

O-234-03

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2281796
BY NIGEL SPENCER DAWES
TO REGISTER THE TRADE MARK
SINGIRL IN CLASSES 16, 18 AND 25**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No. 90077 BY
MILES-BRAMWELL EXECUTIVE SERVICES LIMITED**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No. 2281796
by Nigel Spencer Dawes to register the trade
mark Singirl in Classes 16, 18 and 25**

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**IN THE MATTER OF Opposition thereto under
No. 90077 by Miles-Bramwell Executive Services
Limited**

Background

1. On 27 September 2001 Nigel Spencer Dawes applied to register the mark SINGIRL in respect of the following goods:

Class 16

Paper, cardboard and goods made from these materials not included in other classes, printed matter, book binding material: photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); playing cards; printers' type; printing blocks.

Class 18

Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.

Class 25

Clothing, footwear, headgear.

The application is numbered 2281796.

2. On 14 February 2002 Miles-Bramwell Executive Services Limited filed notice of opposition to this application. They are the proprietors of the three registrations details of which appear in the Annex to this decision. They object as follows:

Section 5(2)(b) - in that the opposed mark is similar to the opponents' trade marks having regard to the common prefix SIN. They note that the opposed application relates to Class 16 goods and that these are identical or similar to the opponents' goods. Thus, it is said there exists a likelihood of confusion. They add that this likelihood is

increased as a consequence of the opponents having multiple registrations for marks incorporating the element SIN.

Section 5(3) - in that the opponents have a reputation as a result of having used the mark SIN for at least ten years in relation to a broad range of services relating to slimming, weight control diet and such like. Use of the opposed mark would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.

Section 5(4)(a) - on the basis of the use referred to above and having regard to the law of passing-off. I note that the claim here is made specifically in relation to the opponents' use in relation to Class 16 goods.

3. The applicant filed a counterstatement in which it is suggested that his products are not similar to the opponents' and it is not his intention to imitate the opponents' products. He does not say what his products are other than that they have nothing to do with nutritional health. He further submits that he has created a new brand and single word in contrast to the opponents' marks. He denies the grounds of opposition.

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

5. The matter came to be heard on 22 July 2003 when the applicant was represented by Ms H Mensah instructed by Jacksons and the opponents by Ms L Lane of Counsel instructed by Swindell & Pearson.

Evidence

6. The opponents have filed evidence in the form of a witness statement by David Rathbone, their Financial Director.

7. Miles-Bramwell Executive Services Ltd trade as Slimming World and is said to be one of the UK's leading weight control and dietary organisations. The company and its predecessors in business began trading in 1969 and have traded continuously within the UK since that date.

8. The company's core business has always been the development and provision of weight control plans, consultation and guidance to assist members of the public in controlling their body weight, and in particular to assist in weight loss whilst maintaining a healthy diet. A cornerstone of the company's business involves the analysis of many food products. These are categorised by assigning to them a numerical value in association with the company's trade mark, SIN. In support of this business the company has and relies on the registrations referred to above.

9. Mr Rathbone exhibits the following documents to demonstrate the nature of the business and how the marks are used:

DR2 - copy extracts of a booklet describing two dietary plans;

- DR3 - two booklets evidencing use of the trade mark SIN, one of which can be dated to 1986. The second booklet illustrates that the mark SIN is used to categorise food products within directories and other printed matter. 'SINS' are used to assist clients and users in their weight control;
- DR4 - a further bundle of copy extracts of literature and printed material produced by the company. I note that it includes a Food Directory giving the 'SIN' values for some 27000 everyday foods.

10. The SIN trade marks are promoted both through national advertising and through localised promotion generally in relation to weight control classes held in most major towns and cities in the UK. At these classes consultants appointed by, and under the control of the company, provide advice and assistance to clients in the matter of weight control and diet, and actively use the SIN Trade Marks in relation to the company's products and services. The company has in the order of 250,000 members subscribing to its services and classes, and has had this scale of membership for at least the last six years. (Mr Rathbone's statement is dated 20 September 2002.)

