



INVESTOR IN PEOPLE

World Intellectual Property Organisation (WIPO)
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1211 Geneva 20
Switzerland

The Patent Office
Trade Marks Registry
Cardiff Road
Newport
South Wales
NP10 8QQ

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Our ref Opp 71212/Trade Marks Law/TB
Date 6 July 2005



Please quote our complete reference on all correspondence

The Case Work Examiner for these proceedings is Mr M King: 01633 811045

Dear Sirs

**NOTIFICATION OF A TOTAL REFUSAL OF PROTECTION BASED ON AN
OPPOSITION BY THE UNITED KINGDOM PATENT OFFICE IN ACCORDANCE
WITH ARTICLE 5 OF THE MADRID PROTOCOL**

RE: International Registration number :827830
For the mark :SIXTYSEVEN BY MUSTANG
Holder of the International Registration :Pascual Ros Aguilar
Opposition number :71212

I must advise you that following receipt of an opposition to the above Trade Mark, it is necessary to issue this formal provisional refusal letter. This provisional refusal covers all of the goods and services of the International Registration.

Please find attached a copy of the Form TM7 (Notice of Opposition) that was received by the United Kingdom Trade Mark Registry.

We also attach:

Copies of the marks referred to in the statement of case.
Form TM8, for any reply to this opposition to be filed.
Form TM33 for an agent/ address for service in the United Kingdom to be appointed.
A copy of an extract from the United Kingdom Trade Marks Act 1994.



INVESTOR IN PEOPLE

If the holder of the International Registration wish to file a counterstatement, they should complete the attached form TM8 and return it together with the counterstatement within **3 months** of the date of this letter. This period cannot be extended, except in the circumstances described below. The holder should note that failure to file a form TM8 and counterstatement will result in the provisional refusal being upheld in accordance with article 10 of the Trade Marks International Registration Order 1996(as amended).

If both parties to this dispute wish to negotiate and want to enter a 'cooling off period' then the time for filing the Form TM8 can be extended for a further nine months by the filing of A Form TM9c.

The Form TM8 and counterstatement should be received on or before **6 October 2005** unless a cooling off period is entered into by the parties.

The holder of the International Registration must provide us with an address for correspondence in the United Kingdom on the attached TM33 within this 3 month period. If one is not provided within this time the refusal will be made final.

Yours faithfully

Tracey Beecham

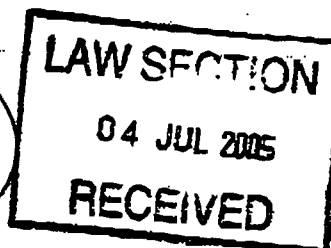
LAW SECTION ASSISTANT CASEWORK EXAMINER

71212

Form TM7

J114502/ 001 002882 TM7.....
02JUL05 200.00 ACCOUNT

Official fee £200 due with this form



Notice of opposition and statement of grounds

The Patent Office
Trade Marks Registry
Cardiff Road, Newport
South Wales NP10 8QQ

Please read the guidance notes below about filling in this form

| | | |
|------------------------------------------------------------------------------------------------------------------------------------------------|---------------------------------------------------------------------------------------------------|-------------------|
| 1. Trade Mark number. | M827830 | 25 (lowest) Class |
| 2. Full name of the applicant or registered proprietor. | Pascual Ros Aguilar | |
| 3. Full name and address (including postcode) of the opponent. | Mustang Bekleidungswerke GmbH & Co. KG Austrasse 10 D-74653 Kunzelsau Germany | |
| 4. Name and address (including postcode) of the agent (if any). | BOULT WADE TENNANT VERULAM GARDENS 70 GRAY'S INN ROAD LONDON WC1X 8BT | |
| 5. Are there any related proceedings currently with the Registry or the courts? If so, give application, registration or opposition number. | No | |
| 6. Under what sections of the Trade Marks Act are you opposing this application? | 5(2)(b) | |
| 7. Declaration | I believe that the facts stated in this notice and in the attached statement of grounds are true. | |
| Your signature | | |
| Your name in BLOCK CAPITALS | BOULT WADE TENNANT | |
| Date | 30 June 2005 | |
| 8. Name and daytime phone number of the person we should contact in case of query. | Felicity K. Hilde 020 7430 7500 | |
| Your reference. | TAB/FKH/T79398GB00 | |
| Number of sheets attached to this form. | This is sheet 1 of 16 | |

Notes You must attach a separate sheet for each earlier mark you rely on.

If there is not enough space for your answers to any section, you may use extra blank sheets.

