

**TRADE MARKS ACT 1938 (AS AMENDED) AND  
TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATIONS NOS 1512117 AND 1512118  
BY RUDOLF BOHNACKER (TRADING AS TEGOMETALL  
RUDOLF BOHNACKER) TO REGISTER THE MARK TEGO TOP SHOP IN  
CLASSES 6 AND 20**

**AND**

**IN THE MATTER OF CONSOLIDATED OPPOSITIONS THERETO UNDER  
NOS 40200 AND 40201 BY TOP SHOP RETAIL LIMITED (NOW TOP SHOP/  
TOP MAN LIMITED)**

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TRADE MARKS ACT 1994**

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by Rudolf Bohnacker (trading as Tegometall Rudolf Bohnacker)  
to register the mark TEGO TOP SHOP in Classes 6 and 20**

10 **and**

**IN THE MATTER OF Consolidated Oppositions thereto under  
Nos 40200 and 40201 by Top Shop Retail Limited (now Top Shop/  
Top Man Limited)**

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**DECISION**

20 On 7 September 1992 Rudolf Bohnacker (trading as Tegometall Rudolf Bohnacker) applied to register the mark TEGO TOP SHOP in Classes 6 and 20 for specifications of goods which read as follows:

25 Shelving, sales gondolas; shelving parts; shelves, columns, supports, brackets, troughs, boxes, back panels, dividing panels, cover plates and panels, perforated panels, canopies, shelf bars, rails, panelling, book supports, tool supports, drawers; connecting and fastening parts for use with shelving; all included in Class 6.

30 Shelving, sales gondolas; cabinets, show cases, glass cases; tables, counters; parts and fittings for use with shelving; shelves, columns, supports, brackets, shelving troughs, boxes, back panels, dividing panels, cover plates and panels, perforated panels, canopies, shelf bars, rails, panelling, book supports, tool supports, drawers; connecting and fastening parts, all being for use with shelving; all including in Class 20.

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The applications are numbered 1512117 and 1512118 respectively.

On 15 July 1994 Top Shop Retail Limited filed notices of opposition to these applications. The grounds of opposition are in summary:

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- i under Section 11 by reason of the opponents' use of the mark TOP SHOP
- ii under Section 12(1) by reason of the fact that the opponents are proprietors of registrations incorporating the words TOP SHOP (see below for details)
- iii under the Well Known Mark and Unfair Competition provisions of the Paris Convention (Article 6 bis (1) and 10 bis (1) refer).

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The opponents also ask that the applications be refused in the exercise of the Registrar's discretion under the provisions of Section 17(2) and seek an award of costs in their favour.

The registered marks on which the opponents rely are as follows:

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NUMBER	MARK	CLASS	JOURNAL/ PAGE	SPECIFICATION
1076327		25	5280/1979	Articles of clothing for women.

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1117657		25	5373/1968	Articles of clothing for women.
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1117658		25	5373/1968	Articles of clothing for women.
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Note

35 The grounds also referred to Trade Mark No 1204487 for the mark TOPSIZE in Class 18. As this application has since been withdrawn (and was in any case for a different mark) I have not included details above.

40 The applicant filed a counterstatement denying the grounds of opposition and putting the opponents to proof of their claims. The applicant says of the opponents' claimed registrations that they are either in the ownership of Top Shop/Top Man Limited or (in the case of 1204487) has been cancelled. He asks that his trade mark proceed to registration and seeks an award of costs in his favour.

45 Both sides filed evidence in these proceedings which were consolidated at an early stage. The matter came to be heard on 8 April 1998 when the applicant was represented by

Mr R Onslow of Counsel instructed by his Trade Mark Attorneys, RGC Jenkins & Co and the opponents by Mr M A Lynd of Edward Evans & Co, their Trade Mark Attorneys.

5 By the time this matter came to be heard, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. In accordance with the transitional provisions set out in Schedule 3 to that Act however, I must continue to apply the relevant provisions of the old law to these proceedings. Accordingly, all references in the later parts of this decision are references to the provisions of the old law.

10 Opponents' evidence (Rule 49)

The opponents filed a statutory declaration dated 14 June 1995 by Stephen Langdon, Managing Director of Top Shop/Top Man Limited (formerly Top Shop Retail Limited), a position he has held for 3½ years.

15 Mr Langdon says that the trade mark TOP SHOP was adopted by the predecessors in title of his company in 1964 and has been used continuously since that date. The mark is said to have been used on a wide range of garments and clothing along with goods such as bags, belts, jewellery, hair accessories, umbrellas, toiletries and make-up.

