

**DECISION OF THE CONTROLLER OF PATENTS, DESIGNS AND TRADE MARKS  
IN PROCEEDINGS UNDER THE TRADE MARKS ACT, 1996**

In the matter of an application for registration of Trade Mark No. 242930 and in the matter of an Opposition thereto.

**KIMARK**

(Represented by Cruickshank & Co.)

**Applicant**

**CALVIN KLEIN TRADEMARK TRUST**

(Represented by FRKelly)

**Opponent**

**The Application**

1. On 14 October, 2009 (the “relevant date”) Kimark, a *Societe en Commandite par Actions*, of Rue Beyaert 54, Tournai 7500, Belgium made application (No. 2009/01849) under Section 37 of the Trade Marks Act, 1996 (“the Act”) to register






as a Trade Mark in respect of “*Bags, wallets, purses, schools bags, umbrellas*” in Class 18, “*Fabrics; bath linen; bed linen; household linen*” in Class 24 and “*Clothing; underwear; bodies; pyjamas; socks; shoes; slippers; hats; caps (headwear); gloves; scarves; bibs, baby's napkins; bathrobes; layettes; belts*” in Class 25.

2. The application was accepted for registration and advertised accordingly under No. 242930 in Journal No. 2151 dated 26 May, 2010.
3. Notice of Opposition to the registration of the trade mark pursuant to Section 43 of the Act was filed on 24 August, 2010 by Calvin Klein Trademark Trust, c/o Wilmington Trust Company of 1100 North Market Street, Wilmington, Delaware 19890, United States of America. The Applicant filed a counter-statement on 1 December, 2010 and evidence was, in due course, filed by the parties under Rules 20, 21 and 22 of the Trade Marks Rules, 1996 (“the Rules”).

4. The Opponent elected to file written submissions in lieu of attending at a hearing of the matter. The Applicant attended a hearing before me, acting for the Controller, on 12 February, 2014. The parties were notified on 20 February, 2010 that I had decided to dismiss the opposition and to allow the mark to proceed to registration. I now state the grounds of my decision and the materials used in arriving thereat in response to a request by the Opponent in that regard pursuant to Rule 27(2).

### Grounds of the Opposition

5. In its Notice of Opposition the Opponent refers to its proprietorship of the following trade marks:

Country	Mark	Classes	Registration No.
Ireland	Calvin Klein	24	171380
Ireland		3 and 18	157274
Ireland		25	157276
Ireland	Calvin Klein	16 and 18	207116
Ireland	Calvin Klein	8, 20, 21, 24, 26, 27 and 35	209460
CTM	Calvin Klein	25	6710107
CTM	Calvin Klein	3, 4, 8, 9, 14, 16, 18, 20, 21, 24, 25, 26, 27, 35 and 42	79707
CTM		3, 4, 8, 9, 14, 16, 18, 20, 21, 24, 25, 26, 27, 35 and 42	66712
CTM	Calvin Klein	25	6710081

and then raises objection to the present application under certain Sections of the Act, which I summarise as follows:

- Section 8(4)(a) – *use of the mark is prohibited in the State by any enactment or rule of law*
- Section 10(2) – *use of the mark would result in a likelihood of confusion on the part of the public, including a likelihood of association with the Opponent’s Trade Mark*
- Section 10(3) – *use of mark would take unfair advantage of, or be detrimental to, distinctive character or reputation of the Opponent’s Trade Mark*
- Section 37(2) – *the Applicant does not use or intend to use the mark in relation to goods covered by the application,*
- Section 42(3) – *the Applicant has failed to satisfy the Controller that the requirements for registration have been met*

The Opponent claims also that registration of the mark is contrary to Council Directive No. 89/104 EEC to approximate the laws of the Member States relating to Trade Marks and that the Controller should use his discretion to refuse the mark.

### **Counter-Statement**

6. In its Counter-Statement, filed on 1 December 2010, the Applicant does not deny the Opponent is the proprietor of the marks cited in the Notice of Opposition, but denies all the grounds of opposition.