Number every extra sheet and say in question 8 above how many sheets you have used.

(REV/July04)

Form TM7

Form TM7

Sheet 2 of 16

Use this sheet if you are basing your opposition on section 5(1) or 5(2) of the Trade Marks Act.
Tick which section you are relying on and give details of the earlier mark.
You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.

Statement of grounds for opposition based on section 5(1) or (2) of the Trade Marks Act 1994.

- ☐ 5(1) identical with an earlier mark and for identical goods or services as the earlier mark.
- ☐ 5(2)(a) identical with an earlier mark and for similar goods or services as the earlier mark.
- ☒ 5(2)(b) similar to an earlier mark and for identical or similar goods or services as the earlier mark.

Details of earlier trade mark

Number: 783602

Is it a UK, Community or International mark? International, designating UK

Representation of the mark:

MUSTANG

What goods or services (including their class) are covered by this mark?

Please see attached Register extract.

State which goods or services in the application you say are identical or similar to those covered by the earlier mark.

All goods in the application are identical and similar to those covered by the earlier mark. See also Statement of Grounds.

Statement of use

If the earlier mark has been registered for five years or more before the publication of the mark you are opposing, state which goods or services the earlier mark has been used on in that time, or state why the mark has not been used in that time;

Form TM7

IPDL Search Result

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1 of 1

(151) 15.06.2002

783602

(180) 15.06.2012

(171) 10

(732) MUSTANG -

Bekleidungswerke GmbH. + Co. KG

Austrasse 10

74653 Künzelsau (DE)

(812) DE

(842) Société allemande Allemagne

(740) Beyer & Jochem

Patentanwälte

Klettenbergstrasse 13

60322 Frankfurt (DE)

(540) Mustang

(541) Reproduction of the mark where the mark is represented in standard characters

(511) 03 *Perfumery; essential oils, cosmetics.*

Parfums; huiles essentielles, cosmétiques.

14 *Watches, jewellery, cuff links, tie pins; goods of precious metal and their alloys or goods coated therewith, namely handicraft objects, decorative objects, ashtrays, cigar and cigarette cases, cigar and cigarette holders.*

Montres, bijoux, boutons de manchettes, épingles à cravate; métaux précieux et leurs alliages et produits en ces matières ou en plaqué, à savoir objets d'artisanat, objets de décoration, cendriers, étuis à cigares et à cigarettes, fume-cigare et fume-cigarette.

25 *Clothing, including knitted clothing; hosiery, shoes, boots, sport shoes, slippers; headgear.*

Vêtements, notamment tricot; articles de bonneterie, chaussures, bottes, chaussures de sport, pantoufles; articles de chapellerie.

(822) DE, 21.05.2002, 301 72 988.3/25

(300) DE, 21.12.2001, 301 72 988.3/25

(831) AT, BA, BG, BX, CH, CZ, ES, FR, HR, HU, IT, LV, MD, MK, PL, PT, RO, RU, SI, SK, UA, UZ, YU

(832) DK, EE, FI, GB, GR, LT, NO, SE, TR



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Trade mark details as at 20 June 2005

DETAILS FOR INTERNATIONAL MADRID(UK) CASE M783602

Mustang

Mark text:
Mustang

UK case status: Protected

Classes: 03, 14, 25

Relevant dates

Date of international registration: 15.06.2002
Date of protection in the UK: 15.06.2002
Next renewal date: 15.06.2012

Priority claims

Priority date: 21.12.2001
Country: Germany
Reference: 301 72 988.3/25

Office of origin details

Office of origin:- Germany

Basic application or registration

Page 2 of 3
5 of 16**number**
301729883/25**Filing or registration date**
21.05.2002

Publication

| | Journal | Page | Publication date |
|--------------------------------|----------------|-------------|-------------------------|
| First advert in UK TMJ: | 6450 | 16848 | 02.10.2002 |

List of goods or services

Class 03:
Perfumery; essential oils, cosmetics.

Class 14:
Watches, jewellery, cuff links, tie pins; goods of precious metal and their alloys or goods coated therewith, namely handicraft objects, decorative objects, ashtrays, cigar and cigarette cases, cigar and cigarette holders.

Class 25:
Clothing, including knitted clothing; hosiery, shoes, boots, sport shoes, slippers; headgear.

