

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 20457617  
IN THE NAME OF WILHELM KAIMANN**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NUMBER 45847 IN THE NAME OF  
LA CHEMISE LACOSTE**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF application No 20457617**

**In the name of Wilhelm Kaimann**

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**AND**

**IN THE MATTER OF opposition thereto**

**under number 45847 in the name of La Chemise Lacoste**

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**Background**

On 29 November 1995 Wilhelm Kaimann of Hansastrasse 2-5, D-33161 Hoevelhof, Germany, applied to register a trade mark in Classes 6, 11, 17, 19 and 20 in respect of the following goods:

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**Class 6** Steel and copper pipes; fuel oil tanks of steel; parts and fittings, all made wholly or principally of metal and all for use in the erection and installation of heating and air conditioning apparatus and devices; suspension means, positioning brackets, holders for fitment on window sills, spacer members, covering strips and lateral screens all made wholly or principally of metal and all being adapted for use with radiators, heating circuit distributors, ventilating devices, air humidifiers, central heating radiators, air deodorising devices or air ionizers.

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**Class 11** Heating boilers of steel or cast iron; hot water supply tanks; gas burners; heating and air conditioning apparatus and devices; radiators, central heating radiators; heated towel rails; heating circuit distributors; air cooling devices; ventilating devices; air humidifiers, air humidifiers for central heating radiators; air deodorising devices; air ionizers.

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**Class 17** Insulating materials; insulating materials for thermal insulation and for use in or with sanitary, heating, air conditioning and refrigerating installations

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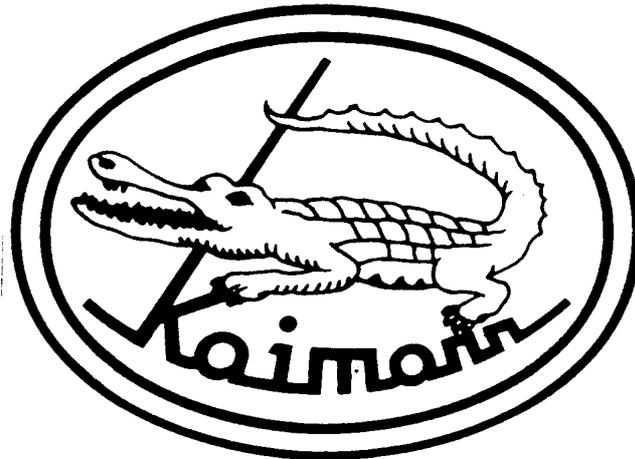
**Class 19** Parts and fittings, all made wholly or principally of non-metallic material and all for use in the erection and installation of heating and air conditioning apparatus and devices; suspension means, positioning brackets, holders for fitment on window sills, spacer members, covering strips and lateral screens all made wholly or principally of non-metallic material and all being adapted for use with radiators, heating circuit distributors, ventilating devices, air humidifiers, central heating radiators, air deodorising devices or air ionizers.

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**Class 20** Fuel oil tanks of synthetic or plastics materials

The mark is as follows:



On 6 November 1996 La Chemise Lacoste filed notice of opposition to this application. The grounds of opposition are in summary:-

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1. The opponents are the proprietors of a number of registered trade marks in the United Kingdom all of which are or have as a principal feature a device of Crocodile, supine and with its tail bent around its back. Details of these registrations can be found as an annex to this decision.
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  2. The opponents have a massive reputation and goodwill in the Crocodile device. It is one of the foremost, world recognized brands for a wide variety of high quality goods centred on the clothing trade but extending widely over almost all areas of commerce and use of the opposed mark would damage their reputation in the Crocodile device
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  3. The opponents also say that use by the applicants would take unfair advantage of the distinctive character or reputation of their Crocodile device.
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  4. The opponents also say that use by the applicants would be prevented in this country as trespassing upon the goodwill of the opponents.
  5. The opponents also say that the opposed mark was adopted in bad faith

40 The opponents request that the Registrar refuse the registration.

The applicants for registration filed a counterstatement in which they concede that the opponents have a registration in one class for which they seek registration, Class 20, but say that the goods are not similar. All other grounds of opposition are denied and the applicant asks for the opposition to be dismissed.

45 Both sides request that an award of costs be made in their favour.

Both sides have filed evidence in these proceedings. The matter came to be heard on 22 March 1999, when the applicants were represented by Mr Peter Charlton of Elkington & Fife, their trade mark attorneys, and the opponents by Mr David Harrison of Mewburn Ellis, their trade mark attorneys.

