

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 2112864
BY TOMMY HILFIGER LICENSING INC.
TO REGISTER THE TRADE MARK
TOMMY GIRL
IN CLASS 3

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 46714
BY ETAM PUBLIC LIMITED COMPANY

BACKGROUND

1) On 15 October 1996, Tommy Hilfiger Licensing Inc., of 913 N. Market Street, Wilmington, Delaware 19801, United States of America applied under the Trade Marks Act 1994 for registration of the trade mark TOMMY GIRL in respect of the following goods:

In Class 3: “Soaps; perfumes; non-medicated toilet preparations; essential oils; cosmetics; preparations for the hair and for the scalp; shampoos; salts, oils, lotions all being non-medicated preparations for the bath; dentifrices; detergents, anti-perspirants and deodorants all for personal use; facial cleansers and scrubs; moisturisers; shower gels; body creams and body lotions; non-medicated anti-acne preparations; colognes; aftershave lotions and aftershave balms; shaving creams”.

2) On the 17 April 1997 Etam Public Limited Company of Jubilee House, 213 Oxford Street, London, W1R 2AH filed notice of opposition to the application. The grounds of opposition are in summary:

a) The opponent is the proprietor of twelve registrations (detailed at Annex A) and through substantial use of these marks has acquired reputation in goods sold under these marks.

b) The mark applied for is not capable of distinguishing the goods and is therefore contrary to Section 3(1)(a) of the Trade Marks Act 1994.

c) The mark applied for is similar to those of the opponent and so offends against Sections 3(1)(a), 3(3)(b), 3(4), 5(2), 5(3) & 5(4)(a) of the Trade Marks Act 1994.

d) As the applicant was aware of the reputation of the opponent in the above trade marks the filing was made in bad faith and so offends against Section 3(6) of the Trade Marks Act 1994.

e) The trade mark applied for is not being used by the applicant or with its consent in relation to the goods covered by the application and the Applicant does not have a bona fide intention of using the mark on all the goods specified. The application therefore offends against Section 3(6) and 32(3) of the Trade Marks Act 1994.

3) The applicant subsequently filed a counterstatement denying all the grounds.

4) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. The matter came to be heard on 23 January 2002 when the applicant was represented by Mr Jones of Messrs Baker & McKenzie and the opponent by Mr Abrahams of Counsel instructed by Messrs Dechert.

OPPONENT'S EVIDENCE

5) The opponent filed a declaration, dated 29 March 2000, by Cassandra Rachel Moore-Fox the Product Director for the opponent company. She states that her declaration is based on personal knowledge and also company records, to which she has full access.

6) Ms Moore-Fox states that the opponent has over two hundred retail outlets throughout the UK, with TAMMY branded products being available in 194 of the Etam stores with, in addition, twelve independent Tammy stores. She states that Tammy branded products are also available by mail order in the "Freemans" catalogue.

7) Ms Moore-Fox states that "one or more of the Company's trade marks was first used in the UK in 1974 in relation to girls' clothing, nightwear and accessories". Since this date, she claims, the range of products sold under the various marks has expanded to include girls' accessories such as jewellery, watches, bags, footwear, stationery and novelty items in addition to girls' clothing. At exhibit CRMF2 she provides three examples of such products, a case for sunglasses, a carrier bag and a shoe bag. At exhibit CRMF3 examples of woven labels and swing tickets are provided. All the exhibits in CRMF2 & 3 show the mark "Tammy" in an ellipse as per Trade mark 2223633 at annex 1.

8) Although the opponent's stores stock women's clothing, and a range of children's (aged 3-8 years) clothing, the TAMMY range is aimed at girls aged from 9-15 years. Ms Moore-Fox provides turnover figures attributable to the TAMMY marks 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

9) Ms Moore-Fox states that the marks are promoted in magazines and national and local press as well as other types of promotions. At exhibit CRMF4 are extracts from these publications including, inter alia, titles such as *19*, *Bella*, *Bliss*, *Elle*, *Good Housekeeping*, *Leeds Evening Press*, *Newcastle Evening Chronicle*, *Now*, *OK*, *Telegraph magazine*, *The Daily Telegraph* and *The Sun*. However, these date between March 1998 - January 2000 and are after the relevant date. The vast bundle of cuttings also contained a large quantity of

papers which had no reference to the opponent's mark.

