

**O-526-16**

**SUPPLEMENTARY DECISION**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION 3108415  
BY AK RETAIL HOLDINGS LIMITED  
TO REGISTER THE FOLLOWING SERIES OF TWO TRADE MARKS:**

**BADRHINO**

**&**

**badrhino**

**IN CLASS 25**

**AND**

**OPPOSITION THERETO (NO. 405200) BY  
RHINO RUGBY LIMITED**

## **Background and pleadings**

1. On 12 August 2016 I issued a decision in relation to these proceedings in which I refused the marks for certain goods, but allowed it for others. I stated:

“77. In terms of the specification as it currently stands, the opposition fails, and the application may proceed to registration, for the following goods:

Nightwear; bathing costumes; swimwear; neck ties, scarves; none of the aforesaid being rugby products nor intended to be sold or purchased in connection with the game of rugby.

78. The opposition succeeds, and the application is to be refused, for the following goods:

Articles of clothing and headgear; articles of outer clothing; articles of under clothing; leisurewear; sportswear; leisure clothing; tee shirts, sweat tops, hooded tops, shorts, jogging bottoms, track suits, jackets, sports tops; none of the aforesaid being rugby products nor intended to be sold or purchased in connection with the game of rugby.”

2. However, due to some of the terms in the specification being broad, terms which covered goods for which the marks should not be refused, I opened the door to a further revision of the specification. I did so on the following terms:

“79. Before concluding, there is one final point to make. Although no revised specification was put forward prior to the hearing, I have commented above on the similarity between the types of goods shown to be sold on the applicant’s website. For the record, I would place chinos, denim jeans and trousers in the same camp as the goods for which I found no likelihood of confusion. However, for casual shirts, I would place them in the same camp as the goods for which I have found a likelihood of confusion. I therefore issue the following direction:

80. The applicant for registration may, within fourteen days of the date of this decision, put forward a revised specification that:

- i) Specifically and positively identifies any further goods (that fall within the ambit of the goods of the current specification) it wishes to include in the final specification.
- ii) Such goods should be of the type, based on the rationale of my decision, which have no more than a low or moderate degree of similarity with those of the opponent.
- iii) Broad terms will not be accepted, even if they are qualified as being casual etc.
- iv) Any revised specification offered should be copied to the opponent who will be allowed fourteen days from the receipt of the same to comment.
- v) I will then issue a final decision stating which goods will be accepted and which will be refused.
- vi) That final decision will also deal with the matter of costs and will trigger the appeal period.”

3. The applicant responded to the above invitation, setting out a revised specification, as follows:

“Long sleeved button front shirts; short sleeved button front shirts; formal shirts; formal long sleeve button front shirts; formal short sleeved button front shirts; button front aloha shirts; denim button front shirts; shirts for suits; knitted button front cardigans; trousers; trouser shorts; chinos; chino shorts; trousers for formal wear; denim jeans; denim shorts; swim shorts; leather jackets; denim jackets; nightwear; bathing costumes; swimwear; neck ties, scarves; flat caps; top hats; fedoras, porkpie hats, trilbies, sun hats, beach hats, rain hats, fur hats,

fashion hats; none of the aforesaid being rugby products nor intended to be sold or purchased in connection with the game of rugby.”

4. The opponent responded stating, first, that no amendment should be permitted. Second, it made submissions on the specific terms should I be against it on its first point. I will come back to the second point later. I will begin with the first point, whether any form of amendment should be allowed.

5. Having already directed that I would consider an amended specification, I am *functus officio* on that point. In any event, it is worth highlighting that the opportunity for the opponent to make submissions in reply to any revised specification removes any prejudice that the opponent might otherwise have suffered. Further, the thrust of my direction inviting an amendment was to ensure applicability with article 13 of the Directive, which states:

“Where grounds for refusal of registration or for revocation or invalidity of a trade mark exist in respect of only some of the goods or services for which that trade mark has been applied for or registered, refusal of registration or revocation or invalidity shall cover those goods or services only.”

6. In view of the above, independent of any action on the part of the applicant, article 13 only permits the registrar to refuse an application to the extent that the pleaded relative ground applies. I issued the direction in order to provide a procedure complaint with the registrar’s article 13 obligations and, also, to avoid the cost and delay inherent in fall-back specifications coming up for the first time on appeal.

7. Before coming to the terms in the specification, I should deal with one further point. The opponent itself (as opposed to its representative) also sent in submissions following the applicant’s proposed specification which I do not consider appropriate to bear in mind. They include evidence about the applicant attempting to advertise its products at a rugby game and information about the applicant’s conduct in that, despite removing shoes and boots from its specification, are still selling such goods. Neither of these points are within the reply submissions I directed, nor are they relevant to what needs to be determined.