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### **Opponents' evidence**

This consists of four statutory declarations. The first dated March 1997 comes from Christian London, Legal Manager of La Chemise Lacoste. Mr London confirms that he has been employed by the company for 14 years.

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Mr London begins by saying that the opponent is an internationally famous company, known for products such as clothing, footwear, headgear, leather goods, sports and leisure bags, umbrellas, cosmetics, eye wear, and watches. He says that his company first used their Crocodile trade mark in 1933 and is currently used in relation to the goods mentioned throughout the world. Mr London says that the trade mark is registered in 185 countries and refers to Exhibit 1 which consists of a list of these countries. He concludes saying that the trade mark was first registered in the United Kingdom in 1959 and refers to Exhibit 2 which consists of copies of trade mark registration certificates from various countries, including the United Kingdom.

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The second statutory declaration comes from Jean-Claude Fauvet, the Communications and Marketing Manager of La chemise Lacoste, a position he has held for the 17 years he has been employed by the company.

Mr Fauvet begins by outlining the distribution arrangement of the goods bearing the Crocodile logo, which he says are sold through independent wholesalers and retailer appointed by his company. He says that his company also has its own boutiques which are devoted solely to selling goods bearing the trade mark and refers to Exhibit 1 which consists of diagrams dated 1996, and illustrating the number of Lacoste boutiques (429) and "corners" (966) in various parts of the world, with the United Kingdom shown as having 2 boutiques and 19 corners.

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Mr Fauvet describes the promotional activities undertaken by his company, stating that the mark features prominently in catalogues, promotional material, advertisements, retail shop displays and company stationery, and refers to Exhibit 2 which consists of samples of promotional materials. The majority of the items in this exhibit are either undated, or are in French and it is not clear when or where they were used and cannot therefore be given much weight. The items of stationery and packaging show use of the Crocodile device although usually in conjunction with the word Lacoste, or the company name La Chemise Lacoste. The rest of the exhibit consists of an extract from what appears to be an advertising industry publication, and articles relating to the history of the Crocodile logo from publications called "Golden Wing" Sportstyle" and "GQ". No circulation figures are given although they date from before the relevant date, and appear to originate from United Kingdom.

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Mr Fauvet gives the worldwide annual turnover in goods marked with the trade mark as US\$600,000,000 per annum, although does not say what goods this is in respect of, whether it relates to the Crocodile mark or all Lacoste brands, or what proportion relates to the United Kingdom. He says that based on the above, it is clear that the trade mark has become exclusively

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associated with the opponent and that they enjoy a substantial reputation and goodwill in the mark. Mr Fauvet goes on to claim that the opponens is a well known trade mark in the sense of Article 6bis of the Paris Convention, and in support of this refers to Exhibit 3 which he describes as an opinion poll. The exhibit consists of an extract from a publication called L'Expansion and dated 2 October 1991. This is a French language publication and no translation has been provided. The name Lacoste is mentioned along with many other brand names, and appears to include "league tables" of some kind. No information has been given as to how, or on what basis the opinion poll was conducted, or whether it relates to the United Kingdom market, and consequently, cannot be given any weight.

Mr Fauvet next refers to the applicants' mark and to Exhibit4 which consists of a copy of the advertisement of that mark published in the Trade Marks Journal. He gives his opinion on the similarity of the applicants' mark to his company's mark, referring to the features which he considers they have in common, and concludes by giving his opinion on the likelihood and consequences of confusion with his company's mark.

The third statutory declaration dated 14 March 1997 comes from David Christopher Harrison. No details of Mr Harrison's involvement with the proceedings or the parties is given but it is known that Mr Harrison is a trade mark attorney acting for the opponents. He refers to Exhibit DCH1 which consists of an extract from Websters New International Dictionary relating to alligator, cayman and crocodile. Mr Harrison refers to the description under alligator, and in particular, to the reference that the snout of an alligator is shorter and broader than a crocodile.

The final statutory declaration dated 17 March 1997 comes from John Allen Nicholas Prenn. Mr Prenn says that since 1988 he has been the Chairman of KBL Limited who are the sole distributors of Lacoste clothing in the United Kingdom (excluding Northern Ireland).