20 A copy of the Burton Group plc (parent company) report for the year 1994 is exhibited (SL1) and shows that Top Shop/Top Man Ltd (Top Shop) has 31 shops throughout the United Kingdom, a further 56 shops within Debenhams department stores, and 23 shops located within other shops. In addition Top Shop runs 125 joint shops selling both TOP SHOP and TOP MAN products. A list of branches is exhibited at SL2. Turnover for 1994 was approximately £217 million. TOP SHOP is used not just as the name of retail sites but is also applied to goods (examples are at SL3).

30 Mr Langdon says that TOP SHOP products are promoted extensively as evidenced by Exhibits SL4 to SL13 which show a variety of publicity material, photographs, inserts and supplements for fashion magazines. There is also a large number of advertisements and editorial material from a range of newspapers. Also exhibited (SL14 and 15) are two music videos produced for use in store to inform customers of the products available under the TOP SHOP trade mark. By virtue of the extensive activity described above Mr Langdon believes that his company's mark is very widely known to the British public and a well known mark for the purpose of the Paris Convention.

In relation to the goods at issue Mr Langdon has this to say:-

40 "Like all other clothes shops in the United Kingdom, my company makes extensive use of shop fittings such as shelves, shelving, racking systems etc. These shop fittings are used not only to store goods but also to display goods to customers and to potential customers. The trade mark of the application in suit consists of three words, two of which are identical to my company's famous trade mark TOP SHOP. The Applicant's trade mark is proposed to be registered for a wide range of shop fitting products in Classes 6 and 20. In the Notice of Opposition filed by my company to prevent registration of the Applicant's trade mark, it is asserted for my company that

it is probable that the Applicants will use the words TOP SHOP upon shops fittings and that thus, goods bearing the TOP SHOP trade mark will appear in clothes shops. Although in the Applicants' Counterstatement, the Applicants put the Opponents to proof of this allegation, it is significant to me that they do not attempt to deny it. If the Applicants achieve a registration of the trade mark of the Application in Suit, then they will be entitled to supply shop fittings under the TOP SHOP trade mark to shops. Those shops can include clothes shops, and can include direct competitors of my company. Thus, there is a very real possibility that my company's TOP SHOP trade mark could appear in the clothes shops of competitors of my company. This is clearly damaging to my company and to the reputation and goodwill my company possesses in its TOP SHOP trade mark and it is for this purpose that my company has brought these Opposition proceedings.

As is stated, in my company's Notice of Opposition, the parent company of my company, The Burton Group plc does in fact offer a shop fitting service, not only to other members of The Burton Group of companies, but also to third parties. I believe that the use by the Applicants of the word TOP SHOP in relation to shop fittings and the goods of the application in suit will lead my company's customers to believe that my company has extended its activities into the naturally ancillary area of shop fittings. I believe that my company's customers and other purchasers of these shop fittings products will believe that those products are goods emanating from or associated with my company."

#### Applicant's evidence (Rule 50)

The applicant filed a statutory declaration dated 6 March 1996 by Peter Strehl. Mr Strehl is a European patent attorney with the firm of Strehl Schubel-Hopf Groening & Partner and acts for the applicant in patent and trade mark matters. He explains that Mr Bohnacker is a very elderly man and it is not possible to get him to sign a declaration at this stage. He (Mr Strehl) is, however, authorised by Mr Bohnacker to sign any documents and declarations on his behalf in patent or trade mark matters. Mr Strehl exhibits (A) a copy of a Power of Attorney to this effect. The information contained in the declaration is within his personal knowledge unless otherwise stated. Finally by way of introductory comment Mr Strehl confirms that he is proficient in the English language.

Mr Strehl comments firstly on the opponents' change of name which he says was recorded at the Trade Marks Registry on 10 June 1994. It, therefore, appears, he says that the notice of opposition has been filed in the incorrect name.

Mr Strehl says that the applicant firm manufactures shelving and exhibits (B) a selection of brochures showing products manufactured by the firm and sold under the mark TEGOMETALL. It is envisaged that TOP SHOP will be a further sub-brand to TEGO. It is not the applicant's intention to use the words TOP SHOP separately from the word TEGO or in a more prominent manner.

Mr Strehl goes on to express the view that TOP SHOP is clearly an extremely non-distinctive trade mark in respect of shelving, clothing, retail services and most other goods or services.

It is for this reason that a disclaimer has been entered against the term. He takes the view that the distinctive element of the applicant firm's trade mark is the word "Tego", and that shelving bearing the trade mark TEGO TOP SHOP will be known and remembered as TEGO rather than TOP SHOP.

