

O-308-08

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2390211
BY WOODBRIDGE ESTATES LIMITED TO REGISTER
A SERIES OF SIX TRADE MARKS IN
CLASSES 9, 16, 25 & 41**

AND

**IN THE MATTER OF OPPOSITION NO 94086 BY
FRONSAC INVESTMENT S.A. AND UPCOMING TM S.A.**

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By Fronsac Investment S.A. and Upcoming TM S.A.**

BACKGROUND

1. On 22 April 2005 Woodbridge Estates Limited applied to register the following series of six marks.

SIXTYSOMETHING
SIXTY SOMETHING
SIXTY-SOMETHING
60SOMETHING
60 SOMETHING
60-SOMETHING

for the following goods and services:

Class 09:

Apparatus for recording, transmission, editing and/or reproduction of sound and/or images; magnetic and/or optical data carriers; recorded magnetic and/or optical data carriers; recording discs, compact discs; DVDs; records; films, video and audio recordings; recorded audio and/or video tapes; computer programs; computer games; digital music (downloadable) from the Internet; publications in electronic form and data supplied online or provided through the Internet; spectacles, sunglasses and cases for spectacles and sunglasses; parts and fittings for all the aforementioned goods.

Class 16:

Printed matter; printed publications; books, magazines, journals; posters, photographs, postcards, song books, sheet music; wall charts; instructional and teaching material; writing and drawing materials and instruments; bags, packaging materials; calendars; stencils, decalcomanias; photograph albums; folders and files for papers; ring binders; note books; note pads.

Class 25:

Clothing; footwear; headgear.

Class 41:

Entertainment services; provision and presentation of live entertainment and/or recorded entertainment; production, presentation or rental of television and/or radio programmes, films, sound and video recordings; presentation,

production and performance of shows, musical shows, concerts, videos and stage productions; information relating to entertainment; interactive entertainment services; digital music (not downloadable) provided from a computer database or the Internet; providing on-line electronic publications (not downloadable); publication of electronic books and journals on-line; electronic games services provided on-line; nightclub and discotheque services; dance club services; club entertainment services.

2. On 26 January 2006 Fronsac Investment SA and Upcoming TM SA filed notice of opposition to this application based on grounds under Section 5(2)(b), 5(3) and 5(4)(a) of the Act.

3. In relation to the first of these grounds the following earlier trade marks are relied on:

NO	MARK	CLASS	GOODS RELIED ON
CTM 1659267	SIXTY PRO-TEC	9	Spectacles and sunglasses.
		25	Clothing, footwear and headgear.
CTM 3112331	MISS SIXTY	9	Sunglasses and eyeglasses; parts and fittings for these goods.
		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.
		25	Clothing, footwear, headgear.
CTM 443887	<i>Miss Sixty</i>	25	Clothing, footwear and headgear.

4. In relation to Section 5(3) the opponents rely solely on CTM No 2530590 for the plain words MISS SIXTY. This registration covers goods in Classes 3, 9, 14, 18, 25, 29, 30, 32 and 33 along with services in Class 43. The statement of grounds adds “but specifically Class 9” optical apparatus and instruments” and Class 25 “clothing footwear and headgear”” which I take to be the goods particularly relied on. In response to the invitation on the form TM7 (Notice of Opposition) to “state which goods or services you say this mark has a reputation for” the opponents indicated “clothing, fashion articles, spectacles, footwear and headgear, sunglasses and cases for spectacles and sunglasses”. A similar range of goods is objected to in the applicant’s specification. The claim is that the opponents’ rights will be diluted and there would be a likelihood of confusion.

5. In relation to Section 5(4)(a) the opponents rely on the sign MISS SIXTY and use of that sign in respect of clothing including jeans, t-shirts, pullovers, other clothing articles, other accessories and shoes. Use is claimed from 1997 in respect of clothing and accessories and from 2001 for shoes. Again the objection is directed at the applicant’s goods in Classes 9 and 25 along with the indeterminate term fashion articles.

6. For the sake of completeness I should add that it seems there was originally a further mark relied on for Section 5(2)(b) purposes, namely CTM 443895 (for the mark SIXTY). However, no statement of use was provided in respect of this mark with the result that it has been removed from the TM7 (the Registry’s letters of 31 January 2006, 28 April 2006 and 7 August 2006 refer).

7. The applicant filed a counterstatement denying the above grounds and putting the opponents to proof of their reputation and goodwill.

8. Both sides have filed evidence. The matter came to be heard on 28 October 2008 when the applicant was represented by Mr J Stobbs of Boulton Wade & Tenant and the opponents by Mr J Delaney of Counsel instructed by Potts Kerr & Co.

Opponents’ evidence

9. The opponents have filed three witness statements, one of which is by way of reply evidence. Two of the witness statements are from David C F Gilmour, the opponents’ trade mark attorney and a partner in the firm of Potts Kerr & Co. His evidence in chief has been filed to provide full details of the various earlier trade marks relied on. This part of the evidence does not call for further comment other than to say that two of the marks referred to play no part in these proceedings. These are CTM No 443895 which has been struck out for the reasons given above and UK No 1476768 which does not seem to have ever been part of the pleaded case.

