

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 2102999
TO REGISTER A TRADE MARK IN THE NAME OF
FASHOFF UK LIMITED IN CLASS 03

AND IN THE MATTER OF OPPOSITION THERETO
UNDER No 46841
BY LANCOME PARFUMS ET BEAUTE & CI

BACKGROUND

1. On 17 June 1996 Moonshadow S.p.A. of Via G. Ceradini, 11/A, 20129 Milano, Italy applied under the Trade Marks act 1994 to register the following trade mark in Class 3:

**...OH!
DE
MOSCHINO**

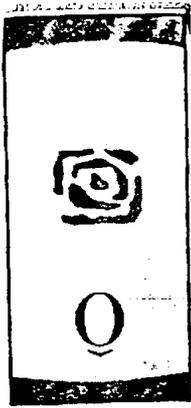
2. The application was published in respect of the following goods:

Class 03: “Soaps; perfumery, cosmetics; dentifrices; talcum powder; bath foams; creams and lotions for the body; cleaning and toilet preparations for the care of the body.”

3. Opposition to the registration was filed by Lancome Parfums et Beaute & Ci on 16 May 1997. The grounds of opposition in summary are:

a) The opponents are the proprietors of the UK registrations shown below and so the application offends against Section 5(2)(b).

| Number | Mark | Effective Date | Specification |
|--------|--------------|----------------|--|
| 914125 | Ô DE LANCÔME | 26.05.1967 | Perfumes, perfumed non-medicated toilet preparations, cosmetics, perfumed toilet waters, eau de Cologne, dentifrices and lotions for the hair. |

| | | | |
|---------|---|------------|---|
| 2101669 |  | 04.06.1996 | Perfume, toilet water; gels and salts for the bath and the shower; toilet soaps; body deodorants; cosmetics; creams, milks, lotions, gels and powders for the face, the body and the hands; sun care preparations; make-up preparations shampoos; gels, sprays, mousses and balms for hair styling and hair care; hair lacquers; hair colouring and hair decolourant preparations; permanent waving and curling preparations; essential oils for personal use; dentifrices. |
|---------|---|------------|---|

Trade Mark 914125 was subject to the following disclaimer: Registration of this mark shall give no right to the exclusive use of the accented letter “O”.

b) Use of the trade mark applied for is liable to be prevented by virtue of any rule of law protecting an unregistered trade mark including an action for passing off based on the opponent’s reputation in the trade marks Ô DE LANCÔME and Ô. The application therefore offends against Section 5(4)(a).

c) The opponent have reputation and goodwill in the trade marks Ô DE LANCÔME and Ô which are confusingly similar to the applicant’s trade mark. The application therefore offends against Section 3(4).

4. The applicant filed a counterstatement denying all the grounds apart from conceding that the opponent is the registered proprietor of trade mark registrations B914125 and 2101669 and that the goods of the applicant’s mark are identical and similar to the opponent’s registered trade marks.

5. Both sides ask for an award of costs. Both sides filed evidence in these proceedings and the matter came to be heard on 19 April 2001, when the applicant was represented by Mr Edenborough of Counsel instructed by D Young & Co while the opponent’s were represented by Ms McFarland of Counsel instructed by Castles.

OPPONENT’S EVIDENCE

6. The opponent’s evidence is in the form of two Statutory Declarations from Jose Monteiro and Alan John Wicken.

7. In his Statutory declaration dated 27 February 1998 Mr Monteiro states that he is the Trade Marks Manager of L’Oreal, of which the opponent is a subsidiary. He has held this position since 1993 and is fully authorised to make this declaration on their behalf. He is fully conversant with the English language.

