

IN THE MATTER OF APPLICATION NO. 2270150 IN THE NAME OF OSKA'S  
LIMITED

AND IN THE MATTER OF OPPOSITION NO. 80502 THERETO BY MORGAN  
SA

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DECISION

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Introduction

1. On 15 May 2001 Oska's Ltd applied to register the trade mark LORNA MORGAN in respect of various specifications of goods in Classes 9, 17, 25, 35, 41 and 42. The goods in Class 25 in respect of which registration was sought were "clothing, footwear, headgear". It is common ground in these proceedings that an individual called Lorna Morgan is a director of the applicant, and that by 15 May 2001 Lorna Morgan had an established reputation as a "glamour model" (that is to say, a model specialising in pornography whether of the "soft" or the "hard" variety). It appears from the evidence that the applicant seeks to exploit this reputation by marketing goods and services under the trade mark the subject of the application.
2. The application so far as it related to goods in Class 25 was subsequently opposed by Morgan SA under sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994. Neither party asked for a hearing, and only the applicant filed written submissions, although some of the evidence filed by the opponent consisted of argument and opinion rather statements of fact. In a written decision dated 7 January 2004 (BL O/005/04) Mr Reynolds acting for the Registrar rejected both of grounds of objection and dismissed the opposition. The opponent now appeals against that decision.

3. In support of the objection under section 5(2)(b) the opponent relies upon three earlier registrations, namely No. 1471211 MORGAN registered in respect of “clothing for women and children” as of 19 July 1991, No. 2042937 a device comprising both MORGAN and MORGAN DE TOI registered in respect of a long list of goods in Class 25 as of 27 October 1995 and No. 2129605 MORGAN registered in respect “footwear, headgear and men’s clothing” as of 15 April 1997. In my view ‘937 can be disregarded, since if the applicant does not succeed on the basis of ‘211 and ‘605, it cannot possibly succeed on the basis of ‘937. Thus the opposition can be treated as being based upon two registrations, both consisting of the word MORGAN, which between them are registered for clothing, footwear and headgear. For brevity I shall refer to these two registrations together as “the opponent’s mark”. Furthermore, I shall refer to “clothing” as including footwear and headgear except where it is necessary to distinguish between them.
4. In support of the both objections, the opponent contends that the opponent’s mark had by 15 May 2001 acquired a substantial reputation as a result of the use made of it by the opponent since 1981.
5. The hearing officer’s assessment was that, in the circumstances of the present case, the section 5(4)(a) objection did not advance the opponent’s cause appreciably further than the section 5(2)(b) objection. Before me counsel for the opponent submitted somewhat faintly that section 5(4)(a) added to the section 5(2)(b) objection in one respect. I agree with the hearing officer’s assessment, and therefore I do not proposed to consider the section 5(4)(a) objection further.

Section 5(2)(b)

6. Section 5(2)(b) provides:

A trade mark shall not be registered if because ... 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.

The hearing officer's decision with respect to section 5(2)(b)

7. The hearing officer began by stating that he took into account the guidance given by the European Court of Justice in Case C-251/95 *Sabel BV v Puma AG* [1997] ECR I-6191, Case C-39/97 *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc* [1998] ECR I-5507, Case C-342/97 *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [1999] ECR I-3819 and Case C-425/98 *Marca Moda CV v Adidas AG* [2000] ECR I-4881.
8. Next the hearing officer compared the respective goods, and concluded that the Class 25 goods specified in the application were identical to those specified in the opponent's mark.
9. The hearing officer then turned to consider the distinctive character of the opponent's mark and stated as follows:
  24. The applicants have commented that MORGAN is a common surname and cannot be regarded as distinctive on its own. The opponents say that, whilst this may be true (particularly in Wales), it is not in common use as a trade mark in relation to clothing. The question of whether a common surname should be regarded as being devoid of any distinctive character unless it has acquired such a character through use is currently the subject of a reference to the European Court of Justice in *Nichols plc's trade Mark* application [2002] EWHC 1424 (Ch).<sup>1</sup> The matter arose there in the context of registrability on absolute grounds. As the opponents' marks here have achieved registration I must assume that they are distinctive to a small degree at least. In fact I have not been given concrete information as to just how common MORGAN is as a surname. I think I can unhesitatingly say that it is extremely common in Wales. Doubtless it is somewhat less prevalent in England and the rest of the UK but still, I would suggest, relatively common. On a scale of distinctiveness which would have invented words and complex graphical marks towards the top and descriptive words or commonplace images towards the bottom, I regard the

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<sup>1</sup> The citation is of the judgment of Jacob J making the reference, now reported at [2003] RPC 16.

surname MORGAN as having a rather low claim to distinctive character.

25. However, the opponents say that this is a case where use has improved their position. The raw data I have recorded above suggest that they may indeed be entitled to claim an enhanced degree of distinctive character through use. The opponents' turnover and advertising figures suggest a business of some size. The clothing market is a somewhat fragmented one with many players large and small. But a turnover which has exceeded £50 million per annum for each of the last four years speaks of a business with a significant and sustained position in the marketplace. Moreover it enjoys a well established track record dating back to 1981 (see Exhibit JL1). I note too that the company operates largely through its own boutiques. These frequently appear to be located in high profile stores such as Debenhams, House of Fraser and Rackhams and major shopping centres such as Bluewater (Kent), Lakeside (Essex), Cribbs Causeway (Bristol) and Merry Hill (West Midlands). A presence in such locations is likely to increase the brand's profile and lead to awareness even amongst those members of the public who are not current customers.

26. I find the rest of the material exhibited in support of the claim to a reputation somewhat less persuasive. Exhibit LC2 consists of a collection of fashion pieces from magazines and newspapers. They are not in the main advertisements dedicated to the opponents' brand and goods but rather fashion collection items featuring goods from a variety of traders which happen to include items from the opponents' collection. Exhibit LC3, the website pages, adds little to the overall picture and I note that some of the material (as with LC2) is after the relevant date. My impression is that the brand is primarily targeted at a young female audience though I accept that it is not exclusively the case. In *DUONEBS Trade Mark* BL 0/048/01 Mr S Thorley QC, sitting as the Appointed Person, in dealing with the question of the reputation attaching to a mark said:

'In my judgement, 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.'

27. Applying these principles it seems to me that the opponents' claim that the MORGAN brand's reputation and distinctiveness has been enhanced through use is not without legitimacy. I have some reservations as to whether the limited amount of supporting material supplied is enough to flesh out and give substance to the underlying

claim but I propose to proceed on the basis that use has improved the opponents' position.

