

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2140147
BY PEACOCKS STORES LIMITED
TO REGISTER A MARK IN CLASS 25**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 48077 BY PARFUMS ROCHAS**

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DECISION

On 25 July 1997 Peacocks Stores Limited applied to register the following mark in Class 25



Une Femme

for a specification of goods which reads:

“Articles of clothing, footwear, headgear; formalwear for women; including skirts, blouses, knitwear, jackets, trousers; casualwear for women, including skirts, blouses, trousers, sportswear, jackets, shorts, T-shirts; lingerie; including bras, briefs, vests, boxers; nightwear for women; including nightshirts, dressing gowns, pyjamas; all the aforesaid goods being for women and/or girls.”

The application is numbered 2140147.

On 20 January 1998 Parfums Rochas filed notice of opposition to this application. The grounds are in summary:

- (i) under Section 5(2) having regard to a registration standing in the name of the opponents (see below for details)
- (ii) under Section 5(3) having regard to the reputation acquired by their mark

(iii) under Section 5(4) in that the opponents have used their trade mark in relation to clothing and this taken with their reputation in the field of perfumes gives them an earlier right protectable under the provisions of this Section.

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Details of the registration referred to above are as follows:

No.	Mark	Class	Journal	Specification
10	861159	3	4741/1115	Perfumes

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The applicants filed a counterstatement denying the above grounds.

Both sides ask for an award of costs in their favour.

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Only the opponents filed evidence. Neither side has requested a hearing. Acting on behalf of the Registrar and after a careful study of the papers I give this decision. In doing so I also take into account Forrester Ketley's (attorneys for the applicants) letter of 19 November 1998 commenting on the opponent's evidence.

Opponents' evidence

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The opponents filed a declaration dated 1 September 1998 by Georges Philippe Zambeaux, their General Counsel. He says that the opponents have used their trade mark FEMME in the United Kingdom since 1948 in relation to perfume and perfumery products. In particular, the trade mark FEMME has been used on perfume, toilet water, body lotion, soap, talcum powder and bath foam.

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Sales of perfumery products are said to have been on an increasing scale since 1948 when use in the United Kingdom first started and sales figures in recent years have been as follows:

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<u>YEAR</u>	<u>£</u>
1992	221 709
1993	199 765
1994	299 773
1995	263 487
1996	347 750
1997	390 617

45

These sales figures represent unit sales amounting to:-

	<u>YEAR</u>	<u>UNITS</u>
5	1992	16 144
	1993	12 829
	1994	26 101
	1995	34 496
	1996	63 830
10	1997	64 392

Sales are made in the United Kingdom through distributors and wholesalers.

In support of the above Mr Zambeaux exhibits

- 15
- GPZ1 - a brochure showing use of the trade mark in relation to perfumery products
- 20
- GPZ2 - a booklet issued in 1994 to celebrate the 50th anniversary since first use of the mark in France
- GPZ3 - magazine advertisements for the company's products
- 25
- GPZ4 - sample packaging used in relation to perfumery products
- GPZ5 - a selection of invoices showing articles of clothing sold under the mark FEMME to the United Kingdom (such use is said to have commenced in 1996). The specific items of clothing sold include jackets, trousers, shirts, dresses, blouses, stoles, coats, suits and waistcoats

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Mr Zambeaux concludes by saying

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“This expansion of the product range is in conformity with the general practice in the luxury fashion field where a great number of Houses are well known in the field of not only *haute couture* fashion, but also perfume. Among such Houses are internationally famous names such as *Dior, Yves Saint Laurent, Calvin Klein, Chanel, Ralph Lauren* and others.

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The practice of traders in luxury goods to sell both fashion and perfume is very well known among the general public and in the case of a famous trade mark such as FEMME any sales of clothing made under the same or very similar trade mark would be assumed to come from the opponent in the light of its considerable reputation in this field.”

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That concludes my review of the evidence.

The relevant Sections of the Act read

5. - (1)

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

- 5 (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,

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

(3) A trade mark which -

- 15 (a) is identical with or similar to an earlier trade mark, and
(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

20 shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

25 (4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

- 30 (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or
(b) by virtue of an earlier right other than those referred to in subsections (1) to (3) of paragraph (a) above, in particular by virtue of the law of
35 copyright, design right or registered designs.

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.

