

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 2206443
BY PACIFIC SUNWEAR OF CALIFORNIA
TO REGISTER A TRADE MARK IN CLASS 25

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 50599
BY HEAD SPORT AKTIENGESELLSCHAFT

BACKGROUND

1) On 20 August 1999, Pacific Sunwear of California of 5200 E, La Palma Ave, Anaheim, CA 92807, United States of America applied under the Trade Marks Act 1994 for registration of the mark BULLHEAD in respect of the following goods in Class 25: “Clothing; footwear; headgear.”

2) On the 12 January 2000 Head Sport Aktiengesellschaft of Wuhrkopfweg 1, A-6921 Kennelbach, Austria filed notice of opposition to the application. The grounds of opposition are in summary:

a) The opponent is the proprietor of trade mark number 1502616 “HEAD” registered in the UK in Class 25 with effect from 2 June 1982.

b) The opponent has used the mark HEAD extensively in the UK and overseas. The mark applied for consists of the opponent’s mark preceded by the word BULL which is not especially distinctive and may be indicative of a quality of clothing such as strength. The mark applied for therefore offends against Sections 5(2), 5(3), & 5(4) of the Trade Marks Act 1994.

d) The applicant also claims protection as a well-known mark under the Paris Convention.

3) The applicant subsequently filed a counterstatement denying the opponent’s claims other than accepting that the opponent is the proprietor of the mark HEAD and that the goods of the mark in suit and the opponent’s mark are similar.

4) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. Neither party wished to be heard in the matter, although both provided written submissions. I shall refer to these submissions as and when necessary in my decision.

OPPONENT’S EVIDENCE

5) The opponent filed four witness statements. The first, dated 26 July 2000, is by Georg Kroll the Vice President, International Licensing of the opponent company, a position he has held for four years. He states that he has a good understanding of the English language. He confirms that all the statements made are within his own knowledge except for the UK sales figures which have been provided by Sportline, a division of H Young (Operations) limited the UK licensees during the period 1997 - 1999. He also states that:

“The copies of documents exhibited to this statement have been extracted from my company’s archives, but I confirm that the articles of clothing, footwear and headgear described or illustrated in certain of the documents which I exhibit were promoted and marketed by Sportline in the United Kingdom during the years stated.”

6) Mr Kroll states that the word HEAD is used on all goods either alone or in conjunction with his company’s “Ski-tip” logo. As a result of the world-wide use he claims that the mark HEAD has become world famous. Sales of clothing, footwear and headgear in the UK in 1997 and 1998 averaged £3.7million. Worldwide sales were averaging approximately £25million per annum in this period. The company was particularly well known in the skiing and tennis markets. In the UK the products were advertised in a number of periodicals such as *Loaded*, *FHM* and *GQ* as well as sports magazines such as *ACE*, *Squash Player* and *Fall Line*.

7) Illustrations of the type of clothing on offer and UK prices are provided at exhibit GK3- 13 which show items bearing just the HEAD mark without the ski-tip logo. Some also have additional words such as “HEAD=MAX” and “SPORTS. TECHNOLOGY / HEAD/AUSTRIA” and “Austria. 1950/HEAD”. Others have the words “The HEAD Exploration” written vertically. In total they show a wide range of sports and leisure clothing, all of which have the word HEAD either solus or with additions. Most are dated 1997 or 1998.

8) At exhibit GK15 are a number of articles and advertisements from newspapers and magazines. These show a number of articles of clothing and footwear with the HEAD mark solus upon them. These are dated between 1996-1998.

9) Mr Kroll claims that the above shows that his company uses the mark HEAD in conjunction with other words and so the average consumer would be misled into believing that the applicant’s goods are part of the opponent’s range.

10) Mr Kroll provides a second statement, dated 17 August 2000. Attached to this statement is exhibit GK16 which is a copy of a price list for Autumn and Winter 1999 which he states was effective from February 1999. The list shows a number of items of ski clothing which have model names such as inter alia, “Excellerator”, “Pakalolo”, “Crystal”, “Wizard”, “Rendezvous” and “Creekside”. Mr Kroll claims that this shows that his company uses words in conjunction with its HEAD mark to identify models or styles. He claims that purchasers of his company’s clothing will have become accustomed to seeing the “word HEAD and other marks in close proximity”.

