

O-135-04

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2301974
BY TOMMY HILFIGER LICENSING INC
TO REGISTER THE TRADE MARK TOMMY IN CLASS 14**

AND

**IN THE MATTER OF OPPOSITION No. 91177
BY ETAM PLC**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No. 2301974
by Tommy Hilfiger Licensing Inc
to register the Trade Mark TOMMY in Class 14**

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**IN THE MATTER OF Opposition No. 91177
by Etam Plc**

Background

1. On 30 May 2002 Tommy Hilfiger Licensing Inc applied to register the mark TOMMY for “Watches, clocks, watch straps, parts and fittings for all of the aforesaid goods; jewellery; articles made of precious metals and their alloys or coated therewith; precious and semi-precious stones; pearls”. (Class 14 of the International Classification system). The application is numbered 2301974.

2. On 23 October 2002 Etam Plc filed notice of opposition to this application. They are the proprietors of the trade mark registrations details of which appear in the Annex to this decision. They raise objections under the following heads:

- (i) under Section 5(2)(b) having regard to the similarity of the applied for mark to the marks of Nos. 1254427 (Class 14), 2222627 (including Class 14) and 2243425 (Class 35) and the identity and/or similarity of the respective sets of goods and services which it is said combine to create a likelihood of confusion. Reference is also made to similarity of goods in Classes 9, 18, 24, 25 and 28 covered by the other marks relied on which, taken with the marks, is again said to create a likelihood of confusion;
- (ii) under Section 5(3) having regard to the opponents’ reputation (unspecified at this point), dissimilar goods and the adverse consequences referred to in the Section;
- (iii) under Section 5(4)(a), and in particular the law of passing off having regard to the opponents’ use of one or more of the trade marks in relation to the sale of Class 14 goods since at least 1984.

3. The applicants filed a counterstatement denying the above grounds and referring me to a decision of another Registry Hearing Officer (under No. O/158/02) in an action between the parties where it was held that forenames may be easily distinguished by the public particularly where one is a very well known male forename (TOMMY) and the other obviously female (TAMMY).

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

5. Both sides filed evidence. Neither side has asked to be heard. Written submissions have been received from Baker & McKenzie on behalf of the applicants and from Dechert on behalf of the opponents.

Opponents' evidence

6. The opponents filed a witness statement by Anthony Indyk, their Merchandise Director. He describes the history of the TAMMY brand as follows:

“The Company conceived the TAMMY brand some time in 1971 or 1972. At that stage the Company was one of the top UK womens wear retailers and wished to strengthen its success in the female sector by selling a range of girlsweare to attract the mother and daughter. The ETAM brand was very well known and the Company wanted a girl’s name that was complementary to the ETAM brand. The name TAMMY was chosen because the Company took the “E” off ETAM, left “TAM” and added “MY” which produced the well known girl’s name of “Tammy”, The TAMMY brand was formally launched in 1972, initially through departments within Etam stores. The first independent stores opened in 1974 and then increasingly as TAMMY departments within Etam stores. Attached marked Exhibit 1 is an article which appeared in the Draper Record on 30 March 1974. Clothing with the brand name of TAMMY was sold under the banner of TAMMY GIRL up until 1990, when the word “Girl” was dropped, leaving the brand TAMMY. The trade mark TAMMY was first used in relation to watches, clocks and jewellery (“the Products”) in 1980.”

7. The TAMMY range of goods is aimed at girls aged from 8 to 15 years. The company has over 200 branches throughout the UK. TAMMY products are available in 176 of the Etam stores, in 14 independent Tammy stores and in 14 Tammy concessions in other stores. They have also been available in the Freemans catalogue and more recently in the Argos, Choice and Great Universal Stores catalogues.

8. Initially, it seems that the main products sold under the TAMMY or TAMMY GIRL marks were clothing but the trade now extends to cosmetics, girls’ accessories, including jewellery and watches, bags, footwear, stationery and novelty items. Exhibit 4 contains a carrier bag, labels and swing tickets showing the mark. Most of the items appear to relate to clothing. Where accessories are mentioned the exhibit either refers to footwear or is non-specific about the nature of the accessory.

9. Turnover is given as follows:

Year	Turnover (£)
1991	53,835,000
1992	56,917,000

1993	63,237,000
1994	61,241,567
1995	64,118,006
1996	65,134,813
1997	72,506,091
1998	68,654,968
1999	85,974,192

	UK (£)	Mail Order (£)	Others (£)
2000	86,700,000	1,000,000	2,000,000
2001	89,647,000	1,000,000	5,900,000
2002	91,000,000	2,100,000	8,500,000

10. Promotion of the products takes place in magazines, the national and regional press, via consumer give-aways and charitable promotions. The approximate marketing spend is given as follows:

Year	Advertising Spend (£)
1998 (PR Budget and advertising only)	100,000
1999 (PR Budget and advertising only)	150,000
2000 (Total marketing spend)	813,800
2001 (Total marketing spend)	872,000
2002 (Total marketing spend)	870,000

Examples of promotional materials are shown at Exhibit 5.

