

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2129433
IN THE NAME OF FASHIONS DIRECT LTD**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 47886 IN THE NAME OF
SPECIALITY RETAIL GROUP PLC**

TRADE MARKS ACT 1994

**IN THE MATTER OF application No 2129433
in the name of Fashions Direct Ltd**

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and

**IN THE MATTER OF opposition thereto under No 47886
in the name of Speciality Retail Group PLC**

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Background

15 On 11 April 1997, Fashions Direct Ltd, of 86-90 Tradeston Street, Glasgow, G5 8BG applied to register a trade mark in Class 25 in respect of the following goods:

Articles of clothing, footwear and headgear.

20 The trade mark is as follows:

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On 8 December 1997, Speciality Retail Group PLC filed notice of opposition to this application, in which they say that they are the proprietors of the following United Kingdom trade mark application:

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Number	Mark	Class	Specification
2027827	SUIT EXPRESS	25	Clothing, footwear and headgear; all included in Class 25

The grounds of opposition are in summary:

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1. Under Section 3

Because the application is for a mark which is the phonetic equivalent of a significant part of the opponent's earlier mark and is not capable of distinguishing the goods of the applicant from the goods of the opponent under Section 1(1) of the Act and should not be registered under Section 3(1)(a) of the Act.

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2. **Under Section 5(2)(b)** Because the application is for a mark which is the phonetic equivalent of a significant part of the opponent's earlier mark such that there is a likelihood of confusion.

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3. **Under Section 3(6)**

The applicants filed a Counterstatement in which they deny all of the grounds on which the opposition is based.

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Both sides request that costs be awarded in their favour.

Only the opponents filed evidence in these proceedings. The matter came to be heard on 18 December 2000, when the applicants were represented by Mr Giles Fernando of Counsel, instructed by A A Thornton & Co, their trade mark attorneys, and the opponents by Mr Guy Tritton of Counsel, instructed by R M Trade Marks Limited, their trade mark attorneys.

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Opponent's evidence

This consists of three Statutory Declarations. The first is dated 19 June 1998 and comes from Toby York, Financial Director of Speciality Retail Group plc (his company), a position he has held for three years. Mr York confirms that the facts set out in his Declaration are either from his own personal knowledge, from his company's records or other sources, as mentioned. He confirms that he is authorised to make the declaration of behalf of the opponents.

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He begins saying that his company was formed on 19 June 1935 as A. Brick & Sons Limited, and through various changes of names became Speciality Retail Group plc on 27 November 1995. He refers to documents 1 to 1d of exhibit TY1 which consist of certificates detailing the formation and changes of name as detailed.

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Mr York continues by referring to four trade marks; SUITS YOU, SUIT HANGER, SUIT CITY and SUIT FACTORY registered by his company in Classes 25 and 42. Details of these registrations are shown as documents 2 to 2g of exhibit TY1, and which show that they have been registered in respect of clothing and the service of clothing hire.

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Mr York next refers to the application to register the trade mark SUIT EXPRESS, details of which are set out above, and also as document 3 of exhibit TY1, saying that the choice of a mark consisting of the word SUIT with another word was in keeping with his company's corporate image. He says that the applicants' mark is the phonetic equivalent of the word EXPRESS, that removing the letter "E" does not alter this, and as such, is wholly contained within his company's mark. He also states that the respective goods are identical.

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He goes on to refer to a search of Marquesa conducted on 3 June 1998, the results of which show that in the United Kingdom there is one trade mark for the word EXPRESS (solus), and eighteen others where EXPRESS/XPRESS is an element of the mark registered in Class 25. Details of these are shown as document 4 to exhibit TY1. He next refers to document 5 of exhibit TY1 which consists of details of a similar search of the Community Trade Marks

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Register which shows there to be six applications or registrations for, or incorporating the word XPRESS/EXPRESS with an earlier date than the relevant date in these proceedings.

5 Mr York says that he considers the mark applied for would be likely to be confused with his company's earlier trade mark, SUIT EXPRESS. He gives his view that the word
XPRESS/EXPRESS on its own is incapable of being a trade mark because of the other
10 registrations that incorporate the word, and consequently, it is not able to distinguish the applicant's goods and should not be registered. He considers that the stylisation does not make the mark sufficiently distinctive, referring to oral use of the word and the likelihood of imperfect recollection.

