

O-199-13

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION
No. 2563678
BY CHELSEA FOOTBALL CLUB LIMITED
TO REGISTER THE TRADE MARK
CHELSEA**

IN CLASS 25

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No. 102368 BY
Mr A. C. K. GEORGE**

BACKGROUND

1) On 8 November 2010 Chelsea Football Club Limited (hereinafter the applicant), applied to register the trade mark CHELSEA in respect of the following goods in Class 25:

“Articles of sports clothing, namely football boots, football shirts, football shorts, football socks, replica football kits, tracksuits; socks; scarves; dressing gowns; pyjamas; slippers; boxer shorts; baby boots; bibs; romper suits; baby sleepsuits; dungarees; braces; wristbands; ties; swimwear and beachwear; bath robes; lingerie and hosiery; belts.”

2) The application was examined and accepted, and subsequently published for opposition purposes on 10 June 2011 in Trade Marks Journal No.6891.

3) On 9 September 2011, Mr A.C.K. George (hereinafter the opponent) filed a notice of opposition. The grounds of opposition are in summary:

- a) The mark in suit is devoid of any distinctive character as the term is non-distinctive in relation to the goods applied for i.e. clothing. Chelsea is an area of London which has a reputation for, amongst other things, wealth, socialites, shopping, in particular clothes shopping and the word CHELSEA is a byword for fashion. The mark offends against Section 3(1)(b).
- b) The mark in suit consists of a sign which designates kind, quality, intended purpose or other characteristics of goods covered by the mark and so offends against Section 3(1)(c). Specifically, the term CHELSEA should remain free to be used for goods made in CHELSEA, goods designed in CHELSEA, goods otherwise associated with CHELSEA.
- c) The opponent is the proprietor of the following trade mark:

Trade Mark	Number	Filing date / registration date	Class	Specification
CHELSEA MAN Registration of this mark shall give no right to the exclusive use, separately, of the words "Chelsea and "Man."	1196388	23.05.83 / 03.03.89	25	Leather jackets, leather waistcoats, leather trousers, leather belts (for wear), shirts, sweat shirts, suits, shoes and trousers, all for men and boys.

- d) The opponent contends that the mark applied for is similar to its earlier mark and is sought to be registered for similar goods. As such the mark in suit offends against Section 5(2)(b). The opponent contends that its earlier mark has a reputation in the UK in respect of clothing.
- e) The opponent contends that it has used its sign in the UK since the mid 1970s and has acquired a reputation under its sign CHELSEA MAN in relation to Men’s and Women’s clothing. As such the mark in suit will offend against Section 5(4)(a).

4) On 16 November 2011, the applicant filed a counterstatement which denied the opponent's claims. The applicant put the opponent to strict proof of use.

5) Both sides filed evidence. Both parties seek an award of costs in their favour. The matter came to be heard on 27 February 2013. At the hearing, the applicant was not represented but provided written submissions; the opponent was represented by Mr Taylor of Swindell & Pearson Limited.

OPPONENT'S EVIDENCE

6) The opponent filed four witness statements. The first, dated 16 February 2012, is by Mr Christopher Kenneth Mayber George. He explains that Mr ACK George is his son and that his son became the proprietor of UK 1196388 on 29 August 2009 when the mark was assigned to him by Morgan Samuel Ltd. The mark CHELSEA MAN is exclusively licensed by the registered proprietor to a company based in Hong Kong called Retrofit Ltd. Mr CKM George owns Retrofit Ltd and in the UK all CHELSEA MAN products are sold exclusively through the Nickleby's retail stores. Mr George explains that he and his son work together in various businesses and that he is authorised to make a statement on behalf of the opponent. He states that the contents of his statement are within his personal knowledge.

7) Mr George states that he has been a director of Retrofit Ltd for the last sixteen years and that his company holds the worldwide licence to use the mark CHELSEA MAN. His company licenses others to use the mark in various territories. The party with the UK license have entered into an agreement with Nickleby's to operate concession stands within their shops. He states that in recent years there have been a number of parties licensed to use the mark in the UK and a number of different parties operating the Nickleby's stores. These are set out in the two tables below:

Company licensed to use CHELSEA MAN in UK by Retrofit Ltd	Company Registration number	Period of license (approx)
Mr CKM George t/a Chelsea Man	-	1991/2000
Brand Fusion Holdings	-	2000/2004
Morgan Samuels Ltd	03592715	2004/2007
Griffington Ltd t/a Chelsea Man	06083217	2007/2009
Morgan Samuel Ltd /York 191 Ltd (change of name on 08/09/2011)	06445484	2009 to date

