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TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 2130218
BY CASIO KEISANKI KABUSHIKI KAISHA
LEY
IN CLASS 14

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AND IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 47639
BY ESCADA AG

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 2130218
BY CASIO KEISANKI KABUSHIKI KAISHA
TO REGISTER A TRADE MARK IN CLASS 14

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AND IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 47639
By ESCADA AG.

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BACKGROUND

On 22 April 1997, Casio Keisanki Kabushiki Kaisha of 6-1, 2-chome, Nishi, Shinjuku, Shinjuku-ku, Tokyo, Japan applied under the Trade Marks Act 1994 for registration of the mark **LEY** in respect of the following goods in Class 14:

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“Horological and chronometric instruments; watches and clocks; parts and fittings for all the aforesaid goods.”

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On the 16 October 1997 Escada A.G. of Postfach 1241, D-85606 Aschheim bei Munchen, Germany filed notice of opposition to the application. The grounds of opposition are:

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- The opponent is the proprietor of the UK trade mark registration number 1470900 ESCADA BY MARGARETHA LEY in class 14 in respect of “jewellery, costume jewellery; all included in class 14. The opponent is using their trade mark in respect of fashion jewellery in the UK and enjoy a substantial reputation therein.

The mark applied for is contrary to the following sections:

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- Section 3(3)(b) as it would deceive the public
- Section 3(4) as its use is prohibited in the UK by enactment or rule of law or by any provision of Community Law.

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- Section 3(6) as the application was made in bad faith
- Section 5(2) as the mark applied for is similar to the opponent’s mark and is to be registered for identical or similar goods.

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- Section 5(4) as use of the mark applied for would be prevented by the law of passing off.

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The applicant subsequently filed a counterstatement denying all of the grounds of opposition, other than accepting that the opponent is the proprietor of registration number 1470900. . Both sides ask for an award of costs.

Both sides filed evidence in these proceedings and the matter came to be heard on 28 April

2000 when the applicant was represented by Mr Graham of Counsel instructed by Marks & Clerk, and the opponent by Mrs Maddox of W P Thompson & Co.

DECISION

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At the hearing the opponent withdrew the grounds of opposition under Sections 3(4) and 5(4).

Subsequent to the hearing, on 31 May 2000 the opponent withdrew their opposition.

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The opposition having succumbed the applicant is entitled to a contribution towards costs. I order the opponent to pay them the sum of £1035. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

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Dated this 22 day of August 2000

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George W Salthouse
For the Registrar
The Comptroller General