

O-102-05

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2232368
BY WESTPOINT STEVENS INC
TO REGISTER THE TRADE MARK:**

MARTEX LUXOR

IN CLASSES 24 AND 27

AND

**THE OPPOSITION THERETO
UNDER NO 92024
BY READMANS LIMITED**

BASED UPON THE EARLIER TRADE MARK:



Trade Marks Act 1994

**In the matter of application no 2232368
by Westpoint Stevens Inc
to register the trade mark:
MARTEX LUXOR
in classes 24 and 27
and the opposition thereto
under no 92024
by Readmans Limited**

BACKGROUND

1) On 12 May 2000 Westpoint Stevens Inc, which I will refer to as Westpoint, applied to register the trade mark **MARTEX LUXOR** (the trade mark). The application was published for opposition purposes in the "Trade Marks Journal" on 11 July 2003 with the following specification:

towels; towelling wash cloths, all being made of cotton or all of cotton with a synthetic yarn decoration; fabric covers for toilet tanks, toilet tank tops and toilet lids; bed covers, bed sheets, bed spreads, pillow cases, pillow shams, bed blankets; dust ruffles (not being parts of clothing); comforters (quilts); table covers, table napkins, all made of textile materials; household linen;

bath rugs, bath mats.

The above goods are in classes 24 and 27 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) On 30 September 2003 Readmans Limited, which I will refer to as Readmans, filed a notice of opposition. Readmans is the owner of United Kingdom registration no 2203017 of the trade mark:



The trade mark is registered for the following goods:

household textile articles; bed linen, bed covers, bed sheets, bed blankets, pillow cases, duvets and duvet covers; valances and towels; all consisting wholly or principally of Egyptian textiles.

The above goods are in class 24 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended. Readmans claims that the respective class 24 goods are identical and that the goods of the application in class 27 are similar to the goods of its trade mark. It claims that the respective trade marks are similar. Consequently, there is a likelihood of confusion and registration of the trade mark would be contrary to section 5(2)(b) of the Trade Marks Act 1994 (the Act).

3) Readmans claims that it has made considerable use of its trade mark and has a considerable reputation and goodwill in relation to it in the United Kingdom. It states that the trade mark has been used since 1999 upon the goods of its registration. Consequently, Readmans claims that its trade mark is protectable by means of a passing-off action and so registration of the trade mark would be contrary to section 5(4)(a) of the Act.

4) Readmans states that Westpoint previously opposed the registration of its trade mark no 2203017, the opposition was dismissed.

5) Readmans seeks the refusal of the application in its entirety and an award of costs.

6) Westpoint filed a counterstatement in which it denies the grounds of opposition. It admits that it opposed Readmans' trade mark application and that the opposition was unsuccessful. However, it states that this is irrelevant.

7) Westpoint seeks the registration of the trade mark and requests an award of costs.

8) Both sides filed evidence.

9) Both sides were advised that it was believed that a decision could be made without recourse to a hearing. However, the sides were advised that they retained their rights to a hearing. Neither side requested a hearing. Westpoint filed written submissions.

EVIDENCE

Evidence of Readmans

10) This consists of two witness statements by Garry William Anthony Johnston. Mr Johnston is the trade mark attorney of Readmans. Most of his witness statements represent submission and comment rather than evidence of fact. I will only comment on the evidence of fact but bear in mind Mr Johnston's submissions in reaching my decision.

11) Mr Johnston states that Readmans' trade mark was first used in 1999 for towels, bath sheets, beach towels and face cloths. He exhibits a kitchen towel which displays Readmans' trade mark in the colour gold on a swing ticket and on a label sewn onto the towel. Mr Johnston states that LUXOR branded goods have been sold throughout the United Kingdom. He states that the turnover since 2001 is estimated to be in the region

of £200,000. Also exhibited is a copy of the decision in relation to the opposition between the two sides referred to in the statement of grounds. The sign upon which Westpoint relied in the opposition was LUXOR.

Evidence of Westpoint

12) This consists of a witness statement by Victoria Walls. Ms Walls is an associate solicitor at Baker & McKenzie. Most of Ms Walls' statement is submission rather than evidence of fact. Again I will only comment on the evidence of fact but bear in mind Ms Walls' submissions in reaching my decision.

