

## **TRADE MARKS ACT 1994**

**IN THE MATTER OF Application N°:2118034  
by GT Interactive Software (Europe) Ltd  
to register a Trade Mark and**

**IN THE MATTER OF Opposition N°: 49598  
by Fashion Box SPA.**

1. On 9<sup>th</sup> December 1996 GT Interactive Software (Europe) Ltd., The Old Grammar School, 248 Marylebone Road, London NW1 6JT applied to register the following trade mark:



Following assignment, the application now stands in the name of Infogrames, Incorporated, 417 Fifth Avenue, New York 10016. These goods are specified with the mark:

Class 9: 'Computer games, interactive computer games, video games, virtual reality games; computer software, computer programmes, cd-roms, compact discs, cartridges and tapes all bearing sound and/or images; recorded media; non-printed matter; parts and fittings for all the aforesaid goods'.

Class 28: 'Toys, games and playthings; electronic games; computer games, interactive computer games, video games, virtual reality games, interactive computer games, electronic amusement apparatus; parts and fittings for all the aforesaid goods'.

2. The opponents are Fashion Box SPA, an Italian joint stock company. Their grounds for objection are cited as under ss. 1(1), 3(3), 3(4) and 3(6) of the Act, and under ss. 5(2), 5(3) and 5(4). They are the proprietors of the marks shown in the Annex. No hearing was requested, and the following decision is based on my best view of the evidence submitted by the parties.
3. As for the grounds under ss. 1(1), 3(3), 3(4) and 3(6) of the Act, all of these fail. S.1(1) contains the definition of a trade mark, and is not a proper ground for refusal of an application under the Act. Perhaps the opponents' agents intended to refer to s 3(1)(a); if so, I see no reason why the mark in suite does not perform the function of a trade mark for the goods at issue. I further see no reason why the mark, inherently, is precluded from registration by ss. 3(3) and 3(4) of the Act. Finally, no evidence is given as to why the application should fail because of it was an exercise of 'bad faith', on behalf of the applicants.
4. The opponents best case, which I am sure they accept themselves, is under the relative grounds of ss. 5(2) to (4). As the reputation/goodwill the opponents possess under their mark has a bearing on each of these, I should consider this next, based on a review of their evidence. This appears in the form of a Statutory Declaration by Attilio Biancardi, the Managing Director of Fashion Box SpA, the opponents. There is rather a substantial amount of material evidence but, it perhaps, proves less than its volume might indicate. I make the following observations on the various goods listed in Mr Biancardi's Declaration.

5. Clothing. Mr Biancardi describes these as the opponents' 'core goods' listing a range of clothing in paragraph 4 of his Declaration. A large number of 'selected' invoices are enclosed in Exhibit AB4, which relate to the '...commercialisation of clothing in the United Kingdom under the REPLAY trade mark of Fashion Box.' 'Commercialisation' is an odd word to use, but I take it to mean marketing, including sales. Very few of the invoices contain a reference to the REPLAY mark, but the applicants have not questioned Mr Biancardi's statement that the sales took place under this sign. I have carefully studied the invoice documents, and note the following:

(1) There are a very large number of invoice documents. This is less impressive than it seems initially, because a number can be excluded on the following basis:

- C They are after the relevant date of December 1996
- C They are copies. I regard this as rather misleading by the opponents; if 1996 is taken as an example, nearly half of the individual documents enclosed were copies. In 1993, over half were copies. Of the 1992 invoices, three copies of the same invoice were included and half over all were copies, and the same with 1991.
- C Several of the documents were unreadable

(2) They extend over the period from 1996 back to 1984.

(3) Taking data from valid invoices, turnover in clothing in pounds sterling is:

Invoice Sales (£)	Year
562138.81	1996
484109.39	1995
45692.44	1994
264342.75	1993
235385.53	1992
123123.46	1991
38727.06	1990
20428.55	pre-1989

6. Also enclosed as evidence of a reputation in clothing are the 'front pages' of '...various catalogues of goods for sale in the United Kingdom, and to Fashion Box's clients worldwide under the REPLAY. The REPLAY trade mark also appears prominently on catalogues distributed to clients within United Kingdom and worldwide which are issued twice a year with every new collection'. Examples enclosed are not clearly for the UK market, for instance, a promotion for REPLAY BLUE JEANS is directed at the Italian, US and Germany market - and most fall beyond the relevant date.

