

**O-429-16**

**SUPPLEMENTARY DECISION**

**TRADE MARKS ACT 1994  
IN THE MATTER OF  
APPLICATION NO 3056957  
BY MUHAMMAD BILAL FIRAZ  
TO REGISTER THE TRADE MARK**



**IN CLASSES 18, 25 & 28  
AND  
OPPOSITION THERETO (UNDER NO. 403003)  
BY  
S. OLIVER BERND FREIER GMBH & CO. KG**

## Background

1) On 18 July 2016 I issued a decision ('the earlier decision') in these proceedings in which I rejected the opposition under section 5(2)(b) in relation to all of the goods in classes 18 and 28 and upheld it in relation to certain of the goods covered by the application in class 25 covered by the broad term "Clothing, footwear and headgear for boxing and martial arts". When considering the similarity between the goods covered by that broad term and the opponent's goods ('t-shirts'), I said:

"36) It seems to me that the applicant's specification is a reasonably broad one such that it may include 't-shirts'. If that is right, the respective goods are identical in accordance with *Meric*. However, even if the applicant's goods do not include 't-shirts', it appears obvious to me that the respective goods would still be highly similar since the applicant's goods would include items such as boxing vests and boxing shorts. Such goods are likely to be made of the same or similar materials as 't-shirts' and so are similar in nature, they are likely to have the same channels of trade and be sold in close proximity. The users are also likely to be the same and the goods can be considered complementary in the sense that they may be put together to create an outfit (co-ordinating a t-shirt with boxing shorts, for example). There may also be a degree of competition between the goods with a consumer choosing between purchasing a vest or a t-shirt for wear during boxing training, for example.

37) Notwithstanding the above conclusion, the broadness of the applicant's specification means that it may cover certain goods which have no similarity to the opponent's 't-shirts'. The applicant's evidence highlights, for instance, that the term 'clothing, footwear and headgear for Boxing and Martial Arts' would include specialised clothing in the form of karate and judo uniforms and karate and judo belts. In the circumstances, it is appropriate to consider whether there is any similarity between those goods and the opponent's 't-shirts'. Clearly, both types of goods are intended to be worn on the person and may be made of similar materials. However, these are very general points. There are a number of other factors which tend to point away from the

goods being similar. It is not obvious to me, for instance, that the trade channels would be the same or converge significantly (and I have no evidence to the contrary), the goods do not appear to be in competition with one another (a person is unlikely to substitute a karate uniform for a t-shirt or vice versa, for example) and I cannot see that there is any meaningful complementary relationship in play. I find that there is no real similarity between the opponent's 't-shirts' and the applicant's goods insofar as the term covers karate and judo uniforms and karate and judo belts. There may also be other specialized clothing falling within the applicant's specification which is not similar to the opponent's 't-shirts'. I will return to these points later when I consider the likelihood of confusion."

Having considered all other relevant factors, I reached the following conclusion in respect of the goods in class 25:

"53) ... Weighing all of the relevant factors against each other and bearing in mind, in particular, the common presence of the KNOCKOUT/KNOCK OUT aspects (which is the sole element of the opponent's mark and the element which carries the greatest weight in the overall impression of the applicant's mark) which give rise to a very high degree of conceptual similarity, I find that, despite the additional elements and stylisation of the applicant's mark, use of those marks on identical or highly similar goods in class 25 will cause the consumer to believe that those goods come from the same or linked undertaking(s)....

54) ...

55) The opposition succeeds in respect of:

**Class 25:** Clothing, footwear and head gear for Boxing and Martial arts.

**REVISED SPECIFICATION**

56) In my conclusions, I have upheld the opposition against “Clothing, footwear and headgear for Boxing and Martial arts” on the basis that this term would either include the opponent’s ‘t-shirts’ or would cover highly similar goods such as, for example, boxing shorts and boxing vests. However, if the applicant’s specification were to be limited then it may be possible to register the mark for other forms of clothing, footwear and headgear for Boxing and Martial Arts. For example, earlier in this decision I concluded that specialised items such as karate and judo uniforms and karate and judo belts would not be similar to the opponent’s goods. Tribunal Practice Notice 1/2012 entitled “Partial Refusal” states:

### **“3.2.2. Defended Proceedings**

In a case where amendment to the specification(s) of goods and/or services is required as the result of the outcome of contested proceedings the Hearing Officer will, where appropriate, adopt one or a combination of the following approaches:

a) Where the proceedings should only succeed in part, or where the proceedings are directed against only some of the goods/services covered by the trade mark and the result can be easily reflected through the simple deletion of the offending descriptions of goods/services, the Hearing Officer will take a "blue pencil" approach to remove the offending descriptions of goods/services. This will not require the filing of a Form TM21 on the part of the owner. If, however, any rewording of the specification is proposed by the owner in order to overcome the objection, then the decision of the Hearing Officer will take that rewording into account subject to it being sanctioned by the Registrar as acceptable from a classification perspective;

b) Where the result cannot be easily reflected through simple deletion, but the Hearing Officer can clearly reflect the result by adding a "save for" type exclusion to the existing descriptions of goods/services, he or she will do so. This will not require the filing of a Form TM21 on the part of the owner. If, however, any rewording of the specification is

proposed by the owner in order to overcome the objection, then the decision of the Hearing Officer will take that rewording into account subject to it being sanctioned by the Registrar as acceptable from a classification perspective;

c) If the Hearing Officer considers that the proceedings are successful against only some of the goods/services, but the result of the proceedings cannot be clearly reflected in the application through the simple deletion of particular descriptions of goods/services, or by adding a "save for" type exclusion, then the Hearing Officer may indicate the extent to which the proceedings succeed in his/her own words. The parties will then be invited to provide submissions/proposals as to the appropriate wording for a list of goods/services that reflects his/her findings and after considering the parties' submissions, the Hearing Officer will determine a revised list of goods/services. Subject to appeal, the trade mark will be, or remain, registered for this list of goods/services.

d) This third approach will be taken when a Hearing Officer considers that there is real practical scope to give effect to Article 13, having due regard to the factors in each individual case. For example, the original specification of the international trade mark registration which was the subject of *Giorgio Armani SpA v Sunrich Clothing Ltd* (cited above) was clothing, shoes, headgear. The successful opposition only opposed the registration to the extent that it covered "men's and boys' clothing", thereby leaving other goods covered by the specification as unobjectionable. Such an outcome could not be reflected in changes to the specification via either the "blue pencilling" approach or the "save for" type of exclusion. The specification was reworded and the international registration was eventually protected for a specification reading Clothing for women and girls, shoes and headgear. Generally speaking, the narrower the scope of the objection is to the broad term(s), compared to the range of goods/services covered by it, the more necessary it will be for the Hearing Officer to propose a revised

specification of goods/services. Conversely, where an opposition or invalidation action is successful against a range of goods/services covered by a broad term or terms, it may be considered disproportionate to embark on formulating proposals which are unlikely to result in a narrower specification of any substance or cover the goods or services provided by the owner's business, as indicated by the evidence. In these circumstances, the trade mark will simply be refused or invalidated for the broad term(s) caught by the ground(s) for refusal. "

I do not consider that my conclusions in this case can easily be reflected by "blue pencilling" or adding a "save-for" type exclusion. As such, I consider it appropriate to allow the applicant 14 days from the date of this decision to provide me with a precise list of goods it wishes to register which would fall within the term "Clothing, footwear and headgear for Boxing and Martial Arts" but which would not be similar to the opponent's 't-shirts'. The applicant's proposed list of goods should be copied to the opponent who will be allowed 14 days, from receipt by it, to comment. I will then issue a supplementary decision in which I will decide whether any proposed terms put forward by the applicant are free from objection and will also deal with the matter of costs."

2) The applicant subsequently put forward a revised specification for class 25 which reads as follows:

"Judo, Taekwondo, Karate, Jiu Jitsu and Mui Thai Uniforms; Judo, Taekwondo, Karate and Jiu Jitsu belts." <sup>1</sup>

The official letter of 05 August 2016 reminded the opponent of its right to file comments on the proposed specification. No comments were received in the time allowed.

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<sup>1</sup> The applicant's e-mail of 01 Aug 2016 refers.

