

O-264-04

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2302635
BY KEVIN PAYNE & SUSANNA KELLY
TO REGISTER A SERIES OF TRADE MARKS
IN CLASSES 18 AND 25**

AND

**IN THE MATTER OF OPPOSITION No. 91367
BY FRONSAC INVESTMENT SA**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No. 2302635
by Kevin Payne & Susanna Kelly
to register a series of Trade Marks in Classes 18 and 25**

and

**IN THE MATTER OF Opposition No. 91367
by Fronsac Investment SA**

Background

1. On 12 June 2002 Kevin Payne and Susanna Kelly applied for SIXKILLER and sixkiller as a series of two trade marks in respect of the following specification of goods:

Luggage, handbags, holdalls, wallets, backpacks, shoulder bags, purses, umbrellas, leather and leather imitation goods (Class 18);

Articles of clothing, footwear, headgear (Class 25).

2. The application is numbered 2302635.

3. On 24 December 2002 Fronsac Investment SA filed notice of opposition to this application. They are the proprietors of the marks, brief details of which appear in the Annex to this decision. A number of them were still pending at the time the opposition was lodged but have now progressed to registration. The opponents say that:

“2. The SIXTY Trade Marks and the KILLAH Trade Marks are used around the world by an Italian company called Sixty SpA of Via Piaggio 35, Chieti 66013, Italy, under a licence granted by the Opponent. The SIXTY Trade Marks were first used in the United Kingdom by Sixty SpA in September 1993, and the KILLAH Trade Marks were first used in the United Kingdom by Sixty SpA in January 1999. Both the SIXTY Trade Marks and the KILLAH Trade Marks have been used continuously since the date of first use in relation to articles of clothing, footwear, headgear and fashion accessories such as bags and handbags.

3. Goods are sold under the SIXTY Trade Marks and the KILLAH Trade Marks throughout the United Kingdom, from both retail stores trading under the trade name MISS SIXTY and also from other national clothing retail outlets such as USC, House of Fraser and Selfridges.

4. As a result of such extensive use by Sixty SpA on behalf of the Opponent, the Opponent has acquired a considerable reputation and goodwill in the United Kingdom, as represented by the SIXTY Trade Marks and the KILLAH Trade Marks.”

4. Objection is raised as follows:

- (i) under Section 5(2)(b) on the basis of a likelihood of confusion between the marks applied for and the opponents’ SIXTY trade marks.
- (ii) under Section 5(2)(b) on the basis of a likelihood of confusion between the marks applied for and the opponents’ KILLAH trade marks.
- (iii) under Section 5(4)(a) by virtue of the law of passing off because the applied for marks are likely to be confused or associated with the opponents’ business on the basis that they constitute the amalgamation of the SIXTY trade marks and the KILLAH trade marks of the opponents.

5. The applicants filed a counterstatement denying the above grounds. They also make a number of observations on the issues brought into play by the opponents’ pleaded case, particularly that under Section 5(4)(a). I will come to these points in due course.

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

7. Both sides filed evidence. The matter came to be heard on 17 August 2004 when the applicants represented themselves and the opponents were represented by Mr K Hodkinson of Marks & Clerk.

Opponents’ evidence

8. The opponents filed four witness statements. Mr A de Bernardi and Mr M F Ries-Bonani are authorised officers of Fronsac Investment SA, the registered proprietors of the earlier trade marks relied on in this opposition.

9. Their evidence simply confirms that an exclusive licence has been granted to Sixty S.p.A. to manufacture and sell goods under the trade marks.

10. The opponents’ main witness statement comes from Renato Rossi, the Managing Director of Sixty S.p.A. He exhibits, RR1, register extracts giving details of the trade marks relied on.

