

**TRADE MARKS ACT 1938 (AS AMENDED) AND
TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 1545994
BY TAMARIND INTERNATIONAL LIMITED TO REGISTER
THE TRADE MARK RELAY IN CLASS 25**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 47839 BY FASHION BOX S.p.A.**

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**IN THE MATTER OF Opposition thereto
under No. 47839 by Fashion Box S.p.A.**

BACKGROUND

On 25 August 1993 Tamarind International Limited of 19th Floor, Tower 1, Enterprise Square, 9 Sheung Yuet Road, Kowloon Bay, Kowloon, Hong Kong applied under the Trade Marks Act 1938 to register the trade mark RELAY for a specification which reads:

"Footwear; sports shoes and training shoes; all included in Class 25."

The application, numbered 1545994, was published for opposition purposes on 24 September 1997.

On 25 November 1997 Fashion Box S.p.A filed notice of opposition to this application. However, on 23 December 1997 the notice of opposition was amended. This amendment was accepted by the Registrar. In summary, the grounds of opposition (as amended) are:

1. Under Section 12 of the Act because the trade mark the subject of the application is similar to the opponents' registered trade marks as detailed below:

No.	Mark	Class	Specification
1201267	REPLAY	25	Articles of outer clothing, but not including skirts or slacks for women, or any goods of the same description as skirts or slacks for women.
M1339509		25	Articles of outer clothing included in Class 25.



Taking Mr Biancardi's declaration first, he says he has been Managing Director of Fashion Box S.p.A., the opponents, since December 1992 and provides Exhibit AB1 which consists of a Company Profile.

5 He says that goods bearing their trade mark REPLAY have been sold throughout the United Kingdom since 1983 and are currently imported into the UK by Elanmain Limited (trading as Options) of London and also by the opponents' controlled subsidiaries New Mills S.p.A., Fashion Toys S.p.A. and Knit Box S.r.L through their respective UK distributors. He says the mark has been used on a wide range of men's, women's and children's clothing and accessories and since 1994 his company has marketed summer and winter collections of clothing, footwear and accessories. These collections typically include coats; jackets; jerkins; trousers including jeans and sweat-trousers; shirts; T-shirts; sweatshirts; skirts, dresses, blouses; knitwear, including pullovers, sweaters and cardigans; headwear, including hats and caps; footwear, including shoes, boots and trainers; underwear, including vests and pants; shorts; 10 tops for women; hosiery, including socks; tracksuits; waistcoats; suits; gloves; scarves; swimwear; belts; bags; purses, wallets, key-cases; costume jewellery.

In support of this Exhibit AB2 provides copies of tags and labels used on the goods sold in the UK. Exhibit AB3 provides copies of front pages of various catalogues of goods for sale in the UK. 20

Mr Biancardi also says that REPLAY has been used prominently in relation to the provision of services for retail shops in the UK since 1994 (ie after the filing date) and Exhibit AB4 shows copies of photographs of REPLAY shops in the UK. Exhibit AB5 shows copies of displays, signs and packaging indicating use of the marks in the shops, as well as a list of shops worldwide operating under the mark and two copies of brochures showing how the mark appears on them. 25

The approximate turnover of goods bearing the mark REPLAY, sold in the UK, expressed in pounds sterling (converted from Italian Lira based on an average exchange rate for each year and taking the years up to the material date) is as follows: 30

	<u>£ Sterling</u>
35	1984 300,520
	1985 442,066
	1986 627,763
	1987 682,253
	1988 629,993
40	1989 342,624
	1990 536,480
	1991 683,274
	1992 1,099,911
	1993 1,775,163

45 The opponents also provide figures for goods sold in the UK by their controlled subsidiaries

New Mills S.p.A. Fashion Toys S.p.A. and Knit Box Srl and also through Promoter Company S.p.A., a licensee of the opponents. This and certain other trading information mainly relates to periods after the applicants' filing date and so is not detailed here.

