

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No 2103978  
BY PERKINS HOLDINGS LTD  
TO REGISTER THE TRADE MARKS:**



**IN CLASSES 8, 9, 11, 14, 16, 18, 20, 21, 25, 26 and 28**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER No 49470  
BY DOROTHY PERKINS RETAIL LIMITED**

**TRADE MARKS ACT 1994  
IN THE MATTER OF Application No 2103978  
by Perkins Holdings Limited  
to register the trade marks:**



**in classes 8, 9, 11, 14, 16, 18, 20, 21, 25, 26 and 28  
and  
IN THE MATTER OF Opposition thereto under No 49470  
by Dorothy Perkins Retail Limited**

**Background**

1. On 25 June 1996 Varsity Europe Limited of Peterborough applied to register the above trade marks as a series of three. The applicant claims the colour blue as an element of the third mark of the series. Subsequent to filing, the application was transferred into the name of Perkins Holdings Limited of Peterborough. The application was published with the following specifications:

*Penknives; screw drivers; ice scrapers -class 8*

*Calculators; laser pointers; tape measures; holders for computer discs - class 9*

*Torches for lighting - class 11*

*Clocks; key rings; card holders and pen holders of precious metals; badges of precious metals or coated therewith; cuff links - class 14*

*Atlases; pens and pencils; conference folders; pen holders; albums; playing cards; calendars; rulers; notebooks and pads; business card holders - class 16*

*Card cases; suit carriers; handbags; wallets; belts; key cases; sports bags, umbrellas - class 18*

*Jewellery and trinket cases - class 20*

*Giftware of glass; decanters, rings - class 21*

*Baseball caps, ties, T-shirts, shirts, sweatshirts, sweaters, jackets, trousers - class 25*

*Badges, buttons - class 26*

*Golf balls, golf tees; toys, playthings, puzzles - class 28*

2. On 11 February 1999 Dorothy Perkins Retail Limited filed notice of opposition to this application.

3. The opponent states that he is the registered proprietor of the following United Kingdom trade mark registrations:

- 605318 in respect of the trade mark DOROTHY PERKINS, registered in respect of: *articles of women's clothing, namely underclothing, nightdresses, pyjamas, corsets, corselettes, girdles, brassieres, stockings, dressing gowns, boudoir caps, knitted jumpers, and cardigans, bathing suits bathing wraps, bathing caps, blouses, play suits, sun-bathing garments and tennis shorts* - in class 25
- 623095 in respect of the trade mark DOROTHY PERKINS, registered in respect of: *knitting yarns wholly or principally of wool* - in class 23
- 944980 in respect of the trade mark DOROTHY PERKINS, registered in respect of: *articles of clothing for women and girls, but not including boots, shoes, or slippers* - class 25
- 1522351 in respect of the trade mark DOROTHY PERKINS, registered in respect of: *sunglasses included in Class 9.*
- 1522352 in respect of the trade mark DOROTHY PERKINS, registered in respect of: *jewellery included in Class 14*
- 1522353 in respect of the trade mark DOROTHY PERKINS, registered in respect of: *holdalls, bags, handbags, purses and umbrellas; all included in Class 18*
- 1522354 in respect of the trade mark DOROTHY PERKINS, registered in respect of: *clothing for women and girls; outerwear, coats, blouses, shirts, dresses, skirts, trousers, jackets, knitwear, jerseywear, underwear, nightwear, jeans, hosiery, swimwear and footwear; all included in Class 25*
- 1522355 in respect of the trade mark DOROTHY PERKINS, registered in respect of: *hair slides, hair restraints, barrettes and hair ties; all included in Class 26*
- 2028036 in respect of the trade mark DOROTHY PERKINS, registered in respect of: *cosmetics; perfumes; toiletries, hair care products; products for the care of the nails; dentifrices; soaps; cleaning preparations and substances; skin care products; beauty products* - in class 3

4. He states that he is also the proprietor of Community Trade Mark Registration no 67470 of the trade mark DOROTHY PERKINS, registered in respect of:

*precious metals and their alloys and goods in precious metals or coated therewith; semi-precious and precious stones; horological and other chronometric instruments; watches, clocks, jewellery and imitation jewellery; parts and fittings for all the aforesaid goods* - class 14

*articles of leather and imitations of leather; trunks and travelling bags; travel cases; luggage; suitcases; holdalls; portmanteaux; valises; bags; handbags; shoulder bags; toilet bags; carrier bags; rucksacks; backpacks; bumbags; sports bags; casual bags; briefcases; attaché cases; music*

*cases; satchels; beauty cases; carriers for suits, for shirts and for dresses; tie cases; notecases; notebook holders; document cases and holders; credit card cases and holders; chequebook holders; wallets; purses; umbrellas; parasols; walking sticks; shooting sticks; belts; parts and fittings for all the aforesaid goods - class 18*

*articles of clothing; footwear; boots, shoes, slippers, sandals, trainers, socks and hosiery; headgear; hats; caps; berets; scarves; gloves; mittens; belts (being articles of clothing) - class 25*

5. The opponent claims that the goods in classes 14, 18 and 25 of the application in suit are identical or similar to those encompassed by his earlier registration. He states that owing to the similarity of the respective trade marks and the similarity or identity of the goods registration of the application in suit would be contrary to section 5(2) of the Act.
6. The opponent also states that owing to the reputation of his earlier trade mark registration of the application in suit in relation to non-similar goods would be contrary to section 5(3) of the Act.
7. The opponent also states that use of the application in suit is liable to be prevented by the law of passing off and so would be contrary to Section 5(4) of the Act.
8. The applicant filed a counterstatement denying the above grounds.
9. Both parties seek an award of costs..
10. Both parties filed evidence. They both agreed that a decision could be made on the basis of the papers filed. Consequently a decision will be taken from a careful study of the papers.
11. Acting on behalf of the Registrar I duly give the following decision.