8. He states that the opponents have used the mark Ô DE LANCÔME in the United Kingdom continuously since 1969. At Exhibit JM1 are examples of packaging which show use of the Ô

DE LANCOME mark. These have a copyright date of 1995 on them. Mr Monteiro states these exhibits show that emphasis is placed on the Ô element of the mark. On each of the three boxes the Ô is printed in larger typeface and is above the words DE LANCÔME. The figures below relate to sales of toiletries bearing the trade mark Ô DE LANCÔME and also to advertising of the mark.

| DATE | SALES | ADVERTISING |
|------|------------|-------------|
| 1993 | £755,000 | £170,000 |
| 1994 | £764,000 | £110,000 |
| 1995 | £862,000 | £176,000 |
| 1996 | £1,035,000 | £217,000 |
| 1997 | £898,000 | £134,000 |

9. At Exhibit JM2 Mr Monteiro provides a selection of invoices relating to the sale of toiletries under the trade mark Ô DE LANCÔME in the United Kingdom during the period 1986 - 1997. Mr Monteiro states that products bearing the trade mark Ô DE LANCÔME have been sold in major retail stores throughout the United Kingdom and, at Exhibit JM3, produces a list of the opponent's customers throughout the United Kingdom, these include Boots, Supergrug, Alders and many others.

10. At Exhibit JM4 Mr Monteiro provides promotional items issued by the opponents. These show the use of the mark Ô DE LANCÔME with the Ô being in larger typeface than the words DE LANCÔME.

11. At Exhibit JM5 Mr Monteiro provides copies of advertisements for the trade mark Ô DE LANCÔME in various magazines. These are dated after the relevant date and show the mark on a single line although the Ô is in larger typeface than the words DE LANCÔME.

12. Mr Monteiro states that in their promotional material and advertising the opponents place considerable emphasis on Ô. He goes on to explain why he considers the opponent's trade marks Ô and Ô DE LANCÔME to be similar to the applicant's trade mark.

13. The second Statutory Declaration dated 20 April 1998 is by Mr Wicken who states that he is an Independent Market Research Consultant. Mr Wicken states that on 6 February 1998 he was asked by Castles, the applicant's trade mark agents, to undertake a market research survey to determine consumer reaction to Ô and Ô DE. He states that he commissioned RSGB, a leading provider of market research services, to undertake the fieldwork. Mr Wicken determined that "the survey should be aimed at women aged 28 - 40 of social grades AB, C1 and C2, in other words, younger middle class women, whom I understand to comprise the relevant public". Exhibit AJW1 provides details of the questionnaire and additional stimulus material used and Exhibit AJW2 provides a report of the results of the survey. Mr Wicken states that 16% of the respondents associated Ô with Lancome, and 10% of respondents associated Ô DE with Lancome.

APPLICANT'S EVIDENCE

14. The applicant's evidence consists of six Statutory Declarations, Three of which are by Louise Westbury who is a registered trade mark agent employed by D Young & Co, the applicant's trade mark agents.

15. In her first declaration Ms Westbury states that she instructed CompuMark, a trade mark research company, to conduct a search for trade marks, effective in the United Kingdom, which contain, as a discreet element, the letters L'EAU, D'EAU, EAU, OH or O. This shows that there are a large number of marks on the United Kingdom register containing those elements. However, this is of little or no relevance to the case because "state of the Register" evidence is, in principle, irrelevant: TREAT 1996 RPC 281.

16. In her second declaration Ms Westbury provides at Exhibit LW3 copies of three letters from retailers within the United Kingdom who sell products marked Ô DE LANCÔME and Oh! De Moschino and state that they are unaware of any confusion between the marks at issue.

17. In her third Declaration Ms Westbury provides at Exhibit LW4 copies of two further letters from retailers within the United Kingdom who state that they are unaware of any confusion between the marks at issue. At Exhibit LW5 Louise Westbury provides copies of documents relating to opposition filed at the Spanish Trade Mark Office to an application for registration of the trade mark ..OH! DE MOSCHINO based on the trade marks Ô DE LANCÔME and Ô. Where the Spanish office found in the applicant's favour determining that there was no possibility of confusion between the marks of the parties.

18. The fourth declaration is by Patricia Pendlebury, a private commercial investigator employed by Farncombe International Ltd. She states that on the instructions of D Young & Co she conducted an investigation into the use made in the United Kingdom of the trade marks **EAU**, **O** and **OH** in relation to Class 3 goods, in particular perfumery, cosmetic and toiletry products. This shows that a number of class 3 products with these elements are advertised and were available in shops at the time of the investigation in 1998.