11) The third statement, dated 27 September 2000, is by John Francis Symonds the opponent’s Trade Mark Attorney. He states that the Patent Office requested and obtained permission to use the ski-tip logo and name HEAD in an internal training quiz. The quiz and answers are attached at exhibits JFS2 & 3. The trainees were shown logo’s including the ski-tip and asked to identify them. This claims Mr Symonds that the Patent Office regards the logo and name to be famous.

12) The fourth statement, dated 24 July 2000, is by David Gilbert the Managing Director of Gilbert and Pollard Sports Limited. Mr Gilbert claims to have a “good knowledge of the sportswear field”. He states that his company has been a specialist distributor of a number of “high-profile brands of sportswear”. He claims that “by August 1999 the trade mark HEAD

was especially well known in the UK for bags, clothing, footwear and racquets". It was this reputation, he claims, that caused his company to seek the distributorship of the brand in the UK.

13) Mr Gilbert also claims:

“With a brand of goods such as HEAD, it is quite common for less eminent manufacturers or dealers to try to take advantage of it by incorporating, say, the word HEAD into a new trade mark, in combination with another word so as to produce a composite word which might suggest a connection with HEAD goods. Thus BULLHEAD conveys a sense of strength or of being hard wearing, or could refer to a range of HEAD clothing. The second syllable HEAD dominates BULLHEAD and will be stressed in speech.”

APPLICANT’S EVIDENCE

14) The applicant filed two witness statements, both by Timothy M Harmon the President of the applicant company a position he has held for three years. In his first statement, dated 2 July 2001 he states that the applicant is the proprietor of US Trade Mark 1833388 (BULLHEAD) for goods in Class 25. This mark was registered on 26 April 1994. This registration was not opposed by Head Sport AG. He claims that despite sales in the USA averaging approximately £1.5million per annum he is unaware of any instances of confusion in the USA.

15) Mr Harmon claims that the opponent always uses its HEAD mark together with its ski-tip logo. He states that a “Bullhead” is a type of fresh water catfish found, inter alia, in the USA. He also provides evidence from the register of other marks which incorporate the word HEAD. However, this is of little or no relevance to the case because “state of the Register” evidence is, in principle, irrelevant: TREAT 1996 RPC 281.

16) In his second statement, dated 16 February 2001, Mr Harmon provides at exhibit TH3 illustrations of how his mark is used in the USA, point of sale materials and also how the mark is intended to be used in the UK. The mark appears as the word solus on occasion but also, more frequently, with a variety of logos.

OPPONENT’S EVIDENCE IN REPLY

17) The opponent filed another witness statement by Mr Symonds. He states that although a “Bullhead” maybe a fish found in America it is not commonly known in the UK. He speculates that this may have been the reason why the opponent did not file an opposition to the registration in the USA. Mr Symonds denies that the opponent always uses the ski-tip logo with the mark HEAD. He claims that the evidence filed makes it clear that the mark is frequently used solus.

18) That concludes my review of the evidence. I now turn to the decision.

DECISION

19) The opponent has claimed that its HEAD trade mark is a well-known trade mark under the terms of *6bis* of the Paris Convention. Of course, establishment of a trade mark as being well-known as per *6bis* simply allows that trade mark to be considered in relation to Sections 5(2),(3) & (4) as an earlier trade mark. The trade mark HEAD is registered in the United Kingdom and is an earlier trade mark. Therefore, I cannot see how it would improve the opponent's case if it were established that the trade mark was well-known as per *6bis*.

20) The first ground of opposition is under Section 5(2)(b) of the Act which states:-

*5.-(2) A trade mark shall not be registered if because -
(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 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 right is defined in Section 6, the relevant parts of which state

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,

(b)...

(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well known trade mark."

22) In determining the question under section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel Bv v Puma AG* [1998 RPC 199], *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc.* [1999] E.T.M.R. 1, *Lloyd Schfabrik Meyer & Co. GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R 723. It is clear from these cases that: -

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel Bv v Puma AG* page 224;

(b) the matter must be judged through the eyes of the average consumer, of the goods / services in question; *Sabel Bv v Puma AG* page 224, 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; *Lloyd Schfabrik Meyer & Co. GmbH v Klijsen Handel B.V.* page 84, paragraph 27;

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel Bv v Puma AG* page 224;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel Bv v Puma AG* page 224;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc.* page 7 paragraph 17;
- (f) 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; *Sabel Bv v Puma AG* page 8, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel Bv v Puma AG* page 224;
- (h) further, 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; *Marca Mode CV v Adidas AG* page 732, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc.* page 9, paragraph 29.