8. In terms of the revised specification, it is clear that it needs breaking down. Save for the goods for which I have already held as acceptable i.e. nightwear; bathing costumes; swimwear; neck ties, scarves <sup>1</sup>, I break the goods down as follows:

Long sleeved button front shirts; short sleeved button front shirts; button front aloha shirts; denim button front shirts

9. As the opponent pointed out, I have already held that causal shirts have a medium degree of similarity to the goods of the earlier mark leading to a likelihood of confusion. The revised goods are no better because they would either cover, or are, casual shirts. These terms are not acceptable.

Formal shirts; formal long sleeve button front shirts; formal short sleeved button front shirts

10. The opponent accepts that formal shirts are more specialist in nature and have a lower degree of similarity to some of the other goods assessments I have made. In comparison to goods such as rugby shirts (even those for casual wear) I consider the similarity to be moderate (between low and medium) and that there is no likelihood of confusion.

Shirts for suits

11. The opponent submits that a shirt for a suit is not limited to formal shirts (as above) and could include shirts of a more casual type. I agree. I consider that there is a medium degree of similarity giving rise to a likelihood of confusion, such that this term is not acceptable.

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<sup>1</sup> The opponent did make further submissions on some of these, but having already given my decision I cannot revisit that decision.

### Knitted button front cardigans

12. Such goods may be causal in nature, are for the upper part of the torso and are not that different from items such as hoodies and sweatshirts that are covered by the earlier marks. I consider there to be a medium degree of similarity giving rise to a likelihood of confusion such that this term is not acceptable

### Trousers; chinos; trousers for formal wear; denim jeans

13. At paragraph 79 of my previous decision I indicated that these goods would be acceptable. The opponent has submitted that trousers would cover tracksuit and jogging bottoms for which I have found confusion. Even if I were not *functus officio* on this point, I would have rejected this submission as this would not be a natural interpretation of the term trousers.

### Trouser shorts; chino shorts; denim shorts

14. The position here is the same as the position I expressed in paragraph 38 of my previous decision which took into account casual shorts, of which all of the above goods could be. There is at least a medium degree of similarity giving rise to a likelihood of confusion, such that these terms are not acceptable.

### Swim shorts

15. The opponent's submits that my previous decision was in error and that goods such as swimwear should have been held to have a medium degree of similarity, a finding which should also apply to swimshorts. Having already reached a decision on swimwear and items such as Bermuda shorts, it is not appropriate to revisit that decision. In relation to swim shorts, the same rationale applies as per my earlier assessment with regard to items such as Bermuda shorts and swim wear, such that there is only a moderate level of similarity (and no confusion).

Leather jackets; denim jackets

16. Whilst I accept that these jackets are unlikely to be worn for sporting purposes, they are, nonetheless, jackets and are, in view, reasonably similar to jackets for other purposes, including those of the type that may be worn for cold weather training. These terms are not acceptable.

Flat caps; top hats; fedoras, porkpie hats, trilbies; fur hats

17. Whilst the headgear covered by the earlier mark may include hats or caps of certain types, the above goods are of such a specific nature that any similarity is moderate at best. These terms are acceptable.

Sun hats, beach hats, rain hats

18. I agree with the opponent's submission that the qualification of sun/beach/rain does not achieve a sufficient degree of distinction with the headgear covered by the earlier mark. These terms are not acceptable.

Fashion hats

19. I agree with the opponent's submission that this term is inherently vague and adds little to the term hats, which must be highly similar to the opponent's headgear. The term is unacceptable.

**Outcome**

20. The opposition fails and the application may proceed to registration for the following goods:

Formal shirts; formal long sleeve button front shirts; formal short sleeved button front shirts; trousers; chinos; trousers for formal wear; denim jeans; swim shorts; nightwear; bathing costumes; swimwear; neck ties, scarves; flat caps; top hats; fedoras, porkpie hats, trilbies, fur hats; none of the aforesaid being rugby products nor intended to be sold or purchased in connection with the game of rugby.

21. However, the opposition succeeds, and the application is to be refused, for the following goods:

Long sleeved button front shirts; short sleeved button front shirts; button front aloha shirts; denim button front shirts; shirts for suits; knitted button front cardigans; trouser shorts; chino shorts; denim shorts; leather jackets; denim jackets; sun hats, beach hats, rain hats, fashion hats; none of the aforesaid being rugby products nor intended to be sold or purchased in connection with the game of rugby.”

22. In relation to costs, the result is something of a score draw and I consider that, in the normal course of events, this should result in no costs to either party. However, given the necessity of the opponent to comment upon the revised specification after the hearing, and given that it would have been better to have provided the revised specification prior to the hearing as a fall-back specification, I consider it appropriate to award it some costs for this. I consider an amount of £250 to be appropriate.

23. I order AK Retail Holdings Limited to pay Rhino Rugby Limited the sum of £250 within fourteen days of the expiry of the appeal period (which commences on the date of this supplementary decision) or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

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

**Oliver Morris**

**For the Registrar**

**The Comptroller-General**