7. Despite these various comments, there is enough here for me to conclude that the opponents have sold clothing under the REPLAY mark for many years in the UK. I find that the opponents do possess a reputation under this mark for 'clothing'.
8. Paper Goods. The opponents' evidence on these goods is less convincing. Mr Biancardi says the REPLAY mark has also been used in respect of goods made from paper and cardboard, like diaries and printed matter, as well as stationary falling in Class 16, but for 'promotional purposes.' I do not believe I can regard this as trade mark use, for these products. Rather it is advertising that seeks to promote clothing, and advances the goodwill I have already concluded exists under the name in those items. I do not believe that any consumer would believe, on seeing stationary carrying the mark REPLAY, that the opponents were involved in the stationary business. Anyhow, there is little, if any, material evidence of sales of these products in the UK. Mr Biancardi refers to four invoices, one to Greece, one to Japan and two to Saudi Arabia. There are passing references to promotional material on some of these.
9. Eyewear. We are told, that '..the REPLAY trade mark has also been used in connection with eyewear products failing in international class 9..' in the UK since 1997. Unfortunately this is after the December 1996, and therefore irrelevant.
10. Perfumery and cosmetics. Mr Biancardi says:

'In the United Kingdom the REPLAY trade mark has been used in connection with soaps, perfumery, essential oils, and cosmetics failing in international class 3. There are now produced and shown to me marked as Exhibit AB7 photographs reproducing perfumes sold in the United Kingdom under the trade mark REPLAY as well as an invoice from Fashion Box licensee's, the company HENKEL SpA MORRIS Divisione Profumi of Ponte della Pietra, Frosinone Italy, showing the actual commercialisation of these goods'.

However, the invoices are after the relevant date, and do not appear to have been targeted at the UK.

11. Imitation jewellery. Similar claims are made of these products. Again, there is no material evidence - and no claim made - that they were available in the UK before the relevant date.
12. Leather products. The mark, apparently, has been used in connection with products made from leather, and imitation leather, such as travelling bags, umbrellas and parasols. I am referred to Exhibit AB9, which depicts some rather poor photocopies of these products, and another large collection of invoices. I have studied these carefully, and note references to 'leather': belts (by far the most common), jackets (rather less) and some occasional mention of hats and gloves. These products I regard as clothing, and do nothing to extend the portfolio of goods for which the opponents possess a reputation. There are some references to wallets and 'keychains' constructed from leather. Finally, in 1994 some 60 or so 'sacks', mostly of cotton, around 16 of leather, were sold. I do not think any of this is enough to grant the opponents a reputation in the sale of 'travelling bags, umbrellas and parasols' under the name REPLAY. I suspect the 'sacks' sold were ancillary to their sales of clothing, and used to promote the same, in an analogous way to the stationary items mentioned above.
13. Mr Biancardi refers to sales figures, in pounds sterling, made under the sign, giving the 'total turnover of goods bearing the REPLAY trade mark'. Those that took place after the relevant date are:

Year	Amount
1984	312,061
1985	442,066
1986	627,763
1987	682,2531
1988	629,993
1989	342,624
1990	536,480
1991	683,274
1992	1,099,911
1993	1,775,163
1994	2,188,997
1995	2,215,637
1996	2,383,166

There is no 'breakdown' of this data according to products sold, but I think I am safe to conclude, after my assessment of the evidence above, that it applies in the vast extent, to clothing, and this is where the opponents reputation lies. Two million pounds worth of turnover per annum in the years leading up to the application is not insignificant, but not huge either, when the turnover of the clothing industry as a whole is considered. However, I surmise from the rest of the opponents' evidence that they are sell high quality, high value goods, which carry a certain cachet.

14. The rest of Mr Biancardi's is, in the main, of doubtful relevance. He refers to advertising of the mark, but it is hard to establish how much of this is specific to the UK, though a small amount of it is (Exhibit AB14). I note from Exhibit AB12 that there are no REPLAY stores in this country, and that any trade their has been has taken place via the distributors mentioned in paragraph 3 of Mr Biancardi's Statement. I have no doubt that the opponents are a fairly successful worldwide purveyor of quality Italian made clothing. Much of their evidence confirms this, but much less actually demonstrates a presence in the UK market. Here they have some reputation for clothing under the mark REPLAY; but for nothing else.

### Decision

15. S. 5(2) states:

'(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'.

The opponents are the proprietors of 'earlier marks' shown in the ANNEX, by virtue of s. 6(1)(a). This latter provision includes registered marks and Community trade marks which

have ‘...a date of application for registration earlier than that of the trade mark in question..’. Thus, the opponents earlier marks are N<sup>os</sup>. 1201267, 1487709, 1551752, 1339503, 2020579, 2019218 and 2019220 (their UK registrations), and N<sup>o</sup>. 259929 (Community registration). There is another Community application (N<sup>o</sup>. 520080), but this was filed after the date of the mark in suite and, thus, is not an ‘earlier mark’.