5 Exhibit AB7 provides a list of UK clients of the UK distributor of REPLAY products including the above articles.

10 Mr Biancardi goes on to say that REPLAY has been extensively promoted and advertised worldwide by means of billboards and television and cinema commercials and through print appearing in magazines and newspapers. In the UK these include Arena (April 1989), Glamour (July 1990), Sportswear International (Winter 1992/93), The Face (March 1993) and numerous others after the filing date.

15 Turning to Mr Whalley's declaration, he says, he is a Chartered Patent Agent and a Registered Trade Mark Agent being a partner in the firm of Marks and Clerk, who represent the opponents. He advises that the opponents have also filed opposition against application 2010307 filed by the applicants for the same mark in respect of "Articles of clothing". He says that as part of that opposition, he filed evidence in the form of a statutory declaration together with Exhibits KW1 and KW2 along with a declaration by Mr Aron Richard Sharpe of 20 Elanmain Limited, the opponents' distributor (mentioned earlier in this decision). He says the opponents wish to adopt that evidence in these proceedings.

25 Exhibit KW - I consists of a copy of Mr Whalley's declaration, dated 23 December 1997, in support of opposition to application No. 2010307, together with Exhibits to that Declaration of KW1 and KW2.

Exhibit KW-II consists of a copy of Mr Sharpe's declaration, also dated 23 December 1997, in support of opposition to application No. 2010307.

30 For the sake of convenience, I provide an extract from my decision on the opposition to 2010307 where I summarised the above evidence as follows:

35 *Taking Mr Whalley's declaration first, he notes the fact that Mr Levy is in London while the applicants' business is in Hong Kong and that Mr Levy states that the records of the Company are available to him. He refers to Mr Levy's statement that the trade mark RELAY was adopted by the "predecessors in business" of Tamarind in or around 1983 and that the mark was in continuous since that date in the UK. He also notes that RELAY was registered by the applicants' predecessors as No. 1204871, filed on 7 October 1983 and turnover of goods in the UK since the mark's*
40 *inception amounts to approximately £35 million f.o.b.*

Mr Whalley says that he obtained copies of relevant documents from the file for 1204871 and shows copies of the following documents in Exhibit KW1:

45 **S** *TM16 dated 11 July 1991 showing the mark was assigned from the original applicants Jaytex Limited to Milford Trading (UK) Limited*

- *TM16 dated 25 January 1994 showing the mark was assigned from Milford Trading (UK) Limited to Discovery Bay Co. Limited.*

5 **S** *TM16 dated 2 October 1995 showing the mark was assigned from Discovery Bay Co. Limited to the present applicants.*

10 *Mr Whalley notes that all the predecessors are British Companies and says that it is not apparent to him how Mr Levy had access to records of these companies so as to make his declaration. Mr Whalley goes on to refer to a revocation action by the current applicants against No 1204871, the registration that now stands in the applicants' name. It appears that, subsequent to the launching of the revocation proceedings, Tamarind took an assignment of the registration and withdrew their action against it. In the circumstances I do not think I can derive any meaningful assistance from the claims made in that action and the observations now offered in relation to that case.*

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20 *Turning to the declaration by Mr Sharpe, he says that he is a co-Director of Elanmain Limited, trading as Options, that his Company was established in August 1989 by him and his co-Director Mr Robert Michael Brown. He says that soon after establishing his Company they commenced importing into the UK as a sole distributor from the opponents their range of REPLAY clothing, He further says that his Company currently distributes the goods to around 200 retail outlets in the UK including Fenwicks, House of Fraser, Harrods and Selfridges as well as independent fashion shops. He goes on to say that he is aware of sales of the applicants' goods which are generally sold through high street multiple traders and "generally have a less up-market image" than the opponents' goods.*

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30 *Mr Sharpe says "I can categorically state that there have been some instances in the past where my customers have confused goods sold under the mark REPLAY of Fashion Box with goods sold under the similar mark RELAY."*

35 *Mr Sharpe refers to Exhibit AB3 of Mr Biancardi's Declaration, which illustrates the opponents' tags and labels and to Exhibit DL1 of Mr Levy's Declaration which illustrates the applicants' tags and labels. He refers to similarities not only between the words but also the diamond shaped label and use of the words "Quality" and "Guaranteed".*