10. With respect to the mark applied for the hearing officer stated as follows:

30. The distinctive character of the applied for mark must in my view rest in the combination of forename and surname. Many people are likely to share the same surname or forename. It is the elements in combination that serve to distinguish. Having said that, unusual forenames or surnames, being inherently more distinctive, are likely to attract a disproportionate amount of attention and may be, or become, the dominant and most memorable element within a full name. This is not the case here. Neither LORNA nor MORGAN are uncommon names. I have no reason to suppose that consumers would rely on either element at the expense of the whole to identify and remember the mark.

11. As to the likelihood of confusion, the hearing officer stated:

31. The matter, therefore, turns critically on whether [the opponent's witness] Ms Carter is correct in the conclusions she asks me to draw about the presence of the surname MORGAN in both marks. Ms Carter's submissions proceed on the basis of suppositions as to consumer reaction that in my view are not necessarily well founded. The evidence is that the opponents have traded for many years under the mark MORGAN (or MORGAN DE TOI and device) without the presence or addition of a female forename. I fail to see why any assumption should be made that LORNA MORGAN is or was the founder of the company. It is true that a number of the leading fashion houses have become recognised by the names of the founders whether presented as full names or forename of surname alone – Coco (Chanel), Giorgio (Armani), Gianni (Versace), etc. But that is in circumstances where the public has been exposed to such usage. That is not the case here. There is no evidence that the public has come to expect the mark MORGAN to be used with one or more forenames. Nor, even on the basis of distinctiveness enhanced through use, can the surname MORGAN be said to fall into the same category as Chanel, Armani or Versace in terms of the distinctive character of the mark.

32. It seems to me that the opponents' case ultimately rests on a series of possible inferences that are drawn in Ms Carter's statement:

'...the average consumer... would not be afforded any compelling reason to discount association with the opponent's mark MORGAN.'

'...the consumer might reasonably suppose that the opponent was extending its brand...'

‘...the consumer might very well assume the existence of an economic link...’

33. The possibility of an association being made should not be discounted completely. If it is right to conclude that the MORGAN brand enjoys a reputation in the market place, some consumers may, on encountering the mark LORNA MORGAN, be put in mind of what for them might be the best known or only MORGAN mark with which they are familiar. But that does not in and of itself mean that they will be confused as to the origin of the goods...
34. I understand [*Sabel* and *Marca Moda*] to mean that merely being reminded of another mark (even one with a reputation) does not in itself constitute a likelihood of confusion. But if the association is such that the consumer considers goods sold under the respective marks share a common or economically linked trade source that is confusion within the meaning of the Section. The difference between these positions was demonstrated in *Laura Trade Mark* O/430/99. In that case the Appointed Person allowed an appeal against the Registrar’s refusal to register LAURA in the face of ‘Laura Ashley’. On the facts of the case the Appointed Person held that:

‘It appears to me that Mr Krause who appeared for the appellants before me was well founded in submitting that the name ‘Laura’ was no more objectionable because of the provisions of Section 5(2) of the 1994 in relation to “Laura Ashley” than the word “John” would in relation to the words “John Lewis” if both were to be used in relation to household paints, or “Thomas” in relation to “Thomas Cook” if the former were to be used in relation to travel services.’

35. In reaching that view he expressed himself as follows:

‘... mere association which the public might make between the two marks is not sufficient – there must be a likelihood of confusion and the two are not the same thing.’

and

‘It is of importance that in both the relevant provisions in the European Directive and in Section 5(2) of the 1994 Act what has to be identified is the *likelihood* of confusion, not simply the *possibility* of confusion. At the very highest, in the present case, in my view, it might be said that there was a *possibility* of confusion in the mind of certain members of the public, but I consider that it was unreal to think in terms of there being a likelihood of confusion.’

36. There is no doubt room for reasonable people to differ in applying the guidance from these cases to the circumstances for a particular use. I

have not found the answer here to be straightforward particularly as the surname element is identical as are the goods of interest and, on balance, I am inclined to accept the opponents' claim that the character of their mark has been enhanced through use. However, it seems to me that full names are of particular importance as identifiers. There is nothing about the opponents' use that suggests anything other than a casual association (if that) would be made between the applicants' mark and their own. Making the best I can of the material before me I am not persuaded that I should elevate any such association into a likelihood of confusion. The opposition fails under Section 5(2)(b).

#### Standard of review

12. This appeal is a review of the hearing officer's decision. The hearing officer's decision with regard to section 5(2)(b) involved a multi-factorial assessment of the kind to which the approach set out by Robert Walker LJ in *REEF TM* [2002] EWCA Civ 763, [2003] RPC 5 at [28] applies:

In such circumstances an appellate court should in my view show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle.

#### Grounds of appeal

13. The opponent contends that the hearing officer erred in principle in four main respects. First, he adopted a legally incorrect approach to the assessment of the inherent distinctiveness of the opponent's mark. Secondly, he adopted a legally incorrect approach to the assessment of the acquired distinctiveness of the opponent's mark, wrongly treated some of the opponent's evidence as being of little or no weight and did not come to any clear conclusion. Thirdly, he erred in his assessment of the mark applied for. Fourthly, he made a number of errors in his assessment of the likelihood of confusion. I shall consider these contentions in turn.

#### Inherent distinctiveness of the opponent's mark

14. The opponent argues that the hearing officer's approach is flawed because, although he referred in the second sentence of paragraph 24 of the decision to

the opponent's contention that the surname MORGAN was not in common use as a trade mark in relation to clothing and did not expressly reject it, it appears from his reasoning in the remainder of paragraph 24 that he regarded this as irrelevant. The opponent submits that, unless it is shown that a surname is commonly used to denote the origin of the goods or services in question, then that surname is inherently distinctive for such goods or services.

15. Before considering this submission, I should observe that it may be questioned whether the inherent distinctiveness of an earlier trade mark is material in a case where, as here, (a) the opponent contends that the mark has acquired a substantial reputation through use and (b) the hearing officer has accepted that the distinctiveness of the mark has been enhanced through use. I consider, however, that the jurisprudence of the Court of Justice requires the tribunal to assess the inherent distinctiveness of the mark as well as any reputation it may be acquired through use: see in particular *Lloyd v Klijsen* at paragraphs 23- 24. Furthermore, the opponent argues that the hearing officer's view that its mark was of low inherent distinctiveness coloured his assessment of the likelihood of confusion. It appears to me that this is a possibility which I cannot discount.
16. In support of its submission, the opponent relies upon the recent Judgment of the Court of Justice in Case C-404/02 *Nichols plc v Registrar of Trade Marks* (16 September 2004). Obviously, this is not a decision which the hearing officer had the benefit of. Before considering the Judgment itself, I think it will be of assistance to set out the background to the case. This has its roots in English case law dating from before the Trade Marks Act 1938 which established that applications to register surnames as trade marks should not readily be accepted and that an important factor in the assessment of such an application was whether the surname in question was a common one or an unusual one: see in particular *Teofani & Co Ltd v Teofani* [1913] 2 Ch 545 and *H.G. Burford & Co Ltd's Application* (1919) 36 RPC 139.
17. Under the influence of this case law, sections 9 and 10 of the 1938 Act were interpreted as prohibiting registration of surnames otherwise than upon proof of distinctiveness unless the surname in question was either so rare that its

signification as a surname could be disregarded altogether (and hence registrable in Part A of the Register) or sufficiently rare that the surname could be regarded as inherently capable of distinguishing (and hence registrable in Part B): see *Kerly's Law of Trade Marks and Trade Names* (12th ed) paragraphs 8-53 and 8-54. Following the decision of Whitford J in *CIBA Trade Mark* [1983] RPC 73, the Trade Marks Registry adopted practice guidelines for the application of this principle which depended on the number of times a name appeared in telephone directories. These guidelines were periodically revised. For example the Registry Work Manual current in 1993 stated:

- (a) Marks may be accepted in Part A if they appear as surnames not more than 15 times in the London Telephone Directory and not more than 30 times in any relevant foreign telephone directory;
- (b) Marks may be accepted in Part B if they appear as surnames not more than 30 times in the London Telephone Directory and not more than 50 times in any relevant foreign telephone directory.

18. In *AL BASSAM Trade Mark* [1994] RPC 315 at 384 lines 32-33, however, Aldous J stated that, while such guidelines might be a useful guide to be applied at the examination stage, they could not be used in oppositions to test compliance with section 10 (see also the judgment of Morritt LJ in the Court of Appeal in the same case at [1995] RPC 511 at 526 and the recent judgment of Aldous LJ in the Court of Appeal in *DU PONT Trade Mark* [2004] FSR 15 at [28]-[33]).

19. In *MISTER LONG Trade Mark* [1998] RPC 401 Geoffrey Hobbs QC sitting as the Appointed Person considered the registrability of surnames under the Trade Marks Act 1994 and Council Directive 89/104/EC which it implements. After referring to certain provisions of the Act and the Directive, he concluded as follows (page 405 lines 36-47):

These provisions indicate to my mind that surnames are neither automatically eligible nor automatically ineligible for registration under the Act. In each case the question to be determined is whether the surname put forward for registration possesses the qualities

identified in section 1(1) of the Act and none of the defects identified in section 3. For the reasons I gave at greater length in *AD2000 Trade Mark* [1997] RPC 167 I think that in order to be registrable a surname or any other sign must possess the capacity to communicate the fact that the goods or services with reference to which it is to be used recurrently by the applicant are those of one and same undertaking. When assessing whether a surname possessed that capacity at the relevant date (the date of application), it is, of course, necessary to bear in mind that surnames, as such, are naturally adapted to identify all individuals so named.

20. In May 2000 the Registrar published Practice Amendment Circular 6/00 setting out the practice which she would thereafter adopt concerning the registration of surnames, forenames and full names under the Trade Marks Act 1994. This stated *inter alia*:

5. In judging the capacity of a surname to distinguish the goods or services of one undertaking the Registrar will consider:
  - (a) the commonness of the surname;
  - (b) the number of undertakings engaged in the trade and from whom the goods or services specified in the application can be said to originate.
6. For this purpose the number of relevant undertakings includes manufacturers, designers and *specialist* retailers of goods, and providers of services.
7. The Registrar will continue to have regard to the London Telephone Directory in assessing the commonness of a surname. However, with the continuing increase in the number of telephone users it is now possible for a name which appears a significant number of times in the London Telephone Directory to be quite uncommon. Consequently, the Registrar will not regard a surname as 'common' unless it appears 200 times in the London or other appropriate telephone directory.
8. Where the goods or services originate from a limited number of traders, e.g. agricultural chemicals or airline services, the average consumer may regard even more common surnames as distinguishing the goods or services of a particular undertaking. The fewer sources of origin there are, the more likely it is that a surname will, if used recurrently, distinguish the goods or services of a particular undertaking.
9. The converse is also true. The more sources of origin there are, the less likely it is that the public will regard a common surname as identifying

the goods or services of a single undertaking. So, so example, given the number of sources of clothing and most food and drinks, the public are very unlikely to regard a common surname as identifying the goods/services of one undertaking – a least until such time as they have been educated to that perception. In the professions, such as the legal profession, the use of surnames is very common, which suggests common surnames will not distinguish except where there are a relatively limited number of sources for the services (e.g. marine surveying). The inability to surnames to distinguish is self evident in some trades. For example, coach companies are often run under names such as ‘Davies of Monmouth’. One of the reasons for this practice is no doubt that whilst ‘Davies of Monmouth’ is capable of distinguishing the services of one undertaking, ‘Davies’ per se is not capable of distinguishing outside its immediate locality.

10. If, having regard to the above guidelines, the Registrar considers that the surname has the capacity to identify the goods/services of a single undertaking, the application may be accepted. If this judgment extends only to certain goods/services listed within the application, acceptance will be offered for those goods/services only.
  
21. In *ABERCROMBIE Trade Mark* (BL O/151/01) at paragraphs [22]-[25] Geoffrey Hobbs QC sitting as the Appointed Person re-iterated the view he had expressed in *MISTER LONG Trade Mark* quoted above, quoted from PAC 6/00 and stated that he agreed with the general tenor of the guidance; although he emphasised that the practice of counting entries in telephone directories was not to be taken to preclude the filing of evidence as to whether a particular surname did or did not satisfy the criteria for registration in relation to the goods or services in question.
  
22. In *Nichols plc v Registrar of Trade Marks*, the applicant applied to register the word NICHOLS for various goods in Classes 29, 30 and 32. The application was refused by the Registrar. As I understand it, the Registrar applied the guidance set out in PAC 6/00 and treated NICHOLS as a common surname because there were over 500 listings of it (or variants such as NICHOL and NICHOLLS) in the London telephone directory. The applicant appealed to the High Court, contending that the Registrar’s practice as set out in PAC 6/00 was contrary to the Directive. When the appeal came before Jacob J, he referred certain questions concerning the interpretation of the Directive to the Court of Justice.

