

O-072-06

**TRADE MARKS ACT 1994**

**IN THE MATTER OF  
APPLICATION NOS. 2313634A AND 2313634B  
IN THE NAME OF REMY'S LIMITED**

**AND**

**IN THE MATTER OF  
OPPOSITION NOS. 91896 AND 91897 THERETO BY  
DOUGLAS & GRAHAME LIMITED**

**IN THE MATTER OF  
APPLICATION NOS. 2313634A  
AND 2313634B IN THE NAME  
OF REMY'S LIMITED  
AND IN THE MATTER OF  
OPPOSITION NOS. 91896  
AND 91897 THERETO BY  
DOUGLAS & GRAHAME LIMITED**

**Background**

1. Application Nos. 2313634A and 2313634B have a filing date of 21 October 2002 and stand in the name of Remy's Limited. Details of the applications are as follows:

Application No.	Mark	Specification
2313634A	REMY'S	Articles of clothing, footwear and headgear.
2313634B Series of two		Articles of clothing, footwear and headgear.

2. On 15 August 2003 notices of opposition were filed by Ansons on behalf of Douglas & Grahame Limited. The grounds of opposition are based on the claim that registration of the trade marks would be in breach of sections 5(2)(b) and 5(3) of the Act because of the existence of the opponent's earlier trade marks and the reputation claimed in them. The opponent's claims are based on the following registrations:

Registration No.	Mark	Specification
1580900		Articles of outer clothing for men, youths and boys, but not including footwear
2047268		Articles of outer clothing for men, youths and boys, but not including footwear
2279907		Articles of outer clothing

260364 (CTM)	REMUS UOMO	Articles of outer clothing for men, youths and boys, but not including footwear
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3. The applicant filed counter-statements essentially denying the above grounds and putting the applicant to proof of its claims.

4. During the course of the proceedings the oppositions against the two applications were consolidated into a single set of proceedings. Both sides filed evidence. Neither party requested to be heard but the applicant filed written submissions. After a careful study of all the papers, I give my decision.

### **Opponent's evidence**

5. The opponent's evidence consists of three witness statements, all dated 19 May 2004. The first is from David Hooks. Mr Hooks is the Financial Director and Company Secretary of the opponent company, positions he has held since June 1999.

6. Mr Hooks says "the trade mark REMUS was adopted in January 1992 with REMUS UOMO adopted in December 1995 for use with "articles of clothing for men, youths and boys" and has been used since that date" on goods both within the UK and for export to other European countries both within and outside the European Community, to countries in Africa and Asia and to Canada, the USA and Russia. It is not clear from his statement which specific marks relied on he refers to.

7. Mr Hooks gives details of what he says is the "total turnover", at wholesale prices as follows:

1999	£8,521,500
2000	£9,176,950
2001	£9,076,200
2002	£9,699,990
2003	£9,854,600

8. Again, he does not specify to which particular trade marks these figures refer nor is the turnover apportioned between each mark. He does not say how much relates to sales within the UK. I also note that some of these figures relate to periods after the relevant date in these proceedings.

9. Mr Hooks says that during the period 1999 to 2003, some £842,370 was spent on "making the trade marks known". I cannot be sure what this means, i.e. whether this relates to advertising or other promotional expenditure and if so through which medium or where it took place, and again, no details are provided to apportion this expenditure to any individual trade mark relied upon.

10. At DH1, Mr Hooks exhibits what are said to be a selection of labels showing the way "the mark" has been used. The labels are photocopied, show a variety of different presentations and not all of the earlier marks as registered are shown. None bears any dates or other identifier.

11. Mr Hooks contends that the opponent has considerable goodwill in the trade marks through the use made of them. He says that “in the offices and warehouses of the opponent’s, the goods under the trade marks are simply referred to as REMUS which forms the major and distinctive part of our trade mark. This is also the situation in the trade, members of which buy our goods.”

12. The second witness statement is from Robert Bruce Spence Robertson, a registered trade mark attorney responsible for the conduct of these proceedings on behalf of the opponent.

