

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2007429
BY SUTTON PUBLISHING LIMITED TO REGISTER A MARK
IN CLASSES 16 AND 41**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No 44158
BY BROOKS BROTHERS INC**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2007429
by Sutton Publishing Limited to register a mark
in Classes 16 and 41**

and

**IN THE MATTER OF Opposition thereto under No 44158
by Brooks Brothers Inc**

DECISION

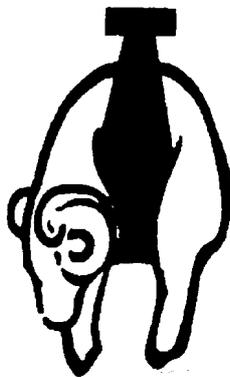
1. On 10 January 1995 Sutton Publishing Limited applied to register the mark shown below for:

Class 16:

Printed matter; books; printed publications; instructional and teaching materials.

Class 41:

Library services; publishing.



2. The application is numbered 2007429.

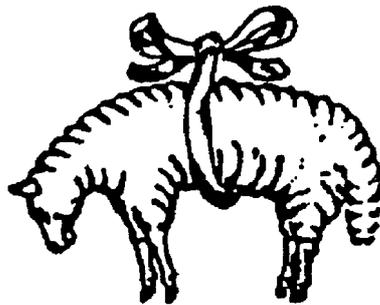
3. On 20 February 1996 Brooks Brothers Inc filed notice of opposition to this application.

4. The opponents say they are retailers both by way of stores and catalogues of goods which include printed matter, books and printed publications and they publish catalogues. They are also the proprietors of registration No. 1132358 for the words GOLDEN FLEECE in

combination with a device which is sometimes referred to as the "Hanging Lamb device" and at other times the "Golden Fleece device". I have used both terms in this decision in relation to the opponents' mark.

This registration is in Class 25 and covers "Articles of clothing for men, women and boys".

The mark is as follows:



"GOLDEN FLEECE"

5. The opponents go on to say that they have supplied mail order catalogues to the United Kingdom since at least 1991 and the catalogues have included printed matter, books and printed publications. Several catalogues have borne the "Hanging Lamb Device" on the front cover. They are also said to have made significant use of the "Hanging Lamb Device" in the USA, Japan and elsewhere and believe that the said device has acquired a substantial reputation not only in the USA but also in the United Kingdom. Sales have also been made via the Internet. They also say they own copyright in the hanging lamb device.

6. As a result of all this objections are taken under Section 5(2)(b), 5(3), (4)(a) and (4)(b) (see below in relation to the latter).

7. The opponents seek refusal of the application or amendment of the goods to remove any possible confusion.

8. The applicants filed a counterstatement denying the above grounds. Both sides ask for an award of costs in their favour. Both sides filed evidence. The matter came to be heard on 25 September 2001 when the applicants were represented by Mr R Price of Taylor Joynson Garrett instructed by Marks & Clerk and the opponents by Mr J Stobbs of Boulton Wade Tennant.

Opponents' evidence

9. The opponents filed an affidavit by Clive Coombes, Vice President of Overseas Development of Brooks Brothers. At the time of giving his affidavit he had been employed by Brooks Brothers for one year but previously was director of store operations and marketing for Marks and Spencer's operations in North America. Marks and Spencer is the corporate

parent of Brooks Brothers. For the purposes of his evidence he confirms he has reviewed the Brooks Brother's archives.

10. Much of the first part of Mr Coombes' affidavit is directed to the introduction of archive material (Exhibits 1-7) showing use of the Golden Fleece words and device since the mid 1800s. Mr Coombes concludes from this that:

"13. The foregoing archive records maintained by Brooks Brothers show long and continuous use of the hanging lamb design or GOLDEN FLEECE symbol for a wide variety of goods and services, including, as demonstrated below, goods that are in part identical, and in part generally related to the goods for which Sutton Publishing Limited seeks registration. Specifically, as demonstrated below, Brooks Brothers has used in the United Kingdom its hanging lamb design on printed matter, books, printed publications and goods that could be considered instructional and teaching materials since long prior to any date upon which applicant is entitled to rely.