### **Opponent's evidence**

12. The opponent's evidence consists of a statutory declaration dated 18 January 2000 by Michael Arthur Lynd who is a trade mark and patent agent. Mr Lynd states that he has been informed of the information that he gives in his declaration. He does not state by whom he has been informed. Mr Lynd states that the opponent has been trading in the United Kingdom in the clothing trade since 1939 and that the opponent has been trading under the company name of Dorothy Perkins and under the trade mark DOROTHY PERKINS since 1939. He states that the opponent operates stores under the DOROTHY PERKINS trade mark in almost every high street in the United Kingdom. He exhibits as MAL 1 a printout of such stores as at 15 May 1996, which he states shows that there are 543 sites operating under the trade mark DOROTHY PERKINS. (It is to be noted that twelve of these sites are listed as being within the Republic of Ireland.)

13. Mr Lynd exhibits as MAL 2 extracts from sets of accounts for Burton Group plc for 1995, 1996 and 1997. From reports and accounts for 1997 it is indicated that DOROTHY PERKINS stores in 1994 and 1995 had turnovers respectively of £252 million and £248 million. It is to be

noted, however, that the report indicates that this figure includes goods sold under the brands Maternity, Secrets, Girls Unlimited, Lonestar and Vivre as well as DOROTHY PERKINS.

14. Mr Lynd states that turnover figures in relation to goods sold under DOROTHY PERKINS were as follows:

1993/94	£251 million
1994/95	£252 million
1995/96	£251 million
1996/97	£284.2 million

15. Mr Lynd states that in 1994/95 £1,531,000 was spent on advertising and promotion; and in 1995/96 £2,515,000. He exhibits two magazines showing advertising - however, each of the magazines emanates from more than three years after the relevant date and so they do not have a bearing upon the instant proceedings. Mr Lynd refers to promotional expenditure between October and December 1999, and furnishes exhibits relating to this. Again this is more than three years after the relevant date and so has no bearing upon the instant proceedings.

16. Mr Lynd exhibits further promotional material under MAL5 - the earliest material emanates more than two years after the relevant date, so again this material has no bearing upon the instant proceedings.

17. Mr Lynd states that the opponent regularly attends trade fairs and fashion shows. He exhibits as MAL6 a copy of a photograph that he states was taken at the Cosmopolitan Trade Shoe. He states that this was held in May 1996 in the United Kingdom, he does not give the actual location.

### **Applicant's evidence**

18. The applicant's evidence consists of a witness statement dated 18 July 2000 by Nigel Ruffles who is the regional marketing manager Perkins Engines Company Limited (a wholly owned subsidiary of the applicant.) He includes as part of his witness statement a statutory declaration which he made in support of the application. Mr Ruffles states that he is not aware of the stores or goods of DOROTHY PERKINS being referred to as PERKINS. He states that he is not aware of any instances of confusion between the clothing sold by the applicant and that sold by the opponent. Mr Ruffles exhibits, also, a catalogue emanating from 1983 entitled "Perkins POWER COLLECTION". He would seem to exhibit this in response to comments made by Mr Lynd for the opponent in relation to the typefaces used by the respective parties. However, the exhibits that to which Mr Lynd refers emanate from well past the relevant date and so are not relevant in the instant case.

19. Mr Ruffles' statutory declaration is dated 5 May 1998. In this declaration Mr Ruffles states that the trade mark PERKINS was first used in the United Kingdom by the applicant in relation to a broad range of merchandising and promotional products in 1989. He states that PERKINS has been used in respect of the following goods:

hand tools; scrapers; pen knives; cutlery; hand operated jacks

calculators; laser pointers; tape measures; vehicle radios; vehicle warning triangles; holders for discs

torches for lighting; lighters; headlights for automobiles; safety lamps; search lights; vehicle reflectors;

clocks; key rings; cigar boxes; card holders of precious metal or coated therewith.

atlases; pens and pencils; conference folders; pen holders; albums; playing cards; calendars; rulers; notebooks and pads; business card holders

card cases; suit carriers; wallets; belts; briefcases; keycases

glassware; decanters; flasks; coasters; kitchen utensils; bottle openers; corkscrews; chamois leather for cleaning

baseball caps, ties, t-shirts, shirts, sweatshirts

badges; buttons

sporting articles; golfing articles; balls, golf balls, golf tees; toys; playthings; model vehicles; puzzles (games)

20. He states that the total turnover for the five years prior to the date of the filing of the application in suit was approximately £400,000. Mr Ruffles states that in 1995 between £30,000 and £50,000 (approximately) worth of promotional merchandise was held by the applicant. He refers to the position from July 1996, which is after the relevant date and so not relevant to the instant proceedings.

21. He states that the trade mark has been used on all the above goods and that the applicant's distributor sales operations effectively cover the whole of the United Kingdom. Mr Ruffles exhibits a price list from 1991. The rest of his exhibits emanate from after the relevant date. He gives an estimate of sales but these relate to 1997, after the relevant date.

