

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2191548
BY MANCHESTER CLOTHING LTD TO REGISTER
A MARK IN CLASS 25**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
NO 50567 BY VIVIENNE WESTWOOD S.R.L.**

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by Manchester Clothing Ltd to Register
a Mark in Class 25**

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**IN THE MATTER OF Opposition thereto under
No 50567 by Vivienne WESTWOOD S.R.L.**

DECISION

1. On 12 December 1999 Manchester Clothing Co Ltd applied to register the mark shown below in relation to “clothing, footwear and headgear” in Class 25.



2. The Trade Mark Journal advertisement contains the following clause “the applicant claims the colours red, yellow and white as an element of the mark”. The application is numbered 2191548.

3. On 29 December 1999 Vivienne Westwood Srl filed notice of opposition to this application. The opponent is the proprietor of the trade mark VIVIENNE WESTWOOD. This mark is said to have been used in the UK for many years in relation to designer clothing and related products as a result of which substantial reputation and goodwill has been generated.

4. The opponent is also the proprietor of the Community Trade Mark registration details of which are set out in the Annex to this decision. A further CTM referred to in the grounds was not relied on at the hearing.

5. On the basis of these circumstances objections are said to arise under Section 5(2)(b), 5(3) and 5(4)(a) of the Act. The actual wording of the objections largely mirrors the wording of the Act without further elaboration. Further objections are said to arise under Section 5(2)(b) and 5(3) on the basis that the opponent’s trade mark has well known marks status and is

entitled to protection under the Paris Convention but these objections were not pursued as separate issues at the hearing.

6. The opponent also objects under Section 3(6) claiming that the application has been made in bad faith. No further explanation is offered to support the claim. Finally there is a reference to exercise of the Registrar's discretion. As there is no such overriding power I need say no more about the latter.

7. The applicants filed a counterstatement denying the above claims against them, questioning the sufficiency of certain of the grounds as pleaded and asking for full and better particulars. It is not clear what (if any) action was taken at the time in response to the applicants' points.

8. Both sides ask for an award of costs in their favour.

9. Both sides filed evidence. The matter came to be heard on 1 March 2002 when the opponent was represented by Ms C May of Counsel instructed by Mathisen Macara & Co. The applicants were not represented at the hearing.

Opponent's Evidence

10. The opponent filed a declaration by Carlo D'Amario, the President of the Board of Directors of Vivienne Westwood Srl based in Milan.

11. Mr D'Amario says that Vivienne Westwood began designing clothes in 1971 along with her partner Malcolm McLaren. The partnership is said to have lasted until 1984 during which time Vivienne Westwood became well known for her avant-garde designs. Mr D'Amario's company was established in 1984 to manufacture and supply clothes under the VIVIENNE WESTWOOD trade mark. The range has since been sub-divided into different lines with the ANGLOMANIA line being launched in 1998 (I infer that this is the mark which is the subject of community trade mark No 553370). The development of Vivienne Westwood's career and the fashion label that bears her name is outlined in a 'Brochure Presentation' (Exhibit A).

12. Mr D'Amario says that the products sold under the VIVIENNE WESTWOOD trade mark in the UK are mainly manufactured by his company's licensees in accordance with his company's directions and distributed in the UK by Vivienne Westwood Ltd. The relationship between Vivienne Westwood Ltd and his company is that the members of his company are also members of Vivienne Westwood Ltd. His company mainly deals with the manufacturing side of the business whereas Vivienne Westwood Ltd deals with the stylistic creation, production and distribution of VIVIENNE WESTWOOD goods in the UK.

13. The VIVIENNE WESTWOOD trade mark has been used in the UK in relation to clothing and accessories such as shoes, jewellery, bags, belts, wallets and other leather goods, sun glasses and perfume. Exhibit B are examples of labels and packaging showing the manner in which the VIVIENNE WESTWOOD trade mark is used in relation to the goods.

14. The goods are sold throughout the UK. A list of retailers is shown at Exhibit C. I note that the list contains a mixture of leading stores (Liberty, Harvey Nicholls, Selfridges), a small

number of flagship stores bearing the designer's own name and what I take to be independently owned retail shops.