Companies operating Nickleby's shops	Company Registration number	Approximate period
HKA (UK) Ltd	03937783	2000/2004
Chesterfield (Property) Ltd	02700649	2005/2007
Churston Retail Ltd	03941205	2007/2009
Churston Retail (2005) Ltd	05254207	2009/2010
Morgann Samuel (International) Ltd	06190146	2010 to date

8) At exhibits CKMG001-003, respectively, he provides copies of license agreements between Retrofit Ltd and Brand Fusion Holdings (dated 10/01/2000), Morgan Samuels Ltd (dated 15/09/2004) and Griffington Ltd (dated 08/06/2007). He also provides copies of concession agreements in the following exhibits:

- CKMG004: between HKA (UK) Ltd and Brand Fusion Holdings dated 5 April 2000.
- CKMG005: between Chesterfield (Property) Ltd and Morgan Samuels Ltd dated 22 January 2005.
- CKMG006: between Chesterfield (Property) Ltd and Griffington Ltd dated 8 June 2007.
- CKMG007: between Churston Retail Ltd and Griffington Ltd dated 2 July 2007.

9) Mr George states that he has been actively involved with the Chelsea Man trade mark since the early 1970s and, as the owner of the company which has the exclusive worldwide license to use the mark, he has had full control over the marks use for the last 12 years. Initially in the 1970s the mark CHELSEA MAN was used on clothing which was wholesaled to a number of retailers who sold the items to the public. In 1975 Nickleby's began to sell clothing under the mark in addition to other retailers. Nickleby's opened a number of retail outlets and by the 1980s wholesaling retailers other than Nickleby's ceased. Mr George states that he has run the Nickleby's chain of retail stores since 1975, he has held a number of posts in the company such as Managing Director and Buying and Merchandising Manager. He confirms that the Nickleby's chain have sold CHELSEA MAN clothing for the last 35 years.

10) He confirms that Nickleby's have sold, during the last five years, the following items under the CHELSEA MAN mark; casual jackets, casual tops, hoodies, unisex sweat tops, shirts, trousers, coats, footwear and shoes, leather bags, belts, waistcoats, leather jackets for men and women, leather coats, ladies trousers and ladies waistcoats. Whilst the number of Nickleby's outlets has dwindled from 34 to 3 Mr George states that there are plans to open more outlets now that rents have reduced. He states that the CHELSEA MAN brand is long established and so little advertising has been carried out since the 1990s. He provides the following sales figures:

Year	Retail gross sales of Chelsea Man goods £
Sept 2002 – Dec 2002	53,941
2003	302,955
2004	546,018
2005	657,579
2006	476,797
2007	329,928
2008	270,792
2009	247,038
2010	161,730
Jan 2011 – 11 June 2011	55,690

11) At exhibits CKMG008 –CKMG0032 he provides copies of weekly stock and sales reports and takings summaries, dating from 2002 – 2011, from the Nickleby's shops in relation to CHELSEA MAN branded clothing which support the figures in the above table. I compared the style reference numbers to those shown in the catalogue at exhibit CKMG0034. I was able to ascertain that in the UK in the week ending 30 September 2006

a total of 44 men's jackets and coats were sold. In the week ending 26 February 2011 a total of 20 men's jackets and coats were sold. In addition, on 1 August 2009 16 belts were sold and a total of two waistcoats were sold (in August and December 2008). Mr George states that the mark CHELSEA MAN has a considerable reputation for quality and exceptional value. He states that use of the mark in suit will damage this reputation and that the applicant would benefit from the opponent's reputation. He states that the general public will assume a link between the two marks. He also provides the following exhibits:

- CKMG0033: A copy of a witness statement, dated 5 May 2011, by Anthony Ash a shop assistant who worked at the Birmingham branch of Nickleby's from 2003-2009 (apart from a few short breaks). He states that although there were a number of companies that owned the store his employment during this period was continuous. He states that during this time the shop always sold men's and ladies clothing including leather jackets under the CHELSEA MAN brand. He confirms that the clothing had labels sewn into, for example the neck, with the brand on it. He recalls the stock selling consistently throughout the period. He also confirms that the attached Chelsea Man weekly stock and sales report was filed on a weekly basis during his time with Nickleby's. He states that the style numbers on the report related to the CHELSEA MAN style number.
- CMKG0034: A copy of a catalogue dated June 2005 which was produced for a Hong Kong Trade Fair. Each style in the magazine has a reference number and this reference number is said to be identical to those found on the weekly returns in earlier exhibits. Mr George states that the reference numbers in this catalogue are identical to those used in the UK. He states that it is therefore possible to use this catalogue to track back the stock numbers referred to in earlier exhibits and identify the precise garment sold. The catalogue shows pictures of both men and women modelling a range of clothing. However, the opponent's specification is limited to various items of clothing "for men and boys". The men in the catalogue are modelling coats, jackets and waistcoats.
- CMKG0035: This consists of pictures of CHELSEA MAN branded clothing in Nickleby's stores, some on hangers with the name NICKLEBY'S. The photographs show CHELSEA MAN neck labels in a variety of jackets. The photographs are said to have been taken in March 2011.
- CMKG0036: This consists of photographs of CHELSEA MAN labels which are stitched into CHELSEA Man branded goods. He states that these are the type of labels which were used in the period 2002-2011.
- CMKG0037: Copies of invoices for CHELSEA MAN labels dated 1995-March 2008. During this time orders were placed for 357,000 labels.

12) The second witness statement, dated 4 April 2012 is also by Mr CKM George. He states that he has been in the clothing retail trade since 1975. He states:

"4. I think that a consumer when seeing or hearing the word CHELSEA will think of the famous place in London, called Chelsea because this area has a reputation for being cool and trendy and fashionable and being a place to get trendy and

fashionable clothing and shoes. In terms of living in the area it is considered to be very affluent and chic and expensive, what estate agents call “sought after”.

5. I think that the reputation of Chelsea as being a cool, trendy, fashionable and a chic place to be started in the 1960s and the Kings Road in Chelsea is intimately associated with the “swinging sixties”. It is not just that the area was cool and trendy, but the shops and the boutiques found in the area were tremendously cool and trendy which created an impression in the minds of consumers of CHELSEA with the trendy and fashionable “clobber”.

6. CHELSEA might not be the place to go for a hand-made suit or a bespoke shirt, but it was and still is the place to go for really cool and trendy shops, selling really trendy clothing, places like the Kings Road and Sloane Street still have a reputation for being cool, trendy and chic and having cool, trendy and chic shopping and selling fashionable cool, trendy and chic clothing and associated items.

7. In terms of the “swinging sixties” there were very trendy shops in Chelsea. In the seventies Chelsea became known as the birthplace of the “punk” fashion movement and the acclaimed designer Vivienne Westwood opened a shop called “sex”. In the eighties and nineties Chelsea became the fashion destination for new romantics, tourist punks and wild child fashionistas. Since then Chelsea has continued to maintain its chic as a fashion mecca. In fact Vivienne Westwood still has a shop in the Kings Road which speaks volumes. The Manolo Blahnik shop which is on Church St, just off Kings Road is another example of Chelsea chic.

8. I think that a consumer when seeing or hearing the word CHELSEA will think of the famous place in London, called Chelsea because this area has a reputation for being cool and trendy and fashionable, and having cool and trendy and fashionable clothing and shoe shops and it has maintained this reputation for selling cool and fashionable and trendy clothes for more than forty years.”

13) The third witness statement, dated 3 April 2012, is by Katy Jane Fuggle an employee of Swindell and Pearson, the opponent’s trade mark representatives. She states that she lived in London for just over two years in the late 1990s and was familiar with parts of Chelsea. She gives her opinion of Chelsea which is of no assistance to my decision.

14) The fourth witness statement, dated 4 April 2012, is by Kieron Peter Mark Taylor the opponent’s Trade Mark Attorney. He provides a dictionary definition showing that Chelsea is a district of London. He provides personal reminiscences which do not assist me in my decision. He provides a number of exhibits KMT003-KMT007 which show that Chelsea has a number of shops selling high end, expensive fashion clothing and accessories. He also provides an analysis of shopping areas of London although I do not understand him to be an expert witness of such issues. He also opines that the area is home to a social elite although quite what this means and how he is qualified to comment is moot.

