

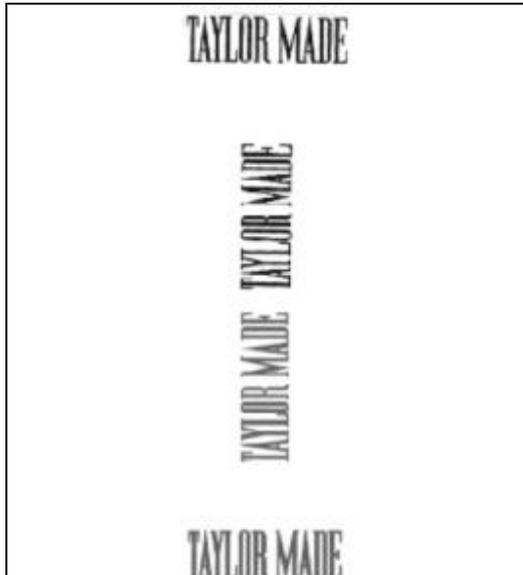
**IN THE MATTER OF APPLICATION
NO. 2252623 BY S.O.S. HAIR
CARE LTD AND IN THE MATTER
OF OPPOSITION NO. 80134
THERE TO BY FINE FRAGRANCES
& COSMETICS LTD**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application
No. 2252623 by S.O.S. Hair Care
Ltd and in the matter of
Opposition No. 80134 by Fine
Fragrances & Cosmetics Ltd**

Background

1. On 14 November 2000, S.O.S. Hair Care Ltd applied to register the following as a series of four trade marks:



with the colour dark blue claimed in the third and fourth marks in the series.

2. The goods covered by the application are:

Personal grooming, bathing, cleansing and beauty products, all being within Class 3; soaps; perfumery, essential oils, cosmetics and hair lotions; all the aforesaid products being non-medicated.

3. The application was accepted and published on 6 June 2001. On 5 September 2001, notice of opposition to the registration was filed on behalf of Fine Fragrances & Cosmetics Ltd. The grounds of opposition are, in summary:

- under S5(1) in that the trade mark is identical with an earlier trade mark and is to be registered for identical goods or services;
- under S5(2)(b) in that the trade mark is similar to an earlier trade mark and is to be registered for goods identical with or similar to those for which the earlier trade mark is protected;
- under S5(3)(a) in that the trade mark is identical with or similar to an earlier trade mark, is to be registered for goods which are not similar to those for which the earlier trade mark is protected and which has a reputation in the United Kingdom and that use of the later mark would take unfair advantage of or be detrimental to the distinctive character or the repute of the earlier trade mark;
- under S5(4)(a) to the extent that use of the trade mark in the United Kingdom is liable to be prevented by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark.

4. The opponent relies on the following United Kingdom trade marks:

1583045 TAYLOR OF LONDON

For: Non-medicated toilet preparations; perfumes; perfume sachets; perfumed paper; potpourri; pomanders containing perfumed preparations and mixtures; essential oils; eau de cologne; toilet water; soaps; talcum powder; preparations for the care and conditioning of the body, skin and scalp; bubble bath, bath gel and shower gel; all included in Class 3 but not including shaving preparations;

2255064 TAYLOR OF LONDON NATURAL PROGRESSION

For: Non-medicated preparations; perfumes; perfume sachets; perfumed paper; potpourri; pomanders containing perfumed preparations and mixtures; essential oils; eau de cologne; toilet water; soaps; talcum powder; hair preparations; preparations for the care and conditioning of the body, skin and scalp; bubble bath, bath gel and shower gel; all included in Class 3;

2255065 TAYLOR OF LONDON SKIN SODA

For: Non-medicated preparations; perfumes; perfume sachets; perfumed paper; potpourri; pomanders containing perfumed preparations and mixtures; essential oils; eau de cologne; toilet water; soaps; talcum powder; preparations for the care and conditioning of the body, skin and scalp; bubble bath, bath gel and shower gel; all included in Class 3;