13. Much of Mr Robertson’s witness statement is commentary and opinion and I do not intend to summarise it fully but will take it into account. He exhibits copies of extracts from The Phone Book for the London area for the years 1978, 1994, 1997 and 2001 and says that “the marks are similar in that both are uncommon surnames”.

14. Mr Robertson states the opponent has “spent the last ten-odd years building up goodwill in the mark REMUS”.

15. A third witness statement is from Beth McCabe who is the personal assistant to the Commercial Director of the opponent company. Again, I do not intend to summarise fully Ms McCabe’s witness statement as it is of no evidential value. She refers to being asked to search a small number of magazines looking for advertisements for menswear under the trade mark REMYS. She provides no information, for example, of the relevant magazines’ publication dates or their circulation. In any event, there is no explanation given of the relevance of this search. Ms McCabe also exhibits a print-out of a website search she carried out. The print-out shows the search to have been carried out on 18 May 2004, well after the relevant date in these proceedings.

### **Applicant’s evidence**

16. The applicant’s evidence also consists of three witness statements. The first is from Sailesh Devji Shah and is dated 25 November 2004.

17. Mr Shah is a Director and Chairman of Remy’s Limited, having been its director since its incorporation on 13 January 1984. He is authorised to make the statement on behalf of his company and the facts he deposes are known to him or taken from his company’s books and records to which he has full access.

18. Mr Shah explains how an unincorporated family business commenced in or about 1974 with the business name being registered on 24 November 1976. At SDS/1 he exhibits a copy of the certificate of registration of the business name as well as the certificate of incorporation of the company. From the commencement of the business, he says, a range of clothing has been continuously marketed by reference to the house mark REMYS with it accruing a substantial goodwill and reputation.

19. Mr Shah exhibits at SDS/2 copies of pages from catalogues listing exhibitors at exhibitions which took place at the NEC in Birmingham. I note that the catalogues are dated February 2003, February 2004 and August 2004. Mr Shah says that his company’s clothing is generally offered for sale to prospective customers either at

exhibitions or at shows with the REMYS house mark used as a badge of origin in relation to all clothes offered for sale. At SDS/3 he exhibits copies of a number of sample catalogues. The catalogues show them to date from 1996 through to 2004. Some also contain price lists and order forms and these bear representations of the marks in suit.

20. Mr Shah gives details of the approximate annual turnover in clothing sold under the mark REMYS in the UK for each of the years 1977 to 2004. Figures range from £242,586 in 1977, to £990,170 in 1982, (these figures relating to calendar years) and from £1,888,539 in 1987, £6,967,374 in 1992, £8,090,853 in 1997 to £6,658,647 in 2002 (these figures relating to financial years to April).

21. Mr Shah also gives details of the approximate amount spent on promoting clothing under the trade mark for the same periods, ranging from a low of £10,000 in 1977 increasing steadily to a high of £180,000 in 2001.

22. Mr Shah states that his company has exhibited its clothing sold under the trade mark REMYS at a number of exhibitions and other shows and gives details of thirty four exhibitions attended between August 1993 and August 2004 at the NEC and Olympia. All of these are after the relevant date.

23. Mr Shah contends that by virtue of the use made of the trade mark, it has acquired a considerable reputation and goodwill and is recognised as a badge of origin of clothing from his company.

24. Mr Shah concludes by providing his comparison of the respective trade marks and says that he is not aware that there have been any instances of confusion between them.

25. There is also a witness statement from Paul John Kelly dated 15 December 2004. Mr Kelly is a trade mark attorney working for the applicant's representatives in these proceedings.

26. Mr Kelly explains that a questionnaire was forwarded to independent traders involved in the clothing industry seeking to establish their knowledge of the trade mark REMYS. He indicates that 39 replies were received and exhibits a copy of each of those replies. To a second witness statement by Mr Kelly, dated 13 January 2005, are exhibited a complete list of the name of the companies or individuals to whom questionnaires were sent along with copies of three further replies received since his first witness statement was signed. There are approximately 200 names on the list and although Mr Kelly gives no explanation of how these names were chosen it appears that they are all customers of the applicant company.

## **Opponent's evidence in reply**

27. This comprises a further witness statement of Robert Bruce Spence Robertson and is dated 17 August 2005.

28. Mr Robertson states that the opponent admits both the existence of the applicant company and that it trades in ladies and gent's clothing. The opponent does not admit that the marks in suit have been used as trade marks.

