

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK Application

**No: 2057858 to register a trade mark
in the name of Scentura Creations Limited.**

5 **AND IN THE MATTER OF Opposition
No: 46024 by Patrick Cox Designs Limited**

Decision

Scentura Creations Limited, London, SW1X 8AT applied on 22 February 1996 to register the WANNABEE for: 'Perfumes, fragrances and toiletries' in Class 3.

10 Patrick Cox Designs Limited oppose the application under s 5(2), s 5(3)¹ and s 5(4) of the Act. They say they have a substantial reputation in the unregistered mark WANNABE for shoes, clothing and bags. There is also an earlier mark, No. 1542002, owned by Calzaturificio Ruggeri & Pagnanini SPA, for the Mark WANNABE for 'Footwear, shoes, boots, slippers and socks; all for women; all included in Class 25'.

15 The Applicants deny these grounds and both parties ask for their costs. The Hearing took place with Dr Lawrence of Counsel, instructed by Finers, representing the opponents, and Mr Purvis of Counsel, instructed by Messrs Alan Winter Peace & Co., appearing on behalf of the Applicants.

20 The Evidence

Further evidence was submitted on the day of the Hearing by both parties, each being sanguine about its inclusion. I saw no reason to object.

25 There are three declarations from the opponents, each from Anthony James Bottomley, who describes himself as 'effectively' acting Managing Director of the 'Patrick Cox Group', dated 28 August 1997, 18 September 1998 and 7 December 1999. He says that the title in registered and unregistered trade marks were assigned to Bartlehiem NV on 30th day January 1997 (Exhibit AJB 1 contains a deed of assignment). He gives his evidence on their behalf, and is authorised to do so for the opponents (Patrick Cox Designs Limited) as well. He does not say he has access to their records.

30 Two declaration are produced by the applicants, one by Christian Nelleman, their company director, dated 5 May 1998 and a second by Nicholas Barrington Peace, a partner in Messrs Alan Peace & Co., the applicants solicitors, dated 13 December 1999.

I have not carried out a full summary of the evidence, here, but only refer to that I regard as essential in my reaching a decision.

¹This ground is not specifically pleaded, but is implicit in the opponents' statement of case.

For the opponents, a key part of their case under the three grounds pleaded is the establishment of a reputation in the name WANNABE. This is abridged as follows.

Mr Bottomley, in his Declaration dated 28 August 1997, states that the opponents have:

5 ‘..acquired in a relatively short time an enormous goodwill and reputation in the mark WANNABE for shoes, clothing and bags, belts, diaries and wallets...WANNABE goods have managed to take an enviable market position and are recognised as a brand leader in the retail shoe market. Their designer, Patrick Cox, has himself achieved a certain level of fame and there is a huge public awareness of both the designer and the goods..’

10 The evidenced amassed to support comes mainly from press cuttings in Exhibits AJB 2. I have to say, that some of these are almost impossible to read and in my view there is no point in submitting evidence if it is of such poor reproduction as to be indecipherable; however, of the mark at issue I was able to discern the following information, relevant to the UK:

15 ! The Sunday Times Magazine, dated July 3 1994, refers to ‘..the classic Patrick Cox Wannabe loafer’. The original is, in parts, unreadable, but the following can be understood:

20 ‘Patrick Cox’s shoes have almost achieved style ubiquity in the fashionable enclaves of our major cities. Standard issue for the cappuccino classes of young, contemporary Britain, his designs dominate the dance floors of trendy nightclubs, bars and restaurants....Celebrity customers include Madonna, Elton John, Jeane Moreau and Michael Jackson, who faxed the outline of his foot to the shop for a pair of bespoke chain-mail covered loafers ...His diffusion line Wannabe by Patrick Cox launched in 1993 has transported him to the footwear stratosphere. Last year this simple £80-£100 range, which has spawned a rash of high street imitators, sold over 100,000 pairs.’

25 ! Time Out magazine, from February 1995, repeats the same information.

! An extract from the Telegraph Magazine, not dated, but cited as being 25 March 1995, which calls Mr Cox’s shoe design as ‘the Wannabe’ as his ‘chief ticket to recognition’ and in its ‘fourth season’, and states:

30 ‘..the Wannabe is probably the most widely copied designer shoe of the decade, credited at a previously unthinkable £85 a pair, with destroying high street preconceptions about what young people will spend on shoes. 500 stores carry Cox’s ‘Wannabe’ and his mainline mens and womens range worldwide but this hardly bruises sales at his shops in Pads, London...’