10. The substance of the opponents’ evidence is to be found in a witness statement by Régis Donati, Director of Upcoming TM SA and previously a director of Fronsac Investment SA. He exhibits the following:

ADB/MFRB 1 - invoices showing use of the trade mark SIXTY (this part of the evidence is of dubious relevance given that the

SIXTY mark is no longer available to the opponents in this action).

- ADB/MFRB 2 - invoices showing use of the trade mark MISS SIXTY from June 2001 to September 2006. The invoices were issued by Sixty S.p.A., the exclusive licensee and producer of SIXTY and MISS SIXTY goods.
- ADB/MFRB 3 - MISS SIXTY catalogues for the years 2003 to 2006.
- ADB/MFRB 4 - SIXTY catalogues (again the relevance of this material has not been explained).
- ADB/MFRB 5 - the addresses of SIXTY flagship stores where MISS SIXTY goods are sold (along with other Sixty S.p.A. brands, SIXTY, ENERGIE and KILLAH etc). It is said that these are not the only distribution channels but no further information is given as to other outlets.
- ADB/MFRB 6 - copies of advertisements in various magazines and papers distributed in the UK during recent years.

11. Further information on the opponents' UK business is contained in an exhibit to Mr Gilmour's second witness statement dated 13 June 2008. It contains a letter received from Potts Kerr's instructing attorneys in Luxembourg. The letter itself is on Sixty S.p.A. notepaper and is in Italian. A further letter in the exhibit from Potts Kerr contains a translation. The translation has not been certified and appears to contain an error in that the two tables of statistics set out in the letter are translated as 'amount of advertising expenses'. In fact the first set of figures dealing with 'fatturato' should, I think, have read turnover.

12. Mr Stobbs took a different point against this evidence at the hearing by suggesting it was not strictly in reply to his own evidence for the applicant. I have some sympathy with that view of the matter but, despite the fact that the evidence was filed in mid June 2008, no objection was taken at the time nor so far as I am aware between then and the hearing date. It also follows that the opponent has had no opportunity to respond to, or deal with, the applicant's criticisms. Not without hesitation because of the above points I have decided that at this late stage I will take the evidence into account. The information supplied is as follows.

13. Turnover (fatturato) in relation to MISS SIXTY expressed in euros:

YEAR	AMOUNT	NUMBER OF ARTICLES
2004	20,049,148	784,442
2005	20,837,051	558,773
2006	15,147,416	518,892
2007	17,366,401	561,872

14. Advertising in relation to MISS SIXTY (again expressed in euros):

YEAR	ADVERTISING EXPENSES
2004	541,857
2005	425,898
2006	383,797
2007	324,138

Applicant's evidence

15. Julius Stobbs, the applicant's trade mark attorney, has filed a witness statement. He is a partner in the firm of Boulton Wade Tennant. He exhibits:

JEBS 2 - the results of a trade mark search conducted on the UK and Community Trade Mark registers to identify marks covering goods in class 25 that contains the element 60 or the word SIXTY. He suggests that the volume of results confirms that this element is commonly adopted by third parties.

JEBS 3 - internet extracts on the basis of which it is suggested that the numeral 60 or the word SIXTY is commonly used in the clothing industry as part of a brand or as a generic indication.

16. His overall conclusion is that no one proprietor can claim exclusive rights to the numeral 60 or the word SIXTY in relation to clothing and related products.

Appraisal of the opponents' evidence of use

17. The relevant date at which the opponents' use must be assessed for the purposes of enhanced distinctive character (for Section 5(2)(b) purposes), reputation (for Section 5(3) purposes) and goodwill (for Section 5(4)(a) purposes) is 22 April 2005. The quantification of the opponents' trade is set out above. Only the 2004 figures and such part of the 2005 figures as is before the relevant date (not specified) can formally be taken into account though subsequent figures are confirmation of the continuation of an established trade. The 2004 turnover of over 20 million euros is significant and is unlikely to have been achieved from a standing start.

18. I also note that there are said to be seven stores in the UK selling, inter alia, MISS SIXTY branded goods. They are in prominent locations in major cities. Thus, for instance, there are stores in the Birmingham Bullring, the Bluewater Shopping Centre, Carnaby Street (London) and the Trafford Centre in Manchester. Although Mr Donati's witness statement does not explain the entries, there are three further references to UK outlets including Selfridges and Harrods. I infer that these outlets may be concessions or at least locations where a significant retail presence exists. The opponents or their exclusive licensee thus have a presence in high profile locations in the UK that are likely to attract customers from a wide geographical area.

19. Two exhibits supplement this picture. Firstly, the MISS SIXTY catalogues in Exhibit ADB/MFRB 3 (discounting those catalogues that are clearly after the relevant date). The mark used in each case is generally the form show in CTM No 3112331.

