

O-217-06

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION
NOS. 2304243, 2331118 AND 2319404
IN THE NAME OF TALAT ISMAIL
TO REGISTER TRADE MARKS IN CLASSES 3 AND 14**

AND

**IN THE MATTER OF CONSOLIDATED OPPOSITIONS THERETO
UNDER NOS. 91320, 91974 AND 91975 IN THE NAME OF
JUICY COUTURE, INC.**

Trade Marks Act 1994

**IN THE MATTER OF Trade Mark application
Nos. 2304243, 2319404 and 2331118
in the name of Talat Ismail,
to register trade marks in Classes 3 and 14**

And

**IN THE MATTER OF consolidated oppositions thereto
under Nos. 91320, 91974 and 91975
in the name of Juicy Couture Inc.**

BACKGROUND

1. On 2 July 2002, Talat Ismail made an application, numbered 2304243, to register the trade mark JUICY DIAMONDS in Classes 3 and 14 in relation to the following specifications of goods:

Class 03: Bleaching preparations, other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.

Class 14: Precious metals, and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments.

2. On 24 December 2002, Mr Ismail made a second application, numbered 2319404, to register the trade mark JUICY, in Class 14 in relation to the following specification of goods:

Class 14: Precious metals, and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments.

3. On 2 May 2003, Mr Ismail made a third application, numbered 2331118, to register the trade mark JUICY SILVER in Class 14 in relation to the following specifications of goods:

Class 14: Precious metals, and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments.

4. On 7 April 2003 and 12 September 2003, Juicy Couture, Inc. filed notice of opposition to these applications, the grounds of opposition being as follows:

5. In relation to application No. 2304243:

1. Under Section 5(2)(b) “because the opponents’ Community trade mark application No 2759942 JUICY COUTURE was filed on 3 July 2002 and covers a wide range of goods and services in classes 3, 18 and 35. The class 3 goods covered by the application No. 2759942 are in part identical and in part similar to the class 3 goods covered by application 2304243. The opponents’ said Community trade mark application No. 2759942 therefore constitutes an “earlier trade mark” within the meaning of section 6(1)(a) of the Trade Marks Act 1994.”

2. Under Section 5(4)(a) by virtue of the law of passing off.

3. Under Section 5(3) The subject application No. 2304243 has been applied for in class 3 in respect of, inter alia, a range of cosmetics and cleaning products and in class 14 in respect of jewellery. The goods of primary interest to the opponent are in the nature of clothing that falls in class 25. Therefore, prima facie, such goods are not the same or similar.

...the adoption by a third party of a confusingly similar trade mark to the opponent’s is very likely to cause confusion and deception when used in respect of the class 3 and class 14 goods covered by the application No. 2304243 because the production and sale of such products is so closely related to the fashion industry. Consequently, registration of the mark applied for would take unfair advantage of, or be detrimental to the distinctive character or repute of the opponent’s trade marks...”

6. In relation to the applications numbered 2331118 and 2319404 the opposition is founded on Sections 5(3) and 5(4)(a), the objections being expressed in similar terms.

7. Details of the earlier marks relied upon by the opponents are shown as an annex to this decision.

8. The applicants filed a counterstatement in which they deny the grounds on which the opposition is based.

9. Both sides ask that an award of costs be made in their favour.

10. Both sides filed evidence in these proceedings. The matter came to be heard on 26 October 2005, when the applicants were represented by Mr Victor Caddy of Wynne, Jones,

Laine & James, their trade mark attorneys. The opponents were represented by Mr George Hamer QC of Her Majesty's Counsel, instructed by Marks & Clerk, their trade mark attorneys.

OPPONENTS' EVIDENCE

11. The opponents' evidence in chief was filed prior to the cases having been consolidated. There is one Witness Statement dated 12 September 2003 from Esther Mary Gottschalk, a technical assistant employed by Marks and Clerk that relates to the opposition against application No. 2304243, and three copies of an identical Witness Statements dated 16 September 2003, 10 March 2004 and 11 April 2004, filed by Mr Stewart Penrose Hosford, filed in relation to each of the three oppositions.

12. In her Witness Statement, Ms Gottschalk states that she has undertaken research relating to the extent that identical trade marks are used by the same proprietors in respect of both jewellery and clothing, the research being conducted through desktop research and a visit to Harrods department store. Ms Gottschalk exhibits the results of her research at EMG1 and EMG2, which shows that seven leading clothing designers sell jewellery under their name, but with the exception of products sold under the brand name Chloe, not that they all do so under the same trade mark, or if they do, that this was the case at the relevant date.

13. The Witness Statement from Mr Hosford exhibits evidence (SPH1 to SPH3) filed in other opposition proceedings.

14. Exhibit SPH1 consists of an Affidavit dated 8 March 2003, from Gela Taylor, President of Travis Jeans, Inc, a position she has held since 1990. Ms Taylor affirms that the information contained within the Affidavit comes either from her own knowledge, or from the books and records of her company to which she has full access.

15. Ms Taylor confirms her company's ownership of the earlier marks relied upon in these proceedings, details of which she exhibits at TJ1. She states that her company first used the trade mark JUICY in the United States in October 1996, in relation to a range of designer clothes, mentioning in particular, jeans. Ms Taylor gives the date of first use of JUICY in the UK as "at least as early as 30 May 1998", with clothes bearing the JUICY COUTURE and JUICY JEANS trade marks being first sold on 11 November 1998 and 31 March 2000, respectively. Ms Taylor states that sales have mainly been through high-class fashion stores. Exhibit TJ2 consists of a collection of invoices relating to sales to customers in the UK. The invoices date from 11 November 1998, and show sales of clothing, primarily to Harvey Nichols. None of the product descriptions mention JUICY or JUICY COUTURE, although the originator details state "Travis Jeans, In., dba JUICY and give the following website address "<http://www.juicycouture.com>". Ms Taylor states that sales of her company's clothing in the UK for the period May 1998 to December 2001, and January to May 2002, amounted to \$372,000 and \$1,465,000, respectively.

16. Ms Taylor says that in the period March to November 2001, her company spent almost £140,000 promoting its clothing in the UK, although not specifically mentioning whether this relates to JUICY. Exhibit TJ3 consists of invoices relating to this expenditure, and show that whilst sums have been spent in the creation of promotional materials, some of the amounts

claimed relate to administrative and organisational activities, such as a retainer fee, hire of furniture, etc, none of which would have had an impact on consumer awareness. Ms Taylor states that exhibit TJ4 consists of copies of two promotional packs containing news articles relating to JUICY/ JUICY COUTURE. She says that her company has been represented at major fashion shows in Europe that would have attracted attention from the UK. Exhibit TJ6 consists of further press articles relating to JUICY COUTURE products, primarily jeans.

17. Apart from giving details of trade mark registration in the US, that Ms Taylor says illustrates that designers have registered identical trade marks in respect of both clothing and perfumery, the remainder of the Affidavit consists of submissions on the relative merits of the case. Whilst I do not consider it to be necessary, or appropriate to summarise these, I will take them fully into account in my determination of this case.

18. Exhibit SPH2 consists of a copy of a Witness Statement dated 10 March 2003, made by Mr Hosford. The Statement exhibits the result of a search to “ascertain the prevalence of registration of trade marks in Classes 3 and 25 by fashion designers”. Mr Hosford states that in order to make these searches he relied, to a certain extent, upon his own knowledge.

