

**TRADE MARKS ACT 1938 (AS AMENDED) AND
TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No 1541879 BY
PAISANO PUBLICATIONS INC
TO REGISTER A TRADE MARK IN CLASS 18**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No 42262
BY THE H. D. LEE COMPANY, INC.**

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**IN THE MATTER OF Opposition thereto under
No 42262 by the H.D. Lee Company, Inc**

BACKGROUND

1. On 14 July 1993 Paisano Publications Inc of Agoura Hills, California, United States of America, applied to register the trade mark **EASYRIDERS** in Class 18. Following examination, the mark was accepted in Part B of the Register and published for the following specification of goods:

“Leather and imitations of leather, and articles made from these materials; skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; all included in Class 18; but not including slings, harnesses, whips or saddlery”.

2. The application is opposed by The H. D. Lee Company Inc, of Wilmington, Delaware, United States of America. In their skeleton argument, the opponents restricted the basis of their opposition to the following grounds:

1) under Section 11 of the Act, as the mark in suit is likely to deceive or cause confusion or would be otherwise disentitled to protection in a court of justice

2) under Sections 12(1) of the Act, as the mark in suit so nearly resembles a range of RIDER marks owned by the opponents and which are registered in respect of goods of the same description as the application in suit. The marks on which the opponents rely are: 935408, 938937 and 1259147 all in Class 25 and for the marks LEE RIDERS (word only), LEE RIDERS (words and device) and Lee Rough Riders (words and device) respectively.

3. The applicants filed a counterstatement in which the grounds of opposition are denied.

4. Both sides ask for the Registrar to exercise her discretion and to award costs in their favour. Both sides filed evidence. The matter came to be heard on 11 June 2001. The applicants were represented by Mr Hornby of Clifford Chance, Solicitors; the opponents were represented by Ms Anna Carboni of Linklaters, Solicitors. At the Hearing I allowed one month for the parties to provide written submissions on the relevance of the decision of the

Appointed Person Mr Simon Thorley in the LOADED trade mark case [2001] 24(2) IPD 24012 to the facts of this case. Written submissions were subsequently received from both parties and I will return to these later in this decision.

5. By the time the matter came to be heard the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. In accordance with the transitional provisions set out in Schedule 3 to that Act however, I must continue to apply the relevant provisions of the old law to these proceedings. Accordingly, all references in the later part of this decision are references to the provisions of the old law.

Opponents' evidence-in-chief

6. This consists of seven statutory declarations. The first dated 5 June 1997 is by Peter Abbiss. Mr Abbiss is the Lee Brand Director (for Lee Northern Europe) of Lee Apparel (UK) Ltd. He explains that this company is a wholly owned subsidiary of VF Corporation (UK) Ltd who are in turn the United Kingdom operation of VF Corporation, the United States parent company of the H.D. Lee Company Inc,. Mr Abbiss states that he is authorised to speak on the opponents' behalf and adds that the information in his declaration comes either from his personal knowledge or from the records of the opponents to which he has full access. Mr Abbiss explains that he has been responsible for sales and marketing activities with his company since 1982. Prior to that he was Sales and Marketing Director for Levi Strauss UK. He states that he is fully acquainted with the business and goods manufactured by the opponents in both the United States and the United Kingdom adding that as a result of his experience of the clothing industry, he is fully aware of the methods used by traders to market, advertise and promote their merchandise.

7. I note the following facts, insofar as they are relevant, from Mr Abbiss' declaration:

- that the opponents are manufacturers and merchants of clothing goods, including jeans, shirts, t-shirts, sweatshirts, jackets, mens', women's, youths' and young girls' casual jeanswear;
- that the approximate annual turnover of goods sold under the opponents' LEE RIDERS marks (in relation to mens and youth jeans) in the period 1990 to 1993 amounted to some £73m;
- exhibit PAW1 and PAW2 consist respectively of, examples of the LEE RIDERS mark in use on labels, on product manuals and display materials (most of which are either undated or post date the material date in these proceedings) and a video cassette containing advertisements which it is said appeared on national television and in cinemas in the period 1991-1997. In addition to the above, Mr Abbiss says that the opponents have advertised in various publications across the United Kingdom, naming COMPANY, CLOTHES SHOW, THE FACE and SKY MAGAZINES as examples. Copies of the magazines mentioned are not provided;
- that the opponents goods have been supplied throughout the United Kingdom. Exhibit PAW3 which consists of a Customer Master File printout (dated 19 May 1997) is supplied to support this claim.

