

O-348-10

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION 2511900
BY PAUSE CLOTHING LTD
TO REGISTER IN CLASS 25 THE TRADE MARK:**

THIRD REPUBLIC

AND

**IN THE MATTER OF OPPOSITION 99552 BY
REPUBLIC (RETAIL) LIMITED**

TRADE MARKS ACT 1994

**In the matter of application 2511900 by Pause Clothing Ltd
to register in class 25 the trade mark THIRD REPUBLIC**

and

In the matter of opposition 99552 by Republic (Retail) Limited

The background and the pleadings

1) On 24 March 2009 Pause Clothing Ltd (“Pause”) applied to register the trade mark THIRD REPUBLIC in respect of clothing, footwear and headgear in class 25.

2) On 18 September 2009 Republic (Retail) Limited (“RRL”) opposed the registration of the above trade mark under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). RRL rely on four trade marks¹ of which it is the proprietor. However, given the nature of the earlier marks, the goods they cover, the goods relied on, and the relevance of the proof of use provisions² to them, I need only consider Community trade mark (“CTM”) 2838712 which is for the mark REPUBLIC. The other earlier marks (two of which are subject to the proof of use provisions) place RRL in no better position. CTM 2838712 is registered for a number of goods and services in a number of classes, but RRL rely only on its goods in class 25, namely:

Articles of clothing, footwear, headgear; belts.

The proof of use provisions do not apply to CTM 2838712³, so it may be taken into account for all of the above goods.

3) Pause filed a counterstatement denying the grounds of opposition. Pause denies the allegation of similarity and it also refers to “81 companies with the trade mark which have “Republic” in their name”.

4) Both sides filed evidence. The matter then came to be heard before me on 13 September 2010. At the hearing RRL were represented by Mr Bruce Marsh of Wilson Gunn. Pause were represented by Ms Nina Matharoo, the daughter of Mr Jasbir Matharoo who is a company director of Pause.

¹ CTM 2838712, CTM 6649396, UK registration 2062832 & UK registration 2188281.

² See section 6A of the Act, which was added to the Act by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

³ The earlier mark was registered within, not before, the five year period prior to the publication of Pause’s application.

The evidence

5) RRL's evidence deals with the use that has been made of its REPUBLIC mark. The evidence comes from Mr Guy Daltrey, RRL's brand manager. In the context of this dispute, the primary relevance of this evidence will be in relation to whether the earlier mark has an enhanced degree of distinctive character. The relevance of this factor will be highlighted shortly. I do not intend to summarise the evidence here, but will come back to it, to the extent necessary, when dealing with this factor.

6) Pause's evidence is from Mr Jasbir Matharoo. He refers to other trade marks owned by Pause and the history of the company (which he says is a wholesaler). As the other marks referred to are completely different to the marks under consideration in this decision, I need say no more about them. Mr Matharoo states that the mark applied for is to be used on garments for men including jackets, shirts, knitwear, shorts and t-shirts. He states that time and money has been invested in designing the logo, examples of the mark on hang tags and labels are shown in Exhibit REP2. There is, though, no suggestion that the mark has so far been used.

7) Mr Matharoo refers to the concepts that underpin the respective marks. He states that THIRD REPUBLIC is a term designating the republic established in France in 1870 after the fall of Napoleon the third lasting until the German occupation of France in world war two, whereas the word REPUBLIC alone means a state in which supreme power is held by the people and their elected representatives and which has an elected or nominated president rather than a monarch. Reference is also made to 81 marks on the register which incorporate the word REPUBLIC which, Mr Matharoo says, are no doubt in use – Exhibit REP3 contains details of these marks. The remainder of his evidence is submission rather than fact which I will bear in mind but will not summarise here.

8) Mr Matharoo also provided some written submissions which, to a large extent, mirror his evidence. In addition to the comments summarised above, Mr Matharoo highlights some of the marks on the register which contain the word REPUBLIC and he also highlights that RRL does not use its REPUBLIC mark on goods but only in relation to the retailing of clothing (Exhibit REP4 refers).

Section 5(2)(b) of the Act

9) This section reads:

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

(a)

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

10) In reaching my decision I have taken into account the guidance provided by the European Court of Justice (“ECJ”) in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).