### **Opponent's evidence in reply**

22. The opponent's evidence in reply consists of a further statutory declaration by Mr Lynd. The declaration can be characterised as for the most part representing submissions rather than evidence of fact. The "submissions" where necessary will be dealt with in my decision. An exhibit that Mr Lynd furnished in relation to the core business of the applicant is also dealt with in my decision. I need say no more about the evidence in reply.

### **Opponent's submissions**

23. The opponent states that the application in suit was published on the basis of distinctiveness

acquired through use, the evidence was not filed in relation to section 7(1) of the Act, honest concurrent user. He, therefore, states that section 7(1) should be ignored. The opponent states that it is possible to envisage a situation where although there is confusion between the respective trade marks that because the confusion does not arise through identity/similarity of the respective trade marks or the similarity/identity of the goods section 5(2) would not apply. He states that equally the situation in the market place does not form a reliable guide to deciding the issue of likelihood of confusion under section 5(2).

24. He states that it is clear that the applicant's goods have been sold only through the applicant's distributors. He states that the applicant's distributors are essentially retailers of diesel engines and are by no means "properly" engaged in businesses/goods in any of classes 14, 18 or 25. In relation to this the opponent in his evidence reply exhibited pages from the web site of the applicant. He also in the evidence in reply refers to *Unidoor Ltd v Marks & Spencer Plc* [1998] RPC 275 and *Elvis Presley Enterprises Inc v Sid Shaw Elvisly Yours* [1999] RPC 567. He states that given the very specific and peculiar distribution channels for the applicant's promotional goods it is no wonder that the opponents has not been able to demonstrate actual confusion. He states that it is possible for the applicant, if registration were granted, to open retail outlets by reference to the shop name PERKINS and sell goods in classes 14, 18 and 25. He states that lack of confusion to date is no guide whatsoever in assessing the likelihood of confusion on the basis of equivalent usages of the respective trade marks in the same market places.

25. The opponent refers to *Arsenal Football Club Plc v Matthew Reed* [2001] RPC 922 at paragraph 57:

"The mere fact that the words or designs are used on an item of clothing does not mean that they are used as a trade mark. Mr Thorley accepts that. At Annex VIII to this judgment is a picture of a shirt in the AFC catalogue bearing the word "SEGA". This is the well-known trade mark of the Japanese electronics company of that name. Similarly, during a period when AFC had a commercial relationship with the electronics company JVC, its players wore shirts bearing the letters "JVC". Mr Thorley accepts, rightly in my view, that that sort of use was not use as a trade mark for shirts. As he said, it was a form of advertising for an electronics company."

The opponent states that Mr Ruffles in his declaration refers repeatedly to the products to which the trade mark PERKINS has been applied as being "merchandising and promotional products", "promotional merchandising" and "promotional products". He states that the actual goods being promoted are in relation to the diesel engines which form the core business of the applicant and not the actual items bearing the PERKINS trade mark. He states that this throws into question the legitimacy of the evidence of use filed by the applicant.

26. He states that the applicant agrees in his written submission that the opponent's trade mark does enjoy a reputation. The opponent states that consequently the essential prerequisite for sections 5(3) and 5(4) is present. He states that registration of the application in suit would prevent the opponent legitimately promoting their own business by selling promotional merchandise, which would be detrimental to him and to the distinctive character and repute of the DOROTHY PERKINS trade mark.

## **Applicant's submissions**

27. The applicant states that the application was allowed to proceed to publication by the Registrar on the basis of acquired distinctiveness. He states that in classes 14, 18 and 25 the application in suit has only been published in respect of specific goods.

28. The applicant states that the opponent does not produce any evidence or any explanation to support the grounds of opposition under sections 5(3) and (4). He submits that these grounds of opposition should, therefore, be struck out. He states that the opponent has failed to demonstrate any goodwill or reputation in relation to the trade mark PERKINS solus.

29. He states that he deduces from paragraph 7 of the statutory declaration of Mr Lynd that the opposition is directed solely against the class 25 goods of the application in suit.

30. The applicant states that the opponent does not indicate where in the Trade Marks Act 1994 it is set out that an applicant is required to show that there has been trade mark usage of his trade mark. He submits that the references to trade mark usage are irrelevant to the considerations in the instant proceedings - *Philips Electronics NV v Remington Consumer Products Ltd* [1999] RPC 809 at page 823 line 43 et seq. He states that the *Elvis Presley* case relates to the 1938 Act.

31. The applicant states that he has used his trade mark PERKINS since 1989 in relation to the goods set out in the declaration of Mr Ruffles. He states that, therefore, at the filing date the applicant has been using his trade mark for over six years concurrently with the opponent's trade mark. He states that the opponent has failed to show that there has been one instance of confusion.

32. The applicant refers to the various authorities of the European Court of Justice in relation to the likelihood of confusion - which are dealt with in my decision.

33. The applicant states that it is clear that the earlier trade mark enjoys a reputation in relation to women's clothing but that reputation is for the trade mark "DOROTHY PERKINS". He states that the public will not analyse the various elements of the trade mark. The reputation is in the totality of the trade mark.

