

O-098-06

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No.2366810
BY SCHOLL LIMITED
TO REGISTER THE TRADE MARK
CHIC FEET
IN CLASSES 3, 5, 8, & 10**

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NUMBER 92979
BY LIDL STIFTUNG & CO KG**

BACKGROUND

1) On 26 June 2004, Scholl Limited of 35 New Bridge Street, London, EC4V 6BW applied under the Trade Marks Act 1994 for registration of the trade mark CHIC FEET in respect of:

In Class 3: Preparations for the care of the skin and the feet; deodorants, anti-perspirants for use on the person; talcum powder; perfumery, fragrances; cosmetics; essential oils; cosmetic creams; powders, lotions, milks, gels, oils and ointments for the care and cleansing of the feet.

In Class 5: Sanitary preparations for the feet; pharmaceutical creams, powders, lotions, milks, gels, oils and ointments for the care and cleansing of the feet; plasters, materials for dressings; medicated pads, and medicated heel grips; disinfectants.

In Class 8: Hand operated household tools and implements all for manicure or pedicure; nail clippers, nail files, scissors; tweezers; parts and fittings for all the aforesaid goods.

In Class 10: Orthopaedic, orthotic, chiropody, foot care, apparatus and instruments; instruments and equipment for hygiene, orthopaedics and for the treatment and care of the feet and skin; cushions for care of the feet; aids for the correction of the feet including supports for the arch of the foot; apparatus for the separation and the straightening of the toes; protective means against the hardening of areas of skin calluses and inflammation of the toes; cushions for the heels, under-heels; protection for metatarsal cushions; boot inserts, foot rings and foot supports; shoe insoles, orthopaedic insoles, disposable insoles, deodorized insoles for orthopaedic footwear; compression hosiery; graduated compression hosiery; medical support hosiery; stockings for varicose veins; elastic bandages for joints, elastic gaiters, elastic knee-joints, elastic bandages, bandages for the waist, bandages for orthopaedic purposes; foot massagers.

2) On 22 November 2004 Lidl Stiftung & Co KG of Stifstbergstrasse 1, D-74167 Neckarsulm, Germany filed notice of opposition to the application. The grounds of opposition are in summary:

a) The opponent is the proprietor of the following mark:

Mark	Number	Effective Date	Class	Specification
 <p>Registration of this mark shall give no right to the exclusive use of the word "Chic".</p>	2067627	03.04.96	3	Soaps; toilet soaps; perfumery; essential oils; cosmetics; hair lotions; dentifrices.

b) The mark in suit is similar to the opponent's trade mark, and the goods applied for are identical or similar. The opponent has made use of the mark in the UK in respect of toiletries such as haircare products and anti-perspirants. The mark applied for therefore offends against Section 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994.

3) The applicant subsequently filed a counterstatement denying the opponent's claims.

4) Only the opponent filed evidence in these proceedings. Both sides ask for an award of costs. The matter came to be heard on 16 February 2006 when the applicant was represented by Miss Brindle of Messrs Wilson Gunn. The opponent was represented by Miss Simpson of Messrs Urquhart Dykes & Lord.

OPPONENT'S EVIDENCE

5) The opponent filed a witness statement, dated 12 September 2005, by Peter Fischer the Managing Director of Lidl Stiftung & Co Beteiligungs-GmbH which is a general partner in the opponent company. He states that his company owns and operates a chain of more than 330 grocery stores in the UK. He states that his company has used the mark CHIC and device in the UK in relation to toiletries such as hair care products, particularly hair styling mousse, hair spray, hair lacquer and anti-perspirants since 1 December 1994.

6) Mr Fischer provides the following sales figures for sales under the CHIC and device mark:

Year	Sales £
1996	83,825
1997	23,522
1998	240,831
1999	267,946
2000	393,751
2001	390,173
2002	491,469
2003	581,848
2004	364,743

7) Mr Fischer states that his company spends approximately 20,000 Euros per annum on advertising and otherwise promoting the goods sold under the Chic and device mark. I note that neither the turnover figures nor the promotional figures are specifically stated to relate to the UK although this is clearly the inference. At exhibit PF1 he provides examples of the type of advertising used, all of which are dated May 2004. The leaflets show, amongst other goods, an image of the actual product and the trade mark. It is stated that the leaflets are distributed throughout the UK. The only use shown of the opponent's trade mark 2067627 is on hair spray (lacquer) and styling mousse.

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

DECISION

9) At the hearing the opponent withdrew the grounds of opposition under sections 5(2)(b) and 5(3). Therefore, the only ground of opposition to be determined is under section 5(4)(a) which reads:

“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

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.”

10) In deciding whether the mark in question “CHIC FEET” 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] 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 purpose 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 Article 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] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] A.C. 731 is 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:

'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:

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

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.

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

- (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.

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.”

11) 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. The relevant date may therefore be either the date of the application for the mark in suit (although not later), or the date at which the acts first complained of commenced – as per the comments in *Cadbury Schweppes Pty Limited v. The Pub Squash Co Pty Ltd* [1981] RPC 429. The applicant does not claim to have used their mark and so the relevant date is the application date of 26 June 2004.

