

TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION No 2041042  
by FINE FRAGRANCES & COSMETICS LIMITED  
TO REGISTER A TRADE MARK  
**RINA KETTY ESSENTIAL MUSK & DEVICE**  
IN CLASS 3

AND IN THE MATTER OF OPPOSITION THERETO  
UNDER NUMBER 44751  
BY HARBY'S CORPORATION NV

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BACKGROUND

15 On 7 October 1995, Fine Fragrances & Cosmetics Ltd of 6 Kingsway Business Park, Oldfield Road, Hampton, Middlesex, TW12 2 HD applied under the Trade Marks Act 1994 for registration of the trade mark **RINA KETTY ESSENTIAL MUSK and DEVICE** (reproduced below) in respect of the following goods in Class 3:

20 “Soaps, perfumes, toilet water, cosmetics, non-medicated toilet preparations; non-medicated preparations for the application to, conditioning and care of the skin, body and scalp; depilatory preparations; shampoos; anti-perspirants; bleaching preparations; non-medicated hair preparations; all emitting a fragrance of musk; all included in Class 3”

25 **RINA KETTY ESSENTIAL MUSK**



35 On the 13 June 1996 Harby's Corporation NV of De Ruyterkade 58A, Curacao, Netherlands Antilles filed notice of opposition to the application. The grounds of opposition are:

40 i) The opponent is the owner of a device trade mark which has been used in the UK since at least as early as 1973 in relation to cosmetics and perfumes. An identical representation of the device trade mark is included in the mark, the subject of the present application. The said opponent's trade mark has, by virtue of its use, become distinctive both to the trade and to the public as denoting exclusively the goods of the opponent. The applicant cannot, therefore, claim to be the proprietor of the mark, the subject of the present application, and  
45 registration thereof in the name of the applicant would be contrary to Section 32 of the Trade Marks Act 1994.

ii) The application offends under Section 3 of the aforesaid Act and, in particular, having regard to the preceding ground, the application offends under Sections 3(4) and 3(6).

5                   iii) The subject application offends under Section 5 of the aforesaid Act and specifically under Sections 5(2)(b) and 5(4) given that the opponent's aforesaid trade mark and business of which it is the badge would be protectable by virtue of the law of passing off and because there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark, given that the mark, the subject of the present application, is very similar to the opponent's trade mark both in terms of the mark and the goods involved. Indeed the device element contained in the subject application is identical with the opponent's earlier mark, meaning that Section 5(1) also applies.

10                   iv) The subject application offends under Section 5(3) of the Act in that the opponent's mark has a reputation in the UK and that the use of the applicant's mark would take unfair advantage of or be otherwise detrimental to the distinctive character or repute of the opponent's trade mark.

15                   v) Registration of the mark, the subject of the present application, would interfere with the trading activities and legitimate use by the opponent of its aforesaid trade mark which it is lawfully using.

20                   The applicants subsequently filed a counterstatement denying all of the grounds of opposition. Both sides ask for an award of costs.

25                   Both sides filed evidence in these proceedings and the matter came to be heard on 11 November 1999 when the applicants were represented by Mr Wyand, Queen's Counsel, instructed by Chancery Trade Marks, and the opponents by Mr Edenborough of Counsel, instructed by Haseltine Lake Trademarks.

30                   **OPPONENT'S EVIDENCE**

35                   This takes the form of two statutory declarations. The first of which is by Mr Albert Matzinger, dated 23 January 1997. Mr Matzinger is the Managing Director of Harby's Corporation NV. He states that Nicoletta Perris of C.E.D.I.P. of Monaco is exclusively licensed to use the opponent's gender symbols trade mark. A declaration by N Perris is attached as an exhibit to his declaration.

40                   The declaration of Nicoletta Perris is also entered as a separate declaration. It is dated 23 January 1997. Ms Perris is a director, a position she has held for 5 years, of C.E.D.I.P., a corporation organised and existing under the laws of the Principality of Monaco, where it is located and from where it conducts its business.