APPLICANT’S EVIDENCE

15) The applicant filed two witness statements dated 29 and 30 May 2012, both by Robert James Hawley the applicant’s Trade Mark Attorney. He states that the Registry has accepted on previous applications that the term CHELSEA is, *per se*, distinctive. However,

none of the cases he provides details of are for class 25 goods and so are not on all fours with the instant case. He points out that none of the exhibits provided by the opponent show that the term CHELSEA is used to identify the geographical origin of goods or that Chelsea has a reputation for producing such goods.

16) Mr Hawley questions the veracity of Mr George, as he points out that Retrofit Ltd, described by Mr George as being based in Hong Kong is registered in the British Virgin Islands. He therefore questions the assertions made by Mr George as to the rights to use the opponent's mark, whether he has the right to sub-license and questions whether the goodwill accrues to the opponent. Mr Hawley also questions Mr George's statement regarding his running of Nickleby's shops as no evidence has been provided by corroborate this claim. Mr Hawley states that the evidence provided by the opponent does not show use of the earlier mark upon all the goods for which it is registered. Mr Hawley comments that much of the evidence provided is prior to the relevant use period, and that items such as the catalogue provided, have the name of Morgan Samuel (HK) Ltd whereas the exclusive UK licensee at this date was Morgan Samuels Ltd. He also points out that Chelsea is a well known football club.

OPPONENT'S EVIDENCE IN REPLY

17) The opponent filed three witness statements in reply. The first two, both dated 11 October 2012, are by Mr C K M George who has already provided evidence. He states that he reiterates and stands by the comments made in his first two statements. He confirms again that he is the owner of Retrofit Ltd, and that this company holds the exclusive license for the brand CHELSEA MAN including UK TM 1196388. He confirms that this mark is owned by the opponent (his son) and that he has been a director of Retrofit Ltd for the last 16 years. He also confirms that Retrofit Ltd is a company organised under the laws of the British Virgin Islands and has its operational base in Hong Kong. He also provides the following exhibit:

- CKMG039: A copy of the licence between his son Mr A C K George and Retrofit Ltd that shows Retrofit is the licensee of the trade mark CHELSEA MAN and which confirms that the goodwill accrues to Mr A C K George.

18) The third witness statement, dated 12 October 2012, is by Mr A C K George who confirms that Retrofit Ltd holds the exclusive license for the brand CHELSEA MAN and that the goodwill accrues to him.

19) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

20) I first turn to the ground of opposition based on section 5(2)(b) which reads:

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.”

21) An “earlier trade mark” is defined in section 6, the relevant part of which states:

“6.-(1) In this Act an “earlier trade mark” means -

- (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.”

22) The opponent is relying upon its trade mark listed in paragraph 3 above which is clearly an earlier trade mark. The opponent was put to strict proof of use by the applicant, and, given the interplay between the dates of the two marks, the opponent’s mark is subject to The Trade Marks (Proof of Use, etc) Regulations 2004 paragraph six of which states:

“6A Raising of relative grounds in opposition proceedings in cases of non-use.

(1) This section applies where-

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if-

- (a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes-

- (a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and
 - (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.
- (5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.
- (6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.
- (7) Nothing in this section affects –
- (a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or
 - (b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

23) I must first consider whether the opponent has fulfilled the requirement to show that genuine use of its mark has been made. In the instant case the publication date of the application was 10 June 2011, therefore the relevant period for the proof of use is 11 June 2006 – 10 June 2011. The requirements for “genuine use” have been set out by the Court of Justice of the European Union (CJEU) in its judgments in *Ansul BV v Ajax Brandbeveiliging BV*, Case C-40/01 [2003] RPC 40 and *Silberquelle GmbH v Maselli-Strickmode GmbH* Case C495/07, [2009] ETMR 28 and by the Court of Appeal in the UK in *LABORATOIRE DE LA MER Trade Mark* [2006] FSR 5. The principles established in these judgments have been conveniently summarised by Ms Anna Carboni, sitting as the Appointed person O-371-09 *SANT AMBROEUS*:

- “(a) Genuine use means actual use of the mark by the proprietor or a third party with authority to use the mark: *Ansul*, [35] and [37].
- (b) The use must be more than merely “token”, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].
- (c) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Silberquelle*, [17].
- (d) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at

maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(i) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(ii) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(e) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] - [23].

(f) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25].”

24) The opponent’s registered specification reads as follows: “Leather jackets, leather waistcoats, leather trousers, leather belts (for wear), shirts, sweat shirts, suits, shoes and trousers, all for men and boys.” From my analysis of the evidence above it is clear that use has been shown only in relation to “Leather jackets, leather waistcoats, leather belts (for wear), all for men”. I will therefore use this reduced specification when carrying out the comparison test.