APPLICANT'S EVIDENCE

10) The applicant filed an affidavit, dated 10 April 2001, by Jade H. J. Huang the Vice President of the applicant company. Ms Huang claims that a survey commissioned in relation to unconnected proceedings shows the general public to associate the name Tommy with the name Hilfiger. The survey was carried out in January 1999 in London. Members of the public were chosen at random on Oxford St in Central London. The interviewees were first asked if they had shopped for clothing, jewellery or cosmetics in the past three months. If they answered no then the interview was stopped. Those that answered yes were asked details of their occupation and the types of shops in which they shopped. They were then shown a list of first names of people and asked to state which they recognised as being connected with the clothing industry. They were asked to supply the persons last name. They were also asked if the name TOMMY BOY meant anything to them. Of the ninety-eight people questioned 82 (83%) managed to provide the surname Hilfiger to go with the first name Tommy. Thirty-one (32%) referred to a perfume or after shave in response to the query regarding "Tommy Boy". In the same survey 97 (99%) provided the surname Klein to the first name Calvin and 92 (94%) provided the surname Lauren to the first name Ralph.

11) Ms Huang claims that the Tommy Hilfiger brand is a household name and that the word TOMMY has become synonymous with the goods of Tommy Hilfiger to such an extent that the TOMMY HILFIGER brand name is more often than not referred to simply as TOMMY. This view is, she suggests, confirmed by the survey mentioned above. I do not accept this contention as the survey was, in my view, significantly flawed. Those members of the public who were questioned were asked to provide the surnames to a number of forenames provided. They were informed that the names may or may not be those of people connected to the clothing industry. Thus the respondents were led into speculating on surnames, and were also steered into considering only the names of designers. The fact that a number could provide the surname Hilfiger merely shows that Mr Tommy Hilfiger is a designer whose name is known to a number of the general public. It tells me nothing about the level of recognition of TOMMY as a trade mark amongst the relevant public.

12) Ms Huang states that a range of personal grooming products under the TOMMY GIRL mark was launched in the UK in August 1997. The range included soaps, body lotions, deodorants and colognes. She provides wholesale and advertising figures as follows:

Year	Value £	Promotion £
June 1997 - June 1998	12,271,000	1,595,242
June 1998 - June 1999	12,456,000	2,175,331
June 1999 - June 2000	9,497,000	1,578,975

13) Ms Huang states that the mark has been widely advertised in women's publications and newspapers as well as on posters and by promotions such as T-shirts.

14) Ms Huang points out that the opponent's goods are sold exclusively through their own

chain of shops whereas the applicant's products are sold via various retail chains.

15) That concludes my review of the evidence. I now turn to the decision.

DECISION

16) At the hearing Mr Abrahams withdrew the grounds of opposition under Sections 3(1)(a), 3(3)(b), 3(4), 3(6), & 32(3).

17) The first ground of opposition is under Section 5(2)(b) of the Act which states:-

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

18) An earlier right is defined in Section 6, the relevant parts of which state

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

(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,

(b)...

(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well known trade mark."

19) In determining the question under section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel Bv v Puma AG* [1998 RPC 199], *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc.* [1999] E.T.M.R. 1, *Lloyd Schfabrik Meyer & Co. GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R 723. It is clear from these cases that: -

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel Bv v Puma AG* page 224;

(b) the matter must be judged through the eyes of the average consumer, of the goods / services in question; *Sabel Bv v Puma AG* page 224, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schfabrik Meyer & Co.*

GmbH v Klijsen Handel B.V. page 84, paragraph 27;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel Bv v Puma AG* page 224;

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel Bv v Puma AG* page 224;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc.* page 7 paragraph 17;

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it; *Sabel Bv v Puma AG* page 8, paragraph 24;

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel Bv v Puma AG* page 224;

(h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG* page 732, paragraph 41;

(i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc.* page 9, paragraph 29.

20) As is clear from Annex A to this decision the opponents are relying on a number of registrations. At the hearing Mr Abrahams considered that the opponent's strongest case was under registrations 1019673 (TAMMY), 2032089 (TAMMY) and 2105644 (TAMMY GIRL stylised).

