

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2194827
BY MARIA PAPAGEORGIU TO REGISTER A SERIES OF THREE MARKS
IN CLASSES 3 AND 42**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No 50417
BY TONY MARGERIE & ASSOCIATES**

TRADE MARKS ACT 1994

IN THE MATTER OF Application No 2194827

by Maria Papageorgiou to register a series of three marks in Classes 3 and 42

and

IN THE MATTER OF Opposition thereto under

No 50417 by Tony Marterie & Associates

DECISION

1. On 16 April 1999 Maria Papageorgiou of London applied to register the following series of three marks :

BLAST

blast

Blast

2. For goods and services in classes 3, 25 and 42. Following the examination process Class 25 was deleted from the application. The application was published for the following goods and services :

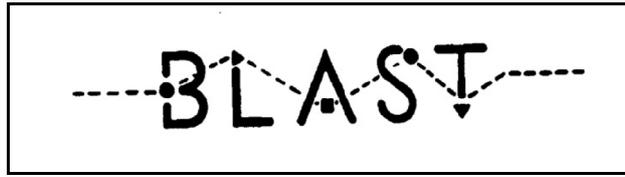
Class 3 : Perfumes; bath preparations; non-medicated toilet preparations; cosmetic preparations; lotions, powders, creams and scrubbing preparations all for use on the skin; face moisturisers and toners; depilatory preparations; deodorants; toilet articles; lip balm; skin and hair masks; preparations for care of the hair; shampoos and hair conditioners; soaps; essential oils; massage preparations; preparations for care of the nails; cosmetics for sun screening; cotton wool and cotton wool buds for cosmetics and toilet use; emery boards.

Class 42 : Beauty salon services; aromatherapy services; skin care treatment services; massage services; beauty treatments; nail care and manicure services; cosmetic treatments; depilatory treatments; hair treatments and hair dressing services; provision of sauna and Turkish bath services.

3. On 18 November 1999 Tony Marterie & Associates of California USA filed notice of opposition to this application.

4. The opponents state that they have two earlier trade mark registrations, namely :

UK Registration : 1356828 Filing Date : 06-09-1988



Class 25 : Articles of clothing included in Class 25 for women and for girls.

CTM Registration : 194712

Filing Date : 01-04-1996

BLAST

Class 9 : Eye glasses, sun glasses and headwear with glasses but not including headgear for cyclists and motorcyclists

Class 18 : Bags, carry-on bags, clutches, shoulder bags, tote bags and travel bags; umbrellas and parasols

Class 25 : Clothing including boots, shoes and slippers and headwear, but not including headgear for cyclists and motorcyclists

5. They say they have made extensive use of these earlier trade marks in the UK. As a result of this objection is said to arise under Section 5(2)(b), 5(3) and 5(4)(a) of the Act.

6. The applicants filed a counterstatement denying the above grounds and both sides asked for an award of costs in their favour.

7. Only the opponents have filed evidence in this case. Both sides were offered the opportunity to be heard, but neither side expressed a wish to do so. The following decision is therefore given after a careful study of the papers filed.

Opponents' Evidence

8. This consists of two statutory declarations dated respectively 20th and 23rd October 2000 from Marc Robin Howard who is the Managing Director of North Coast Industries UK Limited and Emma Louise Pettipher from Boulton Wade Tennant who are the Trade Mark Attorneys acting for the opponents.

9. Turning to the declaration from Mr Howard first, he states that his company has a distributorship agreement with the opponent. He has been employed by his company for five years and has access to all records and is authorised to make the declaration.

Mr Howard states the following :

“From my experience in the clothing and accessories industry, it is my opinion that goods such as spectacles, bags and accessories and clothing are made by the same companies and sold through similar channels of trade to cosmetic preparations. Most designer labels produce the full range of these products, and in today’s market, most consumers would expect a designer label clothing or spectacle manufacturer to produce a corresponding perfume.”

10. He claims that the opponent has a significant reputation in the UK in the trade mark by virtue of its long established use. The mark is claimed to have been first used by the opponent and his company in 1993. Exhibit MRH2 shows correspondence dating from 1993 concerning the trade mark. Exhibit MRH3 shows use of the mark in the context of clothing.

11. Turnover figures for the trade mark are stated as follows :

1995	£700,000
1996	£800,000
1997	£1,000,000
1998	£1,100,000
1999	£1,300,000 (approx)

Figures for 1993 and 1994 are not available. The average cost per item is said to be £15 (at 1999 retail prices).

12. Advertising expenditure is said to have been as follows :

1995	£26,000
1996	£36,000
1997	£46,000
1998	£46,000
1999	£50,000

13. Advertising has been by means of promotional leaflets and displays at exhibitions. Also included in the above is commission to agents.