14. Brooks Brothers has used its hanging lamb device (at times referred to as its GOLDEN FLEECE symbol) throughout the world (including the United Kingdom) on a wide variety of goods (including goods in International Class 16)."

11. Mr Coombes goes on to deal with the circumstances and extent to which his company's goods are printed and sold in the UK. These can be summarised as follows:

- (i) newspaper advertisements - for the past 80 years a Brooks Brothers advertisement has appeared in the New York Times, an international newspaper which circulates throughout the world including the UK (sample advertisement at Exhibit 8).
- (ii) retail mail order catalogues - Brooks Brothers provides its customers with charge account services whereby a customer can order goods from a catalogue and charge the same to the customer's account. The card bears the GOLDEN FLEECE symbol (Exhibit 9). Sample products such as diaries and dictionaries are at Exhibit 10.
- (iii) Shop The World by Mail - this company publishes a catalogue under the same name featuring the catalogues of various organisations including Brooks Brothers, Nieman Marcus, The British Museum etc. Brooks Brothers has participated in the 'global program' since 1992 with some 40,000 catalogues being distributed to the UK quarterly (Exhibits 11 and 12).

12. By way of substantiation of the amount of business conducted Mr Coombes says that those customers that hold a Brooks Brothers charge card receive the company's catalogue and 'bill inserts' (advertisements) and he is able to provide a printout (Exhibit 13) of sales outside the US for the years 1985 to 1989. Included in this printout are sales to UK charge card customers to the following value:

	\$
1985	71,815
1986	87,775
1987	83,251
1988	159,118
1989	106,650

13. He explains that these figures do not represent the entire UK database of Brooks Brothers only those UK charge card customers who made purchases in the referenced years. Further it does not include customers who may have used Master Card, Visa or other third party charge accounts. Records for periods prior to 1985 have been purged but UK charge card customers have existed since at least 1976. In support of this are examples of bill inserts (Exhibits 14 to 18) advertising, inter alia, diaries, envelopes and other stationery, a shipping box (Exhibit 19) and a specimen monthly charge account statement (Exhibit 20). All are said to show the hanging lamb device.

14. In addition to charge account customers, company records show sales to other (non-charge) customers in the UK as follows:

	\$
1992/3	10,556
1993/4	18,098
1994/5	29,095
1995/6	34,171
1996/7	33,131

(these are other than persons using third party charge accounts and customers utilising the 'Shop the World' programme).

15. Mr Coombes adds that:

"28. The records of Brooks Brothers sales are not maintained under trademark names. We have no means of determining the gross sales of any particular goods within any particular jurisdiction without examining every single account in that jurisdiction."

Applicants' evidence

16. The applicants filed a statutory declaration by David Richard Hogg, their Managing Director. He joined the company in 1994 and gives evidence on the basis of his own knowledge and as a result of searching company records.

17. The company was incorporated on 18 October 1978 and has traded as book publishers ever since that date. A complete stock list for the year 1983 is provided (Exhibit DRH1). Current and recent lists of new titles published is at DRH2. Total turnover from incorporation to the filing date of the application is estimated to be between £30 million and £35 million with approximately £1 million being spent on advertising. No further breakdown is given. Further material about the company is at Exhibit DRH3 including articles written about the firm.

18. Mr Hogg goes on to describe the reason for the adoption of the hanging sheep device which has been used since 1978

"I understand that the symbol of a hanging sheep or ram was chosen by reason of our location in Gloucestershire, which from medieval times derived its wealth principally from the production of wool. The area still holds that reputation and devices and logos of sheep and lambs and even other hanging lamb devices are used by other businesses within this area and throughout the Cotswolds."

19. An example of company notepaper in use in or about 1979 and showing early use of the mark is at DRH4. In fact there have been slight stylistic variances over the years. A bundle of catalogues for the years 1988 to 1992 is exhibited showing an earlier version of the device. Current use is shown in the 'new books' catalogue of January 1995 and a 1994 Regional Subscription list (DRH6). The mark is used on catalogues, stationery, stocklists etc.as well as on the spine of books (examples at DRH7).