Names and addresses

Holder: MUSTANG - Bekleidungswerke GmbH. + Co. KG
Austrasse 10, Künzelsau, Germany, D-74653

Representative: Dipl.-Wirtsch.-Ing. Bernd JOCHEM of the office: Patentanwälte BEYER & JOCHEM
Klettenbergstrasse 13, Frankfurt am Main, Germany, D-60322

This enquiry includes information from the International Registration held at the UK Patent Office. We have made every effort to ensure that it is as accurate as possible, but we cannot guarantee that it is a true reflection of the International Registration data supplied by WIPO. If you want to see details of the definitive International Registration, please visit the World Intellectual Property Organization.



* Please note that the "M" prefix is used purely within the UK and is not part of the Madrid (UK) registration number.

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[Click here for a glossary of terms relating to International and Community trade marks.](#)

New case enquiry New text enquiry New proprietor enquiry New refused enquiry



United Kingdom Trade Marks Act 1994

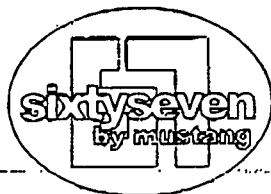
IN THE MATTER OF
International Registration no. 827830
in the name of Pascual Ros Aguilar
(hereinafter "the applicant")
and application for conferral of protection in the UK
for SIXTYSEVEN BY MUSTANG + DEVICE
(hereinafter "the applicant's mark")
and
opposition thereto by Mustang Bekleidungswerke GmbH & Co. KG
(hereinafter "the opponent")

Statement of Grounds

1. The opponent is Mustang Bekleidungswerke GmbH & Co. KG of Austrasse 10, D-74653 Kunzelsau, Germany. The opponent is the proprietor of International Registration no. 783602, protected in the United Kingdom (hereinafter "the opponent's mark"). Register extracts are attached showing full details of the opponent's mark: as it has an earlier date of protection in the United Kingdom than that of International Registration no. 827830, it is an "earlier mark" as defined by Section 6 of the Act.
2. The opposition is based on Section 5(2)(b) of the Act and is directed against all goods claimed by the applicant.
3. The applicant's goods "footwear" are identical to the opponent's goods "shoes, boots, sport shoes".

The applicant's goods "footwear" are also similar to the opponent's goods "clothing; headgear". It is common in the field of clothing and footwear for the same manufacturer to produce both sets of goods under the same mark, and so under the tests set out in *Canon KK v. MGM Inc.* [Court of Justice, Case no. C-39/37, paragraph 23] the applicant's "footwear" must be considered similar to the opponent's "clothing" as the respective goods share their nature, their end users, their method of use and are complementary in nature.

4. The applicant's and opponent's marks are shown below:

Applicant's mark:**Opponent's mark:****MUSTANG**

The applicant's mark consists of the words SIXTYSEVEN BY MUSTANG, together with a graphic element. The opponent's mark is the unstylised word MUSTANG.

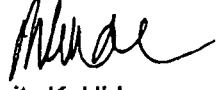
When the required global appreciation of a likelihood of confusion is carried out, all relevant factors must be taken into account. [*Sabel BV v. Puma AG*, Court of Justice, Case C-251/95, paragraph 22]. Such factors include an assessment of the likely perception of the average consumer [*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel BV*, Court of Justice, Case C-342/97, paragraph 26], who is deemed to be reasonably well-informed and reasonably observant and circumspect but who only rarely has the chance to make a direct comparison between the different marks and must place his trust in the imperfect picture of them that he has kept in his mind.

Bearing these points in mind, it is relevant to note that the consumer in the relevant field of clothing and footwear is well used to the concept of house brands being used with sub-brands (e.g. "Air Max by Nike"), and so will immediately perceive the applicant's mark as a sub-brand of the opponent, i.e. as being connected with or otherwise authorised by the opponent. The presentation of the word elements of the applicant's mark as SIXTYSEVEN BY MUSTANG [our emphasis] clearly indicates that the controlling entity - the guarantor of origin, in effect - is the entity Mustang.

5. Given the harmonisation of European trade mark law by means of Directive no. 89/104, it is also relevant to note that the Community Office has issued decisions on very similar disputes between the applicant and the opponent, and we attach for reference a copy of decision nos. 2292/2003, relating to a substantially identical dispute between the same parties. This decision was not appealed. Although the United Kingdom Office is not bound by this decision, we submit that they are of relevance as this opposition asks the United Kingdom Office to determine substantially the same issues.

The opponent requests that protection in the United Kingdom for International Registration no. 827830 be refused entirely under Section 5(2)(b) of the Act, and that an award of costs be made in the opponent's favour.

I believe that the facts stated in this Statement of Grounds are true.