45                   Ms Perris states that her company has an exclusive trade mark licence in respect of the trade mark

gender symbols device from Harby's Corporation NV. The licence covers a number of countries including the UK. She states that the opponent became the proprietor of the mark by assignment from Houbigant Inc, New Jersey in 1992. Prior to this assignment Ms Perris states she was the marketing manager in two Italian companies distributing Houbigant's goods.

Ms Perris states that although the individual male and female symbols are well known, they are not used or known in a combined form. She claims that the decision to intertwine the symbols was taken, by Houbigant "to create an unusual and obliquely suggestive device to encourage potential purchasers to buy and use the product in order to increase their appeal to the opposite sex".. To demonstrate the development of the idea an extract from a report, prepared for Houbigant by Deal advertising agency, is attached at exhibit NP1. This report suggests marketing the product via mens hairdressers "not necessarily to sell the product as a mens cosmetic, but in a semi-suggestive way to promote the idea that men should buy Musk Oil as a present for their wives, girlfriends etc."

It is claimed that the first use of the mark by Houbigant was in the USA in 1970 and has been in continuous use since. The world wide annual turnover of goods bearing the mark is said to be approx. £60 million and consequently it is claimed that the trade mark is internationally recognised as that of the opponent. It is further claimed that the mark was first used in the UK in 1973 and has been in continuous use since "upon and in relation to toiletries with a musk scent, in particular toilet water, perfumes, soaps, bath / shower gels, body lotions and deodorants". Copies of product catalogues and promotional materials for the period 1974 - 1995 are provided at exhibit NP2. These show use of the company's various trade marks including the entwined symbols device.

Turnover figures for goods sold under the trade mark in the UK are provided at exhibit NP3 and are as follows:

YEAR	Units sold	Average price £	Turnover £
1985 /86	171,124	2.46	420,121
1986 /87	207,251	2.27	470,064
1987 /88	191,476	2.72	519,931
1988 /89	177,861	2.87	510,597
1989 /90	166,707	3.59	598,623
1990 /91	67,158	5.76	387,068
1991 /92	137,058	4.57	626,248
1992 /93	84,673	4.18	354,290
1993	N/A	N/A	N/A
1994	N/A	N/A	226,731

1995	104,650	3.50	366,681
1996	116,866	3.03	353,821

5 The absence of figures for the calendar years 1993 & 1994 is said to be due to the changing of distributor twice within this period. Although Ms Perris claims to provide promotional figures at NP6, the exhibit referred to is a jumble of sheets relating to a number of products with no clear coherent figures for each year being provided. These figures do not provide substance to the claim by Ms Perris that they “demonstrate substantial expenditure on a wide-ranging and vigorous promotion strategy for the goods bearing the trade mark”.

10 Ms Perris goes on to state that the goods sold under the trade mark have been advertised in the press and in magazines such as *She*, *Cosmopolitan*, *Woman’s World* & *Marie Claire*. Examples of these advertisements are provided ( at exhibit NP4) for the years 1986 - 1996. Only one of these exhibits is after the relevant date, and none relate to the period between 1990 and June 1995. These all show the device mark used in conjunction with the words “MUSK by ALYSSA ASHLEY”. Ms Perris points out that the quantity of direct advertising has been relatively small, and the opponent has also used sponsorship of sporting events and promotion at point of sale on a consistent basis. At exhibit NP5 examples of promotional materials are provided. These show the use of the gender symbols device initially, and from approx 1981 onwards the gender device takes a lower profile with the words “MUSK by ALYSSA ASHLEY” being more prominent.

15 A list of towns in which the product has been advertised and sold is provided and shows that the product has been available throughout the UK. It is stated that the goods have primarily been sold via multiple retail outlets such as Selfridges, Debenhams, John Lewis, Rackhams, Binns and Boots. A photograph which shows a display counter in the Oxford St., London branch of Boots in 1985 is supplied at NP7 and the device mark can be clearly seen.

20 Finally, Ms Perris states that the public request the opponent’s goods by reference to “the gender symbol perfume” alone or in combination with the words “Musk” and / or “Aylssa Ashley”. Although sales staff at the counter are there to assist Ms Perris believes that there would be a likelihood of confusion because of the “strong and immediately identifiable image produced by the trade mark is so striking”. The likelihood of confusion is compounded by the fact that the word “musk” also appears in close proximity to the opponent’s trade mark and is part of the trade mark in application 2041042.