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He says it is not the firm's intention to feature the trade mark TEGO TOP SHOP prominently on any shelving. Although the trade mark will appear on the goods themselves, it will appear in areas which are not exposed when the goods are in an assembled condition. For example, the trade mark will appear on the rear side of uprights or on the low side of shelves. Where the goods are made of metal, the trade mark will be embossed on the unpainted metal. He adds that although the firm is interested in making its trade mark known to its customers, it is well aware that shopkeepers wish to display their goods under their own trade marks or the manufacturer's trade marks rather than advertise the firm's shelving products. It should be borne in mind that the firm's customers are retailers rather than shoppers.

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Mr Strehl goes on to suggest that shelving on the one hand and clothing and/or retail services on the other are far removed and that members of the public would not assume a connection between them.

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Mr Strehl then addresses the opponents' criticism that the applicant could have had no bona fide reason for adopting the mark at issue other than to pass off his goods as those of the opponents. He does so in part by reference to what he believes Mr Bohnacker's state of knowledge would have been of the opponents' stores or goods. I regard this part of Mr Strehl's declaration to be hearsay and of little assistance to the tribunal. He also says that "the trade mark TOP SHOP, being somewhat laudatory and descriptive, was a logical mark to be used in respect of shelving as a sub-brand to the TEGO trade mark". He goes on to refer to various other TEGO applications.

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Finally Mr Strehl comments at length on Mr Langdon's declaration. A brief summary of his views is as follows:-

- he notes that TOP SHOP is closely associated with TOP MAN and suggests that as a consequence any repute or goodwill enjoyed by the opponents rests in the combination rather than TOP SHOP on its own.
- he makes a number of observations on the £217 million turnover figure quoted by Mr Langdon.
- he criticises references in Mr Langdon's declaration to the applicant's mark as TOP SHOP and emphasises that the mark applied for is TEGO TOP SHOP.
- he submits that if Mr Langdon's argument is taken to its logical conclusion other traders would be unable to use similar trade marks across a broad range of goods.

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- he suggests that shoppers are unlikely to inspect trade marks appearing on shelving or to make any connection between shelving and the goods displayed on them.

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- he says he fails to see the relevance of the fact that the Burton Group plc offer a shopfitting service. Shopfitting is, he says, far removed from clothing and retail services.

Opponents' evidence in reply (Rule 51)

10 This comes in the form of a further statutory declaration dated 9 January 1997 from Stephen Langdon. He firstly criticises the applicant's evidence as "hearsay and lacking in evidentiary substance". In relation to the notices of opposition he says that these were filed by the correct opponent but under the previous name.

15 His reply evidence can be summarised as follows:-

- he says that the applicant's evidence implies that the mark TOP SHOP may function as a sub-brand separately from the housemark TEGO.

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- he makes a number of observations on the issue of the distinctiveness or otherwise of the words TOP SHOP and the possibility that this element of the applicant's mark may acquire a life of its own.

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- he suggests in response to the applicant's explanation of how his mark will be used, that the mark will not be invisible when the goods are in place. He believes that there is a risk of confusion if a TEGO TOP SHOP display is in a store other than a TOP SHOP store.

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- he notes that the applicant has other marks he could use without the risk of confusion.

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- in response to Mr Strehl's comments on the opponents' evidence he says that the sales figures quoted were in respect of retail sales under the mark TOP SHOP. He also points out that it is quite common for stores to display their marks on eg carpets, chairs, counters and cash registers. As a result he believes that if these items carry identical marks applied by other parties then confusion is likely to occur. Certain other aspects of Mr Strehl's declaration are, he suggests, without evidential support.

40 With the above evidence in mind I go on to consider the grounds of opposition.

I will deal firstly with the ground based on Section 12. This Section, so far as is relevant, reads as follows:

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12 (1) Subject to the provisions of subsection (2) of this section, no trade mark shall be registered in respect of any goods or description of goods that is

identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of:-

- a. the same goods
- b. the same description of goods, or
- c. services or a description of services which are associated with those goods or goods of that description.

The reference in Section 12(1) to a near resemblance is clarified by Section 68(2B) of the Act which states that references in the Act to a near resemblance of marks are references to a resemblance so near as to be likely to deceive or cause confusion.