20. The use is in relation to a range of clothing and footwear (singlets, trousers, t-shirts, sweaters, jackets and shoes). There is some non-clothing use on sunglasses and bags. I should add that in relation to sunglasses the Spring/Summer 2005 catalogue records 'Licence : Marcolin SpA'. That may give rise to the question as to whether the licence relates to the brand or the design. In one case (page 25 of the above-mentioned catalogue) MISS SIXTY (stylised) can be seen on the sunglasses. No branding is visible on the sunglasses shown on page 17 of the same brochure.

21. Mr Donati does not say whether these brochures were distributed or available in the UK. As neither the opponents nor their exclusive licensee are UK based it is not an automatic inference that the brochures were present in the UK market. There is remarkably little textual content but the inside back cover pages describe the displayed goods in English. On the other hand a telephone number on the back cover of two of the catalogues appears to be the international dialling code for Italy. I am, therefore, left in some doubt as to the impact of the catalogues on the UK market.

22. The second exhibit I need to consider in more detail is ADB/MFRB 6, this being a selection of advertisements contained in magazines etc that have been distributed in the UK. The material includes advertisements of MISS SIXTY branded goods and fashion pages where a number of brands feature including MISS SIXTY. The magazines featured include Glamour, Dazed, i-D, The Fashion, Zest, The Face, Cosmopolitan, more!, 19, Drapers Record & Menswear, Another Magazine, Wallpaper, Sugar, In Style, B, Elle, Bliss, Mizz, J17, Marie Clair, Looks and Jump. There are also press cuttings from for instance The Mirror, The Times and a number of local newspapers. Most of the exhibited material includes the magazine cover pages as well as the MISS SIXTY advertisements and can thus be dated. The material is mainly from the period 1999 to 2003 and is thus relevant to the period leading up to the filing date of the application under attack. The mark that is consistently used is the version shown in CTM No 3112331. The goods are predominately clothing items. There are a small number of other fashion items – a bracelet, a necklace and some bags but too few in number to make a contribution to a reputation in a 'diffusion' range of fashion goods.

23. There is one specific item in Exhibit ADB/MFRB 6 that is worth mentioning. This is an item on 'young fashion womenswear' from Drapers Record & Menswear from 3 May 2003. MISS SIXTY is shown as the bestselling brand for the previous week. That is admittedly a snapshot in time and its significance should not be overstated. It does, however, place the brand in the same league as French Connection, Diesel and Ted Baker which are the next names on the list. An earlier piece from the same journal dated 12 April 2003 notes that Levi is setting out to target a sector of the market for which "MISS SIXTY is the hot jeans wear label". It is noteworthy that the brand has this sort of status in a sector of the clothes market where Levi itself is a market leader. Mr Delaney's skeleton argument identified a number of other comments drawn from the press coverage that, whilst anecdotal in nature, collectively provide further support for the brand's claim to a reputation.

24. Despite certain weaknesses in the evidence I conclude that MISS SIXTY is a mark that is entitled to claim an enhanced degree of distinctive character in the young female clothing market and likewise a reputation within the *Chevy* test for Section 5(3) purposes and goodwill for Section 5(4)(a) purposes.

DECISION

25. The relevant part of Section 5(2) of the Act is as follows:

“(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.”

26. Mr Delaney referred me to the reasoned Order handed down by the European Court of Justice (ECJ) disposing of the appeal in Case C-235/05P *L’Oreal SA v. OHIM*. The relevant legal principles, drawn principally from the Court’s earlier judgments in *Sabel* [1998] RPC 199, *Lloyd Schuhfabrik Meyer* [2000] FSR 77 and *Canon* [1999] RPC 117 are set out in that Order, the relevant part of which is reproduced below:

“34 It is settled case-law that likelihood of confusion on the part of the public must be assessed globally, taking into account all factors relevant to the circumstances of the case (see, to that effect, Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 22; Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 18; and order of 28 April 2004 in Case C-3/03 P *Matratzen Concord v OHIM* [2004] ECR I-3657, paragraph 28).

35 That global assessment implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between the goods or services covered. Thus, a lesser degree of similarity between those goods or services may be offset by a greater degree of similarity between the marks, and vice versa. Accordingly, it is necessary to give an interpretation of the concept of similarity in relation to the likelihood of confusion, the assessment of which depends, in particular, on the recognition of the trade mark on the market and the degree of similarity between the mark and the sign and between the goods or services covered (see *Canon*, paragraph 17, and *Lloyd Schuhfabrik Meyer*, paragraph 19).

36 In that regard, as the more distinctive the earlier mark, the greater the risk of confusion (*SABEL*, paragraph 24), marks with a highly distinctive

character, either *per se* or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character (see *Canon*, paragraph 18, and *Lloyd Schuhfabrik Meyer*, paragraph 20).

.....