11. To complement the services and in addition to the products provided by the company, the company publishes a magazine entitled "Slimming World" which currently has a distribution in the order of 260,000 copies, approximately 150,000 of which are distributed to members of the public subscribing to the company's services and the remaining 100,000 approximately are sold through outlets such as newsagents and supermarkets to the general public. Slimming World magazine has been produced by the company since January/February 1998, with the distribution being gradually increased since first use from in the order of 195,000 to the current 260,000 copies. Slimming World magazine is said to be the best selling diet magazine title in the United Kingdom.

12. The magazine is issued every two months and relates extensively to diet, food, weight control, healthy lifestyle, fashion and clothing. Each magazine is said to contain many articles and advertisements relating to the above issues and makes use of the SIN trade mark. Sample magazines are exhibited at DR5. Mr Rathbone says that these extracts from magazines show that there is a close association of the company's products and services with clothing and other fashion items and accessories. Also the company runs many promotions with clothing manufacturers and retailers. As a result Mr Rathbone says the company's reputation in the SIN mark extends beyond the core business and into the fashion and clothing business. This gives him cause for concern about the applicants' coverage in Classes 18 and 25 as well as Class 16.

13. The company's turnover is said to have been in excess of £12,500,000 for each of the last five years and has generally increased over time. Figures for earlier years are given as follows, £5 million (1994), £3 million (1993) and £2 million (1992).

14. Mr Rathbone lists the following national newspapers and magazines in which advertisements and articles relating to the company, its services and its SIN trade marks regularly appear:

Daily Mail	The Sun
Sunday People	Health & Beauty
Home & Life	Marie Claire
New Baby	Shape
Top Sante	Total Style
Woman's Own	Women's Health
Woman's Weekly	You and Your Baby

15. Advertisements appear in national presses including The Sun, Daily Mail and Scottish Record on an all-year-round basis. Press cuttings drawn from national publications are exhibited at DR6. Similar material from local publications is exhibited at DR7.

16. Mr Rathbone concludes by saying that, in consequence of this use, if the public were presented with goods, including printed articles and fashion articles, in particular clothing and accessories and the like, branded SINGIRL, they could reasonably be expected to be confused into thinking that the goods derived from his company, or were approved or otherwise endorsed by his company.

17. Mr Dawes, the applicant, has filed a brief witness statement indicating that the applied for mark has not yet been used but reiterating that he does not intend to use it in the field of health, slimming or nutrition. He exhibits details of three Community Trade Mark registrations for the word SINGLE and SINCLAIR (2) with the suggestion that these co-exist with the opponents' marks without confusion. The latter evidence has drawn comments in reply from Mr Rathbone. I do not propose to deal with these submissions at this point but will comment briefly in my decision below.

18. That completes my review of the evidence.

Reputation

19. The reputation that the opponents enjoy in their various SIN marks is relevant to acquired distinctive character for Section 5(2)(b) purposes, to reputation for Section 5(3) purposes and to goodwill for Section 5(4)(a) purposes. Much of the time at the hearing was taken up with Counsels' submissions as to what findings I should make on the basis of the evidence filed and summarised above. I propose, therefore to reach a view on the evidence as a basis for approaching the individual grounds.

20. To understand the context in which SIN (and its derivatives) is used I should record that the opponents' dieting and eating plans have as their basis three constituent parts – 'Free Food' meaning foodstuffs that can be taken in unrestricted amounts; 'Healthy Extras', which allow selection of additional choices to provide fibre, calcium etc; and SINS which allow participants in the programme to indulge in various treats (these being limited in number each day). The SINS system has been in place for many years. By way of confirmation there is undisputed evidence in the form of a dieting record sheet dated 1986. The SINS system operates on the basis of attributing a points score to food items. This primary meaning of the term from the

point of view of the opponents' business is again evident from a very early time. Thus the 1986 booklet refers to "Choose your sins (points) each day from the Food Value Chart". The concept is developed in terms such as Sin-A-Day and Sin Free.

21. The dieting plans and associated activities which are at the heart of the opponents' business are conducted primarily under the mark Slimming World. It is this latter mark that features on the various booklets, directories, charts etc. produced by the opponents. The opponents offer and promote their goods and services in two main ways, firstly through the mechanism of Slimming World Clubs and secondly through the magazine of that name (in fact the magazine also appears to operate under the initial letters SW as well). Mr Rathbone's evidence sets out the opponents' claims as to the number of people attending his company's diet and weight control classes and purchasing the magazine. The turnover figures given above represent, as I understand it, the totality of the opponents' business, but is largely attributable to these main sources of income.