The established test for an objection under these provisions is set down in Smith Hayden and Company Ltd's application (Volume 1946 63 RPC 101). Adapted to the matter in hand the test may be expressed as follows:

Assuming user by the opponents of their marks TOP SHOP (in stylised form) in a normal and fair manner for any of the goods covered by the registrations of those marks, is the tribunal satisfied that there will be no reasonable likelihood of deception among a number of persons if the applicant uses his mark TEGO TOP SHOP normally and fairly in respect of any goods covered by the proposed registrations?

So far as the respective marks are concerned Mr Onslow, for the applicant, made a number of observations on what he considered to be the laudatory nature of the words TOP SHOP simpliciter. He suggested that Section 5(2) of the Act may have been considered sufficient protection for third parties wishing to use the words in a legitimate laudatory manner. In his view, therefore, the opponents' objections must be seen in this overall context. At the hearing Mr Lynd, for the opponents, provided a copy of a registration certificate to show that the words TOP SHOP (in plain block capitals) had since been registered under the Trade Marks Act 1994. I do not propose, or need, to take formal note of this later filed registration in reaching a decision. Submissions at the hearing concentrated principally on the matter of comparison of goods. In this respect I was referred to various passages from Jellinek's Application 1946 RPC 59 (the PANDA case). The Jellinek test requires me to consider the nature, purpose and channels of trade in coming to a view as to whether goods of the same description are involved. I do not think the Section 12 issue requires exhaustive analysis. By any reasonable standard the nature, purpose and channels of trade of the respective goods differ. In coming to this view I have not lost sight of Mr Lynd's submission that the applicant's goods cover a wide range of items including, for instance, canopies and that the goods could appear together in a retail context. But I think Mr Onslow was right to say that this is too broad an approach to the issue of channels of trade. The applicant's goods are not being traded in at the point when they might be in contact with clothing in a retail environment (see also Chapter 10.55 of the Registry Work Manual). I have no hesitation, therefore, in concluding that goods of the same description are not involved. The opposition, therefore, fails under Section 12.



The main ground on which the opponents rely is Section 11. This reads as follows:

“11 It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.”

The established test for objection under this Section is again that set down in *Smith Hayden* but as adapted by Lord Upjohn in the *BALI* trade mark case 1969 RPC 496. Adapted to the matter in hand the test may be expressed as follows:

“Having regard to the user of the mark *TOP SHOP* is the tribunal satisfied that the mark applied for, *TEGO TOP SHOP* if used in a normal and fair manner in connection with any goods covered by the registrations proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?”

The test under Section 11 is not restricted to the same goods or goods of the same description and I must, of course, consider the full range of goods covered by the applicant’s specifications in the light of the actual use made by the opponents of their mark. There were submissions before me at the hearing about the relationship between the goods and how the applicant’s mark would appear or be shown in a trading context. I propose, therefore, to consider what would constitute normal and fair use of the applicant’s mark before going on to deal with the application of the law and the above test to the facts of the case before me.

I should say, firstly, that Mr Onslow, quite rightly I think, conceded that the opponents had a significant reputation for clothing. I also take the view that the evidence shows use of their mark *TOP SHOP* in a number of variant forms including usage in block capital letters. The applicant in his evidence says that the mark *TEGO TOP SHOP* would be applied to the rear of shelves etc though there is no such restriction or condition attaching to the trade mark application. Normal and fair use would, in my view, include affixing or applying the mark (in fact it is said to be embossed) to what would be the visible surface of the goods in a retail situation. I do not say that there is a strong likelihood of this happening because shelving and such like items are not at that point being offered for sale. More importantly, however, I have no doubt that suppliers of such goods would not wish to promote their own marks in such a way as to distract attention from the retailers’ own products and marks. Mr Onslow in his skeleton argument posed the question “can anyone remember what the shelves of a familiar and regularly (visited) supermarket actually look like in detail?” I do not think it requires survey or other evidence to provide an answer to that question.

Mr Lynd rightly reminded me that the applicant’s full range of goods included items such as canopies. In his view this raised the prospect of a *TEGO TOP SHOP* canopy appearing outside a shop or store and resulting in customer confusion as to the origin of the goods in that shop or store. Whilst it might be expected that the applicant would wish to apply his mark to canopies it is in my view going too far to suggest that normal and fair use would extend to a form of presentation such that the mark would be apparent to customers or passers by. That does not seem to me to accord with commercial reality which is that shop canopies

are used to advertise the retailer and/or the goods and not the manufacturer or supplier of the canopy. That state of affairs can, I think, be verified by a visit to any high street. Certainly there is no evidence before me to the contrary.