### **Rule 20 Evidence**

7. Evidence submitted by the Opponent under Rule 20 consists of a Statutory Declaration and supporting evidence, by way of five exhibits (1 to 5), dated 20 April, 2011, of Deirdre Miles-Graeter, Vice President of Calvin Klein Inc. I would summarise her evidence as follows:

- (i) The Opponent is the owner of a number of trade marks (detailed at “Exhibit 1”) consisting of and incorporating the term CALVIN KLEIN. These marks have been used continuously by her company since 1968.
- (ii) “Exhibit 2” contains a printout from Wikipedia chronicling the history of her company and the CALVIN KLEIN brand.

- (iii) Exhibits “3” and “4” contain pictures of use by her company of the CALVIN KLEIN trade marks.
- (iv) Her company advertises and promotes the CALVIN KLEIN trade marks through their websites *www.calvinklein.com* and *www.calvinkleininc.com*.
- (v) Attached at “Exhibit 5” is a sworn Statutory Declaration, and accompanying exhibits, executed by the deponent in 2009 in relation to other matters, which show the notoriety and strong worldwide reputation of her company’s marks. In addition, her company’s marks are protected in the PRC (I take this to be the People’s Republic of China) and have been cited in two cases reported in the books “*Famous and Well Known Marks*” and “*International Analysis by Frederick W Mostert*”.

The remainder of Ms. Miles-Graeter’s declaration ventures into the realm of legal argument regarding the similarity between the marks and goods at issue.

#### **Rule 21 Evidence**

8. Evidence submitted by the Applicant under Rule 21 consisted of a Statutory Declaration and six supporting exhibits (“KM1” to “KM6”) of Pierre Buchsenschutz, General Manager of Kimark. I would summarise his evidence as follows:

- (i) Kimark sell the CALINKALIN range of clothing, which is especially for pregnant women, through the website [www.kiabi.com](http://www.kiabi.com). Mr. Buchsenschutz states Kiabi is a family owned French retail company that operates 455 stores worldwide, including on-line sales through [www.kiabi.com](http://www.kiabi.com). He attaches at “Exhibit KM1” an extract from Kabi’s website displaying CALINKALIN clothing together with an alphabetical listing of brands which includes CALINKALIN listed under “C”.
- (ii) He attaches at “Exhibit KM2” a breakdown of Irish visitors, by town, to the Kabi website during the period 1 January 2011 to 19 April 2012, demonstrating that CALINKALIN products were seen by Irish consumers.
- (iii) “Exhibits KM3” lists goods sold to Irish consumers bearing the mark CALINKALIN from August 2008 to March 2012, which can be linked to invoices attached at “Exhibit KM4” by the product code.
- (iv) Mr. Buchsenschutz states the Croatian Trade Marks Office and the Russian Trade Marks Office both found there was no likelihood of confusion between the

Applicant's mark and Calvin Klein. Documentation relating to the decisions of those offices is attached at "Exhibit KM5" and "Exhibit KM6" respectively.

### **Rule 22 Evidence**

9. In reply to the Applicant's evidence filed under Rule 21 the Opponent filed a Second Statutory Declaration in the name of Deirdre Miles-Graeter of 22 August, 2012. I would summarise the evidence as follows:
- (i) The Applicant has failed to substantiate any of its claims in support of the application.
  - (ii) Much of the content of exhibits is in French and is not relevant or does not lend itself to comment.
  - (iii) The evidence does not show use of the mark in Ireland.
  - (iv) There is no reference to the CALVIN KLEIN mark in the documentation from the Croatian Office and therefore it should not be taken into consideration. The Russian decision related to goods in Class 18 only.

### **Written Submissions and the Hearing**

10. The Opponent filed written submissions in lieu of attending at the Hearing. While the Opponent did not abandon any of the grounds raised in its Notice of Opposition, all evidence lodged in support of the opposition and argument made in its written submissions relate solely to the ground of opposition in respect of Section 10(2) concerning the likelihood of confusion between the respective marks. Therefore, it is on this ground alone that I have decided this matter.
11. In its written submissions the Opponent conducted an in-depth comparison of the respective marks and the goods for which registration is sought. The comparison included references to the standard authorities that provide guidance for decision makers, which I refer to in my analysis below. The Opponent argues that, as a result of the similarity between the respective marks and the identity between the goods for which protection is sought, a likelihood of confusion is inevitable. Whatever differences there are between the respective marks can be offset by the identity of the goods and, in particular, by the distinctive character and renowned reputation of its earlier marks, which entitles the Opponent to a broader level of protection.

