

TRADE MARKS ACT 1994

5 IN THE MATTER OF APPLICATION No 2144051  
by THE TEE SHOP LIMITED  
TO REGISTER THE TRADE MARK  
**FREEX**  
IN CLASS 25

10 AND IN THE MATTER OF OPPOSITION THERETO  
UNDER NUMBER 48325  
by FREE SA

15 **DECISION**

15 **BACKGROUND**

20 On 6 August 1997, the Tee Shop Limited, Unit 5, Eleventh Avenue, Team Valley Trading Estate,  
Gateshead, Tyne and Wear, NE11 0JY applied under the Trade Marks Act 1994 for registration  
of the following trade mark:



35 In respect of: "Adults' and children's clothing, headgear both male and female; all included in  
Class 25".

On the 10 March 1998 Free of 107 Boulevard de Sebastopol, 75002 Paris, France filed notice  
of opposition to the application. The grounds of opposition are:

40 i) The opponent is the proprietor of United Kingdom trade mark registration No  
2060807 consisting of or including the word FREE. The goods of the opponent  
have been sold or offered for sale in many areas in the UK since 1995.

45 ii) Application No 2144051 offends against the provisions of Section 5 of the Act  
in that it is similar to the opponent's Trade Mark and is to be registered for goods  
which are identical with and/or similar to those for which the opponent's Trade  
Mark is protected, and there exists a likelihood of confusion on the part of the  
public which includes the likelihood of association with the Trade Mark.

Particularly when consideration is given to the doctrine of imperfect recollection.

The applicant filed a counterstatement denying all the grounds of opposition, other than accepting that the opponent is the proprietor of mark 2060807. They also claim that:

5

“Phonetic identity or similarity is not to be considered valid grounds for contest. Freex is a corruption of the word freaks, communicating ideas of obsession with sport, FREE has a completely dissimilar meaning, of liberty etc.”

10

They state that a letter by letter comparison is not valid. They also claim that their goods are supplied by catalogue, and therefore the possibility of visual confusion is diminished. They also claim that all their goods are prefixed by additional identifying words such as “Sports Freex” and “Surf Freex” which they claim provides further differentiation from the opponent’s mark.

15

They also refer to POL-RAMA [1977] RPC 581, LANCER [1987] RPC 303 and COCA COLA V PEPSI COLA 1942 [59 RPC 127]. They claim that these cases support the argument whereby the whole word and its meaning are compared and examined.

20

Further, they claim that they have been using the mark in suit in the UK continuously since October 1997. They state:

“At no time has the FREE brand been observed in the European or UK market applied to similar goods. Concurrent use has applied.”

25

Neither side wished to be heard in the matter. The applicant did not file any evidence other than the counterstatement. Both sides ask for costs. My decision will therefore be based on the pleadings and the evidence filed.

30

#### OPPONENT’S EVIDENCE

35

This takes the form of a statutory declaration, dated, 7 November 1998, by Mr Michel Zberro the president of Free S.A. a position he has held since 1 July 1996 having been employed by the company since 4 September 1989.

40

Mr Zberro states that Free S.A. is the registered proprietor of UK Trade Mark 2060807, which he claims he created and adopted in 1989. He claims that it has been used continuously by the opponent since 1995.

45

Mr Zberro claims that the mark FREE is a “designer label” and the products are he claims “purchased by a discriminating clientele through my company’s outlets and via distribution in stores such, for example, as Harrods Limited; TK Maxx; H & M Hennes Limited; Folia House; Arte; TFNC; and Standquick Limited.”

He provides turnover figures “arising out of the sale of the products under the trade mark from 1995 to date”. These are as follows:

| Year             | £ Sterling |
|------------------|------------|
| 1995             | 65,759     |
| 1996             | 59,355     |
| 1997             | 79,174     |
| 1998 ( to 31.08) | 69,910     |

Mr Zberro claims that as a result of the above he believes that the trade mark FREE enjoys a reputation in the UK such that use of the mark in suit would be bound to deceive and / or cause confusion in the minds of the purchasing public.

Mr Zberro claims that the opponent's mark has been advertised and promoted in a variety of ways. These are, he states, on the clothes themselves ( labels, swing tickets) distribution of display material (catalogues, posters, point of sale displays) and via television, the Internet and magazines.

He states the following as examples:

“a) The appearance of Ophelie Winter (young singer, model and famous egeria of Prince) on various television shows and in magazine articles photographed in products as sold under the trade mark.

b) The employment in 1995 of the Jean-Marc Fellous' publicity department to increase the presence of products sold under the trade mark. He established the fame of the trade mark by dressing models such as Eva Herzigova, Helena Christensen, Karen Mulder and Stella Tenant in the products for photographs in magazines such as Elle, Vogue, Glamour, Femmes, Figaro, Madame and Max.

c) The 1995 campaign featuring the model Viola was also carried out with the help of the artistic management of Michel Malart; Jeff Manzetti; and the stylist Nathalie Baumgartner.

d) The company's web site was opened in 1996 and a large selection of products available under the trade mark are displayed to the general public. At the same time, an exclusive distribution agreement was made with the television show “Dance Machine” to design a line of clothing under the trade mark.

e) The 1997 campaign of Jonathan Lenhart featured model Teresa; and over 480,000 copies of the company's catalogue were distributed in the Elle Special Fashion supplement in March of that year.”

Mr Zberro also provides at exhibit FREE1 a number of promotion items. These include:

1) A number of labels, some of which appear to be for inside garments, a swing tag and a nondescript label. Most but not all have the full trade mark of the opponent, the others have just the word FREE.