5 There is one final aspect of normal and fair use on which I should comment. The opponents in their evidence note that the applicant's mark is presented as three separate words and express concern as to the effect if the element TOP SHOP were to be used as a mark in its own right. Whatever the results might be if that happened I think it can safely be said that such usage would not constitute normal and fair use of the mark applied for.

10 With the above comments in mind I turn to the facts of this case and the issue of confusion and/or deception. I have already come to the view that the goods could meet in retail premises albeit that the applicant's goods are not being offered for sale at this point. The applicant's own evidence suggests that his shopfitting products can be, and are, used in (inter alia) clothes shops. The question, therefore, arises as to whether anyone noting the TEGO TOP SHOP mark on, for instance, shelving might think that there is a connection with the opponents. Mr Onslow submitted that any confusion is not relevant confusion because it does not arise in the course of trade (the shelving being merely an adjunct to the retail process). Furthermore he argued that any confusion that might result would be momentary and inconsequential (words drawn from Alan Clark v Associated Newspapers Ltd 1998 RPC 261). Given the very different nature of the goods I think there is sufficient force in this argument that it requires clear evidence to the contrary for the opponents to displace it. The opponents say that, because the applicant's mark incorporates the whole of their mark, it effectively means that their mark will be appearing in clothes shops of competitors. That claim is in my view not enough unless there is some demonstrable connection between the goods or evidence that the opponents' use and reputation go beyond the clothing field. I do not have detailed evidence before me as to how shopfittings reach the market. Commonsense suggests that they are likely to be supplied by the manufacturers themselves, wholesalers/distributors acting on behalf of manufacturers or by shopfitting service companies. I see no real likelihood of confusion between goods sold in this way and the retail sale of clothing. The common link is the retailer but in one case he is himself the customer (for shopfittings) and in the other case he is the supplier (of clothing or other goods). I also bear in mind both sides' comments in relation to the MACY's case 1959 RPC 546 though I think the circumstances there were somewhat different.

35 A further factor to be borne in mind is that the mark applied for is TEGO TOP SHOP. Given that the words TOP SHOP are prima facie descriptive and laudatory it must necessarily have the effect of focussing attention on the distinctive element TEGO. From the opponents' point of view it must also, I think, be the case that, whilst they may through use of their marks have some rights in the descriptive/laudatory words TOP SHOP those rights cannot be extended to other unrelated fields of activity without clear evidence that a reputation has been established in those areas. Given my views on the marks and the goods and the circumstances in which they meet I do not think that any meaningful confusion would result. I would just add in passing that from a practical point of view the decision to enter a shop would have been taken before the customer could come into contact with the applicant's mark.

There is a further aspect of the Section 11 case that I need to deal with. The opponents in their evidence point to the fact that their parent company, the Burton Group plc, offer a shopfitting service. Whilst I have found that there is no evidence to suggest a likelihood of confusion between clothing and shopfitting products, the applicant would in my view face a more serious challenge if it were established that closely related services were being offered under a similar mark. However there is no evidence before me that Burton Group plc offer shopfitting services under the mark TOP SHOP. Had such been the case it would be surprising if the opponents had failed to mention it. In the absence of such information I am unable to draw any conclusions that would be favourable to the opponents.

At the hearing Mr Lynd also sought to develop the argument that, because Section 11 prohibits registration of a trade mark that would be “contrary to law”, this entitles the opponents to rely on the provisions of the Trade Marks Act 1994 and in particular Section 10 thereof. Mr Onslow on the other hand said that the material date in those proceedings was the filing date of the applications in suit (7 September 1992) and the matter needed to be decided as at that date. I agree with Mr Onslow. These applications were filed under the Trade Marks Act 1938 and in accordance with paragraph 10(1) of Schedule 3 (the Transitional Provisions) to the Trade Marks Act 1994 must continue to be dealt with under that law. I do not, therefore, consider that this argument affects my decision under Section 11. Accordingly the opposition fails on this ground.

The opponents also referred in their statement of grounds to Articles 6 bis and 10 bis of the Paris Convention but did not file evidence bearing directly on these points. Nor were any submissions made at the hearing. For the sake of completeness I confirm that I do not see any basis on which the opponents can succeed under either of these heads.

Finally there is the matter of the Registrar’s discretion. But again in the light of my above findings I see no reason for exercising discretion against the applicant.

As the applicant has been successful in these consolidated proceedings he is entitled to a contribution towards his costs. I, therefore, order the opponents to pay the applicant the sum of £800.

Dated this 1st day of May 1998

M REYNOLDS  
For the Registrar  
the Comptroller General