21) At the hearing it was common ground that the specification of registration 2032089 was identical or very similar to that of the mark in suit. For the purposes of the global assessment I will regard the goods to be identical. The opponent's other marks (1019673 and 2105644) are registered for "Articles of clothing for women and girls; but not including headwear" and "Articles of clothing, footwear, headgear" respectively. In determining whether these goods are similar to the specification of the mark in suit I have regard to the decision by Jacob.J. in the *British Sugar Plc v James Robertson & Sons* ["TREAT" 1996 RPC 281]. In that case the court stated that:

"The following factors must be relevant in considering whether there is or is not similarity:

- a) The respective uses of the respective goods or services;
- b) The respective users of the respective goods or services;
- c) The physical nature of the goods or acts of service;

- d) The respective trade channels through which the goods or services reach the market;
- e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in the trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors”.

22) In utilising the same test and applying it to this case it is clear that the uses of the respective goods are dissimilar as the opponent’s goods are designed to clothe the human body whilst the applicant’s goods are for cleansing and beautifying the body. If one restricts the test to the relevant consumers of the opponent’s goods then all would be likely to be users of the applicant’s goods. Even though the applicant’s specification has items more commonly used by men. The specification is not limited thus, but even if it were so, I would consider the goods to still be identical in this respect. The trade channels would be very different and the articles would not normally be found in the same shops. The physical nature of the goods is dissimilar. The goods cannot be said to be directly competitive. Therefore the goods cannot be considered to be similar.

23) Whilst I acknowledge that in view of the CANON - MGM judgement by the European Court of Justice (C-39/97) the TREAT case may no longer be wholly relied upon, the ECJ said that the factors identified by the UK government in its submissions (which are the factors listed in TREAT) are still relevant in determining the degree of similarity of the goods for the purposes of applying the composite test set out in paras 23 & 24 of the ECJ’s decision in SABEL v PUMA (1998 RPC page 199).

24) It is clear from the above cases that in the overall assessment of a likelihood of confusion, the similarity of goods is but one aspect. Due regard should be given to the closeness of the respective marks, the reputation the earlier mark enjoys in respect of the services for which it is registered, and any other relevant factors.

25) The opponent has filed evidence of use of their marks which included turnover figures which show sales averaging approximately £60 million per annum for the last six years. Although not broken down into the various classes of goods sold under the opponent’s marks I accept the contention that virtually all relates to sales of clothing. The opponent clearly has an above average reputation amongst its clientele of young women aged between 9 - 15 years with regard to items of clothing.

26) I must now consider the marks. For ease of reference I reproduce the marks of the two parties below.

Applicant’s mark	Opponent’s marks
TOMMY GIRL	TAMMY

	Tammy Girl™
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27) Visually the marks TOMMY GIRL and TAMMY differ in that the applicant's mark has an additional word and the second letter of the initial word is an "O" whereas in the opponent's mark the second letter is an "A". The opponent's other mark TAMMY GIRL clearly is also two words and so the only difference is the second letter of the initial word.

28) Phonetically the marks differ. Both are relatively well known names and have definite pronunciations. Mr Abrahams contended that regard must be given to accents and brogues, and also the inclination of young girls to speak quickly. I accept that these points must be considered and I accept that the marks have phonetic similarities. Clearly in one comparison the applicant's mark has an additional word whereas in the other comparison the second words are identical. I bear in mind also that, although perfumes and cosmetics are generally purchased with a modicum of care, due allowance must also be made for imperfect recollection.

29) Both marks are well known forenames, one male the other female. The applicant's mark is unusual in that a male forename is linked with the word "GIRL". Whilst the term "Tomboy" is well known the applicant's mark must be regarded as being a syntactically unusual juxtaposition. The use of the word "GIRL" in the opponent's second mark would not be regarded as unusual.

30) In carrying the global assessment of the likelihood of confusion I take note of the comments of Buckley, J. in the *Buler* trade mark case [1966 RPC 141]:

"It seems to me that surnames stand in a different position from the point of view of spelling from ordinary words in the English language, for spelling is a matter of considerable importance in distinguishing one surname from another. One may easily understand the meaning of an ordinary word in the English language, although it is misspelt; but if one finds a surname spelt in a way which one does not expect it to be spelt one is immediately put upon inquiry as to whether or not it is the name of some other person than the person to whom one supposes the name to belong."