Felicity K. Hide
BOULT WADE TENNANT
30 June 2005

647137, FKH, AHB

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OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET
(TRADE MARKS AND DESIGNS)

Trade Marks Department

DECISION No 2314/2003

of 30/10/2003

RULING ON OPPOSITION No B 451 965

Opponent: Mustang – Bekleidungswerke GmbH + Co.
Austr. 10
74653 Künselsau
Germany

Representative: Beyer & Jochem
Klettenbergstr. 13
60322 Frankfurt am Main
Germany

Trade Marks:

MUSTANG

MUSTANG

against

Applicant: Pascual Ros Aguilar
Ptda. De Algoda, p.2, N° 37
03296 Elche (Alicante)
Spain

Representative: Javier Ungria López
Ramón y Cajal, 78
28043 Madrid
Spain



Contested application:

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**THE OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET
(TRADE MARKS AND DESIGNS);**

I. FACTS AND PROCEDURE

On 07/11/2000 the applicant filed application No 1 943 844 to register the figurative mark "67 sixtyseven by mustang" as a trade mark in class 25.

This application was published in Community Trade Marks Bulletin No 70/2001 of 20/08/2001.

On 05/11/2001 the opponent filed a notice of opposition to the application.

The opposition is based on the following earlier rights:

- German trade mark registration No 39 536 135 of the figurative mark "MUSTANG". The trade mark was filed on 04/09/1995 and registered on 09/01/1996 for a range of goods and services. The opponent only bases its opposition on some of the goods in class 25.

The opponent has proved he is the current owner of the registered mark by filing a copy of the registration certificate duly translated into the language of the proceedings.

- Community trade mark registration No 357 178 of the word mark "MUSTANG". The trade mark was filed on 03/01/1997 and registered on 06/02/2003 for a range of goods in classes 14, 18 and 25. The opponent only bases its opposition on some of the goods in class 25.

The opponent is the owner of the CTM registration according to the CTM register.

- Earlier sign used in the course of trade in Germany, namely the trade name "MUSTANG – Bekleidungswerke GmbH + Co." for *clothing and footwear*.

The opponent submitted a copy of an extract of the Commercial Register in Germany duly translated into English.

The opponent directs its opposition against all of the goods of the application.

The grounds of the opposition are those laid down in Article 8(1)(b) and 8(4) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark ("CTMR") (OJ OHIM 1/95, p. 53).

On 04/12/2001 the applicant was notified of the opposition under number B 451 965.

English was established as the language of the proceedings.

The adversarial part of the opposition proceedings began on 05/02/2002.

Both parties filed observations and evidence within the time limits given by the Office.

The Office considers that it has sufficient information and now gives a ruling on the opposition.

II. ARGUMENTS OF THE PARTIES

The opponent claims that there is a likelihood of confusion because of the similarity of the marks and because the goods are identical or similar. The opponent argues that its mark is reputed and submits evidence to prove this, namely (1) AG Nielsen Report on market share for jeans and (2) Spiegel Report on degree of awareness of clothing.

The applicant argues that the marks are different. He further submits a certificate issued by the National Association for the Trademark Defence (ANDEMA) which declares that the designation "MUSTANG" is a notorious trade mark and well-known for shoes, bags, complements and textile products. This certificate also states that the products are being marketed under the trade mark "MUSTANG" by the applicant in all Member States of the European Union. The applicant also submits evidence to prove the co-existence of the trade marks in the European Community and particular in Germany, namely several declarations, two of them being from the Official Chamber of Commerce, Industry and Navigation of Alicante and from the Association of Footwear Manufacturers of Elche.

III. DECISION

A. ON THE ADMISSIBILITY OF THE OPPOSITION

The opposition fee has been paid in accordance with the Regulation.

The opposition has been entered within the prescribed time limit, form and conditions.

Consequently, the opposition is admissible.

B. ON THE SUBSTANCE

According to Article 8(1)(b) CTMR, upon opposition by the proprietor of an earlier trade mark, the trade mark applied for shall not be registered:

if because of its identity with or similarity to the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected; the likelihood of confusion includes the likelihood of association with the earlier trade mark.

1. Likelihood of confusion

For practical reasons the Office will first compare the applicant's mark with the opponent's Community trade mark registration No 357 178 of the word mark "MUSTANG" and only go on to consider the other opposing mark if necessary.

a) **Comparison of the goods**

In assessing the similarity of the goods concerned, all the relevant factors relating to these goods should be taken into account. These factors include, *inter alia*, their nature, their end users and their method of use and whether they are in competition with each other or are complementary (see Judgment of the Court of Justice, Case C-39/97, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* [1998] OJ OHIM 12/98, p 1419, paragraph 23). Further factors include the purpose of the goods, their origin, and the pertinent distribution channels and sales outlets.