34. The applicant states that the Registrar should have regard to section 7(1) of the Act and allow the application to proceed to registration in relation to the goods for which honest concurrent use is shown. He refers to the *CODAS trade mark case* [2001] RPC 240 at 248 where he states that it is clear that where an application for registration has claimed honest concurrent use and the proprietor of the earlier trade mark has opposed the application the provisions of section 7(2) do not make refusal mandatory.

## **Decision**

35. The grounds of opposition pursued by the opponent are those under sections 5(2), 5(3) and 5(4) of the Trade Marks Act 1994. The relevant provisions read as follows:

“5.-

(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(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.

(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.

(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) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

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

36. The term ‘earlier trade mark’ 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.”

37. As the respective signs are not identical the ground of opposition under section 5(2) must be section 5(2)(b). As the opponent is basing his opposition under section 5(4) upon the law of passing-off this ground of opposition must be under section 5(4)(a).

### **Preliminary issue**

38. I note from the records of the Office that all the registrations upon which the opponent relies are in the name of Arcadia Group Brands Limited. This is not a matter to which either party has made reference. I also note from the records of the Office that the United Kingdom registrations were the subject of an assignment to Arcadia after the filing of the opposition. So it is quite possible that the opponent was the registered proprietor of the registrations at the time of the filing of the opposition. Be that as it may I do not consider that anything turns upon this matter. There is no requirement for the opponent to have a locus standi in the proceedings. As Mr Hobbs, acting as the Appointed Person, in *Wild Child case* [1998] 14 RPC 455 at 458 stated:

“Moreover there appears to be no requirement under the Act for the person claiming an earlier protection for an “*earlier right*” to be the proprietor of the right for which protection is being claimed: see sections 38(2), 46(4) and 47(3).”

### **Use of the earlier trade mark**

39. The use of the trade mark in terms of recognition (section 5(2)(b)), reputation (section 5(3)) and goodwill (section 5(4)(a)) could have some effect upon the outcome of the proceedings.

40. The opponent has not specifically claimed or pleaded a potentially enhanced penumbra of protection under section 5(2)(b). However, he has claimed a reputation and consequently I consider it incumbent upon me, taking into account the global appreciation that I must undertake, to consider whether this reputation could also represent public recognition. I also consider that it would be captious to argue that a claim to a reputation is not a claim to recognition. The use of the term reputation in relation to section 5(2)(b) instead of recognition is frequent even amongst the most seasoned of trade mark professionals.

41. In his submissions the applicant accepts that the opponent enjoys a reputation in relation to women’s clothing for the trade mark DOROTHY PERKINS. However, this acceptance of such a reputation does not mean that I can accept that such a reputation is sufficient to satisfy the tests for recognition under section 5(2)(b) or reputation under section 5(3) or goodwill under section 5(4).

42. In his first statutory declaration Mr Lynd states inter alia “I am informed” and “the opponents have informed me”. Such statements are clearly hearsay evidence. It is accepted that the Civil

Evidence Act 1995 allows for hearsay evidence to be considered, as does the Registrar's practice direction following the *St Trudo Case*. However, I need to consider what weight can be given to such evidence. Mr Lynd's statement "I am informed" gives no indication of the source. His statement that "the opponents have informed me" gives a greater indication of the source. However, it does not state who in the opponent's company informed him of the facts he swears to. He also fails to state how, if at all, he has verified this information. It is also to be noted that at the time that the declaration was made the registrations were not in the name of the opponent. So a further potential step is put between the facts sworn to and the source. If the opponent advised Mr Lynd of the facts was this from the records of Arcadia? Possibly the opponent and Arcadia are effectively one and the same but the evidence is silent in relation to this matter. Consequently in considering the evidence I consider that I must very much rely upon what the exhibits tell me. Unfortunately most of the exhibits emanate from well after the relevant date, the date of the filing of the application in suit.

43. Exhibit MAL 1 which identifies the stores under the name DOROTHY PERKINS indicates operations in over 500 sites within the United Kingdom as at 15 May 1996 (before the relevant date). Exhibit MAL 2 shows considerable turnover in relation to DOROTHY PERKINS shops, for 1994 and 1995 £252 million and £248 million respectively. However, this figure includes goods sold under other brands, even if they are sold within shops bearing the name DOROTHY PERKINS.

44. Other exhibits, which are outside the relevant date, are clearly indicative that the sign DOROTHY PERKINS is used in relation to women's clothing at large. I consider that taking all factors into account that there is goodwill in DOROTHY PERKINS in relation to women's clothing.

45. In relation to section 5(2)(b) the European Court of Justice stated that public recognition of a trade mark can affect the likelihood of confusion (see *Sabel* below). The Court did not indicate what would constitute such recognition. Consequently I rely upon the view that Mr Thorley QC, acting as the Appointed Person, took in *DUONEBS* (BL 0/048/01) (unpublished) where he stated:

"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."

46. In relation to section 5(3) the European Court of Justice have clearly set out the parameters in relation to reputation in *General Motors Corporation v Yplon SA Case C-375/97* [2000] RPC 572:

"Article 5(2) of the First Council Directive (89/104/EEC) of 21 December 1988 to approximate the laws of the Member States relating to trade marks is to be interpreted as meaning that, in order to enjoy protection extending to non-similar products or services, a registered trade mark must be known by a significant part of the public concerned by the products or services which it covers. In the Benelux territory, it is

sufficient for the registered trade mark to be known by a significant part of the public concerned in a substantial part of that territory, which part may consist of a part of one of the countries composing that territory.”