20. The books are sold through bookshops, mail order, via the Internet, through book clubs and academic institutions.

21. That completes my review of the evidence.

Preliminary point

22. Shortly before the hearing the opponents sought leave to amend their statement of grounds to correct what they regarded as a 'slight error'. Their grounds had made reference to Section 4(a) and Section 4(b). The intended references were to Section 5(4)(a) and 5(4)(b). The applicants disputed the opponents' view as to the seriousness of the amendment and suggested it was a fundamental change. I heard submissions on the matter as a preliminary point prior to the hearing of the substantive issues. Briefly the positions taken were as follows. Mr Stobbs, for the opponents, suggested that it was an obvious error; the grounds had been pleaded in numerical order by Section; Section 4(a) and (b) did not exist and objections under 4(1)(a) and (b) made no sense; and that it should have been obvious from the narrative text in the statement of grounds and subsequent evidence that Section 5(4)(a) and (b) were intended. Mr Price, for the applicants, submitted that it was not a minor error; it had gone unspotted for the duration of the case; and that in the light of Mr Hobbs' observations in WILD CHILD, 1998 RPC 455, pleadings needed to be properly particularised.

23. It is regrettable that the error in the original statement of grounds was not noted when the opposition was launched though the Registry was not at that time undertaking a detailed scrutiny of pleadings. The applicants did not take issue with the grounds at the time. I note that the statement of grounds referred to the use made of the opponents' mark and also their ownership of copyright in the 'hanging lamb device'. Those statements were consistent with claims under Section 5(4)(a) and (b). Moreover, as the opponents suggest, there is no obvious or likely ground under Section 4(1)(a) or (b). There is nothing to suggest that the error in the pleadings caused any difficulty to either side during the course of the conduct of the proceedings. The opponents' evidence dealt with their claimed use and the copyright position consistently with the claims being under Section 5(4)(a) and (b). In all the

circumstances I consider the requested amendment to be in the nature of correction of a clerical error and that the opponents are entitled to have the amendment made.

24. Notwithstanding the above Mr Stobbs indicated at the hearing that he would not be pursuing the claim under Section 5(4)(b) nor that under Section 5(2)(b). I need say no more about those grounds. That leaves objections based on Section 5(3) and Section 5(4)(a). Both call for evidence to establish reputation/goodwill. I propose to take the Section 5(4)(a) ground first because in the circumstances of this case it appears to offer the opponents a wider avenue of attack than is available to them under Section 5(3). Further their claimed use brings them into a product area which in my view offers them a rather better prospect of success.

25. Section 5(4)(a) reads:

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

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or
- (b)

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

26. Geoffrey Hobbs QC sitting as the Appointed Person in WILD CHILD, 1998 RPC 455, offered the following guidance on the correct approach:

"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:

- i. that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- ii. 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
- iii. 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 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."

27. 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.

In assessing whether confusion or deception is likely, the court attaches importance to

the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action."

28. Mr Price subjected the opponents' evidence to rigorous analysis and criticism. In doing so he referred me to *Euromarket Designs Inc v Peters and Crate & Barrel Ltd*, 2001 FSR 288, and suggested that the circumstances here were analogous to that case in that the examples of use by the opponents represented a trade in the US rather than the UK. His main criticisms were that the exhibits did not show use of the opponents' device on books etc or clothing in the UK; that the evidence failed to substantiate sales to customers in this country; and that there was no evidence of advertising here. Other criticisms bore on the sparsity of original exhibits and the selective nature of some of the photocopied exhibits. Mr Stobbs, for the opponents, asked me to bear in mind the opponents' reputation in the US and the bearing this had on determining reputation in the UK; the fact that the opponents' sign was a particularly distinctive one; that the evidence showed use on items such as diaries, stationery, personal organisers, dictionaries etc. He suggested that, taking the evidence as a whole, a reputation had been established.