19. Exhibit SPH3 consists of a further Witness Statement, dated 11 April 2003, by Esther Mary Gottschalk. Ms Gottschalk says that she was instructed to undertake research to establish the extent to which traders use identical trade marks on both clothing and perfumes/cosmetics. She says that her investigations were conducted through desktop research and a visit to Harvey Nichols department store. The results of her research are shown as exhibit EMG1, and whilst this does show that some proprietors use their name in relation to clothing and perfumery/cosmetics, it does not conclusively establish that they sell such goods under the same trade mark, or if they do, that this was the case at the relevant date.

APPLICANTS' EVIDENCE

20. This consists of a Witness Statement dated 19 August 2004 from Talat Ismail, a jeweller and the applicant for registration.

21. Mr Ismail says that through two companies he designs, sources and manufactures jewellery which is sold directly to the public through retail outlets under the name of Silver Mine, and also to other retailers. Mr Ismail says that his shops also sell jewellery from other manufacturers.

22. Mr Ismail says that in the Summer of 2001, he brought out a range of diamond rings under the name JUICY DIAMONDS, later adding to the range with jewellery incorporating other precious and semi-precious stones which he began selling under names like JUICY GEMS, JUICY TOPAZ, JUICY GARNET, JUICY SMOKEY QUARTZ and JUICY AMETHYST, finally adding JUICY SILVER. He does not give any further details such as the dates the use commenced. Mr Ismail says that in addition, he uses the names JUICY DIAMONDS, JUICY SILVER and JUICY GEMS as trading styles and also in domain names that he owns.

23. Mr Ismail refers to exhibits TI-1, TI-2 and TI-3, which consist of photographs of the

frontage of a shop named Silver Mine, display cabinets containing jewellery with the names, JUICY SILVER, JUICY DIAMONDS and JUICY SAPPHIRE, a jewellery box marked inside JUICY SILVER, and letter-heads and blank pro-forma invoices. Mr Ismail states that the photographs were taken at the date of his Statement, and although undated, the use depicted would be as it has been from the date of first use.

24. Mr Ismail gives details of turnover for sales under the JUICY marks, which ranges from at least £12,000 in 2002, £22,000 in 2003, and to the end of July 2004, not less than £17,600. Mr Ismail states that the figures are a composite of sales at retail and wholesale prices, the goods retailing at about £30 to £90 per item.

25. Mr Ismail says that he is a member of the British Jewellers Association, and refers to exhibit TI4, which consists of an article published in the Jeweller magazine in March 2003, and which features Mr Ismail's jewellery. Mr Ismail gives the circulation of the magazine as being about 4000 people in the UK jewellery trade. Mr Ismail states that since 2002 he has exhibited his own brand jewellery under the JUICY name at the International Jewellery Exhibition at Earls Court, London.

Opponents' evidence in reply

26. This consists of three Witness Statements. The first is dated 19 November 2004, and comes from Stewart Penrose Hosford.

27. Mr Hosford states that he obtained figures from two organisations relating to the retail turnover of jewellery products in the UK. Exhibit SPH4 consists of the letters sent in enquiry, exhibits SPH5 and SPH6 being the replies, which state that in 2003 the market stood at £2,755 million, from which Mr Hosford asserts that Mr Ismail's use is de-minimis. The remainder of Mr Hosford's Statement consists of submissions, mostly in response to the applicant's evidence. This being the case I do not consider it to be appropriate, or necessary for me to summarise it. I will, of course, take these submissions fully into account in my decision.

28. The second Witness Statement is dated 18 March 2005, and comes from Anita Jacobson, Director of Marketing and Licensing for Juicy Couture, Inc. Ms Jacobson states that she is responsible for the development of the JUICY COUTURE brand, including expansion into new categories of goods and services, through which she says she has become familiar with the jewellery industry. Ms Jacobson claims over 15 years experience in the fashion industry in several marketing positions, stating that it is her belief that the fashion industry considers jewellery to be a clothing accessory, and that consumers are likely to associate brands used on jewellery with similar brands used on clothing.

29. Ms Jacobson confirms that JUICY COUTURE was introduced to the UK in 1999, which is slightly at odds with Ms Taylor who gives the date of first use in the UK as 11 November 1998, and that JUICY is a shortened form of the mark. Ms Jacobson goes on to claim that by 2001, JUICY and JUICY COUTURE were well known fashion brands, and were the subject of significant media coverage in the UK, and that JUICY COUTURE products were sold in several fashion outlets in the UK. She continues stating that by early 2002, apparel sold under the JUICY/JUICY COUTURE brands was sufficiently well known in the UK for the

majority of consumers and employees in the consumer jewellery industry to have known about it. Ms Jacobson says that by June 2002, apparel sold under the JUICY and JUICY COUTURE marks was being sold in several stores in the UK, mentioning Harvey Nichols, Liberty and Sefton.

30. The final Witness Statement is dated 21 April 2005, and comes from Stewart Penrose Hosford. Mr Hosford refers to exhibits SPH7 and SPH8, which he says consists of advertising and publicity material that had become available since his previous Statement. The exhibits come from trade and mainstream publications, all preceding the relevant dates in these proceedings, and show that the opponents have been using the mark JUICY COUTURE in the UK in relation to high-end fashion clothing. They also show that the brand is frequently referred to as JUICY.

31. That concludes my summary of the evidence insofar as it is relevant to these proceedings.

PRELIMINARY ISSUE

32. Under cover of a letter dated 18 October 2005, Mr Hosford, of Marks & Clerk, the opponents' representatives, made a request to file an amended Statement of Grounds in relation to opposition to application Nos. 2319404 (Opposition No. 91975) and 2331118 (Opposition No. 91974). The request was copied to Wynne Jones Laine and James, the applicants' representatives. In the letter, Mr Hosford stated:

"We would refer to previous correspondence in connection with the above and, following discussions with Counsel, we are now filing herewith amended Statements of Grounds with regard to the oppositions to both applications nos. 2319404 and 2331118.

We believe it was implicit in the original Statement of Grounds that the opponents objected to the registration of these trade marks under Section 5(2)(b) bearing in mind the reference to the prior rights of the opponent in paragraph 2 of the Statement of Grounds. Counsel has suggested that this be made explicit and we are therefore attaching fresh copies of the Statements of Grounds where we have added two new paragraphs 3 and 4 and renumbered the remaining paragraphs. No other amendments have been made"

33. Under cover of a letter dated 21 October 2005, Mr Hosford made a further request to amend the pleadings in relation to these, and the third opposition against application no. 2304243 (Opposition No. 91974). The basis for the amendments requested were put as follows:

"So far as concerns the Statement of Grounds relating to Applications Nos. 2319404 and 2331118, in our haste, because of the imminent Hearing, to specifically mention Section 5(2)(b), we simply copied and pasted paragraphs 3 and 4 from the original Statement of Grounds submitted in connection with Application No. 2304243 without stopping to consider whether the original Statement of Grounds was correct or whether the new paragraphs were entirely appropriate for the two later filed applications. Our sincere apologies to all concerned due entirely to our haste in

making it quite clear that we would be pursuing a Section 5(2)(b) point with regard to all three oppositions.