12. At the Hearing the Applicant was represented by Ms. Mary Rose O'Connor, Trade Mark Attorney of Cruickshank Intellectual Property Attorneys. For her part Ms. O'Connor also conducted a detailed comparison of the respective marks, cited authorities in support of her arguments, and concluded the respective marks were not similar at all. Ms. O'Connor conceded the marks at issue share certain letters, but the net effect is that the resulting level of similarity is no more than superficial.

### **Decision**

13. The relevant part of Section 10(2) of the Act, insofar as the present application is concerned, reads as follows:

*(2) A trade mark shall not be registered if because –*

*(a) it is identical with an earlier trade mark and would 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 would 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 of the later trade mark with the earlier trade mark.*

14. As is evident from the wording of Section 10(2), the four basic requirements that must be met in order for an objection under it to succeed are that, (i) there must be “an earlier trade mark”, (ii) the goods of the application must be identical with or similar to those in respect of which the earlier trade mark is protected, (iii) the mark applied for must be identical with or similar to that earlier trade mark, and (iv) there must be a resultant likelihood of confusion on the part of the public.

15. The first two of these conditions are fulfilled. The Opponent's marks were filed prior to the relevant date and by virtue of Section 11(1)(b) of the Act, are earlier trade marks as against the present application for the purposes of Section 10. The goods for which protection is sought are identical to the goods protected by the Opponent's earlier marks.

## Comparison of the marks

16. I have compared the respective marks of the parties on the criteria of visual, aural and conceptual similarity and have attempted to make an overall assessment of the extent to which they should be regarded as similar or different. It is important to stress that this is an assessment of the overall impression the marks make on me, having put myself in the shoes of the average consumer of the goods for which the Applicant is seeking protection. Notwithstanding the detailed comparisons I make below, I am mindful that the European Court of Justice has noted (*Sabel BV v Puma AG and Rudolf Dassler Sport Case C-251/95*)<sup>1</sup> that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. For this reason, the appreciation of the visual, aural and conceptual similarity of the marks must be based on the overall impressions given by them, rather than on specific points of detail that are likely to go unnoticed by the average consumer.
17. There are some visual similarities between the marks in that both begin with “CAL”, end in “IN” and contain the letters “I-N-K” in the middle. But there are obvious differences also. The Applicant’s mark comprises a single word whereas the Opponent’s contain two words. Also, the overlapping, shaded circles in the Applicant’s mark are not present in the earlier marks, though these circles are entirely secondary in the overall impression of the Applicant’s mark. There are upper case letters in the earlier marks but none in the Applicant’s mark. The presence of the large initials “C” and even larger “K”, which dominate the Opponent’s logo mark, emphasises the two-word nature of the earlier marks. These letters are so prominent they obscure the words “Calvin Klein” to such an extent that the logo mark will be seen as “CK”, together with an explanation of what the “CK” stands for. In my opinion, the average consumer would judge the level of visual similarity between the Applicant’s mark and the Opponent’s CALVIN KLEIN word mark as medium-high, and between the Opponent’s “CK Calvin Klein” logo mark as medium-low.
18. Orally, the respective marks commence with the syllable “CAL” and end in “IN”. It is well established that the opening syllable of a word mark is generally the most important in terms of its visual and aural identity. I cannot be certain of how the average consumer would pronounce the Applicant’s mark, but I imagine most people would pronounce it “CAL-IN-KAL-IN” where the first two syllables are repeated. Of course one could split

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<sup>1</sup> Paragraph 23 of decision dated 11 November, 1997

CALINKALIN another way and pronounce it ‘CAL-INK-A-LIN, though in my opinion, such a pronunciation of the word would not make it any more or any less aurally similar to the Opponent’s marks. In assessing the overall level of similarity of the two marks from a purely aural perspective, I would say that there is a medium degree of aural similarity.