8. The remaining six declarations are from the following members of the trade: Stefan Pesticcio of Top Man, Cavan Cooper of American Classics, Stephen Docherty of Fosters Trading Company, John Mason of Littlewoods Home Shopping, Tim Whitworth of Best Trading and Julia Redman of Burton Menswear. All six declarations have been filed in support of the opponents' contention that the applicants' EASYRIDER mark is confusingly similar to the opponents' LEE RIDERS marks. I do not propose to summarise each of the declarations here but will of course bear the declarants comments in mind when reaching my decision. However, reproduced below is an extract from the declaration of Stefan Pesticcio which I consider to be fairly typical of the content of the declarations filed. Having explained that he is a Buyer with Top Man with over nine years experience in the retail industry, Mr Pesticcio comments as follows:

“My company sells a variety of LEE jeans and casual clothing, including LEE RIDERS. The distinctive qualities about the jeans, are: the pocket plasters, the stitching, the logo, the quality and the fit. I do not associate the word RIDERS with any other clothing manufacturer except LEE. I cannot think of any clothing which includes the name RIDERS in it. I believe that the RIDERS series of marks is well known to UK casual clothing purchasers as indicating goods from the manufacturer of LEE jeans and other clothing.

Although our stores do stock leather clothing, I have not heard of the name EASYRIDERS in this context. I think that the general public regards the clothing and leather goods sections as closely related, particularly in smaller shops that sell leather goods, jeans and T-shirts together. If my company were to stock the Paisano EASYRIDERS leather goods I believe the public may assume that the EASYRIDERS goods had come from the same source as the RIDERS goods. I also believe that the public could be confused in relation to these products and names”.

Applicants' evidence-in-chief

9. The applicants' evidence consists of an affidavit dated 14 December 1998 by Robert Davis. Mr Davis explains that he is the Treasurer and Vice President of Finance at Paisano Publications Inc a position he has held since 1992. He confirms that he is authorised to make his declaration on the applicants behalf adding that the information comes from either his own personal knowledge or from the records of his company to which he has full access.

10. The following relevant facts emerge from Mr Davis' affidavit:

- that the trade mark EASYRIDERS has been in use on a continuous basis in the United Kingdom since at least 1987-88;
- that his company publishes a magazine under the name EASYRIDERS which is circulated worldwide and which relates to motorbikes and the world of motorcycling.;

- that since at least 1987-88 his company has sold goods under the trade mark in the United Kingdom. The majority of the sales of such goods are through mail orders placed by readers of the company's magazine. Exhibit RD1 consists of a bag and key wallet bearing the mark;
- that the company does not keep accurate records of sales of the goods under the trade mark. But the worldwide turnover for the period 1992-1997 amounted to some \$12.5m;
- that the company's turnover figures under the trade mark in the United Kingdom was approximately 5% of worldwide turnover and thus United Kingdom turnover in the period 1992-1993 amounted to some \$600k and in respect of goods covered by the specification some \$200k;
- that goods sold under the trade mark in the United Kingdom are promoted by placing advertisements in its EASYRIDERS magazine and by producing catalogues illustrating the range of goods available. Exhibits RD2, RD3, RD4 and RD5 consist of: copies of advertisements and catalogues dating from 1987, examples of pages from the applicants' web site, copies of invoices and shipping documents illustrating sale of goods under the trade mark by the applicants to customers in the United Kingdom and examples of name tags and neck and woven labels which are sewn into or onto the goods.