2255066 TAYLOR OF LONDON NATURE'S AROMATICS

For: Non-medicated preparations; perfumes; perfume sachets; perfumed paper; potpourri; pomanders containing perfumed preparations and mixtures; essential oils; eau de cologne; toilet water; soaps; talcum powder; hair preparations; preparations for the care

and conditioning of the body, skin and scalp; bubble bath, bath gel and shower gel; all included in Class 3;

2255069 TAYLOR OF LONDON BODY FORMULA

For: Non-medicated preparations; perfumes; perfume sachets; perfumed paper; potpourri; pomanders containing perfumed preparations and mixtures; essential oils; eau de cologne; toilet water; soaps; talcum powder; hair preparations; preparations for the care and conditioning of the body, skin and scalp; bubble bath, bath gel and shower gel; all included in Class 3.

5. The applicant filed a counterstatement essentially denying the claims. Both parties seek an award of costs. Only the opponent filed evidence. In line with established practice, the Registry wrote to the parties and advised them that an oral hearing was not required to enable a decision to be made in these proceedings. The parties were reminded of their right to be heard or file written submissions. Neither party requested a hearing and no submissions were filed. I therefore take careful note of the pleadings and evidence filed in reaching this decision.

Opponent's evidence

6. This consists of a statutory declaration of Muriel Bailiwick dated 13 March 2002. Ms Bailiwick states that she is the Company Secretary of Fine Fragrances & Cosmetics Ltd (her company) a post she has held since 1986 and that she is authorised to make the declaration on behalf of the company.

7. Ms Bailiwick refers to her company's trade mark registrations. She gives a brief history of her company and its predecessors in title stating that the mark TAYLOR OF LONDON was first used by them in 1887 and she exhibits a fuller history. She goes on to say her company's products are sold worldwide including some 385 outlets spread throughout the United Kingdom and she exhibits a breakdown of the number of outlets per county and country of the United Kingdom.

8. Sales figures for the years 1991-2002 are given by Ms Bailiwick as:

Year	Sales (£)
1991	623,588
1992	805,198
1993	818,912
1994	878,762
1995	930,956
1996	957,142
1997	1,431,826
1998	1,469,654
1999	1,407,598
2000/01	1,669,976
2001/02	1,128,016 (est)

9. Ms Bailiwick states that her company does not directly advertise its products but that they are made known as a result of the activities of its sales force. Her company also exhibits at the NEC Spring Fair. Ms Bailiwick exhibits brochures and promotional material.

10. Ms Bailiwick contends that her company has acquired a substantial reputation in TAYLOR OF LONDON as a result of substantial and continued use for over 114 years. She says that her company's products are frequently ordered and/or identified by customers as being "made by Taylor of London" and that confusion is likely to arise if the applicant sells an identical or very similar range of toiletries or perfumed products under the mark TAYLOR MADE alongside her TAYLOR OF LONDON range. Confusion is also likely to occur, she says, through oral use.

11. That concludes my review of the evidence.

Preliminary issue

12. The Registry letter to the parties advising them that the case was considered suitable for a decision from the papers and without recourse to a hearing, also made comments on the grounds of opposition. In particular, it was noted that the grounds of opposition under Sections 5(1) and 5(3)(a) were without substance. This is because the respective trade marks are not identical and therefore the S5(1) ground is not applicable. The respective goods of the application and the opponent's marks are either identical or similar and therefore the provisions of S5(3)(a) do not apply. Neither party challenged this preliminary view. I therefore continue on the basis that the opposition is proceeding on the grounds of S5(2)(b) and 5(4)(a) only.

Decision

13. The remaining grounds of opposition are those under S5(2)(b) and S5(4)(a). The relevant provisions of the Act read as follows:

- "5.- (1)
- (2) A trade mark shall not be registered if because-
- (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,
- there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

- (3)
- (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.”