29. Mr Robertson points out that the applicant has provided no samples of its goods and nor has it filed any labels to indicate how the relevant goods are sold or whether any packaging which might be used shows use of the trade marks in suit.

30. Commenting on the turnover figures provided by Mr Shah, Mr Robertson exhibits, at RBSR2, copies of the profit and loss accounts for the applicant taken from records kept at Companies House. From these, he says, it is clear that the turnover figures provided include amounts for goods sold under other trade marks or brand names. He goes on to say that the catalogues provided do not show use of the marks in suit as trade marks but merely as decoration on clothing.

31. Mr Robertson goes on to provide comments on the questionnaire forming the exhibits to Mr Kelly's witness statements and suggests that the questionnaire is flawed. Mr Robertson says that only one of the traders listed by Mr Kelly (and who did not respond to the questionnaire) are supplied goods by the opponent.

32. That completes my review of the evidence filed in these proceedings.

## **Decision**

33. The opposition is based on objections under sections 5(2)(b) and 5(3) of the Act. Section 5(2) states:

“5. -(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 association with the earlier trade mark.

(3) A trade mark which -

- (a) is identical with or similar to an earlier trade mark,

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.”

34. The opponent relies on four registrations to support their opposition. It is not disputed that all four are “earlier trade marks” within the meaning of Section 6 of the Act.

35. I remind myself of the guidance given by the European Court of Justice in the now well known cases of *Sabel BV v Puma AG, Rudolf Dassler Sport* [1998] RPC 199, *Canon v MGM* [1999] RPC 117 and *Lloyd Schuhfabrik Meyer & Co. v Klijsen Handel BV* [2000] FSR 77. It is clear from these cases that the likelihood of confusion must be appreciated globally, taking account of all relevant factors.

36. It has been noted that a lesser degree of similarity between the respective goods may be offset by a greater degree of similarity between the respective marks but that the goods must share some similarity in order to fall within the scope of section 5(2). There is also a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it.

37. There is no dispute that identical goods are involved. I therefore go on to consider the respective marks. For convenience I set out the respective marks below.

Applicant’s Marks	Opponent’s Marks
<p>2313634A</p> <p>REMYs</p>	<p>1580900</p> 
<p>2313634B</p> 	<p>2047268</p> 
	<p>2279907</p> 

	<p>260364 (CTM)</p> <p>REMUS UOMO</p>
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38. The opponent's evidence is somewhat sparse on facts but the opponent says it has been trading under the trade mark REMUS since January 1992. It does not specify which particular mark it refers to. All of the marks relied on by the opponent contain either the word REMUS or stylisations of it. The opponent also says that it adopted the REMUS UOMO mark, which could be any or all of three of the marks it relies on, in December 1995.

39. No figures are provided by either party to show the value of the UK clothing market, but on any estimation it is likely to be extremely large. The opponent says its total turnover under the marks stands at approximately £9m a year. Whilst a turnover of £9m is not insignificant in general terms, it is likely to be relatively small in terms of the clothing market as a whole. There are no figures given which apportion turnover to any of the individual earlier marks relied on nor how much of the turnover relates to sales in the UK, and there is no evidence of where, specifically, any sales have taken place. On the basis of the evidence as filed, I cannot say that any of the earlier marks relied on by the opponent has any enhanced distinctive character through the use made of it. That said, I am of the opinion that each of the earlier marks is, per se, of a relatively high distinctive character.

40. The applicant has provided evidence of use of the marks in suit. Use of a mark by an applicant which is honest and concurrent is not a defence which, of itself, will save an application but it is a relevant factor to be taken into account in the determination of whether there is a likelihood of confusion. The applicant's sales figures provided are also likely to be relatively small in relation to the clothing market as a whole.