2) A print-out of the front page of a web site which has the full trade mark of the opponent, and which indicates its availability in French or English. This is not dated.

3) There are a number of photographs of women. On some there appears to be a reference to the provider of the clothes etc. that the models are wearing and the word FREE appears a number of times. However, as the rest of the wording is in French with no translation no account can be taken of these. There also appears to be the front covers from "FREE magazine". One is clearly dated 1998, but the other is indistinct. Again the exhibits have no translation.

4) A carrier bag with the word FREE print across it and an address of "84 Champs Elysees"

5) A brochure printed in French and English which includes the following quotes:

"Clothes that are made in harmony with a new lifestyle, a second skin to feel freer and in accord with one's moods and tastes." and "FREE, Freedom has no limits."

6) A brochure of pictures of clothes which includes T-shirts with the word FREE together with a variety of slogans and devices.

7) A four-page leaflet giving details of the background of the company. From the data provided it is clear that the leaflet was produced either in 1997 or shortly thereafter. It states that the company started in 1989. It provides the milestones of the company and also indicates the way that the company has used "messages" such as "FREE WINTER" "FREE YOUR NATURE" "THE SPIRIT OF FREE" and "FREE, FREEDOM HAS NO LIMITS." These messages have been printed on some of the clothes including T-shirts. The prices are clearly towards the lower end of the spectrum with average prices being given for Jackets, trousers and wool outfits of between 400FF and 600FF (approx. £50 - 70).

At exhibit FREE2 is a list of retail outlets for products under the trade mark in the UK. Most of the outlets listed are in London, and the other twelve are dotted around England. Mr Zbarro also states that the exhibit includes specimen invoices. However, whilst the addresses are in the UK and most of the documents are dated prior to the relevant date the detail of what is being provided is in French with no translation provided.

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

## DECISION

The only ground of opposition is under Section 5(2)(b) which reads:

*5.- (2) A trade mark shall not be registered if because -*

*(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 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.”*

For ease of reference the marks of both parties are reproduced below:

|    |   |  |
|----|---|--|
| 5  | Applicant's mark  | Opponent's mark  |
| 10 |  |  |
| 15 |   |  |

20 I have to determine whether the marks are so similar that there exists a likelihood of confusion on the part of the relevant public. In deciding whether the two marks are similar I rely on the decision of the Court of Justice of the European Communities (ECJ) in the Sabel v Puma case C251/ 95 - ETMR [1998] 1-84. In that case the court stated that:

25 *“Article 4(1)(b) of the directive does not apply where there is no likelihood of confusion on the part of the public. In that respect, it is clear from the tenth recital in the preamble to the Directive that the appreciation of the likelihood of confusion ‘depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified’. The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case.*

35 *Global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The wording of Article 4(1)(b) of the Directive - “there exists a likelihood of confusion on the part of the public” - shows that the perception of the marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.*

40

5 *In that perspective, the more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either per se or because of the reputation it enjoys with the public.”*

10 I also have regard to the approach adopted by the European Court of Justice in Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc. (case C-39/97) (ETMR 1999 P.1) which also dealt with the interpretation of Article 4(1)(b) of the Directive. The Court in considering the relationship between the nature of the trade mark and the similarity of the goods stated:

15 *“A global assessment of the likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between these goods or services. Accordingly, a lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the marks, and vice versa. The interdependence of these factors is expressly mentioned in the tenth recital of the preamble to the directive, which states that it is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion, the appreciation of which depends, in particular, on the recognition of the trade mark on the market and the degree of similarity between the mark and the sign and between the goods or services identified.”*

25 The opponent’s mark is registered for the following in Class 25:

30 *“Dressing gowns, bathrobes, lingerie, underwear, dresses, skirts, trousers, suits, coats, shirts, jackets, ties, stoles, scarves, gloves, rain coats, socks, stockings, pants, babywear, footwear, slippers, belts, headwear.”*

This specification is clearly encompassed in the applicant’s specification in the same class. The applicant’s specification includes clothing for women and children and footwear which, although not identical to the opponent’s goods, are similar.

35 I turn next to consider the trade marks.

40 Visually, the opponent’s mark is formed of a word and a device element. The device is not very distinctive, at best I would describe it as half of a maple leaf. Clearly the prominent feature is the word FREE. The applicant’s mark has the word FREE with the letter X added and printed in a highly stylised manner where the letters are not easily identified..

Phonetically, the marks share the first syllable FREE. The applicant’s mark has a second syllable which will be seen as “X” or “EEKS”. The applicant suggests that the latter version will be adopted forming a misspelling of the word FREAKS.

45 Conceptually the opponent’s mark alludes to freedom and liberty. The applicant’s mark can be seen as if the letters were formed from ice crystals, or that the letters were mutating. The latter

assists with the “freakish” imagery.

5 The opponent has claimed sales under the mark prior to the material date, 6 August 1997, of £120,000. These sales figures in the context of the clothing industry can only be regarded as minuscule.

I must consider the marks as wholes and take into account the degree, if any, of similarity between the marks and goods of the two parties with due attention to other factors such as reputation.

10 In the case in suit the difference between the two marks of the parties is such that despite the similarities in the specifications there exists, in my opinion, no likelihood of confusion. The opposition under Section 5(2) therefore fails.

15 The opposition having failed the applicant is entitled to a contribution towards its costs. I order the opponent to pay them the sum of £235. This sum to be paid within one month of the expiry of the appeal period or within one month of the final determination of this case if any appeal against this decision is unsuccessful.

20 Dated this 29 day of March 2000

25 George W Salthouse  
For the Registrar  
The Comptroller General