

TRADE MARKS ACT 1938 (AS AMENDED)
AND TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 1476964
BY JOGINDER PAL KAINTH AND SOHANIAL KAINTH T/A S.K.
TRADERS & CO.
TO REGISTER A TRADE MARK
L'AVEC
IN CLASS 25

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 41658
BY CLAREMONT GARMENTS (HOLDINGS) PLC

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15 BACKGROUND

On 18 September 1991, Joginder Pal Kainth and Sohanial Kainth trading as S.K.Traders & Co., of 46 Lower Tower St, Birmingham, West Midlands, B19 3NH applied under the Trade Marks Act 1938 for registration of the trade mark L'AVEC in respect of:

20 "Articles of outer clothing, jackets, jogging suits, sweatshirts, overalls, flying suits, T-shirts, pilot shirts, jumpers, trousers; all included in Class 25. "

On 14 November 1994, Claremont Garments (Holdings) Plc, filed notice of opposition to the application. The grounds of opposition are in summary:

- 1) The trade mark in suit offends against Sections 9 and 10 of the Trade Marks Act 1938.
- 2) The trade mark in suit so nearly resembles the opponents' marks, and for similar goods that registration would offend against Section 12(1) & 12(2) of the Trade Marks Act 1938.
3. The trade mark in suit is liable to deceive or cause confusion and so offends against Section 11 of the Trade Marks Act 1938.
- 4) The trade mark in suit offends against Section 17 of the Trade Marks Act 1938.
- 5) Registration of the trade mark in suit would unfairly prejudice the opponents' business activities and would be damaging to their trading position in general.
- 6) the trade mark sought to be registered would offend against the provisions of Directive 89/104/EEC.
- 7) The trade mark does not meet the criteria as set out in Section 68 of the Trade Marks Act 1938, in that the mark consists of words which should be open to all persons in the clothing trade.

8) The opponent asks that the Registrar exercise his discretion in their favour.

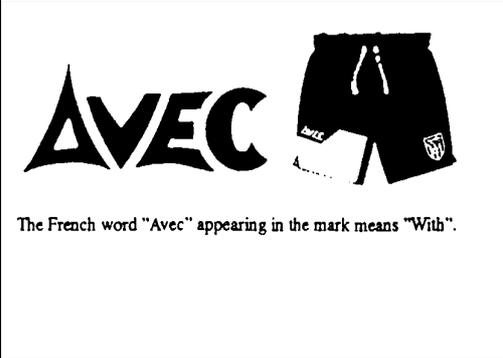
The applicants filed a counterstatement denying all the grounds of opposition, except that they accept that the marks maybe likely to lead to confusion with the opponents mark but claim that they have prior rights in the mark. The applicants also ask the Registrar to exercise his discretion in their favour and both sides seek an award of costs in their favour. Both sides filed evidence in these proceedings and the Opponents requested a hearing. A date for the hearing was set at 19 October 1999. The applicants indicated that they would not attend whilst the opponents representatives did not appear at the hearing, subsequently submitting a fax indicating that they would not be attending.

By the time this matter came to be decided 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 this decision are references to the provisions of the Trade Marks Act 1938 (as amended) unless otherwise indicated.

OPPONENTS' EVIDENCE

The opponents filed four statutory declarations. The first, dated 31 May 1996, is by Susan Dring the Company Secretary of the opponents. A position she has held since August 1992.

Ms Dring states that the opponents are the proprietors of two trade marks:

Mark	Number	Date Registered	Class	Goods
 <p>The French word "Avec" appearing in the mark means "With".</p>	1566435	22.3.94	18	Leather, imitations of leather; goods made of leather and of imitation leather; bags, handbags, suitcases, shoe bags, rucksacks, sports bags, cricket bags, umbrellas, walking sticks all included in Class 18
	1557072	Not yet registered. Filed on 21/12/93	25	Clothing, footwear and headgear.

Ms Dring states that Claremont Garments Limited is a wholly owned subsidiary of the opponents, and trades as Avec Sportswear. She claims that the name AVEC is not only a trade mark but also a trading name. She claims that first use of this mark in the UK was on clothing in Class 25 in January 1994.

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Ms Dring also claims that “Claremont make use of the mark AVEC by printing on garments, on garment labels and bags and in reference to garments in merchandise catalogues”. Exhibit SD1 shows Soccer strips, tracksuits, polo shirts sweat pants, drill tops and pants and jackets for sale by the Sunderland Football Club in their 1994 club brochure, with the name AVEC clearly visible.

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Ms Dring claims that the opponents have contracts with two other football clubs to supply football strips and replica strips and related goods. This she claims means that the AVEC trade mark “enjoys recognition by the thousands of spectators of soccer events either through attendance at events or through media coverage.” In addition to replica strips and related goods sold through retail outlets Ms Dring claims that the opponents also sell non club related sportswear bearing the AVEC mark. Exhibit SD2 shows the AVEC TRAINING RANGE logo which has the letters ATR in very large print with the words Avec training range in much smaller print set below.