11. Sixty S.p.A. are manufacturers and merchants of clothing and fashion articles including trousers, jackets, shirts, shorts, dresses, coats, jumpers, swimwear, belts, hats, shoes etc. Mr Rossi says that the marks SIXTY and MISS SIXTY were first used on clothing in the UK in 1993. The trade mark KILLAH was first used on clothing in the UK in 1999. He exhibits at RR2 advertisements that have appeared in various national and international magazines and newspapers. In fact almost all this material is in German, French or Italian languages and magazines. Other material appears to be directed at the US or Canadian market. There are

references to Miss Sixty and Killah Babe in an extract from Sportswear International but this is dated November 2002 (after the material date). There is one item in this Exhibit from April 2001 which is clearly of potential relevance to the extent that it is within the relevant time frame and shows a UK cover price (along with the equivalent in other currencies). The name of the magazine is not clear.

Mr Rossi also exhibits:

RR3 - extracts from SIXTY catalogues for years 1996/7 through to the material date and beyond;

RR4 - extracts from the MISS SIXTY catalogues for the years 1996/7 through to the material date and beyond;

RR5 - extracts from the KILLAH catalogues from 1999 to the material date and beyond.

In each case the catalogues are said to have been widely distributed through the trade in the UK both to actual buyers of the goods and to potential buyers.

RR6 - a selection of debit notes for goods sold under the mark SIXTY and issued to customers in the UK. The dates range from 1993 to 2003;

RR7 - a selection of debit notes for goods sold under the mark MISS SIXTY and issued to customers in the UK. The dates range from 1997 to 2000;

RR8 - a selection of debit notes for goods sold under the mark KILLAH and issued to customers in the UK. The dates range from 1999 to 2003.

12. The final piece of evidence is from Keith Leonard Hodkinson, of Marks & Clerk, the opponents' professional representative in this matter. He exhibits a copy of a page from Retail Week published in or around September 2003 which he says shows the notoriety in the UK of the SIXTY, MISS SIXTY and KILLAH brands. The article itself appeared well over a year after the relevant date but is relevant to the extent that it is a historical overview of the development of Sixty S.p.A.'s business in the UK. It fleshes out the development of the UK business to a rather greater extent than Mr Rossi's evidence. It is somewhat curious that the opponents should rely on indirect evidence of this kind rather than a fuller and more informative statement of their own. I note the following main points in the article:

- Sixty UK had forecast sales of £60 million for 2003;
- there are said to be seven stand alone stores, three outlet stores and three shop-in-shops;
- the main brands are the three relied on here, along with one called ENERGIE;
- there is dual branding of MISS SIXTY and ENERGIE in some stores;

- in other respects the individual brands appear to have dedicated stores (“Killah should see its first stores open in the UK by the first half of next year ... and the more catwalk-influenced Sixty brand will also get its own shops”).

Applicants’ evidence

13. Kevin Payne and Susanna Kelly filed a joint witness statement. In the main it consists of submissions that I will take into account in my decision. I do not, therefore, propose to summarise their statement at this point.

Decision

14. I now turn to the grounds of opposition commencing with that under Section 5(2)(b). This reads:

“(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.”

15. 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] R.P.C. 117, *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.

16. For the benefit of the private applicants and in case the matter goes to appeal the guidance from these cases can be summarised as being:

- (a) the likelihood of confusion must be appreciated globally, taking account of all the relevant factors; *Sable 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; *Sable BV v. Puma*, 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. Klijsen 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; *Sable 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 slightly 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 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.

17. Mr Hodkinson’s skeleton argument indicated the position he was taking at the hearing as follows:

“It is not contended that the SIXKILLER marks are confusingly similar to the SIXTY or MISS SIXTY marks taken in isolation; it is contended that the SIXKILLER marks are confusingly similar to the KILLAH marks in isolation; and that when the public are aware of both SIXTY and KILLER marks, there is an enhanced risk of confusion both with SIXTY and with KILLAH, but particularly KILLAH.”