19. The fifth declaration is by Paolo di Filippo, a Director of Moschino (UK) Ltd. He states that he has held this position since 1993 and that he has full access to the relevant records. Mr di Filippo states that he is responsible, inter alia, for marketing and legal affairs. He states that is not aware of any instances of confusion between goods sold under the mark in suit and goods sold under the two marks of the opponent.

20. The sixth declaration is by Marco Gobbetti the managing director of Moon Shadow SpA a position that he has held since 1994. He states that he has full access to the relevant records. Mr Gobbetti states that the mark in suit has been used in the United Kingdom in relation to Class 3 goods since June 1996.

21. Mr Gobbetti provides the following sales figures for perfumery and toiletry products sold under the mark in suit:

| YEAR | SALES |
|-------------------------|----------|
| 1996 (June - December) | £221,089 |
| 1997 | £262,421 |
| 1998 (January - August) | £149,676 |

22. At Exhibit MG1 Mr Gobbetti provides details of magazines and newspapers in which the mark in suited. A copy of a promotion leaflet showing goods under the mark in suit is provided at Exhibit MG2.

23. Mr Gobbetti states that Moschino (UK) Limited is the registered proprietor of a range of marks incorporating the word “MOSCHINO” in the United Kingdom for a wide variety of goods.

24. Finally Mr Gobetti refers to trade mark infringement and opposition proceedings in France, opposition proceedings in Spain and ex parte proceedings in Italy where the French and Italian courts and the Spanish trade mark office each held that there is no likelihood of confusion between the trade mark “**...OH! DE MOSCHINO**” and the earlier marks cited by the opponent. Copies of these decisions are at Exhibit MG3.

OPPONENT’S EVIDENCE IN REPLY

25. This evidence is in the form of Statutory Declarations from Jose Monteiro, Mr David Castle and Emma Hodson. All three declarations comment on the evidence of the applicant, such as the letters from retailers, state of the UK register and overseas legal actions. As the original evidence on these issues was not found to be helpful in the decision, neither will the counter views of the opponent.

APPLICANT’S FURTHER EVIDENCE

26. Mr di Filippino provides a further declaration in which he states that the instant application (No 2102999) has been assigned by Moschino (UK) Ltd to Fashoff UK Ltd and further states that the assignment has been recorded on the Trade Marks Register.

27. Ms Westbury also provides an additional declaration which details how the various letters from retailers, referred to in her earlier declarations came to be sent. However, given the weight attached to these letters I do not find that this declaration assists my decision.

28. That concludes my review of the evidence. I now turn to the decision.

DECISION

29. The first ground of opposition is under Section 3(4) which reads:

3. (4) A trade mark shall not be registered if or to the extent that its use is prohibited in the United Kingdom by any enactment or rule of law or by any provision of Community law.

30. At the hearing Ms McFarland contended that this ground of opposition allowed the Registry to “bring into play discretion” and seek to use Section 3(4) in relation to an anticipated passing off action. I do not accept these views. Section 3(4) is derived from Article 3(2)(a) of the Directive 89/104 which reads:

“3(2) Any Member State may provide that a trade mark shall not be registered or, if registered, shall be liable to be declared invalid where and to the extent that:

(A) the use of that trade mark may be prohibited pursuant to provisions of law other than trade mark law of the Member State concerned or of the Community,...

31. I also note that the Section is annotated with the words “Absolute grounds”, thus precluding a comparison with other trade marks. The opponent did not file any evidence other than on relative grounds, and so the opposition under this section fails.

32. I next consider the grounds of opposition under Section 5(2) which reads:

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

(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 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.”

33. An earlier right is defined in Section 6, the relevant parts of which state

6.- (1) In this Act an ‘earlier trade mark’ means -

(a)...a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.

34. I have to determine whether the marks are so similar that there exists a likelihood of confusion on the part of the relevant public. In deciding this issue I rely on the guidance of the European Court of Justice in *Sabel Bv v Puma AG [1998 RPC 199 at 224]*, *Canon v MGM [1999 ETMR 1]* and *Lloyd Schfabrik Meyer & Co. GmbH v Klijsen Handel BV [1999 ETMR 690 at 698]*. It is clear from these cases that: -

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer, of the goods / services in question, 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;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(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;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it;

(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);

(h) 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.