- 40 In the first place, it is settled case-law that in order to assess the degree of similarity between the marks concerned, it is necessary to determine the degree of visual, aural or conceptual similarity between them and, where appropriate, to determine the importance to be attached to those different elements, taking account of the category of goods or services in question and the circumstances in which they are marketed (see *Lloyd Schuhfabrik Meyer*, paragraph 27).
- 41 In addition, the global assessment of the likelihood of confusion must, as regards the visual, aural or conceptual similarity of the marks in question, be based on the overall impression created by them, bearing in mind, in particular, their distinctive and dominant components. The perception of the marks in the mind of the average consumer of the goods or services in question plays a decisive role in the global assessment of the likelihood of confusion (see *SABEL*, paragraph 23, *Lloyd Schuhfabrik Meyer*, paragraph 25, and the order in Case C-3/03 P *Matratzen Concord v OHIM*, paragraph 29)."

The average consumer

27. The goods in issues are spectacles, sunglasses etc in class 9 and clothing, footwear and headgear in Class 25. The relevant public is the populace at large. Consumers are likely to possess a reasonable degree of brand awareness (though it will vary from individual to individual) and to exercise some care and attention in the purchasing process of fashion clothing items not least because size, fit, colour, matching and other issues will need to be considered. Spectacles and sunglasses will likewise not be chosen without some care and attention (particularly the former). It is generally accepted (see *React Trade Mark* [2000] RPC 285) that visual considerations are of primary importance in relation to these fashion items because they are chosen in retail premises or through catalogues though that is not to say that oral requests or recommendations cannot play a part.

Comparison of goods

28. The parties' specifications in Class 25 (for the reasons set out below the comparison is based on the opponents' CTM No. 3112331) are expressed in identical terms and so do not call for further comment. The same is true in relation to sunglasses and parts and fittings for these goods in Class 9. Beyond this the applied for specification covers spectacles. That term does not appear in the specification of No 3112331 but the term eyeglasses does. There may or may not be a semantic difference. If there is it is a very slight one and the goods are still closely similar.

29. The only other point I need to mention in relation to the comparison of goods is that Mr Delaney's attempt to build a case for similarity between bags in the applicant's Class 16 specification and bags and other items in the opponents' Class 18 specification must fail as the point was never pleaded.

Comparison of marks

30. The opponents' original statement of grounds relied on four earlier trade marks for Section 5(2)(b) purposes. For the reasons given earlier CTM No 443895 (for the mark SIXTY) was struck out at a relatively early stage. Of the surviving marks Mr Delaney indicated in his skeleton argument and at the hearing that he would no longer be relying on No 1659267 and No 443887 as it was accepted that these marks did not advance the opponents' case beyond No 3112331, that is to say the mark MISS SIXTY in slightly stylised form. That was, in my view, a realistic and helpful concession though I will need to return to these other marks briefly below. No. 3112331 is not subject to the need to make a statement of use.

31. Paragraphs 40 and 41 of the *L'Oreal* case set out the criteria for comparing marks and the factors to be taken into account including the process of identifying distinctive and dominant components.

32. Mr Delaney's position was set out very fully in his skeleton argument. It can be summarised as being that:

- visually the word SIXTY is the dominant component in both marks in part due to the strong impact of the 'XTY' combination. In contrast the MISS and SOMETHING components are more commonly observed everyday words and likely to be perceived by consumers as of less importance.
- aurally, the SIXTY element is identical in each case and is the dominant component. It is said that the words MISS and SOMETHING are relatively softly spoken and make less impact.
- there is no basis for distinguishing the marks in conceptual terms. The dominant SIXTY component does not carry any particular semantic meaning. The MISS element may serve to indicate that the mark is to be used in the women's-wear segment of the market. The element SOMETHING will either be understood as a 'catch all' suffix focussing attention back on to SIXTY and hence an association with the opponents' mark or it would be understood as an element akin to a question mark and so indefinite and incapable of distinguishing products from the underlying SIXTY brand.

33. Mr Stobbs, for the applicant, accepted that the objection either stood or fell against all the marks in the series and, therefore, that no distinction needed to be drawn between the numeral and word versions of the applied for series. He rejected the approach of focussing on the element SIXTY and treating it as the dominant element of the respective marks. On the contrary he regarded SIXTY as being a

weak element taken on its own. His submissions emphasised the need to make a whole mark comparison taking account of the conceptual differences between the marks. In his view MISS SIXTY would be taken as a name because the word MISS usually precedes a name whilst SIXTY SOMETHING was a way of referring to age.

34. It can thus be seen that these submissions throw into sharp relief the key question of whether SIXTY is the/a dominant component or has independent distinctive character within one or the other or both of the marks.

35. The approach to dealing with composite marks and the issue of independent distinctive character was set out in *Medion AG v Thomson multimedia Sales Germany & Austria GmbH*, Case C-120/04. The relevant passage reads:

“29 In the context of consideration of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see *Matratzen Concord*, paragraph 32).

30 However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.

31 In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.”

36. That case involved the use of a company name as part of a composite mark (THOMSON LIFE) but it was held in *Rousselon Frères et Cie and Horwood Homewares Limited* [2008] EWHC 881 (Ch) (since reported at [2008] R.P.C. 30) that the reasoning of the decision applied to other types of composite marks (paragraph 89 of the judgment).