11. Mr Davis then turns his attention to the declaration filed by Mr Abbiss filed as the opponents' evidence- in- chief. The only point I need to note is:

- that in so far as the declarants from the trade are concerned, Mr Davies' notes that each of the declarants state that their company or store sells LEE products. As such, Mr Davis concludes that none of the declarants can be independent of LEE. In addition, he comments that in his view the declarants have not taken into account the specific means by which his company sells goods under the mark ie. through mail-orders placed by readers of their EASYRIDERS magazine or through the applicants' website.

Opponents' evidence-in-reply

12. This consists of a statutory declaration dated 15 June 1999 by Mary Wotring. Ms Wotring explains that she is the Secretary of The H.D.Lee Company Inc for whom she has worked since 1979. She states that she is authorised to speak for the opponents in these proceedings adding that the information in her declaration comes either from her own knowledge or from the records of her company to which she has full access.

13. Having read Mr Davis' evidence for the applicants, Ms Wotring makes the following comments:

- that the figures that have been provided are for EASYRIDERS products in general. In Ms Wotring's view the applicants trade mainly in motorcycle publications and

motorcycle accessories. There is, she says, no breakdown of the figures provided to indicate whether the turnover relates to goods sold under the mark EASYRIDERS in the United Kingdom;

- that the catalogues and advertisements provided by Mr Davis as exhibit RD2 do not demonstrate that goods bearing the mark applied for have been available to customers in the United Kingdom. In Ms Wotring's view the exhibit indicates that the goods illustrated seem only to be offered for sale to customers in the United States;
- that the evidence relating to the applicants' website is not relevant as it is after the material date in these proceedings;
- that in relation to the invoices provided as exhibit 4 to Mr Davis' declaration, there is no indication that all the items listed bore the mark EASYRIDERS. That in so far as the invoices relate to goods sold under the EASYRIDERS mark, these are only in relation to videotapes, calendars and wallets;
- in relation to the various declarations filed by members of the trade on the opponents behalf, Ms Wotring accepts that all the declarants sell goods produced by the opponents. However, she points out that they also sell other clothing goods and accessories, adding that they are all professional retailers who are knowledgeable of the trade relevant to these proceedings. She adds that none of the declarants is related to the opponents' group of companies and they have therefore provided completely independent trade evidence.

14. That concludes my review of the evidence insofar as I consider it relevant to the matters in-hand.

DECISION

15. The matter falls to be decided under Sections 11 and 12 of the Act. These Sections read as follows:-

"11. It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.

12.-(1) Subject to the provisions of subsection (2) of this section, no trade mark shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of:-

- a. the same goods
- b. the same description of goods, or

- c. services or a description of services which are associated with those goods or goods of that description."

16. The reference in Section 12(1) to a near resemblance is clarified by Section 68(2B) of the Act which states that references in the Act to a near resemblance of marks are references to a resemblance so near as to be likely to deceive or cause confusion.

17. The established tests for objections under these provisions are set down in Smith Hayden and company Ltd's application (Volume (1946) RPC 101) later adapted, in the case of Section 11 by Lord Upjohn in the BALI trade mark case (1969) RPC 496. Adapted to the matter in hand, these tests may be expressed as follows:-

(Under Section 11) Having regard to the user of the opponents' RIDERS and LEE RIDERS marks, is the tribunal satisfied that the mark applied for EASYRIDERS if used in a normal and fair manner in connection with any goods covered by the registration proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?

(Under Section 12) Assuming user by the opponents of their LEE RIDERS marks, in a normal and fair manner for any of the goods covered by the registration of those marks, is the tribunal satisfied that there will be no reasonable likelihood of deception amongst a substantial number of persons if the applicants use their mark normally and fairly in respect of any goods covered by their proposed registration?"

18. I begin with the objection under Section 12(1) of the Act. Given that identical goods are not involved here, I turn to the established judicial test for goods of the same description set out by Romer J in the PANDA trade mark case (1946) 63 RPC. This test requires that consideration be given under three headings, namely:

- the nature and composition of the goods;
- the respective uses of the articles;
- the trade channels through which the commodities are respectively bought and sold.