35 ! Sales of clothing, bags, wallets and diaries under the mark are also claimed, but no evidence is submitted, that applies before 22 February 1996. Exhibit AJB 3 contains accessories to shoe purchase - labels, shoehorns and carrier bags, all marked with the name ‘Wannabe’. In Mr Bottomley’s second declaration, a wallet/bag is included in evidence (AJB 8). There is no indication of how many of these were sold before the relevant date.

! Total world-wide sales are give as £12M in 1995, 25% of which is claimed as sales in the UK. No figures are given for earlier dates, and I am not told when the mark was first used.

! Advertising spend to the relevant date is given as:

5	Season	Year	Amount
	Autumn/Winter	1995	£140,000
	Spring/Summer	1995	£164,230
	Autumn/Winter	1996	£200,000

! A letter from Ms Mimi Spencer, dated 29 March 1999, Fashion Editor of the London Evening Standard, provides the following statement:

15 'The Wannabe name has been inextricably linked with that of Patrick Cox for many years. Within the fashion world, it is usual to refer to Cox's loafer shoes as "Wannabes", thus making the two names synonymous. The notion of a different company using the name for their product - particularly in an area affiliated to the fashion industry, particularly in an area in which Patrick Cox himself may seek to do business in the future - seems to be faintly ludicrous. Wannabe is deemed to be a Cox trademark, and anything bearing the name will be thought of as a Cox product.'

20 I do not think I can place much weight on this evidence; it is three years after the relevant date and is essentially hearsay.

There is no evidence that the applicants have traded under their proposed mark before 22 February 1996 (or after). They mainly confine their evidence to comment on the opponents' evidence, refer to their choice of the mark, and to the history of the word 'wannabe'. I will refer to that evidence I consider relevant later.

25 The Decision

I will deal with the ground under s 5(4)(a) first.

S 5(4)(a) states:

'(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-

30 (a) by virtue of any rule of law (in particular, the law of passing off) protecting a unregistered trade mark or other sign used in the course of trade..'

The law on this common law tort is clearly set out by Geoffrey Hobbs QC, acting as the 'Appointed Person', in *Wild child* [1998] 14 RPC, 455:

35 '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 Warnink BV -v- J Townend & Sons (Hull) Ltd [1979] ACT 731 is (with footnotes omitted) as follows:

5 “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 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.

15 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”.

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;

25 “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:

- (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.

35 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.

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

- (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;
- 5 (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
- 10 (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.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.” ’

15 Thus, to succeed in a passing off action, it is necessary for the opponents to establish that at the relevant date (22 February 1996): (i) they had acquired goodwill under their mark, (ii) that use of the mark would amount to a misrepresentation likely to lead to confusion as to the origin of their goods; and (iii) that such confusion is likely to cause real damage to their goodwill.

The opponents use of the mark at issue is typically in the following form:



20 ‘Patrick Cox’ is generally used with the WANNABE mark. Though WANNABE is used alone, for example: ‘Wannabe is probably the most widely copied designer shoe of the decade’, there appears to be very significant - and intentional - promotion of Mr Cox’s name as well. I have no doubt that the above mark is indicative of a particular product, i.e. shoes. But I do not accept that there was a similar reputation for clothes in general under this mark, 25 at the application date.

Mr Purvis made some comments on the opponents’ evidence. First, he pointed out that the opponents’ mark was a ‘single device mark comprising a number of features’ - the word WANNABE, a circular device and ‘Patrick Cox’. He stated:

30 ‘..the dominant part of it is “Patrick Cox”. It is an indication almost that the word WANNABE could not be indicative of Patrick Cox goods unless the words “Patrick Cox” were in a prominent position, so that you identify the origin of the goods not by reference to the word WANNABE but by reference to the words “Patrick Cox”...’

and that is a consistent theme of the use of the mark by the opponents; elsewhere Mr Purvis stated that the opponents’ mark was not ‘WANNABE’ but ‘WANNABE by Patrick Cox.’ In 35 his view, it was the name ‘Patrick Cox’ that brought in custom, not the name WANNABE.