Mr Prenn begins by outlining the sales of Lacoste clothing in the United Kingdom, and gives a figure over the three years up to 30 April 1997 of £17,000,000 at wholesale prices which he says equates to £42,000,000 at retail prices, and a figure of £12,000,000 for the previous five year period. The period to April 1997 extends some 18 months beyond the relevant date and it is not possible to tell what the figure would be to the relevant date although based on the previous years turnover is likely to be significant. He describes the goods he deals in as high quality luxury clothing which he says have been imported into the United Kingdom since, at the latest, the 1970s, and that in addition, other goods such as fragrance, soaps, shoes, frames for spectacles, sunglasses and watches have been exploited by Lacoste. He does not say whether the turnover figures relate to sales under the Lacoste name, the Crocodile logo (or both) and no information is given for any goods other than clothing.

He goes on to say that through years of brand building the Lacoste Crocodile mark is one of the top five brands in terms of logo recognition in this country, saying that this recognition has been achieved through sponsorship, advertising public relations and celebrity endorsement but beyond this does not give any further information. Mr Prenn next says that the opponents are about to repeat an advertising campaign from the previous year which appeared in a large number of national daily newspapers and featured the Crocodile mark and the Lacoste name. He goes on to give some statistics which he says are based on the results from last years campaign and concludes by giving his opinion on the likelihood and consequences of any confusion should

another Crocodile brand appear in the market place.

### **Applicants' evidence**

5 This consists of a statutory declaration dated 27 August 1997 from Peter Charlton, a registered trade mark attorney acting for the applicants in these proceedings.

10 Mr Charlton refers to Exhibit PJC1 which consists of a certified copy of a trade mark registration obtained by the applicants in Germany in 1971. Mr Charlton refers to the fact that mark is essentially the same as the applicants mark in this application.

### **Decision**

15 No further evidence was filed in these proceedings, and I turn to consider the grounds of opposition. At the hearing Mr Harrison confirmed that these were founded under Section 3(6), Section 5(3) and Section 5(4)(a) of the Act. I turn first to the grounds under Section 3(6) of the Act, which reads:

20 **3(6)** A trade mark shall not be registered if or to the extent that the application is made in bad faith.

25 The opponents assert that the opposed mark was adopted in bad faith, but do not say on what basis they believe this to be the case. At the hearing Mr Harrison was not able to clarify this much beyond saying that the opponents have a substantial reputation in their Crocodile mark, and that the applicants have not explained why they seek to register their mark in the United Kingdom so long after registering the mark in Germany. The mark applied for is identical in its material particulars to the applicants' mark registered in Germany which in my view is a reasonable indication that they have not attempted to appropriate a mark owned by the opponents. There is nothing in the evidence which goes any way towards establishing that the applicants decision to apply for registration of the mark in the United Kingdom was anything other than bona fide, and consequently, I find that the opposition fails under Section 3(6).

I next turn to consider the objection under Section 5(3) which reads:

35 **5(3)** A trade mark which -

(a) is identical with or similar to an earlier trade mark, and

40 (b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

45 shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

The term “earlier trade mark” is itself defined in Section 6(1) of the Act, which reads:

6. (1) In this Act an “earlier trade mark” means -

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

10 The opponents are the proprietors of a number of registrations each of which qualifies as an “earlier trade mark” within the provisions of Section 6(1)(a) above, and in my view are registered in respect of goods which are neither identical nor similar to the goods of the opposed application.

15 This takes me to the matter of the respective marks. The earlier rights relied upon by the opponents consist of the device of a reptile, said to be a crocodile, either on its own or in a composite mark with the word LACOSTE. Mr Harrison contended the opponents' marks and the applicants' mark were identical, which, as the applicants' mark incorporates the word KAIMANN cannot be the case. However, it may well be that Mr Harrison was not referring to the applicants' mark as a whole, but rather the reptile device element of the mark. If there is any  
20 similarity in the marks it can only be in the reptile element and I propose to consider the respective marks by a comparison of the opponents' “Crocodile” mark alone, for if this mark is not similar the composite mark will be even further away.

25 The European Court of Justice has issued guidance on the approach that should be followed in determining whether two marks are similar in the case of *Sabel v Puma C251/95*. The Court said:

“That global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components.”