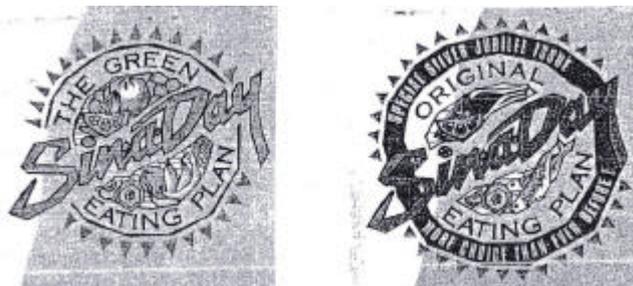
22. Two principal issues arise from this state of affairs. Ms Lane conceded, as I think she was bound to do, that some of the opponents' use of SIN and its derivatives is descriptive in nature and not trade mark use in the sense that it is merely a convenient way of describing or indicating an aspect of the dieting/weight watching plans (and the points system). Her submission was, nevertheless, that there is other use which can properly be said to be trade mark use.

23. If that hurdle is overcome there is still the question of the extent of that use and the reputation/goodwill that it gives rise to. Ms Lane's primary submission on this was that the nature of the business is such that use of SIN etc. cannot be separated out and quantified in its own right. That seems to me to amount to a claim that the use of SIN is so integrated into the whole Slimming World business that use of one is use of the other.

24. I will deal with these points in turn. Both Counsel helpfully took me through the opponents' own material (by which I mean booklets etc produced by them) and the press cuttings in Exhibits DR6 and 7 in support of their respective positions. The position in the opponents' own exhibits variously shows:

- a SINS telephone hotline (DR2);
- references to the Sin-A-Day, diet and Sin-A-Day portions, 'Choose your sins' (Exhibit DR3);
- a Slimming World offer of a 'One hundred Original Sin Free Recipes' book (DR3);
- a Slimming World booklet about the Sin-A-Day diet which also describes, lists and gives points scores for SINS (DR3);
- a Slimming World Food Directory with on the spine "OVER 30,000 SIN VALUES" (DR4);

- a copy of the Sin Free recipe booklet advertised in Slimming World (and also bearing the latter brand) and referred to above (DR4);
- Slimming World booklets relating to the SIN-A-DAY Green Eating Plan and Original Eating Plan under the following logos (DR4);



- a Slimming World recipe book referring inter alia to '90 Sin-free and Low-Sin recipes' and 'the easily identified Sin-free stamp' (DR4);
- there are various other references to SIN values (DR4);
- a reference on the front cover of Slimming World magazine for March/April 1998 to 'Plus Loads of Brand New Low-Sin Recipes' (DR5).

25. So far as the press cutting material is concerned these appear to have been generated as a result of a media monitoring exercise by a marketing company. I note that they are normally headed 'SLIM WORLD' – I infer that the primary objective of the monitoring services is to pick up references to Slimming World. By common consent the national press extracts at DR6 contain few references to SIN or its derivatives and then only in a descriptive sense.

26. As one might expect, given that the Slimming World clubs are locally based, there is a considerable volume of press cuttings from local or regional publications. A number clearly pick up on the notion of SIN/S and generate headlines such as 'SIN yourself slim', 'Sins of the slimmers' and 'Sin-a-day leaves couple 11 stone lighter'. There are other references to 'Serves 4 sin value = 3 ingredients', 'low sin recipes' and 'just keep count of the sins'.

27. Ms Mensah, for the applicant, suggested that much of the material in these exhibits contained no evidence of use of SIN/S as a trade mark; was in certain respects repetitious; was descriptive rather than trade mark use; or otherwise irrelevant in the case of, for instance, third party use of 'sin-free sandwiches' and 'sin-free sausages' (picking up, I think, on the descriptive references in Slimming World).