13) Ms Walls states that in the earlier opposition proceedings Readmans at no time referred to use of its trade mark in the United Kingdom. She exhibits a copy of the counterstatement filed by Readmans in relation to the opposition to which reference has already been made. She points out in particular paragraph 7 of the counterstatement:

“The applicant denies that any future use of the Mark **LUXOR & Device** the subject of the above application is likely to cause confusion and that Registration would be contrary to section 5(4)(a) of the Trade Marks Act 1994 as its use in the United Kingdom is not liable to be prevented under Section 56 of the Trade Marks Act 1994 as stated in Paragraph 7 to the Statement of Grounds of Opposition.”

Ms Walls refers to the above paragraph as it refers to “future use”, not current or previous use.

DECISION

Likelihood of confusion – section 5(2)(b) of the Act

14) According to section 5(2)(b) of the Act a trade mark shall not be registered if because:

“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.”

Section 6(1)(a) of the Act defines an earlier trade mark as:

“a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks”

Readmans' trade mark is an earlier trade mark as defined in the Act.

15) In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117 and *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77 and *Marca Mode CV v Adidas AG and Adidas Benelux BV* [2000] ETMR 723.

Comparison of goods

16) Westpoint has said little about the identity/similarity of the respective goods. There seems to have been a tacit acceptance of their identity/similarity. However, in order to avoid any question over this matter I will make a comparison of the goods. The goods of the application are:

towels; towelling wash cloths, all being made of cotton or all of cotton with a synthetic yarn decoration; fabric covers for toilet tanks, toilet tank tops and toilet lids; bed covers, bed sheets, bed spreads, pillow cases, pillow shams, bed blankets; dust ruffles (not being parts of clothing); comforters (quilts); table covers, table napkins, all made of textile materials; household linen; (the class 24 goods)

bath rugs, bath mats. (the class 27 goods).

The goods of Readmans' registration are:

household textile articles; bed linen, bed covers, bed sheets, bed blankets, pillow cases, duvets and duvet covers; valances and towels; all consisting wholly or principally of Egyptian textiles.

The goods of the earlier registration, owing to the very general term *household textile articles* could include all the class 24 goods of the application. The class 24 goods of the application do not, obviously, have to be made of Egyptian textiles. However, they could be. In *Galileo International Technology LLC v Galileo Brand Architecture Limited* BL 0/269/04 Professor Annand, sitting as the appointed person, stated:

“16. I believe that overlapping specifications satisfy the test for identical goods or services in section 5(1) of the TMA. There is no necessity for such specifications to co-extend.”

In this case there is an overlap. Consequently, I consider that the class 24 goods of the application are identical to the goods of the earlier registration.

17) In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J considered that the following should be taken into account when assessing the similarity of goods and/or services:

- “(a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;

- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

18) In *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* the European Court of Justice held in relation to the assessment of the similarity of goods that the following factors, inter alia, should be taken into account: their nature, their intended purpose (the original incorrect translation of ‘Verwendungszweck’ in the English version of the judgment has now been corrected) and their method of use and whether they are in competition with each other or are complementary.

19) I take on board the class in which the goods are placed is relevant in determining the nature of the goods (see *Altecnic Ltd's Trade Mark Application* [2002] RPC 34). Goods in one class cannot be identical to those in another, although they may be similar to a high degree.

20) *Bath rugs* and *bath mats* could be of textile material, as the goods of the earlier registration are. They are likely to be found in bathrooms as many of the goods of the earlier registration. These are goods that could form a matching set of goods with towels. Consequently, the goods could be sold in the same area of shops, indeed could be sold together. The relationship between the goods is more than one born of a possible aesthetic or subjective complementary relationship (see *Sergio Rossi SpA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-169/03*). I consider that there is a clear and definite relationship in trade between *bath rugs* and *bath mats* and *towels* and *household textile articles*. I consider that *bath rugs* and *bath mats* are highly complementary to various of the goods of the earlier registration. I do not think that it is mere coincidence that Westpoint has applied for the class 27 goods as well as the class 24 goods. The goods would be used in relation to bathing, as could towels. I consider that *bath rugs* and *bath mats* are similar to a high degree to *household textile articles* and also to *towels*.

21) So, the class 24 goods of the application are identical to the goods of the earlier registration and the class 27 goods of the application are similar to a high degree to the goods of the earlier registration.