30 The mark applied for is a composite mark consisting of a device of a reptile placed prominently above the word KAIMANN and contained within an oval border. The word KAIMANN is the applicants' surname, and very close to KAIMAN, the German word for CAYMAN, a sub-species of alligator which may account for the applicants use of the device of a reptile in his trade mark.  
35 Mr Harrison gave an analysis of the differences between a crocodile, alligator and a cayman to show that the device in the applicants' mark is not a cayman but a crocodile. Mr Charlton said that he could not tell one species from another and I would say that I am in the same position, as I suspect would be a substantial part of the public at large.

40 The applicants' mark also contains the word KAIMANN and in assessing the distinctive components of a mark it is, generally speaking, accepted that words speak louder than devices in composite marks. The mere fact that there is a word in the applicants' mark gives the respective marks a different appearance although that in itself does not mean that the marks are not similar.  
45 The word element in my view affects the way in which the marks will be referred to, which, in the case of the applicants mark is likely to be by reference to the word element, whereas the opponents' mark will be referred to as the “crocodile” mark, or by persons familiar with it, as the LACOSTE mark.

Mr Harrison referred to the stance of the two reptiles, both shown from the side showing two legs, a long snout with the mouth open and teeth visible, and the tail arching over the reptile's back. Mr Charlton submitted that this was a natural pose for a reptile and given the shape of the border to the applicants' mark, how else could the tail have been shown. In the Sabel-Puma case to which I was referred, it was said:

“However, in circumstances such as those in point in the main proceedings, where the earlier mark is not especially well known to the public and consists of an image with little imaginative content, the mere fact that the two marks are conceptually similar is not sufficient to give rise to a likelihood of confusion.”.

The evidence suggests that the opponents have a reputation for the crocodile device, the word Lacoste and these two elements together as a composite marks. The opponents say that while their reputation is centred on clothing, it extends to almost all areas of commerce, and that Lacoste has “exploited” specific items of non-clothing goods. The goods mentioned are mostly items for wear and considered as “fashion accessories”. However, there is nothing in the evidence to show the extent of any trade in such goods in the United Kingdom and I therefore come to the conclusion that the opponents have established that they are likely to have a reputation in the United Kingdom, but only in respect of “luxury” clothing.

Both marks are fairly ordinary representations of reptiles and to that extent are conceptual similar but that is likely to always be the case when the device borders on a reasonably true to life representation. I also bear in mind that in the Sabel-Puma case it was said that “The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.”. Taking this, and my previous comments into account, I come to the view that when considered “globally” the marks are not similar, and accordingly, that the opposition under Section 5(3) does not get out of the starting gate.

However, should I be found to be wrong in my determination, I will go on to consider whether use by the applicants of their logo mark for the goods covered by their application, would take unfair advantage of, or be detrimental to the distinctive character or repute of the opponents mark. It was put to me by Mr Harrison that a likelihood of confusion was not necessary to substantiate an objection under Section 5(3), a position arrived at by the Hearing Officer in the Oasis Stores Limited trade mark case to which I was referred, and also by Mr Geoffrey Hobbs QC sitting as the Appointed Person in the Corgi Classics Ltd's invalidity action (No 9236) and I see no reason to depart from this line.

In *RBS Advanta v Barclays Bank plc* 1996 RPC P307, Laddie J. considered the meaning of the proviso to Section 10(6) of the Act which deals with comparative advertising. The second half of the proviso contains wording identical with the wording in Section 5(3) of the Act. Laddie J. expressed the following view on the meaning of the above words in that context:

“At the most these words emphasise that the use of the mark must take advantage of it or be detrimental to it. In other words the use must either give some advantage to the defendant or inflict some harm on the character or repute of the registered mark which is above the level of *de minimis*.”

The opponents say that they have established an extensive reputation for luxury goods, and in doing so have deliberately not extended their use of the mark to goods which would devalue the cachet surrounding their mark, which would be the effect should the applicants put their mark into use. I accept that people seeing the applicants' mark may well be reminded of the opponent, but I am not convinced that this will be other than as a retailer of designer clothes. Seeing a mark upon some goods and being reminded of a similar trade mark with a reputation for goods far removed from those goods does not, in my view, take unfair advantage of the goodwill or repute of the mark brought to mind. Mr Harrison drew my attention to the decision of the Registrar's Hearing Officer in which Visa International Services Association succeeded in an opposition under Section 5(3) against CA Sheimer (M) Sdn. Bhd who had sought to register an identical mark in respect of condoms to that used in relation to credit card services by the opponent. In his decision the Hearing Officer said:

The evidence goes to support what I believe to be clear, namely that the scale of use of the VISA mark in relation to credit card services, and resulting reputation, combined with the daily use of that mark in connection with many and varied consumer products, would cause the public to wonder whether there is a connection in trade between the opponents' and dissimilar consumer goods under the same mark. As a consequence I find that a substantial number of members of the public are likely to have cause to wonder whether the applicant's products are in some way connected with the services provided by the opponents. That in turn leads me to find that whether or not any deception is intended, there are sufficient grounds for a finding that unfair advantage would be taken of the reputation of VisaISA's mark.

