

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK
Application No. 2057858 to register a trade mark
in the name of Scentura Creations Limited**

**AND IN THE MATTER OF Opposition
No. 46024 by Patrick Cox Designs Limited**

DECISION

1. On 2nd May 2000, Dr. W. J. Trott, a principal hearing officer acting on behalf of the Registrar, rejected an opposition to the registration of trade mark 2057858. The trade mark was applied for by Scentura Creations Limited and is in respect of the trade mark "Wannabee" in Class 3 in respect of perfumes, fragrances and toiletries. The mark was applied for on 22nd February 1996 and was opposed by Patrick Cox Designs Limited (Cox) under section 5(2), section 5(3) and section 5(4) of the Trade Marks Act 1994 on the basis
 - (a) of the registration of an earlier trade mark 1542002 ("Wannabe"), owned by an Italian company, Calzaturificio Ruggeri & Pagnanini SpA, for footwear, shoes, boots, slippers and socks; all for women; all included in class 25 and
 - (b) on the basis of Cox's alleged substantial reputation in the unregistered mark Wannabe for shoes, clothing and bags.

2. Dr. Trott rejected the opposition. He held that Cox had established a reputation in the Wannabe mark as being indicative of shoes but he

rejected the contention that there was a similar reputation for clothes in general as at the application date.

3. On the basis of this finding as to reputation, he went on to consider the question of misrepresentation for the purposes of the law of passing off and concluded that the relevant fields of activity, shoes as opposed to perfumes, were too far apart for any relevant association to be made. He thus held that the objection under section 5(4) failed.
4. So far as concerns the objection under section 5(2)(b), he held that the registration in respect of footwear, shoes, boots, slippers and socks; all for women was not similar enough to perfumes, fragrances, and toiletries for the obvious similarities between the two marks to give rise to the required confusion and therefore rejected the opposition based on section 5(2).
5. Finally he rejected the section 5(3) objection on the basis that no reputation had been shown in the registered trade mark, the property of the Italian company, who were not a party to proceedings; the only reputation that had been shown was by Cox's dealings in shoes which were not limited to ladies shoes.
6. The Opponents gave the requisite Notice of Appeal to the Appointed Person and filed a fully reasoned Notice of Appeal.

Additional Objection under Section 3(6)

7. Paragraph 18 of the Grounds of Appeal sought permission to amend the Statement of Grounds of Opposition to include an allegation of bad faith pursuant to section 3(6) of the Act on the ground that the applicant had no bona fide intention to use the mark. In support of this, reference was made to the undisputed fact that the applicant had not traded under the Wannabee trade mark for more than four years after the application was made.

8. This application was pursued by Dr. Lawrence on behalf of Cox at the hearing before me. She made it clear that her client did not wish to file any further evidence and was content to rely on the evidence of non use, and indeed of no trade at all, that was before Dr. Trott.

9. In order to meet the possibility that leave to amend might be granted the applicant provided to Cox, a short period before the hearing, some further evidence relating, apparently, to their bona fide intention to use the mark. I did not see this evidence and indicated that I would not consider whether the evidence should be admitted until after I had ruled upon whether the amendment should be allowed. Dr. Lawrence however made it plain that if the amendment was allowed, and the evidence was admitted, she would seek an order for disclosure and for liberty to cross-examine the deponent with the obvious consequence that the hearing would have to be adjourned.

10. At the conclusion of argument on the application, I indicated that I was not prepared to grant leave to amend and that the application for

leave would accordingly be dismissed. My reasons are simple. The application was made very late, well after the hearing before Dr. Trott, when, at that hearing, the material that Dr. Lawrence now seeks to draw to my attention was already before the Registrar. Dr. Lawrence frankly conceded that the reason the matter was not raised before Dr. Trott was that the argument had not occurred to her at that time and that it became more apparent as the time delay increased.

11. In my judgment, it is undesirable that new issues should be raised on appeal save in the most unusual cases. These will, almost inevitably, be in cases where additional material has come to light which was not available to be put before the Registrar. In the present case I am satisfied that the argument, insofar as it should be put forward at all, could and should have been put forward before the Registrar and that it would be a wrong exercise of my discretion to allow it to be put forward now, even if it could be put forward without the possibility of an adjournment. On that basis I refuse the application.