Comparison of trade marks

22) The trade marks to be compared are:

Readmans' trade mark:



Westpoint's trade mark:

MARTEX LUXOR

23) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Sabel BV v Puma AG*). The visual, aural and conceptual similarities of the marks must, therefore, be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components (*Sabel BV v Puma AG*). Consequently, I must not indulge in an artificial dissection of the trade marks, although taking into account any distinctive and dominant components. The average consumer rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind and he/she is deemed to be reasonably well informed and reasonably circumspect and observant (*Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*). "The analysis of the similarity between the signs in question constitutes an essential element of the global assessment of the likelihood of confusion. It must therefore, like that assessment, be done in relation to the perception of the relevant public" (*Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02).

24) In its counterstatement and its evidence Westpoint spends a lot of time attacking the LUXOR element of Readmans' trade mark. Its attacks are short on evidence in relation to supporting them. However, certain facts are not disputed by Readmans. There is no doubt that Luxor is a place in Egypt. Although there is an absence of evidence in relation to the nature of the place. Egypt, Mr Johnston accepts, has a reputation for producing high quality cotton. However, he states that there is no evidence that Luxor has such a reputation. This is the case, there is no evidence relating Luxor to cotton production or the textile industry. The average consumer for the goods of the application is the public at large. Some, if not all, of these are goods that are likely to be in every home. Consequently, I have to consider the perception of the population at large. There is an absence of evidence as to how well-known Luxor is or is likely to be. My own knowledge of Luxor is limited to knowing that it is in Egypt. It is very difficult to know the state of knowledge of the average man or woman in the street, whether she or he would even know of the existence of the place. The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public (European Court of First Instance Case T-79/00 *Rewe Zentral v OHIM (LITE)* [2002] ETMR 91). In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and

thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ETMR 585). In this case the issue does not relate to Readmans' trade mark as a whole but to the LUXOR element; whether the device element is the distinctive and dominant element of the trade mark. Of course, in considering the trade mark I am considering its effect when compared with another trade mark; not the registrability per se. What would the perception of the average consumer be? Would the average consumer effectively discount the LUXOR element owing to its geographical significance taking into account the goods? If for instance one saw Sheffield on an item of steel with a device, it is very possible that for the average consumer the Sheffield element would have no trade mark significance and have no effect when comparing it with another trade mark. I do not consider that would be the case here. For me the average consumer would see a LUXOR and device trade mark. It would be the word element that is the distinctive and dominant element. It is the word element that is most likely to be retained in the memory when seeing another trade mark, and which is unlikely to be compared side by side.

25) Clearly, the trade marks coincide only in the LUXOR element. This is identical visually and phonetically. Westpoint argues that there would be different conceptual associations owing to the presence of the word MARTEX. It argues that LUXOR would not be seen as relating to the place in Egypt but would be taken as alluding to luxurious nature of the goods. There is no evidence to suggest that LUXOR has ever been used so as to be synonymous or allusive to luxury. I consider that there will be two groups of people. Those who know of Luxor as a place in Egypt. For this group I can see no reason why, knowing the name of the place, the conceptual association would be with anything other than the place. There will be others who do not know of the place. For the latter group, if Westpoint's argument is correct to some extent, then those people will logically see the LUXOR element of both trade marks as alluding to luxury. I have considered the trade marks prior to reading the counterstatement and evidence of Westpoint. I have obviously considered them after having considered all the evidence, submissions and claims. At first blush I did not see LUXOR in MARTEX LUXOR as referring to luxury. After considering the arguments of Westpoint I still do not see an allusion to luxury. So for those who know of Luxor there will be conceptual identity in relation to the LUXOR elements of the trade marks. For those who do not there will be no conceptual dissonance. If there is an allusion to luxury, for this latter group, then this conceptual association will exist for both trade marks and so there would be conceptual identity.

26) I have to consider the respective trade marks in their entirety. Such a consideration requires considering the effects of the differences as well as the similarities (see *Croom's Trade Mark Application* [2005] RPC2). I find the device element in Readmans' trade mark very much subsidiary to the word LUXOR. Westpoint's trade mark has the word MARTEX. It strikes me that MARTEX in itself is a strong element. The positioning of LUXOR after MARTEX gives the impression to me of a house mark followed by a sub-brand. The LUXOR elements of the respective trade marks are identical, despite

Westpoint's claims to a conceptual dissonance. Mr Hobbs QC, sitting as the appointed person, in *Torremar* [2003] RPC 4 stated:

“At this point it is necessary to observe that marks which converge upon a particular mode or element of expression may or may not be found upon due consideration to be distinctively similar. The position varies according to the propensity of the particular mode or element of expression to be perceived, in the context of the marks as a whole, as origin specific (see, for example, *Wagamama Ltd v City Centre Restaurants Plc* [1995] FSR 713) or origin neutral (see, for example, *The European Ltd v The Economist Newspaper Ltd* [1988] FSR 283).”