I do not believe this case assists the opponents, as distinct from the Visa case, the respective marks are not identical, nor have they used their mark "in connection with many and varied consumer products...", a distinction drawn to my attention by Mr Charlton in his submissions.

In the Oasis Stores trade mark case it was said that "any use of the same or similar mark for dissimilar goods or services is liable to dilute, and as a consequence, be detrimental to the distinctive character of the earlier mark, but as the intent of the provision was not to prevent the registration of any mark similar or the same as a mark with a reputation, this was a matter of degree.". I cannot disagree with this position and propose to adopt the criteria used by the Hearing Officer in that case in considering the likelihood of detriment, which is as follows:

1. The inherent distinctiveness of the earlier trade mark;
2. The extent of the reputation that the earlier mark enjoys;
3. The range of goods or services for which the earlier mark enjoys a reputation;
4. The uniqueness or otherwise of the mark in the market place;
5. Whether the respective goods/services, although dissimilar, are in some way related or likely to be sold through the same outlets;
6. Whether the earlier trade mark will be any less distinctive for the goods/services for

which it has a reputation than it was before.

Prima facie the device of a crocodile is a distinctive mark; I have no evidence on the uniqueness or otherwise of the mark in the marketplace. I have already found that the opponents are likely to have acquired a reputation in respect of “designer” clothing, but that there is nothing in the evidence to substantiate a claim to a reputation beyond this. The respective goods are totally dissimilar, unrelated and most unlikely to be sold through the same wholesale or retail outlets. I conclude that the registration and use of the applicants' mark will not have a detrimental effect on the distinctive character of the opponents' mark for any goods in respect of which it enjoys a reputation.

This leaves the matter of whether registration would be detrimental to the repute of the opponents mark. In *Philips Electronics v Remington Consumer Products* 1998 RPC 283 Jacob J. said:

“Good trade marks add value to goods - that is one of the things they are for.” “For instance the Rolls Royce grille adds value to a Rolls Royce. But it does so primarily because it signifies Rolls Royce and not because of its inherent shape.”

The mark Rolls Royce adds value to goods sold under it is because people know that they originate from a particular manufacturer with a reputation for producing high quality products. They are expensive items, usually only within reach of persons of a certain standing, all of which adds to the exclusivity of the Rolls Royce mark, and in the minds of the public, the status and value of the goods sold under it in. The cachet of exclusivity is the image that the opponents appear to have cultivated and certainly rely upon to a great extent in their claim to a reputation.

In the *Oasis Stores* trade mark case, the hearing officer addressed the question of detriment, saying:

“It appears to me that where an earlier trade mark enjoys a reputation, and another trader proposes to use the same or similar mark on dissimilar goods or services with the result that the reputation of the earlier mark is likely to be damaged or tarnished in some significant way, the registration of the later mark is liable to be prohibited under Section 5(3) of the Act. By ‘damaged or tarnished’ I mean affected in such a way so that the value added to the goods sold under the earlier trade mark because of its repute is, or is likely to be, reduced on scale that is more than de minimis.”

In the *TREAT* trade mark case (1996 RPC 281 at 295) Jacob J. gave the following dictum on the scope of Section 10(3) of the Act, which, contains the same wording as Section 5(3), stating:

“ I only note that it might cater for the case where the goods were vastly different but the marks the same or similar and the proprietor could show that the repute of his mark was likely to be affected. The sort of circumstances of the Dutch *Claeryn/Klarein* (mark for gin infringed by identical sounding mark for detergent, damage to the gin mark image), may fall within this kind of infringement, even though they do not fall within section 10(2) because there is no likelihood of confusion as to trade origin.”