19. The following extract from the Trade Marks Registry's Examination Work Manual gives further guidance on the Registry's approach to the comparison of goods issue (Chapter 10.55):

"In practice, if it is considered that the respective goods coincide in respect of two headings then this is sufficient to justify a finding that the goods are of the same description. (See the Floradix case 1974 RPC 583)

"6. It is doubtful whether given goods are goods of the same description merely because they pass through the same channels of trade.

7. Channels of trade can be broken down into three elements although not all goods will necessarily have all three.

- (a) producer/manufacturer
- (b) wholesaler (if any)
- (c) retailer (if any)

The channels of trade are considered to be the same if two sets of goods meet at any point in their channels of trade. For instance if it is common for both X goods and Y goods to be made by the same firm, or retailed by the same shop the goods are said to have the same channels of trade.

Difficulties may be encountered when dealing with goods sold in departmental stores or supermarkets. In the case of a department store the channels of trade for both X goods and Y goods would be the same if they were sold in the same department or over the same counter.

In the case of a supermarket the channels of trade of both X goods and Y goods would be the same if the two sets of goods were commonly displayed or grouped together.”

20. I note in passing that Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* (the TREAT case) (1996) RPC 281 at pages 296/7 provides what he calls an elaboration on the old judicial test for goods of the same description. Whilst his remarks were made in the context of proceedings under the Trade Marks Act 1994, there is support for the approach adopted by the Registry in relation to consideration of channels of trade where goods are sold in supermarkets or stores. He gives as one of his criteria:

- “(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;”

21. In these proceedings, the opponents base their objection under Section 12(1) of the Act on three registrations in Class 25. These registrations are (cumulatively) registered in respect of the following goods: “Jeans, jackets and trousers”. The question I need to answer is this. Are the goods for which the opponents have registrations, goods of the same description as those for which registration is sought by the applicants in the present case? The applicants are seeking registration in respect of: “Leather and imitations of leather, and articles made from these materials; skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; all included in Class 18; but not including slings, harnesses, whips or saddlery”.

22. At first sight, application of the criteria indicated above would suggest that they are not. Let us consider some examples. Could an umbrella, parasol or walking stick be considered goods of the same description as jeans, jackets and trousers? In my view they could not. The nature and composition of the respective goods are different as are their respective uses. Whilst the goods could (possibly) be bought and sold through the same trade channels, they would not it seems to me be sold side by side or in close proximity (even in smaller stores) or if they were, it would be more by accident than design.

23. What then of the remaining goods in the applicants' specification? Are leather and imitations of leather and articles made from these materials, skins, hides, trunks and travelling bags goods of the same description as the opponents articles of clothing? Here again ones initial reaction may suggest that they are not. Whilst the nature and composition of the respective goods could (perhaps) be the same (clothing and bags made of leather for example), the respective uses of the goods would be quite different. What then of the trade channels through which the respective goods pass?

24. In support of their opposition the opponents have filed evidence from six individuals involved in the retail clothing industry. All of the declarations were sworn in 1997 (some four years after the material date in these proceedings) and all of the declarants are distributors of the opponents' goods. At the hearing, (not surprisingly) both sides urged me to give this expert evidence quite different weight. Mr Hornby (for the applicants) pointed me to the timing of the declarations, adding that in his view the declarants could not be considered impartial given their business relationship with the opponents. Whilst Ms Carboni (for the opponents) accepted that the declarants did not address the position in 1993, she argued that it would be difficult to see why the situation would be so different at the date the declarations were made. She added that in view of the general knowledge of consumers one might think that they might be more sophisticated now than four years ago and so less likely to be confused. In so far as the impartiality of the declarants were concerned, Ms Carboni conceded that all of the declarants did sell LEE products. That said, she noted that they were all from independent outlets who also sold their own or other people's brands. It is as a result of this, that in Ms Carboni's view, the declarants were well placed to talk about the relevant customers and their reaction to the goods.