12. I should however point out that the foundation for Dr. Lawrence's attack was that the mark had not been used since the date of application. In his statutory declaration on behalf of the applicant, Christian Nelleman, its managing director, made it plain that he had not heard of Patrick Cox and was not aware that the word Wannabe was used in connection with Cox's footwear at the time that his company decided in 1995 to use the mark Wannabee on perfumes. No application was made to cross examine Mr. Nelleman on this and I fail to see how non-use of an application, made bona fide, during a

period in which the mark is subject to opposition, can render the application made in bad faith.

The Substantive Appeal

13. I was supplied with full skeleton arguments on behalf of both parties and those arguments were fully and carefully developed in oral argument before me. I do not think I do the arguments any injustice by condensing the issues into the following:

(i) There was no substantial dispute as to the law.

(ii) So far as concerns section 5(4), the parties accepted that the law was as stated by Dr. Trott who relied upon the statement of law by Geoffrey Hobbs Q.C., acting as the Appointed Person in *Wild Child* (1998) RPC 455.

(iii) So far as concerns section 5(2), the question of similarity of goods and marks and the likelihood of confusion was to be considered on the basis of a global appreciation as set out in *Sabel BV v. Puma A.G.* (1998) RPC 299.

(iv) Section 5(3) was intended to prevent the "parasitic" use of trade marks so that a non-confusing association could nonetheless cause detriment (see *General Motors Corporation v. Yplon SA* (2000) RPC 572.

(v) The primary area of dispute between the parties was on a question of fact - the extent of the reputation enjoyed by Cox in the Wannabe trade mark.

14. To my mind resolution of this dispute leads directly to a conclusion on this appeal.

15. Mr. Purves, who appeared on behalf of the applicant, supported the findings as to reputation made by Dr. Trott. These are set out in the following passages of his decision

"Patrick Cox is generally used with the Wannabe mark. Though Wannabe is used alone, for example; "Wannabe is probably the most widely copied designer shoe of the decade", there appears to be very significant - and intentional - promotion of Mr. Cox's name as well. I have no doubt that the above mark (a device mark containing both the word Patrick Cox and Wannabe) is indicative of a particular product i.e. shoes. But I do not accept that there was a similar reputation for clothes in general under this mark at the application date". (page 5 lines 20-25).

"This may be the case, but considering the evidence above, however, I think the use the opponents have made of their mark has given them a reputation for shoes under the name Wannabe, but this is always associated in their promotional material with the designer Patrick Cox; the two stand together" (page 6 line 9-12).

"Here the opponents have not established a reputation for clothing. At the relevant date the opponents mark appears to have been a single product mark - at least there is no evidence to the contrary" (page 7 lines 25-27).

16. Dr. Lawrence on the other hand contended that this was an erroneous appreciation of the evidence; as she put it, the evidence as to reputation in shoes by 1996 was enormous. She contended that the mark had achieved a cult status and that it was so well known in the fashion world that everybody in the relevant public knew of the mark and associated the mark Wannabe with Patrick Cox and his fashion business. The nature of Dr. Lawrence's submissions are encapsulated in paragraphs 4.2 - 4.5 of her skeleton which state

4.2. The Patrick Cox WANNABE range was launched in 1993 and quickly acquired the sort of reputation that other designers can only dream of. The July 3 1994 edition of the Sunday Times Magazine describes him as being "catapulted into the footwear stratosphere" and the 25 March 1995 edition of the Sunday Telegraph Magazine as "the most successful independent footwear designer in Britain" whose chief "ticket to recognition has undoubtedly been the Wannabe, now in its fourth season".

4.3. He sold more than 100,000 pairs of WANNABES in 1994 and won Accessory Designer of the Year at the British Fashion Awards. His shoes are described as "standard issue for the cappuccino classes of young, contemporary Britain". His designs "dominate the dance floors of trendy nightclubs, bars and restaurants", worn by "a generation whose insteps have been raised in the high-tech comfort of Adidas and

Reebok" as part of a "Dolce & Gabbana Dolce Vita lifestyle", from the "16-year old disco dollies who travel in from the suburbs to Knightsbridge ladies who lunch".