18. On that basis I do not need to consider the SIXTY or MISS SIXTY marks individually from the point of view of likelihood of confusion. I do need to consider the opponents’ position based on their KILLAH marks. As can be seen from the Annex to this decision, No 968941, is an earlier trade mark which is registered for goods in Classes 18 and 25 which are identical to those of the application in suit. Of the other two registrations, No 1472646 is more obviously relevant in terms of the goods specified but has a more prominent device and the addition of the word BABE. I propose to take No 968941 as offering the opponents their best chance of success. I understand from Mr Hodkinson that the bracketed word “(Killah)” forms no part of the registered mark (per the registration certificate). The presence of this bracketed element is, therefore, unexplained but I proceed on this basis that it is KILLAH in stylised form with the accompanying device that is the mark to be taken into account for comparison purposes.

19. The respective marks are, therefore,:

Applicants' marks

SIXKILLER

sixkiller

Opponents' mark



20. The applied for series of marks requires little comment save to say that SIXKILLER is to the best of my knowledge an invented word and one that has no meaning in relation to goods at issue. I also take no account for present purposes of a somewhat different version of the mark submitted in the applicants' evidence. I can only consider the marks applied for.

21. The opponents' mark is a composite one consisting of the word KILLAH and a device which appears to be in the form of an ace of spades. The device is neither the most prominent element in the mark nor is it of negligible importance. It must be given due weight within the context of the mark as a whole.

22. So far as the word KILLAH is concerned, Mr Hodkinson submitted that, presentation-wise, it was in a conventional font. Mr Payne took the opposite view. The truth is probably somewhere in between. There is a degree of irregularity and stylisation in the lettering (including the use of the capitalised letter H at the end of the word) which takes it away from the purely conventional. The stylisation (it is said to be graffiti inspired) adds something but does not obscure or detract from the presence and effect of the underlying word.

23. Rather more germane to the issue of comparison is how the word KILLAH will be seen by consumers. Central to Mr Hodkinson's submissions was the proposition that it would in effect be seen as an alternative spelling of the word KILLER. The argument proceeds on the basis that it is not uncommon for an '-a' to be substituted for an '-er' word ending. I accept that submission as far as it goes. The substitution of '-a' for '-er' in word endings is an occasional occurrence in casual usage and perhaps in tabloid journalism. I am not aware that '-ah' is commonly substituted for '-er'. It is a point that might have been susceptible to evidence. But as matters stand it goes beyond what I am prepared to accept. I would have taken KILLAH to be a purely invented word or possibly an unusual surname. That is not to say that it would not mean different things to different people. If it is street slang or casual usage for 'killer' and likely to be generally understood as such amongst a cross-section of consumers then the position needed to be established with some care. I note that a footnote to an extract from Sportswear International in Exhibit RR2 refers to "...Killah Babe, later shortened to Killah, from the American slang word description for the expression *killer babe*". But the Journal itself is dated November 2002 and there is no information on its availability in the UK. As some explanation of the origin of the expression was considered necessary it confirms my doubts about the level of familiarity with it in this country.

24. Before turning to a comparison of the respective marks there is one other factor I need to consider. The distinctive character of a mark can be the product of its inherent characteristics and

any enhanced distinctiveness acquired through use. I regard the opponents' composite mark as having a high degree of inherent distinctiveness. The evidence of use filed by the opponents does not further elevate the distinctive character of the mark within the terms of the guidance in *DUONEBS* Trade Mark, O/048/01 where in relation to the reputation attaching to a mark it was said that:

“In my judgment, I believe what the ECJ had in mind was the sort of mark which by reason of extensive trade had become something of a household name so that the propensity of the public to associate other less similar marks with that mark would be enhanced. I do not believe that ECJ was seeking to introduce into every comparison required by Section 5(2), a consideration of the reputation of a particular existing trade mark.”

25. The KILLAH brand was not introduced to the UK until 1999. No attempt has been made by Mr Rossi to quantify the trade. The few invoices that have been submitted along with the catalogue material confirm that there has been use but not to an extent, duration or intensity that would support a more favourable finding on distinctiveness. However, given the undoubted inherent merits of the mark I do not think that this materially impacts upon the opponents' prospects of success.

26. Visually, I find there is a low degree of similarity between the respective marks arising from the common element KILL- but that the overall visual impressions created by the mark is quite different.

