an opponent relies upon a Community trade mark, it is sufficient for the purposes of section 5(3) to show that it has a reputation in the United Kingdom and that the hearing officer was wrong in law to hold that it was required to show a reputation in the Community.

31. I am unable to accept this argument. Section 5(3) on its face expressly

distinguishes between what is required in the case of an earlier national mark, namely “a reputation in the United Kingdom”, and what is required in the case an earlier Community trade mark, namely “a reputation ... in the European Community”. This distinction reflects the difference between Article 4(4)(a) of the Directive, which requires that “the earlier [national] trade mark has a reputation in the Member State concerned”, and Article 4(3), which requires that “the earlier Community trade mark has a reputation in the Community”. The same distinction is also to be found in Article 5(5) of Council Regulation 30/94 of 20 December 1993 on the Community trade mark. I cannot see any basis on which the Act, the Directive and the Regulation can be interpreted as merely requiring that the Community trade mark relied upon should have a reputation in the Member State in question. Nor did the opponent’s attorney cite any authority or commentary to support such an interpretation. Furthermore, as the applicant’s attorney pointed out, the judgment of the ECJ in Case C-375/97 *General Motors Corp v Yplon SA* [1999] ECR I-5421 at [25]-[29], while not directly on point, tends to support the opposite interpretation.

32. It follows that the hearing officer did not make the error of law alleged.”

58. On that basis the opponent’s case falls at the first hurdle. I might just add that, on the basis of the reputation requirement set out in *General Motors Corporation v Yplon SA*, Case C-375/97, the opponent has in any case failed to substantiate a UK reputation to the requisite standard (see my observations on the evidence of use above). The Section 5(3) objection also fails.

### **COSTS**

59. The applicant has been successful and is entitled to a contribution towards its costs. I order the opponent to pay the applicant 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 20th day of August 2007**

**M Reynolds  
For the Registrar  
The Comptroller-General**