15. Sales figures for goods sold under the VIVIENNE WESTWOOD trade mark in the UK are as follows:-

YEAR	£
1996	3,429,285
1997	5,052,003
1998	5,835,062
1999	3,682,698

16. It is not said how these sales figures break down across the range of clothing and accessories referred to above. However, the supporting invoices (Exhibit D) appear to relate primarily to clothing with some clothing accessory items (cufflinks) also shown. I infer that the bulk of the sales are likely to be of clothing consistent with the main thrust of the business.

17. During the years 1995-2000, Vivienne Westwood Ltd spent the following amounts on advertising and promoting VIVIENNE WESTWOOD products in the UK by means of brochures, leaflets, press advertisements etc.

YEAR	£
1995	40,000
1996	60,000
1997	80,000
1998	100,000
1999	100,000
2000	100,000

18. Examples of advertising and promotional materials are shown at Exhibit E.

19. In addition to the above mentioned advertising, VIVIENNE WESTWOOD clothes and accessories are displayed at fashion shows. In the years 1995-1998, Vivienne Westwood Ltd participated in two UK fashion shows each year incurring the following expenses:

YEAR	£
1995	50,000
1996	50,000
1997	50,000
1998	50,000

20. Exhibit F contains examples of articles which have appeared in the UK press concerning fashion shows at which VIVIENNE WESTWOOD clothes and accessories have been shown. The reputation thus established is said to have been reinforced by articles in newspapers and

magazines having a circulation in the UK and by the publication of a book entitled ‘Vivienne Westwood’. Examples of these articles and a copy of the book are at Exhibit G.

21. By virtue of the above Mr D’Amario submits that anyone seeing the name Westwood used in relation to clothing or accessories would believe there to be a connection with Vivienne Westwood and products manufactured and supplied by Vivienne Westwood Srl.

Applicants’ Evidence

22. The applicants filed a witness statement by Zahid Shafi, a Director of Manchester Clothing Ltd.

23. Mr Shafi says that Manchester Clothing is a leading wholesaler of children’s clothing being predominantly school wear and sports wear. Approximately 90 per cent of the goods are sold to clothing retailers and 10 per cent to clothing wholesalers. The goods are said to be “sold to many hundreds of customers throughout the UK”.

24. Manchester Clothing is said to have first adopted the trade mark WESTWOOD in relation to the goods in 1980 and to have used it continuously since in various forms including in the form shown in the present application in which the word WESTWOOD is in combination with the ‘WW’ shield device - that has been the predominant form of use since about 1995 onwards although that form was first adopted in the early 1980s.

25. Examples of various forms of the label used since 1980 are shown in Exhibit ZS 1.

26. Turnover under the WW WESTWOOD label is given as follows:

YEAR	TURNOVER BY CASH
1995	1,625,750
1996	1,720,000
1997	2,170,770
1998	2,002,112
1999	1,950,725

These are wholesale values. Retail values are said to be 50 to 80 per cent greater.

27. The following sums have been spent on promotional material:

YEAR	COSTS OF LABEL , LETTERHEADS SHOW CARDS ETC	COST OF ADVERTISING
1995	£6,725	£2,440
1996	£6,980	£2,600
1997	£7,450	£2,750
1998	£7,700	£2,900
1999	£8,000	£3,500

28. The goods have also been exhibited at trade shows held at the National Exhibition Centre, Birmingham. Exhibit ZS2 contains examples of the use of the WW WESTWOOD trade mark on and in relation to the goods and in their promotion.

29. Mr Shafi goes on to offer what amount to submissions on the opponent's evidence. The main points seem to me to be:

- it is not disputed that Vivienne Westwood is a well known and highly regarded fashion designer.
- she is known and referred to by her full name and not the surname WESTWOOD alone.
- use of VIVIENNE WESTWOOD on any significant commercial scale does not seem to have commenced until 1984 that is after the applicants first used WESTWOOD.
- there is nothing to suggest that the VIVIENNE WESTWOOD mark has been or will be used in relation to children's wear and sportswear. Rather it is a designer label or haute couture
- the respective goods are in different sectors of the market.