29. The following main points emerge from the evidence in my view:

- the opponents have a long standing stores business in the US (established 1818). The Golden Fleece/hanging lamb device has been widely used in relation to that business both in conjunction with the words Brooks Brothers and as a standalone mark or, less commonly, with the words GOLDEN FLEECE
- the actual form of the device used may have altered slightly over the years but it is still recognisably the same device that is shown, for instance, in the very old invoice at Exhibit 2
- historically Brooks Brothers' business seems to have been as clothing retailers/suppliers. Many of the documents refer to e.g. Brooks Brothers Clothing and Brooks Brothers Clothiers
- at some point other goods started to be offered for sale. I am not clear as to precise dates and the point is not critical but Exhibit 4, for instance, shows a Christmas 'Gifts for Men and Boys' brochure for 1946
- more recent material suggests that the opponents offer for sales items such as luggage, diaries, toiletry kits, manicure sets, pens, wallets, Christmas cards, stationery, valet stands, photo albums, trouser presses, mirrors, leather goods, clocks, cologne (Exhibits 8, 10, 12, 14-18)
- it would appear that the catalogue covers show the hanging lamb device. With a few exceptions it is not possible to say whether the device appears on individual products (the photocopies of catalogue pages are indistinct)

- so far as overseas markets are concerned Brooks Brothers rely mainly on their advertisements in the New York Times and other newspapers (the only exhibits are from the New York Times), catalogue sales to charge card customers and advertisements in the Shop The World by Mail "catalogue of catalogues"
- no circulation figures or other information is given in support of the New York Times advertisements which would enable me to assess exposure in this country. Even if I were to take the view that some copies are likely to be available here four of the sample advertisements relate to clothing, the fifth being in respect of luggage. Any attempt to draw meaningful conclusions beyond this would be mere speculation
- selected pages from Brooks Brothers' catalogues are exhibited (Exhibit 12) primarily to show use in relation to printed matter, (diaries, stationery and the like). These items usually occupy no more than two pages in catalogues which (from the page numbering sequences) appear to run to 50 or more pages. The complete catalogues are not exhibited. I note that the front covers usually show clothing. It is not unreasonable to infer that clothing advertisements made up a large portion of the catalogues
- there is further support for the above inference in Exhibit 11 this being the Brooks Brothers entry in the Shop the World by Mail catalogue. The two examples given concentrate exclusively on Brooks Brothers reputation for clothing reflecting, I assume, the primary content of the catalogue
- print outs have been supplied of Brooks Brothers sales outside the US for the years 1985 to 1989 corresponding to the sales figures given earlier in this decision. I accept that Brooks Brothers have a number of foreign account holders with UK addresses. I do not entirely accept Mr Price's point that these might simply be American citizens living in this country though some may fall into that category. However no information is given on products sold and the opponents concede that they do not keep records in a form that would enable them to produce such information. Nor, of course, is it possible to say whether the sales were under the Brooks Brothers' device mark
- the only examples of products are the 1997 pocket diary and desk diary, a dictionary and a thesaurus (Exhibit 10). The hanging lamb device is shown on the spine of the dictionary and thesaurus and as a repeated pattern on the inside covers. Other marks (publishers' marks) are also present. The diaries use the repeated pattern on the inside covers. The desk diary also features the device as a rather more obvious indicator of origin on the first page. The information on the diaries is largely directed at a US audience. I do not regard that as conclusive of the fact that they were not available to UK customers. But there is simply no evidence that these specific items were purchased by customers in the UK

- the other exhibited items (Nos 14 to 18) in the form of advertising inserts also suffer from the drawback they are not in themselves evidence of a single sale in the UK.

30. Even allowing for Mr Stobbs' submission that I must bear in mind the totality of the evidence I find myself in near complete agreement with Mr Price's analysis of the evidence and the conclusions he asks me to draw.

31. It is not fatal to the opponents' cause under Section 5(4)(a) that they do not have an establishment or place of business in this country. The presence of customers in this country is sufficient to constitute the carrying on of business here to which local goodwill may be attached (*Pete Waterman Ltd & others v CBS United Kingdom Ltd*, 1993 EMLR 27 and *Euromarket Designs Inc v Peters and Crate & Barrel Ltd*, 2001 FSR 288).

32. Mr Stobbs referred me to the *Sheraton* case (unreferenced). If that is *Sheraton Corporation of America v Sheraton Motels Ltd*, 1964 RPC 202, then I do not think it is inconsistent with the later cases. The plaintiffs in the *Sheraton* case owned a chain of hotels in the United States and other countries which they advertised and obtained reservations for in this country. It was held that, whilst the business was primarily conducted abroad they nevertheless had a reputation (and it would seem customers) in this country which could be injured by confusion.