Following further discussions with Counsel, we have now added an additional paragraph "5" to the Statement of Grounds in respect of Applications Nos. 2319404 and 2331118. The extra paragraph simply identifies the Opponents Trade Marks No. 2831147 and 2829711 (and not just 2759942 and 2829224) as specific claims under Section 5(2)(b). The only other amendment is to re-number the succeeding paragraphs.

We have also amended the Statement of Grounds in connection with Application No. 2304243 so as to specifically identify all five of the Opponents prior trade marks and we have done this by inserting a new paragraph 4 to identify 1177377: amending and re-numbering the old paragraph 4 so that it refers only to No. 2759942: and then introducing new paragraphs 6, 7 and 8 to specifically refer to No's . 2829224, 2831147 and 2829711, respectively. The only other amendment is to re-number the succeeding paragraphs.

All three Statements of Grounds identified the Opponents prior Community Trade Mark Registration No. 1177377 and their four Community Trade Mark applications (now registered) Nos. 2759942, 2831147, 2829711 and 2829224 as grounds for opposition. We understand that these prior rights must necessarily be considered by the Hearing Officer, irrespective of whether or not the Statement of Grounds includes a specific plea under Section 5(2)(b). The respective trade marks are not identical and, consequently, Section 5(2)(a) does not apply."

34. The only specific mention of Section 5(2)(b) in any of the Statements of Grounds originally filed is in respect of opposition No. 91320, the relevant paragraph reading as follows:

"4. The opponent's Community trade mark application No. 2759942 JUICY COUTURE was filed on 3 July 2002 and covers a wide range of goods and services in classes 3, 18 and 35. The Class 3 goods covered by application No. 2759942 are in part identical and in part similar to the class 3 goods covered by application No. 2304243. The opponent's said Community trade mark application No. 2759942 therefore constitutes an "earlier trade mark" within the meaning of section 6(1)(a) of the Trade Marks Act 1994. Consequently, registration of the mark applied for would be contrary to the provisions of section 5(2)(b) of the Trade Marks Act 1994."

35. From the Statement of Grounds enclosed with the letter of 21 October 2005, this was to be replaced by:

"4. The opponent's Community trade mark registration No. 1177377 JUICY COUTURE was filed on 19 May 1999 and covers a wide range of goods in class 25. The opponent's said Community trade mark registration No. 1177377 therefore constitute an "earlier trade mark" within the meaning of section 6(1)(a) of the Trade Marks Act 1994. Consequently, registration of the mark applied for would be contrary to the provisions of section 5(2)(b) of the Trade Marks Act 1994.

5. The opponent's Community trade mark application No. 2759942 JUICY COUTURE was filed on 3 July 2002 and covers a wide range of goods and services in classes 3, 18 and 35. There is a convention priority claim of 3 January 2002 so far as concerns the goods in class 18. The opponent's said Community trade mark applications No. 2759942 therefore constitutes an "earlier trade mark" within the meaning of section 6(1)(a) of the Trade Marks Act 1994. Consequently, registration of the mark applied for would be contrary to the provisions of section 5(2)(b) of the Trade Marks Act 1994.

6. The opponent's Community trade mark application No. 2829224 JUICY BABY was filed on 27 August 2002 and covers a wide range of goods and services in classes 3, 25 and 35. There is a convention priority claim of 28 February 2002 so far as concerns the goods in class 25. The opponent's said Community trade mark application No. 2829224 therefore constitutes an "earlier trade mark" within the meaning of section 6(1)(a) of the Trade Marks Act 1994. Consequently, registration of the mark applied for would be contrary to the provisions of section 5(2)(b) of the Trade Marks Act 1994.

7. The opponent's Community trade mark application No. 2831147 JUICY COUTURE was filed on 28 August 2002 and covers a wide range of goods and services in classes 3 and 35. There is a convention priority claim of 28 February 2002 so far as concerns most of the goods in class 3 and all of the services in class 35. The opponent's said Community trade mark application No. 2831147 therefore constitutes an "earlier trade mark" within the meaning of section 6(1)(a) of the Trade Marks Act 1994. Consequently, registration of the mark applied for would be contrary to the provisions of section 5(2)(b) of the Trade Marks Act 1994.

8. The opponent's Community trade mark application No. 2829711 JUICY JEANS was filed on 27 August 2002 and covers a wide range of goods and services in classes 18, 25 and 35. There is a convention priority claim of 28 February 2002 so far as concerns all of the services in class 35. The opponent's said Community trade mark application No. 2829711 therefore constitutes an "earlier trade mark" within the meaning of section 6(1)(a) of the Trade Marks Act 1994. Consequently, registration of the mark applied for would be contrary to the provisions of section 5(2)(b) of the Trade Marks Act 1994."

36. The effect of this change of wording was to bring into consideration a further 4 of the opponent's Community trade marks, but more significantly, made it clear that the opponents' objection under Section 5(2)(b) was in respect of both Class 3 and Class 14 of the application. The applicants would have been aware of the existence of CTM No. 2829224, the opponents having listed this, and two other CTM marks in paragraph 2 of the original (and revised) Statement of Grounds. Whilst the original paragraph 4 only mentioned Class 3, the following paragraphs of the Statement of Grounds indicated that the opponents' objection extended to Class 14 also. Paragraph 7 in particular read as follows:

"The trade mark applied for contains as a prominent feature the word JUICY. It is well established that it is the initial letter, syllable or word that is generally most

important in distinguishing between marks. The addition of the word DIAMONDS to the applicant's trade mark is insufficient to distinguish. The word DIAMONDS is simply the name of the class 14 goods and is little more than a laudatory puff in respect of class 3 goods. There is a clear similarity between the respective trade marks visually, phonetically and conceptually such that there exists a likelihood of confusion and/or association on the part of the public who will not be able to distinguish between the respective trade marks."

37. Whilst this paragraph does not explicitly mention Section 5(2)(b), the wording "likelihood of confusion and/or association" is the relevant consideration for an objection under that head.

38. In respect of opposition Nos. 91974 and 91975, the Statement of Grounds enclosed with the letter of 21 October 2005 added the following paragraphs:

"4. The opponent's Community trade mark application No. 2759942 JUICY COUTURE was filed on 3 July 2002 and covers a wide range of goods and services in classes 3, 25 and 35. The opponent's Community trade mark application No. 2829224 JUICY BABY was filed on 27 August 2002 and covers a wide range of goods and services in classes 3, 25 and 35. The opponent's said Community trade mark applications No. 2759942 and 2829224 therefore both constitute an "earlier trade mark" within the meaning of section 6(1)(a) of the Trade Marks Act 1994. Consequently, registration of the mark applied for would be contrary to the provisions of section 5(2)(b) of the Trade Marks Act 1994.

5. The opponent's Community trade mark application No. 2831147 JUICY COUTURE was filed on 28 August 2002 and covers a wide range of goods and services in classes 3 and 35. The opponent's Community trade mark application No. 2829711 JUICY JEANS was filed on 27 August 2002 and covers a wide range of goods and services in classes 18, 25 and 35. The opponent's said Community trade mark applications No. 2831147 and 2829711 therefore both constitute an "earlier trade mark" within the meaning of section 6(1)(a) of the Trade Marks Act 1994. Consequently, registration of the mark applied for would be contrary to the provisions of section 5(2)(b) of the Trade Marks Act 1994."