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Ms Dring claims that “since January 1994, Claremont have had three official kit launches to both the media and retail trade”. This she claims has led to TV and press coverage, and at exhibit SD3 are three press releases from Sunderland AFC (dated July 93, February 94 & May 96), one press release from the opponents (undated but referring to a launch in April 1994), a press release by Sheffield United FC (dated Feb 95) and a photograph from the Northern Echo showing two members of Sunderland AFC management wearing AVEC tops and pants (undated).

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Ms Dring also refers to TV coverage of perimeter boards during coverage of matches in 1994, and also souvenir brochures and programmes. Examples are provided at exhibit SD4 which show photographs of players wearing football kit with the AVEC name clearly visible. Approximate turnover figures of £1 million - £2 million were provided in relation to each of the years 1994 and 1995 in relation to the AVEC mark.

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Ms Dring claims that the opponents have made considerable use of the mark AVEC, and that a large proportion of the population would have “come into contact with AVEC, either through attendance at football matches, through the media or by exposure to individuals wearing an AVEC sportswear garment. ”

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She also claims that:

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“It is in the public interest that Claremont be permitted to protect their valuable reputation and goodwill in the trade mark AVEC by obtaining trade mark registration. Registration of the mark is nevertheless hindered by the applicants mark L’AVEC applied for in respect of the goods of Class 25.”

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“The continued activities of Claremont under the mark AVEC would be unfairly prejudiced if S K Traders were to obtain registration of the mark L’AVEC. Furthermore having regard to the use and reputation in the AVEC mark by Claremont, use of the mark

L'AVEC by S K Traders in relation to the goods upon which Claremont are making use of their trade mark AVEC could deceive and cause confusion.”

5 The opponent filed three statutory declarations from individuals involved in retailing sports clothing. These are:

Mr Kenneth Lewis a sportswear buyer of First Sports Retail Outlets based in Tyne and Wear.

Mr Martin G Dixon a director of Dixon Sports based in Gateshead.

Mr Graham McDonnell the commercial manager of Sunderland AFC.

10 All three state that:

1) They are familiar with the activities of Claremont Garments, under the trade mark AVEC.

2) That because of the use made of the mark AVEC by Claremont Garments that goods bearing the AVEC trade mark would now be associated with goods of Claremont.

15 3) They know of no other company in the field of clothing or sportswear that use a mark identical to or similar to AVEC.

20 4) Should another company use the mark AVEC or similar in relation to clothing that deception and confusion would be inevitable.

APPLICANTS' EVIDENCE

25 This consists of two statutory declarations. The first, dated 24 October 1997, is by Mr Joginder Pal Kainth. He is one of the partners who trade as S.K. Traders & Co. and has been employed by the business since 1977.

30 Mr Kainth explains that:

“Sohaniel Kainth began trading about 23 years ago as S. K. Traders & Company manufacturing corporate / promotional clothing such as casual jackets, body warmers, leisure suits, T-shirts, sweaters and bags and also providing design embroidery and printing services. Joginder Pal Kainth joined the business about some 3 years later. “

35 Mr Kainth states that the trade mark L'AVEC was first used in the UK in December 1987 on the following goods: “ Articles of outer clothing, jackets, jogging suits, sweatshirts, overalls, flying suits, T-shirts, pilot shirts, jumpers, trousers”.

40 At exhibit JK1 a brochure is provided (undated)which shows the mark L'AVEC being used as a trading name. Mr Kainth states that the brochure has been used in the same format since 1987. At exhibit JK2 are copies of headed stationery, a business card and a clothing label are provided all of which have L'AVEC clearly marked on them. None are dated.

45 Exhibit JK3 consists of a number of invoices. These all have the name of the company (S.K.Traders & Co) at the top of the invoice. Underneath there is a device mark which looks like a swatch of fabric and the name L'AVEC. Underneath this are the words “promotional clothing”

in small print. The earliest invoice is date 1 December 1987 and is for the provision of waistcoats valued £2,474. Other invoices are supplied for subsequent years. Mr Kainth provides turnover figures for the applicants' business as follows; although he does not state explicitly that all the turnover was under the mark L'AVEC.

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Year	UK sales at Ex-factory prices
1987	434,000
1988	526,000
1989	450,000
1990	455,000
1991	263,000
1992	246,000
1993	220,000
1994	225,000
1995	280,000
1996	341,000
1997	455,000

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The company have advertised in the magazine "Promotions and Incentives". At exhibit JK4 a copy of the invoice for their advertisement is provided (dated March 1988), as is a copy of the magazine (although not the issue that the advertisement appeared in). An invoice for four further advertisements in this magazine is provided under the same exhibit and shows advertisements booked for July and September 1989, January and April 1990.

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Mr Kainth claims that his company has supplied goods to Grattan and at exhibit JK5 he provides a "merchandise specification form" dated 14 June 1989 which Grattan Plc sent to the company for completion. At exhibit JK6 are documents which show that the applicants had the L'AVEC design produced for them by a design and creative marketing company, Set Square, in March 1988. This was partly funded by The Design Council.