#### 40 APPLICANT’S EVIDENCE

This consists of a statutory declaration by Mr Douglas Fawcett, dated 3 October 1997, who is the Chairman of Fine Fragrances & Cosmetics Ltd, a position he has held for twelve years.

45 Mr Fawcett casts doubt on the right of Ms Perris to give evidence. He calls into question whether C.E.D.I.P. have a licence and if so for what trade marks. Also, the question of the rights of the opponent in the mark are questioned. In both cases Mr Fawcett points out that no evidence of

licences or assignments were filed. Further, he questions the ability of Ms Perris to comment on usage of the mark prior to her joining C.E.D.I.P. in 1992. Especially as it involves the provision of sales and promotion figures from other companies and no mention is made of how such figures were obtained or any back up provided to substantiate such figures. Mr Fawcett questions whether Houbigant have used the mark continuously in the UK and reveals that a receiver was appointed to Houbigant Ltd on 29 April 1994.

Mr Fawcett points out that other manufacturers use the gender symbols for items of toiletries and provides copies of press articles showing the common use of the gender symbols and also examples of products from three other manufacturers which use the gender symbols either intertwined or in one instance overlapping to form a single circle. The gender symbols on these products would appear to be used to designate unisex products. Also provided are examples of the gender marks already on the Trade Marks Registry. He also questions Ms Perris' assertion that customers would ask for the opponent's product by reference to the gender symbols when the advertising supplied by the opponent shows the use of the symbols with the words "MUSK by ALYSSA ASHLEY". Mr Fawcett contends that the opponent's trade mark is phonetically and visually different to the trade mark applied for as customers would ask for the "Alyssa Ashley Musk" and not refer to the gender symbols.

Finally he comments unfavourably on the evidence of use provided which he claims relies on the provision of "a pair of photographs taken twelve years ago in Boots", he concludes "I would ask that the Registrar should draw his own conclusions from this woeful lack of evidence".

#### OPPONENT'S EVIDENCE IN REPLY

This consists of three statutory declarations. The first of which is again by Ms Perris, dated 7 April 1998. She confirms that a licence agreement was made between Harby's Corporation NV and C.E.D.I.P. dated 26 March 1993. Sections of the licence agreement are provided (at exhibit HC1) and show that the trade marks covered by the agreement are:

"Alyssa Ashley and Robert Ashley in any form, and any other names or trade marks, designs, symbols, logos, devices or insignia which have been heretofore developed and used or shall be developed and used at any time during the term of this agreement by the Proprietor or an affiliate of the Proprietor whether or not registered ....".

In the schedule of trade marks attached to the agreement there are forty-nine marks listed. The only entry relating to the UK is for "Alyssa Ashley".

A copy of the assignment from Houbigant Inc, dated 15 March 1993, is also provided (at exhibit HC2) and the wording regarding the trade marks and the schedule of marks is exactly the same as in the licence agreement referred to above. At paragraph 2B of the agreement it states:

"The assignor has agreed to assign all its rights, title and interest in the trade marks to the assignee together with the goodwill associated with its trade in the particular goods / services or classes of goods / services for which the trade marks have been used."

Ms Perris states that the information provided in her earlier statutory declaration was based on her knowledge of the marks from previously being involved with the distribution of the products prior to 1992 and also from enquiries made by her and reference to Company records.

5

The second statutory declaration is by Jane More O’Ferrall, dated 7 April 1998, who is a trade mark attorney and partner in Haseltine Lake Trademarks, where she has worked since 1986.

10

Ms O’Ferrall comments on the examples of gender symbol marks stated as being on the Register by Mr Fawcett. Three had lapsed prior to the relevant date, 7 October 1995, two have been revoked, and the remaining mark does not cover goods in Class 3 and is shown as being under opposition.

15

The third statutory declaration is by Ian Laird, dated 7 April 1998, who is the Managing Director of Incorporated Perfumery Distribution Ltd, a position he has held for four years.