14. Exhibit MRH4 shows promotional literature.

15. Mr Howard says that clothing bearing the opponents' trade mark has been in wide national circulation since 1993. Bags and other accessories have been sold since 1997. Sales are made through agents and the company "now has approximately 300 separate accounts".

16. The BLAST trade mark, is said to have received considerable press exposure since 1995. Exhibit MRH5 is a copy of a press release dated January 1995. Also included in that exhibit are

examples of articles and adverts which occurred in regional newspapers throughout the country showing use of the BLAST trade mark, including the Cumberland Evening News & Star, The Bristol Evening Post, The Aberdeen Express, The Grimsby Evening Telegraph, The Reading Evening Post and The Herald Express Torquay.

17. In addition the company has advertised in trade publications such as Draper's Record and Womenswear Buyer.

18. The Company also makes a lot of sales through word of mouth transmission and from direct correspondence with individual women in the UK. In addition increased exposure was generated from a free giveaway prize draw run by Euro Communications and Publicity. Exhibit MRH6 consists of dated examples of correspondence relating to that prize draw. Other advertising information is not clearly before the material date in these proceedings.

19. Turning now to Ms Pettipher's declaration, she states that

"In my experience as a registered Trade Mark Attorney, all of the goods of interest to the opponent would be classified as fashion items."

20. She goes on to make a number of assertions and submissions based on this proposition. I will deal with these below.

21. Ms Pettipher also refers to the Eternity Trade Mark case dated 4th September 1996.

22. As the applicant did not avail herself of the opportunity to submit any evidence in this case, and consequently there was no evidence in reply from the opponent, that concludes my review of the evidence.

23. The opponents rely on two registrations both of which constitute earlier trade marks within the meaning of Section 6(1)(a) of the Act. Their CTM registration, No. 194712, is identical to the first mark in the applicant's series of three marks and either identical or closely similar (the opposition is actually expressed as being under Section 5(2)(b)) to the other marks. The CTM also has a broader range of goods than the opponents' UK registration, No. 1356828, and, therefore, offers them a better chance of success. Neither the opponents' statement of grounds, nor their evidence, is of great assistance in translating the two main strands of their evidence (going to their own reputation and the claim that fashion goods companies will offer a range of goods) into consequences in terms of the law. Section 5(2) and 5(3) have been pleaded as alternative positions. Ms Pettipher's evidence suggests that the opponents consider their stronger case is under Section 5(2). I will, therefore, start with that ground. The Section reads

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

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

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

24. The Section raises a single composite question namely whether there are similarities in terms of marks and goods which would combine to create a likelihood of confusion; *BALMORAL Trade Mark*, 1998 RPC 297. Guidance is available from the European Court of Justice in relation to the principles to be applied and in particular through the following cases: *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

25. According to *Sabel v Puma* there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character either per se or because of the use that has been made of it (paragraph 24 of that case).

26. The word *BLAST* seems to me to be an inherently distinctive one in relation to the goods at issue. True it is a dictionary word but it has no obvious relevance to goods in Classes 9, 18 and 25. Has the use made of the mark further enhanced its intrinsic merits? Sales under the mark have been running at about the £1 million p.a. mark over the five year period 1995 to 1999. That is neither an insignificant sum nor in my view is it likely to be particularly large judged by the size of the clothing industry (though I accept the opponents have something of a niche market (see below)). I say the clothing industry because the evidence establishes little if any, usage on goods outside this area. I will return to the opponents' evidence of use in dealing with Sections 5(3) and 5(4) below. Suffice to say at this point that I do not think the usage shown has been on a sufficient scale to further enhance the inherent attributes of the mark. In *DUONEBS*, a decision of Mr S Thorley QC sitting as the Appointed Person in opposition No. 45187 to application No. 2044296 (the decision is dated 2 January 2000) it was said

"In my judgment, I believe what the ECJ had in mind was the sort of mark which by reason of extensive trade had become something of a household name so that the propensity of the public to associate other less similar marks with that mark would be enhanced. I do not believe that ECJ was seeking to introduce into every comparison required by section 5(2), a consideration of the reputation of a particular existing trade mark."

27. I do not think the opponents' can claim an enhanced level of distinctive character for their mark but I acknowledge its inherent strengths.

28. Turning to the goods and services it was held in *CANON v MGM*

"In assessing the similarity of the goods or services concerned... all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their end users and their method of use and whether they are in competition with each other or are complementary..."

29. In *British Sugar Plc v James Robertson & Sons Ltd*, 1996 RPC 281 Jacob J also considered that trade channels should be taken into account.