39. As I have already said, the original Statement of Grounds in respect of these oppositions made no mention of Section 5(2)(b), nor was there anything that could be construed as implying that these oppositions also included that ground. There was no dispute that I had the discretion to amend the pleadings.

40. Tribunal Practice Notice (TPN) 4/2000 provided practitioners with an indication of the information that the Registrar will expect to be contained in Statements of Case and Counter-statements, and the procedure which the Registrar was to adopt with respect, inter alia, in relation to requests for amendment to these documents. The following is an extract of the relevant sections of TPN4/2000 relating to requests to amend a Statement of Grounds :

"Amendments to statements of case & counter-statements

22. As parties will be expected to file focussed statements of case and counterstatements, the Trade Marks Registry will consider requests to amend these documents later in the proceedings. Amendments may include adding or removing a ground of opposition/revocation or invalidity or correcting information contained therein. If an amendment becomes necessary parties should seek leave to make the amendment at the earliest opportunity. When seeking leave to amend full details of the amendment together with the reasons for the amendment should be submitted.

Whilst each request to amend will be considered on its merits the Registry will aim to give favourable consideration to such requests on the basis that it is likely to avoid a multiplicity of proceedings and thus help resolve the dispute between the parties quickly and at less cost. If the amendment requires the other party to file an amended counter-statement or additional evidence, an award of costs to cover this may be made.”

41. In *Cobbold v London Borough of Greenwich* (Court of Appeal, 9 August 1999, unreported) Peter Gibson L J considered the approach that should be adopted under the Civil Procedure Rules 1998 in relation to requests to amend (see paragraph 17.3.5 of Civil Procedure):

“The overriding objective is that the court should deal with cases justly. That includes, so far as practicable, ensuring that each case is dealt with not only expeditiously but also fairly. Amendments in general ought to be allowed so that the real dispute between the parties can be adjudicated upon provided that any prejudice to the other party or parties caused by the amendment can be compensated for in costs, and the public interest in the efficient administration of justice is not significantly harmed.”

42. As is stated in the *Cobbold* decision, the rules governing the amendment of Statements of Case are to be found in Part 17 of the CPR, Rule 17.3 stating:

“Where the court gives permission for a party to amend his statement of case, it may give directions as to:

- (a) amendments to be made to any other statement of case; and
- (b) service of any amended statement of case.”

43. CPR 17.3.5 goes on to state:

“Under the previous rules the Court would refuse permission to amend only in exceptional cases where an amendment could not be made without doing injustice to the other party: it is a well established principle that the object of the Court is to decide the rights of the parties and not to punish them for mistakes they make in the conduct of their cases by deciding otherwise than in accordance with their rights.

I know of no kind of error or mistake which, if not fraudulent or intended to overreach, the court ought not to correct if it can be done without injustice to the other party. Courts do not exist for the sake of discipline but for the sake of deciding matters in controversy, and I do not regard such amendment as a matter of favour or grace.....it seems to me that as soon as it appears that the way in which a party has framed his case will not lead to a decision of the real matter in controversy, it is as

much a matter of right on his part to have it corrected if it can be done without injustice, as anything else in the case is a matter of right (per Bowen L J in *Cropper V Smith* (1884 26 Ch.D 706 at 710-71) however negligent or careless may have been the first omission and however late the proposed amendment, the amendment should be allowed if it can be made without injustice to the other side. There is no injustice if the other side can be compensated by costs *Clarapede v Commercial Union Association* (1883) 32 W.R. - 262 at 263.

However, other pre-CPR cases emphasis that, where permission to amend was sought at trial, justice cannot always be measured in terms of money and a judge is entitled to weigh in the balance additional issues.

In the present application, the opponents regretfully decided to amend the grounds of opposition late and after the pleadings were originally settled but such an error can be accommodated for in costs and without any amendment to the evidence timetable. The detriment to the applicant is minimal insofar as it has failed to file its evidence in support of the application in any event.

The CPR and supporting case law envisage such an amendment as a matter of right and that delay (save for one resulting in an amendment to the pleadings at the date of trial, where the application will only be granted subject to additional matters being weighed in the exercise of the discretion) will be condoned.”

44. Whilst the CPR places the balance in favour of the amendment, it draws a distinction with requests for an amendment to the pleadings at the date of trial, saying that the application will only be granted subject to additional matters being weighed in the exercise of the discretion.

45. Mr Caddy argued that Marks & Clerk are a professional organisation, and should have known the requirements relating to Statements of Grounds. If they had intended to argue Section 5(2)(b) they should have clearly said so. The fact that Section 5(2)(b) is mentioned in the pleadings for opposition No. 91320, but not in those filed in relation to opposition Nos 91974/91975 is a glaring inconsistency and in these circumstances the applicants were justified in assuming that that ground was not being pursued against the latter two cases.

46. On my reading, it is clear to me that the Statement of Grounds for opposition No. 91320 only specifically mentioned Section 5(2)(b) in relation to Class 3, but in my view there was enough in the wording of the other paragraphs to have indicated to the educated that the opponents' objection extended to Class 14. However, in the other two cases there was no mention of Section 5(2)(b) at all, or anything that could be taken as inferring that there was an objection under that section.

47. Whether or not the objection was already there, the above case law shows that “however negligent or careless may have been the first omission”, in the interest of gaining a final determination and avoiding a multiplicity of proceedings, a request for an amendment to the pleadings should not be rejected unless allowing the revision would cause the applicants to suffer detriment or damage from which they could not recover, either through costs or some other means.

48. It is almost inevitable that in any case where one side seeks to improve or clarify their

case, the other party will consider that their case is going to be harmed. I asked Mr Caddy whether, and if so how, the applicants would be disadvantaged by allowing the amendments, to which Mr Caddy responded that had the applicants been aware that the ground under Section 5(2)(b) also extended to Class 14, they may have filed additional evidence from the trade relating to trade practices, whether a single brand is used on a range of products, in this case, jewellery, cosmetics and clothing, the overall aim being to assist in determining the likelihood of confusion. I accepted that in the circumstances of this case this was not an unreasonable request. The amended Statements of Grounds were admitted, and Mr Caddy was granted two months in which to file any such evidence. The applicants subsequently decided not to file evidence.

49. Having disposed of the preliminary issue, I expressed my view that I did not consider it necessary to adjourn. To do so would delay the case and cause both parties the expense of reconvening at some later date. The original pleadings had encompassed Section 5(2)(b), albeit somewhat differently, but the issues on which submissions would be required had not changed significantly. Mr Hamer said that with the emphasis on case management he considered it sensible to continue. Although having some initial misgivings, Mr Caddy confirmed that the basis and relevant case law of Section 5(2)(b) is well settled, and that he was happy to go on and make his case based on the amended pleadings.

DECISION

50. I turn first to consider the ground under Section 5(2)(b). The relevant part of the statute reads:

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

(a)

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

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

51. An earlier trade mark is defined in Section 6 of the Act as follows:

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

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,”

52. I take into account the well established guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v.*

Klijzen Handel B.V. [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG and Addidas Benelux BV* [2000] E.T.M.R. 723. It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijzen Handel B.V.* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;
- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG*, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

53. In any analysis it is inevitable that reference will be made to the elements of which a mark is composed, and rightly so, for the case law requires consideration to be given to the distinctiveness and dominance of the component parts. However, it must be remembered that the consumer does not embark on an analysis of trade marks, and it is the marks as a whole that must be compared.