The opposition is directed against:

ready-made indoor and outdoor clothing; footwear; headgear in class 25.

According to an earlier decision No 2431/2002 (dated 14/08/2002) the CTM application number 357 178 has been rejected for *shoes and footwear for sports* in class 25. The mark has been registered for the remaining goods in this class on which the opposition is based:

clothing, corsets, sportswear, clothing of leather, belts, headgear in class 25.

The applicant's goods *ready-made indoor and outdoor clothing* are included in the opponent's term *clothing*. Therefore, these goods are identical.

The applicant's goods *footwear* are very similar to the goods covered by the opponent's mark. In fact, footwear, shoes and boots serve the same purpose, in principle, as the items of clothing: they are intended for wear by humans, both as protection from the elements and as articles of fashion. The nature of the goods is, therefore, similar and the end users are identical. Moreover, these goods are often sold and presented together in the same shops. In addition, many manufacturers and designers will design and produce both. This is especially true of retail outlet chains or chain stores, which will often provide footwear and clothes under the same trade mark. Taking all these factors into account, the goods *footwear* and *clothing* are considered similar to each other.

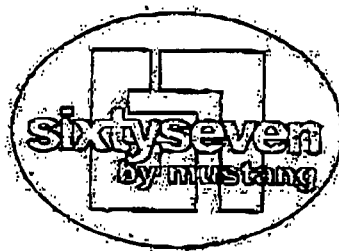
The *headgear*, of the contested mark is of an identical or very similar nature to the *clothing* of the earlier mark, in particular as regards types of clothing which are supposed to give some protection against wind and rain. Furthermore, *headgear* is not only seen as a means for protecting the head against weather influences, but also as a fashion article which is supposed to match the outfit and, for this reason, is sometimes chosen as a complementary item to clothing. Therefore, not only the end users, but also the purpose of the respective goods are identical in this regard. Moreover, the distribution channels of the respective goods are sometimes identical and their sales outlets and departments are often either the same or at least closely connected. Taking all these factors into account, the goods *headgear* and *clothing* are considered similar to each other.

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b) Comparison of the signs

The likelihood of confusion must be determined by means of a global appraisal of the visual, aural and conceptual similarity of the marks, on the basis of the overall impression given by the marks, bearing in mind, in particular their distinctive and dominant components (see Judgment of the Court of Justice, Case C-251/95 *Sabèl BV v Puma AG, Rudolf Dassler Sport* [1997] OJ OHIM 1/98, p. 91, paragraph 22 et seq.).

The comparison has to be made between the following signs:

**MUSTANG**

(earlier mark)

(CTM application)

The earlier mark consists of the word "MUSTANG" written in a normal typeface.

The CTM application consists of the words "SIXTYSEVEN" and "BY MUSTANG" pictured on two lines and superimposed on the numeral "67". All these elements are pictured in a white script and placed inside an oval frame. The words "BY MUSTANG" are pictured in a smaller typeface than the word "SIXTYSEVEN".

The relevant territory is the European Union.

The word "SIXTYSEVEN" is English and has the meaning "67". This word is likely to be understood by European consumers with a basic knowledge of English. In relation to the goods in question, namely clothing, it is common to use numbers in order to differentiate different models of clothing, especially jeans. Thus, to these consumers, the word "SIXTYSEVEN" may be considered weak for the products sold under the mark, as it may indicate a model in a range of clothing coming from the same manufacturer or even be seen as a reference to the year 1967. Therefore, they are likely to perceive the word "MUSTANG" as the dominant word in the contested mark.

According to Collins English Dictionary the word "MUSTANG" has the following meaning: "a small breed of horse, often wild or half wild, found in the south-western U.S.". It is possible that a proportion of European consumers will perceive the word "MUSTANG" with this meaning. However, the relevant consumers could also make some connotation to the brand of a car, namely the "Ford Mustang".

The two marks are visually similar to the extent that they both contain the word "MUSTANG". The differences are the figurative element in the contested mark and the addition of the number "67" and the words "SIXTYSEVEN BY" in this mark. However, the number "SIXTYSEVEN/67" is weak for the goods in question.