15 Mr York concludes his Declaration by referring to document 6 of exhibit TY1, which consists of references for the word EXPRESS extracted from dictionaries and a thesaurus, noting the references to speed or rapid movement which he considers to be a relevant in respect of clothing.

20 The next Statutory Declaration is dated 31 July 1998, and comes from Jeanette Pauline Wood, a trade mark agent and a Director of RM Trade Marks Limited, a position she has held for two and a half years.

25 Ms Wood refers to documents 1 to 1c of exhibit JPW1, which consist of details of four registrations for the trade mark SHOE EXPRESS which she says were extracted from Marquesa on 30 June 1998. She recounts a visit to the premises of SHOE EXPRESS in Cambridge, and refers to documents 2 and 3 of exhibit JPW1, which consists of a carrier bag and till receipt, noting that both bear the SHOE EXPRESS trade mark. She next refers to documents 4 and 5 of exhibit JPW1, which consist of an extract from the April 1998 edition of the Cambridge and District telephone directory, and the 1997/98 edition of the Cambridge Yellow pages, noting that these show the existence of SHOE EXPRESS stores in several
30 locations.

35 Ms Wood recounts a telephone conversation with an employee of Bentalls, in which she enquired about the availability of the Bentalls Express range of clothing (document 6 of exhibit JPW1 exhibits details of a registration in Class 25 for the trade mark BENTALLS EXPRESS). Ms Wood says that she was informed that the BENTALLS EXPRESS range of clothing was available in all of their stores. Ms Wood concludes her Declaration by giving her views on the distinctiveness of the mark under opposition.

40 The final Statutory Declaration comes from Dr Linda Carey, a researcher for RM Trade Marks Limited, a position she has held for two years.

45 Ms Carey says that she has regularly conducted trade mark searches and that the searches of the United Kingdom and Community trade mark registers (part of exhibit TY1) were for all trade mark applications and registrations for the marks EXPRESS and XPRESS in Class 25.

That concludes my review of the evidence insofar as it is relevant to these proceedings.

Decision

I will turn first to the ground under Section 1(1) and Section 3 of the Act. At the hearing Mr Tritton sought to have the grounds amended so as to remove the ground under subsection (a) of Section 3(1), to be replaced by subsection (b) on the basis that the mark is devoid of any distinctive character, and subsection (c) because the mark applied for describes a characteristic of the style of operation of a retailer of clothing, namely an express service. The ground under Section 3(6) was also dropped. After hearing submissions from both sides I determined that the amended grounds should be admitted. The revised grounds were foreshadowed in the evidence and any possible disadvantage to the applicants, who had indicated that they would not wish to see the matter delayed, could be avoided by granting leave to file evidence directed at the amended grounds, any additional work to be reflected in any award of costs. No evidence was filed.

The opposition stands, therefore, as one under Section 3(1)(b) and (c), and Section 5(2)(b). I turn first to consider the grounds under Section 3(1). That section reads as follows:

3.(1) The following shall not be registered -

(a)

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or rendering of services, or other characteristics of goods or services,

(d)

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

I begin by looking at how the law stands. In the *British Sugar Plc v James Robertson & Sons Ltd (TREAT)* trade mark case, (1996) RPC 9, Mr Justice Jacob said:

“Next is “Treat” within Section 3(1)(b). What does *devoid of any distinctive character* mean? I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark? A meaningless word or a word inappropriate for the goods concerned (“North Pole” for bananas) can clearly do. But a common laudatory word such as “Treat” is, absent from use and recognition as a trade mark, in itself (I hesitate to borrow the word *inherently* from the old Act but the idea is much the same) devoid of any distinctive character.”

The meaning of “devoid of any distinctive character” was addressed by Lord Justice Robert

Walker in an appeal by Proctor & Gamble Limited in relation to their bottle marks ([1999] RPC 673) who commented as follows:

5 Despite the fairly strong language of s.3(1)(b), “devoid of any distinctive character” - and Mr Morcom emphasised the word “any” - that provision must in my judgement be directed to a visible sign or combination of signs which can by itself readily distinguish one trader’s product - in this case an ordinary, inexpensive household product - from that of another competing trader”.