37. Self evidently, the competing marks share the element SIXTY (or that word expressed as a number). All three elements of the respective marks are commonly used and understood words. In my view what gives the marks their distinctive character is the bringing together of elements in such a way as to create a new or particular idea. In the case of MISS SIXTY that idea may be taken to be either a

name as Mr Stobbs suggests or alternatively it may suggest a connection with a style from a particular decade. I note that in *Claudia Oberhauser v OHIM*, Case T-104/01, [2003] E.T.M.R. 58, relied on in a number of respects by Mr Delaney, the CFI considered that one of the meanings that could be conveyed by the words Miss Fifties (a key component of the opponent's mark) was a reference to "women of that decade". Other possible meanings were considered because the relevant public was Spanish consumers (it appears to have been considered that they would understand the element Miss but may or may not have recognised or understood the element Fifties). The mark here is Miss Sixty and not Miss Sixties but I am not persuaded that the average consumer will take a different view of the mark on that account. Contrary, therefore, to Mr Delaney's submission that the MISS element may simply be taken as indicating a range of women's-wear, I find that, whilst it may also carry that message, the character of the mark resides in the bringing together of two common words to create a novel idea.

38. The same is true of SIXTY SOMETHING and the other marks in the series. The words represent a perfectly normal use of language. It, or comparable expressions, would be used typically in circumstances where one might be uncertain of another person's age or wished, for reasons of discretion, to refer in imprecise terms to age.

39. It follows from all this that I do not regard SIXTY as having independent distinctive character within the marks. Rather, the commonplace elements that make up the marks combine to create new ideas or meanings of their own.

40. However, that is not the same as saying that there is no similarity between the marks. Almost inevitably, where marks consisting of two words have one word in common there is a measure of similarity (unless the common element is so descriptive or lacking in distinctiveness that it would be ignored or largely discounted by consumers) but it is a question of degree.

41. Visually, the common element appears in different positions in the respective marks and, taken as wholes, the marks seem to me to be quite different to one another. The same is true of aural considerations. This is not a case where one element is so dominant that the second element may be dropped or rendered negligible on visual or aural acquaintance with the marks.

42. The reason for that is, in my view, the clear conceptual distance that exists between them as discussed above.

43. The European Courts have held that conceptual differences between trade marks can be of importance. Thus in Case C-361/04P (*Picaro/Picasso*) the ECJ noted the following paragraph in the CFI's judgment:

"Such conceptual differences can in certain circumstances counteract the visual and phonetic similarities between the signs concerned. For there to be such a counteraction, at least one of the signs at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately [Case T-292/01 *Phillips-Van Heusen v OHIM – Pash Textilvertrieb und Einzelhandel* (BASS) [2003] ECR II-4335, paragraph 54]."

and approved the point in paragraph 20 of its own judgment.

44. The *Phillips-Van Heusen Corp v Pash Textilvertrieb und Einzelhandel* case referred to in the above passage contains the following:

“Next, it must be held that the conceptual differences which distinguish the marks at issue are such as to counteract to a large extent the visual and aural similarities pointed out in paragraphs 49 and 51 above. For there to be such a counteraction, at least one of the marks at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately. In this case that is the position in relation to the word mark BASS, as has just been pointed out in the previous paragraph. Contrary to the findings of the Board of Appeal in paragraph 25 of the contested decision, that view is not invalidated by the fact that that word mark does not refer to any characteristic of the goods in respect of which the registration of the marks in question has been made. That fact does not prevent the relevant public from immediately grasping the meaning of that word mark. It is also irrelevant that, since the dice game Pasch is not generally known, it is not certain that the word mark PASH has, from the point of view of the relevant public, a clear and specific meaning in the sense referred to above. The fact that one of the marks at issue has such a meaning is sufficient - where the other mark does not have such a meaning or only a totally different meaning - to counteract to a large extent the visual and aural similarities between the two marks.”

45. The guidance from these cases is relevant here. I find that the marks can be readily distinguished at a conceptual level and have only a low degree of visual and aural similarity.

Family of marks/sub branding

46. Before turning to my conclusions on likelihood of confusion I need to refer to a further factor that Mr Delaney submitted I should bear in mind when making the global assessment – namely the concept of sub-branding that is said to be particularly relevant in the clothing market. More specifically it was put to me that the applicant’s series of mark would be seen as sub-brands within a family of SIXTY branded products all linked to the same economic entity. Mr Delaney relied on the following passage from the *Claudia Oberhauser* case in relation to the sub-branding issue:

“49. It must further be observed, with regard to the conditions in which the products in question are marketed, that it is common in the clothing sector for the same mark to be configured in various different ways according to the type of product which it designates. It is also common for the same clothing manufacturer to use sub-brands, that is to say signs that derive from a principal mark and which share with it a common dominant element, in order to distinguish his various lines from one another (women's, men's, youth). In such circumstances it is

conceivable that the targeted public may regard the clothing designated by the conflicting marks as belonging, admittedly, to two distinct ranges of products but as coming, none the less, from the same manufacturer.”