I do not think the evidence supports this assertion. See, for example, the third bullet point on page 2 above. Further, I think this argument would carry more weight if the trade mark at issue was more descriptive and consequently less distinctive. WANNABE has no significance for shoes and is at least as 'strong' an element as the name 'Patrick Cox'. Dr Lawrence at the
5 Hearing stated:

'...where the personality and flair of the designer himself is the subject of interest.... this adds to the reputation and the goodwill of the goods he designs. He has been extensively profiled and interviewed, and this has added to the cult status....of the WANNABE goods.'

This may be the case, but considering the evidence above, however, I think the use the
10 opponents have made of their mark has given them a reputation for shoes under the name WANNABE, but this is always associated in their promotional material with the designer Patrick Cox; the two stand together.

Second, Mr Purvis dismissed the evidence of the opponents reputation as that of a 'few
15 cuttings' from news papers, and said the opponents have not been '..able to produce evidence of a reputation at all and certainly not a compelling reputation.' In the light of the material summarised on pages 2 and 3 above, I do not believe this is tenable. Time Out, the Telegraph Magazine and Sunday Times Magazine are not inconsiderable publications.

Third, the failure of an Internet search for the opponents' WANNABE mark. Mr Peace's
20 Declaration, records such a search conducted on 12 December 1999. Mr Purvis said at the Hearing:

'The Internet, as I think we would all appreciate, is the single most important commercial
25 tool of our generation. ... The Government has got this huge thrust towards E-commerce and you will be able to take into account the things that you see in ordinary everyday life and hear on the TV and radio. One of the things that is in current vogue is to do all your Christmas shopping on the Internet. So, if you have heard of the word "Internet", if you knew of the Internet - a lot of people have Internet connections a home - you might decide that you wanted a WANNABE product and you might type in WANNABE. If you did that you would not find Patrick Cox. What you would find is WANNABE.com, which is the domain name, as one can see, of a specialist supplier of domain names. It has got nothing
30 to do with Patrick Cox.'

I regard this as somewhat irrelevant. A failure to find the opponents' mark on the Net does
35 nothing to invalidate the evidence summarised above. In fact, the mark was found, as Mr Peace's Declaration notes, on a web site owned by of Calzaturificio Ruggeri & Pagnanini SPA, the manufacturer of Patrick Cox and Patrick Cox WANNABE shoes (see paragraph 7 of the second Bottomley's Declaration dated 18 September 1998).

Finally, the word WANNABE is not original. Again, in my view, this is irrelevant. The question is whether it has become an indicium of the opponents' goodwill.

In summary, I do not think any of these assertions threaten my conclusion concerning the Opponents' goodwill. Of more moment is the extent for which that goodwill demands protection, in particular, does it extend to 'Perfumes, fragrances and toiletries' sold under the mark WANNABEE? Can confusion between the marks used on these two products occur
5 such that damage will be caused to the opponents goodwill in their mark?

Wild Child cited (above, page 5) the factors to be considered in determining an answer to these questions. I have already dealt with the nature and extent of the opponents' goodwill. I want now to deal with the closeness of the respective fields of activity in which the plaintiff and the defendant conduct business.

10 In evidence the connection between fashion houses and perfume was noted (see Mr Bottomley's first Declaration, paragraph 11). At the Hearing, Dr Lawrence referred me to *The Eternity Trade Mark* [1997] RPC 155, where the Registry's Hearing's Officer stated:

15 'The opponents evidence establishes that there is a significant relationship between fragrances in Class 3 and articles of clothing in Class 25 and that it is common practice for a designers name to be associated with both fragrances and clothing e.g., Chanel, Yves St Laurent, Ralph Lauren etc.'

20 There are at least three reasons why *Eternity* is distinguishable from the present case. First, as Mr Purvis noted *Eternity* was decided under s 11 of the old, 1938, Act. This section only required that a significant number of people would have 'cause to wonder' whether there was a commercial connection between the products carrying the marks at issue, while the tort of passing off necessitates actual confusion or deception, that is, a misrepresentation between them (see *BALI Trade Mark* [1969] 14 RPC 472). This is an all together higher test.

25 Second, in the *Eternity* case the opponents, Calvin Klein, supplied a perfume called ETERNITY and a had a significant reputation for clothing as well. The applicants in that case sought to register that mark for clothing. Here the opponents have not established a reputation for clothing. At the relevant date the opponents' mark appears to have been a single product mark - at least there is no evidence to the contrary.

