

O/130/12

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2557195  
BY DEFAY TO REGISTER THE TRADE MARK**



**IN CLASS 14**

**AND IN THE MATTER OF OPPOSITION  
THERE TO UNDER NO 101431  
BY TOD'S SPA**

## BACKGROUND

1) On 27 August 2010, DeFay applied under the Trade Marks Act 1994 (“the Act”) for registration of the following mark:



2) The application is in respect of the following list of goods in Class 14:

*Jewellery, Costume Jewellery, and watches made from precious metals, clay, wood, plastic. Comprising of precious stones, craft stones, various beads, and craft wire.*

3) The application was published in the Trade Marks Journal on 22 October 2010 and on 20 January 2011, Tod's S.p.A. (hereafter “Tod's”) filed notice of opposition to the application. The ground of opposition is that DeFay's application offends under Section 5(2)(b) of the Act because it is similar to three of Tod's earlier marks and in respect of similar or identical goods. The relevant details of these earlier marks are:

<p>CTM*4208112</p>  <p>The image shows a black and white logo. At the top is a profile of a head, possibly a classical figure, facing left. Below the head, the name 'Fay' is written in a white, elegant cursive font. The entire logo is enclosed within a dashed white rectangular border.</p>	<p>Filing date: 20 December 2004 Registration: 3 February 2006</p>
<p><b>Class 8:</b> <i>Cutlery, in particular knives, forks, spoons, scissors and rasors.</i></p> <p><b>Class 14:</b> <i>Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes, jewellery and personal</i></p>	

*ornaments, costume jewellery, precious stones, horological instruments, clocks, watches, pendulums, chronographs and stop watches.*

**Class 16:** *Paper, cardboard and goods made from these materials, not included in other classes; stationery, diary covers, address books and briefcases.*

**Class 19:** *Building materials (non metallic), ceramic tiles for floorings and coverings.*

**Class 20:** *Furniture, parts of furniture, statues of ceramic, glass or wood for use as parts of furniture in class 20; mirrors, picture frames, goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics, small decorative objects of wood or other materials not included in other classes.*

**Class 21:** *Household or kitchen utensils and containers (not of precious metal or coated therewith); unworked or semi-worked glass (except glass used in building); glassware, crystal glassware, porcelain and earthenware not included in other classes, non-electric brushes, sponges for household use, abrasive sponges for household cleaning, brushes, combs, shaving brushes, dishes, drinking glasses.*

**Class 24:** *Textiles and textile goods, not included in other classes, curtains, seat covers, drapery, blankets, bed blankets, tablecloths, bed linen, household linen, table linen, bath linen (except clothing), towels in class 24.*

\* Community Trade Mark

CTM8437352

Filing date: 20 July 2009  
Registration: 21 January 2010



CTM8437402

Filing date: 20 July 2009  
Registration: 21 January 2010



Both marks are in respect of the following identical list of goods:

**Class 9:** *Spectacles, sunglasses, spectacle lenses and frames, contact lenses, optical lenses, magnifying glasses, spectacle cases, chains and cords, parts and fittings for all the aforesaid goods; covers of leather for digital music players, mobile telephones, DVDs, CDs, computer cables, apparatus for the reproduction of sound, palm-top computers, electronic personal organisers, television cameras and cameras.*

**Class 18:** *Bags, handbags, travelling bags, card cases, card cases of leather, credit card holders of leather, wallets, covers of leather for briefcases, key rings of leather, handbags, trunks, travelling bags, cosmetics bags, sports bags included in this class, athletics bags, evening bags and shoulder bags for women, shopping bags of leather, school satchels, garment bags for travel, hat boxes for travel, shoe carriers for travel, beach bags, bags, nappy bags, rucksacks, Boston bags, travelling bags, canvas bags, overnight bags, trolley suitcases, bags for climbers, formal handbags, vanity cases (not fitted), animal skins, hides, cases and boxes of leather, cases of leather, umbrellas, leather leashes.*