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Therefore, less importance should be given to this word, as it does not have a strong distinctive character. Furthermore the additional word elements "BY MUSTANG" strengthen the impression that "SIXTYSEVEN" is a mere description of the products themselves. Consequently, the word "MUSTANG" will be perceived as the dominant part of the CTM application, at least by European consumers with some knowledge of English.

Thus, the overall impression is that the two trade marks have some visual similarities.

The pronunciation of the word "MUSTANG" in the earlier mark coincides with the pronunciation of this word the CTM application. The only difference is the addition of the words "SIXTYSEVEN BY" in the contested mark. However, this part of the mark will most likely be regarded by the relevant part of the public as of secondary importance as it gives an indication of the goods rendered under the mark. Thus, the public will attribute greater importance to the "MUSTANG" element than the number "SIXTYSEVEN" in the CTM application.

Therefore, the opposing trade marks also have phonetic similarities.

From a conceptual point of view, both the CTM application and the earlier mark refer to the word "mustang" which, to some consumers, gives association to a horse or a brand of cars. Thus, to certain consumers there is a conceptual link between the two marks as "SIXTYSEVEN" merely describes the kind of the goods, as mentioned above.

c) Coexistence of the conflicting trade marks.

The applicant argues that he is the owner of three earlier trade mark registrations in Spain and submits evidence of registration. It regards Spanish trade marks Nos 867 718 "CALZADOS MUSTANG", 664 479 "CALZADOS MUSTANG" and 1908 881 "MUSTANG".

Moreover, he submits declarations, which state that the trade mark "MUSTANG" has been used for footwear which has been exported to European countries, especially Germany where the goods have been sold and exposed on different fairs.

In this respect the Office would like to point out the following:

Firstly, the applicant's earlier marks are not identical to the contested CTM application.

Secondly, there might be different reasons why the signs coexist, e.g. a different legal or factual situation in the past or prior rights agreements between the parties involved.

Moreover, the applicant did not submit evidence that the signs have been used in the European Union. The declarations do not prove that footwear was actually sold under the trade-mark "MUSTANG" in the relevant territory. Thus, there is no evidence of actual co-existence on the market.

In several decisions the Boards of Appeal have emphasised the importance of co-existence on the marketplace and of the real presence of the two marks on the market as for instance in decision of 08/01/2002 in case R 360/2000-4 NO LIMITS / LIMMIT, paragraph 13, where the Board reasoned as follows:

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Decision No 2314 / 2003

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"Coexistence of confusingly similar marks in the trade mark register is not relevant. Article 8(1)(b) CTMR makes reference to confusion on the part of the public, i.e. confusion on the market place. Evidence of actual and peaceful coexistence of conflicting marks on the market is a circumstance that the Board may take into consideration in order to assess the likelihood of confusion in the meaning of Article 8(1)(b) CTMR. However, the appellant has failed to supply that evidence. The simple allegation that the respondent did not take action against registration or use of the appellant's mark for Spain is not sufficient. The argument of past peaceful coexistence must be supported by evidence of real presence of the two marks on the market place. Coexistence should be understood as 'co-use', namely concurrent use of the two (supposedly conflicting) marks, rather than 'co-registration', i.e. concurrent presence in a trade mark register. The appellant did not supply evidence that his mark and the respondent's mark have actually been co-used in Spain".

The Board has reasoned similarly in decision of 05/09/2002 in case R 0001/2002-3 CHEE.TOS/CHITOS, paragraphs 26-29, and decision of 27/02/2002 in case R 0851/2000-3 MAGIC / MAGIC BOX, paragraph 30.

Therefore, this argument cannot be taken into account.

d) Conclusion

The goods of the CTM application are identical or similar to the goods of the earlier Community trade mark registration.

As mentioned above, the trade marks of the applicant and the opponent have certain visual and phonetic similarities and are conceptually similar in part of the territory where English is spoken/understood, due to their common and distinctive element "MUSTANG".

It should be noted that the average consumer only rarely has the chance to make a direct comparison between the different marks but must place his trust in the imperfect picture of them he has kept in mind (see Judgment of the Court of Justice, Case C-342/97 *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.* [1999] OJ OHIM 12/99, paragraph 26).

In general the established similarities between trade marks are retained in the average consumer's recollection rather than their differences.

Taking into account all the relevant factors of the case, it is concluded that, because of the identity and similarity of the goods of the earlier mark and those of the contested CTM application and because of the visual, phonetic and conceptual similarities, there is a likelihood of confusion on the part of the public in the European Community where the earlier trade mark is protected.

As the opposition is successful on the basis of the earlier Community word mark "MUSTANG", it is not necessary to compare the other earlier German mark with the CTM application.