28. If or to the extent that the above usages constitute trade mark use (and I will give my own view below) there is the further question of the extent of that use. There is no breakdown of the turnover as between, the magazine, the clubs and slimming classes, sales of printed matter (booklets, recipes, food directories etc) and other goods. Nor is there invoice evidence to enable me to take a view on the matter. Mr Rathbone refers to turnover of £12.5 million in each of the last five years (his evidence is dated 20 September 2002). The magazine itself was priced at

£1.95 in 2000 and is a bi-monthly publication. That suggests revenue of approximately £3 million from that source. There is insufficient information to gauge revenue from sales of other goods and services.

29. In any case the main mark used is Slimming World. There is even less evidence to enable me to gauge the use of the SIN marks. Ms Mensah's analysis of the evidence suggested disjointed use of SIN, SIN-A-DAY and SIN FREE but that it was not clear what goods or services this use was in relation to and, in any case, it was not possible to distinguish what might be taken as trade mark use from purely descriptive use. Whilst I accept Ms Lane's submission that there may be difficulties in separating out use of the SIN marks from Slimming World, I am unable to accept that the use shown accrues to each of the marks.

30. Making the best I can of the opponents' evidence I find as follows:

- SINS and derivative combinations are used colloquially to refer to treats allowed as part of dieting etc. plans;
- the public has been educated to understand the concept and the related points system;
- the main trade mark used is Slimming World;
- the opponents' own publications send out mixed messages as to whether the use of SINS is descriptive or in a trade mark sense;
- where a word is conceded to be used in a descriptive manner as SINS is it likely to be more difficult to convey the message that in other contexts it is being used as a trade mark;
- in the context in which they occur most of the references to SINS are likely to be taken as descriptive references to the dieting/points system;
- much of the use cannot be said to be in relation to a trade in goods or services;
- the press cutting material does little if anything to further the opponents' claim;
- there are exceptions to the generality of the above findings notably (but not exclusively) the logo forms depicted above and prominently displayed at the front of booklets. From their stylised presentation and position as free-standing elements these composite marks more readily lend themselves to being perceived as trade marks (a separate issue arises as to whether they constitute normal and fair use of the marks as registered);
- even accepting that there is some trade mark use, the evidence is insufficient to enable me to gauge the true extent of this use and its impact on consumers;

- reasonable inferences can be drawn as to sales of the magazines but that is clearly under the Slimming World and/or SW marks;
- the other major contribution to turnover is likely to be the slimming club services but that too is primarily under the Slimming World mark;
- all the booklets, recipes, food directories etc. relied on have Slimming World as the primary mark. That does not rule out secondary branding but no information is given on sales of these goods.

31. With these findings in mind I turn to the individual grounds.

Section 5(2)

32. This reads:

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

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

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

Sub-paragraph (b) applies here.

33. I take into account the 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 Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

Similarity of marks

34. The visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by those marks bearing in mind their distinctive and dominant components, *Sabel v Puma* paragraph 23. The matter must be judged through the eyes of the average consumer of the goods/services in question, *Sabel v Puma*, paragraph 23; the average consumer is deemed to be reasonably well informed and reasonably circumspect and observant but rarely has the chance to make direct comparisons between marks. Imperfect recollection must, therefore, be allowed for, *Lloyd Schuhfabrik v Klijsen Handel*, paragraph 27.

35. The opponents have three earlier trade marks. Ms Lane submitted at the hearing that her clients' marks had both inherent and acquired distinctive character (see *Sabel v Puma*, paragraph 24) and also as a result of being part of a family of SIN marks. On the basis of my findings on the evidence I reject the opponents' claim to any enhanced degree of distinctive character. It is clear from *The Infamous Nut Co Ltd's Trade Marks*, [2003] RPC 7 and *Torremar Trade Mark* [2003] RPC 4 that any claim in this respect must be supported by evidence of use to show that an element (SIN in this case) has achieved enhanced distinctiveness in the eyes of the public because it is common to a family of marks. For the reasons given above I am unable to accept any such claim here. The matter, therefore, rests on the inherent characteristics of the respective marks. It will, I think, be sufficient to take registration No. 1939479 for the mark SIN as offering the opponents their best chance of success.