27. Aurally, the opponents' position is somewhat stronger. I accept Mr Hodgkinson's submission that in speech the difference between the '-er' and '-ah' endings may not be apparent. Both may be slurred to create a flat 'a' sound. Furthermore the device element of the opponents' mark is less likely to be referred to in speech. Even so, taking the applicants' marks in their entirety the respective marks have only a modicum of similarity bearing in mind that the initial element SIX-/six- will not go unnoticed or be dropped in speech. I also bear in mind that it was held in *REACT* Trade Mark, [2002] RPC 285 in relation to clothing that:

“The Hearing Officer was prepared of his own experience to hold that the initial selection of goods would be made by eye, and I believe this is correct. I must therefore, in taking into account the likelihood of aural confusion, bear in mind the fact that the primary use of the trade marks in the purchasing of clothes is a visual act.”

28. So far as conceptual considerations are concerned, this turns critically on whether KILLAH is seen as simply a corruption of the word 'Killer'. For the reasons I have given above I am prepared to accept that some may see it that way but not that a significant proportion of average consumers (taking the relevant audience to be the public at large) will take that message from the mark. I bear in mind in this respect that the average consumer is generally not credited with pausing to analyse marks or to speculate on underlying meanings. (*Sabel BV v. Puma AG*, paragraph 23). Moreover, even if there is a category of consumers that would see the mark differently it would require the consumer to engage in a process whereby he/she discounts the impact of the device, extracts 'Killer' from KILLAH and makes the connection with the

applicants' mark which merely incorporates an uncorrupted spelling of that word as an element within it.

29. It is well established that likelihood of confusion is a matter of considering both similarities and differences between marks and goods. I have little hesitation in concluding that on the basis of a global consideration of the above factors there is no likelihood of confusion if the applied for mark is registered.

30. The second issue under Section 5(2)(b) is Mr Hodkinson's case based on use of the opponents' SIXTY and KILLAH marks such that each reinforces the risk of confusion between the other and the applicants' mark. The case was put as follows in his skeleton argument (footnotes omitted):

“4.12 It is therefore justifiable to have regard to them together, and not merely to consider them separately in comparison with the mark applied for. Whilst at first ENERCAP might seem to be against this, firstly the decision is one of the Appointed Person, secondly the decision of 10 September 1998 predates the Canon decision of 29 September 1998 (above) where circumstances of use are material to s(5)(2)(b) without restriction as to the type of use; and thirdly there was in fact no use pleaded in that case, so the point was entirely obiter and of course directed to whether families of marks can be pleaded. It is clear in any event from *Novartis Nutrition AG v Lifesource International Inc* in opposition before the OHIM that families of marks in use may reinforce each other. There is no reason why familiarity with more than one mark, lacking a common element, should not likewise enhance the risk of confusion.

4.13 Thus trade marks forming the subject of UK Application No. 2302635 are likely to be confused or associated with the business of the Opponent, on the basis that the marks constitute the amalgamation of the SIXTY Trade Marks and KILLAH Trade Marks of the Opponent. Members of the public who only have an imperfect recollection of the Opponent's trade marks are likely to confuse or associate the trade marks forming the subject of UK Application No. 2302635 with the SIXTY Trade Marks and the KILLAH Trade Marks of the Opponent. By combining two familiar brands sold in the same outlets, there is an inevitable linkage in the mind of the consumer to the Opponent's marks. The use made by the opponent of its two marks is such that each reinforces the risk of confusion between the other and the applicant's mark.”

31. This submission raises issues of pleadings, of law and of fact. It is clear from the opponents' statement of grounds that the 'amalgamation' of marks claim was being run under Section 5(4)(a). The grounds based on Section 5(2)(b) have been pleaded as alternatives to the Section 5(4)(a) case but expressed in separate paragraphs dealing in turn with the SIXTY trade marks and the KILLAH trade marks. On a plain reading of the grounds I do not consider that the applicants could reasonably have anticipated that the amalgamation of marks issue was being put in play in relation to Section 5(2)(b). Moreover, as the point is in my view a novel one, it should not have been left to inference.