11. Turnover attributable to watches, clocks and jewellery is given as:

Year	Turnover (£000)
1995	2,000
1996	2,473
1997	1,515
1998	1,378
1999	1,426
2000	1,706
2001	834
2002	353

12. Approximately 2% of turnover has been spent on marketing these products since 1995. Examples of the products are contained in Exhibit 6. Examples of press coverage of the

company's products are shown at Exhibit 7 from a range of national and local newspapers and magazines. Copies of unsolicited press coverage referring to the TAMMY brand are shown at Exhibit 8.

13. Mr Indyk goes on to say that:

“In May 1987, the company acquired Gladesmore Holdings Ltd, trading as Peter Brown. This business traded in menswear and boyswear. The trade mark “TOMMY BOY” was first registered in 1989 and merchandise was first sold under that trade mark in 1993. The trade mark TOMMY BOY was assigned to Tommy Boy Music Inc. on 3 April 1997. The initial turnover figures for products sold under the trade mark “TOMMY BOY” in the year 1993/4 was £65,000. The subsequent turnover figure for products sold under the trade mark during the year 1994/5 was £60,000.”

Goods were sold in a wide variety of locations throughout the UK. Photocopies of garments branded TOMMY BOY and sold during the above mentioned period are shown at Exhibit 9.

Applicants' evidence

14. The applicants filed a witness statement by Jade H J Huang, Vice President of Tommy Hilfiger Licensing Inc. She introduces her evidence in the following terms:

“Although TH has been particularly successful in the United Kingdom with its range of men's and women's clothing, accessories and fragrances, I have described the history and international structure of TH below, in order to show the extensive reputation of the TOMMY trade mark both in the UK and around the world. It also serves as background information on the growth of the TOMMY HILFIGER brand. I shall then give a detailed account of the UK launch of the brand and its subsequent growth into a leading fashion and fragrance brand in the UK.”

15. There follows a detailed review of the Tommy Hilfiger business much of which is directed at the worldwide position and, even within that part of the witness statement dealing with the UK, is not well focussed in terms of the goods at issue. I do not, therefore, propose to record what has been said.

16. In so far as the evidence addresses the goods of relevance to this application Ms Huang says, under the heading of 'Tommy Hilfiger Accessories':

“TH first launched a range of accessories in Autumn 1993 with a line of belts and other small leather goods. The range of TH branded accessories has now expanded greatly to include jewellery (introduced Spring 1999) and men's and women's watches (introduced Spring 2001). Accessories form an important part of the TH brand, not only complementing the core products of clothing and fragrances but making the TOMMY and TOMMY HILFIGER marks represent an entire “look” and lifestyle which consumers are able to experience. Sales of accessories have been strong since their launch such that they now make an important contribution to total revenue figures in the UK and

worldwide. Some examples of TH's watches and jewellery products and advertisements therefor are attached at Exhibit "JH6".

17. The exhibit referred to (JH6) shows a range of watches under a number of brands (TOMMY HILFIGER, TOMMY, a Tommy Hilfiger signature mark, a device mark etc). I note that one of the early advertisements has the text 'launch collection Spring 2001' and dollar pricing on the associated products. The later catalogues similarly carry dollar prices. It is not clear whether these catalogues circulated in the UK. The result is that I find little in the applicants' evidence that is of assistance to this action. I should just add that the opponents filed a witness statement by Stephen Weeks which is in effect a critique of the applicants' evidence. In the light of my above comments I do not need to summarise this evidence.

Decision

Section 5(2)

18. Section 5(2) reads as follows:

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

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
- (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."

Sub-paragraph (b) applies here.

19. I take into account the well established 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] RPC 117, and *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77.

20. It will be apparent from the above review of the pleadings that the opponents put their Section 5(2) case on a number of alternative footings. In the absence of explanation I am unable to accept that the goods relied on in Classes 9, 18, 24, 25 and 28 are similar to the Class 14 goods applied for. I note in any case that the opponents make these goods the basis for an alternative pleading under Section 5(3). It is reasonable to infer that they see their best case as resting on Nos. 1254427, 2222627 and 2243425. The first of these registrations is for the word TAMMY solus. The other two are for TAMMY in an elliptical border. The border seems to me to make but a marginal contribution to the distinctive character of the marks. For convenience I set out

below the respective Class 14 specifications of the applied for mark and the opponents' registration No. 2222627.