54. I must also bear in mind the nature of the goods and services for which the respective marks are, or may be used, for if the items are usually obtained by self selection it will be their visual appearance that will have greater significance, whereas if they are obtained only on request, greater importance should be attributed to their similarity in sound. But whatever is the case, the consideration must take account of all relevant factors.

55. The opponents cite five earlier marks; Community Trade Mark No.1177377 JUICY COUTURE, Community Trade Mark No. 2759942 JUICY COUTURE, Community Trade Mark No. 2829224 JUICY BABY, Community Trade Mark No. 2831147 JUICY COUTURE and Community Trade Mark No. 2829711 JUICY JEANS. In their skeleton argument, the applicants referred to the fact that these marks are recorded as being in the ownership of L.C.Licensing, Inc. and not the named opponents, Juicy Couture, Inc. The opponents explained that the marks had been assigned. Given this, explanation, and the late stage that the issue was raised, I saw nothing practical to be gained (or lost) in allowing the proceedings to continue as they stood.

56. A question was also raised over the effective dates of these earlier marks. Only one, No. 1177377 had a filing date earlier than that of the opposed application. The remaining four had been filed after the subject applications, but claimed an International Convention priority date that pre-dated the application. Under cover of a letter dated 25 October 2005, the opponents provided me with documentation to support the priority claim in respect of CTM2831147 and CTM2829711, but not CTM2829224 or CTM2759942. The priority dates of all of these marks is noted on the official CTM register, and even without supporting documentation I consider it appropriate, in the absence of evidence to the contrary, to accept the register as correct. Accordingly, all five marks cited by the opponents stand as earlier marks within the meaning of Section 6(1) of the Act.

57. The word JUICY is an ordinary English word that will be known to those familiar with the English language. It describes an attribute of foodstuffs such as fruit, and less commonly is used as a term to describe something interesting or profitable. There is no evidence that it has any relevance for the goods and services covered by the opponents' earlier marks, and as I see it, in respect of such it is a word with a strong distinctive character. However, the same cannot be said of the words COUTURE, BABY and JEANS. These are also well known English words, but unlike JUICY they each have possible descriptive connotations for at least some of the goods covered by their specifications of goods and services. Accordingly I would say that where the suffix word has such relevance, the word JUICY is clearly the dominant distinctive element. But even where the second element possesses a distinctive character, that JUICY is the first element in the marks, generally accepted as of greater significance in the overall impression created by the marks, it will be this word that will be left in the minds of the consumer.

58. The marks applied for consist of the word(s) JUICY, JUICY DIAMONDS and JUICY SILVER. As with the goods and services of the opponents' earlier marks, the word JUICY has no relevance, and as such is a distinctive element. Again, in respect of at least some of the goods covered by the relevant specifications, for example, precious metals and jewellery items covered by Class 14, and cleaning/polishing preparations for silver in Class 3, the words DIAMOND or SILVER may describe a characteristic. Consequently, where there is such relevance, the word JUICY will clearly be the distinctive element, but even where this is

not the case, by virtue of its positioning as the first element, JUICY plays a more significant role in the overall impression of the marks, and as such, is the dominant, distinctive element.

59. That the respective marks either are the word JUICY, or have the word as a separate element means that it will be easily discernible, clearly enunciated, and this being so, there is inevitably a degree of visual and aural similarity. Self-evidently, adding another word, whether descriptive or not, will affect how the marks sound and look as a whole, but less so where, as in the case of JUICY the word is separated and presented as the first element. Where, as in this case, the dominant, distinctive element of the respective marks is identical, the conceptual message conveyed by each is likely to be the same unless the additional element(s) change the context of the common feature. I do not consider that that is the case here; the marks are going to be remembered as JUICY marks. Taking all of the aforesaid into account, in my judgement, when compared as a whole, the respective marks are similar

60. I turn next to consider the goods and services covered by the respective trade marks. As neither the opponents' nor the applicants' specifications are stated to be specialised in some way, and being of a type that is generally purchased by the public at large, I must proceed on the basis that the consumers of the respective goods and services are notionally the same.

61. The application for JUICY DIAMONDS covers the following goods in Class 3:

“Bleaching preparations, other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.

62. The opponents' earlier marks JUICY COUTURE and JUICY BABY also cover goods in Class 3. The specifications are, with one exception, identical in their scope, the difference being that one specification includes “candles” although this is of no significance. The specifications read as follows:

“Soaps, cosmetics, perfumery, essential oils, cosmetics, hair lotions, dentifrices, perfume, eau de toilette, body splash, after shave, body lotions, body scrubs, bath soaps, bubble baths, bath oils, bath and shower gels, hair shampoos, hair conditioner, hair spray, hair treatment lotions; facial masks, sunscreens, skin moisturisers, body gels, lip gloss, lipstick, blush, eye shadows, mascara, eyeliner, foundation, compacts, nail polish, nail polish remover, body powder, talc lotion, in international class 3.”

63. The opponents' specification would encompass products for bleaching the skin and hair. However, this term in the applicants' specification is followed by the expression “, other substances for laundry use”, the use of the word “other” having the effect of limiting the purpose of these products to being for laundry use. Such goods are beyond the scope of the opponents' specifications.

64. Both the applicants' and the opponents' specifications specifically mention the goods “soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices” and there can be no dispute that in this respect, identical goods are involved. The expression “cleaning and polishing” preparations would encompass goods such as skin cleansers, body scrubs, soaps, and nail polishes, so again, the respective goods are identical in respect of such goods.

65. This leaves the goods expressed as “scouring and abrasive preparations”. It seems to me that by its normal use the term “scouring preparations” is unlikely to describe any of the goods covered by the opponents’ specification, which essentially fall in the description of cosmetic, perfumery and toilet products. Whilst the term “abrasive preparations” is not a normal description used for such products, it is capable of covering goods such as dentifrices and skin preparations for exfoliating the skin, etc, and this being the case, is capable of describing identical goods to those of the opponents’ specification. However, if limited to being for laundry or household use, this would remove any similarity.

66. To me it is self-evident that the goods and services in the other classes covered by the opponents’ earlier marks are neither the same nor similar to the goods in Class 3 of the application. I do not, therefore, consider that they take the opponents’ case any further forward in relation to their opposition to registration in respect of the goods in Class 3 of the application.

67. Turning next to consider the goods covered by Class 14 of the application, The applicants’ marks JUICY DIAMONDS, JUICY and JUICY SILVER cover goods in Class 14, which are stated as follows:

“Precious metals, and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments.”

68. The opponents’ earlier marks do not cover goods in this class so it is a question of whether any of the goods or services are similar. In determining this question I have considered the guidelines formulated by Jacob J in *British Sugar Plc v James Robertson & Sons Ltd (Treat)* [1996] R.P.C. 281 (pages 296, 297) as set out below:

"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 services;
- (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 particular they are respectively found or likely to be found in supermarkets and in particular whether they are, or 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 the industry, put the goods or services in the same or different sectors."