20

Mr Laird states that his company is the UK distributor for the opponent’s products, and that he has been involved with the opponent’s brands for “about seventeen years” and has an extensive knowledge of those brands and the perfumery trade in general.

25

Mr Laird comments on the products supplied by the applicants as examples of other manufacturers using the gender symbols on their products. He firstly comments on the products of Keyline Brands Ltd which bear the name “Musk Royale and device”. Mr Laird states that he regards these as lookalike products which retail at approximately a quarter of the price of the opponent’s products. He states that he is not aware of how long this product has been on the market, but states that he has been unsuccessful in his attempts to ascertain where it is currently on sale. He claims that the product is not seen widely in the market. Mr Laird states that he considers Boots as the most important outlet for mass fragrances in the UK and the products of Keyline Brands Ltd are not stocked by Boots whereas the opponent’s products are sold widely through Boots outlets.

30

The other products are, claims Mr Laird, from the same source although marked up under different names ( United Toiletries & Cosmetics and Jean Yves Cosmetics). He claims that he has never seen the product known as “The Look For Me” on the market in the UK

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Mr Laird states that the products of the opponent have been on the market in the UK for “many years and there is considerable goodwill attached to them. I would also like to stress that, throughout the time I have been involved in distributing the opponent’s products, their pack has remained unaltered, and has presented a consistent image to the public. This has been a deliberate marketing strategy. Even the men’s line of products carries the combined gender symbol logo”.

40

Finally, he claims that “To my personal knowledge and belief, the intertwined gender symbol, in association with the word MUSK, is an integral, and important, part of the public’s recognition of the opponent’s products”.

45

I record here that Mr Laird voluntarily attended the hearing for cross examination on his evidence.

Under cross examination Mr Laird stated that the company was called “Houbigant” which had a sub brand “Alyssa Ashley”. He stated that:

5 “In the early days of the company all brands went under one family which was Houbigant. They later decided they would have two divisions and Houbigant would be reserved for fine fragrance brands and Alyssa Ashley would cover the market product. When that product was changed they took the Houbigant away and they put Alyssa Ashley on the brand.”

10 Mr Laird stated that he had been employed by the Houbigant company as a salesman until 1994 when the company went into receivership. He stated that:

15 “Another company called RA French Fragrance took over the distribution of the brands, and I was employed by that company, so I carried on selling them. That only lasted for about six months, and in September of that year IPD was opened, which is where I work now, and I still sell those products.”

20 Mr Laird confirmed that he was involved in preparing the turnover figures provided as exhibit NP3 by Ms Perris. He explained that some time after the closure of Houbigant, he had been contacted by the landlord of the premises that Houbigant had occupied. Mr Laird was offered access to remove any point of sale material and also any of the company records that were left. Mr Laird states that he took a number of books which were used by the marketing department and took from these the figures which said “Musk Actual Sales.” Mr Laird stated that:

25 “The one thing I did find was that there were some sort of contradictions in the figures. This is before the days of computers to a large extent, and there did seem to be some variants. You could take a couple of different numbers. As I said I was not a part of the Marketing Department, I just took the document for what it was and took the number off the page.”

30 Mr Laird confirmed that the figures provided did not, to the best of his knowledge, include sales of goods without the intertwined symbol on them.

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

#### 40 DECISION

Prior to the hearing the opponent withdrew the following grounds of opposition: “Sections 3 (unparticularised), 3(4) (in particular), 5(1), 5(2)(b), 5(3) & 32.”

45 Thus the only grounds of opposition left to be considered are 3(6) and 5(4)(a).

Firstly, I consider the ground of opposition under Section 3(6) which is as follows:

*“A trade mark shall not be registered if or to the extent that the application is made in bad faith.”*

5 The Act does not define the term bad faith, leaving it to the Tribunal or the Court to determine whether an application was made in bad faith based upon the circumstances of a particular case. The Notes on Sections, published by the Patent office, and based upon the Notes on Clauses provided to Parliament during the passage of the Trade Marks Bill in relation to Section 3(6) provides examples of where bad faith might be found, these are:

10 (i) where the applicant had no bona fide intention to use the mark, or intended to use it, but not for the whole range of goods and services listed in the application;

15 (ii) where the applicant was aware that someone else intends to use and /or register the mark, particularly where the applicant has a relationship, for example as employee or agent, with that other person, or where the applicant has copied a mark being used abroad with the intention of pre-empting the proprietor who intends to trade in the United Kingdom;

20 (iii) where the mark incorporates the name or image of a well-known person without his agreement. (This should not be taken as meaning that this provision is legislating for the protection of a personal name or reputation - these remain unprotected under English law, but the nexus between unregistrability and the name of a well-known person is that of bad faith in which the application is made.)