**Class 25:** *Clothing of leather, coats of leather, jackets of leather, trousers of leather, skirts of leather, tops of leather, waterproof clothing of leather, long coats of leather, overcoats of leather, belts of leather, shoulder belts for clothing of leather, belts, clothing, stuff jackets, jackets, greatcoats, jumpers, trousers, jeans, skirts, dresses, coats, overcoats, cloaks, parkas, jerseys of wool, shirts, tee-shirts, blouses, cardigans, underwear, nightdresses, bath robes, bathing suits, negliges, bathing suits, dressing gowns, eveningwear, one-piece clothing, two-piece clothing, evening gowns, shawls, sashes for wear, neckties, bow ties, clothing for men, clothing for women, shirts, hawaiian shirts, sweatshirts, underwear, polo-shirts, bodysuits, blazers, shorts, sport shirts; shoes, athletic shoes, slippers, shoe covers, low shoes, shoes of leather, shoes of rubber, goloshes, clogs, fishing shoes, basketball shoes, dress shoes, heels, hiking boots, rugby boots, boxing shoes, baseball shoes, patent shoes, beach shoes, inner soles, soles for footwear, footwear uppers, heels for shoes and boots, non-*

*slipping devices for shoes and boots, tips for footwear, rain shoes, running shoes, work shoes, shoes of straw, gymnastics shoes, boots, ski boots, half-boots, apres ski boots, football boots, lace boots, hockey shoes, handball shoes, esparto shoes or sandals, sandals, bath sandals; gloves, gloves for protection against the cold, gloves of leather, mittens; hats and caps, visors (headgear), hats and caps of leather.*

4) All three of Tod's marks are earlier marks as defined in section 6 of the Act and as they have all completed their registration periods within the five year period ending with the publication of DeFay's mark, they are not subject to the proof of use provisions set out in Section 6A of the Act.

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

6) Only Tod's filed evidence in these proceedings, but I will bear in mind, but not detail here, the submissions of DeFay that were included in its counterstatement. Both sides ask for an award of costs. Neither side requested to be heard and I make this decision after careful consideration of the papers.

### **Tod's Evidence**

7) This takes the form of a witness statement by Stefano Sincini, CEO of Tod's. He states that the FAY and HOGAN brands were created in the 1980s with the marks relied upon being adopted in 2001 (HOGAN) and 2003 (FAY). He provides the following turnover figures in respect of the UK (but it is not clear to what goods these turnover figures relate):

<b>Year</b>	<b>Turnover (€) for FAY</b>	<b>Turnover (€) for HOGAN</b>
2002	4,862.11	406,093.28
2003	13,086.94	927,497.31
2004	1,492.00	1,289,200.10
2005	1,490.50	1,370,715.60
2006	161,022.34	1,519,172.50
2007	319,347.31	1,546,929.30
2008	171,259	1,176,134.35
2009	138,612	1,141,336.21
2010	19,246	1,447,944

8) An extract, dated 2 June 2011, from Tod's website is provided at Exhibit A showing its European distribution network and this includes four London addresses for a company called Londra. Alongside two of these entries appears "(TOD'S)", the implication being that the business is a distributor of TOD'S branded goods. A third has "(HOGAN)" appearing alongside and the fourth has "(ROGER VIVIER)". A fifth distributor is listed as being an outlet in Bicester.

9) Mr Sincini states that Tod's manufactures and sells a wide range of high quality clothing, shoes and accessories in respect of its earlier marks. Extracts, all dated 2 June 2011, from its websites [www.todsgroup.com](http://www.todsgroup.com), [www.tods.com](http://www.tods.com), [www.hoganworld.com](http://www.hoganworld.com) and [www.fay.com](http://www.fay.com) are provided at Exhibit B. These illustrate FAY branded coats and jackets and HOGAN branded shoes, a bag and a coat.

10) Mr Sincini estimates that the average annual spend on promotions is approximately €550,000. Such promotion includes adverts in magazines, editorials, television advertisements, media events and catalogues.

11) Mr Sincini also makes numerous submissions that I will not detail here, but I will bear in mind.

## **DECISION**

### **Section 5(2)(b)**

12) Section 5(2)(b) reads:

“(2) A trade mark shall not be registered if because –

(a) ...

(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.”

13) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the Court of Justice of the European Union (CJEU) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] FSR. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] ETMR 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) 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*,

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,

(f) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either *per se* or because of the use that has been made of it; *Sabel BV v Puma AG*,

(g) in determining whether similarity between the goods or services covered by two marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(i) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(j) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*

(k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of

the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

(l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM (LIMONCELLO)*

### ***Comparison of goods***

14) In assessing the similarity of goods, it is necessary to apply the approach advocated by case law and all relevant factors relating to the respective goods and services should be taken into account in determining this issue (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*).

15) I also keep in mind the guidance of the General Court (“GC”) in *Gérard Meric v OHIM*, T-133/05 (*MERIC*) that goods listed in one party’s specification are included in a more general category listed in the other’s specification, or vice versa.

16) I find it convenient to consider the similarity of goods based upon Tod’s CTM 4208112 FAY logo mark. When taking account of the guidance in *MERIC* it is evident that all of DeFay’s goods are identical to those listed in Tod’s Class 14 specification.

### ***The average consumer***

17) As matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, paragraph 23) it is important that I assess who the average consumer is for the goods and services at issue.

18) The average consumer of the respective goods is those members of the general public who wish to purchase jewellery and the like. For these goods the level of care exhibited during the purchasing act will be the same as for other consumer products in that it will not involve the highest degree of attention, but neither will it be an unconsidered purchase. The purchase will be predominantly visual because of the aesthetic considerations involved in the selection process of goods whose main purpose is for personal adornment. However, I do not ignore the aural considerations that may be involved.

### ***Comparison of marks***

19) Once again, I will confine my considerations by reference to Tod’s FAY logo mark.

20) For ease of reference, the respective marks are reproduced below:

Tod's mark	DeFay's mark
	

21) When assessing the extent of similarity between the respective marks, I must do so with reference to their visual, aural and conceptual similarities bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*, para 23). Firstly, I will consider the dominant and distinctive elements of the respective marks. Tod's mark consists of the word FAY, a device in the form of a bust of a dog, a dotted line boundary, all set against a dark background. The word FAY is the largest element and is the only aural element of the mark. It is clearly the dominant and distinctive element. The device of a dog's head, whilst not being the dominant element, is nonetheless, an element that must be considered in the overall comparison. The dotted line boundary, on the other hand, is of lower significance even if it cannot be described as negligible.

22) In respect of DeFay's mark, this consists of the words DE FAY in a fancy script together with a wing device at the beginning of the mark and a circle device encompassing most of the first letter. The word element is significantly larger than the other elements being approximately three times as long as the other elements. Despite the word being bound up in the device element, the single most dominant and distinctive element of the mark is the word DE FAY. Nevertheless, the combined circle and wing device endows the mark with a particular visual character that I must factor in when considering the "whole mark" comparison required.

23) From a visual perspective the marks are similar insofar as they both contain the same word FAY and that the font is similar with the shape and angle of the letters being the same. However, in all other respects, the marks are different. DeFay's mark contains a device of yellow feathers in an arrangement reminiscent of a bird's wing tip. This is attached to the left edge of a circle surrounding the majority of the letter "D". On the other hand, Tod's mark includes the device of a dog's head, a dotted line boundary and a dark background.

Taking account of all these differences, I conclude that the existence of the word FAY in both marks does no more than lift similarity of otherwise disparate marks to a moderate level.

24) From an aural perspective, it is only the word elements that have any significance as the device element will not be expressed aurally. Tod's mark will be pronounced as the single syllable FAY whereas DeFay's mark will be pronounced as the two syllables DE and FAY. Clearly the second syllable of DeFay's mark is identical to the complete aural element of Tod's mark. Further, the DE element of DeFay's mark is a short sound. Taking this into account, I conclude that the respective marks share a reasonably high level of aural similarity.