16. In my view, the opponents’ best case is founded on their UK registration N<sup>os</sup>. 1201267, 1487709 and 1551752. These are all REPLAY word marks and, are identical or very similar to the applicants’ mark. The other earlier marks contain device elements with the word REPLAY, further words (REPLAY GAZETTE) or are less similar altogether (E-PLAY).
17. I note the rather limited embellishments in the applicants’ mark; these add little and I take it to, essentially, duplicate the opponents’ REPLAY mark. Thus, the issue of confusing similarity turns, in my view, on the similarity of the goods in question.
18. I think I can categorise the opponents goods as clothing (including hats and shoes), spectacles, jewellery, watches and clocks and a range of goods in Class 18, such as, handbags, suitcases, trunks, travelling bags, wallets, briefcases, and umbrellas. The applicants goods are:

Class 9: ‘Computer games, interactive computer games, video games, virtual reality games; computer software, computer programmes, cd-roms, compact discs, cartridges and tapes all bearing sound and/or images; recorded media; non-printed matter; parts and fittings for all the aforesaid goods’.

Class 28: ‘Toys, games and playthings; electronic games; computer games, interactive computer games, video games, virtual reality games, interactive computer games, electronic amusement apparatus; parts and fittings for all the aforesaid goods’.

These, perhaps, can be classified as toys and/or games and, where they are computerised, with the associated software and hardware.

19. The test for similarity of goods is that established by Jacob J in *British Sugar plc v James Robertson & Sons Ltd* [1996] 9 RPC 281, which has been confirmed in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] ETMR:

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

To this list, Jacob J included the respective trade channels through which the goods reach the market.

20. It is usual to go through the criteria listed, one by one, so as to determine the identity, or otherwise, of the items at issue. I’m not sure this is necessary here because, in my view, it is fairly obvious that they are different. For the sake of completeness, however: their nature is different, as is their method of use and so are their trade channels. The goods are neither in competition or complementary. What of the end users? Of course, all would fall into the overall category of ‘consumers’, but I would think that the purchasers of computer games and

toys might tend to be children or younger adults. Of course, the latter buy clothes, and purchasers of computer games and toys may be doing so on behalf of children or younger adults, but neither are likely to be of the same set of mind when they are buying clothing or set out to acquire toys or games.

21. There is extensive case law on s. 5(2). Would an average consumer of the goods/services in question (*Sabel BV v Puma AG* [1998] RPC 199, page 224), who is deemed to be reasonably well informed and reasonably circumspect and observant, on seeing REPLAY on clothing and then on computer games and toys would be confused? I do not believe so. It is, of course, the case that a lesser degree of similarity between the goods at issue might be offset by a greater degree of similarity between the marks (*Canon* page 7, paragraph 17), but this does not apply when the goods are unrelated, as here. They are not 'less similar' than certain items which might be regarded as 'very similar' or 'similar'. They are just plain different.
22. In coming to this conclusion, I have taken account of the reputation that the opponents possess for clothing, and I do not think it helps them. The character of their name is not 'highly distinctive', either *per se* or because of the use that has been made of it in the market place (see *Sabel* page 8, paragraph 24). The opponents have a, perhaps, more than modest reputation for clothing sales in the UK. But even if it was vast, that type of use would not be enough to save their opposition here. The goods are too dissimilar.
23. Finally, there is no evidence to suggest that manufacturers of clothing, spectacles etc., are likely to be taken as economically linked undertakings (see *Canon* page 9, paragraph 29).
24. I notice that one of the controllers of the opponents' distribution of their clothing in the UK is called Fashion Toys SpA. Despite the name, there is nothing to indicate a trade in toys in the UK. The name could be another reference to clothing, i.e. as 'toys' (playthings?) of fashion.
25. The next ground of objection is under s. 5(3). This states:

'(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'.
26. It is clear that similarity of goods is not a requirement under this section. However, for the section to bar registration of a mark certain conditions must apply. In *RBS Advanta v Barclays Bank plc* [1996 RPC] 307 Laddie J considered the meaning of the proviso to Section 10(6) of the Act, which deals with comparative advertising, but contains wording identical with the wording in Section 5(3) of the Act. Laddie J expressed the following view on the meaning of the above words in that context:

‘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 mark which is above the level of *de minimis*.’