4.4. *The design of the shops themselves has also added to the aura of the mark; they are decorated with Louis XVI furniture and trappings. As the Sunday Times Magazine put it, open the door of his London SW3 boutique, with its inky-blue felt-lined walls, sisal flooring and opulent furnishings and you are faced with an immediate dilemma; do you shop here or move in?*

4.5. *The shops are so popular he has to employ bouncers and even the bouncers have achieved a certain celebrity status. "Visitors to Chelsea can recognise Cox's Symons Street shop by the restless crowds seemingly permanently camped outside the door". The bags and accessories are distinctive and stylish; it is all about image and style and he has celebrities such as Madonna, Elton John, Sharon Stone and Michael Jackson flocking to his door.*

17. Dr. Lawrence also relies upon the sales figures in the evidence, the "huge number of outlets, many of which are in large department stores", the expert evidence of Mr. Bottomley who was responsible for the business development of the Opponent's business and of Mimi Spencer, the fashion editor of the Evening Standard who wrote a

letter which is exhibited as exhibit AJB9 to Mr. Bottomley's third declaration.

18. In order to resolve this dispute it is necessary to have regard to the actual evidence. Mr. Purves cautioned me to beware in approaching the evidence not to permit my judgment to be affected by what he suggested was a gloss that Dr. Lawrence sought to place on the evidence, particularly he cautioned me to have regard to actual evidence as at the date of application (27th February 1996) and to assess the opinion evidence of Mr. Bottomley against the actual evidence that was served. I believe he is absolutely correct in cautioning me thus. It is the duty of the Registrar and of this tribunal on appeal to assess the weight that can be attached to the actual evidence that is placed before the court. It is not for us to try to assess on the basis of the evidence that has been filed, the strength of evidence which might have been filed had the Opponents sought to do so. The relevant date, for all relevant purposes, is the date of application.

19. Dr. Lawrence sought to contend that in the case of passing off, where there was no use of the mark, it was permissible to take into account evidence occurring after the relevant date so as to show the way in which the reputation would have developed by the time the mark was used. In my judgment this is wrong in law. Section 5(4) postulates a hypothetical passing off action commenced as of the date of application. It is the reputation at that date that has to be assessed and the question of misrepresentation has to be approached on the

basis of a notional and fair use of the mark applied for. If the mark is not used until a later date and at that later date the opponent considers it has a different and more extensive reputation or considers that the way in which the applicant has used the mark is in some respects not the same as a notional and fair use, his recourse is not to alter the approach in a trade mark opposition but to bring such passing off action as he sees fit.

20. With that introduction I shall approach the evidence. I deal first with the concrete evidence. This is contained in paragraphs 8 and 9 of Mr. Bottomley's first declaration. Prior to the date of application, the opponents had sold £12 million worth of shoes worldwide in 1995 and an equivalent quantity in the first 2 months of 1996 (the total figure for 1996 was £13 million). Mr. Bottomley gives evidence that about 25% of this was derived from sales in the U.K. Also during that period some £300,000 was spent on advertisements in worldwide top selling women's fashion and men's fashion magazines with wide circulation in the United Kingdom.

21. The evidence as to the availability is contained in paragraph 6. However that evidence, which refers to more than 250 shops in 31 countries including, in the United Kingdom, major department stores such as Harrods, Selfridges, Dickens & Jones & Liberty's, is given as of the date of his declaration (28th August 1997). It is not given as at 22nd February 1996. Dr. Trott was left to speculate as to the number at that date. Plainly there would be some but neither he nor I can have the slightest idea how many.

22. In support of the alleged breadth of reputation, Mr. Bottomley draws attention to a collection of press cuttings (exhibit AJB2) which he contends provides an indication of the reaction to the products in the marketplace. The first is in Vogue Australia of June/July 1994 which contains an extensive article on Patrick Cox but contains no reference to the trade mark Wannabe at all. The second is in an Italian publication called Vogue Pelle of September 1994 which refers to Patrick Cox's store in Paris and does record the fact that the trade mark Wannabe is to be used on "a young and practical diffusion line", which I understand to be a line of goods produced by a fashion house for the wider market. Save that the Paris store was a success the article gives me no indication as to the recognition of Wannabe shoes.

23. The next article is in the Sunday Times of July 3rd 1994 which focuses on the Patrick Cox store in London which contains the following

"His diffusion line, Wannabe by Patrick Cox, was launched in 1993 and catapulted him into the footwear stratosphere. Last year this simple £80-£100 range, which has spawned a rash of high-street imitators, sold more than 100,000 pairs.... he designs around 30 mens and 60 women styles each season for his Patrick Cox label and 25 for the Wannabe range..... "

Again, this article records the undoubted fact that the shoes were sold and sold successfully but does not greatly assist beyond this.