69. Whilst I acknowledge that in the view of the *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, a judgement by the European Court of Justice (3-39/97) the *Treat* case may no longer be wholly relied upon, the ECJ said the factors identified by the UK government in its submissions (which are listed in *Treat*) are still relevant in respect of a comparison of goods.

70. The opponents' earlier marks JUICY COUTURE and JUICY JEANS covers the following goods in Class 18:

"Luggage, tote bags, hand bags, knapsacks, beach bags, all purpose sport and carrying bags, umbrellas, duffel bags, athletic bags, shoulder bags, backpacks, brief cases, diaper bags, toiletry kits, garment bags, luggage tags, key cases, leather key chains, and wallets."

71. Whereas jewellery is for personal adornment, goods of the kind covered by Class 18 are generally for containing, protecting and carrying articles when a person is moving from one location to another. Items such as umbrellas and luggage tags are ancillary items. The respective uses are therefore different. Both types of goods are bought and used by the public at large, and I see no reason why the respective users should not be considered the same. Jewellery made of leather is proper to Class 14, and would be covered by the applicants' specification, so at least in respect of such goods the physical nature of the respective goods would be the same. There is no evidence that goods of the kind found in Class 14 travel in the same trade channels as those of Class 18. It is my experience that luggage and jewellery is most commonly obtained by self-selection, usually reaching the consumer through separate retail outlets, but where both are stocked by a single retailer such as a department store, are found in distinct areas. They are not in any way competitive or complementary. Balancing these factors I have little difficulty in determining that these are different goods.

72. The next class covered by the opponents' earlier marks is Class 25, which form part of the coverage of the JUICY BABY, JUICY COUTURE and JUICY JEANS marks. All three specifications cover clothing at large, although two go on to list the goods in more detail and quite clearly cover the extent of the goods found in Class 25. The specification for comparison is as follows:

"Clothing, footwear, headgear, neckties, scarves, belts, footwear, shirts, sweaters, coats, suits, dressing gowns, hats, socks, caps, dresses, bathing suites; shirts, jackets, jogging suits, sweatshirts, sweatpants, shorts, jeans, pants, shirts, underwear, lingerie, swimwear, vests, blouses, overalls, t-shirts, stockings, tights, aprons, robes, pyjamas, knit tops, camisoles, tank tops, gloves, suspenders, boxer shorts, undershirts, trousers, blazers, leggings, leotards, panties, bras, bustiers, teddies in international class 25."

73. To me it is self-evident that goods such as horological and chronometric instruments are quite different in terms of their nature, purpose and channels of trade to clothing.

74. As I have already said, jewellery is for personal decoration, which is a consideration for the fashion conscious consumer when selecting clothing, but is not the main purpose of clothing. It is frequently selected and worn to complement clothing and could be considered to come within the ambit of a clothing accessory. Both types of goods are bought and used by the public at large, and I see no reason why the respective users should not be considered the same. Whilst it is feasible for jewellery to be made from the same materials as clothing (and vice-versa), in all but exceptional cases they will be made from materials very different in nature. There is no evidence that jewellery and clothing share a common manufacturing base, although as with many goods they may well come together in the wholesale part of the journey, particularly so in the case of costume or fashion jewellery. Jewellery is traditionally sold in dedicated stores, although it is not uncommon for fashion/costume jewellery to be sold in clothes shops, and where this happens, it is usually displayed, if not alongside, at least in reasonably close proximity to the clothing. In general trade both are usually obtained by the consumer self-selecting. Whilst jewellery would not be considered to be a product in competition with clothing, it is in some instances sold to complement it. Balancing these factors I find that jewellery, whether costume, fashion or otherwise, is not a similar good to clothing.

75. This leaves the opponents' specifications covering retail store services forming part of the JUCY COUTURE, JUCY JEANS and JUCY BABY trade mark applications. The current practice in relation to the treatment of retail services for the purposes of Section 5(2)(b) is set out in Practice Amendment Notice PAN 7/06 issued on 25 May 2006, which reads as follows:

"In case C-418/02, Advocate General Phillipe Leger opined [agreeing with communication No. 3/01 from the President of OHIM] that "the risk of confusion between [retail] services and the products, if it cannot be excluded, is nevertheless improbable except in particular circumstances, for example when the respective marks are identical or almost identical and well established on the market."

The ECJ did not feel the need to answer the referring court's question about the scope of protection of retailers' marks and so there is no definitive statement of law. Nevertheless, the Advocate General's Opinion is of persuasive value. In the light of it we will consider raising a section 5(2) objection in the course of official examination where: a mark is registered (or proposed to be registered) for retail services (or similar descriptions of this service) connected with the sale of specific goods or types of goods; another mark is registered (or proposed to be registered) by a different undertaking for goods of the type expressly mentioned in the specification of the retail services trade mark; the earlier trade mark has at least a normal degree of distinctive character, i.e. marks with low distinctive character, such as, for example, common surnames, need not be cited; the later trade mark is not just similar to the earlier mark but is identical or virtually identical to it, or contains a dominant and/or independently distinctive feature of it.

The reputation of the earlier trade mark and (unless it is obvious) the practices of the trade will only be taken into account on the basis of evidence in opposition or invalidation proceedings.

In view of these factors, we will conduct a search for earlier trade marks as detailed in the guide to cross searching which is an annex to this manual.”

76. The practice in force at the relevant date is set out in Practice Amendment Circular 13/00, which set out the practice to be used by the registrar in relation to relative grounds objections. The relevant paragraphs read as follows:

“Search of the Register

15. The Registrar’s preliminary view is that, prima facie, there will only be a likelihood of confusion between a retailer’s mark and a trade mark for related goods in (usually some combination of) the following circumstances:

- i) where the retail service in question specialises in bringing together the type of goods for which a conflicting mark is registered in a goods class;
- ii) where it is common practice in the trade for retail businesses of the type in question to produce a relevant range of “own brand” products;
- iii) where the earlier mark has a highly distinctive character, either per se or because of the use made of it.

16. The reputation of the earlier trade mark and (unless it is obvious) the practice of the trade will only be taken into account on the basis of evidence in opposition proceedings.

17. The Registrar will conduct a search of earlier trade marks as follows:

- i) Applications for the “bringing together of a variety of goods etc” in department stores, convenience store, supermarket, newsagent or on a television shopping channel:

Only Class 35 will be searched in order to identify conflicting marks for the same or similar services.

- ii) Applications which specify the type of specialist store that “bring together the goods” (or specialist catalogues etc), a search will normally be made into the main class of classes covering the principle goods brought together by the retailer. For example, in the case of:

The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a retail clothes store.

Class 25 will be searched and the Registrar will consider whether to refuse protection for the later trade mark *ex officio*.

18. A similar approach will be followed if the later trade mark is proposed to be registered in respect of:

The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from a clothing and accessories catalogue by mail order or by means of telecommunications.

Whether an objection under section 5 is raised as a result of the search will depend upon the matters identified at paragraph 15 above, and the degree of similarity between the respective marks (which will normally have to be higher than would be the case if the respective marks were to be registered for the goods themselves).”

77. Whilst the earlier practice is more detailed in setting out some of the considerations to be applied, I do not see that there is much difference in substance between the guidance provided, nor any tension with the criteria set down in *Treat* and/or *Canon*.