23. In his Opinion (reported at [2004] ETMR 48) Advocate General Ruiz-Carabo Colomer stated (omitting footnotes):

35. In this case, it seems clear that the method employed by the United Kingdom Registry differs from the approach preferred by the Court of Justice to date in assessing the distinctive character of a mark. However, no sufficient reasons have been put forward in favour of choosing another interpretative method.
36. I agree with the majority of the parties that the question whether a surname, however common, may indicate the commercial origin of products and services must be analysed in relation to the specific market concerned. The fact that, in a given commercial sector, ordinary surnames are customarily used for identification of that kind, with certain possible consequences regarding the assessment of distinctiveness, cannot be transposed, without more, to any other sector. Reference could be made, in the last resort, to specific particular features, linked to the peculiarities of the products or services designated, rather than to a special characteristic inherent in a category of marks.
37. For the rest, there is nothing in the Directive to justify treating surnames differently, since Article 6(1)(a), the only provision specifically devoted to them, is concerned with limiting the protective effects of trade marks, and that is quite separate from the question of examining absolute grounds for refusal, as I shall have occasion to explain shortly.
38. In those circumstances, any judgment as to the distinctiveness of a surname must observe the same guidelines as those applicable to other types of word marks.
39. According to the Court of Justice, for a trade mark to fulfil its principal task, it is sufficient if it enables the public to distinguish the product or the service which it designates from others, which have another commercial origin, and to conclude that it was manufactured, marketed or rendered under the control of the proprietor of the trade mark, who accepts responsibility for its quality. In that respect, Article 2 of the Directive makes no distinction between different categories of marks, for which reason similar criteria must be used to assess their distinctiveness in all cases.
40. The distinctive character must be analysed from the viewpoint of the average consumer of such type of products or services, the consumer being deemed to be reasonably well informed and reasonably observant and circumspect.
41. In that context, it is necessary to take into account, for example, the particularity that, in certain sectors, common names or surnames are

assiduously used to designate a commercial origin, sometimes by way of trade mark. If that is the case, there is nothing to prevent the registration authorities from finding that the mark has no capacity to distinguish. Such a finding must be specific and must not be made in an all-embracing or abstract manner.

42. However, it is not possible, under Article 3(1)(b) of the Directive, to take account of a general interest, in order to make sure that certain very frequently occurring surnames are available to all present and potential operators.
  43. As I have already stated, the purpose of the absolute ground for refusal in that provision is to prohibit the registration of signs which are devoid of any real distinctive character, that is to say, those signs which the average consumer, who is reasonably well informed and reasonably observant and circumspect, does not identify as reliably indicating the commercial origin of the product. It is, of course, in the general interest to prevent certain operators from appropriating to themselves three-dimensional shapes which are useful from an aesthetic or technical point of view, or from monopolising certain signs apt to describe the product *per se*, its actual or supposed qualities and other characteristics, such as where it originates from. Subparagraphs (c) and (e) of Article 3(1) of the Directive deal with those concerns. It is also appropriate to consider the similar general interest in keeping available, for use by all, signs which are customary in the current language, or in the *bona fide* and established practice of the trade, which – under subparagraph (d) – may not be registered.
  44. However, it does not seem that extensive protection should be afforded to signs which, without being descriptive, are for other reasons devoid of any specific distinctive character. I do not believe that there is any general interest in maintaining in the public domain signs which are incapable of identifying the commercial origin of the goods or service which they designate.
  45. Nor does the Directive contain any provision to ensure that no relative advantage is granted to the first operator who applies for registration of a given surname.
  46. Consequently, the potential distinctiveness of a surname depends on whether, in relation to the goods or services in respect of which registration is sought, the relevant consumer considers that the sign identifies those of one undertaking rather than those of another. The commonness of the surname is one of the facts which it is appropriate to take into consideration, once more in relation to certain goods or services, although it is not decisive.
24. In its Judgment the Court of Justice stated:

22. Article 2 of Directive 89/104 contains a list, described as a ‘list of examples’ in the seventh recital in the preamble to that directive, of signs which may constitute a trade mark, proved that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings, that is to say to fulfil the trade mark’s function as an indicator of origin. That list expressly includes ‘personal names’.
23. According to Article 3(1)(b) of Directive 89/104, the distinctive character of a mark must be assessed in relation to the goods or services in respect of which registration is applied for and in relation to the perception of the relevant consumers (see Case C-299/99 *Philips* [2002] ECR I-5475, paragraphs 59 and 63, and Case C-218/01 *Henkel* [2004] ECR I-0000, paragraph 50)
24. In that regard, the provision concerned draws no distinction between different categories of trade mark (see, to that effect, Joined Cases C-53/01 to C-55/01 *Linde and Others* [2003] ECR I-3161, paragraph 42, and, regarding the identical provision in Article 7(1)(b) of Council Regulation (EC) No 40/94 on the Community trade mark (OJ 1994 L 11, p.1), the order of 28 June 2004 in Case C-445/02P *Glaverbel v OHIM* [2004] ECR I-0000, paragraph 21).
25. The criteria for assessment of the distinctive character of trade marks constituted by a personal name are therefore the same as those applicable to the other categories of trade mark.
26. Stricter general criteria of assessment based, for example, on:
  - a predetermined number of persons with the same name, above which that name may be regarded as devoid of distinctive character,
  - the number of undertakings providing products or services of the type covered by the application for registration, or
  - the prevalence or otherwise of the use of surnames in the relevant trade,cannot be applied to such trade marks.
27. The distinctive character of a trade mark, in whatever category, must be the subject of a specific assessment.
28. In the context of that assessment, it may indeed appear, for example, that the perception of the relevant public is not necessarily the same for each of the categories and that, accordingly, it could prove more difficult to establish the distinctive character of trade marks in certain categories than that of those in other categories (see, in particular, *Henkel*, paragraph 52, and, in relation to Article 7(1)(b) of Regulation

No 40/94, Case C-468/01P *Procter & Gamble v OHIM* [2004] ECR I-0000, paragraph 36, and the order in *Glaverbel v OHIM*, paragraph 23).

29. However, such greater difficulty as might be encountered in the specific assessment of the distinctive character of certain trade marks cannot justify the assumption that such marks are *a priori* devoid of distinctive character or cannot acquire such character through use, pursuant to Article 3(3) of Directive 89/104.
30. In the same way as a term used in everyday language, a common surname may serve the trade mark function of indicating origin and therefore distinguish the products or services concerned where it is not subject to a ground of refusal of registration other than the one referred to in Article 3(1)(b) of Directive 89/104, such as, for example, the generic or descriptive character of the mark or the existence of an earlier right.
31. The registration of a trade mark constituted by a surname cannot be refused in order to ensure that no advantage is afforded to the first applicant since Directive 89/104 contains no provision to that effect, regardless, moreover, of the category to which the trade mark whose registration is sought belongs.
32. In any event, the fact that Article 6(1)(a) of Directive 89/104 enables third parties to use their name in the course of trade has no impact on the assessment of the distinctiveness of the trade mark, which is carried out under Article 3(1)(b) of the same directive.
33. Article 6(1)(a) of Directive 89/104 limits in a general way, for the benefit of operators who have a name identical or similar to the registered mark, the right granted by the mark after its registration, that is to say after the existence of the mark's distinctive character has been established. It cannot therefore be taken into account for the purposes of the specific assessment of the distinctive character of the trade mark before the trade mark is registered.
34. The answer to the first four questions must therefore be that, in the context of Article 3(1)(b) of Directive 89/104, the assessment of the existence or otherwise of the distinctive character of a trade mark constituted by a surname, even a common one, must be carried out specifically, in accordance with the criteria applicable to any sign covered by Article 2 of the said directive, in relation, first, to the products or services in respect of which registration is applied for and, second, to the perception of the relevant consumers. The fact that the effects of registration of the trade mark are limited by virtue of Article 6(1)(a) of that directive has no impact on that assessment.