10 In the Home Sopping case Mr Simon Thorley sitting as the Appointed Person cited with approval the decision in the Proctor & Gamble case and went on to say:

15 In my judgement, Mr McCall is placing too light a restriction upon Section 3(1)(b) when he suggests that a mere spark of distinctiveness is enough.

20 I am bound, and with respect, agree with the reasoning of Robert Walker LJ. One must have regard to the mark as a whole, and ask whether the combination of signs contained in the trade mark can by itself readily distinguish the products or services of one trader from those of another.

25 Mr Tritton argued that the mark is the phonetic equivalent of the ordinary English word EXPRESS which is a word that describes a type of service that a retailer may wish to provide; an express service; and has a very natural use in the context of the sale and advertisement of clothing. He dismissed the get up as ornamentation and simply not sufficient to get round the lack of registrability.

30 Taken in order, the first question posed by Mr Tritton is whether XPRESS is the equivalent of EXPRESS. In the XPRESSLINK case (1999 ETMR 146) to which I was referred, it was accepted that “people seeing, saying and hearing the word XPRESSLINK will regard it as the semantic equivalent of the words EXPRESS LINK”. The loss of the initial letter E in EXPRESS makes some minor difference to the appearance, but when spoken or heard the misspelling will not be apparent. Consequently I would not dispute that visually XPRESS is close in appearance to EXPRESS and would be indistinguishable from the latter when spoken.

35 The next question is, assuming that the mark will be seen as and regarded as the phonetic equivalent of the ordinary word EXPRESS, is it one which is barred from prima facie acceptance under the provisions of Section 3(1)(b) and (c). I was referred to the SUIT EXPRESS trade mark case (unreported) in which an application was made to register the words SUIT EXPRESS in respect of clothing, footwear and headgear and had been opposed, inter alia, under Section 3(1)(b) and (c). In his decision the Hearing Officer said:

40 20. Mr Arnold submitted that the words ‘SUIT EXPRESS’ consisted exclusively of a sign that may serve, in trade, to designate a characteristic of the goods at issue and was, consequently, devoid of any distinctive character. In response to a question from me, Mr Arnold explained that the basis of this objection was that the applicant’s mark described a suit (of clothes) “made or purchased rapidly.” In support of this submission he referred me to the decision of The Appointed Person in Siemen’s

Application, 1999 ETMR 146. In that case Mr Hobbs QC considered the word 'XPRESSLINK' to be equivalent to 'Express Link', which he concluded was a sign that may serve, in trade, to designate the intended purpose (rapid data transmission) of the goods (telecommunications apparatus).

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21. There are two strands to Mr Arnold's argument. Firstly, it is suggested that other clothing traders may use the words 'SUIT EXPRESS' to convey the message that they will find the customer a suit to his or her requirements very quickly. I do not consider that such a statement says anything about the characteristics of the goods themselves. This is readily distinguishable from the facts in Siemens' Application where there was little doubt that the words 'Express Link' could serve to designate a characteristic of the goods at issue. The most that can be said of the first usage postulated by Mr Arnold, is that the words may say something about the style of the applicant's retail operation. There may be cases where such indications are open to objection under Section 3(1)(b) even though the sign does not describe characteristics of the goods listed in the application. "Open every day" and "better customer service" would clearly fall within this category. I do not believe that the words "Suit Express" are open to such an objection. The most that can be said about the words is that they allude to a (possible) style of retail operation. That is not enough to justify the refusal of the applicant's mark.

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If the words SUIT EXPRESS say something about the style of the applicant's retail operation rather than describe a characteristic of the goods, the same must apply to the word EXPRESS alone. The Hearing Officer went on to say that he considered the word SUIT to impart the necessary degree of distinctiveness to EXPRESS for the mark to be registrable, although did not say that EXPRESS on its own would be any different. I do, however accept, as did the Hearing Officer in that case, that the word EXPRESS on its own has less in the way of distinctiveness than SUIT EXPRESS.

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Finally, setting aside the question of whether XPRESS (or in other words EXPRESS) is prima facie registrable, there is the fact that if the mark is a word, it is represented in what can only be described as a stylised lettering. There is no evidence that this is a recognised or commonly used font, and I do not see how I can say that the average consumer of the goods in question will be used to seeing words represented in this style, much less that they will recognise the mark as being letters forming the word XPRESS. That the initial letter is separated in its own border makes this even less likely. The question I have to consider is whether the surplus is such that the mark is capable of performing the function of a trade mark, and in my view it is.