33. I accept that the opponents can claim to have made sales to people with addresses in this country. However the sales values are rather modest and the nature of the goods sold is not identified (or identifiable by the opponents). If any inference at all is possible it is that such sales are more likely to have been of clothing but even then the extent to which the device mark featured (as opposed to, or in addition to, the words *Brooks Brothers*) cannot be ascertained from the evidence. The opponents' evidence is open to further criticisms not dealt with above. There are, for instance, unsubstantiated claims that purchases are also made using third party credit cards. Whether these were purchases in the US by UK citizens or from the UK is not stated (in *Crate & Barrel* Jacob J took the view that the first of these categories did not constitute use of a mark in this country).

34. The evidence as a whole falls a long way short of making out a case under Section 5(4)(a). To the extent that it does establish a trade in this country I am unable (because the opponents are also unable) to say precisely what goods have acquired a goodwill and are known by the distinguishing feature of the hanging lamb device (with or without the words *Brooks Brothers*).

35. As the opponents have failed to establish their position in relation to the first leg of the passing off test there is no need to consider the issues of misrepresentation and damage. I will simply say that the opponents' device is a distinctive one. The applicants' mark shares with it some conceptual similarity notwithstanding that the two are distinguishable on a side by side comparison. The authorities counsel against the latter approach and warn that the eye is not always an accurate recorder of detail. Imperfect recollection would also play a part. However, as I have not been able to identify the goods sold in this country or the mark used, including the effect of the *Brooks Brothers* housemark if present (as seems likely), further

consideration of the misrepresentation point is of limited value. The opposition fails in relation to Section 5(4)(a).

36. The remaining ground of opposition is under Section 5(3). This reads:

"5.(3) A trade mark which -

- (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,

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."

37. In the light of my above findings in relation to the opponents' claim to a reputation in this country it will, I think, be apparent that they are unlikely to succeed under this head. My reasons for believing this to be the case can be briefly stated as follows. Section 5(3) requires the existence of an earlier trade mark as defined by Section 6(1) of the Act. The only basis for this claim is registration no. 1132358, full details of which are shown at the start of this decision. The mark is the opponents' hanging lamb device and the words GOLDEN FLEECE (the device of a sheep is disclaimed). It is registered for a clothing specification.

38. The opponents are required under Section 5(3) to show that the earlier trade mark has a reputation. Guidance on the requirements in respect of reputation were set out in *General Motors Corporation v Yplon SA*, 2000 RPC 572, in paragraphs 23 to 27. Paragraph 26 indicates the standard that must be reached

"26. 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."

39. That is in my view a relatively high threshold. The opponents fail to meet it for the reasons given above. There is also the additional point that my consideration under Section 5(3) must be based on reputation attaching to the mark of the registration. I can find little if any use of the device in association with the words GOLDEN FLEECE. The opponents' case under Section 5(3) is bound to fail. I have not, therefore, needed to consider the other authorities to which I was referred. For the sake of completeness and in the event of an appeal I will simply record the main ones as being *Pfizer Ltd v Eurofood Link (UK) Ltd*, 2001 FSR 17, *Premier Brands UK Ltd v Typhoon Europe Ltd*, 2000 FSR 767, *LOADED Trade Mark*, a decision of Mr S Thorley sitting as the Appointed Person (SRIS reference 0/455/00). It is not, I think disputed that these cases are relevant authorities for the purpose of determining whether the adverse consequences contemplated in Section 5(3) exist. The opposition fails under Section 5(3).

40. As the applicants have been successful they are entitled to a contribution towards their costs. Mr Price asked for an award above the normal scale reflecting the additional work involved in dealing with the late request to amend the opponents' grounds and the fact that two grounds were effectively abandoned at the hearing. I do not regard the former as involving significant additional work. So far as the abandoned grounds are concerned I am not persuaded that the applicants' evidence (which was not in any case very extensive) would have been significantly different if the grounds under Section 5(2)(b) and 5(4)(b) had not been present at the outset. I do, however, accept that the applicants needed to devote time to researching the law relating to copyright. Mr Price's skeleton argument dealt with both this ground and also the abandoned Section 5(2)(b) ground. My award, therefore, makes allowance for this.

41. I order the opponents to pay the applicants the sum of £1200. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 18TH day of October 2001

M REYNOLDS
For the Registrar
the Comptroller-General