Applicants' goods	Opponents' goods
Watches, clocks, watch straps, parts and fittings for all of the aforesaid goods; jewellery; articles made of precious metals and their alloys or coated therewith; precious and semi-precious stones; pearls.	Jewellery and imitation jewellery; ornamental articles made of precious metal; horological and chronometric instruments; clocks and watches; smokers articles made of precious metal.

21. It is apparent that the specifications contain goods which are identical and described in identical terms. Other items such as precious and semi-precious stones and pearls have no exact equivalent in terms of the words used by the opponents to describe their goods but I regard such items as being closely similar to jewellery. Watch straps and parts and fittings for watches and clocks must also be considered similar to the goods they relate to. In short the applicants' goods are either identical or closely similar to those of the opponents.

22. For the sake of completeness I should say that the opponents' registration No. 2243425 which relates to a mail order catalogue service does not appear to place them in a more advantageous position.

23. The opponents' written submissions suggest that the trade mark TAMMY is very similar to the mark applied for and that, at a glance, one could fail to spot the difference. They add that "orally they may in some cases be identical".

24. The applicants for their part have referred me in particular to the decision, O/158/02, of another Registry Hearing Officer in the earlier proceedings between the parties involving Etam Plc's opposition to the mark TOMMY GIRL (again the opponents' mark was TAMMY and identical or very similar goods were involved). The Hearing Officer had considered the *BULER Trade Mark* case [1966] RPC 141 where Buckley J had commented on the importance of spelling in distinguishing between surnames. Although that was a case under the preceding law the Hearing Officer held that the judge's comments were equally applicable now and that the same considerations "would extend to forenames particularly where one is a very well known male forename and the other obviously female".

25. Nevertheless, I propose to consider the marks afresh recognising too that the applied for mark in the earlier proceedings was not simply TOMMY but TOMMY GIRL. According to the authorities the visual, aural and conceptual similarities of the marks must be assessed by reference to their overall impressions bearing in mind their distinctive and dominant components (*Sabel v Puma*, paragraph 23). Distinctive character may be either inherent or acquired (*Sabel v Puma*, paragraph 24). The matter must be judged through the eyes of the average consumer who is deemed to be reasonably well informed, circumspect and observant (*Lloyd Schuhfabrik v Klijsen*, paragraph 27).

26. The opponents concede that Tammy is a well known girl's name (paragraph 3 of Mr Indyk's evidence). It may be said to enjoy no more than an average degree of distinctive character based

on its inherent characteristics. However, on the basis of the information supplied and the high profile enjoyed by the brand (with a strong high street presence), I believe it is reasonable to suppose that use has improved the mark's position and that, accordingly, it can claim an enhanced degree of distinctive character at least in relation to clothing. The position in relation to watches, clocks and jewellery is much less certain. I note that sales have been on a declining trend with a noticeable fall off in the years since 2000.

27. Turning to a comparison of the marks, they have obvious points of visual similarity in terms of length and construction and with only the second letter being different. There are aural similarities too but on the whole I am inclined to think that the ear is reasonably well attuned to differentiating between names, particularly well known ones, on the basis of what might be relatively small differences if they existed in the context of invented words. It is the difference between male and female forenames that is at the heart of this issue.

28. I have hesitated over the outcome largely because allowance must be made for a variety of presentational formats. It so happens that the usage shown in the parties' evidence (though the opponents' is thin when it comes to the goods at issue) is largely in plain block capitals where the differences between TAMMY and TOMMY, would not go unnoticed. But normal and fair use would also include lower case lettering and use in a variety of typefaces. I also bear in mind that, where use is on, as distinct from in relation to, the goods brand names may be somewhat less easy to read due to small lettering on, particularly, watch faces. That circumstance of trade may be offset to a greater or lesser extent by the presence of other promotional matter at the point of sale and the fact that consumers are apt to treat the purchase of watches and items of jewellery with at least a modicum of care. Moreover, the examples of Class 14 goods in Exhibit 6 to Mr Indyk's witness statement seem to me to exemplify how such goods will typically be presented to customers. Various rings and small jewellery items are placed on or attached to a card which clearly shows the mark TAMMY in the elliptical device form. A girl's watch is presented in a transparent display/presentation container which again clearly shows the mark. A 'heart' clock also has the TAMMY mark on both the clockface and container.

29. Likelihood of confusion is a matter of global appreciation taking all relevant factors into account. With the above principal considerations in mind I have come to the view that the net effect of identity of goods and the similarities and differences between the marks is that there is no likelihood of confusion. The opposition thus fails under Section 5(2)(b).