Furthermore, as the CTM application must be rejected under the terms of Article 8(1)(b) CTMR, it is not necessary to go on to consider whether or not the opposition is

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Decision No.2314 / 2003

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well founded under the terms of Article 8(4) CTMR.

C. COSTS

According Article 81(1) CTMR, the losing party in opposition proceedings must bear the fees incurred by the other party, as well as all costs.

According to Rule 94(1) of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing the CTMR ("IR") (OJ OHIM 2-3/95, p.258), the apportionment of costs is dealt with in the decision on the opposition.

Since the applicant is the losing party in the opposition proceedings, it must bear all costs incurred by the other party in the course of these proceedings.

ON THOSE GROUNDS, THE OFFICE HEREBY:

1. Upholds opposition number **B 451 965** for all the contested goods.
2. Rejects application number **1 943 844** in its entirety.
3. Orders the applicant to bear the costs.

Alicante, 30/10/2003

The Opposition Division

Birgit Holst Filtenborg

Julio Laporta

Wolfgang Schramek

Form TM8

Nil Fee



Notice of defence and counterstatement

The Patent Office
Trade Marks Registry
Cardiff Road, Newport
South Wales NP10 8QQ

Please read the guidance note about filling in this form.

| | |
|------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|----------------|
| 1. Trade Mark number. | (Lowest) Class |
| 2. Full name of the applicant or registered proprietor. | |
| 3. Opposition, invalidation, revocation, or rectification number. | |
| 4. Name and address (including postcode) of the agent (if any). | |
| 5. If a statement of use of any earlier trade marks has been given in support of the opposition or invalidation action, do you accept this statement? | |
| 6. If you answered "No" to question 5, do you want the other side to provide proof of use of the earlier marks? If you want the other side to provide proof of use you must state in your counterstatement for which earlier marks and for which goods and services you require that proof. | |
| 7. Counterstatement | |

Counterstatement (continued from previous sheet)

| | | |
|----|---------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------------------|
| 8. | Declaration | I confirm the truth and accuracy of the information in this notice of defence and counterstatement. |
| | Your signature | |
| | Date | |
| 9. | Name and daytime phone number of the person we should contact in case of query. | |
| | Your reference. | |
| | Number of sheets attached to this form. | |

Note If you need more space for your counterstatement you may attach separate sheets. Number each one and say in question 9 how many sheets you have used.

Form TM33

No official fee due



Request to appoint or change an agent or to enter or change an address for service

The Patent Office
Trade Marks Registry
Cardiff Road, Newport
South Wales NP9 1RH

Please refer to notes for guidance on completing this form

| 1. Give details of the applications or registrations this will affect or the designation under the Madrid Protocol to which this request relates | <table border="1"> <thead> <tr> <th>Number(s)</th> <th>(Lowest) Class</th> <th>Licensee Numbers</th> </tr> </thead> <tbody> <tr> <td> </td> <td> </td> <td> </td> </tr> <tr> <td> </td> <td> </td> <td> </td> </tr> </tbody> </table> | Number(s) | (Lowest) Class | Licensee Numbers | | | | | | |
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| Number(s) | (Lowest) Class | Licensee Numbers | | | | | | | | |
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| | | | | | | | | | | |
| 2. Full name of (a) proprietor (b) opponent (c) licensee (indicate a) to c) as appropriate) | 2. Full name of (a) proprietor (b) opponent (c) licensee (indicate a) to c) as appropriate) | | | | | | | | | |
| 3. On behalf of the proprietor, grantor, licensee or opponent we notify you that we are the authorised: a) agent and address for service or b) address for service or c) agent (indicate a) to c) as appropriate) | 3. On behalf of the proprietor, grantor, licensee or opponent we notify you that we are the authorised: a) agent and address for service or b) address for service or c) agent (indicate a) to c) as appropriate) | | | | | | | | | |
| 4. Is the agent or address for service authorised for: a) all transactions or b) this transaction only (indicate a) or b) and if b) provide details of transaction) | 4. Is the agent or address for service authorised for: a) all transactions or b) this transaction only (indicate a) or b) and if b) provide details of transaction) | | | | | | | | | |
| 5. New address for service or agent's details to be recorded Trade Marks AOP number (if you know it) Your reference | 5. New address for service or agent's details to be recorded Trade Marks AOP number (if you know it) Your reference | | | | | | | | | |
| Signature | Signature | | | | | | | | | |
| Name (block capitals) | Name (block capitals) | | | | | | | | | |
| Date | Date | | | | | | | | | |
| Name and daytime telephone number of person to contact | Name and daytime telephone number of person to contact | | | | | | | | | |
| State number of sheets attached to this form | State number of sheets attached to this form | | | | | | | | | |



RELEVANT SECTIONS OF THE UNITED KINGDOM TRADE MARKS ACT 1994



SECTION 1

(1) In this Act "trade mark" means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of another undertaking.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.