25. In my judgment the following principles emerge from the Court's exposition of the law:

(1) There are no special, stricter rules for assessing the distinctive character of signs which consist of surnames. In particular, it cannot be assumed that surnames are *a priori* devoid of distinctive character. Nor is it legitimate to assess surnames according to general criteria such as those mentioned in paragraph 26. Nor is it legitimate to refuse registration of surnames in order to ensure that no advantage is afforded to the first applicant. Nor is it relevant that Article 6(1)(a) of the Directive entitles third parties to use their own names in certain circumstances. [Judgment paragraphs 25-26, 29-33.]

(2) A surname must be specifically assessed for distinctive character in accordance with the criteria applicable to any sign covered by Article 2 of the Directive in relation to the goods or services for which registration is sought and the perception of the average consumer of such goods or services. [Judgment paragraphs 27, 34.]

(3) The perception of the average consumer is not necessarily the same for all categories of signs. Thus it may be more difficult to establish that certain categories of sign are distinctive than other categories of signs. [Judgment paragraph 28.]

26. It is clear from principle (3) that the Court is not saying that the tribunal must ignore the fact that a sign propounded for registration is a surname. It is settled jurisprudence of the Court that, in assessing whether a sign is devoid of distinctive character under Article 3(1)(b) or under Article 7(1)(b) of the Community Trade Mark Regulation, the tribunal must have regard to all the relevant facts and circumstances: see e.g. Case C-363/99 *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* [2004] ETMR 57 at paragraph 35 and Case C-136/02P *Mag Instrument Inc v OHIM* (7 October 2004) at paragraph 48. It is therefore proper to take into account any and all characteristics of the sign in question which bear upon its distinctiveness according to the

perception of the average consumer of the goods or services in question. This applies as much to surnames as it does to signs such as colours, shapes and smells.

27. Furthermore, it appears from principle (3) that the Court acknowledges that the average consumer does not necessarily perceive surnames in the same way as other categories of signs and that this may make it more difficult to establish that they are distinctive. Surnames have three characteristics in particular which differentiate them from other word marks. First, individuals generally acquire them at birth (although they may be adopted subsequently). Thus one's surname is generally a given so far as the individual is concerned, rather than the result of an exercise of choice. Secondly, they form an important part of an individual's identity. There is thus a strong motivation for individuals to use surnames to denote the origin of goods or services supplied by them (or by companies founded by them). Thirdly, it is inherent in the nature of surnames that they are shared with a greater or lesser number of other individuals. Those other individuals may also supply such goods or services or desire to do so.
28. Accordingly, I do not read the Court as disagreeing with the observation of the Advocate General in paragraph 46 of his Opinion that it is proper to take into account the commonness of the surname in question provided that this is done as part of a specific assessment of the distinctiveness of the surname in respect of those goods or services. I consider that in most respects the Court's Judgment is consistent with the Advocate General's Opinion. The only significant difference between the two, it seems to me, is that the Advocate General appeared in paragraph 35 of his Opinion to endorse the Registry's practice as set out in PAC 6/00, particularly with regard to the use of telephone directory evidence (referred to in paragraph 34 of the Opinion, which I have not quoted above), whereas the Court in paragraph 26 of its Judgment has plainly disapproved it. In paragraph 30 of its Judgment the Court says that a common surname "*may* serve the trade mark function of indicating origin" [emphasis added]. It follows that a common surname may not serve this function: it depends on the facts of the individual case. To put it another way,

the Court is clearly not saying that a common surname must be treated as being as distinctive as, say, an invented word. What it is saying is that even common names must be specifically assessed for distinctive character with respect to the goods or services in question.

29. What I find less easy to determine is whether the Court disagreed with the observation of the Advocate General in paragraph 41 of his Opinion that it is proper to take into account the extent to which surnames are used to designate commercial origin in the sector in question provided that this is done as part of a specific assessment of the distinctiveness of the surname in relation to the goods or services for which registration is sought. In paragraph 26 of its Judgment the Court disapproved of the use of “the prevalence or otherwise of the use of surnames in the relevant trade” as a *general* criterion of assessment. It does not necessarily follow, however, that this factor must be disregarded when conducting a *specific* assessment of distinctive character. As a matter of logic, the prevalence or otherwise of the use of surnames is a relevant factor, since if the use of surnames is prevalent a surname is less likely to be distinctive than if the use of surnames is not prevalent. With some hesitation, I conclude that this factor may be taken into account, but only as part of a specific assessment of the circumstances of the individual case.
30. As I understand its argument, the opponent (i) accepts that common use of the surname in question to denote the origin of the goods or services in question is material to the assessment of distinctive character, but (ii) submits that, if a sign is not shown to be commonly used to denote the origin of the goods or services in question, then the fact that it is a common surname is irrelevant to the assessment of distinctive character even if the sector is one in which the use of surnames is prevalent.
31. So far as the first point is concerned, this must be right. If a number of traders use the surname SMITH to denote the origin of clothing supplied by them, then that sign does not distinguish the goods of one undertaking from the goods of other undertakings.

32. As to the second point, in my judgment this is not a correct statement of the law in the light of *Nichols*. For the reasons I have given, I consider that the commonness of the surname is a factor that may be taken into account as part of a specific assessment of the distinctive character of the surname in relation to the goods or services in question, particularly where the field in question is one where the use of surnames to designate origin is prevalent. What is not permissible is the application of a “rule-of-thumb” approach as set out in PAC 6/00.
33. In *Nichols* the Court was considering the assessment of the distinctive character of surnames in the context of registrability, and in particular the absolute ground for refusal under Article 3(1)(b) of the Directive. The Court has previously stated that in that context distinctiveness must be subject to stringent and full examination: Case C-104/01 *Libertel Group BV v Benelux-Merkenbureau* [2003] ECR I-3793 at paragraph 59. I consider, however, that the same approach must be adopted when considering the inherent distinctiveness of an earlier trade mark for the purposes of a relative ground of objection.
34. In the present case it is common ground that MORGAN is a common surname, particularly in Wales; that clothing is a field in which traders commonly trade under their own names (or, in the case of companies, which bear the names of their founders); and that clothing is a field in which many traders are engaged.
35. Nevertheless, the opponent’s witness Louise Carter, the mail order manager of the opponent’s UK distributor Tower Hill Clothing Ltd, stated in paragraph 11 of her witness statement that the surname MORGAN was not in common use as a trade mark for clothing. This statement was not contradicted by the applicant’s witness Lorna Morgan in her witness statement in answer. In these circumstances I must proceed on the basis that Ms Carter’s evidence is correct. On the other hand, Ms Carter’s evidence does not exclude the possibility that *some* traders other than the opponent supplied clothing under and by reference to signs which consisted of or included the surname MORGAN as at 15 May