30 Third, the fashion houses mentioned above - Chanel, Yves St Laurent, Ralph Lauren - fall into the category of 'well known' marks. I do not think, on the evidence, this can be claimed of the opponents' name.

Dr Lawrence also referred me to *Annabel's (Berkley Square) v Schock* [1972] RPC 838, and stated:

35 'In that case the plaintiff's business was a night club and the defendant's was an escort agency. In the Court of Appeal Russell LJ held that since both the plaintiff's and the defendant's business was concerned with night entertainment, there was, "A relevant association between the fields of activities sufficient to make it impossible to say that the general public could not be confused into thinking that Mr Schock's business under the name of 'Annabel' was something to do with or was associated with the plaintiff's business also under the name of 'Annabel's'. That is an indication of an approach and, in my

respectful submission, the correct approach. In this case we have two different classes of goods which are associated very strongly in the fashion world. In that case it was night entertainment, here we have fashion world, and for the same reasons there is a very strong likelihood of confusion on the part of the public.'

- 5 This may be the case, but I do not think it applies here. On the basis of my previous comments the 'relevant association' cannot be made in this case. The fields of activity are simply too far apart. As far as a connection between 'fashion' and 'perfume' is concerned, the use of the Patrick Cox name with the WANNABE mark does not help, as there is no evidence that Mr Cox was a well known designer of anything other than shoes at the relevant date. I note that
- 10 there is no strict requirement for a 'common field of activity' between marks for misrepresentation to occur under passing off, as was found in the *LEGO* case (see *Lego Systems Aktieselskab and another v Lego M Lemelstrich Ltd* [1983] FSR 155). However, in that instance a very famous **invented** mark was at issue, not a known word as here. Further, the opponents cannot claim to match the reputation residing in the LEGO name.
- 15 All in all, the opponents do not have enough evidence to make out a case for misrepresentation at the material date, and this ground therefore fails.

Turning to s 5(2)(b) this states:

'A trade mark shall not be registered if because-

- (a) ..., ..
- 20 (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'.

25 An earlier mark is defined in Section 6(1), *inter alia*, as a registered trade mark and so, by virtue of this section, the mark cited by the opponents is an earlier mark for the purposes of Section 5(2)(b). It is virtually identical to the applicants' WANNABEE. However, the goods at issue - 'Footwear, shoes, boots, slippers and socks; all for women; all included in Class 25' and 'Perfumes, fragrances and toiletries' are not similar enough to give rise to the required confusion.

30 S 5(3) states:

The next ground the Opponents plead is under s 5(3). This states:

'(3) A trade mark which -

- (a) is identical or similar to an earlier trade mark, and
- 35 (b) is to be registered for goods or services which are not similar, to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom .. 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.’

5 It is clear that the similarity of goods is not a requirement under this section. However, I think
this ground is bound to fail. The owners of the earlier mark - Calzaturificio Ruggeri &
Pagnanini SPA - are not a party to these proceedings and make no claim to a reputation in the
UK for the mark as registered, i.e. WANNABE. There is a reputation in the mark shown on
page 5 - PATRICK COX WANNABE - but it is the opponents’ who claim to have owned the
10 goodwill at the material date. This is an unregistered mark, and does not fall within the
definition of an earlier mark for the purposes of s 5(3).

Even if I am wrong about this I do not think the opponents can succeed on this ground. The
purpose of s 5(3) is to protect the distinctive character or reputation of a mark, and protect
against illegitimate exploitation. As intimated above, I accept that the opponents have a
15 reputation in PATRICK COX WANNABE for shoes, not in WANNABE *per se*. The
applicants have applied for WANNABEE for perfumes and I fail to conceive how registration
of the applicants’ mark will in some way parasitise on the opponents’ reputation, or in some
way harm it.

The applicants are successful. They are entitled to an award of costs, and I order the
opponents to pay to them £800. This sum is to be paid within one month the expiry of the
20 appeal period or within one month of the final determination of this case if any appeal against
this decision is unsuccessful.

Dated this 2nd day of May 2000

25 **Dr W J Trott**
Principal Hearing Officer
For the Registrar
the Comptroller-General