(2) References in this Act to a trade mark include, unless the context otherwise requires, references to a collective mark (see Section 49) or certification mark (see Section 50).

SECTION 2

(1) The following shall not be registered-

- (a) signs which do not satisfy the requirements of Section 1(1),
- (b) trade marks which are devoid of any distinctive character,
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.

Provided that a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

(2) A sign shall not be registered as a trade mark if it consists exclusively of-

- (a) the shape which results from the nature of the goods themselves,
- (b) the shape of goods which is necessary to obtain a technical result, or
- (c) the shape which gives substantial value to the goods.

(3) A trade mark shall not be registered if it is-

- (a) contrary to public policy or to accepted principles of morality, or
- (b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or services).

(4) A trade mark shall not be registered if or to the extent that its use is prohibited in the United Kingdom by any enactment or rule of law or by any provision of Community Law.

(5) A trade mark shall not be registered in the cases specified, or referred to, in Section 4 (especially protected emblems).

(6) A trade mark shall not be registered if, on the date of the application, it is made in bad faith.

SECTION 4

(1) A trade mark which consists of or contains-

- (a) the Royal arms, or any of the principal armorial bearings of the Royal arms, or any insignia or device so nearly resembling the Royal arms or any such armorial bearings as to be likely to be mistaken for them or it,

(b) a representation of the Royal crown or any of the Royal flags,

(c) a representation of Her Majesty or any member of the Royal family, or any colourable imitation thereof, or

(d) words, letters or devices likely to lead persons to think that the applicant either has or recently has had Royal patronage or authorization,

shall not be given unless it appears to the registrar that consent has been given by or on behalf of Her Majesty or, as the case may be, the relevant member of the Royal family.

(2) A trade mark which consists of or contains a representation of-

(a) the national flag of the United Kingdom (commonly known as the Union Jack), or

(b) the flag of England, Wales, Scotland, Northern Ireland or the Isle of Man,

shall not be registered if it appears to the registrar that the use of the trade mark would be misleading or grossly offensive.

Provision may be made by rules identifying the flags to which paragraph (b) applies.

(3) A trade mark shall not be registered in the cases specified in-

section 57 (national emblems etc of Convention countries), or

section 58 (emblems etc of certain international organizations).

(4) Provision may be made by rules prohibiting in such cases as may be prescribed the registration of a trade mark which consists of or contains-

(a) arms to which a person is entitled by virtue of a grant of arms by the Crown, or

(b) designs so nearly resembling such arms as to be likely to be mistaken for them, if it appears to the registrar that consent has been given by or on behalf of that person.

(5) A trade mark which consists of or contains a controlled representation within the meaning of the Olympic Symbol etc (Protection) Act 1995 shall not be registered unless it appears to the registrar-

(a) that the application is made by the person for the time being appointed under Section 1(2) of the Olympic Symbol etc (Protection) Act 1995 (power of Secretary of State to appoint a person as the proprietor of the Olympic Association Right), or

(b) that consent has been given by or on behalf of the person mentioned in paragraph (a) above.

SECTION 5

(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

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

(a) it is identical with an earlier trade mark and is to 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 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 confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

(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, or

(b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered design.

A person thus entitled to prevent the use of a trade mark is referred to in this Act as a 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.

SECTION 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) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), or

(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 or the World Trade Organization Agreement as a well known trade mark.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.

(3) A trade mark within subsection (1)(a) or (b) whose registration expires shall continue to be taken into account in determining the registrability of a later mark for a period of one year after the expiry unless the registrar is satisfied that there was no bona fide use of the mark during the two years immediately preceding the expiry.

SOURCES OF PROFESSIONAL HELP AND ADVICE

You may obtain details of where to get independent or professional help/advice from either of the following:

+ The Institute of Trade Mark Attorneys
Chartered House
25 St Andrew Place
LONDON
SE1 0AA

tel: +44(0) 20 8526 2652
fax: +44(0) 20 8686 5723

+ The Chartered Institute of Patent Agents
Simple Lane Building
25 Abchurch Lane
LONDON EC4N 3DF