36. Although SIN is a dictionary word I regard it as having a reasonable degree of distinctive character in relation to the goods and services for which it is registered. The mark applied for is SINGIRL. Ms Mensah submitted that the overall impact of the latter is quite different; that the applied for mark is a play on 'single'; that it is not permissible to isolate elements in marks for the purposes of comparison; and that even if it was perceived as SIN-GIRL it is still visually, phonetically and conceptually dissimilar.

37. Visually, the respective marks are of different length but I do not think it will escape the attention of even the casual observer that the applied for mark is made up of two well known dictionary words and contains SIN as its first and a prominent element. That is not in my view artificial analysis of the mark, it is simply that the eye naturally looks for, and will recognise, identifiable elements. The elements which go to make up the mark applied for are also likely to be evident in oral use. Conceptually, it is not wholly inconceivable that consumers will see a play on single in the mark SINGIRL but I doubt that it is particularly likely or that it is the most natural reaction to the mark. It may also be the case that, as Ms Mensah suggested, the mark will convey other meanings (vice-girl being one). In relation to the goods at issue here I also bear in mind that GIRL is likely to be non-distinctive. The applicants' specification for instance, covers printed matter (magazines and such like) and clothing that can be aimed at girls. In those circumstances the focus of attention in relation to the applied for mark is more likely to be on the first element. Mr Dawes has indicated in his evidence that he does not intend to use his mark in fields which overlap with the opponents. He has not restricted his specification in any way which gives expression to this claim. Normal and fair use would, therefore, include use of the mark SINGIRL on some goods which are identical or closely similar to those of the opponents (see below). Taking all these factors into account I find that there is a similarity between the marks and that that similarity is likely to be accentuated in relation to overlapping goods which may be directed at girls.

Comparison of goods

38. The guidance provided by the ECJ in the *Canon* case is as follows:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those

factors include, inter alia, their nature, their end users and their method of use and whether they are in competition with each other or are complementary.”

39. In *British Sugar Plc v James Robertson & Sons Ltd (TREAT)*, [1996] RPC 281 Mr Justice Jacob also considered that channels of trade should be brought into the reckoning.

40. Submissions at the hearing concentrated on the respective Class 16 specifications. For the record I confirm that I can see no similarity between any of the other Classes (that is to say Classes 25 and 28 in the applicant’s case and Classes 29, 30, 32, 41 and 42 in the opponents’ registration). The Class 16 specifications are:

Applicant’s goods

Printed matter; photographs, stationery, books, directories, recipes, pamphlets, charts, greeting cards, magazines, periodical publications.

Opponents’ goods

Paper, cardboard and goods made from these materials not included in other classes, printed matter, book binding material; photographs; stationery; adhesives for stationery or household purposes; artists’ materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); playing cards; printers’ type; printing blocks.

41. The applicant’s only concession on identity/similarity is in relation to printed matter, photographs and stationery. Other items are said not to be similar, in particular where goods are more likely to find trade uses rather than being aimed at consumers (printing blocks for instance). Similarity is usually a matter of degree. Ms Lane conceded that some of the goods applied for had less obvious similarities with her client’s goods.

42. I bear in mind that the terms printed matter and stationery are indeterminate in scope and capable of embracing a wide variety of goods. In *Minerva Trade Mark*, [2000] FSR 734 Mr Justice Jacob (as he then was) was of the view that ““printed matter” cannot in my judgment mean merely that the trade mark is printed on something” but held that the term was nevertheless capable of wide interpretation.

43. The term stationery is defined in Collins English Dictionary as “any writing materials such as paper, envelopes, pens, ink, rulers etc.”.

44. With these considerations in mind I find that “paper, cardboard and goods made from these materials not included in other Classes”, “adhesives for stationery or household purposes” “office requisites (except furniture)” are similar to stationery (office requisites in particular is a general term that would include stationery). “Plastic materials for packaging (not included in

other Classes)” is an item that may be purchased at a stationery shop but is somewhat further removed from what would generally be understood to be a stationery item. “Instructional and teaching material (except apparatus)” may come in the form of printed matter and is, therefore, either identical or similar to that term. The remaining items, that is to say “book binding material”, “artists’ materials; paint brushes”, “typewriters”, “printers’ type; printing blocks” seem to me to be more specialist items that would not generally be held to be similar to any of the opponents’ Class 16 goods. It may be that some of them (artists’ materials come to mind) could be purchased in a large stationery shop but they would generally be in a dedicated area of the shop. That leaves “playing cards”. I have hesitated over this item because playing cards are printed items and so may come within the general term printed matter. But I am inclined to take the view that any similarity is more theoretical than real. The average consumer would not naturally regard the term printed matter as extending to such a specific item. If there is similarity it is limited in scope.