In this case I am of the view that the average consumer for the goods, who is presumed to be reasonably well-informed and reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*), is likely to see Westpoint's trade mark as consisting of LUXOR as a sub-brand and MARTEX as an indication of the identity of the manufacturer. Coming across Readmans' trade mark he or she is very likely, in my view, to consider that this is use simply without the specific identification of the manufacturer. **Taking into account all the above I have come to the conclusion that the respective trade marks are distinctively similar.**

Conclusion

27) In considering the issue of likelihood of confusion I have to consider various factors, including:

- the distinctiveness of the earlier trade mark;
- the degree of similarity between the trade marks;
- the degree of similarity between the respective goods;
- the nature of the respective goods and the subsequent purchasing decision;
- the average consumer for the goods involved;
- that trade marks are seldom compared directly and the potential purchaser may be prey to imperfect recollection;
- any claim to reputation.

28) I consider that the earlier trade mark has a reasonable distinctiveness and the presence of the geographical name does not undermine the LUXOR element fatally. The issue of the distinctiveness of an earlier trade mark really comes into play where an earlier trade mark lacks a great deal of distinctiveness and because of this the differences between it and a later mark would lead the average consumer to distinguish between the two trade marks. Owing to the nature of the LUXOR element and the fact that it is identical, I do not consider that this will be the case here. It seems to me that this case has many similarities to that of *Leder & Schuh AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-32/03*, even though that case deals with clothing. That case deals with the common presence of a word and the use of what appears to be a house mark in relation to that common element:

“51 S’agissant de l’appréciation globale du risque de confusion, le Tribunal rappelle que, dans le secteur de l’habillement, il est fréquent que la même marque présente différentes configurations selon le type de produits qu’elle désigne et que, dans ce secteur, il est habituel que la même entreprise utilise des sous-marques, à savoir des signes dérivant d’une marque principale et partageant avec elle un élément dominant commun, pour distinguer ses différentes lignes de production (arrêt Fifties, précité, point 49).” (English version not yet available.)

In that case there was also argument as to the inherent distinctiveness of the earlier trade mark – Schuhpark. The above judgment is similar to that of Stamp J in *Bulova Accutron* [1969] RPC 102:

“Particularly having regard to the fact that BULOVA is the house name of the applicants and has a significance other than as a trade mark, its addition before the word ACCUTRON does not in my judgment serve to prevent the deception or confusion which would in the view of the Court of Appeal have been caused but for that adoption. As the Assistant Registrar remarks in his decision: "As BULOVA and ACCUTRON do not hold together as a phrase or present a wholly different meaning to the separate components, I think that their combination will be taken by many persons on first impression as an indication that the manufacturer of the watches is using two separate trade marks in connection with his products". I would add that the combination of the two words is likely to be taken by other persons on first impression as an indication that the part of the trade mark which consists of BULOVA is a house name of the marketers of the watches, that the trade mark is ACCUTRON and that they will confuse them with watches marketed under the trade mark ACCURIST simpliciter.”

(Also see *L’Oréal SA v v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-112/03.*) The respective goods are identical or highly similar, and so the interdependency principle has to be considered – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*). In this case I consider that there is a good degree of similarity between the respective trade marks as well as an identity/high degree of similarity between the goods. The goods themselves will not necessarily involve the most careful and educated of purchasing decisions. They could be of very low value, although they could cost a lot. As already stated, the average consumer is the consumer at large. Readmans in its statement of grounds claimed a reputation in the trade mark. I find nothing in the evidence to support this claim, certainly not by the material date – the date of application for the trade mark.

29) This is a case where I have no doubt that there is a likelihood of confusion in relation to all of the goods of the application. The average consumer would think that the respective goods emanated from the same economic undertaking or economically linked undertakings. The application should be refused in its entirety.

Passing-off – section 5(4)(a)

30) Readmans could do no better in relation to its passing-off claim and so I see no need to deal with it here. However, I would note that I concur with Westpoint that as of the date of application Readmans has failed to establish a goodwill related to its trade mark. So the claim would have failed.

COSTS

31) Readmans Limited having been successful is entitled to a contribution towards its costs. I order Westpoint Stevens Inc to pay Readmans Limited the sum of £850. 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 this case if any appeal against this decision is unsuccessful.

Dated this 18th day of April 2005

**David Landau
For the Registrar
the Comptroller-General**