47. Both tests require very high hurdles to be cleared. The onus is upon the opponent to prove that his earlier trade mark enjoys a reputation or public recognition. He needs to furnish the evidence to support his claim. In the instant case I am in the invidious position of having to essentially decide these issues from indicative evidence. I consider that taking into account the strict requirements which need to be satisfied and that the public recognition under section 5(2)(b) and reputation under section 5(3) very much expand the parameters of “normal” trade mark protection it is not appropriate that I should hypothesise on evidence that is partial and only indicative.

48. In relation to this matter I take into account the findings of the European Court of Justice in *Windsurfing Chiemsee Produktions- und Vertriebs GmbH (WSC) and Boots- und Segelzubehör Walter Huber (C-108/97)*

“— a trade mark acquires distinctive character following the use which has been made of it where the mark has come to identify the product in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish that product from goods of other undertakings;  
— it precludes differentiation as regards distinctiveness by reference to the perceived importance of keeping the geographical name available for use by other undertakings;  
— in determining whether a trade mark has acquired distinctive character following the use which has been made of it, the competent authority must make an overall assessment of the evidence that the mark has come to identify the product concerned as originating from a particular undertaking and thus to distinguish that product from goods of other undertakings;  
— if the competent authority finds that a significant proportion of the relevant class of persons identify goods as originating from a particular undertaking because of the trade mark, it must hold the requirement for registering the mark to be satisfied;  
— where the competent authority has particular difficulty in assessing the distinctive character of a mark in respect of which registration is applied for, Community law does not preclude it from having recourse, under the conditions laid down by its own national law, to an opinion poll as guidance for its judgment.”

49. Although this relates to acquired distinctiveness the parameters set can, I believe, be taken into account in relation to considering whether an opponent has proved that his trade mark enjoys recognition or reputation; the acquired distinctiveness does depend on recognition/reputation. Making an overall assessment of the evidence before me I do not find that it satisfies me that the trade mark DOROTHY PERKINS is a household name (*DUONEBS*) or is known by a significant part of the public concerned in a substantial part of that territory *General Motors Corporation v Yplon SA Case C-375/97*. This is not to say that this is not the case but that on the basis of the evidence of the opponent that it has not been proved.

50. Consequently I cannot find that the opponent has shown that he enjoys a public recognition in relation to section 5(2)(b) nor a reputation in relation to section 5(3).

### **Use of PERKINS by the applicant**

51. There has been much time expended by the parties in relation to the promotional nature of the goods of the applicant. I consider that much of the argument does not have a bearing upon the instant case. Where it does have a bearing is in relation to the claim that there has not been confusion and also in relation to the grounds of opposition on the basis of passing-off.

52. The applicant also makes reference to section 7 of the Act. He seems to be under a misunderstanding as to how this part of the Act effects opposition proceedings.

Sections 7 (1) and (2) of the Act state:

- “7. - (1) This section applies where on an application for the registration of a trade mark it appears to the registrar-
- (a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or
  - (b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied, but the applicant shows to the satisfaction of the registrar that there has been honest concurrent use of the trade mark for which registration is sought.
- (2) In that case the registrar shall not refuse the application by reason of the earlier trade mark or other earlier right unless objection on that ground is raised in opposition proceedings by the proprietor of that earlier trade mark or other earlier right.

53. This section of the Act certainly does not allow an application to proceed upon the basis of honest concurrent use when there are opposition proceedings. It only allows an application to pass to publication. Once the application has been opposed all that use of the application can do is to bring in another factor in the consideration of whether there is a likelihood of confusion; it can bring to the argument that the trade marks have been used concurrently without confusion which could be indicative that there is not a likelihood of confusion. This is the position in *CODAS Trade Mark* [2001] RPC 240 at pages 247 to 248:

“However, if opposition is filed then the registrar must determine whether the grounds for refusal upon which the opposition is based are made out. If the opposition is based upon Section 5 then the provisions of the appropriate subsections must be considered. The fact that honest concurrent use has been shown at the examination stage cannot overcome the objection. If, for example, the trade mark the subject of the application for registration and the trade mark the subject of the earlier right were identical, and the specification of goods or services of the application was identical to the specification of the goods or services covered by the earlier trade mark, then refusal must follow under Section 5(1), which bars absolutely the registration of identical trade marks in respect of identical goods or services (unless the proprietor of the earlier trade mark consents

to the registration of the later trade mark). But in relation to Section 5(2) the respective trade marks or respective specifications of goods or services may only be similar and the fact that there has been actual use of the trade mark in suit concurrently with the earlier trade mark, may be relevant in determining whether there is a likelihood of confusion.”

54. In the instant case the applicant has clearly admitted that the goods upon which he uses the trade marks are promotional. His catalogue for 1996/1997 - although from after the relevant date I consider that this catalogue can be taken into account as being indicative of the nature of use of the sign -includes an order form that is clearly designed for internal use. It includes a budget number and is entitled Promotional Merchandise.

55. The catalogue actually commences with an introduction which states:

“Dear **Colleague** (*my emphasis*)

Welcome to the new Varity-Perkins promotional merchandise collection...”