25 A claim that an application was made in bad faith implies some deliberate action by the applicants which they know to be wrong, or as put by Lindsay J. in the Gromex case [1999] RPC 367 at page 379:

30 “Includes some dealings which fall short of the standards of acceptable commercial behaviour.”

35 In my view there is an onus on the opponents when basing a ground of opposition under Section 3(6) on point (ii) above to demonstrate that the applicants are seeking to register a trade mark which it knows belongs to another. An allegation that the applicants should have been aware of the earlier trade mark, which the opponents consider similar to the applicants’ trade mark in suit, is not sufficient to sustain an objection to registration under this head. The applicants have denied the allegation. In the absence of any evidence that the applicants made their application in bad faith this ground of opposition is bound to fail. The onus is on the opponent under Section 3(6). That onus has not been discharged and this ground of opposition is therefore dismissed.

40 I now turn to the ground of opposition under Section 5(4)(a) which reads:

45 “5. (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 designs.*

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

In deciding whether the mark in question “RINA KETTY ESSENTIAL MUSK and DEVICE” offends against this section, I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the WILD CHILD case (1998 14 RPC 455). In that decision Mr Hobbs stated that:

*“The question raised by the Grounds of Opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the Applicant from those of other undertakings (see Section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Art.4(4)(b) of the Directive and Section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the Applicant in accordance with the law of passing off.*

*A helpful summary of the elements of an action for passing off can be found in Halsbury’s Laws of England 4th Edition Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in Reckitt & Colman Products Ltd - v - Borden Inc [1990] RPC 341 and Even Warnik BV - v - J. Townend & Sons (Hull) Ltd [1979] AC 731 is ( with footnotes omitted) as follows:*

*‘The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:*

*(1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;*

*(2) that there is a misrepresentation by the defendant ( whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and*

*(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.*

*The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House’s previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of “passing off”, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.’*

*“ Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:*

5            *To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:*

10           *(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and*

15           *(2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.*

20           *While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.*

25           *In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:*

- 30           *(a) the nature and extent of the reputation relied upon;*
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;*
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;*
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and*
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.*

35           *In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”*

40           The date at which the matter must be judged is not entirely clear from Section 5(4)(a) of the Act. This provision is clearly intended to implement Article 4(4)(b) of Directive 89/104/EEC. It is now well settled that it is appropriate to look to the wording of the Directive in order to settle matters of doubt arising from the wording of equivalent provisions of the Act. It is clear from Article 4(4)(b) that the earlier right had to have been “acquired prior to the date of application for registration of the subsequent trade mark, or the date of the priority claimed...”. The relevant date is therefore 7 October 1995, the date of the application.

45           With these considerations in mind I turn to assess the evidence filed on the behalf of the parties in the present proceedings as set out earlier in this decision. For ease of reference the trade marks of both parties are reproduced below:

Applicants' trade mark	Opponents' trade mark
<p data-bbox="79 380 119 414">5</p> <p data-bbox="79 571 119 604">10</p> <p data-bbox="79 761 119 795">15</p> <p data-bbox="79 952 119 985">20</p> <p data-bbox="255 526 798 571">RINA KETTY ESSENTIAL MUSK</p> 	<p data-bbox="1149 481 1316 817"> MUSK by  ALYSSA  ASHLEY </p> 

25

The opponents' mark shown above is the mark used by the opponent at the relevant date (7 October 1995). The opponents claim that this mark has been used since 1981. Prior to 1981 the words ALYSSA ASHLEY did not appear, but as this pre-dates the application by fourteen years it is virtually irrelevant.