The term “earlier right” is defined in section 6 of the Act as follows:

- “6.- (1) In this Act an “earlier trade mark” means-
- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,”

14. In his statement of grounds the opponent relies on five registrations. Of these five, four, Nos. 2255064, 2255065, 2255066 and 2255069 share an application date of 6 December 2000. This is later than the application date of the mark in suit which is 14 November 2000. No priority dates are claimed and therefore these four registrations are not earlier trade marks within the meaning of the Act. This leaves just one registration, No. 1583045. This has an application date of 26 August 1994 and is an earlier trade mark within the meaning of the Act.

Section 5(2)(b)

15. In determining the question under S5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel v Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *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. It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors: *Sabel BV v Puma AG*, paragraph 22;

- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question: *Sabel BV v Puma AG*, paragraph 23, who is deemed to be reasonably well informed and reasonably circumspect and observant –but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen B. V.* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details: *Sabel BV v Puma AG*, paragraph 23;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki v Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (f) 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; *Sabel BV v Puma Ag*, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*, paragraph 26;
- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG*, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, paragraph 29.

16. Under section 5(2) the test is a composite one, involving a global appreciation taking into account a number of factors. With these comments in mind, I go on to consider the applicant's case under section 5(2)(b).

17. As set out earlier in this decision, the goods covered by the opponent's registration are largely identical to those of the applicant. The applicant's mark is a series of four. All consist of the words TAYLOR MADE; two of the marks being presented horizontally, two vertically. On one of each style of presentation, a limit to the colour dark blue applies. Neither word is distinctive in its own right although there is some distinctiveness in the combination for the goods in question.

18. The opponent's mark consists of the non distinctive words TAYLOR OF LONDON. Both the applicant's and the opponent's marks share a common element, the word TAYLOR which is a common surname. Both marks also contain other words, the single word "MADE" in the applicant's case and the two words "OF LONDON" in the opponent's case. Whilst there is some similarity between the marks in that both share a common beginning, i.e. the word TAYLOR, the remainder of the marks display significant differences. These differences are, I believe, further exaggerated given that the applicant's mark TAYLOR MADE is likely to bring to mind the common phrase TAILOR MADE. The differences between the marks, visually, aurally and conceptually are greater than the similarities between them.

19. The opponent has filed evidence of use of the trade mark and I go on to consider whether the mark has acquired a higher distinctive character through use.

20. The evidence provided by the opponent shows that the mark TAYLOR OF LONDON was first used in 1887 and has been in continuous use since that date. Annual sales figures provided show that sales have increased from around £623k in 1991 to around £1.5m for 1999 and 2000/01. No information is provided to indicate the unit price of any individual item sold under the trade mark, nor what market share these sales represent. The opponent states that no direct advertising takes place, but that products are "made known as a result of the activities of our sales force" and at trade fairs. Brochures and invoices are provided to support this claim but I note that they are either undated or dated after the relevant date. There is no evidence of any advertising to the average consumer, who, I believe, would be ordinary members of the public. I accept that use of such length has resulted in a goodwill under the mark, however in view of the scale of use and the absence of promotion, it would not be safe to assume that the mark is a household name or even approaching it. TAYLOR is a common surname and consequently the average consumer will be less likely to assume that all marks incorporating that name identify goods of one undertaking. Indeed it may be that those aware of such longstanding use by the opponent may be thought to be that much less likely to assume that the applicant's mark is a "new" version of the opponent's mark. In any event, on the basis of the evidence before me, I am unable to find that the trade mark has accrued an enhanced level of distinctiveness through use.

21. Taking all factors into account, I find that there is no likelihood of confusion. The opposition under section 5(2)(b) therefore fails.

Section 5(4)(a)

22. The opponent also seeks to rely on the ground of objection under section 5(4)(a) of the Trade Marks Act 1994. The requirements of this ground of opposition have 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 and can be summarised as follows:

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

23. As I have found that there is no likelihood of confusion, there is no misrepresentation. The case under S5(4)(a) is therefore no better than that under S5(2)(b). The objection under section 5(4)(a) fails.

Conclusion

24. The opposition has failed all on grounds and the applicant is entitled to an award of costs. I order that the opponent pays the applicant the sum of £700 as a contribution towards his costs. 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 10th day of December 2002

Ann Corbett

**For the Registrar
The Comptroller-General**