25) When considering the issues under Section 5(2) and the likelihood of confusion, I take into account the guidance from the settled case law provided by the CJEU in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). In the recent case of *La Chemise Lacoste SA v Baker Street Clothing Ltd* [ALLIGATOR O/333/10] Mr Hobbs QC acting as the Appointed Person set out the test shown below which was endorsed by Arnold J. in *Och-Ziff Management Europe Ltd and Oz Management Lp v Och Capital LLP; Union Investment Management Ltd & Ochocki*, [2010] EWCH 2599 (Ch).

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods/ services in question; who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements; nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(e) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element in that mark;

(f) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

(g) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it;

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient;

(i) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(j) if the association between the marks causes the public to wrongly believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Distinctive character of the opponent's earlier trade mark

26) The opponent has provided evidence of use of the marks in the UK. This use has not been extensive with little or no advertising being undertaken and the goods being sold in only three shops. Sales during the period 2006-2010 inclusive averaged £300,000 per annum. The opponent has not put these figures in context of market share. It is obvious that the market for such items in the UK must be measured in the millions. To my mind the opponent has not shown that it has a significant reputation in the mark at paragraph 3 above. Given the opponent's comments in its opposition under Section 3 it is clear that the

opponent does not believe that the term CHELSEA has any distinctiveness. It is obvious that the word MAN in relation to clothing for men and boys has little distinctiveness either. I also note that the opponent's mark was subject to a disclaimer. I accept that the opponent's mark is registered and therefore has a degree of distinctiveness but, as the opponent's comments in its statement of ground suggest, it must be considered to be a mark with a low level of distinctiveness.

The average consumer and the nature of the purchasing process

27) I must now determine the average consumer for the goods of the parties. Both parties have specifications, broadly speaking, of clothing. Such goods will be sold in, inter alia, traditional retail outlets on the high street, through catalogues and on the Internet. The opponent's specification for which use has been shown is limited to items for men, but this would not affect the potential trade channels, and so I must keep all of these trade channels in mind. I also take into account the fact that women often purchase clothing for the men in their lives. The average consumer of the goods at issue is a member of the general public who is likely, in my opinion, to select the goods mainly by visual means. I accept that more expensive items may be researched or discussed with a member of staff. In this respect I note that in *New Look Ltd v OHIM Cases- T-117/03 to T-119/03 and T-171/03*, the General Court (GC) said this about the selection of clothing:

“50. Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly, the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

28) In the same case the Court also commented upon the degree of care the average consumer will take when selecting clothing. It said:

“43. It should be noted in this regard that the average consumer's level of attention may vary according to the category of goods or services in question (see, by analogy, Case C 342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26). As OHIM rightly pointed out, an applicant cannot simply assert that in a particular sector the consumer is particularly attentive to trade marks without supporting that claim with facts or evidence. As regards the clothing sector, the Court finds it comprises goods which vary widely in quality and price. Whilst it is possible that the consumer is more attentive to the choice of mark where he or she buys a particularly expensive item of clothing, such an approach on the part of the consumer cannot be presumed without evidence with regard to all goods in that sector. It follows that that argument must be rejected.”

29) Clearly, the average consumer's level of attention will vary considerably depending on the cost and nature of the item at issue. However, to my mind even when selecting routine inexpensive items of clothing such as socks or a belt, the average consumer will pay attention to considerations such as size, colour, fabric and cost. Overall the average consumer is likely to pay a reasonable degree of attention to the selection of items of clothing.

Comparison of goods

30) For ease of reference the competing goods are reproduced below with the opponent's specification being restricted to the goods for which it has provided proof of use (see paragraph 24 above):

Applicant's specification	Opponent's relevant goods
Articles of sports clothing, namely football boots, football shirts, football shorts, football socks, replica football kits, tracksuits; socks; scarves; dressing gowns; pyjamas; slippers; boxer shorts; baby boots; bibs; romper suits; baby sleepsuits; dungarees; braces; wristbands; ties; swimwear and beachwear; bath robes; lingerie and hosiery; belts.	Leather jackets, leather waistcoats, leather belts (for wear), all for men