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The second statutory declaration, dated 28 October 1997, is by Nigel Edward Parker. Mr Parker is a trade mark attorney working for H.N & W.S Skerrett, trade mark agents to the applicants.

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Mr Parker provides a history of his clients attempts to register their various marks and the dealings with the Registry and the opponents. As exhibits he has filed copies of letters between the parties and also letters from the Registry.

That completes my review of the evidence.

DECISION

I first consider the grounds of opposition under Sections 9 & 10 which state:

5 9. -(1) *In order for a trade mark (other than a certification trade mark) to be registrable in Part A of the Register, it must contain or consist of at least one of the following essential particulars:*

10 (a) *the name of a company, individual, or firm, represented in a special or particular manner;*

 (b) *the signature of the applicant for registration or some predecessor in his business;*

 (c) *an invented word or invented words;*

15 (d) *a word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname;*

20 (e) *any other distinctive mark, but a name, signature, or word or words, other than such as fall within the descriptions in the foregoing paragraphs (a), (b), (c), and (d), shall not be registrable under the provisions of this paragraph except upon evidence of its distinctiveness.*

25 (2) *For the purposes of this section “distinctive” means adapted, in relation to the goods in respect of which a trade mark is registered or proposed to be registered, to distinguish goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection exists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.*

30 (3) *In determining whether a trade mark is adapted to distinguish as aforesaid the tribunal may have regard to the extent which -*

 (a) *the trade mark is inherently adapted to distinguish as aforesaid; and*

35 (b) *by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact adapted to distinguish as aforesaid.*

40 10. - (1) *In order for a trade mark to be registrable in Part B of the register it must be capable, in relation to the goods in respect of which it is registered or proposed to be registered, of distinguishing goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.*

45 (2) *In determining whether a trade mark is capable of distinguishing as aforesaid the tribunal may have regard to the extent to which -*

(a) the trade mark is inherently capable of distinguishing as aforesaid; and

(b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing as aforesaid.

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(3) A trade mark may be registered in Part B notwithstanding any registration in Part A in the name of the same proprietor of the same trade mark or any part or parts thereof.

10 As this application is for registration in Part A of the Register, the opposition under Section 10 is not relevant. No evidence has been filed to support this ground of opposition. The opposition under Section 9 therefore fails.

The next grounds of opposition are under Section 12(1) of the 1938 Act. This reads as follows:

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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:

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(a) the same goods,

(b) the same description of goods, or

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(c) services or a description of services which are associated with those goods or goods of that description.

30 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.

35 The opponents have stated that they are the proprietors of two identical trade marks. Number 1566435 registered as of 22 March 1994 for goods in Class 18 and 1557072 as yet unregistered but filed on 21 December 1993 for goods in Class 25. In their evidence the opponents claim that they first used the trade mark on clothing in the UK in January 1994.

40 The applicants application was filed on 18 September 1991 and they claim to have been using their mark in the UK since December 1987 on items of clothing. They have produced evidence to substantiate their claim to use since this date.

45 An objection under Section 12 (1) can be based only on a mark already on the register at the date of the application in suit. Clearly at the relevant date of 18 September 1991 the opponents did not have a trade mark registered or pending, nor had they used their mark on clothing in the UK. Therefore the opposition under Section 12 fails.

The next ground of opposition is under Section 11 of the 1938 Act. This reads 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.”

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Here again the critical date is the date of application for registration of the mark in suit. Section 11 comes into play if, at that date, 18 September 1991, Claremont Garments (Holdings) Ltd was using one of its then unregistered trade marks for the purposes of any of the goods specified in S.K.Traders & Co 's application. The opponents first use was by their own admission in 1994. I note that the opponents applications for registration are dated 21 December 1993 and 22 March 1994, both post-date the application in suit which was filed on 18 September 1991. Also the applicants first use of the mark was in December 1987 whereas the first use by the opponent of their mark is stated by them to have been in January 1994. In Welsh Lady [1964] RPC 459 at page 461 Wilberforce J. stated:

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“It seems to me, on the evidence, that this mark had been used for many years in connection with the proprietor's goods and that it had become distinctive of their goods, and it would be quite impossible to say that they would be disentitled to protection in respect of it in a court of justice. The applicants' use of a similar mark which, it appears, has caused the confusion is of more recent use, and it does not seem to me that a more recent use of that kind causing confusion would be a reason for disentitling the owners of the older mark to registration.”

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The opposition under Section 11 therefore fails.

The opponents have also claimed that the registration should be refused under Section 17 & Section 68 of the Act and also Directive 89/104/EEC . The opponents claim that the registration of the application in suit would prejudice both their business and use of their own mark in Class 25. However, in view of the applicants earlier use and application for registration it would clearly be inappropriate to exercise the Registrar's discretion under Section 17(2) against them. Thus there are no grounds for refusal. The opposition under Sections 17 and 68 therefore fail.

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The opposition having failed the applicants are entitled to a contribution towards their costs. I order the opponents, Claremont Garments (Holdings) Plc, to pay the applicants the sum of £935

Dated this 7 Day of February 2000

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George W Salthouse
For the Registrar
The Comptroller General

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