Section 5(3)

30. This is raised as an alternative ground of objection in relation to those of the opponents' registrations which contain dissimilar goods.

31. The scope of the Section has been considered in a number of cases notably *General Motors Corp. v Yplon SA (Chevy)* [1999] ETMR 122 and [2000] RPC 572, *Premier Brands UK Limited v Typhoon Europe Limited (Typhoon)* [2000] ETMR 1071, *Daimler Chrysler v Alavi (Merc)* 2001 [RPC] 42 and *C.A. Sheimer (M) Sdn Bhd's TM Application (Visa)* 2000 RPC 484.

32. I accept that the opponents can claim the necessary underpinning reputation at least in respect of their clothing business. The applicants' goods are dissimilar to clothing. I have held in relation to Section 5(2) that there is no likelihood of confusion between the marks (though I accept that it is well established that Section 5(3) is not dependent on confusion -see *Merc* at paragraph 85).

33. The opponents expressed their pleaded ground in terms which largely replicate the wording of the Act. Their written submissions refer to the applicants' mark being detrimental to the distinctive character and repute of their earlier trade marks and the danger of 'blurring' (by dilution) and inhibition. They go on to submit as follows:

“It is important to bear in mind the very substantial reputation of the mark as, the more well known a mark, the easier it is for a proprietor to establish detriment to that mark: *Premier Brands UK Ltd v Typhoon Europe Ltd* [2000] FSR 767 at page 789. This is a case where the mark is very well known to the sector of the market and there is likely to be detriment if a similar mark is used in a related field. Further, the opponent has not established any reputation in the mark applied for in relation to the goods covered by the application in the United Kingdom. In contrast, the applicant has submitted evidence to establish that the trade mark “TAMMY” has been used extensively in relation to the goods in the United Kingdom and although the total turnover figures relating to the types of products covered by Class 14 are not great in recent years, it must be remembered that each individual item will often cost less than £5.”

34. As I am of the view that the net effect of the similarities and differences between the respective marks does not result in a likelihood of confusion in relation to identical goods I am unable to accept the case for detriment to distinctive character or repute in relation to goods that are not similar (albeit that they are in the fashion field and, therefore, by no means at the outer reaches of dissimilarity) in the absence of persuasive reasons as to why this should be so.

35. I am also not persuaded that this is a case where the issue of 'inhibition' needs to be considered. The reference in the opponents' written submissions is unexplained but derives, I believe, from a decision of the Appointed Person in *Loaded Trade Mark*, O/455/00. If that is so, the circumstances of this case seem to me to be quite different.

36. Finally, the opponents refer in the above passage to their existing trade in relation to Class 14 goods. However, as their pleaded case is in relation to dissimilar goods this aspect of their use is not relevant to the Section 5(3) case notwithstanding the fact that the decisions of the ECJ in *Davidoff & Cie SA and Gofkid Ltd*, C-292/00, and *Adidas-Salomon AG and Fitnessworld Trading Ltd*, C-408/01, now confirm that the scope of this provision may also extend to identical and similar goods where a claim to this effect forms part of the pleaded case.

Section 5(4)(a)

37. The requirements for this ground of opposition are set out 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 opponents' 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 opponents, and
- (3) that the opponents have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the applicants' misrepresentation.

38. The ground has been pleaded on the basis of:

“..... the goodwill and reputation of the opponent in the Trade Marks acquired through use. The opponent has been using one or more of the Trade Marks in the United Kingdom on and in relation to Class 14 goods sold in the UK since at least 1984. As a result of this use, the opponent has built up substantial goodwill and reputation in the Trade Marks in the United Kingdom.”

I take the reference to 'trade marks' to be a reference back to the marks specifically identified in the grounds of opposition and set out in the Annex to this decision. On that basis I can see no basis for finding a misrepresentation for Section 5(4)(a) (passing off) purposes when the opponents have failed to establish a likelihood of confusion under Section 5(2)(b).

39. However, a further issue is raised in Mr Indyk's evidence regarding use of the mark TOMMY BOY as a result of the opponents' acquisition of Gladesmore Holdings Ltd. I do not think it can fairly be said that this matter was clearly and properly pleaded or the subject of a formal request to amend the case as originally pleaded.