47. I indicated at the hearing that I saw difficulties in pursuing the family of marks argument both on the basis of the case as pleaded and as it has been developed in the evidence. The opponents rely on a single registration for Section 5(2)(b) purposes. The two other marks that featured in the pleaded case under this head were given up in Mr Delaney’s skeleton argument because they were not considered to advance the opponents’ case. If I have understood his submission correctly his position was that, even though these marks were not relied on as individual earlier trade marks, they could still be taken into account as part of a family.

48. The permissibility of relying on a claim to a family of marks was considered in the *Infamous Nut Co Ltd’s Trade Marks*, [2003] RPC 7 where Professor Ruth Annand, sitting as the Appointed Person, held as follows:

“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.”

49. So far as I can see no claim to a family of marks (or the consequences thereof) was foreshadowed in the statement of grounds. It is inappropriate in my view for such a claim to be raised for the first time at the conclusion of a case. The opponents face the further difficulty that they can only rely on earlier trade marks and even then only to the extent the ‘family’ members have been used. It is not permissible, for instance, to elide earlier trade mark rights with other (non-registered) earlier rights. Even taking a generous view of the matter and factoring back into the family argument the two other earlier trade marks (Nos 1659267 and 443887) that formed part of the opponents’ case under Section 5(2)(b) would not improve their position because no use of those marks has been drawn to my attention. I, therefore, reject any claim to a family of SIXTY branded marks.

50. As Mr Delaney’s submission linked the sub-branding point inextricably to the family of marks claim then the sub-branding argument must also fail. In any case,

whilst I acknowledge the CFI's acceptance of the practice of sub-branding in the clothing industry, I do not read the Court's remarks as suggesting anything more than that this is a practice that can be borne in mind within the factual content of the particular case that is being examined. The point was of particular relevance in the *Claudia Oberhauser* case because of the nuances of meaning for Spanish customers faced with the mark Miss Fifties (see in particular paragraphs 41 to 43 of the judgment). I would have some difficulty in accepting that the applicant's mark here would on any view of the matter be seen as a sub-brand of the opponents' MISS SIXTY mark (with or without the benefit of the 'family' argument).

Other issues

51. The applicant's evidence presented material to indicate the presence of a number of marks on the UK and Community register containing the element SIXTY (or 60) along with internet material showing the word or numeral in use either as a part of a brand or as a generic indication.

52. The state of the register evidence is open to the usual criticism that is made of such material namely that it does not in itself say anything about what the position is in the marketplace and hence how consumers react to marks consisting of or containing the element SIXTY/60. From my own review of this material it strikes me that most of the marks are quite different from one another and the marks before me. I do not get much assistance from the evidence in reaching a decision on this case. The same is largely true of the internet material. Although potentially more useful because it addresses the position in the marketplace the actual examples given show marks whose distinctive character is generally quite different to the marks before me. Also, without knowing more about the extent to which consumers have been exposed to these marks (no trading information is given) the relevance of this material is limited.

53. Finally, I should for the sake of completeness mention that Mr Stobbs provided copies of some six OHIM or OHIM Appeal Board decisions involving competing marks that had one element in common. They were, of course, decided on their own particular facts and circumstances and were not relied on as precedents as such. I have considered these cases but do not consider they assist beyond providing examples of the application of key principles.

Conclusions on likelihood of confusion

54. The *L'Oréal* case reaffirms the need to take account of all factors relevant to the circumstances of the case. The global assessment that I am required to undertake implies some interdependence between the relevant factors particularly the marks and the goods. I bear in mind here that the parties' goods in classes 9 and 25 are either identical or closely similar. I have also held that the MISS SIXTY mark has achieved a degree of recognition in the clothing trade that entitles it to lay claim to an enhanced degree of distinctive character and hence penumbra of protection (it is in any case reasonably distinctive considered on the basis of its inherent qualities). These are clearly points that weigh in favour of the opponents. Against this the differences between the marks far outweighs the point of similarity arising from the presence of the element SIXTY. Even allowing for the fact that some consumers will

be more brand aware than others, the opponents are some way from persuading me that any confusion is likely to result from use of the marks in relation to a common set of goods. In reaching that view I have considered the matter from the point of view of indirect, as well as direct, confusion along with the possibility of sequential as opposed to concurrent exposure to the marks on the part of consumers. I have also, of course, rejected the opponent's submission on 'sub-brands within a family'. The opposition fails under Section 5(2)(b).

Section 5(3)

55. The relevant provision reads:

"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 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."

(Section 5(3) has been amended by The Trade Marks (Proof of Use, etc) Regulations 2004 (SI 2004 No. 946) giving effect to the judgments of the ECJ in *Davidoff & Cie SA and Zino Davidoff SA v Gofkid Ltd* (C- 292/00) and *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd* (C-408/01)).