"I think that this aspect of the matter also involves some consideration of the phonetic aspect of the matter, for if the word as written would not appear prima facie to have the same sound as the name which it is said to be a misspelling of, then it seems to me more difficult to regard it as merely a misspelling of the name in question."

31) Although these comments were made regarding a case under the 1938 Act I do believe that the views expressed are still valid under the 1994 Act. Similarly, although the learned judge referred to surnames, I believe that his comments would extend to forenames, particularly where one is a very well known male forename and the other obviously female.

32) With all of this in mind I come to the conclusion that when all factors are considered, that there was no likelihood of confusion at 15 October 1996, between the applicant's mark

and any of the three opponent's marks. Consequently, the opposition under Section 5(2)(b) fails.

33) I next turn the ground of opposition under Section 5(4) 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) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark."

34) In deciding whether the mark in question "TOMMY GIRL" offends against this section, I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the WILD CHILD case (1998 14 RPC 455). In that decision Mr Hobbs stated that:

The question raised by the Grounds of Opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the Applicant from those of other undertakings (see Section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Art.4(4)(b) of the Directive and Section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the Applicant in accordance with the law of passing off.

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 Even 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.

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:

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.

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;

(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

(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."

35) With these considerations in mind I turn to assess the evidence filed on the behalf of the parties in the present proceedings as set out earlier in this decision, and the arguments put forward at the hearing. I will consider these under the three main headings of Goodwill, Misrepresentation and Damage.

GOODWILL

36) The opponent has shown in its evidence that it was trading in the UK under the marks TAMMY and TAMMY GIRL at the relevant date. The turnover figures for the six years prior to October 1996 show sales of clothing averaging £60 million per annum. They had approximately 200 retail outlets throughout the UK and also sold goods via mail order. No use of the opponent's mark with regard to goods in Class three has been shown.

MISREPRESENTATION

37) To succeed under this heading the opponent only has to show that the relevant public will believe the goods offered by the applicant are goods of the opponent. The relevant public in this case are young women between 9-15 years old.

38) Earlier in this decision I found that the marks TOMMY GIRL and TAMMY / TAMMY GIRL were not confusable and so there would not be any misrepresentation. I do not believe that members of the public would confuse the two trade marks, or believe that there was a trade connection between the users of the two marks. The opponent has filed no evidence that the trade or customers would expect TOMMY GIRL to be economically linked to TAMMY / TAMMY GIRL and the onus under Section 5(4)(a) is on the opponent (*South Cone Inc.* HC 2000 APP00617).

39) In my opinion use of the applicant's trade mark would not amount to a misrepresentation resulting in the passing off of its products as those of the opponent. On this footing the opposition under Section 5(4)(a) of the Act must fail.

40) Finally I turn to the ground of opposition under Section 5(3) which reads:

5 (3) A trade mark which -

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

(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 (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.

41) Section 5(3) of the Act is identical in all material respects to Section 10(3) of the Act. Throughout my decision I therefore intend to look to the comments of Neuberger J. dated 21 January 2000 in the case of Premier Brands UK Ltd v Typhoon Europe Ltd [2000] FSR 767,

hereinafter referred to as “Typhoon”.

Confusion

42) The issue of whether it was necessary to show confusion was raised at the hearing. In Typhoon Neuberger J stated at page 788:

“It appears tolerably clear to me from the terms of Section 10, that confusion is not a necessary ingredient to establishing infringement under Section 10(3). Indeed, this now seems to be established by authority: see Sabel [1998] RPC 199 at 223: the same view was taken by Advocate -General Jacobs in General Motors [1999] All ER (EC)865 when he said at 870 (paragraph 26)

‘[T]he issue was resolved by the [ECJ] in its judgment in Sabel....., which made it clear, when ruling on Article 5(1)(b) that Article 5(2) did not require confusion.’

(This is also consistent - or at least not inconsistent - with the view expressed obiter by Aldous LJ in British telecommunications Plc v One in a million Ltd [1999]FSR 1 at 25.)”

43) The absence of instances of actual confusion in the opponent’s evidence is not therefore fatal to their case.

Without due cause?