32. As can be seen from the above extract from Mr Hodkinson's skeleton argument the case is made by analogy with the principles that have been held to apply in relation to a family of marks. Specifically, Mr Hodkinson submitted that, although there is no authority on the point, he did not need one as it is well established that the likelihood of confusion must be appreciated globally taking into account all the relevant factors (*Sabel BV v. Puma AG*, paragraph 23).

33. I have great difficulty with the proposition thus advanced. The comparison that I am required to make in relation to the opponents' earlier trade marks is a mark for mark one against the applied for mark SIXKILLER. The point was well made in the following extract from the decision of Professor Annand, sitting as the Appointed Person in *The Infamous Nut Company Limited's Application*, O/411/01:

“ 35. It is impermissible for section 5(2)(b) collectively to group together several earlier trade marks in the proprietorship of the opponent.

36. Section 5(2)(b) speaks of registration being refused on the basis of an earlier trade mark (as defined by section 6). Thus where the opponent relies on proprietorship of more than one earlier trade mark, the registrability of the applicant's mark must be considered against each of the opponent's earlier trade marks separately (*ENER-CAP Trade Mark* [1999] RPC 362).

37. In some circumstances, it may be possible for the opponent to argue that an element in the earlier trade mark has achieved enhanced distinctiveness in the eyes of the public because it is common to a “family of marks” in the proprietorship and use of the opponent (*AMOR*, Decision no 189/1999 of the Opposition Division, OHIM OJ 2/2000, p.235). However, that has not been shown by the evidence to exist in the present opposition and cannot, as contended by Mr Walters on behalf of the opponent, be presumed from the state of the register in Classes 29 and 31.”

34. The family of marks principle only comes into play when, through use, the relevant public has learned to recognise that an element common to a family of marks is indicative of the fact that marks sharing that element are in common ownership. Thus, when faced with another mark employing that element confusion may result if that expectation is not satisfied. I fail to see that there can be any such expectation when two marks (SIXTY and KILLAH) have no element in common as consumers, who do not ordinarily concern themselves with ownership of marks, would have no reason to make any sort of origin association between them. Neither can I find any support for the opponents' position in the ECJ authorities referred to above. The opponents' rely upon the global nature of the test for likelihood of confusion which brings all relevant factors into account. The relevant passage from *Sabel v Puma* reads:

“As pointed out in paragraph 18 of this judgement, Article 4(1)(b) of the Directive does not apply where there is no likelihood of confusion on the part of the public. In that respect, it is clear from the tenth recital in the preamble to the Directive that the appreciation of the likelihood of confusion “depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign and between the trade mark and the sign and

between the goods and services identified”. The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case.

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

35. There is nothing in the passage which suggests that a relevant factor to which an opponent might have recourse might be the elision of rights arising from the use of dissimilar marks which happen to be in their ownership. I, therefore, reject this aspect of the opponents’ case both for want of proper pleading and as a matter of law. If there is a point to be run based on the factual circumstances which, the opponents say, underpin their case it seems to me to be more appropriate to the ground under Section 5(4)(a) where it certainly formed part of the pleaded case.

36. I, therefore, turn to Section 5(4)(a) which 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)

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.”

37. The requirements for this ground of opposition can be found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *WILD CHILD Trade Mark* [1998] RPC 455. The three elements that must be present can be summarised as follows:

- (1) that the opponents’ goods have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the applicants (whether or not intentional) leading or likely to lead the public to believe that goods offered by them are goods 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 applicants’ misrepresentation.

38. In *REEF Trade Mark* [2002] RPC 19 Mr Justice Pumfrey observed in relation to the evidential requirements that:

“There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a *prima facie* case that the opponents’ reputation extends to the goods comprised in the applicants’ specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s11 of the 1938 Act (see *Smith Hayden (OVAX)* (1946) 63 RPC 97 as qualified by *BALI* [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the *prima facie* case. Obviously he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

It is clear from these observations that the onus is on the opponents to establish their reputation/goodwill.