56. Mr Delaney's skeleton argument summarised the guiding principles relevant to the determination of an objection under this ground. For convenience I reproduce them as follows (annotated only to the extent of adding full case references):

- a) 'Reputation' for the purposes of Section 5(3) means that the earlier trade mark is known by a significant part of the public concerned with the products or services covered by that trade mark (*General Motors Corp v Yplon SA (CHEVY)* [2000] R.P.C. 572).
- b) Under this provision the similarity between the trade marks does not have to be such as to give rise to a likelihood of confusion between them; the provision may be invoked where there is sufficient similarity to cause the relevant public to establish a link between the earlier trade mark and the later trade mark or sign (*Adidas Salomon AG and Adidas Salomon BV v Fitnessworld Trading Ltd* Case C-408/01).
- c) The link must be such that it would cause real as opposed to theoretical effects (*Intel v Sihra* [2003] R.P.C. 44 & *Intel Corporation Inc v CPM United Kingdom*) [2007] E.T.M.R. 59)
- d) The provision is not aimed at every sign whose use may stimulate the relevant public to recall a trade mark which enjoys a reputation with

them (*Premier Brands UK Limited v Typhoon Europe Limited* [2000] F.S.R. 767).

- e) The stronger the earlier trade mark's distinctive character and reputation the easier it will be to accept that detriment has been caused to it (*Premier Brands & CHEVY*).
- f) There is detriment to the distinctive character of the earlier trade mark where it is no longer capable of arousing immediate association with the goods or services for which it is registered. There is detriment to the repute of the earlier trade mark where the goods or services for which the later trade mark is used appeal to the public's senses in such a way that the earlier trade mark's power of attraction is diminished (*Spa Monopole v OHIM*). These concepts have also been described as blurring or tarnishing the earlier trade mark (*Daimler Chrysler v Alavi* [2001] R.P.C. 42).
- g) Unfair advantage is taken of the distinctive character or the repute of the earlier trade mark where there is clear exploitation and free-riding on the coat-tails of a famous trade mark or an attempt to trade upon its reputation (*Spa Monopole v OHIM* Case T-67/04).

57. I should also mention the Court of Appeal's judgments in *Intel Corporation Inc v CPM United Kingdom (Intelmark)* [2007] E.T.M.R. 59 and *L'Oréal SA v Bellure*, [2008] E.T.M.R. 1 both of which have resulted in a number of questions being referred to the ECJ. In particular, in the first of these cases, questions have been asked about the circumstances to be taken into account in determining whether a link will be made between the marks concerned. At the time of writing an Advocate General's Opinion has been issued in *Intelmark*. Neither side has suggested that the case before me should be stayed to await the ECJ's judgments in these cases. I propose to proceed on the basis of the established jurisprudence in this area as reflected in Mr Delaney's summary.

58. The opponents' case under this head is based on the claim that "the opponents trade mark rights will be diluted and there would be a likelihood of confusion" (from the statement of grounds). Mr Delaney's position at the hearing was that, if I was with him in relation to Section 5(2)(b) then he would automatically succeed under both the unfair advantage and detriment heads of Section 5(3) (per Jacob LJ at paragraph 70 of *esure Insurance Ltd v Direct Line Insurance Plc*, [2008] EWCA 842). If, on the other hand I was against him under Section 5(2)(b), as has turned out to be the case, then his case rested on unfair advantage alone.

59. The problem with that position, as identified by Mr Stobbs at the hearing, is that it is not available to the opponents on the basis of the case as pleaded (and set out above). I have held that there is no likelihood of confusion and dilution is not one of the specified heads of damage under the Act and the Directive from which it derives. Though the term is sometimes used in decisions it is usually in the context of dilution of the distinctive character of a mark (detriment) and not unfair advantage – see to that effect the Advocate General's Opinion in *Adidas-Salomon AG and Adidas*

Benelux BV v Fitnessworld Trading Ltd Case 408/01 at paragraph 37. Accordingly, I agree with Mr Stobbs that the opponents have no case left to run under Section 5(3).

60. However, in the event that the matter goes to appeal and I am found to be wrong in coming to the above view I will give brief consideration to the unfair advantage claim. On this, Mr Delaney suggested that even if the similarity between the marks falls short of establishing a likelihood of confusion it was still enough to create a link. The applicant would thereby obtain an unfair advantage “in that their products will be considered to be sub-brands emanating from the SIXTY family, or else it will be considered that MISS SIXTY endorsed such products” (from the skeleton argument). I have already rejected the sub-brand/family argument in relation to Section 5(2)(b). In any case the opponents only ever pleaded a single mark (No 2530590) for Section 5(3) purposes so there is no basis for a family claim in the statement of grounds nor, I would hold, on the evidence.