31) The applicant has suggested that the opponent's goods are "in the nature of formal wear". Without wishing to get into a discussion of sartorial standards I wonder at the world inhabited by the writer of this submission and question if leather jackets and leather waistcoats could ever be regarded as formal wear even by the standards of certain parts of society. The applicant also contends that its goods "exclusively relate to the professional football team Chelsea Football club and will be purchased by and for supporters of that club". However, no specification can be restricted in such a manner as it would require goods to be sold only to those who could prove themselves to be a supporter of the football club, a nonsensical suggestion. Just prior to the hearing the applicant offered three different limitations by way an addition to the end of the above specification. These are:

- a) ; all of the foregoing relating to and/or being associated with Chelsea Football Club.
- b) ; all of the foregoing being items of sportswear, casual wear, leisure wear, sleepwear and swimwear.
- c) ; all of the forgoing being items of sportswear, casual wear, leisure wear, sleepwear and swimwear relating to and/or being associated with Chelsea Football Club.

32) These suggestions imply a lack of knowledge of trade mark issues. Whether the goods will be associated with Chelsea Football Club is the underlying issue in this opposition. Simply stating this in a specification will not enable the applicant to defeat the opposition as the specification does not go into the marketplace. Describing the goods applied for as, inter alia, leisure wear does not differentiate them, to my mind, from the goods of the opponent. I reject the limitations offered. The term "belts" appears in both specifications and these are therefore identical, I note that the applicant's specification has the term "namely" in it and so all of the goods are items of sportswear. Whilst these are not identical with the goods of the opponent they are very similar as there is a blurring of the lines between goods for use in sporting activities and general leisure wear, such that such goods must be regarded as highly similar.

Comparison of trade marks

33) The trade marks to be compared are as follows:

Applicant's mark	Opponent's mark
CHELSEA	CHELSEA MAN

34) It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as wholes and does not pause to analyse their various details. In addition, he rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has kept in his mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant elements of the respective trade marks and, with that conclusion in mind, I must go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

Distinctive and dominant components

35) Clearly, the mark in suit consists of a single word and its distinctiveness lies in its totality. The opponent's mark has two elements, the words "CHELSEA" and "MAN". Given that the specification is in relation to clothing for men, I do not believe that the word "MAN" will be accorded much significance by the average consumer. To my mind, the dominant distinctive element in the opponent's mark is the word CHELSEA although in my comparison I cannot ignore the presence of the word "MAN", despite my earlier comments.

Visual and aural similarity

36) Clearly, both marks share the same initial word, CHELSEA. The opponent's mark also has the element "MAN" which does make for a visual and aural difference. However, to my mind, there is a high degree of visual and aural similarity.

Conceptual similarity

37) Clearly, the applicant's mark will bring to mind a geographical area of London. The absence of any other identifier will mean that a specific link to a particular organisation within the geographical area will not be made by the average consumer. The opponent's mark, when viewed in relation to clothing, will be seen as a link to a geographical area of London as the "MAN" element will be seen as relating to the goods being designed for men. Even if it were viewed without any indication of the goods, it would be seen as referring to a male from the Chelsea area, or perhaps (although the evidence is scant on this) as a reference to a fashionable individual. To my mind there is a high degree of conceptual similarity.

Likelihood of confusion

38) I must now take all the above into account and consider the matter globally taking into account the interdependency principle- a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods and vice versa. Clearly the goods are identical or highly similar, and the marks are very similar. This means that there is a likelihood of consumers being confused into believing that the goods provided by the applicant are those of the opponent or provided by some undertaking linked to them. **The opposition under Section 5(2) (a) therefore succeeds.** None of the limitations offered

by the applicant would result in a different finding and nor can I envisage any amendment to the specification that would overcome the opposition.

39) In view of this finding I do not need to continue to consider the other grounds of opposition.

CONCLUSION

40) The opponent has succeeded under Section 5(2)(b) against the whole of the specification applied for.

COSTS

41) As the opponent has been successful it is entitled to a contribution towards its costs. The opponent contended that the applicant's behaviour during the course of the opposition was such that costs above the normal scale should be considered. In particular it complained of a lack of specificity in pleadings and also in the evidence filed. However, its own evidence can hardly be described as paragon. I therefore decline to award costs off the scale but will remain within it.

Preparing a statement and considering the other side's statement	£300
Preparing evidence	£900
Preparing for and attending a hearing	£1000
TOTAL	£2200

42) I order Chelsea Football Club Limited to pay Mr A.C.K. George the sum of £2200. This sum 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 14th day of May 2013

**George W Salthouse
For the Registrar,
the Comptroller-General**