2001. Given that MORGAN is a common surname, that clothing is a field in which traders commonly trade under their own names and that clothing is a field in which many traders are engaged, I would not be surprised if there were other traders in clothing, such as tailors or knitwear suppliers or clothing retailers, called MORGAN. Whether that it is so or not must be regarded as an open question on the evidence before me.

36. Looking at the position more generally, the fact that clothing is a field in which it is common for traders to use their own names is a point which potentially cuts either way. If the field is one in which it is a common occurrence for more than one trader to supply goods or services under the same surname, and so consumers are accustomed to distinguishing between such traders by reference to their first names and/or geographical locations, then this militates against distinctiveness. This is true, for example, of legal professional services.<sup>2</sup> If, however, the field is one in which it is common for traders to supply goods or services under their respective surnames, but consumers do not require a first name or geographical location to be supplied in order to distinguish between them, then this militates in favour of distinctiveness. (To my mind, this is one reason why the Court of Justice was right to say in *Nichols* that general criteria of assessment are not appropriate.)
37. In the present case the opponent's evidence refers to the well-known designer brands of clothing (COCO) CHANEL, (MIUCCI) PRADA, (GIORGIO) ARMANI and (GIANNI) VERSACE. In each of these cases, the surname is distinctive without the first name, although many consumers would also know the first name. What is noticeable about each of these cases is that, not only have they acquired an extensive reputation through use, but also each of the surnames is one that is rare in the United Kingdom because it is a foreign surname. Neither party's evidence refers to any examples of clothing brands which share the same surname and are distinguished by consumers by means of a first name. In my judgment, however, I can take judicial notice of the fact that there are instances of this. Two of which I am aware are PAUL SMITH

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<sup>2</sup> For example there are two barristers called ARNOLD, both of whom are members of the Chancery Bar Association, but who have different first names.

and TEDDY SMITH and CALVIN KLEIN and ANNE KLEIN. What is noticeable about these examples is that the surnames are ones that are more common in the UK (and the USA, in the case of KLEIN). Obviously, this is particularly true of SMITH. Moreover, I have only cited reasonably well-known brands. If one were to include small clothing traders called SMITH, I have no doubt that there would be many more. I also believe that the two cases I have cited are not the only ones. I therefore conclude that clothing is a field where consumers are aware that it may be necessary to differentiate between clothing traders who share the same surname by means of first names where the surname is a common one in the United Kingdom, but not where it is an uncommon one.

38. The question then is whether the average consumer of clothing, being aware that (a) MORGAN is a common surname, particularly in Wales, (b) MORGAN is not in common use as a trade mark for clothing, (c) clothing is a field in which traders commonly trade under their own names, (d) many traders are engaged in the field of clothing, and (e) it may be necessary to differentiate between clothing suppliers who share a common surname by means of first names, would without education assume that MORGAN denoted clothing emanating from a single undertaking or regard it as potentially denoting clothing from more than one trade origin. I do not find this an easy question to answer, but on balance I consider that without use MORGAN would be devoid of distinctive character in relation to clothing and therefore would not be registrable.
  
39. I therefore consider that, despite not having the advantage of the Judgment in *Nichols*, the hearing officer's assessment of the inherent distinctive character of MORGAN was over-generous to the opponent, rather than unduly parsimonious as the opponent contends. The hearing officer took the fact that MORGAN has in fact been registered as indicating that it possessed a small degree of distinctive character, but in my judgment he fell into error by doing so. The fact that a mark has been registered does not necessarily mean that it has distinctive character: it may have been accepted in error. Moreover, in the present case the evidence shows that at least the '211 registration was accepted

on the basis of evidence of use. The next question, therefore, is whether the opponent has proved that its mark has become distinctive through use.

#### Acquired distinctiveness

40. The opponent's first point under this heading is that the passage quoted by the hearing officer from the decision of Simon Thorley QC sitting as the Appointed Person in *DUONEBS Trade Mark* BL O/048/01 is not a correct statement of the law having regard to the jurisprudence of the European Court of Justice. A similar submission was made to David Kitchin QC sitting as the Appointed Person in *STEELCO Trade Mark* BL O/268/04. Having reviewed the Court's decisions in *Sabel*, *Canon* and *Lloyd*, Mr Kitchin concluded at paragraph 17 of his decision:

The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe that the observations of Mr Thorley QC in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion.

I agree with Mr Kitchin. It follows that, in so far as the hearing officer directed himself in accordance with *DUONEBS*, I consider that he misdirected himself.

41. I have to say, however, that it is not clear to me that the hearing officer actually applied *DUONEBS*. Although paragraph 27 of his decision begins with the words "Applying these principles", his conclusion is merely that "the opponent's claim that the MORGAN brand's reputation and distinctiveness has been enhanced through use is not without legitimacy" and that "use has improved the opponents' position". Thus the hearing officer did not find that

MORGAN was a household name, yet nevertheless proceeded on the basis that its distinctiveness had been enhanced by use.

42. This leads to the opponent's next point, which is that the hearing officer failed to make any clear finding as to the acquired distinctiveness of the opponent's mark. In my judgment there is substance in this criticism. All the hearing officer found was that the distinctiveness of MORGAN had been enhanced through use i.e. it had a better claim to distinctive character than the low claim it had on the basis of his assessment of inherent distinctiveness. He made no finding as to extent of the distinctiveness acquired as a result of such enhancement.
  
43. I also consider that there is substance in the opponent's criticism that the hearing officer was unjustified in apparently giving little or no weight to some of its evidence, and in particular the contents of exhibit LC2. This exhibit consists of a large bundle of press cuttings most of which are dated between 5 February 2001 and 10 May 2001, although a few are dated after 15 May 2001 and must be disregarded and some others do not actually refer to MORGAN by name. The hearing officer appears to have given these cuttings little or no weight on the ground that they are mostly editorial in nature rather than advertisements (although some are advertisements). In my judgment he was clearly in error to do so, for two reasons. First, editorial references to a trade mark are just as capable of boosting its reputation as paid-for advertising. Indeed, I believe that many consumers would regard an editorial mention as more of an incentive to purchase the goods in question than a paid-for advertisement. Secondly, editorial references are capable of shedding light on a trade mark's existing reputation as well as enhancing that reputation.
  