24. Next, the edition of Time Out of February 22nd- March 1st 1995 contains a further article on Patrick Cox which includes the following:

"The reason for the fuss is a simple, if unprecedented one, Symons Street is London home to shoe designer Patrick Cox's infinitely desirable creations. In particular it is here that his diffusion range comprising the Wannabe loafer - a simple square-toed design which costs £85.00-£100.00 and comes in a multitude of fabrics and all the colours of the rainbow can be found in all its glory..... he is, he says, currently "in a big panic", looking for a suitable site for a second store. This will house the entire Wannabe collection which now includes not only the shoes but also rucksacks, filofaxes and a small collection of outerwear as well as a second diffusion range, featuring reinterpreted trainers (all jewel-coloured satins with go-faster stripes and, for women, a cut away heel) which arrives in the shop this month....."

"Cox says that the reasons for the success of the Wannabe loafer are threefold.

First"

"Then there is the whole cult status that's become part of it. I think that when English fashion works, it transcends normal fashion."

"Finally, there is the price. Patrick Cox's mainline collection costs anywhere between £120 and £400. It is more classical than the Wannabe collection"

25. This undoubtedly supports the contention that the Wannabe range has been successful but one has to note that the suggestion of a cult status comes from the mouth of Patrick Cox himself.
26. Finally, there is an article in the Telegraph Magazine of 25th March 1995 which makes the point that Patrick Cox is already the most successful independent footwear designer in Britain and that its chief ticket to recognition has been the Wannabe loafer. It goes on to record that purpose built Wannabe stores stocking his newly launched accessory and outerwear lines are planned in London, Paris and New York
27. Taken as a whole, these magazines go some way to showing that the Wannabe range of loafer has been a success, possibly a significant success, but in my judgment it does not go as far as Mr. Bottomley contends in his declaration when he states in paragraph 2

"The opponents have acquired in a relatively short time an enormous goodwill and reputation around the world in the mark Wannabe for shoes, clothing and bags, belts, diaries, wallets and the like. The Wannabe goods have managed to take an enviable market position and are recognised as a brand leader in the retail shoe market. Their designer, Patrick Cox, has himself achieved a certain level of fame and there is a huge public awareness of both the designer and the goods in the marketplace. This is due in part to a substantial advertising campaign of the products in top

fashion magazines and publications but mainly, I believe, it is the phenomenal success and broad range of appeal of the designs and goods themselves. In particular, the Wannabe logo, which was designed about 4 years ago by Patrick Cox, has become extremely popular and is a much sought after item by the fashion conscious and has been remarked upon and worn by a number of well known celebrities".

28. Opinion evidence of this nature, given by a representative of the Opponents, has to be judged on the basis of the underlying material put forward in support. I regard the evidence put forward in support as being slight. The sales figures speak for themselves but it is hard to place them in context without having details of the overall sales figures for shoes within this country and indeed of sales figures of this type of shoe at the price commanded by the Wannabe shoes. Equally the advertising prior to February 1996 was not on a large scale and it is not possible to put it into context. The articles relied upon plainly show a public awareness of the shoes as being a high quality and popular item. But evidence of this nature cannot serve to elevate the trade mark Wannabe to the levels contended for by Dr. Lawrence in her skeleton or by Mr. Bottomley in paragraph 2.

29. In paragraph 11 of his first declaration Mr. Bottomley turns to the potential connection between the fashion business and that of perfumery. He quotes well known examples such as Tommy Hilfiger, Hugo Boss, Channel, Yves St.Laurent, Ralph Lauren,

Versace, Armani and Calvin Klein. On basis of this, he states his belief that "if perfumes and ancillary products were sold under the name Wannabe, customers and potential customers would assume that they were part of the opponents Wannabe clothing, shoes and other goods range or that there was an association with the opponents".

30. Whilst that may be in the case of the well known examples quoted by Mr. Bottomley, I have to assess the question on the facts of this case and cannot be swayed by the fact that in other cases the reputation of a fashion house might be so well known that perfumes would be assumed to be associated with them.