61. As to endorsement, it would on the face of it be an extraordinary state of affairs if one clothing supplier was to endorse another’s products (as distinct from, say, a designer licensing or otherwise allowing his or her name to be used on a third party’s clothing range). I have not been shown any evidence that such a practice is known or at all common in this area of trade let alone that there is anything in the history of the trade in the MISS SIXTY mark that would lead consumers to have an expectation that the mark would be used in this way. If by endorsement it was intended to suggest that use of the applied for mark would be taken to be licensed use then that might be a little more plausible particularly in relation to a diffusion range of fashion goods. But the evidence does not suggest that the opponents engage in this sort of licensing activity or at least not in relation to the core clothing business. The evidence discloses a minimal amount of use outside of clothing (a few bags, sunglasses and accessories) under the MISS SIXTY brand. Again, there is nothing to suggest a licensing trade under the mark or variants thereof.

62. Furthermore, I have not been pointed to any authorities dealing with endorsement issues under Section 5(3) though I can see that circumstances might arise where an argument could be based on such a claim. *Aktieselskabet v OHIM* (TDK), Case T-477/04 was a case where an opponent succeeded in opposing an application for clothing based on a history of sponsorship activities, particularly in the sporting field. It was held by the Court of First Instance that, were the applied for mark to be used by the applicant on sports clothing, such use would lead to the perception that that clothing was manufactured by, or under licence from, the intervener (the Japanese company TDK Kabushiki Kaisha, manufacturer of audio and video tapes). Whilst this case confirms that the possibility of sponsorship/licensing arrangements may in certain circumstances form the basis of an objection under Section 5(3), the facts of the case before me are some way from supporting an arguable case from the opponents’ perspective. The opponents would also face the further difficulty that the low level of similarity between the marks would be unlikely to create the necessary link for the purposes of the Section.

Section 5(4)(a)

63. The relevant part of the statute, Section 5(4)(a), reads as follows:

“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.”

64. The requirements for a passing off action can be summarised as being:

(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.

65. I have already accepted that the opponents have goodwill arising under the sign MISS SIXTY from their clothing business.

66. The goods against which objection is raised include ‘clothing, spectacles, footwear and headgear, sunglasses’. All of these items featured in the objection under Section 5(2)(b) where I also took into account the effect of the opponents’ reputation based on the mark that is consistently used on and in relation to the goods. The opponents are in no better position in relation to the above goods under Section 5(4)(a).

67. The case based on the law of passing off does, however, differ in one material respect as the objection extends to ‘fashion articles’. As there is no restriction on the fields of activity under passing off (*Lego Systems A/S v Lego M Lemelstrich Ltd*, [1983] FSR 155) the opponents are entitled to run a more wide-ranging objection under this head and are not restricted to identical or similar goods. (I should add for the record that there has never been a pleaded objection to the applicant’s Class 41 services).

68. There has been no attempt to define what goods the opponents object to under the umbrella term 'fashion articles'. Mr Delaney's skeleton argument suggested that a misrepresentation would arise in relation to 'any of the goods for which registration is sought (and particularly on goods in Classes 9 and/or 25), the Applicant's products will be considered to be sub-brands emanating from the SIXTY family, or else it will be considered that MISS SIXTY endorsed such products." This reasoning and language is an echo of that used in relation to the other grounds. The opponents' statement of grounds refers to and relies on a single sign, MISS SIXTY (and not a family of marks or signs).

69. The only goods that have been expressly identified as 'fashion articles' (beyond the Class 9 and 25 goods dealt with elsewhere) are bags. 'Bags' featured in Mr Delaney's skeleton and submissions under Section 5(2)(b) but, as I indicated at the hearing, these articles were never referred to in the pleaded case under that Section.

70. My view of the passing off case can be shortly stated. The opponents are in no better position under this head because no misrepresentation would arise. That state of affairs would subsist just as much in relation to bags or other fashion articles as it does in relation to Class 9 and Class 25 goods.

COSTS

71. The opposition has failed in relation to each of the grounds on which it was brought. The applicant is entitled to a contribution towards its costs. Mr Stobbs, whilst not suggesting I should make an award outside of the published scale, invited me to take note of the fact that the opponents had moved some way from their pleaded case and that a number of the marks originally relied had been dropped (at least so far as a mark for mark comparison is concerned) at the hearing. Mr Delaney did not consider that the applicant had been materially prejudiced in the conduct of its case.

72. Submissions at the hearing focussed on CTM No 3112331 and Mr Delaney conceded that two other marks that formed part of the opponents' pleaded case under Section 5(2)(b) did not advance their cause. That was a realistic concession that enabled submissions at the hearing to be focussed on what were plainly going to be the key issues. To this extent the opponents should not be penalised for adopting an approach that had a beneficial effect on the conduct of the hearing.

73. The manner in which the opponents' case was developed at the hearing in a number of other respects meant that it was not well aligned with the case set out in the amended statement of grounds. On the other hand I cannot see that the applicant would have conducted its case differently. Mr Stobbs was able to deal with the opponents' case as argued at the hearing by means of his own submissions. Any prejudice to the applicant was slight. Accordingly, I order the opponents to pay the applicant the sum of **£2000**. 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 13th day of November 2008

**M Reynolds
For the Registrar
The Comptroller-General**