39. The primary evidence in this case comes from Mr Rossi and goes to supporting the claim that the SIXTY and MISS SIXTY marks have been used since 1993 in relation to menswear and womenswear respectively. The KILLAH marks have been used since 1999. Mr Rossi does not attempt to quantify the level of trade. Exhibit KLH1 to Mr Hodgkinson’s evidence, the Retail Week press article, indicates a sales forecast for Sixty UK of £60 million in 2003. That is after the material date but indicative of a substantial trade.

40. Unfortunately, Mr Rossi’s evidence puts little flesh on the bones. The press clippings and newspaper advertisements at RR2 appear to be almost exclusively US, French, Italian and German publications and in some cases are dated after June 2002.

41. The catalogue material exhibited at RR3 to 5 gives some indication of the range of goods but no information is given, other than general claims, as to the number of catalogues circulated and to whom they were sent. There is also other matter in these exhibits which is in foreign languages or cannot be clearly linked to the UK and/or is after the material date. Sufficient survives to suggest that the opponents have a trade in the UK. The invoice evidence at RR6 to 8 leaves me with the impression that much of this trade is to niche retailers/smaller clothes shops but with some sales to larger stores such as House of Fraser and Bentalls. I find the evidence as a whole to be sketchy and not well directed to explaining and substantiating the nature and extent of the trade.

42. However, even setting aside my doubts about the evidence directed at establishing a trade under the individual brands, I find the evidence to be almost wholly unhelpful to the applicants’

claim based on a misrepresentation arising as a result of the public's perception of the collective force of the SIXTY and KILLAH marks arising from the use made of them.

43. Firstly, there is no evidence of dual branding either in the form of the two standalone brands being used together or as a housemark and sub-brand. Quite the contrary, the evidence is that SIXTY, MISS SIXTY and KILLAH are directed at different segments of the market. Exhibit KLH1 characterises it as follows:

- SIXTY - a more sophisticated menswear range
- MISS SIXTY - the womenswear equivalent of Energie (the latter is itself said to be used in relation to denim-based menswear)
- KILLAH - 'for the young, eclectic and extravagant female'.

44. It is not surprising, therefore, the individual brands have their own catalogues and advertising material. The intention is also to have separate shops dedicated to the individual brands. The following extracts have been taken from KLH1:

"...there are MISS SIXTY stand-alone stores in...."

"KILLAH should see its first stores open in the UK by the first half of next year...."

"By early 2005 we will start looking at the first stand alone SIXTY store..."

45. The only references to dual branding are as follows (again from KLH1):

"...the recently opened Bicester store which is dual-branded MISS SIXTY and ENERGIE..."

"The company has since expanded to 13 UK outlets under the MISS SIXTY brand and one under the ENERGIE brand in Covent Garden . The Carnaby Street store is dual-branded as MISS SIXTY and ENERGIE..."

46. However, I acknowledge that the opponents' trading is not restricted to their own stores. I have, therefore, looked carefully at the evidence available to me from the invoices/debit notes at RR6 to 8. On the basis of this material there appears to be very limited overlap in terms of the retail outlets served (leaving aside debit notes addressed to Sixty UK Ltd which I take to be either the opponents' UK operating company or an in-house wholesaler /distributor). The only examples I have found are in respect of SIXTY and MISS SIXTY goods both going to a shop called Yellow Moon and MISS SIXTY and KILLAH goods both going to Legends Surf Shop. This latter is, therefore, the only example of circumstances where the public might be exposed to both MISS SIXTY and KILLAH in a retail environment. However, given that Legends Surf Shop presumably displays a variety of brands it would require very much more to satisfy me that

the public would make any sort of association between what are on the face of it entirely different marks.