3) Having considered the limited specification put forward by the applicant, I find that “Judo, Taekwondo, Karate and Jiu Jitsu Uniforms; Judo, Taekwondo, Karate and Jiu Jitsu belts” are all types of specialised martial arts clothing which are not similar to the opponent’s goods for the reasons given in paragraph 37 of the earlier decision and accordingly, the opposition fails in relation to them.<sup>2</sup>

4) That leaves the term ‘Mui Thai Uniforms’. Unlike the other well-known forms of martial arts uniforms proposed by the applicant, this is not one with which I am familiar. However, I note that the applicant’s own evidence appears to shed some light on the nature of such clothing. The evidence contains a bill of landing<sup>3</sup> and invoices<sup>4</sup>. These list various goods including judo, taekwondo and karate uniforms. There is nothing described as a ‘Mui Thai Uniform’ however there are goods listed which are described as ‘THAI SHORTS’ (which I assume is an abbreviation of ‘Mui Thai shorts’) and the only photographs of shorts in the evidence are those which are of the kind (or very similar to the kind) worn by boxers<sup>5</sup>. This suggests to me that Mui Thai is a form of boxing/kick boxing, in which participants wear attire which is the same as, or very similar to, that worn by traditional boxers. As such, I consider that my comments in paragraph 36 of the earlier decision in relation to boxing shorts and vests are equally applicable to the proposed term ‘Mui Thai Uniforms’. I find those goods to be highly similar to the opponent’s ‘t-shirts’ and that there is a likelihood of confusion in respect of them for the reasons given in paragraph 53 of the earlier decision. Consequently, ‘Mui Thai Uniforms’ cannot be retained as part of a limited specification.

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<sup>2</sup> *Waterford Wedgwood plc v OHIM – C-398/07 P*, the CJEU stated: “35....Since the Court of First Instance found, in paragraph 35 of the judgment under appeal, that the goods in question were not similar, one of the conditions necessary in order to establish a likelihood of confusion was lacking (see, to that effect, *Canon*, paragraph 22) and therefore, the Court of First Instance was right to hold that there was no such likelihood.”

<sup>3</sup> ‘PROOF 10’

<sup>4</sup> ‘PROOF 9’

<sup>5</sup> ‘PROOF 5’

## Outcome

5) The applicant has been wholly successful in classes 18 and 28 and partially successful in class 25. The application may therefore proceed to registration for the following goods:

**Class 18:** Bags, Sports bags, equipment bags, parts and fitting for all the aforesaid goods. Bag used in martial arts and boxing.

**Class 25:** Judo, Taekwondo, Karate and Jiu Jitsu Uniforms; Judo, Taekwondo, Karate and Jiu Jitsu belts.

**Class 28:** Apparatus, articles and equipment for use in relation to boxing, martial-arts, body-building and weight training. Boxing gloves, sporting articles, protection wear for use in relation to boxing and martial arts; Leather and artificial leather Gloves and boxing gloves used for martial arts; Body Shaped/Moulded padding for protecting parts of the body (Specially made for use in Sporting activities); Punching bags; Shields for use in martial arts; Accessories and fittings for all the aforesaid; Miscellaneous sportswear.

## Costs

6) As the applicant has had the lion's share of success, which I estimate to be at around 80%, it is entitled to an award of costs<sup>6</sup>. Adopting the "rough and ready" approach taken by Amanda Michaels in *Wm Morrison Supermarkets Plc v Nisa-Today's (Holdings) Limited* (BL O/197/11), and keeping in mind that the applicant has not incurred the expense of legal representation, I award the applicant costs on the following basis:

Considering the notice of opposition  
and preparing a counterstatement:

£100

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<sup>6</sup> Cost awards are governed by Tribunal Practice Notice 4/2007



Preparing evidence and considering the opponent's evidence:	£250
Less 20% to reflect partial success	- £70
<b>Total:</b>	<b>£280</b>

7) I order s. Oliver Bernd Freier GmbH & Co. KG to pay Muhammad Bilal Firaz the sum of **£280**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 9th day of September 2016**

**Beverley Hedley**  
**For the Registrar,**  
**the Comptroller-General**