31. It is in this respect that Mr. Bottomley in his third declaration produces as exhibit AJB9 a copy of a letter that he has received from Mimi Spencer, the fashion editor of the London Evening Standard dated 29th March 1999. The substantive part of that letter reads as follows;

"The Wannabe name has been inextricably linked with that of Patrick Cox for many years. Within the fashion world, it is usual to refer to Cox's loafer shoes as "Wannabe's" thus making the two names synomous. The notion of a different company using the name for their product - particularly in an area affiliated to the fashion industry, particularly in an area in which Patrick Cox himself may seek to do business in the future - seems to be faintly ludicrous. Wannabe is

deemed to be a Cox trade mark, and anything bearing the name will be thought of as a Cox product".

32. Dr. Trott did not think that he could place much weight on this evidence since it was three years after the relevant date and is essentially hearsay.

33. As to the latter, I do not believe this is a valid objection to placing weight on the contents of the letter. There was no suggestion that the letter represented anything other than the genuine views of the writer. The fact that it was three years after the relevant date is however plainly important as I must assess the position as at 1996. Ms. Spencer does state that the Wannabe name has been linked with that of Patrick Cox for many years which would not be inconsistent with a reputation in the name Wannabe connected with Patrick Cox in 1996 but this is a conclusion which Dr. Trott had come to on the basis of other evidence. The remainder of the letter is of little or no assistance. Ms. Spencer does not identify the areas affiliated to the fashion industry that she is considering nor does she give any reasons why those particular areas are affiliated to the fashion industry. She seems to consider that an area in which Patrick Cox himself might seek to do business in the future is a ground for objection. Plainly it cannot be of itself. For these reasons, which differ slightly from those of Dr. Trott, I do not believe that any great weight can be placed upon Ms. Spencer's letter.

34. In truth, when analysed, the evidence here is remarkably thin. Notwithstanding the submissions of Dr. Lawrence I am wholly unpersuaded that Dr. Trott's conclusion as to the strength of the reputation in the trade mark Wannabe as indicating shoes is in anyway at fault. There was a reputation at the relevant date in the trade mark Wannabe as indicating shoes. It was a reputation which connected the mark with Patrick Cox. There was no reputation in clothing in general. It is on the basis of that reputation that I must approach the legal issues.

Section 5(4)

35. The question that falls to be decided is whether or not a notional and fair use by the Applicant of the mark Wannabee on perfume would be likely to lead to relevant confusion between that perfume and the opponent's shoes. There is no evidence that shoe manufacturers as a class have habitually extended their business into that of perfumery. The evidence, such as it is, seeks to draw a comparison between the reputation in Wannabe shoes with that of an established fashion house such as Chanel or Calvin Klein. I do not believe that this is justified in the case of this opponent on the evidence before me.

36. Dr. Lawrence relied before me, as she had before Dr. Trott, on *The Eternity trade mark* (1997) RPC 155. That was a case concerning Calvin Klein's Eternity Perfume where it was established that he had a significant reputation for clothing as well. In my view, Dr. Trott rightly distinguished the facts of that case from those of the present. Dr. Trott concluded that the fields of activity were too far apart for a

conclusion of confusion to arise notwithstanding the undoubted similarity in the marks. In my judgment that was a conclusion that he was fully entitled to reach on the evidence before him and is one with which I agree. The appeal under section 5(4) therefore fails.

37. It must follow from that that the appeal under section 5(2)(b) fails as well. In order to succeed, taking a global view of the evidence, I must be satisfied that the similarity of the marks and the similarity of the goods is such as to give rise to the required confusion, namely confusion as to origin. The marks are substantially the same. The goods are however different and just as this difference is sufficient to negate an inference of likelihood of misrepresentation for the purposes of the law of passing off, so also it must be for the purposes of section 5(2).

38. So far as concerns the appeal under section 5(3), Dr. Lawrence sought to argue that the reputation established by her client in the trade mark Wannabe counted also as the necessary reputation in the registered trade mark owned by the Italian company since the goods sold in this country had been manufactured by the Italian company. I have my doubts that his submission is correct in law but I do not propose to resolve it in this case since, for the reasons given, I am not satisfied that the evidence was sufficient to establish the necessary reputation for a case successfully to be raised under section 5(3). Like Dr. Trott, I do not consider that any use of the Wannabee trade mark on perfumes will be parasitic upon the actual reputation in Wannabe shoes.

39. For all these reasons this appeal will be dismissed. The parties were agreed that I should make an award of costs in favour of the successful party and I propose to order that the Opponent pay to the Applicant a further sum of £800.00 in addition to and on the terms set out in the decision of Dr. Trott.

Simon Thorley Q.C.

6th November 2000