The difference between promotional use of signs and trade mark use is well established. There clearly is a difference as the receiver of the goods will not see the sign as an indicator of origin of the goods but indicator of the goods or services being promoted. The question is whether the goods of the applicant act as a billboard for promotion of the main goods or whether they is a separate albeit smaller trade in respect of the secondary goods - *Daimler Chrysler AG v Javid Alavi* [2001] RPC 813 at page 823. Non-trade marks usage is also dealt with in *Unidoor Ltd v Marks and Spencer PLC* 1988 [RPC] 275 and as indicated by the opponent in *Arsenal Football Club Plc v Reed* 2001 [RPC] 922. (The applicant has objected to this authority owing to its recent provenance. I do not understand this argument. The decision does not change the law but reflects and illustrates the law as it exists. It is also part of the precedent law at the time of the writing of the decision. It is, therefore, appropriate to consider it. In fact in relation to non-trade mark and trade mark usage it represents no variance from the earlier cases referred to above).

56. Exhibited to the second declaration of Mr Lynd is a copy of the applicant’s web site which shows him to be a producer of diesel and natural gas engines.. It does not reply to anything which can be considered to be unforeseen or surprising in the evidence of the applicant and could have readily been furnished as evidence in chief. So taking into account the parameters set out in *Peckitt’s Application* [1999] RPC 337 I do not consider that it is evidence strictly in reply and so I take no cognisance of it in the instant proceedings

57. However, taking into account the evidence of the applicant and his own statements as to the goods being promotional I do not consider that the relevant public will see PERKINS as being an indicator of origin of the goods but simply as a promoter of his main goods. (This is well illustrated by that part of his catalogue which deals with pens, where certain of the pens are clearly described as being CROSS pens - thus identifying their trade source.) Consequently even though the sign PERKINS has been used in relation to the goods of the application in suit I do not consider that it will have crossed paths with the goods of the applicant in the normal course of trade. There is, for instance no indication that the goods of the applicant have been sold in clothing shops or to the public. The evidence indicates that the goods have been given to purchasers of the main goods of the applicant, which I take to be engines - Mr Ruffles works for

Perkins Engines Company Limited. Even if my last comment is not correct the fact that there is no indication that the goods have been put into the marketplace at large militates against any argument that the respective goods have co-existed in any true sense. Consequently the absence of proof of confusion proves nothing in relation to a potential situation where having rights in the trade mark PERKINS the applicant could put such goods into the marketplace at large. This finding applies to the issues under consideration in relation to both section 5(2)(b) and section 5(4)(a).

### **Section 5(2)(b) objection**

58. In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] R.P.C. 199, *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. 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* page 224;

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG* page 224; 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 of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* page 84, 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* page 224;

(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* page 224;

(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 Kaisha v. Metro-Goldwyn-Mayer Inc* page 7, 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* page 8, 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* page 224;

(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*

page 732, 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* page 9 paragraph 29.

### **Comparison of goods**

59. In relation to section 5(2)(b) the opponent focuses in his statement of grounds and submissions upon the goods of the application in suit in classes 14, 18 and 25 as representing similar or identical goods. As the earlier registrations are all for the same trade mark DOROTHY PERKINS I can deal with the goods encompassed by these registrations together. All the goods of the application in suit are directly encompassed by the specifications of the earlier registrations in classes 14, 18 and 25, with the exception of *card cases* and *key cases*, and so are identical. However, *articles of leather and imitations of leather* would encompass the former goods if they were made of these materials; in such circumstances the respective goods would be identical. If the *card cases* and *key cases* of the application in suit were made of a different material they would be the same as such goods made of leather and imitations of leather other than in their material of manufacture and so would be similar. Consequently all the respective goods are identical or highly similar.

60. Although I have focussed primarily upon the claim in relation to identical or similar goods in classes 14, 18 and 25 it is also necessary for me to give consideration to the issue as to whether there are any other similar goods in other classes. In class 21 of the specification of the application in suit *rings* appear. The goods are not further specified and, therefore, I must take it that the specification encompasses all types of rings in this class. Consequently it will encompass candle rings and napkin rings not of precious metals. The specifications of the opponent's registrations in class 14 encompass all good of precious metals in this class. Therefore, this specification will encompass napkin rings and candle rings of precious metals, which other than the material of construction are identical to the same goods in class 21. I must, therefore, find that *rings* in class 21 of the application in suit enjoy a high degree of similarity with the goods of the opponent.

61. *Pen holders* of the application in suit in class 16 and *badges* and *buttons* in class 26 will for the same reasons as given in relation to *rings* above be similar to the goods of the opponent encompassed by class 14; if of precious metal they will be in class 14. The only matter that separates the goods is their material of manufacture. This also holds good in relation to *business card holders* in class 16 of the application in suit which if of leather or imitations of leather are encompassed by the class 18 specification of the opponent.

62. In *Canon* the European Court of Justice held, in relation to the assessment of the similarity of goods, that the following factors inter alia should be taken into account: their nature, their end users and their method of use and whether they are in competition with each other or are complementary.

63. In relation to the other goods of the application in suit the opponent has put forward no argument as to similarity and I cannot see how they would satisfy the criteria of *Canon* in relation to similarity.

**64. Consequent upon the above I find that all the goods of the application in suit in classes 14, 18, 25 and 26 and business card holders and pen holders in class 16 and rings in class 21 are either identical or highly similar to the goods encompassed by the earlier registrations of the opponent.**

### **Comparison of signs**

65. The trade marks to be compared are as follows:

Earlier registration:

**DOROTHY PERKINS**

Application in suit:



66. I do not consider anything turns upon the different formats of the series of marks the subject of the application in suit, nor that the third trade mark has a colour claim.