11) The existence of a likelihood of confusion must be appreciated globally, taking into account all relevant factors (*Sabel BV v Puma AG*). As well as assessing whether the respective marks and the respective goods are similar, other factors are relevant including:

The nature of the average consumer of the goods in question and the nature of his or her purchasing act. This is relevant because it is through such a person’s eyes that matters must be judged (*Sabel BV v Puma AG*);

That the average consumer rarely has the chance to make direct comparisons between trade marks and must, instead, rely upon the imperfect picture of them he or she has kept in mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*) This is often referred to as the concept of “imperfect recollection”;

That the degree of distinctiveness of the earlier trade mark (due either to its inherent qualities or through the use made of it) is an important factor because confusion is more likely the more distinctive the earlier trade mark is (*Sabel BV v Puma AG*);

That there is interdependency between the various factors, for example, a lesser degree of similarity between the marks may be offset by a greater

degree of similarity between the respective goods, and vice versa (*Canon Kabushiki Kaisha v Metro- Goldwyn-Mayer Inc*).

12) In terms of the goods, I agree with Mr Marsh's submission that there can be no dispute that the goods are identical. Pause's goods are: clothing headgear and footwear. RRL's goods include the same terms. I note Pause's evidence which states that its mark is to be used on specific types of clothing for men. Even if the goods were limited to this (which they are not) then identical goods are still in play as RRL's specification would include such goods within its ambit⁴.

13) Ms Matharoo highlighted at the hearing that Pause's goods were wholesaled rather than retailed and that no labels are sewn into the garments. Whilst this may be so, the point is academic because Republic's mark is capable of being used both at retail and wholesale level. There is, therefore, no differentiation. This factor is also not significant because: 1) even if the goods were sold on a wholesale level, there is no reason why the mark used at wholesale will not be present when subsequently retailed (even if the mark is not sewn into the garments) – so the end consumer may, therefore, still encounter it, 2) there is nothing to prevent a wholesaler selling direct to the public and, 3) the mode of selling (wholesale/retail) is simply a marketing strategy rather than an objective quality of the goods – marketing strategies are temporal and can come and go with the passage of time. I must assess the matter notionally, on the basis of the goods sought to be registered, namely clothing, footwear and headgear.

14) Clothing is bought by the public at large. The average consumer is, therefore, a member of the general public. The case-law informs me that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting goods can, however, vary depending on the particular goods in question (see, for example, the judgment of the GC in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)). In my view, clothing will be purchased with a reasonable degree of care and attention. The average consumer may try the goods on and is likely to inspect them for colour, size, style etc. All of this increases the potential exposure to the trade mark. That being said, the purchase is unlikely to be a highly considered process as clothing is purchased relatively frequently and although cost can vary, it is, generally speaking, not a highly expensive purchase.

15) Although aural similarity will not be ignored completely from my analysis, I am conscious that the visual impression of the trade marks is likely to take on more significance as the purchase of clothing is normally a visual act⁵.

⁴ See *Gérard Meric v OHIM* (Case T-133/05), a judgment of the General Court ("GC") – the GC was previously known as the Court of First Instance of the European Communities ("CFI").

⁵ See *Société provençale d'achat and de gestion (SPAG) SA v (OHIM) Case T-57/03* and *React Trade Mark* [2000] RPC 285.

16) That leads to a comparison of the marks. The competing marks, for ease of reference, can be seen in the table below:

Pause's mark	RRL's mark
THIRD REPUBLIC	REPUBLIC

17) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account any distinctive and dominant components.

18) In terms of submissions, Mr Marsh argued that the word REPUBLIC was the dominant and distinctive element of Pause's mark and, as such, this resulted in the respective marks being similar both visually and aurally (I will come back to concept shortly). Ms Matharoo stressed the whole mark comparison that must be made and that the presence of the word THIRD was bound to be noticed and that this made the marks dissimilar.

19) In terms of distinctive and dominant components, RRL's trade mark, being a known dictionary word, does not separate into distinctive and dominant components. The word REPUBLIC is, therefore, its only constituent part. Pause's mark, on the other hand, consists of two known dictionary words. However, the construction of the mark is that the word THIRD qualifies the word REPUBLIC and plays a subordinate role. The word REPUBLIC is also longer than the word THIRD both on visual impression and upon phonetic breakdown. As a consequence of all this, and despite the word THIRD being at the beginning of the mark⁶, the word REPUBLIC is the more dominant element. This does not mean that I ignore the word THIRD as it is only possible to do so if it were negligible in the overall impression of the mark⁷ – it is certainly not that. In fact, although the word REPUBLIC is the more dominant element, it is not overwhelmingly so.

⁶ The rule of thumb that beginnings of words/marks are more important than the ends is just that, a rule of thumb - each case must be considered on its merits. See, by way of example, the decisions of the GC in *Spa Monopole, compagnie fermière de Spa SA/NV v OHIM* (Case T-438/07) and *Castellani SpA v OHIM* (T-149/06). These, of course, are not relied upon for their facts but only the point of principle.