40 *Finally, Mr Sharpe says that, from his own knowledge, the opponents' goods were sold under the name REPLAY as early as the beginning of 1982, when he personally sold denim shirts, and not 1984 as stated in Mr Biancardi's Declaration".*

Applicants for Registration's Evidence

45 *The applicants' evidence consists of a statutory declaration by Mr Daniel Levy dated 5 July 1999. He says that he was the Chairman of Tamarind International Limited until October 1998 and that he currently represents the major shareholder and is duly authorised to make the declarations on behalf of the applicants.*

He confirms that he is the same Daniel Levy who made statutory declarations dated 30 June 1997 and 2 March 1998 in the matter of the opposition to their application 2010307. He re-affirms the declarations and exhibits copies of both declarations as Exhibit DL/2 and requests that they be admitted into the proceedings as part of the applicants' evidence.

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For the sake of convenience, I provide an extract from my decision on the opposition to 2010307 where I summarised the above evidence as follows:

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The applicants' evidence consists of a statutory declaration by Mr Daniel Levy dated 30 June 1997. He says he is the Chairman of Tamarind International Limited which has its principal place of business in Hong Kong. He says that the trade mark RELAY was adopted by his Company's predecessors in business in or about the year 1983 and that the mark has been in continuous use since that date in the United Kingdom in relation to a range of clothing for men and boys. He says the mark RELAY was registered by his Company's predecessors in the United Kingdom under number 1204871 as of 7 October 1983 in respect of "articles of clothing for men, youths and boys" and the registration and Common Law rights in the mark have been assigned to his Company by Deed of Assignment dated 15 September 1995.

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The principal goods sold in the UK under and by reference to the trade mark RELAY since 1983 comprise "woven shirts, casual jackets, sweaters, T-shirts, knitted shirts, denim wear, jeans, trousers and sweatshirts." Total turnover in the goods sold under the trade mark in the UK, he says, amounts to approximately £35 million f.o.b. value and current annual turnover amounts to approximately £952,380 f.o.b. value. He says that retail selling prices would be greater amounting to £100 million to £125 million in total sales under the mark in the UK. He goes on to say that his Company's merchandise as marketed under the RELAY trade mark has been exhibited at various menswear shows in the UK by his Company's predecessors and that approximately £300,000 has been spent in promoting the goods by reference to the trade mark since its inception.

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Mr Levy says that by virtue of the use made of the mark since its inception in 1983 the trade mark RELAY has acquired a considerable reputation and is recognised by the trade and members of the public as indicating an exclusive connection with his Company.

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Exhibit DL/1 provides copies of swing tickets and specimen labels showing the manner of use of the trade mark RELAY.

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Mr Levy also refers to the statutory declaration by Mr Biancardi on behalf of the opponents. He says that his Company's use of RELAY and registration 1204871 in 1983 pre-date the opponents' claimed date of first use of REPLAY in 1984 and so the applicants enjoy an earlier right in the UK. He also says that, notwithstanding the extensive use, his Company has no knowledge or experience of confusion arising between its trade mark and that of the opponents. He further says the two marks are

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not confusingly similar as alleged by the opponents as they are each English words having well defined meanings and are words recognisable by the purchasing public in the UK".

5 In his second declaration

10 *"Mr Levy confirms that although resident in London he has access to the applicants' records in Hong Kong and travels there regularly to attend Board Meetings. He confirms that the full records of the applicant and those of its predecessors are available to him. He says that he did not state in his previous Declaration that he had access to the records of Jaytex Limited, Milford Trading (UK) Limited and Discovery Bay Company Limited. However, he says that Jaytex Limited and Milford Trading (UK) Limited were both at one time wholly owned subsidiaries of Milford International Limited, a Hong Kong Company, all under the ultimate control of a Mr Peter Ripper and it was Milford International Limited and other related companies to whom he referred as being the applicants' predecessors.*