44. I consider that the cuttings in exhibit LC2 provide strong support for the opponent's contention that by 15 May 2001 MORGAN had acquired a substantial reputation in the field of clothing. By way of example only I refer to the following:

- (1) An article published in *The Daily Telegraph* on 5 February 2001 suggesting that the singer, actress and author Madonna had triggered a cowgirl revival in high street fashion states:

Morgan, with 52 shops in Britain, has just launched a “Cowgirl” range of studded and diamante T-shirts printed with rodeo slogans and bucking broncos.

- (2) On 2 March 2001, 13 March, 27 April 2001 and 27 April 2001 *OK!* magazine published articles about, and featuring photographs of, Samantha Mumba (a pop singer), Caprice Bourret (a “supermodel”), Jenni Falconer<sup>3</sup> (a television presenter) and Lisa Scott-Lee (a pop singer with the group Steps). In the first article the caption to the photograph states that “Irish star Samantha wears ... trousers, £49.99, by Morgan”, in the second article Morgan is included among a list of stockists, in the third article the caption to the photograph states “Jacket, £99.99; trousers, £59.99; waistcoat, £39.99, all by Morgan...” and in the fourth article the caption to one of the photographs states “Lisa wears ... jeans, £120, by Morgan”. The issue of *OK!* dated 27 April 2001 seems to have been a particularly good one for the opponent, since in addition to the articles about Jenni Falconer and Lisa Scott-Lee, a column by Tamara Beckwith (a socialite) contains a reference to her slipping on “my Morgan sequined Union Jack top”.

- (3) An article published in the *Lancashire Evening Post* on 16 April 2001 states:

Posh Spice is a big fan, so are pop nymphets Atomic Kitten and Samantha Mumba. When they aren’t spending oodles on designer names, their high street fashion shop of choice is Morgan, the French fashion store that now has outlets all over the world – Paris, Athens, Sydney, Hong Kong ... Preston. The shop with the cutting edge styles had been in the town, on Fishergate, for a while now, but this week it’s due to move into its new home in the St George’s Centre.

And that’s not all that’s new about Morgan. At long last its designers have realized that it would get more customers if it catered to more

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<sup>3</sup> The part of the article included in LC2 does not include Ms Falconer’s name, but she is readily identifiable from the information given.

than semi-anorexic 16-year olds. It's launched a new UK sizing structure ... which means that real women will get a look in. Just as well because the girls in the Hear'Say popstars are also reported to have taken a shine to Morgan's clothes and they are very definitely built like women ought to be.

- (4) On 1 May 2001 four newspapers published by Sheffield Newspapers Ltd, namely the *Sheffield Star*, the *Barnsley Star*, the *Doncaster Star* and the *Rotherham Star*, each ran a promotional competition in conjunction with the opponent which included the following text:

Win Morgan gift voucher to dress in style

It's loved by many a famous face. Victoria Beckham, Atomic Kitten, Samantha Mumba and Caprice are just a few of the celebs who are regularly seen sporting Morgan designs.

And, from tomorrow, the French-based label will be even more accessible to South Yorkshire women, when it opens a new store at Meadowhall.<sup>4</sup> And, to mark the occasion, we have £50 gift vouchers to offer to give luck Star readers.

The store will feature Morgan's extensive clothing and accessory range – which includes a new sizing policy following High Street demand for larger sizing. Morgan now caters for size 8 to 16 as more and more women buy into the catwalk look.

From its humble beginnings as a family business in Paris, Morgan has grown into a worldwide label, with over 500 shops in 50 countries.

- (5) There are a number of cuttings on the theme of how to imitate a designer look by buying clothes from high street stores which recommend MORGAN garments. These include articles in the following: *Elle* April 2001; *The Guardian* 28 April 2001; *Evening Standard* 30 April 2001; *Eastern Daily Press* 1 May 2001; and *Daily Mail* 10 May 2001. There are also a number of cuttings on the theme of how to look like particular celebrities by buying clothes from high street stores which recommend MORGAN garments. These include articles in the following: *The Sun* 15 March 2001; *Marie Claire* April 2001; *Marie Claire* May 2001; *Star* 10 April 2001; *Daily Record* 27 April 2001; and eight *Express and Star* newspapers published in cities including Birmingham and Wolverhampton on 11 May 2001. These

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<sup>4</sup> A large shopping centre in Sheffield.

lists are non-exhaustive. Furthermore, they do not include a number of other cuttings recommending or listing MORGAN garments which do not fall into these categories.

45. Taking this evidence into account together with the matters referred to by the hearing officer in paragraph 25 of his decision and the opponent's advertising expenditure figures quoted in paragraph 13 of his decision (rising to £362,500 in 2001), I conclude that as at 15 May 2001 MORGAN had a strong reputation in the field of women's clothing. While it may not have been quite a household name, it was certainly a well-known name in that field. In my view the evidence does not establish, however, that MORGAN had any reputation in the fields of men's clothing, children's clothing, footwear and headgear at that date. The evidence does show that the opponent was selling men's clothing by 4 June 2003, but not that it was doing so before then. As for footwear and headgear, it appears that the opponent may have sold such items, but the evidence is too scanty for any firm conclusion to be drawn.

#### Assessment of the applicant's mark

46. The opponent contends that the hearing officer erred in his assessment of the applicant's mark and that he should concluded that the word MORGAN was the dominant component. I see no error in the hearing officer's assessment of the relative importance of the two words, however. To put it another way, LORNA qualifies MORGAN and MORGAN qualifies LORNA: see *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 159, [2004] ETMR 56 at paragraph [26] and *McQUEEN CLOTHING CO Trade Mark* (BL O/120/04) at paragraph [33]. That said, the question remains as to how the average consumer who was familiar with MORGAN would react when presented with LORNA MORGAN.

#### Likelihood of confusion

47. The opponent contends that the hearing officer made a number of errors in his assessment of the likelihood of confusion. The opponent's main arguments are

that the hearing officer failed to consider who was the average consumer of the goods in question, failed properly to consider the impact of the distinctive character of MORGAN upon the average consumer's perception of LORNA MORGAN, failed to make allowance for imperfect recollection, wrongly treated the present case as analogous with *LAURA Trade Mark* and failed to apply the "interdependency principle" i.e. the principle established by the jurisprudence of the European Court of Justice that a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and vice-versa. In my judgment there is substance in most of these points.