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Clearly the goods of the two parties are identical or very similar. The goods upon which the opponents claim usage upon are contained within the applicants' specification.

35

The opponents' claim that the public would be confused as to the source of the applicants' goods believing them to come from them. The opponents state that they have a world wide annual turnover of approx. £60 million. The opponents also claim that their products are sold in retail outlets throughout the UK and that in the period 1985 - 1995 sales in the UK amounted to over £4 million. There is no evidence of the market share, nor are there any comprehensible promotional figures.

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There are doubts about the accuracy of the sales figures provided in Ms Perris's evidence. Mr Laird is the only possible source of figures prior to 1993. Ms Perris states that she previously distributed Houbigant's products for two Italian companies, but she does not state that she distributed goods in the UK. It is clear that the figures were prepared by Mr Laird, but the figures he provided were from records given to him but for which he was not directly responsible. He himself accepts that there were contradictions in the figures used to compile exhibit NP3. It seems

clear that there was use of the gender symbol in the UK, to Mr Laird's knowledge, back to 1981 at least. What is less certain is the extent of that use.

5 There is also some doubt regarding whether the goodwill in the UK business conducted by or on behalf of Houbigant was assigned to the opponents. The assignment document is not beyond doubt, but it seems likely that the goodwill was so assigned.

10 It is even less clear whether the sales in the UK can all be ascribed to the intertwined gender symbol (the indicium) solus. The opponents use of the mark in the period 1985 - 1995 was one of the matters that Mr Laird was cross examined about at the hearing. He maintained that the gender mark had been used on the product throughout the period. From the evidence provided by the opponents it is clear that the indicium was very prominent on the product when originally launched onto the market in the 1970's, but has in the intervening years been somewhat relegated with the words "Musk by Alyssa Ashley" now being more prominent, as shown in the example  
15 of the opponents mark above. There is little doubt that the opponents' indicium was used on the products, packaging and in publications which circulated within the UK before the relevant date. However the goodwill was unlikely to have subsisted in the indicium per se, but rather in the composite mark shown on page eleven above.

20 Even if I assume that the opponents owned a relevant goodwill at the date of the application, the marks of the two parties must also be compared to ascertain if misrepresentation would occur. The applicants' mark must be considered in the format sought to be registered. The opponents' mark has altered over the years from the indicium and the word "musk", to the mark "Musk by Alyssa Ashley and device" shown above which began in the 1980's.

25 Clearly both marks contain the word "musk" , but this would be regarded as descriptive as it refers to the use of musk oil to provide a particular fragrance. They also have the same intertwined gender symbols. They obviously differ in that the applicants' mark has the words "Rina Ketty Essential" whereas the opponents' mark has the word "by Alyssa Ashley". There is  
30 a small degree of similarity between the marks, but as Millett L.J. observed in *The European Ltd v The Economist Newspaper Ltd* (1998 FSR 283 at 288):

"A degree of similarity is tolerable: the question is whether there is a confusing similarity."

35 In my view it is possible for a highly distinctive sign to indicate common origin despite the presence of other distinguishing features. However, the male and female gender symbols are not highly distinctive, even when intertwined. Although there is no evidence from ordinary members of the public, it seems likely that the gender symbols would be taken as an indication that the cosmetics appealed to both males and females. In my opinion the public are more likely to  
40 rely upon names such as "Rina Ketty" and "Alyssa Ashley" to distinguish the trade source of the respective goods.

Taken as wholes, even though the goods are identical, I do not believe that members of the public would confuse the two trade marks, or believe that there was a connection between the two  
45 products. Neither do I believe that, at the relevant date, a Court would have regarded the gender mark solus to have been factually distinctive of the opponents goods to the relevant class of persons. If that is right, the applicants use of their trade mark would not have amounted to a

misrepresentation resulting in the passing off of its products as those of the opponent. On this footing the opposition under Section 5(4)(a) of the Act must fail.

5 The opposition having failed the applicants are entitled to a contribution towards their costs. I order the opponents to pay the applicants the sum of £1235

Dated this 7 day of February 2000

10

George W Salthouse  
For the Registrar  
15 The Comptroller General

20