25) Conceptually, Tod's mark will be perceived as a female personal name. Tod's submits that the DE element of DeFay's mark will only be perceived as a preposition. I accept this. It means "of" or "from" and occurs as part of personal names<sup>1</sup>. As such, the word element of DeFay's mark will also be perceived as a personal name. I do not consider the presence of a small space between the DE and FAY element to change this perception. The device element of DeFay's mark does not impact upon this primary perception to any great extent. Taking all of this into account, the fact that the word element of both marks is a personal name, and that the word FAY is present in both, leads to a perception that the respective personal names relate to the same or related persons. The respective device elements do not impact upon this perception, but I take account of the fact that in Tod's mark the device includes a wing and in DeFay's mark the device includes a dog. The remaining device elements that are present in the respective marks have a negligible impact upon the conceptual identity of the marks. Taking all of this into account I conclude that the respective marks share a reasonably high level of conceptual similarity.

26) Having found that the respective marks share a moderate level of visual similarity and a reasonably high level of aural and conceptual similarity, I conclude that they share a moderately high degree of similarity overall.

### ***Distinctive character of the earlier trade mark***

27) I must consider the distinctive character of the earlier mark because the more distinctive it is, either by inherent nature or by use the greater the likelihood of confusion (*Sabel BV v Puma AG* [1998] RPC 199). The distinctive character of the earlier trade mark must be assessed by reference to the goods for which it is registered and by reference to the way it is perceived by the relevant public (*Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91).

28) Tod's mark consists of the female personal name FAY together with the device of a bust of a dog, a dotted rectangular boundary and a dark background.

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<sup>1</sup> [www.collinsdictionary.com](http://www.collinsdictionary.com)

Whilst female personal names are not particularly distinctive in respect of jewellery and similar goods as they are quite commonly used in that industry, the additional elements, particularly the bust of a dog combine with the name to give the mark a moderately high level of inherent distinctive character.

29) I must also consider the effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act. This was considered by David Kitchen Q.C. sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchen concluded at paragraph 17 of his decision:

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in *Reed Executive & Ors v Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

30) Tod's discloses turnover figures in respect of its FAY mark that vary widely from €1,492 in 2005 to €319,347 in 2007. In addition to this erratic and wide variation, there is no indication what goods the turnover relates to. Therefore, it is not possible to ascertain what proportion relates to goods that are similar or identical to DeFay's goods. Even if it does all relate to Tod's Class 14 goods, the amounts are very small when the obviously large jewellery market in the UK is considered. Consequently, I am unable to conclude that there is any enhanced distinctiveness resulting from Tod's use of its mark in respect of relevant goods.

### ***Likelihood of confusion***

31) I must adopt the global approach advocated by case law and take into account that marks are rarely recalled perfectly with the consumer relying instead

on the imperfect picture of them he has in kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27).

32) I have found that the respective marks share a moderate level of visual similarity and a reasonably high level of aural and conceptual similarity. I have also found that Tod's mark has a moderately high level of distinctive character and the respective goods are identical. The average consumer is the general public and the nature of the purchasing act is predominantly visual.

33) When taking all of the above into account, I find that the differences between the marks are not sufficient to avoid a likelihood of confusion. Both marks contain the same name FAY presented in a very similar font. Whilst DeFay's mark includes the preposition DE, this, by its very nature, informs the consumer that it relates to the same undertaking as provides the goods under the FAY mark. Whilst there are distinct visual differences between the respective marks (resulting from the different device elements), it is not unusual in the fashion and jewellery industries to use mark variants on different ranges of goods. Consequently, whilst the consumer will not mistake one mark with the other, he is likely to assume that, because of the word FAY appearing in a very similar font in both marks, the goods provided under the respective marks are provided by the same or linked undertaking.

34) Therefore, when considering normal and fair use, with regard for the notional and average consumer, I find that there is a likelihood of confusion in respect of all of DeFay's goods.

35) In light of these findings, it is not necessary for me to consider Tod's grounds of opposition insofar as it relies upon its HOGAN marks.

## **COSTS**

36) The opposition having been successful, Tod's is entitled to a contribution towards its costs. I take account of the fact that no hearing has taken place and that only Tod's filed evidence. I award costs on the following basis:

Preparing Notice of Opposition (and including official fee) and considering other side's statement	£500
Preparing evidence	£600
<b>TOTAL</b>	<b>£1100</b>

37) I order DeFay to pay Tod's S.p.A. the sum of £1100. 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 23<sup>rd</sup> day of March 2012**

**Mark Bryant  
For the Registrar,  
the Comptroller-General**