40. There is in any case scant evidence in substantiation of trade under the mark TOMMY BOY. Turnover figures are given for two years only (1993/4 and 1994/5) at levels (£65,000 and £60,000) which can scarcely have made a significant impact given the relatively wide spread of towns and cities in which goods are said to have been sold under the mark. The trade was also exclusively in menswear and boyswear it would seem. The mark was assigned to Tommy Boy Music Inc. in 1997 but no trading information is given for the period after 1994/5 and no claim or submission has been made in respect of residual goodwill. There is just a single exhibit in support of the claim – this being two photocopied pages showing the mark TOMMY BOY JEANS on jeans or shorts. If or to the extent that the opponents rely on this usage I find it wholly inadequate to support a claim under Section 5(4)(a).

41. The applicants have thus been successful and are entitled to a contribution towards their costs. For the reasons given above, I have not found the applicants' own evidence to be well directed in terms of the issues at the heart of this case. I see no reason why they should benefit from a cost award in respect of this evidence. The applicants are, however, entitled to an award

in respect of their appraisal of the opponents' evidence and their written submissions. Taking all relevant factors into account I order the opponents to pay the applicants the sum of £1200. 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 14th day of May 2004

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

ANNEX

Opponents' earlier trade marks:

No.	Mark	Class	Specification
1254427	TAMMY	14	Jewellery, chronometric instruments.
2111943	TAMMY	16	Printed matter; printed publications; books; newspapers, comics, magazines and periodical publications; posters and prints; stationery; bookbinding requisites; photographs; bags; calendars, planners, diaries and organisers; printed advertising materials; playing cards; stickers; decalcomania; labels; wrapping and packaging materials; artists' materials.
1254428	TAMMY	18	Articles made of leather or of imitation leather; bags and cases; all included in Class 18; skins and hides; trunks (luggage) and umbrellas.
1019673	TAMMY	25	Articles of clothing for women and girls; but not including headwear.
2032089	TAMMY	03	Cosmetics; soap; perfumery; essential oils; preparations for the care and styling of hair; shampoos and conditioners; hair lotions; deodorants for personal use; anti-perspirants; toilet preparations and waters; preparations for the care of the skin, scalp and body; sun tanning preparations; preparations for reinforcing and strengthening nails; preparations for use in the bath and shower; preparations for toning the body; aftershaves; creams, gels, powders, talcum powders and lotions; shower foams; dentifrices; depilatories; cleansing masks for the face; eye make-up remover; nail polish and varnish remover; cuticle lotions and nail revitalising lotions; all the aforesaid being non-medicated.
2222627		09 14	Spectacles, sunglasses and frames for the aforesaid goods; cases for spectacles and sunglasses. Jewellery and imitation jewellery;

		<p>18 ornamental articles made of precious metal; horological and chronometric instruments; clocks and watches; smokers articles made of precious metal.</p> <p>24 Articles made of leather or of imitation leather; bags and cases; toiletry bags; purses, wallets; articles made of hides; trunks (luggage) and umbrellas.</p> <p>25 Bed linen, bed covers, duvets, duvet covers, bed quilts, bed sheets, pillow cases, pillow shams, bed blankets, eiderdowns, sleeping bags and sleeping sacks, cases for mattresses and for sleeping garments; cloth labels; bath linen, towels, face cloths, covers for toilet seats; table clothes, table napkins, table covers, table mats; curtains and draperies, all made of textile materials or of plastics.</p> <p>28 Articles of clothing; footwear; headgear.</p> <p>28 Toys, games and playthings; toy action figures, toy vehicles, toy building structures and building tracks; dolls furniture accessories; parts and fittings for all the aforesaid goods; but not including any such goods in the form of dolls, dolls clothing and accessories for dolls.</p>
2223633		<p>03 Perfume, toilet water; gels and salts for the bath and the shower; toilet soaps, body deodorants; talcum powder; cosmetics; creams, milks, lotions, gels and powders for the face, the body and the hands; sun care preparations; make-up preparations; preparations for reinforcing and strengthening nails; nail care preparations; nail polish, nail varnish; nail polish and nail varnish remover; shampoos; gels, sprays, mousses and balms for hair styling and hair care; hair lacquers, hair colouring and hair decolorant preparations; permanent waving and curling preparations; essential oils for personal</p>

			use; dentifrices.
2233981		16 30	Printed matter; printed publications; books; newspapers, comics; magazines and periodical publications; posters and prints; stationery; bookbinding requisites; photographs; bags; calendars, planners, diaries and organisers; printed advertising materials; playing cards; stickers; decalcomania; labels; wrapping and packaging materials; artists' materials. Non-medicated confectionery; biscuits (other than biscuits for animals); chocolate, chocolates; candy; chewing gum, bubble gum.
2243425		35	The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase these goods from a clothing and accessories catalogue by mail order; consultancy services relating to the acquisition of goods and services.
2114838	TMY T.M.Y.	25	Articles of clothing, footwear, headgear.