44) In Typhoon (at page 790) Neuberger J stated:

“The purpose of Section 10(3) is, as I have indicated, to protect the value and goodwill of trade marks, particularly in cases where they are well known, from being unfairly taken advantage of or unfairly harmed. I accept, of course, that, as the very use of the word “unfairly” demonstrates the section is not intended to confer absolute rights on trade mark proprietors in all circumstances. However, it does not appear to me likely that it could have been envisaged that the use of a sign for goods which may in practice very heavily damage the value of a mark, whose development and exposure has been the subject matter of considerable effort and expense by the proprietor, should be immune from attack by the proprietor of the mark simply because the sign was innocently adopted. Such a construction of Section 10(3) would not only be capable of producing an unfair, even capricious, result so far as the proprietor of the trade mark is concerned, it would also encourage those considering adopting new signs to carry out a minimum amount of research, and could fairly be said to be conferring an advantage on the ignorant and lazy over the well-informed and careful. Furthermore, it seems to me undesirable that the outcome of a case where the court is satisfied that the allegedly infringing sign will seriously damage the reputation of the registered mark should depend on the view which the court forms as to the knowledge, subjective intentions, and even the unconscious desires, of the owner of the allegedly infringing sign.”

“Secondly, although I accept that the words “being without due cause” are somewhat

opaque in their effect, I consider that they have to be read as not merely governing the words “the use of the sign”, but also as governing the words “takes unfair advantage of, or is detrimental to”. Section 10(3) must be read in a commercially sensible way. Bearing in mind its overall purpose, it appears to me that (without at this stage intending to indicate where the burden of proof lies) it requires the defendant to show not merely that the use of the allegedly infringing sign in connection with the defendant’s goods is “with due cause”, it also requires him to show that although the use of the sign might otherwise be said “to take unfair advantage of or is detrimental to” the mark, the advantage or detriment are not “without due cause”.

“Thirdly, it appears to me that this conclusion is consistent with the view of the Benelux Court in *Lucas Bols* [1976] IIC 420 at 425, where, when discussing the meaning of “without justifiable reason” which appeared in a similar context in the Uniform Benelux Trade Mark Act as “without due cause” in Section 10(3), the Court said this:”

“What this requires, as a rule, is that the user (of the mark) is under such a compulsion to use this very mark that he cannot honestly be asked to refrain from doing so regardless of the damages the owner of the mark would suffer from such use, or that the user is entitled to the use of the mark in his own right and does not have to yield this right to that of the owner of the mark....”.

“On the same page, the court went on to suggest that a ‘justifiable reason’ may be ‘if the user can assert an older right than that of the [registered proprietor]’ but went on to emphasise that whether the alleged infringer can establish a ‘justifiable reason’ must be ‘resolved by the trial judge according to the particular facts of each case.’.”

45) The applicant claims that the mark in suit is merely an extension of the use of the TOMMY HILFIGER marks with products clearly aimed at females. The applicant only began use of the mark in the UK in 1997. The opponent had, by the relevant date, used its mark for approximately twenty years.

46) In order to bring an action under Section 5(3), the opponent needs to show that the goods are dissimilar and that they have a reputation in their earlier mark. I have found earlier in this decision, see paragraph 25, that the opponent’s mark had, at the relevant date, a reputation for female clothing in Class 25. The applicant’s specification is, broadly, for perfumes and cosmetics which are clearly dissimilar goods, therefore the second leg of Section 5(3) is satisfied.

47) In these circumstances I have no hesitation in reaching the conclusion that, if Etam Public Limited Company can otherwise succeed in its claim under 5(3) the applicant can obtain no assistance from the words “without due cause” in that section.

Taking unfair advantage

48) This was not covered in their evidence and at the hearing Mr Abrahams made no reference to this.

Detriment

49) In summary, the opponent's case that the applicant's use of the TOMMY GIRL mark causes and will cause detriment to the distinctive character or repute of the TAMMY / TAMMY GIRL trade marks is as follows:

- a) The similarities between the trade marks will, despite the differences in the goods, result in members of the public associating the goods of the applicant with those of the opponent. The close relationship between the goods (clothing and cosmetics) will increase the chances of association between the marks.
- b) The use of the mark by the applicant on the goods covered by its specification will result in a reduction of the "differentness" of the opponent's mark. The opponent's mark will no longer be as different from the rest of the field as it was before and hence "blurring" of the opponent's mark has occurred.
- c) The applicants use of the mark TOMMY GIRL on perfumes and cosmetics would inhibit the ability of the opponent to use its mark on similar products and would cause damage to the value of the opponent's mark.