Opponent's Evidence in Reply

30. Mr D'Amario filed a further declaration the primary purpose of which appears to be to dispute Mr Shafi's assertion that the opponent does not use WESTWOOD alone as a trade mark in relation to clothing. He says that the opponent's mark is frequently shortened to WESTWOOD and the goods are referred to as WESTWOOD goods. In support of this he exhibits (Exhibit J) copies of extracts from The Daily Telegraph of Friday 24 October 1997, OK! of 30 October 1998, Blitz of August 1988 and The Daily Express of 18 March 1993 in which the opponent's goods are referred to as WESTWOOD alone.

31. Mr D'Amario also disputes Mr Shafi's claim that use of VIVIENNE WESTWOOD as a trade mark in relation to clothing only commenced on any significant commercial scale in 1984. He exhibits (Exhibit K) a copy of an article from The Face of November 1982, Cosmopolitan of September 1982 and WWD London of 22 December 1982 showing use of the trade mark VIVIENNE WESTWOOD.

32. The opponent also filed the following:-

Statutory Declaration of Murray Blewett
Statutory Declaration of Christopher Di Pietro
Statutory Declaration of Mark Spye
Statutory Declaration of Robert Pinnock
Statutory Declaration of Brigitte Stepputis
Witness Statement of Joanna Kenyon

Witness Statement of Amanda Kelly
Witness Statement of Peri Dallas Mosig
Witness Statement of Koulla Constantin
Witness Statement of Sara Burn

33. The statutory declarations are from individuals who are fashion designers for Vivienne Westwood Ltd or are otherwise employed by Vivienne Westwood. The witness statements are from people in the fashion industry. Their evidence goes to their own familiarity with the trade mark VIVIENNE WESTWOOD and its reputation for fashion clothing and accessories and the fact that the mark is often used as WESTWOOD alone. I have a number of concerns about this evidence which I will come to in due course.

34. That concludes my review of the evidence.

35. Section 5(2)(b) reads as follows:-

"5.-(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."

36. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

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*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, 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.* paragraph 27;
- (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*, paragraph 23;

- (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*, paragraph 23;
- (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*, paragraph 17;
- (f) there is 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; *Sabel BV v. Puma AG*, paragraph 24;
- (g) 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*, paragraph 26;
- (h) 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*, paragraph 41;
- (i) 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*, paragraph 29.

Distinctiveness of the opponent's mark

37. The guidance from *Sabel v Puma* is that there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character either per se or because of the use made of it. I am also required to bear in mind the distinctive and dominant components of the mark.

38. The principal components of the opponent's earlier trade mark are the words VIVIENNE WESTWOOD and the orb device. The words VIVIENNE WESTWOOD are presented in a particular typeface/form. It is not in itself particularly remarkable or memorable though I note that the original material filed in evidence (labelling, packaging, swing tags, invoices etc) show that this is the typeface that is consistently used.

39. It is often said that words talk in trade marks. That is likely to be the case here. I bear in mind also that in the clothing field (particularly haute couture) the name of the designer is likely to be of particular importance. Accordingly the words VIVIENNE WESTWOOD are likely to be the dominant element in the mark. The impact of the orb device should not, however, be underestimated. It is not an element of the mark that has been adopted casually or for incidental effect. Exhibit A (the Vivienne Westwood brochure presentation) indicates that "The Orb symbolises the world, yet it is very British - it is part of the royal regalia which the Queen holds at the State Opening of Parliament. Thus it represents Vivienne Westwood as a British designer with an international perspective. The Orb represents tradition, the satellite ring the

future, and describes the work of Vivienne Westwood where all new discoveries in design come from studying tradition".

40. It might, of course, be said that the average consumer may not be aware of the significance of the orb or the reason for its adoption. That may be so but it features prominently in the promotional material and in a number of photographs (the Vivienne Westwood Fashion Memoir book at Exhibit G and the Newsweek photograph at Exhibit F for instance). It also appears to be used as a standalone logo on certain goods (see the bags brochure at Exhibit E).