67. The marks of the application in suit consist of the surname PERKINS. The earlier registration consist of the full name DOROTHY PERKINS. Consequently both trade marks relate to the same surname and in so much as they do have a conceptual similarity. There is not an identity of conceptual similarity as the earlier trade mark is a personal name rather than just a surname.

68. As PERKINS appears in both trade marks there is a visual and phonetic similarity in relation to this element. Although, obviously, the word DOROTHY is alien to the application in suit.

### **Conclusion**

69. I must make a global appreciation of the respective signs.

70. In considering the issue of likelihood of confusion I need to take into account the interdependency principle as the respective signs encompass either identical or very similar goods.

71. In considering the likelihood of confusion I need to consider the average consumer of the respective goods who owing to their nature could be any member of the public. I think it

reasonable to consider whether on seeing a full name and the surname from the full name solus the average consumer would consider that the respective goods emanate from the same undertaking. I also take into account that potentially the goods could be side by side. If confronted with labels bearing DOROTHY PERKINS and PERKINS on identical goods would the consumer assume that there must be an economic link, indeed that this was part of the same brand? I am of the opinion that there is a high likelihood of this.

72. It is also to be taken into account that for the most part the consumer may not be faced with the goods side by side but have to rely on imperfect recollection. Will he recall the PERKINS element as the distinctive element? I consider that this is quite possible.

73. It was established under the 1938 Act that the beginnings of words are more important in assessing similarity than the ends (*TRIPCASTROID* 42 RPC 264 at page 279). I consider that this is a reflection of human perception and so is not an issue that changes because of a change in trade mark acts. Therefore, it seems to me that this view is equally valid under the 1994 Act. It is also a position that OHIM follows, for instance in decision no 1126/2000 - Official Journal 10/2000 at page 1506. The beginnings of the word elements of the respective trade marks commence with two different words and I consider that the principles of *TRIPCASTROID* equally apply when viewing trade marks as a whole. In the instant case the respective trade marks commence with very different words.

74. The *TRIPCASTROID* theory has to be considered in the context of the respective trade marks. It could be that a second element owing to its concept or meaning is as significant or more significant than the first element. In relation to a surname this could readily be the case. We are used to identifying goods and persons by reference to their surnames.

74. In reaching a decision in relation to the likelihood of confusion I have particularly born in mind the following comments of the European Court of Justice in *Canon*:

“Accordingly, the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 4(1)(b) of the Directive (see *SABEL*, paragraphs 16 to 18).”

The respective goods are identical or highly similar. The respective signs have similarities conceptually, visually and orally; they have a degree of similarity. So in this respect the opposition passes the initial requirements for section 5(2)(b). The opponent has thrown the necessary double - similarity of goods, similarity of signs - to set his claim in motion. (It is possible that an opposition could pass these tests and still fail as the degrees of similarity is such that there is not a likelihood of confusion - it is the natural corollary of the interdependency principle.) However, in the instant case I consider that, owing to the common surnominal element and the close proximity/identity of the goods, the public would be likely to believe that the respective goods emanate from the same undertaking.

**75. I, therefore, find that the opposition in relation to classes 14, 18 25, 26 and business card holders and pen holders in class 16 and rings in class 21 is upheld and the application in suit is refused in respect of these goods.**

### Section 5(3) objection

76. I have already decided that the opponent has not established a reputation for his earlier trade mark in terms of the parameters set out by the European Court of Justice. However, in the event that I am wrong in this assessment I will consider whether if the opponent had established a reputation he would have succeeded under this head.

77. From my findings above in relation to identical and similar goods it is clear that there are goods in the specification of the application in suit which are not similar or identical. Therefore, there are goods which could be the subject of objection under section 5(3).

78. In *Barclays Bank plc v RBS Advanta* [1996] RPC 307 Laddie J considered the proviso to Section 10(6). The second part of the proviso contains wording identical with the wording of Section 5(3) of the Act. Laddie J stated:

“At the most these words emphasise that the use of the mark must take advantage of it or be detrimental to it. In other words the use must either give some advantage to the defendant or inflict some harm on the character or repute of the registered trade mark which is above the level of de minimis”

79. In considering whether the use of the trade mark in suit would be detrimental to the distinctive character or the repute of the opponents’ trade mark I take into account the parameters set out in *Oasis Stores Ltd’s Trade Mark Application* [1998] RPC 631 at page 649 et seq. In the words of Mr James in *Oasis* the reputation of the trade mark DOROTHY PERKINS must be likely to be damaged or tarnished in some significant way:

“By ‘damaged or tarnished’ I mean affected in such a way so that the value added to the goods sold under the earlier trade mark because of its repute is, or it likely to be, reduced on scale that is more than de minimis.”

80. In *Premier Brands UK Ltd v Typhoon Europe Ltd* [2000] FSR 767 Neuberger J in relation to this ground refers to the concept of dilution:

“However, while dilution is a useful concept to bear in mind, it does not necessarily follow that every case of infringement under section 10(3) will necessarily involve dilution, nor does it follow that the proprietor of a mark will necessarily succeed in establishing infringement under section 10(3) in every case where he establishes dilution.”