40 I should preface my decision by saying that, as no hearing has taken place, I have not had the benefit of submissions from the parties as to how the facts of the case as established by the evidence relate to the grounds of objection and the provisions of the Act. However it is, I think, clear that an action under Section 5(2) and 5(3) can only be based on an earlier trade mark. The opponents’ only claim in this respect is registration no. 861159. I take the view
45 that for Section 5(2) and 5(3) purposes I must disregard any common law rights the opponents lay claim to in respect of clothing and goods in Class 3 which fall outside the specification of registration no. 861159. Any common law rights in respect of these goods are

taken into account in my consideration of the Section 5(4) position.

I will deal with the Section 5(2) ground first. As the mark applied for is not identical to the opponents' earlier trade mark (no. 861159) the matter falls to be considered under sub-paragraph (b).

The proper approach to the matter has been set out by the European Court of Justice in number of recent cases, including Canon v MGM (1999 ETMR 1). The following passage from that case is relevant:

“17. A global assessment of the likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between the goods or services. Accordingly, a lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the marks, and vice versa. The interdependence of these factors is expressly mentioned in the tenth recital of the preamble to the Directive, which states that it is indispensable to give an interpretation of the concept of the likelihood of confusion, the appreciation of which depends, in particular, on the recognition of the trade mark on the market and the degree of similarity between the mark and the sign and between the goods or services identified.

18. Furthermore, according to the case law of the Court, the more distinctive the earlier mark, the greater will be the risk of confusion, (SABEL. paragraph 24). Since protection of a trade mark depends, in accordance with Article 4(1)(b) of the Directive, on there being a likelihood of confusion, marks with a highly distinctive character, either per se or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character.”

The opponents' earlier trade mark is the word FEMME. It is represented in a slightly stylised form but nothing in my view turns on the small degree of stylisation arising from the script form used. The applicants' mark is the composite one shown at the start of this decision consisting of the words UNE FEMME and a device of what might be flowers or simply a complex abstract form.

The above test requires me to consider the character of the earlier trade mark both in terms of its inherent qualities and the reputation it possesses on the market. Evidence has been filed which shows use since 1948 and which reached almost £350,000 in 1996. That might suggest that the mark has some enhanced degree of distinctive character. However, that view needs to be tempered firstly by the fact that the word is almost invariably used in close association with the word ROCHAS; and secondly because in terms of its inherent characteristics it is in my view only a weakly distinctive mark, FEMME being the French word for woman, a point which would not, I think, be lost on even those with only a rudimentary knowledge of the language. Used in relation to perfumes designed to create feminine appeal there cannot be said to be any significant degree of invention involved. Whilst the opponents may have educated the public to see the word FEMME as a trade mark or part of a trade mark the difficulty they faced in so doing can be demonstrated by the fact that one of the male fragrances illustrated in Exhibit GPZ1 is labelled “EAU de ROCHAS pour HOMME” where I

take the reference to “pour HOMME” (for men) to be no more than a description of the target audience. I bear these points in mind, therefore, in considering the distinctive character to be attributed to the mark and the degree of protection to be accorded it.

5 The applicants’ goods, women’s and girls’ clothing, are self evidently different from perfumes
taking account of the criteria in *British Sugar Plc v James Robertson & Sons Ltd* (the *TREAT*
case), 1996 RPC 281 at page 296 et seq. But it is well established (*Canon v MGM* above and
10 *BALMORAL Trade Mark* 1999 RPC 297) that an objection under Section 5(2) raises a single
composite question. Thus I have to come to a view as to whether there are similarities (in
terms of marks and goods) which would combine to create a likelihood of confusion if the
earlier trade mark and that presented for registration were used concurrently in relation to the
goods concerned. Applying this test I have come to the clear view that there is no likelihood
of confusion on the part of the public if the applicants’ mark is registered. The opposition fails
under Section 5(2)(b).