41. The opponent's mark is, therefore, an inherently distinctive one. The words may be the dominant element but the orb device also plays its part.

42. The evidence further establishes that the intrinsic merits of the mark have been reinforced by extensive use. The history of Vivienne Westwood's activities and fame as a fashion designer are set out in Exhibit A from her beginnings in the punk era to the present day - she is perhaps best known for her avant garde designs.

43. I do not understand the applicants to dispute Vivienne Westwood's fame as a designer. What they do say, however, is that she has always been known and referred to by her full name and not by her surname alone. The opponent takes a contrary view and says that the goods are often referred to simply as WESTWOOD. It is a point that is not without importance and arises more particularly in the context of Section 5(4)(a) (dealt with below). Ms May made a number of submissions bearing on the point. The most significant ones were that in her view the evidence supported the claim that the surname WESTWOOD has achieved independent recognition and that clothing designers are often known by their surnames alone rather than their full names eg (Giorgio) Armani and (Coco) Chanel.

44. Before considering the opponent's position it is worth recording what I consider to be the correct approach in law having regard also to the ECJ authorities. Section 5(2) is based upon the existence of an earlier trade mark in this case the composite mark of CTM No 976183. The correct approach it seems to me is for me to base my consideration on the totality of the mark having regard to its distinctive and dominant components. Evidence as to how the mark is actually used and the relative importance attached to elements of the mark by customers will help to inform the tribunal's view in this respect. But the process must not be taken to the point where consideration of a distinctive or dominant element is allowed to supplant an appraisal of the totality of the mark. In this particular case, if the opponent is able to demonstrate that reliance is placed on the surname WESTWOOD that is something I would need to bear in mind but I must not approach the matter as if the mark was the surname alone.

45. The evidence relied on by the opponent to support her contention regarding the particular recognition accorded to WESTWOOD is threefold consisting of Mr D'Amario's claim in his second declaration; references to WESTWOOD in Exhibits A, G and J; and the statements of those individuals who have supplied supporting declarations or witness statements.

46. Mr D'Amario's claim appears to have arisen in response to an observation in the applicants' evidence. The claim did not appear in the statement of grounds or the opponent's evidence in chief both of which refer almost exclusively to the opponent's position being based

on the full name VIVIENNE WESTWOOD. Where the 'brochure presentation', newspaper and magazine articles (Exhibits A, G and J) employ the surname alone it is clear from the context that reference is being made to Vivienne Westwood. The full name identifier is used to preface or explain what follows. The third category relied on are the individuals who are or have been employed in various capacities by Vivienne Westwood or are otherwise employed in the fashion industry. This evidence suffers from a number of weaknesses - the statements are in near identical terms to the effect that "From my own knowledge, I know that the trade mark is very often used just as WESTWOOD alone without the word VIVIENNE and that, when so used, I immediately associate it with the goods of Vivienne Westwood S.r.l.". Individuals employed within the Vivienne Westwood organisation can scarcely be said to be independent observers and their views may reflect usage within the business rather than outside. The other witnesses from the wider fashion industry do not explain the basis for their views, the circumstances in which WESTWOOD is used on its own or their reasons for believing that the average consumer would be of the same view. There is no direct evidence from consumers themselves on the point. More importantly it seems to me that the primary evidence, in the sense of material emanating from the opponent (marketing, promotional and packaging items etc) strongly suggests that customers are presented with the full name (and with the orb device).

47. My conclusions in relation to the use and distinctive character of the opponent's mark are as follows:

- the main use on company literature, promotional material, invoices etc has been of the composite mark
- the name VIVIENNE WESTWOOD, being both a prominent element of the mark and the name of the designer is a distinctive and dominant component of the mark
- there is some evidence that the surname WESTWOOD attracts attention and has achieved recognition in its own right but on the material before me it does not displace my finding that it is the full name within the mark that is likely to be recognised as the primary distinctive component
- the mark as a whole has a high degree of distinctive character and recognition
- that recognition was originally in respect of haute couture women's clothing but has extended over the years to include men's clothing (the MAN range) and a younger audience (the ANGLOMANIA range)
- the Vivienne Westwood range also now includes a prêt à porter range (RED LABEL) and Ms May drew my attention to Exhibit F which contains a Newsweek article from 1993 recording that Vivienne Westwood has designed a mass market clothing line for Littlewoods stores.