12) With these considerations in mind I turn to assess the evidence filed on behalf of the opponent in the present proceedings as set out earlier in this decision.

13) To succeed under this ground the opponent must show that it enjoyed goodwill at the relevant date. The opponent claims to have used the mark in the UK since 1994. However, whilst sales and promotion figures are provided it does not categorically state that they relate solely to the UK. The opponent has provided copies of newsletters or leaflets that are stated to be distributed throughout the UK. At the hearing the opponent’s representative contended that the inference that the figures for turnover and promotion related to the UK was clear. I do not accept this contention. The opponent should file clear unequivocal evidence. In the instant case I accept that the newsletters show use of the mark in the UK prior to the relevant date and I therefore accept that the opponent had goodwill in the UK in relation to the goods shown in the newsletter which were branded with the mark relied upon. Although use on anti-perspirants and haircare products in general has been claimed this use has not been corroborated. On the basis of the evidence provided the opponent, whilst it has just managed to show goodwill, cannot be regarded to have a reputation in its mark.

14) The opponent has opposed the whole of the applicant’s specification. The opponent stated, in the statement of grounds, that its mark had been used “in respect of toiletries such as haircare products and antiperspirants”. However, the only use shown is on styling mousse and hair-spray. I shall therefore be comparing the specification of the mark in suit to the opponent’s revised specification of “Styling Mousse and hair-spray”.

15) The opponent is opposing the whole of the applicant’s specification which includes goods in Classes 3, 5, 8 and 10. Clearly, the applicant’s goods in Classes 8 and 10 are far removed from the two hair care products of the opponent. The applicant’s goods in these classes are almost exclusively for use on the foot, not the head. When considering if there is misrepresentation I shall be regarding these goods as dissimilar. Similarly, the applicant’s goods in Class 5 are also aimed primarily at the feet. It could be contended that they are beautifying products for use on the body and so share some of the same characteristics as the opponent’s hair care products and it is on this somewhat tenuous basis that I will include the Class 5 goods in my considerations as being vaguely similar. Even some of the applicant’s Class 3 goods, such as powders, lotions, milks, gels, oils and ointments for the care and cleansing of

the feet, are quite different to the opponent's goods. Clearly, the opponent's strongest case is in relation to "Preparations for the care of the skin and the feet; deodorants, anti-perspirants for use on the person; talcum powder; perfumery, fragrances; cosmetics; essential oils; cosmetic creams". These are similar to the opponent's products.

16) It is well established that in the law of passing off there is no limitation in respect of the parties fields of activity. Nevertheless the proximity of an applicant's field of activity to that of the opponent's is highly relevant as to whether the acts complained of amount to a misrepresentation.

17) I therefore turn to consider the marks of both parties. For ease of reference the marks of both parties are reproduced below:

Opponent's mark	Applicant's mark
	<p data-bbox="804 808 979 842">CHIC FEET</p>

18) The opponent contends that the dominant component of its mark is the word "Chic" and that this is identical to the first word of the applicant's mark. This they claim will, when used in a normal and fair manner result in misrepresentation. However, this overlooks the fact that the word element of the opponent's mark is shown in a very unusual fashion. The first, third and fourth letters are in a normal lowercase font. However, the second letter appears to be a capital letter "H" with the majority of the second up stroke missing. The lower half of the letter is also considerably obscured by the device element. At first blush the word is not obviously "chic" it requires a small amount of reasoning to work out the word. The applicant's mark also has the second word "feet" which doubles the length of the mark. The opponent's mark has a device element which includes within it the words "Patet Omnibus Qualitas". However, these are so small that I doubt many consumers would even notice them, and even if their attention were drawn to the words they would be regarded as being typical of the usual Latin phrases used in heraldic devices which few, if any, understand. I do not regard the device or the wording contained within it as significant.

19) Therefore, whilst there are similarities both visually and aurally there are also significant differences. Conceptually, the opponent's mark merely implies that the consumer can have stylish hair if they use the opponent's products, a common concept perpetrated by other manufacturers of hair care products. The applicant's mark conjures up an all together different and unusual image of having stylish feet. Although not unheard of it is, in my view, a slightly unusual image. One might more readily refer to stylish or chic footwear instead of feet.

20) I have to consider the matter from the point of view of the average consumer. The opponent contended that this should be regarded as one of their customers who was aware of the opponent's products. In essence the question I have to address is whether

the relevant public seeing the applicant's mark used on similar or identical products in Class 3 would be likely to believe the goods were being offered by the opponent. It is my view that the differences between the marks is such that such a misrepresentation would not occur. If misrepresentation would not occur on the goods in Class 3 which provides the opponent with its strongest case then clearly there is no likelihood of misrepresentation occurring when the goods are dissimilar. Therefore the opposition under Section 5(4)(a) fails in relation to all of the goods of the applicant's specification.

COSTS

21) As the applicant was successful it is entitled to a contribution towards its costs. I order the opponent to pay the applicant the sum of £1,500. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 10th day of April 2006

**George W Salthouse
For the Registrar,
the Comptroller-General**