35. I also take into account the recent case of *Marca Mode CV v Adidas AG and Adidas Benelux BV* [2000] ETMR 723. The European Court of Justice said of Article 4(1)(b) (transposed into UK law in Section 5(2)(b):

“The reputation of a mark, where it is demonstrated, is thus an element which, amongst others, may have a certain importance. To this end, it may be observed that marks with a highly distinctive character, in particular because of their reputation, enjoy broader protection than marks with a less distinctive character.....Nevertheless, the reputation of a mark does not give grounds for presuming the existence of a likelihood of confusion simply because of the existence of a likelihood of association in the strict sense.”

36. The Court felt that the concept of association of marks in the global assessment of the likelihood of confusion was over emphasised. It is not sufficient for the average consumer to merely associate marks in the sense that if prompted a consumer will call to mind another mark. Thus a mere possibility of confusion, even in situations where a mark clearly has a strong reputation, is not a valid ground for opposition to a trade mark.

37. At the hearing it was common ground that goods of both parties were identical or very similar. It is clear from the above cases that in the overall assessment of a likelihood of confusion, the similarity of goods is but one aspect. Due regard should be given to the closeness of the respective marks, the reputation the earlier mark enjoys in respect of the goods or services for which it is registered, and any other relevant factors.

38. The opponent relies upon two marks, (Ô DE LANCÔME and Ô and device) shown earlier in this decision. The first of these is subject to a disclaimer regarding the accented letter “O”.

39. The mark applied for consists of three words, an ellipsis (three dots indicating an omission) and an exclamation mark. These are combined to form "...OH! DE MOSCHINO".

40. When comparing the mark in suit to "Ô DE LANCÔME", visually the respective marks have the first letter in common albeit one is an accented single letter whereas the other is unaccented and forms part of a word. They also share the same second word and are of similar length. The marks differ visually in that the mark in suit has an ellipsis, has a letter "H" forming the word "OH" as its first word, complete with an exclamation point and the last words are totally dissimilar. These differences far outweigh the commonality.

41. Aurally the marks share the first two syllables "O" and "dee" or "duh". The third words are dissimilar in sound and in the number of syllables. It is well established (and no less true under the 1994 Act) that the beginnings of words are of particular importance - see for instance the following passage from London Lubricants (1920) Ltd's application (Tripcastroid) (1925) 42 RPC 264 at page 279 lines 36-40:-

"But the tendency of persons using the English language to slur the termination of words also has the effect necessarily that the beginning of words is accentuated in comparison, and, in my judgement, the first syllable of a word is, as a rule, far the most important for the purpose of distinction."

42. It is possible that the "O" and "OH" parts of the respective marks may be considered to be a play on the aurally similar French word "eau" meaning water. A number of the products included in both parties specifications could be said to be perfumed water, and the word eau is commonly used in the perfumery industry. Ms McFarland also contended that both marks are "evocative of France".

43. When considering the opponents' "Ô and device" mark to the mark in suit, again it is clear that they have the first letter in common, one accented the other not, one being part of a word the other a single letter. In all other respects they are totally dissimilar. In my view the differences far outweigh any similarities. Aurally the opponent's mark is wholly found within the first syllable of the mark in suit. But the mark in suit also has a further four syllables. The opponent's mark is the phonetic equivalent to the word eau or water which is a word in common use in the perfumery industry.

44. I must also consider whether all or any of the opponents marks have a particularly distinctive character either arising from the inherent characteristics of the marks or because of the use made of them. The opponent has claimed that they have reputation in the letter "Ô". However, the evidence of use of the marks filed shows that the letter "Ô" is not used solus. It is normally accompanied by the words DE LANCÔME. The volume of sales relates to the mark "Ô DE LANCÔME" with no figures shown for the mark "Ô and device". The opponent contends that the "Ô" part of the mark "Ô DE LANCÔME" is always larger and so is the dominant feature, or at least is the most memorable part of the mark. They also provided a consumer survey in their evidence. However, the survey showed that despite being restricted to the most favourable group of "Younger middle class women" only 16% associated the mark "Ô" with the opponent. In the case of "Ô DE" this recognition fell to 10%. Any enhanced level of reputation enjoyed by the opponents would, in my opinion, rest in the mark "Ô DE LANCÔME".