Applicants' use of their mark

48. I have already recorded the substance of Mr Shafi's evidence. The applicants' business is a reasonably long standing one said to date back to 1980. Apart from some early labelling there is little said about that early trade but Mr Shafi documents and quantifies the trade from 1995 onwards. The opponent has not challenged any aspect of this evidence. But Ms May suggested that it should be treated with some care because the use shown was not reflected in the specification applied for. The use appears to have been almost exclusively in children's schoolwear and sportswear whereas the specification applied for goes much wider. Ms May's point was that I must bear in mind notional fair use across the full breadth of the applied for specification. I will come back to this and Ms May's other submissions when I consider the likelihood of confusion. For present purposes I accept that the applicants have an established trade under the mark at issue in the limited range of goods described by Mr Shafi. It is true that the precise form of the mark has varied somewhat over the years but it seems that the applicants have settled on the form applied for in recent years (and indeed it has been used since at least 1981).

Similarity of goods

49. The specification of the opponent's earlier trade mark (CTM No 976183) covers a number of Classes. In particular it includes 'clothing, footwear and headgear' in Class 25 which are precisely the goods of the subject application. On a notional consideration of the matter, therefore, identical goods are involved. I will come to the applicants' actual use a little later on but Ms May rightly emphasised that I must bear in mind what it will be open to the applicants to do if they secure a registration and not simply what they have done in the past.

Similarity of marks

50. For convenience the marks at issue are

Applicants' mark



Opponent's mark



I am required to consider the matter on the basis of visual, aural and conceptual similarities bearing in mind the distinctive and dominant components of the marks and judging the matter through the eyes of the average consumer.

51. It was held in REACT and Device Trade Mark [1999] RPC 529 that a "majority of the public rely primarily on visual means to identify the trade origin of clothing although I would

not go so far as to say that aural means of identification are not relied upon". I have no reason for adopting a different approach here. In fact the relatively high price of haute couture clothing is likely to mean that in that particular segment of the market consumers will take particular care and are more rather than less likely to purchase on the basis of a visual inspection of the goods.

52. I have already set out my views on the elements that make up the opponent's mark, their relative importance within the totality of the mark and the impact of the opponent's use.

53. The applicants' mark is also a composite one consisting primarily of a shield device containing two Ws and the word WESTWOOD, the whole being set against a background of horizontal lines. The applicants claim the colours red, yellow and white. The representation used above is taken from the application form.

54. Ms May suggested that the effect of presenting the letters within, and shaped to, the curved form of the shield device was to render them that much closer to letter Vs and that this effect was further enhanced by the fact that the middle ascenders of the letters are noticeably shortened. Against that the letters are in my view rather more likely to be seen as picking up the Ws of WESTWOOD in the two colour form in which the word and the shield are presented. So far as the word itself is concerned it would normally be read as the single word WESTWOOD and not WEST WOOD despite the contrasting colours of the background.

55. Visually the marks are readily distinguishable on a side by side comparison but the ECJ cases caution that consumers rarely have the chance to make comparisons in this way and do not usually pause to analyse marks. Marks are usually encountered sequentially not concurrently. The words VIVIENNE WESTWOOD and WESTWOOD would, in my view, be key elements that the average consumer would remember and would be likely to use in oral references to the marks. Aural and conceptual similarities also, therefore, turn on recognition of the name/surname. This is not of course to say that other presentational dissimilarities will go unremarked. I should also say at this point that Ms May asked me to bear in mind that the opponent also uses a number of device marks other than the one that is present in CTM No 976183. Her point was that the public would be used to seeing the VIVIENNE WESTWOOD name associated with a variety of device marks and might consider the applicants' device as just another variant. It seems to me that that argument is flawed to the extent that the Section 5(2) objection is based upon a particular earlier trade mark. I cannot bring into the consideration other marks or elements of marks whether they exist in registered or unregistered form.