25. Ms Carboni pointed out that all of the declarants essentially made the same statement. That is, that the leather goods field is perceived by customers as being associated with clothing. In support of this Ms Carboni drew my attention to the comments of Mr Pesticcio which I have reproduced above. However, for the sake of convenience those comments are repeated again here. Mr Pesticcio says:

“Although our stores do stock leather clothing, I have not heard of the name EASYRIDERS in this context. I think that the general public regards the clothing and leather goods sections as closely related, particularly in smaller shops that sell leather goods, jeans and T-shirts together.....”.

26. At the Hearing I referred the parties to the decision of Mr Simon Thorley QC acting in his role as the Appointed Person in the LOADED trade mark case and in particular Mr Thorley's comments with regard to expert evidence. Although that was a case decided under the 1994 Trade Marks Act, it provides useful assistance on the approach this Tribunal should adopt when considering expert evidence. As mentioned earlier in this decision, both parties have provided written submissions on the application of the LOADED principles to the facts of this case:

The applicants' conclusions

“All “the expert evidence” submitted by Lee does not meet the standards set out in the Loaded case.

- It is not clear that any of the six declarants has relevant expertise in relation to the matters on which they give evidence, at least at the relevant dates.
- No detailed reasoning is given in the declarations for the conclusions drawn. Indeed, each declaration would fit on a single sheet of A4, being about four paragraphs long.
- Impermissible conclusions about reputation and confusion are rife in this “evidence”.
- In any event, the relevant dates of 1989 and 1993 are not addressed.

The six declarations should, therefore, be rejected in their entirety”.

The opponents’ conclusions

“Paisano is incorrect in asserting that the LOADED standards are not met. Each of Lee’s expert witnesses gives evidence of their relevant experience which at the least can be said to put them in a position of being significantly more knowledgeable than either party’s adviser or the Hearing Officer as to the relevant public’s perception of Lee’s RIDERS goods and the likelihood of confusion if Paisano uses the EASYRIDERS mark on clothing and leather goods.

It was open to Paisano to put forward trade witnesses whose views were contrary to those expressed by the six witnesses for Lee. It is notable that they did not do so.

Paisano cannot use the arrival of a new decision as an excuse for late attacks on the credibility of witnesses. That is the effect of many of its submissions. Paisano should have dealt with this by a request to cross examine. It did not. Accordingly, the evidence should stand and be taken into account.”

27. In considering the question of expert evidence in the LOADED trade mark case, Mr Thorley commented as follows:

“In order to resolve this aspect of the case, I have reminded myself as to the functions of an expert witness and particularly of the observations of Millett L.J. in *The European Limited v The Economist Newspaper Limited* (1998) FSR 283 at 291:

“The function of an expert witness is to instruct the judge of those matters which he would not otherwise know but which it is material for him to know in order to give an informed decision on the question which he is called to determine. It is legitimate to call evidence from persons skilled in a particular market to explain any special features of that market of which the Judge might otherwise be ignorant and which may be relevant to the likelihood of confusion. It is not legitimate to call such witnesses merely in order to give their opinions whether the two marks are confusingly similar. They are experts in the market, not on confusingly

similarity.....in the end the question of confusingly similarity is one for the Judge. He was bound to make up his own mind and not leave the decision to the opinion of the witnesses”.

Mr Thorley goes on to say:

“Whilst that observation was made in relation to evidence as to confusion, it is important in this case on reputation as well in that it directs attention to the necessity to have regard to the expertise of the deponent in question so that the relevant Judge can be informed as to matters within the trade which he would otherwise be ignorant of. Weight can only be attached to an expert’s opinion when it is an opinion which

(a) is based upon his experience

(b) is explained in sufficient detail so that the court can comprehend the reason why the expert holds that opinion and can assess by reference to the explanation the weight that is to be attached to it”.