27. In *Corgi Trade Mark* [1999] RPC 15, 549 at 558, Geoffrey Hobbs, acting as the Appointed Person, said:

‘It seems to me ... that section 5(3) provides “extensive protection to those trade marks which have a reputation” (see the ninth recital to Council Directive 89/104/EEC) by specifying particular circumstances in which the protection enjoyed by an “earlier trade mark” may be taken to extend to cases involving the use of the same or similar mark in relation to goods or services which are not similar; those circumstances exist when: (i) the “earlier trade mark” can be shown to possess a distinctive character enhanced by a reputation acquired through use in relation to goods or services of the kind for which it is registered; and (ii) it can be shown that use of the later mark in relation to goods or services of the kind for which it is registered (or sought to be registered) would without due cause capture the distinctive character or repute of the “earlier trade mark” and exploit it positively (by taking unfair advantage of it) or negatively (by subjecting it to the effects of detrimental use).’

Thus, one of the objectives of s 5(3) is to protect against the illegitimate exploitation of the distinctive character or reputation of a mark. The marks at issue are (more or less) identical. Against this, however, is the fact that REPLAY is not a fancy word and has a clear dictionary meaning. Unlike the KODAK mark, for example, it does not possess the inherent distinctiveness of a wholly invented word, coupled with a massive reputation.

28. Further, the reputation the opponents’ do have is of a specific type, not vast, residing in clothing. Despite the contentions made in their evidence, I do not believe that this reputation extends beyond clothing in the UK.
29. In view of this, I find it difficult to conceive how registration of the applicants’ mark will in some way parasitise on the opponents’ reputation. It would be necessary for the distinctive character or reputation of the earlier trade mark to increase the marketability of the defendants’ products in order to provide them with an unfair advantage of the kind contemplated by Section 5(3). I do not see how that would occur against the background of the opponents’ reputation for clothing and the applicants’ interest in toys and computer games.
30. Also under this section, I need to consider whether registration of the applicants’ mark would harm the character or repute of the registered mark which is above the level of *de minimis*. I think it is helpful, only by way of illustration of the species of harm that s. 5(3) might protect against, to consider *Hack’s Application* [1941] RPC 91. Here, the proprietors of a well known mark (BLACK MAGIC), registered for chocolate and chocolates, succeeded in opposing an application to register the same mark for ‘laxatives other than laxatives made with chocolate.’ The potential for damage to the reputation of the earlier trade mark in this case, with consequential damage to its ability to add value to the goods it has been used for, is obvious. One might conceive that a purveyor of exceptionally gruesome - or prurient - computer games might denigrate the reputation of a particularly respectable and traditional clothing firm of very significant reputation. This would be a matter for evidence, for which

there is none here. And I think I can fairly note the difficulty of categorising the advertising commonly employed by many clothing companies these days as traditional or staid. The opponents' own promotional material is fairly typical (Exhibit AB14).

31. *Oasis Stores Ltd's Trade Mark Application* [1998] RPC 631, provides criteria against which this limb of s. 5(3) should be tested. These are:
1. The inherent distinctiveness of the earlier trade mark;
  2. The extent of the reputation that the earlier mark enjoys;
  3. The range of goods or services for which the earlier mark enjoys a reputation;
  4. The uniqueness or otherwise of the mark in the market place;
  5. Whether the respective goods/services, although dissimilar, are in some way related or likely to be sold through the same outlets;
  6. Whether the earlier trade mark will be any less distinctive for the goods/services for which it has a reputation than it was before.
32. I do not consider the mark at issue to be of particular inherent distinctiveness. In relation to points 2, 3 and 5, the goods for which the opponents possess a reputation are very different from those of the applicants. As for factor 4, I am unable to conclude anything as there is no evidence before me to suggest uniqueness or otherwise. And, finally, there is no reason for me to consider that the opponents' services will be any less distinctive as the result of registration and use of the applicants' mark.
33. In view of the above detailed considerations I must conclude that the applicants' trade mark has not been shown to take unfair advantage of the distinctive character or repute of the opponents' or cause damage to that character or repute. The onus is on the opponents to establish their case under this section, that is, to show how the criteria identified by Mr Justice Laddie above would follow if the applicants' mark is registered. They have not done so and this ground fails.
34. The final ground of objection is that under s. 5(4)(a);
- '(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, ..'
- The three elements of the familiar test for passing off under this section are goodwill under the mark (at the relevant (the application) date of 9<sup>th</sup> December 1996), a likelihood of misrepresentation and damage (see *Wild Child* [1998] 14 RPC 455).
35. I have already found that the opponents are the possessors of some goodwill under their mark REPLAY for clothing. However, following my finding above under s 5(2), I do not believe



that misrepresentation is likely if the applicants use their mark in a normal and fair manner. The goods for which the opponents goodwill has been established (clothing) are too dissimilar to the applicants games and toys. I note that there is no strict requirement for a 'common field of activity' between marks for misrepresentation to occur under passing off, as was found in the *LEGO* case (see *Lego Systems Aktieselskab and another v Lego M Lemelstrich Ltd* [1983] FSR 155). However, in that instance a very famous *invented* mark was at issue, not a known word as here. Further, the opponents cannot claim to match the reputation residing in the LEGO name. This ground fails, and the opposition fails.