Likelihood of confusion

56. This is a case which, in my view, turns not so much on whether there is likely to be direct confusion between the respective marks but whether the average consumer will make an association between them because of the elements VIVIENNE WESTWOOD and WESTWOOD and, if so, what the nature of that association will be. The guidance from the ECJ cases (Marca Mode and Canon) referred to above is that the mere fact that the earlier trade mark has a reputation is not sufficient to establish a likelihood of confusion simply because there is a likelihood of association in the strict sense. The mere fact that one mark may

bring the other mark to mind is not enough unless the association results in confusion as to origin. That is to say the public is wrongly led to believe that goods offered under the later mark come from the same or an economically linked undertaking.

57. Given the overall presentation of the respective marks before me I have not found this an easy question to answer. I have little doubt that the VIVIENNE WESTWOOD name is widely known. I note too that she has operated in areas of the fashion clothing market (the Littlewoods lines for instance, the Red Label collection and the Anglomania collection aimed at younger people) that extend beyond haute couture and are available for purchase from retail outlets across the country. The effect of that must be that the parties' marks are, at the margins of the respective businesses, exposed to an overlapping range of customers. It was held in CODAS Trade mark [2001] RPC 240 that "the mere fact that there has been honest concurrent use is not a defence which in itself will save an application, but it is one of the "relevant" factors which should be taken into account in determining whether there is a likelihood of confusion". It is not suggested that the applicants' actual trade has caused or is likely to result in confusion with the VIVIENNE WESTWOOD mark. I have, therefore, come to the view that there is no likelihood of confusion on the basis of the trade the applicants have established in their evidence.

58. In reaching the above view I have not lost sight of the point made in Ms May's skeleton argument and in submissions at the hearing that "the applicant will frequently use the word WESTWOOD alone and without the WW prefix and/or the shield device". I think that is overstating the position. The applicants have been candid in showing (Exhibit ZS1) the various forms of their mark that have been used since 1980. Overwhelmingly the mark used is the one applied for or with substantially the same elements. There are just a few examples (mainly from the early 1980s) where WESTWOOD is used on its own. There are also instances where Westwood is used in narrative text but only in circumstances where the composite mark is shown prominently as the primary identifier. There is also a more fundamental point. The mark applied for is the composite one shown. Registration would allow the applicants normal and fair use of that mark. I should not approach the matter on the assumption that they will use WESTWOOD on its own or speculate on what the consequences would be if they did.

59. The applicants have achieved some limited success but there remains the fact that their specification is cast in broad terms. I am not persuaded that they are entitled to the full breadth of the specification. As currently worded it would allow them to enter other areas of the clothing trade including haute couture and designer wear. I am of the view that, given the reputation attaching to the VIVIENNE WESTWOOD mark, the public would be likely to consider that goods offered under the applicants' mark emanated from the opponent or represented a development of the opponent's trade. That being so the opposition succeeds under Section 5(2) save for the restricted category of goods referred to above. I will deal with the consequences of this after briefly disposing of the other grounds of opposition.

60. The Section 5(3) ground was not pursued at the hearing. Section 5(4)(a) 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
- (b)

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.”

61. The conventional test for determining whether an opponent has succeeded under this Section has been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC sitting as the Appointed Person, in *WILD CHILD Trade Mark* [1998] RPC 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

- (1) that the opponent’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 applicants (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the applicants are goods or services of the opponent; and
- (3) that the opponent has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the applicants’ misrepresentation.

62. Having taken the opponent’s reputation into account in my consideration of the Section 5(2) objection, the Section 5(4)(a) ground did not seem to me to add anything to the opponent’s case save that Ms May’s skeleton argument and submissions addressed the question as to whether reputation/goodwill subsisted in relation to the surname WESTWOOD in addition to the designer’s full name. I gave a preliminary indication at the hearing that in my view the claim in relation to WESTWOOD was not apparent from the statement of grounds. Ms May accepted that it had not been separately pleaded but invited me to approach the matter on the basis that such a claim was in effect subsumed within, and part of, the claim in relation to VIVIENNE WESTWOOD. She suggested that there was no prejudice to the applicants in this respect because the point had been addressed in the evidence.