⁷ See *Shaker di L. Laudato & Co. Sas*.

20) Any similarity resides in the presence of the word REPUBLIC in Pause's mark, which is the entirety of RRL's mark. Considering the construction of the respective marks and the dominant and distinctive elements in them, there is a degree of similarity from both a visual and aural perspective. There is, though, a difference due to the addition of the word THIRD at the beginning of Pause's mark. Weighing all these considerations, I consider there to be a reasonable, neither high nor low, degree of visual and aural similarity.

21) In terms of concept, for a conceptual meaning to be relevant it must be one capable of immediate grasp⁸. Such assessment must, of course, be made from the perspective of the average consumer. The average consumer cannot be assumed to know the meaning of everything. In the *Chorkee case* (BL O-048-08), Anna Carboni, sitting as the Appointed Person, stated in relation to the word CHEROKEE:

"36.By accepting this as fact, without evidence, the Hearing Officer was effectively taking judicial notice of the position. Judicial notice may be taken of facts that are too notorious to be the subject of serious dispute. But care has to be taken not to assume that one's own personal experience, knowledge and assumptions are more widespread than they are.

37. I have no problem with the idea that judicial notice should be taken of the fact that the Cherokee Nation is a native American tribe. This is a matter that can easily be established from an encyclopaedia or internet reference sites to which it is proper to refer. But I do not think that it is right to take judicial notice of the fact that the average consumer of clothing in the United Kingdom would be aware of this. I am far from satisfied that this is the case. No doubt, some people are aware that CHEROKEE is the name of a native American tribe (the Hearing Officer and myself included), but that is not sufficient to impute such knowledge to the average consumer of clothing (or casual clothing in the case of UK TM no. 1270418). The Cherokee Nation is not a common subject of news items; it is not, as far as I am aware, a common topic of study in schools in the United Kingdom; and I would need evidence to convince me, contrary to my own experience, that films and television shows about native Americans (which would have to mention the Cherokee by name to be relevant) have been the staple diet of either children or adults during the last couple of decades."

22) In relation to the word REPUBLIC alone, this strikes me as a normal everyday word which the average consumer is likely to be aware of. Whilst they may not be able to define it in as much detail as Mr Matharoo does in his evidence, they will know that it relates to a form of constitution of a country. The

⁸ This is highlighted in numerous judgments of the GC and the ECJ including *Ruiz Picasso v OHMi* [2006] e.c.r. -I-643; [2006] E.T.M.R. 29.

word REPUBLIC has a meaning capable of immediate grasp. There was no real dispute between the parties on this.

23) In relation to Pause's mark, Mr Matharoo states in his evidence that THIRD REPUBLIC is a historical reference to France. As a fact, this is not challenged or disputed. I have no reason to suspect that it is not true. However, it is a different matter altogether as to whether the average consumer will be aware of this term. Whilst evidence does not have to be provided to prove that the average consumer knows of a particular meaning, in the absence of evidence, I must be persuaded that the meaning is a notorious fact of which the average consumer will be aware. At the hearing the parties, for obvious reasons, took opposite views on this. From my point of view, I am not satisfied that the historical meaning of THIRD REPUBLIC will be known by the average consumer in the UK. The term does not strike me as one which will be commonly known. It may exist in history books or other reference works but it is not, in my experience, one that will be commonly used or referred to today. I see no reason to assume that the average consumer will be aware of its meaning. The words THIRD and REPUBLIC do not, therefore, combine to create a known concept. The word REPUBLIC will retain its meaning as set out in the previous paragraph. The addition of the word THIRD could be said to add to this concept, but it does not do so in a way which gives it a clearly different concept. The mark as a whole simply refers to a republic that is third in number. On account of all this, whilst there may not be conceptual identity, there is a degree of conceptual similarity.

24) Overall, balancing the visual, aural and conceptual similarities, the degree of similarity is at a reasonable degree.

25) I have already stated that the degree of distinctiveness of the earlier mark is an important factor to consider. This is because the more distinctive the earlier mark (based either on its inherent qualities or because of the use made of it), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). From an inherent starting point, the earlier mark is reasonably high in distinctive character. The word REPUBLIC makes no suggestive or allusive reference to the goods. It is fairly fanciful word. In his evidence and submissions Mr Matharoo referred to the various other marks on the register that incorporate the word REPUBLIC. This, potentially, could mean that the average consumer sees the word as being less fanciful because it is a word commonly used by other traders. However, there is no evidence of any of these marks in actual use and it cannot safely be assumed that the average consumer has encountered them. In *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281 Jacob J stated:

“In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led to the Registrar to put the marks concerned on the Register. It has long been held that under the old Act that comparison with other marks on the Register is in principle irrelevant when

considering a particular mark tendered for registration, see *e.g. MADAME Trade Mark* (1966 RPC 541) and the same must be true of the 1994 Act. I disregard the state of the register evidence.”