The sort of detriment envisaged was damage likely to cause detriment to the reputation of the

earlier trade mark in some material fashion. In the Claeryn/Klarein case it was found that the use of a similar mark for detergent as for a well known gin created a possibility that the reputation of the mark for the gin would suffer by bringing to mind a detergent. In time the reputation of the earlier mark may have suffered so that it no longer added the same degree of value to the goods as it did before. The potential for damage to the reputation of the Claeryn gin trade mark and the resultant damage to its ability to add value to the goods is plain to see.

Here we have a clothing manufacturer claiming that they have a reputation which extends to almost all areas of commerce, such that, if the applicants use what they say is a very similar mark on their goods, the use would be associated with them and as a consequence, their good name would suffer. Under Section 5(3) the onus falls on the opponents to make out their case. I find that there is nothing to substantiate their claim to a reputation much beyond that centred on their trade in up-market clothes and come to the view that the opponent has failed to establish that use of the applicants' composite mark would take unfair advantage or be detrimental to the character or repute of their earlier mark.

I next turn to consider Section 5(4)(a) which 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) ....

The opponents contend that they would succeed in an action for passing off against the applicants should their mark be used in the United Kingdom. A helpful summary of the elements of an action for passing off can be found in Halsbury's Laws of England 4th Edition Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in Reckitt & Colman Products Ltd - v - Borden Inc [1990] RPC 341 and Erven Warnik BV - v - J. Townend & Sons (Hull) Ltd [1979] AC 731 is (with footnotes omitted) as follows:

The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff'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 defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

5 The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of "passing off", and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.

10 Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that;

15 To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

- 20 (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

25 While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

30 In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- 35 (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- 40 (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
- 45 (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances."

I have previously accepted that the opponents have a reputation, albeit in respect of quality clothing, although concluded that the respective marks are not similar. While I have no evidence

before me to show how the applicants use their mark or the manner in which they carry on trade, the specification of goods for the application shows that they are involved in the sale of plumbing, heating or construction components. While this is a very different area of trade it is quite possible that a purchaser of the opponents' clothing may at some time come into contact with or become  
5 aware of the applicants' mark and goods. However, the respective goods are so different that in considering the likelihood of potential purchasers being deceived into believing that the goods of the applicant are from or connected in some way with the opponent, I come to the conclusion that the average consumer of the goods in question who is reasonably well informed and reasonably observant and circumspect would not make that mistake.

10 Apart from inferring that they wish to avoid the possibility of their mark being associated with the wrong type of goods, the opponents have not said how they will be damaged should the applicant's put their mark into use. Mr Harrison considered that although the goods of the application were dissimilar this in itself was not a defence, and in support of his contention  
15 referred me, inter alia, to Lego Systems Aktielskab and another V Lego M. Lemelstrich Limited (FSR 1983 155) in which the manufacturers of famous toy building bricks succeeded in a passing-off action against a long established Israeli manufacturer of coloured plastic irrigation equipment, such as garden sprays and sprinklers. In the Oasis Stores Limited trade mark case [1998] 19 RPC 631 to which I was also referred, the Registrar's Hearing Officer said:

20 at page 10 line 40:

25 It could be argued that Lego's mark, like the opponents is, or was at the time, a 'one product' mark, yet that did not prevent the passing off action from succeeding. On the other hand, there was at least a tenuous link between the products in the Lego case insofar as both sets of goods were made of the similar materials. There is no link at all between the goods at issue here. Further, as Mr Mellor pointed out at the hearing, there was substantial evidence of likely confusion in that case. In this case there is much more limited evidence of likely confusion..”

30 And at page 645 line 40:

35 “It appears to me that the burden of establishing an earlier right under Section 5(4)(a) rests on the opponents. The fact that the parties are trading in different fields adds to the evidential burden on the opponents in showing that there is a real risk of confusion or deception. I also bear in mind that where the fields of activity are far removed as in this case, it cannot be assumed that even if a small amount of confusion did arise, it would necessarily result in damage to the opponents.”

40 The opponents' evidence shows that in the United Kingdom they have a trade exclusively based on one product, that is, clothing. There is no link, tenuous or otherwise between the respective goods, and there is absolutely no evidence of any confusion or likely confusion or that the opponents would suffer any damage. In my view, the opponents have not made out their case and  
45 the ground of opposition under Section 5(4)(a) consequently fails.

The opposition having failed on all grounds I order that the opponent pay the applicant the sum of £635 as a contribution towards their costs.