63. I do not accept those submissions for the following reasons. It is not only the opponent’s statement of grounds that makes no mention of a claim based on WESTWOOD alone. Mr D’Amario’s evidence in chief also refers repeatedly and consistently to the opponent’s claims based on the name VIVIENNE WESTWOOD. Only in the last paragraph of his first declaration is it suggested that “The VIVIENNE WESTWOOD trade mark is in fact so well known that I believe that anyone seeing the name Westwood used in relation to clothing or accessories would believe there to be a connection with the famous fashion designer ...” Even that assertion includes no specific claim as to the opponent’s use of WESTWOOD or recognition of that element. It is true that the opponent’s reply evidence touched on usage of WESTWOOD but that appears to have resulted from an observation by Mr Shafi that “There is nothing in the opponent’s evidence to suggest that they have ever used WESTWOOD alone as a trade mark in relation to clothing”. There is, of course, no reason why goodwill cannot

subsist under a number of different signs but if the opponent believed that separate claims arose it behoved them to raise the point in their statement of grounds or to seek an appropriate amendment. It cannot simply be said to exist as a result of the generality of the claim in relation to the name VIVIENNE WESTWOOD. I do not propose to consider this Section 5(4)(a) ground further.

64. The final ground is under Section 3(6). The provision reads:

"3.-(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith."

The objection was put in the following terms in the opponent's statement of grounds:

"By reason of the above or otherwise, application No 2191548 has been made in bad faith and should therefore be refused in accordance with the provisions of Section 3(6) of the Trade Marks Act 1994."

65. I can see nothing in the preceding paragraphs of the statement of grounds that gives a clue as to the nature of the objection save the references to the opponent's own reputation.

66. In her skeleton argument Ms May put the matter as follows:

"On the evidence, at best the applicant can only be said to have an intention to use the Trade Mark in relation to children's schoolwear. There is no evidence of any intention to use it in relation to other kinds of clothing, footwear or headgear.

Further, at all times the applicant must have been aware of the opponent and its use of the word Westwood in relation to clothing, footwear and headgear."

67. At the hearing it appeared to be the first of the above objections that the opponent wished to pursue. However the applicants could have had no reason to suppose or infer that they faced such an objection not least because they have a long trading history and may well have the intention to expand it. There have now been a number of reported cases where the need for fully particularised pleadings has been emphasised. In addition to WILD CHILD (referenced above), there are Julian Higgins' Trade Mark Application, Club Europe Trade Mark and Demon Ale Trade Mark reported in [2000] RPC at pages 321, 329 and 345 respectively. In the light of the guidance from these cases the opponent's objection does not get off the ground. However further consideration of the matter is academic in the light of my above findings and the effect on the applicants' specification.

68. If within 28 days of the expiry of the appeal period the applicants file a Form TM21 restricting their specification to "children's school clothing and children's sports clothing" the application will be allowed to proceed to registration accordingly. If they fail to file a Form TM21 restricting their specification the application will be refused in its entirety.

69. In the circumstances of this case with both sides having achieved a measure of success I make no order as to costs. If, however, the applicants do not amend their application on the

above basis and the application is refused in its entirety the opponent will be free to lodge an appropriate claim for costs.

Dated this 22nd day of March 2002

**M REYNOLDS
For the Registrar
the Comptroller-General**

OPPONENT'S EARLIER TRADE MARK

NO	MARK	CLASS	GOODS
CTM 976183		9	Spectacles; sunglasses; spectacles cases; spectacle mounts; spectacle glasses; spectacle frames; pince-nez; chains for spectacles; cords for spectacles; scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighting, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus.
		14	Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments.
		18	Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.
		24	Textiles and textile goods, not included in other classes; bed and table covers.
		25	Clothing, footwear, headgear.