19. Conceptually, in my opinion, the marks are completely different. The Opponent’s marks relate to a person (Calvin Klein). In terms of the contested goods the consumer would understand the Opponent’s marks to indicate an individual who owns or founded the brand or the person who designs, or in the past designed, goods bearing the mark. In contrast the Applicant’s mark is a made-up word without meaning.
20. Having completed a global assessment, I find the two marks share a low level of overall similarity – they are far more dissimilar than they are similar.

### **Likelihood of confusion**

21. The question is whether that similarity is sufficient to come within the meaning of Section 10(2)(b) of the Act? The criteria against which that assessment should be made have been enunciated in a number of decisions of the European Court of Justice<sup>2</sup> in this area and they include the following:
  - (i) A lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks, and vice versa;
  - (ii) The more distinctive the earlier mark, the greater will be the likelihood of confusion;
  - (iii) In determining the distinctive character of the earlier mark, it is necessary to make an overall assessment of its capacity to identify the goods for which it is registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings;
  - (iv) In making that assessment, account should be taken of the inherent characteristics of the mark; the market share held by it; how intensive, geographically widespread and

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<sup>2</sup> Sabel BV –v- Puma AG and Rudolph Dassler Sport (Case C-251/95) [1998] 1 CMLR 445; Canon Kabushiki Kaisha –v- Metro-Goldwyn-Mayer Inc. (Case C-39/97) [1999] 1 CMLR 77; Lloyd Schuhfabrik Meyer & Co. GmbH –v- Klijsen Handel BV (Case C-342/97) [1999] 2 CMLR 1343



long-standing use of the mark has been; the amount invested in its promotion; the proportion of the relevant public which, because of the mark, identifies the goods as originating from a particular undertaking; and statements from chambers of commerce and industry and other trade and professional associations;

- (v) A global appreciation of the likelihood of confusion must, as regards the visual, aural and conceptual similarity of the marks in question, be based on the overall impression created by them, and the importance to be attached to each of those elements must take account of the category of goods and the way in which they are marketed;
- (vi) The assessment must be made from the perspective of the average consumer who is deemed to be reasonably well-informed, observant and circumspect but who rarely has the chance to make a direct comparison of the marks and must rely on the imperfect picture that he has of them in his mind;
- (vii) The likelihood of confusion must be appreciated globally, taking into account all of the factors relevant to the circumstances of the case.

22. In applying those criteria to the facts of the present case, I have reached the following conclusions:

- a. The Opponent's marks have a high degree of inherent distinctiveness and have an obvious capacity to identify the goods for which they are registered as being those of a particular undertaking and thus to distinguish those goods from those of other undertakings.
- b. The Opponent's marks are long established, recognised easily and known in the State, and are readily associated with clothing and fashion items in general. I am satisfied they have acquired substantial additional distinctiveness through use and promotion on those products.
- c. The consumers of the relevant goods are the public generally and it is the likely perception of the average member of the public that I shall consider.

- d. The overall impression created by the marks in question is that they are different. Visually and verbally they are somewhat different. Conceptually the marks are completely different.
  - e. For the reasons set out in paragraphs 19-22 above, I regard the marks in question as having a low level of similarity. However, the goods covered by the Application are identical to the goods of the earlier registrations, which means a lower level of similarity between the marks could be deemed sufficient to declare a likelihood of confusion exists.
23. In light of the foregoing factors, I am required to make an overall assessment of the likelihood of confusion that may exist. The confusion in question may be direct confusion, whereby the Applicant's services are mistaken for those of the Opponent, or indirect confusion, whereby the Applicant's goods are associated in the mind of the consumer with that of the Opponent and a common commercial origin is inferred. I must look at the question of likelihood of confusion from a practical perspective in the context of the marketplace and put myself in the shoes of the average consumer.
24. The Opponent's CALVIN KLEIN marks appear on identical goods for which the Applicant seeks protection for its CALINKALIN mark. Consumers of these goods typically purchase them in retail stores, where they are on display on the shop-floor, on the basis of visual examination. Consumers are not likely to request them by name at the counter. Accordingly, I must attach more importance to the visual comparisons between the marks than to the verbal comparison.
25. I must judge the matter of the assessment of likelihood of confusion in accordance with ECJ guidance to decision-makers, which can, for the purpose of these proceedings, be summarised as follows: *Imagine a typical purchasing scenario involving the average person who already knows products sold under the earlier trade mark and ask yourself whether it is likely that, on encountering the Applicant's mark when shopping, he will use the Applicant's retail services in the mistaken belief that the services are being provided by the undertaking he knows by the earlier mark (direct confusion) or that the retailer is linked economically to the undertaking he identifies by the earlier mark (indirect confusion by association).*