41. The applicant says it has used the mark REMYS as a house mark since the family business began in the mid 1970s. The opponent submits that the applicant trades only under other trade marks and uses the marks in suit merely as decoration on the clothing it sells. Whilst the evidence filed by the applicant does show use of other marks, it also shows clear use of the marks in suit (see e.g. Autumn/Winter catalogue 1996 in relation to 2313634A and the Spring/Summer catalogue 1998 in relation to 2313634B, both at exhibit SDS3) and supports the applicant's claim to have used the marks as house marks. The applicant has provided turnover and advertising figures relating to use of the marks for a period of some 25 years. Whilst I have no doubt that the applicant has traded under its marks and it has provided evidence to show it exhibits at various locations, no evidence is provided to show how, where or to whom any sales have taken place.

42. The applicant has submitted evidence to support its claim that it "generally" sells its goods at trade fairs rather than direct to the end user. The opponent's evidence

states it too sells to the trade. This is supported by exhibit SDS2 which although referring to trade exhibitions held at the NEC in Birmingham in 2003 and 2004, and therefore after the relevant date, does lend support to each party's claim. But the evidence does not indicate that "the trade" is the only customer and I have to consider the specification of goods as applied for or registered which are not limited in any way.

43. The applicant has filed a number of questionnaires said to have been forwarded to independent traders. The opponent criticises this evidence. For my part, there is no evidence of how these traders were chosen, nor how the questionnaires were forwarded to them, i.e. whether they were sent under cover of a letter and if so who sent it or what information that letter contained. I have no evidence of how the specific questions were chosen. The questionnaires are not all complete and responses, some of which are not clear, do not establish what the position might have been at the relevant date. In short, I can give this particular evidence little weight.

44. Both of the applicant's marks are the word REMYS. In the case of 2313634A, the mark is presented in plain block capitals. In the case of 2313634B, the letters are also in block capitals but with the middle letter "M" in a larger font and therefore standing slightly taller than the letters either side of it. There is also underlining extending horizontally away from each of the uprights of the letter "M". The added stylisation present in trade mark No. 2313634B does not detract from the mark being clearly seen as REMYS.

45. In its evidence and submissions, the opponent refers to the marks relied on as REMUS trade marks, although some clearly contain other elements and others are subject to stylisation. I shall consider first, the opponent's earlier mark No.1580900. This mark consists of the letters R and E, the letters being joined with the "tail" of the R running into the base of the E. These letters stand apart from the rest of the mark which appears to consist of the letters M, U and S somewhat "concertina-ed" with the U being merged into the letters M and S either side of it. Although the stylisation is somewhat unusual and would not be overlooked, I believe the mark would clearly be seen as REMUS. The respective marks both begin with the letters RE, have the middle letter M and end in the letter S. They are of similar length. Although there are some visual differences, the respective marks also have significant visual similarities.

46. Mr Robertson exhibits extracts from various editions of the London Phone Book, showing REMY to be an uncommon surname and suggests that REMYS could be seen as the possessive form of that name. That is one possible interpretation although I am aware that Remy is also a French forename e.g. as in the name of the French rugby player or the cognac, Remy Martin. The word, presented as it is with no apostrophe, may be considered to be the plural version of the name. However, given that the name REMY is uncommon, and the mark in suit is not REMY but REMYS, it may be that it would be more likely to be seen as an invented word with no particular meaning or derivation. As for the opponent's mark, the same evidence shows REMUS to be an equally uncommon surname. I believe it to be much better known as the name, either of a character from Roman mythology or the eponymous uncle, the subject of the storybooks of Joel Chandler Harris. I come to the view that the marks are conceptually different.

47. The applicant submits that the marks in suit is pronounced “rem-ys”. As this submission was made on paper rather than orally, I’m unsure whether this is intended to mean it is pronounced “rem-ees” or “rem-iss”. Whatever the applicant meant, the mark could equally, I believe, be pronounced “re-mees” or “re-miss”. I have already indicated that despite the elision of the letters making up the latter part of the opponent’s earlier mark, it would, I believe be recognised as a stylisation of the relatively well known word REMUS and thus would be pronounced “re-mus”. Given the shortness of the respective marks and the fact that they share four of their five letters, those letters appearing in the same position in each case, and, given that in everyday speech there is an increasing tendency to poor enunciation leading to the slurring of words, I consider that any potential differences are likely to be lost. The respective marks are aurally similar.