26) In view of the above, I regard REPUBLIC to be a mark of a reasonably high degree of inherent distinctiveness.

27) The earlier mark has also been used which could, potentially, enhance its distinctive character. However, Mr Matharoo pointed out in his written submissions (a submission that Ms Matharoo repeated at the hearing) that the REPUBLIC mark is used for the retailing of clothing rather than for clothing itself. To counter this, Mr Marsh highlighted that Mr Daltrey’s evidence contains swing tags and woven labels (Exhibit REP2). Mr Daltrey states in his evidence that the tags and labels are used to designate REPUBLIC clothing. Turnover and advertising figures are provided which differentiate the REPUBLIC branded clothing from the third party brands it sells. The figures range from around 1 fifth of units sold to around one third being REPUBLIC branded goods. The figures involved appear, on the face of it, reasonably significant. However, there is no evidence as to market share and there is no evidence as to the nature of the advertising/promotion that is claimed to have taken place other than the existence of its shops (which in fairness to RRL are large in number), its website (but no access figures are provided) and that it has won some retailing awards. I come to the view that whilst some average consumers will know of REPUBLIC as a retailer and to a lesser extent as a clothing brand, it is difficult to assess the degree of such knowledge. For all these reasons, I cannot find that the distinctive character of the mark in relation to clothing per se is enhanced through use to any significant extent. The mark is, though, reasonably high in distinctiveness from an inherent point of view.

Conclusions

28) It is clear that all these factors have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17) and that a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

29) Ms Matharoo highlighted that there were lots of other marks registered that contain the word REPUBLIC (she mentioned, in particular, BANANA REPUBLIC) and that the average consumer will be aware of this and will, therefore, be able to distinguish between THIRD REPUBLIC and REPUBLIC in the same way that consumers are able to distinguish between BANANA REPUBLIC and REPUBLIC. As stated in paragraph 25, the fact that there may be other marks on the register tells me little. There is no evidence that a plethora of REPUBLIC

based marks are in use in the UK to which the average consumer has been exposed so that he or she has become attuned to differentiating between REPUBLIC and other marks containing the word REPUBLIC. This argument is, therefore, of little relevance. Also of little relevance is the argument that REPUBLIC are principally retailers. The earlier mark is not subject to the proof of use provisions and it must, therefore, be considered for its full specification which includes clothing. It is a notional assessment that must be made on the basis of both REPUBLIC and THIRD REPUBLIC being used in relation to articles of clothing.

30) In terms of the relevant factors, the goods are identical and the marks reasonably similar. The earlier mark is also reasonably high in inherent distinctive character. However, an average consumer will pay a reasonable degree of care and attention to the goods that they are choosing and, so, they may be able to differentiate between the two marks. Whilst this is a possibility, the reasonable degree of similarity, a similarity based on what I regard as the dominant and distinctive element in Pause's mark, is, in my view, likely to result in confusion. This is particularly so when one bears in mind the concept of imperfect recollection (because consumers rarely see marks side by side), the most memorable aspect of Pause's mark being its dominant and distinctive element REPUBLIC. Even if I am wrong on this and the average consumer notices and recalls that one mark is THIRD REPUBLIC and the other is REPUBLIC, then it is my view that this will be put down not to a co-incidental inclusion of the same word, but to an economic connection between the undertakings responsible for the goods⁹. The opposition succeeds.

Costs

31) RRL has been successful and is entitled to a contribution towards its costs¹⁰. In his written submissions Mr Matharoo stated that RRL's request for costs was intimidating given that RRL is a multi-million pound company and Pause is a two man family business. I note this, but RRL's request is fully justified and the respective size of the companies involved should not immunize Pause from an award against it. I hereby order Pause Clothing Ltd to pay Republic (Retail) Limited the sum of £1300. This sum is calculated as follows:

Preparing a statement and considering the other side's statement
£200

Expenses – opposition fee
£200

⁹ This is a relevant form of confusion – see *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*.

¹⁰ Costs are normally awarded on the basis of the registrar's published scale in Tribunal Practice Notice 4/2007.

Filing evidence and considering Pause's evidence
£500

Attending the hearing
£400

32) The above sum should 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 11 day of October 2010

**Oliver Morris
For the Registrar,
The Comptroller-General**