15 Section 5(3) prohibits the registration of a trade mark which is identical or similar to an earlier
trade mark where dissimilar goods or services are involved and where one or more of the
adverse consequences identified in the Section has been established. In approaching this
matter I bear in mind guidance from Geoffrey Hobbs QC sitting as the Appointed Person in
20 *CORGI Trade Mark*, 1999 RPC 549 and *Visa International Service Association v CA Sheimer*
(M) Sdn Bhd (unreported at the time of writing but dated 28 September 1999) in relation to
Opposition No. 43886 and application no. 2012498. The European Court of Justice has also
given guidance particularly as regards the construction to be placed on the term ‘reputation’ -
see *General Motors Corporation v Yplon SA* (the *CHEVY* case) C-375/97. Finally, in
25 relation to the issues of unfair advantage and/or detriment I have regard to *Oasis Stores Ltd’s*
Trade Mark application (the *EVEREADY* case), 1998 RPC 631 and *AUDI-MED Trade Mark*
1998 RPC 863.

30 In the light of my finding under Section 5(2) I accept that the applicants’ goods are not similar
to the goods for which the earlier trade mark is protected. Sub paragraph (b) of Section 5(3)
is, therefore satisfied. So far as sub-paragraph (a) is concerned the applicants’ mark
incorporates the whole of the opponents’ earlier trade mark. The word FEMME is preceded
by the French indefinite article and the words appear under a device. Given the weakly
distinctive inherent characteristics of the word FEMME and the consequentially heightened
35 significance of the device in the applicants’ mark it is not without hesitation that I have come
to the view that the marks are similar.

40 The opponents must still of course establish that their earlier trade mark has a reputation. The
guidance given in this respect by the ECJ in the *CHEVY* case is as follows:

“The public, amongst which the earlier trade mark must have acquired a reputation is
that concerned by that trade mark. That is to say, depending on the product or
service marketed, either the public at large or a more specialised public, for example
traders in a specific sector.

45 It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive
that the trade mark must be known by a given percentage of the public so defined.

The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

5 In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.”

(Paras 24 to 27)

10 Although there is a suggestion in the opponents’ evidence that they regard themselves as being a luxury fashion house there is no independent evidence to this effect and a comparison of the units sold/turnover figures does not suggest a particularly high unit value for the goods though the true picture is possibly obscured by the inclusion in the figures of the cheaper perfumery products (soap, talcum powder, bath foam etc.) referred to in the evidence in addition to the perfumes of the registration.

15 Making the best I can of the evidence before me I am inclined to accept that the opponents have some reputation in the mark FEMME as a result of the use made of it. The extent of that reputation is difficult to judge because the mark is normally used in association with the housemark ROCHAS. Moreover there is little in the evidence to guide me on the size of the market; the brand’s position in that market; and the extent of recognition by the relevant part of the public. On that basis I am not satisfied that the opponents have sufficiently substantiated a reputation within the terms of the guidance provided in the CHEVY case.

20 However, even if I am found to be wrong on this point it is still incumbent on the opponents to satisfy me that use of the later mark would have any of the detrimental consequences set out in Section 5(3). The opponents have not particularised or explained their concerns apart from in the broadest possible terms by reference to the wording of the Act. They do not, so far as I can see, claim that the applicants set out to take unfair advantage of their mark or that inadvertently such a consequence would come about.

25 In Audi-Med Trade Mark the Hearing Officer said

35 “Any use of the same or similar mark for dissimilar goods or services is, to some extent, liable to dilute the distinctiveness of the earlier mark. The provision is clearly not intended to have the sweeping effect of preventing the registration of any mark which is the same as, or similar to a trade mark with a reputation. It therefore appears to be a matter of degree.”

40 He went on to suggest a number of criteria that should be considered. These were the similarity of the respective marks; the inherent distinctiveness of the earlier trade mark; the extent of the reputation that the earlier mark enjoys; the range of goods or services for which the earlier mark enjoys a reputation; the uniqueness or otherwise of the mark in the market place; whether the respective goods/services, although dissimilar, are in some way related or likely to be sold through the same outlets; and whether the earlier mark will be any less distinctive for the goods/services for which it has a reputation than it was before.

I have already indicated that I find the marks to be similar but not strongly so mainly because the earlier trade mark is not an inherently distinctive one and is usually associated with the house mark. The extent of the reputation is difficult to gauge but is certainly limited in scope to perfumes (these being the only goods in respect of which 'earlier trade mark' status can be claimed). No evidence is before me as to whether other traders use the mark but that is unlikely to be a conclusive consideration given the nature of the mark. The most that can be said in the opponents' favour is that the respective goods might be said to come under the general heading of fashion items and to that extent could meet at a retail level. However, taking all these factors into account the opponents' mark will not in my view be any less distinctive for the goods for which it has a reputation than it was before. The opposition thus fails under Section 5(3).