28. At the hearing Ms Carboni also drew to my attention the comments of the (then) Vice Chancellor Sir Nicholas Browne-Wilkinson in *Guccio Gucci spa v Paolo Gucci* (1991) FSR 89 in which the Vice Chancellor observed (in relation to expert evidence):

“Plainly it is my decision as to whether or not people will be confused but why I should be required to make that decision on the basis of my own lack of information, rather than on the basis of expert advice from those who can tell me what the experience in that market is, I do not understand”

29. Whilst a number of the applicants’ criticisms of the various declarations are clearly correct (in particular the timing of the declarations and the declarants pre-existing business relationship with the opponents), these criticisms are not in my view sufficient for me to simply dismiss the expert evidence. All of the declarants are employed by companies which are involved in the retail clothing industry and which appear to be independent of the opponents in these proceedings. Whilst the level of experience of the various declarants varies, the cumulative effect of the evidence suggests to me that the declarants believe that the public regard clothing and leather goods as closely related. Clearly these conclusions were reached in 1997 but as Ms Carboni pointed out, I think it is unlikely that the position would have been significantly different at the material date.

30. Having reached this view of the expert evidence, which goods then are to be considered goods of the same description as the opponents’ jeans, trousers and jackets? I note that the question of what goods in Class 18 are similar goods to those in Class 25 has been considered before - see the Hearing Officer’s decision in *QS BY S.OLIVER* (1999) RPC 520. Although this was a decision under Section 5(2)(b) of the 1994 Trade Marks Act which applied the test for similar goods propounded by Jacob J in the *TREAT* trade mark case, it is, I think, useful in reaching a decision in this case.

31. At the hearing Ms Carboni indicated that the following articles were of particular concern to the opponents:

“They include, as well as belts, purses, handbags, and wallets, backpacks”.....
Perhaps the larger trunks and travel bags might be less likely to be sold in the same outlet”.

32. Belts for wear are proper to Class 25 and as such are not relevant, but I have reached the conclusion that purses, handbags, wallets and backpacks are goods of the same description as the named articles of clothing. However, I am not persuaded that this applies to leather and imitations of leather (at large) nor to all articles made from these materials or indeed to skins, hides, trunks or to travelling bags at large.

33. I now go on to consider the marks themselves. The established test for comparison of marks is set down in Pianotist Co’s application (1906) 23 RPC 774, page 777 at line 26 et seq:

"You must take the two words. You must judge of them both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of these trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion - that is to say - not necessarily that one will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public, which will lead to confusion in the goods - then you may refuse the registration, or rather you must refuse the registration in that case."

34. At the hearing, Ms Carboni also drew my attention to the comments in *Aristoc Ltd v Rysta Ltd* (1945) 62 RPC and urged me bear in mind the principle of imperfect recollection when comparing the respective marks.

35. The opponents rely on three registration. These are reproduced below:

Registration No: 935408

Mark: LEE RIDERS - (word only)

Goods: Jeans being articles of clothing, and jackets.

Registration No: 938937



Goods: Jeans being articles of clothing, and trousers.

Registration No: 1259147



Goods: Trousers, jeans, jackets, all being articles of clothing.

36. The application is in respect of the mark EASYRIDERS presented as one word in block capital letters. In my view the highpoint of the opponents case is in respect of registration No: 935408 which is for the word only trade mark LEE RIDERS. If the opponents can not succeed with this registration they are unlikely to succeed with the other two, both of which include significant device elements and in respect of 1259147 additional words. I undertake the comparison below based upon the opponents LEE RIDERS (word only) trade mark.

37. The respective trade marks consist of nine and ten letters respectively. When one compares the opponents' LEE RIDERS mark and the applicants' EASYRIDERS mark it is clear that both share the element RIDERS occurring as it does in the suffix position of both trade marks. In the opponents' trade marks the words LEE and RIDERS are presented as two separate words whereas the applicants' mark is presented as one word. In so far as the prefix elements of the trade marks are concerned ie. LEE and EASY, they are clearly quite different. Both are readily recognisable in their own right. In the case of LEE as a surname or male forename and in so far as EASY is concerned, as a well know dictionary word meaning, inter alia, not difficult; simple. It is of course well established that it is the first element of a trade mark that is as a rule the most important for the purposes of comparison - see the comments in London Lubricants (1920) Limited's application - 42 (1925) RPC 264 and I shall bear this in mind when reaching my decision.