15 *In response to the reference to the Revocation proceedings by the opponents through Mr Whalley's Declaration he says the applicants were alleging non-use by Discovery Bay Company Limited, not by the applicant or its predecessors. He confirms that the turnover figure £35 million f.o.b. does not include use of the trade mark RELAY by Discovery Bay Company Limited, if any.*

20 *With regard to Mr Sharpe's reference to confusion by customers Mr Levy says "he has chosen not to or cannot provide any evidence of such alleged confusion. In any event the evidence to support such allegation should have been, if at all, included in the opponents' main evidence so that it could have been responded to."*

25 *With regard to Mr Sharpe's reference to the similarity of the labels Mr Levy says that he firmly believes that the use of the diamond shaped swing tag and/or label is commonplace as is the use of the words "quality" and "guaranteed" such that no one trader can claim an entitlement to their exclusive use".*

30 Mr Levy goes on to say that the words RELAY and REPLAY have separate and distinct meanings. In support of this he provides copies of extracts from Collins English Dictionary (Third Edition), giving the meaning of the two words, as Exhibit DL/3.

35 Mr Levy concludes by saying that notwithstanding the extensive use made of the applicants' mark in the UK side by side with the opponents' mark neither he nor the applicant company has any knowledge or experience of confusion between the marks.

40 That concludes my summary of the evidence.

45 Although objection was originally taken under Sections 9 and 10 of the Act these grounds were not pursued before me. I confirm that I can see no basis for rejecting the application on these grounds.

The matter therefore falls to be decided under Sections 11 and 12 of the Act. These Sections read as follows:

5 "11. It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.

10 12.-(1) Subject to the provisions of subsection (2) of this section, no trade mark shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of:-

- 15 a. the same goods
- b. the same description of goods, or
- 20 c. services or a description of services which are associated with those goods or goods of that description."

The reference in Section 12(1) to a near resemblance is clarified by Section 68(2B) of the Act which states that references in the Act to a near resemblance of marks are references to a resemblance so near as to be likely to deceive or cause confusion.

25 The established tests for objections under these provisions are set down in Smith Hayden and Company Ltd's application (Volume 1946 RPC 101) later adapted, in the case of Section 11 by Lord Upjohn in the BALI trade mark case 1969 RPC 496. Adapted to the matter in hand, these tests may be expressed as follows:-

30 **(Under Section 11)** Having regard to the user of the opponents' mark REPLAY (or REPLAY and device), is the tribunal satisfied that the mark applied for RELAY if used in a normal and fair manner in connection with any goods covered by the registration proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?

35 **(Under Section 12)** Assuming user by the opponents of their mark REPLAY (or REPLAY and device) in a normal and fair manner for any of the goods covered by the registration of that mark, is the tribunal satisfied that there will be no reasonable likelihood of deception amongst a substantial number of persons if the applicants use their mark normally and fairly in respect of any goods covered by their proposed registration?"

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45 The relevant date is the application filing date of 25 August 1993. Ms Clark put her case primarily on the basis of Section 12. I have dealt with Counsels' principal submissions and my own views on the respective marks REPLAY and RELAY in the context of the related opposition action under the 1994 Act. The composite nature of the test under that Act (with the reputation of the opponents' mark being taken into account) is a somewhat different one to

the Section 12 test set out above. However so far as the marks themselves are concerned, basing my consideration on the criteria set down in Pianotist's Application (1906) 23 RPC 774, I have no reason to reach a different view. I will, therefore, put on record and adopt for the purpose of the present action the following paragraphs from the related action.

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So far as the marks are concerned Ms Clark suggested that they are visually and aurally similar and that it is the visual characteristics which are of particular importance in the clothing market because most purchases are made on the basis of visual inspection of the goods. She also argued that conceptually both marks suggested reputation (relaying a signal for instance) or shared sporting connotations. Not surprisingly Mr Mitcheson argued to the contrary that the marks created different visual impact; that RELAY was softer on the ear than REPLAY; and that conceptually the words have distinct meanings. He also contended that customers pay close attention to purchases of clothing.