26. It is not necessary to find that every consumer would be confused and nor is it sufficient to find that some consumers might be confused in order to refuse registration of a trade mark under Section 10(2). The question is whether it is likely or unlikely that the average person would be confused in the course of the typical purchasing scenario. The comparison between the Opponent's marks and the Applicant's mark has identified some similarities, but notwithstanding these, when the respective marks are viewed as a whole the immediate and obvious conclusion I draw is the marks are different.
27. However, the Courts have ruled that a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and in these proceedings the goods are identical. Bearing this important consideration in mind I am satisfied nonetheless that the actual level of similarity between the marks falls way short of what is required in order for me to conclude that a likelihood of confusion exists.
28. While the Courts have ruled that the more distinctive the earlier mark, the greater will be the likelihood of confusion, this does not mean that differences between marks should be overlooked or played down. In my opinion, in cases where the respective marks are different, the decision maker cannot bestow a greater level of similarity than that which exists between the marks, on the basis that the earlier marks are highly distinctive.
29. The Court of Justice of the European Union has also found in *LLOYD*<sup>3</sup> the average consumer "*must be deemed to be reasonably well informed and circumspect and observant – but who rarely has the chance to make a direct comparison between marks and must instead rely upon the imperfect picture of them he has kept in his mind*". However, in my opinion, this does not hold true for extremely well-known marks such as the Opponents in these proceedings
30. Extremely successful, well-known and highly distinctive marks must be afforded greater levels of protection than other marks, but their standing in the marketplace means they are less likely to be confused with other marks, even third-party marks that contain some shared elements. They are both instantly recognised and instantly differentiated from other marks. This is because, in my opinion, consumers keep perfect pictures of extremely well-known marks in their minds, not imperfect pictures. The CALVIN KLEIN brand is

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<sup>3</sup> Lloyd Schuhfabrik Meyer & Co. GmbH –v- Klijsen Handel BV (Case C-342/97) [1999] 2 CMLR 1343

renowned as one of the foremost fashion labels in the world and, as such, goods bearing the brand command higher retail prices and are sold in outlets operating at the upper-end of the fashion market. The mark has global appeal and would be known to most, if not all Irish adult consumers who have ever bought clothing or are in any way fashion conscious. I am satisfied the average consumer would easily recall the extremely well-known CALVIN KLEIN mark and would not be likely to err in recollecting it.

31. The Opponents marks are readily identified from both a verbal and visual perspective and I am satisfied that, in the instant case, consumers will instinctively recognise that the Applicant's CALINKALIN mark is not CALVIN KLEIN. The average consumer will not be likely to be confused and to wrongly believe that goods bearing the Applicant's mark originate from, or are associated with, the same undertaking that is responsible for the CALVIN KLEIN mark.
32. For these reasons, I have decided that there is no likelihood of the confusion or a likelihood of association between the Applicant's mark and the Opponent's earlier marks that Section 10(2) of the Act seeks to avoid. I am satisfied that the prior registration and use of the Opponent's earlier trade marks does not constitute grounds for refusal of the application to register CALINKALIN. Therefore, I have decided to dismiss the opposition and to allow the application to proceed to registration.

Dermot Doyle  
Acting for the Controller  
22 July 2014