23) The specifications of the two parties marks are as follows:

Applicant	Opponent
Clothing; footwear; headgear	Articles of outer clothing; footwear; sportswear; all included in Class 25; but not including headgear.

24) In their counterstatement the applicant acknowledged that the goods of the two parties are similar. In my opinion the applicant's specification encompasses the whole of the opponent's specification. Therefore, apart from "headgear" the goods applied for are identical to those of the opponent. It is clear from the above cases that in the overall assessment of a likelihood of confusion, the similarity of goods is but one aspect. Due regard should be given to the closeness of the respective marks, the reputation the earlier mark enjoys in respect of the services for which it is registered, and any other relevant factors.

25) Visually the marks differ only in that the mark in suit has the word BULL in front of the word HEAD whereas the opponent's mark is simply the word HEAD. However, it is accepted that differences at the start of a trade mark are more significant.

26) Phonetically the marks are quite different, although obviously they share the sound of the

word HEAD.

27) Conceptually, the opponent's mark could be seen as alluding to either the goods (and by extension the wearer) being the "leader" or the "one in front" which given its use on sports clothing is apt. The applicant's mark in the UK does not have a clear meaning. Whilst I accept that it is the name of a fish found in the USA there is no evidence that the word shares this meaning in the UK. At best the word conjures up an image of the head of a Bull with connotations of strength and durability.

28) The opponent contended that the average consumer has been accustomed to seeing their mark in conjunction with other words, usually of a non-descriptive nature. They therefore claim that the average consumer would view their mark HEAD as a "House mark" and consequently would assume that the applicant's mark was simply another variant on the theme. In corroboration of this contention the opponent filed evidence of use of "secondary marks" in addition to their registered mark HEAD. However, I note that in all the instances the word HEAD was the first part of the mark and was usually the most prominent part of the mark. It was also normally printed in larger typeface than any of the other words, emphasising its importance. In the instant case the mark has an element attached to the front of the word HEAD. In these circumstances I do not believe that the mark in suit would be seen as the opponent's house mark conjoined with the word BULL.

29) Items of clothing are not, I would suggest, chosen without some consideration. The average consumer of such products would, in my opinion, exercise some care in the selection. In *REACT (1999) 15 RPC 529* the Hearing Officer held the following:

"I am therefore prepared to accept that a majority of the public rely *primarily* on visual means to identify the trade origin of clothing, although I would not go so far as to say that aural means of identification are not relied upon."

30) I also have to consider whether the opponent's mark has a particularly distinctive character either arising from the inherent characteristics of the mark or because of the use made of it. The opponent has shown that it has used the mark HEAD solus and that the average sales for clothing and footwear are £3.7 million per annum. However, no evidence has been filed as to the size of the market in the UK for clothing and footwear. In such circumstances the opponent's marks cannot be regarded as enjoying an above average reputation at the relevant date, but it is an inherently strong mark. Even so allowance must be made for the notion of imperfect recollection.

31) With all of this in mind I come to the conclusion that when all factors are considered that there was no realistic likelihood of confusion at 20 August 1999. Consequently, the opposition under Section 5(2)(b) fails.

32) I next consider the grounds of opposition under Sections 5(3) & 5(4) which read:

5 (3) *A trade mark which -*

(a) *is identical with or similar to an earlier trade mark, and*

(b) *is to be registered for goods or services which are not similar to*

those for which the earlier trade mark is protected,

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, 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.

(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade*
- (b)*

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark.

(5) Nothing in this section prevents the registration of a trade mark where the proprietor of the earlier trade mark or other earlier right consents to the registration.

33) It is claimed that the public would be confused as to the source of the applicant's goods believing them to originate from the opponent. The opponent states that their products are well-known in the UK. I have already found that their reputation has not been shown to be above average.

34) I have already compared the two marks and found the opponent's mark HEAD is not similar to the applicant's mark BULLHEAD. In my view the lack of similarity will prevent the public believing that the products of the applicant originate from the opponent. The grounds of opposition under Section 5(3) and 5(4) therefore fail.

35) The opposition having failed the applicant is entitled to a contribution towards costs. I order the opponent to pay the applicant the sum of £700. 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 5th day of December 2001

George W Salthouse
For the Registrar
The Comptroller General