48. First, the hearing officer made no finding as to the identity of the average consumer or the level of care that would be exercised. The goods in question here are clothing, footwear and headgear. Thus the average consumer is representative of the entire adult population in the UK (and children with purchasing, or at least pester, power). As I have already found, the opponent's mark is a well-known mark for women's clothing. Its goods are moderately priced items sold through high street stores. Likewise, normal and fair use of the applicant's mark would embrace use upon inexpensive items sold through high street stores. It follows that no special care would be taken in their selection.
  
49. Secondly, I do not consider that the hearing officer correctly addressed the impact of the distinctive character of MORGAN, perhaps because, as I have already noted, he made no clear finding as to this. Given the significant reputation of MORGAN and the level of attention that would be exercised by the average consumer of clothing, I consider that the average consumer presented with goods marked LORNA MORGAN, particularly but not exclusively women's clothing, might well believe that they came from the same or economically-linked undertakings. In my view the average consumer might well assume that LORNA MORGAN related to MORGAN in the same way as COCO CHANEL to CHANEL, MIUCCI PRADA to PRADA, GIORGIO ARMANI to ARMANI and GIANNI VERSACE to VERSACE. The fact that the average consumer has not been educated to link MORGAN

with a first name would not prevent this, but on the contrary would be a factor that encouraged the making of this assumption. If the average consumer had been educated to link MORGAN with (say) ELIZABETH, then confusion would be rather less likely.

50. Thirdly, the hearing officer did not consider the effect of imperfect recollection. It seems to me that, once it is remembered that the average consumer may not have the opportunity to compare the two marks side by side but may have to rely upon his or her imperfect memory of the opponent's mark, then there is a significant chance that the average consumer would mistake LORNA MORGAN for MORGAN or least think them connected in an origin-signifying manner.
51. Fourthly, I am concerned by the hearing officer's reliance upon *LAURA Trade Mark*. Sir Donald Nicholls V-C trenchantly observed in *Mölnlycke AB v Procter & Gamble Co (No 5)* [1994] RCC 49 at 114 lines 22-23 that:

Citing previous decisions on a question of fact is not a useful, nor is it a proper, exercise.

It is therefore not correct, however tempting it may be, to try to decide whether there is likelihood of confusion in one case by drawing a factual analogy with a different case, as opposed to applying the principles of law established by that case. While I have no doubt that the hearing officer was endeavouring to stay on the right side of this line in citing *LAURA Trade Mark* for its discussion of the difference between confusion and association, it does appear me to that he regarded the present case as analogous to that one and that this influenced his assessment of the likelihood of confusion.

52. In my judgment this case is not analogous to *LAURA Trade Mark*, but rather the converse of that case. In that case Matthew Clark QC sitting as the Appointed Person held that the dominant component of the earlier trade marks relied upon was ASHLEY, and since this component was wholly absent from the mark applied for he concluded that there was no likelihood of confusion.

In the present case, however, the sole and dominant component of the earlier trade marks is MORGAN and the entirety of that component forms part of the mark applied for (which is why it has not been necessary for either the hearing officer or myself to devote space to a detailed consideration of the extent of the visual, aural and conceptual similarities between the two).

53. If one were disregard the principle stated by Sir Donald Nicholls V-C, and indulge in the search for factual analogy, I consider that the present case is much closer to *PERKINS Trade Mark* BL O/516/01 and *McQUEEN CLOTHING CO Trade Mark* (cited above), both of which concerned applications to register trade marks in respect of *inter alia* clothing. In the former case, it was held by the Registrar's hearing officer that there was a likelihood of confusion between the applicant's mark PERKINS and the opponent's mark DOROTHY PERKINS. In the latter case, it was held by Geoffrey Hobbs QC sitting as the Appointed Person that there was no likelihood of confusion between the applicant's mark McQUEEN CLOTHING CO and the opponent's mark ALEXANDER McQUEEN. In my view this demonstrates the soundness of the principle enunciated by Sir Donald Nicholls V-C, since it shows that in two superficially similar earlier cases opposite results were arrived at. I do not question either decision, each of which depended on an application of the same principles of law to different factual circumstances and different evidence. Thus comparing the present case to them with a view to deciding which decision should be followed would be a fruitless, as well as an illegitimate, exercise.
54. I would add that a further problem with the search for factual analogy is knowing where to stop. If it were legitimate to consider the two decisions discussed in the preceding paragraph, it could be argued that one should also consider *COCO DE MER Trade Mark* [2004] EWHC 992 (Ch) in which COCO DE MER was held confusingly similar to COCO for *inter alia* clothing, various decisions of OHIM Boards of Appeal such as Case R185/2000-2 in which TED BAKER was held confusingly similar to CLAUDIA BAKER for clothing or even perhaps *JEAN P. ROGER Trade*

*Mark* (BL O/108/04) in which JEAN P. ROGER was held confusingly similar to POL ROGER for alcoholic beverages. That way madness lies.

55. So far as the “interdependency” principle is concerned, the hearing officer correctly proceeded on the basis that the goods were identical. While the hearing officer did not expressly consider the interdependency principle, I consider that it adds little to the points I have already considered.
56. The applicant argued before the hearing officer that (i) there had been no confusion in practice between its goods and those of the opponent and (ii) confusion was unlikely since its goods were aimed at a different target market. As to (i) the applicant admits that the quantity and value of its clothing sales are “relatively low”, and no proper details of such sales have been provided. In any event, as the hearing officer rightly held, whether there is a likelihood of confusion must be assessed on the basis of normal and fair use of the mark in relation to the goods specified in the application, which is not limited to any particular types of clothing nor to any particular target market. As to (ii), even if it is assumed that the target market for the applicant’s goods would not be confused, that does not negate the existence of a likelihood of confusion if the applicant’s mark were to be used in other ways falling within the scope of normal and fair use. (I should perhaps add that I do not consider that it would be permissible to limit the specification by reference to the applicant’s intended target market: cf. *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* at paragraphs 111-117 and *McQUEEN CLOTHING CO Trade Mark* at paragraphs [27]-[30].)

### Conclusion

57. I conclude that the opponent has established a likelihood of confusion within the meaning of section 5(2)(b). The appeal will therefore be allowed, with the result that the application will be refused so far as it relates to goods in Class 25. For the avoidance of doubt, the application may proceed to registration in respect of the goods specified in Classes 9, 17, 35, 41 and 42 if (as I understand to be the case) it has not already been divided.

Costs

58. The hearing officer ordered the opponent to pay the applicant the sum of £1000 as a contribution to its costs. I shall reverse that order and order the applicant to pay the opponent a further sum of £1000 in respect of the appeal, making a total of £2000.

15 October 2004

RICHARD ARNOLD QC

Amanda Michaels, instructed by fj Cleveland, appeared for the opponent.

Jonathan Gilmore of Oska's Ltd appeared for the applicant.