81. In *LOADED* (BL 0/455/00) Mr Thorley QC, acting as the Appointed Person, made the following comments in relation to unfair advantage/detriment:

“So far as concerns unfair advantage/detriment, whilst these are alternative provisions, very often they will go hand in hand. It is now well settled law that the requisite detriment/unfair advantage can be proved without proving confusion of a nature required under section 5(2) and section 10(2) - confusion as to origin

between similar marks used on similar goods, (see *Pfizer* paragraphs 28-32 and *Premier Brands*, transcript pages 25-26). It follows that the requisite detriment/unfair advantage can be proved by satisfying the Tribunal that the public makes a connection between the later and the earlier mark and that that connection is prejudicial to the earlier mark.”

82. It seems to me that in considering the issue of unfair advantage/detriment, taking into account the above authorities, the opponent has to show that the public would make a connection between his trade mark and that of the applicant and that that connection would have to be prejudicial - whether this is by dilution/blurring or tarnishing.

83. The sole argument that the opponent uses in his submission in relation to this is that registration of the application in suit would prevent him from legitimately promoting his own business by selling promotional merchandise and that this would be to his detriment. This argument does not address the key issues of unfair advantage/detriment. Any trade mark registration could restrict another trader in the future from using a particular sign in relation to his goods or services - that is the very purpose of registering trade marks, to give protection for possible infringement in the future. It does not go to the point of showing that any connection between the respective trade marks would be prejudicial to the earlier trade mark.

84. In considering the issue of whether there could be any prejudice it is necessary to take into account the proximity of the trade marks. In the instant case the respective trade marks are similar but certainly not identical. It is also necessary to take into account whether in relation to the non-similar goods that the public would be likely to see a connection. If they do not see a connection then there cannot be a prejudice. I take into account that a connection might be oblique where the signs are very close or identical, for instance in use of identical trade marks encompassing toilet cleaner and wine.

85. In the instant case I consider it reasonable to take into account that the respective signs are not identical and that the PERKINS element is a common surname - and so an element that the public could readily associate with another enterprise in relation to non-similar goods. I also take into account that nature of the goods which are not similar and that if the opponent had proved a reputation this would only be in relation to women’s clothing. The non-similar goods have no obvious relationship with women’s clothing, this is not a case which deals with established extensions in trade. I am left wondering why the purchaser should assume that there is a connection between the non-similar goods and women’s clothing. The opponent has put forward no persuasive argument in relation to this matter. I have nothing before me that shows or indicates that the registration of the application in suit in relation to non-similar goods would damage the opponent or be to his detriment. In relation to the non-similar goods I can see no reason why the public seeing the trade mark PERKINS in relation to the non-similar goods should see any connection with DOROTHY PERKINS in relation to women’s clothes.

**86. Consequent upon the above in addition to dismissing this ground of opposition on the basis that the opponent has failed to establish the necessary reputation I also dismiss this ground on the basis that he has failed to establish that registration of the application in suit in relation to non-similar goods would take unfair advantage or be detrimental to the earlier trade mark of the opponent.**

## Section 5(4)(a) objection

87. I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC in the *Wild Child case (1998) 14 RPC 455*. In that decision Mr Hobbs stated that:

"The question raised by the Grounds of Opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the Applicant from those of other undertakings (see Section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Art. 4(4)(b) of the Directive and Section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the applicant in accordance with the law of passing off".

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

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

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

....."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.”

88. The date at which the matter must be judged is not entirely clear from Section 5(4)(a) of the Act. This provision is clearly intended to implement Article 4(4)(b) of Directive 89/104/EEC. It is now well settled that it is appropriate to look to the wording of the Directive in order to settle matters of doubt arising from the wording of equivalent provisions of the Act. It is clear from Article 4(4)(b) that the earlier right had to have been "acquired prior to the date of application for registration of the subsequent trade mark, or the date of the priority claimed .....". The relevant date is therefore the date of the filing of the application in suit.

89. In relation to the goods of the application in suit which have been found similar or identical under section 5(2)(b) the opponent could be in no better a position under section 5(4)(a) and so I will say no more about these goods.

90. Passing-off does not require goods to be similar and, therefore, I must consider this issue in relation to the goods of the application in suit which I have found to be not similar.

91. The opponent has established, and the applicant accepts, that he enjoys goodwill in relation to women’s clothing. In assessing whether the opponent has established a valid basis for passing-off I have to take into account the distance between the goods.

92. In *Harrods v Harrodian School* [1996] RPC 697 Millett LJ stated:

“It is not in my opinion sufficient to demonstrate that there must be a connection of some kind between the defendant and the plaintiff, if it is not a connection which would lead the public to suppose that the plaintiff has made himself responsible for the quality of the defendant’s goods or services”

In relation to section 5(3) I have already held that I do not consider that the public would see a connection in relation to non-similar goods between the two parties. I think that this absence of a perceived connection is damning to the case of the opponent. If the public will not associate the respective trade marks owing to the distance between the respective goods there cannot be deception and there cannot be damage.

**93. In relation to non-similar goods I dismiss the grounds of opposition under section 5(4)(a).**

**94. As a result of the above findings the application in suit is to be refused in respect of all goods in classes 14, 18, 25 and 26 and for business card holders and pen holders in class 16 and rings in class 21.**

**95. As both parties have been successful under some heads I make no award of costs in relation to the instant proceedings.**

**Dated this 16 day of November 2001**

**D.W.Landau  
For the Registrar  
the Comptroller-General**