36. The applicants are entitled to a contribution towards their costs. I order the opponents to pay them £400. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.




**Dated this 4<sup>TH</sup> Day of October 2001.**

**Dr W J Trott  
Principal Hearing Officer  
For the Registrar, the Comptroller General**


## ANNEX

UK Marks

Mark	Number	Filing date	Goods
REPLAY	1201267	05.08.1983	‘Class 25: Articles of outer-clothing, but not including skirts or slacks for women, or any goods of the same description as skirts or slacks for women’.
	1487709	08.01.1992	<p>‘Perfumes and perfumery; soaps, toilet soaps; essential oils for personal use; cosmetics; deodorants for personal use; creams, lotions and oils for the face and the body; cleansing milks, creams and oils; make-up creams; beauty masks; make-up removers; eye shadows; lipsticks; mascara; rouge; crayons for the eyes and the lips; powders, creams, oils and lotions, all for suntanning and after sun exposure; pre and after shave creams and lotions; talcum powders; bath salts, foams and oils; after-bath creams and lotions; shampoos; depilatory preparations; nail polishes; hair lotions; dentifrices; all included in Class 3’.</p> <p>‘Spectacles; spectacle frames; spectacle cases; parts and fittings for all the aforesaid goods; all included in Class 9’.</p> <p>‘Jewellery and costume jewellery; rings, bracelets, necklaces, hair-clips, tie-bars, scarf rings, pendants, clips, cufflinks, earrings, keyholders, brooches, pins; watches, clocks; horological and chronometric instruments; parts and fittings for the aforesaid goods; all included in Class 14’.</p> <p>‘Handbags, suitcases, trunks, travelling bags, vanity cases sold empty, purses, billfolds, attache cases, wallets, briefcases, belts, key-cases, passport cases, business and credit card cases; umbrellas; all included in Class 18’.</p>
	1551752	27.10.1993	‘Coats, overcoats, jerkins, jackets, trousers, skirts, shirts and blouses, hosiery, pullovers, sweaters, cardigans, tracksuits, sweatshirts, foulards, ties, socks and stockings, hats, caps, boots, shoes and slippers; all included in Class 25’.

	1339503	24.03.1988	Articles of outer-clothing included in Class 25.
REPLAY GAZETTE	2020579	15.05.1995	Class 16: 'Magazines, newspapers, periodicals, and printed publications; but not including magazines relating to puzzles and crosswords'.
	2019218	01.05.1995	Class 25: 'Coats, overcoats, jerkins, trousers, jackets, shirts, T-shirts, skirts, knitwear, sport track suits, sweat shirts, socks and stockings, neckties, hats, berets, foulards, footwear'.
	2019220	01.05.1995	

Community Marks

Mark	Number	Filing date	Goods
REPLAY	520080	18.04.1997	<p>Class 3: 'Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices'.</p> <p>Class 9: 'Spectacles; scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus'.</p> <p>Class 14: 'Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments'.</p> <p>Class 16: 'Magazines, newspapers, periodicals, printed publications; paper, cardboard, articles of paper; office requisites except magazines and periodicals relating to crosswords and puzzles, writing and drawing implements and all related articles'.</p> <p>Class 18: 'Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery'.</p> <p>Class 25: 'Clothing, footwear, headgear'.</p> <p>Class 28: 'Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees'.</p> <p>Class 35: 'Advertising; business management; business administration; office functions; shop window dressing'.</p> <p>Class 42: 'Transfer of know-how and licensing, consultancy relating to the installation and setting up of shops, exterior and interior design and furnishing of shops and related signs (except shop window dressing), cafeterias, cafés, catering, cocktail lounges, snack-bars, refreshments, restaurants, self-service restaurants, providing of food and drink'.</p>
	259929	20.05.1996	<p>Class 9: 'Spectacles [optics], spectacle cases, chains for spectacles, spectacle frames, spectacle glasses, pince-nez'.</p>