48. I bear in mind the average customer does not normally analyse the detail of a trade mark and rarely has the chance to make a direct comparison but must rely instead on the imperfect picture he has kept in his mind. I also bear in mind the well established principle that in respect of clothing, the use of a trade mark is primarily visual, see *React Trade Mark* [2000] RPC 285. On a global appreciation, it seems to me that whilst there are some differences in the respective trade marks, there are also significant similarities and the similarities outweigh the differences especially as identical goods are involved. I consider there is a likelihood of confusion in respect of the opponent’s earlier mark No. 1580900.

49. Given my findings above it is not strictly necessary for me to consider the other earlier marks relied on by the opponent however, in case I am found to be wrong, and for the benefit of any appellate tribunal, I go on to consider briefly the objection based on the opponent’s Community Trade Mark No. 260364. The mark is for the words REMUS UOMO in plain block capitals. For those, like myself, with some knowledge of Italian, the word UOMO would be recognised as meaning “man” and therefore non-distinctive for the goods as registered. Given, however, that the average British person is notorious for his poor grasp of foreign languages, to those without such knowledge the word is likely to be meaningless. I have already found that REMUS is a relatively well know name and, whilst I do not think the presence of the word UOMO in the mark as a whole would be overlooked, it would either be seen as non-distinctive for the goods in suit, or would not be easily be recognised or pronounced for those without specific knowledge of Italian. The earlier trade mark, when considered as a whole, is visually and aurally similar to the marks in suit. I consider there to be a likelihood of confusion between the respective marks.

50. Trade Mark No. 2047268 is for what is said to be a series of two marks. The first consists of the word REMUS, stylised as it appears in Trade Mark No.1580900 but with the word placed above the word UOMO which is of equal width and appears in smaller plain block capitals, the whole being in white on a black rectangular background. The second mark is for the word REMUS, this time unstylised, with each of the letters being individual letters and again appearing above the word UOMO, but with the letters of this latter word separated by clear spaces which leads to it extending further to the right than the word above it. The respective marks have similarities and, for the same reasons as explained above, I consider there to be a likelihood of confusion between the respective marks.

51. The final earlier mark relied on by the opponent is No.2279907. This is for a series of four marks. Each contains the word REMUS with a degree of stylisation in that the middle letters “M” and “U” are elided with the letters R, E and S being separate. Each of the marks also contains the word UOMO placed under the word REMUS in smaller font and extending from the centre of the M to the furthest point of the letter S. Each of the marks in the series also contains an “O” device in a noticeably larger and bolder font, with each of the devices containing the numeral “2”. The “O” device has a fairly high degree of visual dominance although the presence of the word REMUS would not be overlooked. Again, the respective marks have a degree of similarity and I consider there to be a likelihood of confusion between them.

52. Having found the similarities between the respective marks to outweigh the differences, albeit to differing degrees in terms of each of the opponent’s earlier marks and having found there to be a likelihood of confusion, the oppositions under section 5(2)(b) against both applications, Nos. 2313634A and 2313634B, succeed.

53. The opponent also opposes the applications for registration by its reliance on the provisions of section 5(3) of the Act. Again, given my findings above, it is not strictly necessary for me to consider this ground, however, in case I am found to be wrong in relation to the objection under section 5(2), I go on briefly to consider the objection under section 5(3) which states:

“5.-(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark,

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.”

54. In my consideration of the objection under section 5(2), I made various criticisms of the evidence filed by the opponent. The evidence as filed does not enable me to apportion any reputation to any individual earlier mark relied on. The objection raised under section 5(3) falls at the first hurdle.

55. As a result of my decision, the oppositions against application Nos. 2313634A and 2313634B succeed.

**Costs**

56. The opposition having succeeded, the opponent is entitled to an award of costs in its favour. The two sets of proceedings were consolidated at a relatively early stage, the notices of opposition and defence were identical and the evidence filed by either party, where it was of any evidential value, was not extensive. The decision was made without recourse to a hearing. I order the applicant to pay the opponent the sum of £1,500. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of these cases if any appeal against this decision is unsuccessful.

**Dated this 15<sup>th</sup> day of March 2006**

**ANN CORBETT  
For the Registrar  
The Comptroller-General**