38. Assuming notional and fair use of the marks (as I must), I assume that the trade marks are to be used in connection with goods be they articles of clothing or leather goods which are destined for the mass market and which may be sold in any number of different ways. While the respective goods are clearly not in the category of goods mentioned in the LANCER trade mark case (1987) RPC 303, they would in my view still be bought with some care and attention. They are most likely to be purchased by self selection be it either in a retail outlet or perhaps from a publication in which a range of other traders goods are sold. But I do not discount that on occasion the goods may be purchased by telephone, or may be asked for in a retail outlet or indeed may be purchased on the basis of personal recommendation. However, I think that it is the self selection of the goods bearing the respective trade marks which is the manner of purchase likely to predominate.

39. In so far as any conceptual similarity between the trade marks is concerned, at the hearing Mr Hornby asked me to take judicial notice of the fact that the word EASYRIDERS conveys a particular connotation - that is in the context of motorcycling. Ms Carboni cautioned me against such an approach, commenting that in her view the word EASYRIDERS does not automatically convey the motorcycling connection unless one is a fan of the applicants' magazine or the film of the same name. Clearly for those members of the public aware of the film of the same name and/or the motorcycling connection, this would serve as a further distinguishing feature between the respective marks. That said, I agree with Ms Carboni that absent evidence of the public's reaction to the word EASYRIDERS, it would be improper for me to speculate. In the circumstances, I have not attributed (nor have I found it necessary to) any conceptual meaning to the word EASYRIDERS.

40. Taking all these factors into consideration, what then of the marks as totalities? In my view the marks are both visually and orally quite different. Given the nature of the respective goods and the manner in which these goods are likely to be purchased they do not resemble each other sufficiently to be likely to cause confusion in the minds of the public which will lead to confusion in the goods.

41. In summary, I have found that while the opponents' goods in Class 25 may be considered goods of the same description as some of the applicants' goods in Class 18, the respective marks are sufficiently different such that in use there is no likelihood of deception amongst any persons. The opposition under Section 12(1) of the Act therefore fails.

42. I go on to consider the opponents' objection under Section 11 of the Act, but do not consider a different finding from that above is possible in this case. Though the opponents have significant use of their trade marks in the United Kingdom the applicants trade mark is sufficiently different to that of the opponents such that if used in a normal fair manner in respect of any of the goods set out in the specification it would be unlikely to cause deception and confusion amongst any persons. The objection under Section 11 also fails.

43. The opponents having failed in these proceedings the applicants are entitled to a contribution towards their costs. This opposition is but one of three sets of proceedings between the parties which were heard on the same day. Both sides filed evidence in the various proceedings a good deal of which was common to all. In his skeleton argument Mr Hornby notes that the opponents chose to drop a number of the original grounds of objection

(namely the objections under Sections 9&10, 17(1) and 68 of the Act) adding that these were only notified to the applicants in a facsimile dated 7 June 2001. In view of this and in view of the comments in the Woolf reforms, Mr Hornby sought an award of costs outwith the official scale. In response Ms Carboni commented that while she did not defend the manner in which the case had been originally pleaded, she pointed out that the original pleadings were filed some six years ago prior to the Woolf reforms. She also noted that the applicants' counterstatement simply denied the various allegation and put the opponents to proof; an approach which would not be acceptable in the post Woolf era.

44. Having considered these submissions, I should say that I do not think that the evidence the applicants filed in these proceedings would have been significantly different absent the grounds which were dropped prior to the hearing. The restriction of the grounds also reduced the length of the hearing and allowed the advocates to focus on the real areas of dispute. In the circumstances of this case and given the date when these proceedings began, I do not think it is appropriate to attach any undue criticism to the manner in which the proceedings were conducted by either party. In the circumstances I do not propose to make an award of costs outwith the official scale. Accordingly I order the opponents to pay the applicants the sum of **£650** as a contribution towards their costs. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of the matter.

Dated this 13 day of November 2001

M KNIGHT
For the Registrar
he Comptroller-General