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It is of course possible to over analyse marks and in so doing shift the focus away from the real test which is how marks will be perceived by customers in the normal course and circumstances of trade. For this reason I have not recorded some of the detailed submissions as to the structure of the words. There are self evidently points of similarity between the words but they are also relatively short words where small differences are more easily noticed. More importantly both words are common dictionary words that would be readily understood by the vast majority of people. I struggle to accept that the average person would make any conceptual link between them or that there is any real risk of aural confusion.

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The opponents' strongest case seems to me to be the visual similarity between the words accepting also, as I do, that most clothing is purchased on the basis of visual inspection. In a retail environment marks may be presented or viewed in a variety of ways. I would hesitate to rule out entirely the possibility that a customer, perhaps viewing labels from a distance, might be mistakenly drawn to the wrong mark. However I do not see it as being a likely rather than merely a possible occurrence. It would also be a momentary confusion that would not survive the normal purchasing process where rather closer attention is likely to be paid to the brand name."

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I conclude that even allowing for imperfect recollection there will be no reasonable likelihood of confusion or deception if the applicants use their mark in a normal and fair manner. That effectively decides the matter without my needing to consider whether the respective goods are the same or of the same description. I propose, therefore, to only comment briefly on the latter.

Only two of the registrations relied on by the opponents are relevant for Section 12(1) purposes - that is Nos. 1201267 and 1339509. No. 1551752, which specifically refers to 'boots, shoes and slippers', has a later filing date. The question that arose at the hearing was whether the "outer clothing" of the other two registrations was the same or the same description as the applicants' "footwear; sports shoes and training shoes". The matter turns particularly on the breadth to be ascribed to the term "outer clothing". I mentioned at the hearing that the matter had arisen before in inter partes proceedings. This was opposition

Nos 17815 and 17614 to applications 1190344 and 1202655 for the marks SILVER SHADOW and HI-TEC SILVER SHADOW. In those proceedings it had been argued that "footwear" is not included within the general term "clothing". The Hearing Officer held

5 "I am unable to accept this submission. A scrutiny of entries in such dictionaries as
Collins English Dictionary and Websters International Dictionary (3rd Edition) shows
that clothing is defined as "articles of dress"; "something which covers or clothes";
"covering for the human body" and "all the garments and accessories worn by a person
at any time". In my view these definitions show conclusively that footwear is covered
10 by the general term clothing and indeed it has been Registry practice so to treat for a
very long time".

If I were to follow that reasoning I would conclude that "outer clothing" as a general term
must also include "footwear". In the event a decision on the point is not critical to the
15 outcome. As I did not have the above extract from the SILVER SHADOW cases to hand at
the hearing and neither Counsel had an opportunity to consider the point it would be wrong to
reach a formal view on the matter. The opposition based on Section 12 fails in the light of my
view on the marks themselves.

20 Section 11 is not primarily relied on by the opponents. Their case would in any event rest on
their use in relation to clothing other than footwear. Their trade in footwear appears to have
got under way in earnest after the material date in these proceedings. There is just a single
invoice (dated 23 July 1993) that is said to relate to the sale of footwear before the material
date. However even if the opponents' use on clothing is accepted as a basis for the Section 11
25 objection it would not assist them in the light of my views on the marks themselves. This
ground also fails.

For the sake of completeness I should also say that in the event that an appeal tribunal takes a
different view of the marks and overturns my decision I take the view that the applicants
30 would have no defence to the Section 11 and 12(1) objections on the basis of honest
concurrent use (Section 12(2)). Mr Levy makes no claim to use on footwear (paragraph 3 of
his declaration of 30 June 1997 at exhibit DL/2).

35 As the opposition has failed the applicants are entitled to a contribution towards their costs. I
order the opponents to pay them the sum of £635. This sum is to be paid within seven days of
the end of the appeal period or within seven days of the final determination of this case if any
appeal against this decision is unsuccessful.

40 **Dated this 14 day of November 2000**

45 **M REYNOLDS**
For the Registrar
the Comptroller-General