30. The opponents have not filed written submissions. In their evidence they have not sought to distinguish between the three Classes of their CTM registration or to mount arguments based on particular goods. Ms Pettipher does however, say

"In my experience as a REGISTERED Trade Mark Attorney, all of the goods of interest to the Opponent would be classed as fashion items. As such, they would be manufactured by the same companies that manufacture perfumes and cosmetics and would be sold through similar channels of trade. Therefore, for the purposes of the Trade Marks Act, and interpretation through Case Law (and in particular the ECJ Decision in Sabel v Puma) these goods will be considered similar. As cosmetics and perfumes are often manufactured by the same companies as manufacture goods such as spectacles, luggage and clothing and footwear, there is a likelihood that the same manufacturers or companies would also provide beauty salon services on the basis of their perfumes and cosmetic products and therefore these services should also be considered similar to the goods of interest to the Opponent for the purposes of the Trade Mark Act."

31. I will come back to the opponents' claim in relation to fashion goods labels later in this decision. But as indicated above their trade as set out in the evidence is essentially a clothing business.

32. I have to consider the applicant's goods in Classes 3 and 42 with each of the Classes covered by the opponents' registrations in mind. However in the circumstances of this case and without submissions bearing on particular goods I do not consider that I need to go through an item by item or even Class by Class comparison.

33. I find that the nature of the respective goods and services is in each case quite different. The end users of any consumer goods or fashion items can, at a high level of generality, be said to be the same but beyond that any useful comparison breaks down. Methods of use are self evidently different. Channels of trade too will in general be different. It is true that department stores are likely to sell perfumery and cosmetic items as well as eye glasses, bags and clothing but they are

likely to be in different parts of the store. The respective goods are not in competition with one another and are not obviously or necessarily complementary. At least I am not aware that perfumery or cosmetics are purchased to complement or match other aspects of dress or appearance. It is not akin to the sort of considerations that prevailed in *QS BY S. OLIVER Trade Mark*, 1999 RPC 520, where certain types of bags and purses were regarded as clothing accessories and therefore complementary to the clothing. The applicant's Class 42 services seem to me to be even further removed. It follows that notwithstanding the identity and/or close similarity of the marks and the distinctive character of the mark *BLAST* I am unable to conclude within the context of the composite test that there is any likelihood of confusion. The opposition fails under Section 5(2).

34. Turning to Section 5(4)(a) the conventional test for determining whether the opponents have succeeded under this section has been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC sitting as the Appointed Person, in *WILD CHILD Trade Mark* 1998 RPC 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

- (1) that the opponents' 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 applicant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the applicant are goods or services of the opponents, and
- (3) that the opponents have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the applicant's misrepresentation.

35. The claims made by the opponents are set out in the evidence summary. I consider that the evidence establishes that

- the opponents' trade in the UK is largely, if not exclusively, confined to clothing and is of a modest but not insignificant size
- the opponents appear to target women in the 35 + age bracket and sell through a network of commission agents
- consistent with the latter there is advertising support for the agents predominantly through local newspapers
- wider promotional ambitions are served through exhibiting at trade shows and advertising in the trade press

- more recently (and after the material date) the products have been advertised on a TV shopping channel.

36. The relatively modest size of the business must be seen in the context of the somewhat specialist agent - based business that the opponents operate and the particular customer profile that is targeted. There is some evidence of customer recognition in the correspondence exhibited at MRH6. Although the matter is not beyond dispute I propose to accept for the purposes of what follows that the opponents' goods (ladies' clothing) have acquired a goodwill in the particular market they serve and are known by the distinguishing feature BLAST. I do not accept that the same can be said for goods other than ladies' clothing.

37. It is well established that in the law of passing off there is no limitation in respect of the parties' fields of activity. Nonetheless the proximity of an applicants'/defendants' field of activity to that of the opponents/plaintiffs is relevant as to whether the acts complained of amount to a misrepresentation - see *Lego System A/S v Lego M Lemelstrich Ltd*, 1983 FSR155. The opponents ask me to accept that they operate in the fashion goods area and that it is "very common for perfumes, clothing, luggage and spectacles to be sold under fashion labels". Ms Pettipher gives a number of examples of companies for whom this might be true - Christian Dior, Guess, Moschino, Yves St Laurent, Chanel, Polo/Lauren. There are others. A listing is also provided to demonstrate that companies such as these have registrations spanning (typically) Classes 3, 9, 14, 18 and 25. Whether they use their marks to the full extent of the registrations has not been established by the evidence.