Likelihood of confusion

45. I was referred to the following comments of the Appointed Person (Mr G Hobbs QC) in *Raleigh International Trade Mark* [2001] RPC 202:

“I think it is clear from the case law of the European Court of Justice that an objection under Section 5(2) of the Act raises a single composite question: are there similarities (in terms of marks and goods or services) which would combine to create a likelihood of confusion if the “earlier trade mark” and the sign subsequently presented for registration were used concurrently in relation to the goods or services for which they are respectively registered and proposed to be registered?”

46. Having regard to my findings in relation to the respective marks and goods I consider that there is a likelihood of confusion where identical and closely similar goods are involved. I consider the following to be in this category:

“Paper, cardboard and goods made from these materials not included in other Classes, printed matter; photographs; stationery; adhesives for stationery or household purposes;.... office requisites (except furniture); instructional and teaching material (except apparatus).”

47. In relation to the remainder of the applicant’s Class 16 specification I am not persuaded that there is a likelihood of confusion having regard to the net effect of the similarities/differences between marks and goods. Furthermore the Class 18 and 25 specifications are in any case free from objection under Section 5(2)(b).

SECTION 5(3)

48. This Section reads:

“(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.”

49. The scope of the Section has been considered in a number of cases notably *General Motors Corp. v Yplon SA (Chevy)* [1999] ETMR 122 and [2000] RPC 572, *Premier Brands UK Limited v Typhoon Europe Limited (Typhoon)* [2000] FSR 767, *Daimler Chrysler v Alavi (Merc)* 2001 [RPC] 42, *C.A. Sheimer (M) Sdn Bhd's TM Application (Visa)* 2000 RPC 484 and *Valucci Designs Ltd v IPC Magazines (Loaded)* O/455/00. More recently there has also been the decision of the ECJ in *Davidoff and Cie SA and another v Gofkid Ltd* [2003] ETMR 534.

50. For the reasons given above I find that there is similarity between the marks and that the similarity will be at its highest in relation to goods for which the element GIRL is likely to be taken as a descriptive indicator. The applicant's specification contains both similar and dissimilar goods and thus potentially brings *Davidoff v Gofkid* into play.

51. It is, however, an underpinning requirement of the Section that the mark or marks relied on have a reputation in the United Kingdom. The nature of the reputation that is required to found an action under Section 5(3) was the subject of the following guidance in the *Chevy* case:

“... It is only where there is a sufficient degree of knowledge of that mark that the public, when confronted by the later trade mark, may possibly make an association between the two trade marks, even when used for non-similar products or services, and that the earlier trade mark may consequently be damaged.

24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector.

25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular 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 in promoting it.”

52. On the basis of my analysis of the opponents’ evidence of use they would fail to establish the necessary reputation in relation to any of their earlier trade marks (leaving to one side for the moment submissions by both Counsel as to the adequacy of the pleaded case in this respect). Even accepting that some of the use of the SIN marks may be seen as something other than descriptive use, the true extent of trade mark use cannot be determined from the evidence and must in my view fail the high threshold test for a Section 5(3) case.

53. As this finding effectively decides the matter I propose to only give brief consideration to the issues of unfair advantage/detriment. The main thrust of the opponents’ case shifted somewhat between Mr Rathbone’s evidence and the hearing. The former appeared to be based on the position that the Slimming World magazine contained fashion articles/advertising in addition to weight control, diet, lifestyle etc. issues and that the magazine also runs promotions with clothing manufacturers/retailers. If or to the extent that this aspect of the opponents’ case is intended to show that use of the mark SINGIRL on Class 18 and 25 fashion goods would take unfair advantage of or cause damage to the opponents’ SIN marks, I reject it. The magazine trades under the name Slimming World. There may be occasional references to SIN (‘Low-Sin summer’, ‘Sun, sea and sins’ etc.) but they would not be taken as trade mark use in relation to particular goods and services.