Finally there is the objection under Section 5(4). The opponents have not specified the earlier right claimed but I assume they base their objection on the law of passing off.

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

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

- (1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and
- (3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive literal definition of 'passing off', and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House."

Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

I have commented above on the nature and extent of the opponents’ reputation based on the evidence of use in relation to perfumes and perfumery products. The opponents also say that their reputation extends beyond the perfumery field in line with the practice of traders in luxury goods who sell both perfumery and fashion clothing. Organisations such as Yves Saint Laurent, Calvin Klein and Ralph Lauren are cited as examples of this practice.

The link between clothing and perfumery within the context of the trade of leading fashion houses has been considered in a number of cases. There is support for the general proposition in, for instance, ETERNITY Trade Mark case 1997 RPC 155 where Calvin Klein Cosmetics Corporation opposed the mark ETERNITY in respect of clothing on the basis of their established trade in toiletries and cosmetics under the mark ETERNITY and the reputation of CALVIN KLEIN in designer clothing. The Hearing Officer held that:

“ETERNITY is very well known in relation to fragrances at the relevant date and the same purchasers of such goods will be the purchasers of items of clothing in department stores and fashion shops and it is easy to see that such purchasers would have “cause to wonder” as to the origin of the goods.”

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Arising from this it seems to me that it is not uncommon for large fashion houses to extend their brands across a range of luxury goods. But equally there is no absolute presumption that individual traders will necessarily follow this practice and adopt what was originally a clothing mark in relation to perfumery or vice versa. The precise circumstances and activities of individual traders will vary and each case needs to be considered on its own evidence. On the whole it seems to me more likely that housemarks or designer names will be used to establish the common trade source of goods rather than sub-brands (though the ETERNITY case, where Calvin Klein had extensive use in both goods areas, suggests that it is by no means impossible to make the case based on a sub-brand).

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It must also be borne in mind that the ETERNITY case was decided under Section 11 of the Trade Marks Act 1938 where establishing that consumers might have ‘cause to wonder’ was sufficient to found a successful action. The test under Section 5(4)(a) imposes a more onerous requirement on an opponent.

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I have already indicated that I take the view that the opponents have established a reputation in the marks FEMME or FEMME ROCHAS for perfumes and perfumery products on the basis of their use since 1948 in this county. It is well established (see for instance LEGO system A/S v Lego M Lemelstrich Ltd 1983 FSR 155) that there is no limitation in respect to the parties’ fields of activity in an action of this kind. However, the nature and extent of the opponents’ use is a relevant consideration and the proximity of the applicants’ field of activity to that of the opponents is material in considering whether there is or is likely to be any misrepresentation (again see the LEGO case). I, therefore, go on to consider the effect of the opponents’ use on clothing on the issues of reputation and misrepresentation. On the basis of the evidence before me I conclude as follows:

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- use on clothing started in 1996

- the only specific evidence of this trade are the invoices at GPZ5

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- the invoices have various identifiers or references on them. Some refer to “Ready to wear Rochas”, others to those words in conjunction with “Spring/Summer 1996 Femme” (or similar)

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- all of the clothing invoices are addressed to what I take to be two shops in Old Bond Street, London

- no overall turnover or promotional expenditure is given

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- no clothing is exhibited so I cannot determine what mark or marks were applied to the goods when they were offered for sale. I infer that some sales must have been made because the collection of invoices suggests a process of reordering

It seems to me that this evidence is rather thin. I am not persuaded that it properly substantiates the claim to a more broadly based reputation for fashion goods in general or clothing in particular.

5 As noted in the above passage from Halsbury whilst it is sometimes necessary to consider the
issues of reputation and misrepresentation as separate issues ultimately it is a single question
of fact. Taking account of the respective marks and the nature and extent of the reputation
established by the opponents I do not consider that a substantial number of members of the
public would be misled into purchasing the applicants' goods in the belief that they were the
10 opponents' or that the opponents would suffer any other form of damage (the opponents
themselves do not point specifically to any other adverse consequences). Therefore the
Section 5(4)(a) ground, fails.

15 As the applicants have been successful they are entitled to a contribution towards their costs.
I order the opponents to pay the applicants the sum of £235.

Dated this 10 day of December 1999

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25 **M REYNOLDS**
For the Registrar
the Comptroller General