47. Mr Hodkinson, nevertheless, submitted that I should take into account the trade who might be exposed to both brands and, therefore, make an association between them. By ‘trade’ I take him to mean intermediaries such as importers, wholesalers, distributors and such like. Whatever the merits of that argument, there is simply no or insufficient evidence before me on the point. It is by no means clear whether such trade intermediaries are used (the debit notes suggest sales and billing directly from Italy) but I accept that further evidence on the point might have told a different story. Nor, of course, is there any direct evidence from the trade as to their perceptions of the opponents’ use and the potential impact of use of the applied for marks.

48. On the basis of the factual evidence before me, therefore, I have little hesitation in concluding that the opponents’ case based on the claim that the applied for marks would be seen as an amalgamation of the opponents’ SIXTY and KILLAH marks must fail. Furthermore, to the extent that the opponents’ place reliance on the use of their marks taken individually they can be in no better position than under 5(2)(b). In short the opposition fails on all the grounds on which it has been brought.

49. The applicants are entitled to a contribution towards their costs. They have represented themselves during the course of this action. In *Adrenalin Trade Mark*, O-040-02, Simon Thorley QC, sitting as the Appointed Person on appeal, observed that:

“It is correct to point out that the Registrar’s practice on costs does not specifically relate to litigants in person but in my judgment it could not be that a litigant in person before the Trade Mark Registry could be placed in any more favourable position than a litigant in person before the High Court as governed by the CPR [Civil Procedure Rules]. The correct approach to making an award of costs in the case of a litigant in person is considered in CPR Part 48.6.”

50. Part 48.6 of the Civil Procedure Rules referred to in the above passage provides as follows:

“**48.6**—(1) This Rule applies where the court orders (whether by summary assessment or detailed assessment) that costs of a litigant in person are to be paid by any other person.

(2) The costs allowed under this Rule must not exceed, except in the case of a disbursement, two-thirds of the amount which would have been allowed if the litigant in person had been represented by a legal representative.”

51. These proceedings commenced on 7 June 2002 so the applicable scale is that introduced in Tribunal Practice Notice 2/2002 (costs in proceedings before the Comptroller) for cases starting after 22 May 2000. Applying that scale (details of which were notified to the parties at the commencement of the proceedings) would normally result in an award of £900. That figure has been calculated on the basis that the applicants were required to consider the opponents’ statement of grounds and evidence and file a counterstatement; that their own evidence consisted largely of submissions; and that they jointly attended the hearing to offer further submissions.

Applying the two-thirds guideline consistent with the practice of the High Court where private litigants are concerned I order the opponents to pay the applicants the sum of £600.

52. 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 1st day of September 2004

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

ANNEX

Opponents' earlier trade marks:

Number	Mark	Class	Specification
443887 (CTM)		3, 14, 16 and 25	<p>Soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices.</p> <p>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.</p> <p>Writing or drawing books, books, pencils, pencil holders, plastics for modelling, pens, felt pens for colouring, document wallets, paper, playing cards, adhesive tapes for stationery purposes.</p> <p>Clothing, footwear, headgear.</p>
443895 (CTM)		9,18 and 25	<p>Spectacles and sunglasses</p> <p>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.</p> <p>Clothing, footwear, headgear.</p>
2530590 (CTM)	MISS SIXTY	3,9,14, 18,25,29, 30,32 and 33	<p>Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions;</p>

		<p>dentifrices.</p> <p>Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus.</p> <p>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.</p> <p>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.</p> <p>Clothing, footwear, headgear.</p> <p>Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, milk and milk</p>
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			<p>products; edible oils and fats. Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.</p> <p>Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.</p> <p>Alcoholic beverages (except beers).</p>
1472711 (CTM)		3,14 and 16	<p>Soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.</p> <p>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.</p> <p>Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding 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.</p>
968941 (CTM)	 (Killah)	9,18 and 25	<p>Spectacles and sunglasses.</p> <p>Leather and imitations of</p>

			<p>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. Clothing, footwear, headgear.</p>
1472646 (CTM)		16,18 and 25	<p>Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding 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. Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery. Clothing, footwear, headgear.</p>