54. At the hearing Ms Lane concentrated on the negative connotations of the mark applied for (vice girl) and the detriment it might cause to the opponents’ repute. The connection is too tenuous to have any real force. Furthermore the opponents themselves have chosen to use a word with negative connotations and to play on that word in their promotional activities.

SECTION 5(4)(a)

55. The Section reads as follows:

“(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.”

56. The elements that must be present are agreed to be as follows (following the guidance in *WILD CHILD Trade Mark* [1998] RPC 455):

- (1) that the opponents' goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the applicant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the applicant are goods or services of the opponents, and
- (3) that the opponents have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the applicant's misrepresentation.

57. The opponents' case is based on the fact that "the evidence of Slimming World shows that at that [the relevant] date it had acquired a goodwill and reputation in the trade marks" and that this extended to SIN prefixed marks more generally. A particular point is made of the fact that the opponents' goods and services are aimed at women. Clothing and accessories are said to be intimately connected in the minds of the public with image and, hence, diet and weight control. My attention has been particularly drawn to the Slimming World magazine exhibits and press advertising illustrating the connection.

58. It may be that an objection could be successfully sustained on the basis of such a claim. But for reasons which I do not need to repeat I am unable to accept that the opponents have established a foundation for their case. The goodwill that is protected under passing off is the goodwill of a business and results from trading activity. It does not protect a name as such—only insofar as that name or sign is the manifestation of the business.

59. Bearing in mind the standard of proof required (see Mr Justice Pumfrey's comments in *South Cone Inc v Bessant (Reef Trade Mark)*, [2002] RPC 19 at paragraphs 27 and 28), I am not satisfied that the use shown assists the opponents. There are a few instances where it might be said that the SIN marks are used in relation to a trade in goods rather than in a purely descriptive manner. But the extent of such use is not clear and the quantification/substantiation of it is lost in the generality of the claims which largely go to use of the main mark Slimming World. A claim under Section 5(4)(a), unlike Section 5(2) is not limited to similar goods. It might thus have offered the opponents a wider avenue of attack. However, on the basis of the material before me this ground of opposition does not succeed.

60. The opposition has been successful to a limited extent. The application will be allowed to proceed if, within, 28 days of the expiry of the appeal period, the applicant files a Form TM21 restricting his Class 16 specification to:

"Book binding materials; artists' materials; paint brushes; typewriters; plastic materials for packaging (not included in other Classes); playing cards; printers' type; printing blocks."

61. The Classes 18 and 25 specifications are unaffected. If the applicant does not amend his specification in this way the application will be refused in its entirety.

62. Both sides have achieved a measure of success but, in overall terms, and bearing in mind that a detailed review of the press cuttings material was necessary, I consider that the applicant is entitled to an award of costs albeit not at the full rate. I order the opponents to pay the applicant the sum of £1000. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 14TH day of August 2003

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

		32	yeast, baking powder, salt, mustard, vinegar, sauces, salad dressing, spices.
			Beers, mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.
		41	Education; providing of training; arranging and conducting of educational seminars.
		42	Advisory and counselling services; advisory and counselling services relating to slimming, diet, exercise.
2237304	SIN FREE	16	Printed matter; photographs, stationery, books, directories, recipes, pamphlets, charts, greetings cards, magazines, periodical publications.
		29	Meat, fish, poultry and game; meat extracts; products containing meat, sausages, puddings, cooked meat, cooked meat products; preserved, dried and cooked fruits and vegetables; jellies; jams; eggs, milk and milk products; edible oils and fats; preserves; prepared meals and snacks, prepared and packaged foods.
		30	Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee, flour and preparations made from cereals, bread, snack foods, prepared and packaged meals and foods, pastry products, confectionery, ices, ice creams, honey, treacle, yeast, baking powder, salt,

			mustard, vinegar, sauces, salad dressing, spices.
		32	Beers, mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.
		41	Education; providing of training; arranging and conducting of educational seminars.
		42	Advisory and counselling services; advisory and counselling services relating to slimming, diet, exercise.