38. I have also been referred to *ETERNITY Trade Mark*, 1997 RPC 155. This was a case decided under Section 11 of the 1938 Act. The headnote records that

"The opponents had launched a wide range of toiletries and cosmetics (including fragrances) under the identical mark ETERNITY in 1989, since when sales had been very substantial, and backed by heavy promotional activity and media interest. Their mark had always been presented in conjunction with the name CALVIN KLEIN, a clothing designer with an extensive reputation. The evidence showed that there was a close link between fashion houses and perfumers and it was common practice for brand names of fragrances to be used on clothing, either alone or in association with the house name."

39. That case was, of course, decided on its own facts. I do not think it is likely to be disputed that there are a number of leading fashion houses who have expanded and diversified from their core activity and use the power of their brand to offer a range of fashion items. It is sometimes referred to as a diffusion range. It does not, however, follow that because this practice exists in one segment of the market (usually I would surmise the top end) that it is a practice universally adopted by all clothing or perfumery companies. The clothing market particularly is a fragmented one with many players large and small. There is no evidence of a general expectation that traders in the clothing field will also produce perfumery/cosmetics/other fashion items or vice versa. On

the contrary I would venture to say that on the whole they are discrete trades. At any rate it is for an opponent who wishes to claim that they have the characteristics of, or are recognised as, a diversified fashion house to support such a claim with evidence. The opponents here have in my view fallen some way short of doing so. There is no evidence to suggest that customer expectation goes beyond clothing. It might also be said that the image they seek to project is not that of a fashion house. Thus the company brochure included in MRH3 contains references such as "The main range is BLAST which provides ladies of 35 plus with co-ordinated, casual clothing that is customer forward rather than fashion forward."

40. The circumstances (and applicable law) are not the same as in the ETERNITY case. For the opponents to succeed I would need to be satisfied that there would be a misrepresentation on the applicant's part that would be likely to lead the public to think that their goods and services were those of the opponents. I do not think I can say that that is the case. The opposition, therefore, fails under Section 5(4).

Section 5(3) 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."

41. 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."

42. That is in my view a relatively high threshold. I am prepared to accept that there is likely to be some awareness and recognition of the opponents' mark in relation to women's clothing. But I cannot with any confidence say that their mark is known by a significant part of the public concerned given the size of the potential market for such goods.

43. There is the further difficulty for the opponents in that they need to satisfy me that use of the applicant's mark would result in one of the adverse consequences contemplated by the Section. There is guidance on the proper approach to this question in a number of cases notably *Premier Brands UK Ltd v Typhoon Europe Ltd*, 2000 FSR 767 and *Re Loaded Trade Mark*, a decision of the Appointed Person under reference 0/455/00. The opponents have not clearly identified the nature of their objection under this head (other than by reference to the wording of the Act). Mr Howard does, however say "I can see no other reason for her [the applicant] to use the BLAST trade mark other than to take advantage of my Company's reputation". The onus lies on the opponents to establish that that is the case (*Loaded and Audi-Med Trade Mark*, 1998 RPC 863).

44. It was held in *Premier Brands v Typhoon Europe* in relation to Section 10(3) which is equivalent in scope to Section 5(3)

"Finally, it is right to mention that section 10(3) is not intended to have the sweeping effect of preventing the use of any sign which is the same, or similar to, a registered trade mark with a reputation; nor is section 10(3) intended to enable the proprietor of a well known registered mark to be able to object as a matter of course to the use of a sign which may remind people of his mark. In at least three decisions in the Trade Mark Registry, it has been held that what section 10(3) is intended to prevent is the use of a sign which exploits the distinctive character or repute of an established trade mark in either or both of the ways contemplated in paragraphs (a) and (b) of that subsection: see *AUDI-MED Trade Mark* [1998] R.P.C. 863; *Oasis Stores Ltd's Trade Mark Application* [1998] R.P.C. 631 and *VISA* (unreported, cited above).¹"

45. I am not persuaded that the opponents have made out any sort of case that might suggest the applicant will gain unfair advantage by riding on the back of whatever existing reputation the opponents can claim. The opponents' position might have been stronger if they had been able to establish that they had a significant reputation as a fashion house with the attendant expectation that might engender in customers or that there was some particular aspect of their reputation that might be damaged if the applicant trades in her chosen area of goods and services. But they have not done so. Even weighing the strength of the mark BLAST in the balance I cannot see that on the basis of the use that has been shown the opponents should be entitled to prevent the applicant registering and using her mark. The opposition fails under Section 5(3) as well.

46. The applicant has been successful and is entitled to a contribution towards her costs. I order the opponents to pay her the sum of £400. 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 the case if any appeal against this decision is unsuccessful.

Dated this 9th day of November 2001

M REYNOLDS
For the Registrar
the Comptroller-General

¹ Since reported in 2000 RPC 484