45. I must also take into account the disclaimer attached to the mark “Ô DE LANCÔME”. The accented letter “O” has been disclaimed. In PACO RABANNE (2000 RPC 451) the Hearing Officer stated:

“It therefore appears to me that entry of a disclaimer should be regarded as an admission that the disclaimed matter is not in itself distinctive of the trade origin of the proprietor’s goods or services. In those circumstances use of the disclaimed matter by another party, as a trade mark, cannot, without other similarities, be sufficient to give rise to a likelihood of confusion with the registered trade mark.”

46. From this it follows that the ground of opposition based upon the earlier trade mark registration, number 914125, fails. The only points of similarity between the earlier mark and the later trade mark is the letter “Ô”, which is the subject of a disclaimer and the common word “DE”.

47. It is my opinion that the average consumer is likely to exercise some care when selecting such goods, and, even allowing for the notion of imperfect recollection, is not likely to be confused.

48. With all of this in mind I come to the conclusion that while there are superficial similarities, they are more than counterbalanced by the differences, and when all factors are considered, that there was no realistic likelihood of confusion at 17 June 1996. Consequently, the opposition under Section 5(2)(b) fails.

49. Lastly, I consider the other ground of opposition under Section 5(4)(a) which states:

(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*

(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.

(5) *Nothing in this section prevents the registration of a trade mark where the proprietor of the earlier trade mark or other earlier right consents to the registration.*

50. I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the WILD CHILD case (1998 14 RPC 455). In that decision Mr Hobbs stated that:

“The question raised by the Grounds of Opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the Applicant from those of other undertakings (see Section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Art.4(4)(b) of

the Directive and Section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the Applicant in accordance with the law of passing off.

A helpful summary of the elements of an action for passing off can be found in Halsbury's Laws of England 4th Edition Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in Reckitt & Colman Products Ltd - v - Borden Inc [1990] RPC 341 and Even Warnik BV - v - J. Townend & Sons (Hull) Ltd [1979] AC 731 is (with footnotes omitted) as follows:

'The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

51. The date at which the matter must be judged is not entirely clear from Section 5(4)(a) of the Act. This provision is clearly intended to implement Article 4(4)(b) of Directive 89/104/EEC. It is now well settled that it is appropriate to look to the wording of the Directive in order to settle matters of doubt arising from the wording of equivalent provisions of the Act. It is clear from Article 4(4)(b) that the earlier right had to have been "acquired prior to the date of application for registration of the subsequent trade mark, or the date of the priority claimed....". The relevant date is therefore 17 June 1996, the date of the application.

52. It is clear from the opponents' evidence that they do have goodwill in the UK under their mark "Ô DE LANCÔME". Earlier in this decision I found that the marks "...OH! DE MOSCHINO" and "Ô DE LANCÔME" / "Ô and device" were not confusable and so there would not be any misrepresentation. The decision under Section 5(2)(b) above took into account the question of a disclaimer, which is not appropriate to the issue under section 5(4). However, even leaving the disclaimer aside I still come to the same conclusion, that the marks are not similar. I do not believe that members of the public would confuse the trade marks of the two parties, or believe that there was a trade connection between the users of the marks, notwithstanding the customer survey relied upon by the opponent. The opponent has filed no evidence that the trade or customers would expect "...OH! DE MOSCHINO" to be economically linked to "Ô DE LANCÔME" or "Ô and device" and the onus under Section 5(4)(a) is on the opponent.

53. In my opinion use of the applicant's trade mark would not amount to a misrepresentation resulting in the passing off of its products as those of the opponent. On this footing the opposition under Section 5(4)(a) of the Act must fail.

54. The opposition having failed the applicants are entitled to a contribution towards their

costs. I order the opponents to pay the applicants the sum of £1635. 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.

Dated this 20 day of July 2001

George W Salthouse
For the Registrar
The Comptroller General