78. Both practices mention that for there to be a potential for objection, the retail services covered by the earlier mark must specifically mention the goods or types of goods for which the subject application is seeking registration. In the case in hand, the opponents’ earlier marks cover retail store services, inter alia, in the field of jewellery, fashion accessories, cosmetics, home products and personal care products, in essence the same goods as covered by the subject application. To my mind, if the consideration is the goods, and the goods are identical, both parties must be trade competitors.

79. Another requirement is that the earlier trade mark must have a normal degree of distinctive character, and the later trade mark should be identical or virtually identical to it, either as a whole, or in respect of a dominant and/or independently distinctive feature of it. On my assessment above I found the respective marks to be identical in their dominant and independently distinctive component.

80. The Registry practices and the *Treat/Canon* cases refer to the reputation of the earlier trade mark and/or the circumstances of the trade as being relevant, but as indicated, establishing the position in respect of reputation is a matter for evidence. The practices also suggest that the same would be the case in respect of the trade, but in assessing this it is possible to make an “informed” judgement based upon the nature and use of the goods.

81. Self-evidently, the physical nature of a service will be different to that of an item of goods, but as indicated above, it is not the act of retailing per se that is the primary consideration, but rather the identity in the goods to be retailed with those covered by the subject application, the circumstances in which the service is provided and the goods reach the consumer, and the expectations of the relevant consumer.

82. Where, as in this instance, the goods listed in the opponents’ retail specification are the same as those listed in the subject application, unless either is specialised in some way, the use and users must notionally be the same, and both will be delivered to the same end consumer in the same manner. There is no evidence that goes to whether it is common in the trade for retail businesses of the type in question to produce a relevant range of “own brand”

products, and as confirmed by Mr Ismail, I believe that this is precisely the position in respect of retail jewellers. These are familiar businesses in the high street, and from my own knowledge I am aware that whilst items such as watches, clocks and ornaments originate from a different named manufacturer, jewellery is frequently unmarked and would be regarded as the product of the jeweller.

83. The opponents refer to having first used the trade mark JUICY in the UK since “at least as early as 30 May 1998”, and the marks JUICY COUTURE and JUICY JEANS since at least as early as 11 November 1998 and 31 March 2000, respectively. The use is stated as being in respect of clothes sold through high-end fashion stores. The evidence includes a large collection of invoices and other documents exhibited by Gela Taylor, which Mr Hosford introduces as an exhibit to his own Witness Statement. These show the opponents to have been trading in the UK under the names JUICY JEANS, Inc., dba JUICY, the “dba” according to an online acronym finder appears to mean, *inter alia*, “doing business as”. There is also a reference to a web address incorporating the name JUICY COUTURE.

84. The earliest invoice is dated 11 November 1998, confirming one of the dates given above. Whilst these show use of JUICY COUTURE and JUICY in the contact details, the consumer would not see these documents, and as none of the goods listed are stated to have been branded “JUICY”, these invoices provide little assistance in establishing whether, and to what extent the opponents may have built a reputation under the marks.

85. Ms Taylor also exhibits various invoices and letters relating to work done by an agency in respect of promotional activities provided between March and October 2001. Whilst these state the work to have been done on behalf of JUICY COUTURE, there is nothing that shows that any of the promotions were in respect of JUICY branded products. The name JUICY COUTURE is mentioned in some documents as a reference or job number, but this could simply be a restatement of the company name, and not a reference to the brand being promoted.

86. Part of Ms Taylor’s evidence includes copies of articles and features from various publications. Some clearly originate from after the relevant date, or cannot be seen to have been available in the UK. However, those that are relevant show the name JUICY to have been given a fairly wide exposure in regional and national publications from at least as early as July 2001, initially in respect of tracksuits, but also in respect of jeanswear and items such as t-shirts. The Evening Standard of 30 July 2001 refers to JUICY as “The World’s most wanted jeans”. Although these examples are limited, I do not believe it would be disputed that some of the publications, such as Evening Standard, Metro, Health & Fitness magazine, and The Mail on Sunday reach a significant number of people, and through mediums such as this, brands can quickly become known. Ms Taylor has also given details of shows at which her company’s products have been exhibited. Although these are prior to the relevant date, they were held in Paris. Whilst it is possible that there were attendees from the UK, there is no evidence of this by which to gauge the effect on the consumer’s perception.

87. Mr Hosford provided further examples of the opponents’ being featured in the press, some from a trade publication entitled DrapersRecord, and others from nationally circulated publications including The Guardian Weekend (7 July 2001), Evening Standard (30 July and later), OK magazine (28 September 2001) and the Sunday Telegraph Magazine (31 March

2002).

88. Evidence directed to the trade includes the results of Ms Gottschalk's investigations using Harrods as a reference base, and via the internet, both of which revealed that the jewellery and clothing from a number of designer brands are sold under the same trade mark. Much of this does not show that this was the position at the relevant date. There is one reference to Giorgio Armani being "about to produce its first ever jewellery collection" in May 2002, although not that this would be under the same brand as the Armani clothing, or that this would be in the UK market. Given this, and the fact that the date is a matter of two months prior to the relevant date, I do not consider it safe to take this as showing the practice at the relevant date.

89. Ms Gottschalk also provides internet search results directed at establishing the trade practice of dual branding of clothes and perfumery. Whilst the factual evidence showing the position at the relevant date is limited, an article detailing the history of Chloe mentions that in 1974 the company extended the brand established in respect of clothing into perfume. Given the number of references to instances of apparent dual branding, and the fact that the Chloe example shows this to have been a trade practice some 28 years prior to the relevant date, I do not consider it unreasonable to take this to be indicative of a reasonably well established practice amongst high-end brands at the relevant date. Mr Hosford adds to this by providing details of registrations for a single mark effected in respect of, inter alia, goods in classes 3, 14 and 25, again, essentially in respect of what would be called designer brands. But as has been stated many times, register evidence of this sort does not show the actual position in trade.

90. Based on the evidence provided, I am satisfied that at the relevant date the opponents' use of the trade mark JUICY COUTURE had been sufficient to establish a reputation in the UK market in respect of clothing, albeit limited in its range and only for women. Although there is no specific evidence that goes to the extent of the opponents' trade, the nature and extent of their exposure in the media is likely to have generated an awareness well beyond the deminimis. There is also some support for the contention that they have a certain consumer awareness of the brand JUICY solus. But even though the opponents may have a reputation, it is in respect of goods different to those for which the applicants' seek registration, and if viewed in isolation it provides no assistance in determining whether the services covered by their earlier marks are similar to the goods for which the subject application is sought to be registered. Such as it is, the trade evidence "indicates" that some designer brands may be registered and used as trade marks in respect of clothing and jewellery. More conclusively, it establishes the practice of dual branding in respect of clothing and cosmetics products, in particular, perfumery. I do not see that the official practice and/or the *Treat* and *Canon* cases require there to be identity in all of the criteria listed for a retail service to be deemed similar to the goods to be the subject of that retail trade. Taking a view in the round I consider that in respect of the goods covered by Classes 3 and 14 of the application, the opponents' retail service are similar.

91. Taking all factors into account, in particular, the dominant, distinctive components of the respective marks, the identity in the goods/services, channels of trade and notional consumer, and the potential for confusion through imperfect recollection into account, I come to the view that if the applicants were to use their mark in connection with the goods for which they

seek registration, that there is a real likelihood of confusion. The objection under Section 5(2)(b) succeeds accordingly.