50) I shall consider these contentions in turn.

Association

51) The opponents contend that it is well established that successful fashion labels will launch a range of cosmetics and/or perfume. In my view, this contention would appear to be borne out by the applicant's actions. They also contend that the average consumer would, on seeing the applicant's mark in use on cosmetics and perfumes, assume that the opponent had made the move or crossover from fashion into cosmetics and perfumery.

52) I do not accept that the average consumer would reach this conclusion. The average consumer in the instant case is a young female aged between 9-15 years. Mr Abrahams acknowledged that such consumers were brand conscious. Earlier in this decision I compared the marks of the two parties. In my view the average consumer would not perceive the applicant's mark as being in any way associated with the opponent. The marks are two recognisable forenames, one male the other female. The syntactically unusual juxtaposition of a male forename with the word GIRL after it is highly distinctive. The applicant's mark would not be associated with the opponent.

Blurring

53) The opponent contends that its "differentness" to the rest of the field will be reduced by the applicant's use of its mark. The opponent did not file any evidence as to the state of the market, or the uniqueness of their mark in the cosmetics / perfumery market. In my opinion, the use of recognisable forenames on such products is somewhat common. The presence of another clearly distinguishable forename could not be said to reduce the differentness of the opponent's mark. In coming to this view I have taken into account the reputation of the opponent.

Inhibition

54) In the absence of confusion or association I do not accept that the opponent will be fettered in the use of its mark on cosmetics / perfumery.

55) I therefore find that the opposition fails on the ground under Section 5(3).

56) The opposition having failed the applicant is entitled to a contribution towards costs. I order the opponent to pay the applicant the sum of £1535. This sum 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 05 day of April 2002

George W Salthouse
For the Registrar
The Comptroller General

ANNEX A

Mark	Number	Effective Date	Class	Specification
TAMMY	2032089	31.08.95	3	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.
TAMMY	1254427	15.11.85	14	Jewellery, chronometric instruments
TAMMY	1254428	15.11.85	18	Articles made of leather or of imitation leather; bags and cases; all included in Class 18; skins and hides; trunks (luggage) and umbrellas.
TAMMY	1019673	26.10.73	25	Articles of clothing for women and girls; but not including headwear.
TAMMY ATTITUDE	2023480	9.6.95	18	Bags, handbags, luggage, suitcases, rucksacks, briefcases, holdalls, trunks, suit carriers, hat boxes, purses, wallets; articles made of leather and imitations thereof; umbrellas and parasols.
TAMMY ATTITUDE	1540977	6.7.93	25	Articles of clothing; headgear; footwear; all included in Class 25.
TAMMY BY ETAM Registration of this mark shall give no right to the exclusive use of the word "Tammy".	1254426	15.11.85	3	Soaps; perfumes; essential oils; cosmetics; hair lotions; cleaning and polishing preparations and substances; non-medicated toilet preparations.
TAMMY GIRLS DIVISION	1578817	20.7.94	18	Bags, handbags, luggage, suitcases, rucksacks, briefcases, holdalls, trunks, suit carriers, hatboxes, purses, wallets; articles made of leather and imitations thereof; umbrellas and parasols; all included in Class 18.

	2105644	23.7.96	25	Articles of clothing, footwear, headgear.
<p>TAMMY GIRLS DIVISION</p> <p>Registration of this mark shall give no right to the exclusive use of the words "Girls Division".</p>	1553884	17.11.93	25	Clothing, footwear, headgear; all included in Class 25.
TAMMY GIRLZ DIVISION	2017413	12.4.95	18	Bags, handbags, luggage, suitcases, rucksacks, briefcases, holdalls, trunks, suit carriers, hat boxes, purses, wallets; articles made of leather and imitations thereof; umbrellas and parasols.
TAMMY GIRLZ DIVISION	2014265	13.3.95	25	Clothing, footwear, headgear, all for women and girls.
	2223633	pending	3	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 use; dentifrices.