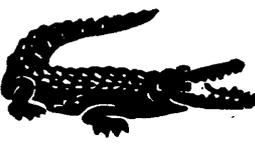
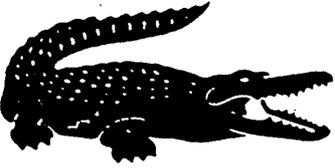
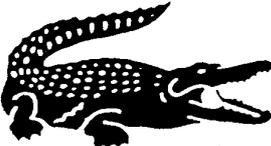
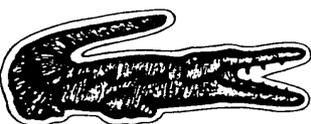
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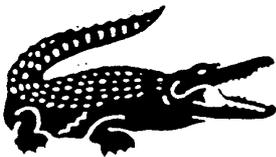
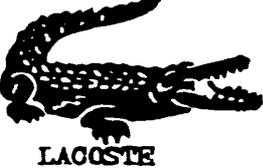
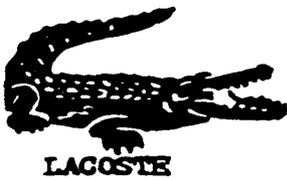
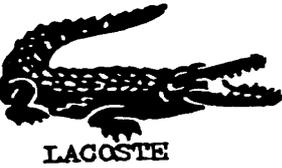
**Dated this 19 Day of May 1999**

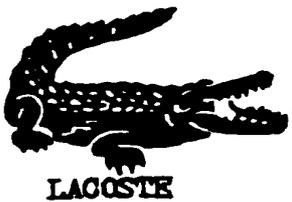
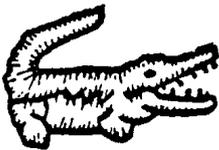
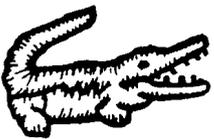
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15 **M Foley**  
**For the registrar**  
**The Comptroller-General**

## REGISTRATIONS DETAILED IN THE GROUNDS OF OPPOSITION

Number	Mark	Class	Specification	
5	979872		32	Beer, ale and porter; non-alcoholic drinks and preparations for making such Drinks, all included in Class 32.
10	749867		28	Balls for games, tennis racquets, squash racquets, badminton racquets and golf clubs.
15	1064402		28	Balls for games, tennis rackets, squash rackets, badminton rackets and golf clubs.
20	1452623		28	Golf clubs; golf balls, tennis balls; tennis rackets, frames and strings; golf and tennis bags, golf tees, tennis racket grips and golf gloves; all included in Class 28.
25	1221371		26	Lace, embroidery, ribbons, braid, all being textile small wares; buttons, press buttons and slide fasteners, all included in Class 26.
30	1328764		26	Textile small wares, buttons, hooks and eyes, all included in Class 26.
35	787826		25	Sports shirts.
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5	974896		25	Sports shirts; gowns and dresses, all for women
10	1178977		25	Articles of sports clothing, sweaters, pullovers, jackets, slacks, suits, gowns dresses, socks being articles of clothing, stockings and articles of underclothing, but not including any of the aforesaid goods made from reptile skin or from imitation reptile skin.
15	1221370		25	Articles of clothing, but not including maternity clothing or clothing made from reptile skin or from imitation reptile skin.
20	1227476		22	Sails for boats; bags (in the nature of sacks) and sacks, all for holding sails.
25	1230433		20	Furniture, mirrors included in Class 20 and picture frames; shop fittings made wholly or principally of plastics or wood
30	1124565		18	Leather, imitation leather and articles included in Class 18 made from all the aforesaid materials; trunks, travelling bags, umbrellas and parasols; but not including any of the aforesaid goods made from reptile skin or from imitation reptile skin.
35	1259081		14	Jewellery, buckles, tie pins, earrings, brooches, bracelets and pendants, all made of precious metal or coated therewith; imitation jewellery; horological and chronometric instruments.
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5 1213941	 <p>LACOSTE</p>	12	Motor land vehicles and sail boats.
10 15 1103734	 <p>LACOSTE</p>	9	Spectacles, sunglasses and goggles for protective purposes.
20 25 929358	 <p>LACOSTE</p>	3	Perfumes, eau de cologne, non-medicated toilet preparations, cosmetics and soaps.
929359*		3	Perfumes, eau de cologne, non-medicated toilet preparations, cosmetics and soaps.

\*929359 is no longer a live registration