92. Whilst my decision in respect of the ground under Section 5(2)(b) effectively decides the matter, for completeness I will go on to consider the remaining grounds of opposition. I turn first to the ground under Section 5(4)(a). That section reads as follows:

“5.-(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

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

(b)

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

93. Mr Geoffrey Hobbs QC, sitting as the Appointed Person set out a summary of the elements of an action for passing off in his decision in the *WILD CHILD* Trade Mark case [1998] RPC 455. Mr Hobbs summarised the requirements as follows:

“(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.”

94. I have accepted the evidence to establish that the applicants’ mark JUICY COUTURE has a reputation in the UK, in relation to articles of ladies clothing, primarily track or sweat suits, jeanswear, t-shirts and the like, and on the facts before me it is not unreasonable to accept that they have achieved a level of goodwill commensurate with this reputation. There is also evidence that shows they have been referred to in the media as JUICY, which in turn may well have created an awareness amongst consumers but I put it as no more than that.

95. I also came to the view that the opponents’ earlier marks are similar to the marks applied for, and that taking into account all of the surrounding factors, there was a likelihood of confusion in relation to the goods covered by the application in suit. However, that was a consideration founded to a significant extent on a notional comparison of the goods and services covered by the respective marks, whereas in determining an objection under Section 5(4)(a), the focus is directed towards the actual goods and/or services for which the opponents have built their reputation and goodwill.

96. The opponents' reputation is in respect of articles of ladies clothing, which from the references in the press appears to be directed towards the upper end of the market. Clearly, such goods are not the same as jewellery, household preparations, perfumery and the like for which the applicants seek registration. However, in *Harrods v Harrodian School* [1996] RPC. 697, it was accepted that there is no rule that the respective parties must be operating in the same field of activity, but the more remote the activities, the stronger the evidence needed to establish a real likelihood of damage. Where the fields of activity are different, the burden of proving that the applicants' use presents a real likelihood of damage to the opponents' business is a very heavy one (*Stringfellows* [1984] RPC 546).

97. Whilst watches and such are worn, in part for aesthetic purposes, and in some cases would be considered a fashion accessory, they are quite different in terms of their nature, purpose and channels of trade to clothing. Jewellery is solely for personal decoration. It is frequently selected and worn to complement clothing and could be considered a clothing accessory, particularly so in the case of costume or fashion/costume jewellery which I know to be sold in clothes shops where it is displayed either alongside or in close proximity to the clothing. Evidence of the trade shows that jewellery and clothing from a number of designer brands is sold under a single brand name, so I do not consider that the two activities are that far apart. As far as the goods covered by Class 3 or the subject application are concerned, these are self-evidently quite different to clothing. However, evidence of the trade also shows dual branding of clothes and perfumery to be a reasonably well established practice amongst high-end brands.

98. Taking into account the opponents' reputation and goodwill in the name JUICY COUTURE, that the word JUICY is the dominant, distinctive component of this, and the marks applied for, and the relationship between the trade in clothing and jewellery/perfumery, I come to the view that use of the marks applied for in respect of jewellery or perfumes would amount to a misrepresentation that is likely to damage the opponents reputation and goodwill. The ground under Section 5(4)(a) made out in respect of perfumery in Class 3, and jewellery in Class 14 of the application.

99. Turning finally to the ground under Section 5(3). That section reads as follows:

“5.-(3) A trade mark which –

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

100. The European Court of Justice in *Davidoff & Cie SA and Zino Davidoff SA v Gofkid Ltd* (C-292/00) which was confirmed by its decision in *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd* (C-408/01) determined that Article 5(2) of the Directive granted a right to the proprietor of an earlier trade mark with a reputation, to prevent others from using an identical or similar trade mark in relation to goods or services where such use would, without due cause, take unfair advantage or be detrimental to the distinctive character

of the earlier trade mark.

101. The first requirement to be met under Section 5(3) is for an earlier trade mark to be identical or similar to the trade mark that are the subject of these proceedings. In my determination of the grounds under Section 5(2)(b), I found the opponents' marks JUICY COUTURE, JUICY JEANS and JUICY BABY to be similar to the applicants' marks, JUICY, JUICY SILVER and JUICY DIAMONDS.

102. The next requirement is that the opponents' mark possesses a reputation in the UK to the extent set out by the ECJ in *General Motors Corporation v. Yplon SA* [1999] E.T.M.R. 122 (Chevy). The court concluded that the requirement implies a certain degree of knowledge amongst the public, and considered that the required level would be reached when the earlier mark is known by a significant part of the relevant sectors of the public. In deciding whether this requirement is fulfilled all relevant factors should be considered, including, the market share held by the trade mark, the intensity, geographical extent and duration of its use and the size of the investment made by the undertaking promoting it; the stronger the reputation and distinctive character, the easier it will be to accept that detriment has been caused to it.

103. The opponents claim use of JUICY in the UK since "at least as early as 30 May 1998", and JUICY COUTURE and JUICY JEANS since at least as early as 11 November 1998 and 31 March 2000, respectively, in respect of clothes sold through high-end fashion stores. The evidence includes a large collection of invoices and other documents which show the opponents to have been trading in the UK under the names JUICY JEANS, Inc., dba JUICY, the "dba" according to an online acronym finder appears to mean, inter alia, "doing business as". There is also a reference to a web address incorporating the name JUICY COUTURE. These documents would only be seen by the distributor/retailer, but given that so few of these are shown it is not possible to say that through these documents the mark will have become known to any significant extent in the trade. That none of the goods listed in these documents are stated to have been branded "JUICY" does little to assist in gauging the impact of the opponents' marks amongst consumers..

104. The most persuasive evidence is contained within the features and articles from the media. These date from June 2001 onwards giving approximately a year of exposure prior to the relevant date, and whilst limited in number, as I have highlighted above, they have appeared in publications that can reasonably be inferred to have a wide circulation and to reach a substantial number of people.

105. In the Statement of Grounds the opponents specifically mention the close proximity of the trade in clothing, and that of jewellery and perfumery; I have no argument with this, particularly in high-end goods where the opponents' reputation appears to exist. There is an obvious advantage to a trader who can latch on to the established reputation of a brand with a cache of desirability, and the higher the reputation, or exclusivity of the mark or goods, the greater the potential for detriment. Whilst it is not necessary for there to be a likelihood of confusion for their to be a finding in favour of the opponents, I take the view that given the identity of the trade marks, the close proximity of the trades in clothing, and jewellery and perfumery, that if the applicants were to use their trade marks in respect of jewellery and/or perfumery, this would, without due cause, take unfair advantage of, or be detrimental to, the

distinctive character or the repute of the opponents' earlier trade marks. The ground under Section 5(3) therefore succeeds accordingly.

106. The oppositions having been successful, the opponents are entitled to costs. Taking into account the stage at which the proceedings were consolidated, and the duplication in the evidence filed, on my calculations the opponents should be awarded the sum of £4,950 as a contribution towards their costs. However, the opponents' requests for amendment to the pleading will have caused the applicants additional costs that should be taken into account, and for this I apportion the sum of £750. The cost award therefore stands as £4,200, this sum to be paid by the applicant 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 2nd day of August 2006

**Mike Foley
for the Registrar
the Comptroller-General**