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I come to the view that the degree of stylisation is such that the mark is unlikely to be seen simply as the letters XPRESS (and by extension EXPRESS), and even if it were, that this is not a word which either describes a characteristic or is prima facie incapable of distinguishing the goods in question. Consequently, the grounds founded under Section 3(1)(b) and (c) fail.

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Turning to the ground founded under Section 5(2)(b) of the Act, which reads as follows:

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

(a)

5 (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.

10 The term 'earlier trade mark' is itself defined in Section 6 as follows:

6 (1) In this Act an earlier trade mark means -

15 (a) a registered trade mark, international trade mark (United Kingdom) 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,

20 I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 2, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schufabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] 45 F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

25 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;

30 (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 of them he has kept in his mind; *Lloyd Schufabrik Meyer & Co. GmbH v Klijsen Handel B.V.* paragraph 27;

35 (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; 15 (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;

40 (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*, paragraph 17;

45 (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;

5 (g) mere association, in the sense that the later mark brings the earlier mark to 30 mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*, paragraph 26;

10 (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;

15 (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.

20 I do not dispute that the opponent's mark SUIT EXPRESS is a registrable mark. I do not, however, consider it to have a high degree of distinctiveness prima facie, and there is scant evidence on which to assess any acquired distinctiveness. That said, the respective goods are self evidently the same, and there being nothing to suggest that there is any difference in the customer base, eg, one being high quality bespoke, the other mass market, I can only conclude that notionally the average consumer in each case is one and the same.

25 A relevant consideration is the manner in which the consumer will encounter and select the goods, in this case, clothing. In the *React Music Ltd v Update Clothing Ltd* (29 June 1999), Mr Simon Thorley QC, sitting as The Appointed Person said:

30 Ms Clark drew my attention to the fact that in relation to clothing of the type for which the mark is to be registered, anybody using the mark aurally would be informed to some extent of the nature of the goods they were proposing to purchase; they will therefore know of a mark; and they will know what they want. I think there is force in this in the context of purchasing clothes. The Hearing Officer was prepared on his own experience to hold that the initial selection of goods would be made by eye, and I believe this is correct. I must therefore, in taking into account the likelihood of aural
35 confusion, bear in mind the fact that the primary use of the trade marks in the purchasing of clothes is a visual act.

40 Though one consists of the word XPRESS and the other the words SUIT EXPRESS (and they therefore share a common element) the respective marks are visually quite different. Thus, bearing in mind the above, I see no real likelihood of one being confused for the other. For there to be any shred of aural similarity requires the viewer to be able to recognise the applicant's mark as the letters XPRESS, and setting aside my doubts that this will be the case, it still has to be borne in mind that EXPRESS is but one element of the opponents' mark, so
45 the most that can be said is that the applicant's mark sounds the same as part of the opponent's mark.

The opponent's case relies upon the consumer reaching the conclusion that the two marks are essentially EXPRESS marks, and confusion through imperfect recollection. That "The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details." (Sabel Puma) would suggest that there is little merit in such an argument in this case. However, where a mark is made up of a number of components includes a strong discernable element (eg, an invented word), or an ordinary word or combination of words represented in an unusual manner (such as misspelling and/or conjoined), it may well be that this will register and stick in the mind of the consumer, although in such cases (where the comparison is based on only one of a number of elements) the degree of similarity of that element in my view will need to be significant for the possibility of a likelihood of confusion to occur. Where, as in this case, a mark is made up of two less distinctive elements used in conjunction, I take the view that another mark having some identity in one element alone is unlikely to be sufficient to find there to be a real likelihood of the two marks being confused.

Adopting the "global" view advocated, I have little difficulty in coming to the position that there is no real likelihood of confusion, and consequently, the ground under Section 5(2)(b) also fails.

The opposition having failed on all grounds I order the opponents to pay the applicants the sum of £435 as a contribution towards their costs. This sum 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 2ND day of July 2001

**Mike Foley
for the Registrar
The Comptroller General**