

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK REGISTRATION NO: 1398622
IN THE NAME OF PAISANO PUBLICATIONS INC**

AND

**IN THE MATTER OF AN APPLICATION FOR A DECLARATION OF
INVALIDITY THERETO UNDER NO: 9623 BY THE H.D. LEE COMPANY INC**

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AND

IN THE MATTER OF AN Application for a Declaration of Invalidity thereto under No 9623 by the H.D. Lee Company Inc

BACKGROUND

1. On 16 June 1997, The H.D. Lee Company Inc of Wilmington, Delaware, United States of America applied for a declaration of invalidity against registration No: 1398622 standing in the name of Paisano Publications Inc. The registration is in respect of the trade mark **EASYRIDERS** which stands registered in Class 25 for a specification of goods reading:

“Articles of outer clothing, T-shirts, sweat shirts, trousers, waistcoats, tank tops, bandanas; all included in Class 25”.

2. The mark was applied for on 14 September 1989 and the registration dates from 28 October 1994.

3. The grounds of the action were initially extensive. However, they were limited in both the applicants’ skeleton argument and at the hearing before me to the following single ground:

under the provisions of section 47(2) of the Act - the applicants contend that the mark should be declared invalid:

- under section 5(2) of the Act in that: (i) it is similar to earlier trade marks (details set out later in this decision) of the applicants which are registered for goods identical or similar to those for which the trade mark is protected and (ii) in that it is similar to an earlier trade mark of the applicants which is defined under section 6(1)(c) as a trade mark which at the date of application for registration of the trade mark in question was entitled to protection under the Paris Convention as a well known trade mark, (the applicants’ LEE RIDERS trade marks being well known marks in the United Kingdom).

4. The registered proprietors filed a counterstatement in which the grounds were denied.

5. Both sides asked for the Registrar to award costs in their favour and both sides filed evidence. The matter came to be heard on 11 June 2001. The applicants for invalidation were represented by Ms Anna Carboni of Linklaters, Solicitors. The registered proprietors were represented by Mr Hornby of Clifford Chance, Solicitors.

APPLICANTS FOR INVALIDITY'S EVIDENCE

6. This consists a statutory declaration dated 7 January 1998 by Sharon Beard. Ms Beard explains that she is the Secretary of The H.D.Lee Company Inc adding that she is authorised to speak on the applicants' behalf. The information in her declaration comes either from her personal knowledge or from the records of the applicants to which she has full access. Ms Beard states that she is fully acquainted with the business and goods manufactured by LEE in both the United States and the United Kingdom adding that she is fully aware of the methods used by traders to market, advertise and promote their merchandise.

7. The following relevant facts emerge from Ms Beard's declaration:

- that the applicants are manufacturers and merchants of clothing goods, including jeans, shirts, t-shirts, sweatshirts, jackets, mens', women's, youths' and young girls' casual jeanswear. Lee is, says Ms Beard, a major company in the jeans and clothing industry in the United States, the United Kingdom and the world
- that the applicants are the registered proprietors of United Kingdom trade mark registration No's: 935408 and 938937 both for the trade mark LEE RIDERS and registered in Class 25
- that trade marks with the combined word RIDERS are well known in the United Kingdom to casual clothing purchasers as designating goods from LEE. Exhibit SAB2 consists of six statutory declarations which were originally filed in connection with the applicants' opposition to an application by the registered proprietor in relation to goods in Class 18. The declarations are from the following members of the trade: Stefan Pesticcio of Top Man, Cavan Cooper of American Classics, Stephen Docherty of Fosters Trading Company, John Mason of Littlewoods Home Shopping, Tim Whitworth of Best Trading and Julia Redman of Burton Menswear. All six declarations were filed in support of the applicants' contention that the registered proprietors EASYRIDER trade mark is confusingly similar to the applicants' LEE RIDERS trade marks. I do not propose to summarise each of the declarations here but bear them in mind in reaching my decision. However, reproduced below is an extract from the declaration of Stefan Pesticcio which I consider to be fairly typical of the content of the declarations filed. Having explained that he is a Buyer with Top Man with over nine years experience in the retail industry, Mr Pesticcio comments as follows:

“My company sells a variety of LEE jeans and casual clothing, including LEE RIDERS. The distinctive qualities about the jeans, are: the pocket plasters, the stitching, the logo, the quality and the fit. I do not associate the word RIDERS with any other clothing manufacturer except LEE. I cannot think of any clothing which includes the name RIDERS in it. I believe that the RIDERS series of marks is well known to UNITED KINGDOM casual clothing purchasers as indicating goods from the manufacturer of LEE jeans and other clothing.

Although our stores do stock leather clothing, I have not heard of the name EASYRIDERS in this context. I think that the general public regards the clothing and leather goods sections as closely related, particularly in smaller shops that sell leather goods, jeans and T-shirts together. If my company were to stock the Paisano EASYRIDERS leather goods I believe the public may assume that the EASYRIDERS goods had come from the same source as the RIDERS goods. I also believe that the public could be confused in relation to these products and names”.

REGISTERED PROPRIETORS' EVIDENCE

8. The registered proprietors' evidence consists of an affidavit dated 14 December 1998 by Robert Davis. Mr Davis explains that he is the Treasurer and Vice President of Finance at Paisano Publications Inc a position he has held since 1992. He confirms that he is authorised to make his declaration on the applicants behalf adding that the information comes from either his own personal knowledge or from the records of his company to which he has full access.

9. The following emerge from Mr Davis' affidavit:

- that the trade mark EASYRIDERS has been in use worldwide since at least the 1970s and has been used on a continuous basis in the United Kingdom since at least 1987-88
- that his company publishes a magazine under the name EASYRIDERS which is circulated worldwide and which relates to motorbikes and the world of motorcycling. Mr Davis believes that his company's magazine is the leading magazine in its field. Within the magazine, explains Mr Davis, the registered proprietors also advertise a range of goods including a range of clothing and footwear for sale to its readers by mail order. Mr Davis confirms that the registered proprietors sells under the trade mark all the goods the subject of the registration. Exhibit RD1 consists of three items of clothing bearing the trade mark
- that goods sold under the trade mark in the United Kingdom are promoted by placing advertisements in its EASYRIDERS magazine and by producing catalogues illustrating the range of goods available. Exhibits RD2, RD3, RD4 and RD5 consist of: copies of advertisements and catalogues dating from 1987, examples of pages from the applicants' web site, copies of invoices and shipping documents illustrating sale of goods under the trade mark by the applicants to customers in the United Kingdom and examples of name tags and neck and woven labels which are sewn into or onto the goods.

10. Mr Davis then turns his attention to the declaration of Ms Beard filed as the applicants' evidence- in- chief. Commenting on this evidence, Mr Davis makes the following points:

- that in so far as the declarants from the trade are concerned, Mr Davies' notes that each of the declarants state that their company or store sells LEE products. As such, Mr Davis concludes that none of the declarants can be independent of LEE. In addition, he comments that in his view the declarants have not taken into account the specific means by which his company sells goods under the mark ie. through mail-

orders placed by readers of their EASYRIDERS magazine or through the applicants' website.

APPLICANTS FOR INVALIDITY'S EVIDENCE IN REPLY

11. This consists of a statutory declaration dated 15 June 1999 by Mary Wotring. Ms Wotring explains that she is the Secretary of The H.D.Lee Company Inc for whom she has worked since 1979. She states that she is authorised to speak for the applicants in these proceedings adding that the information in her declaration comes either from her own knowledge or from the records of her company to which she has full access.

12. Having read Mr Davis' evidence for the registered proprietors, Ms Wotring makes the following comments:

- that the catalogues and advertisements provided by Mr Davis as exhibit RD2 do not demonstrate that goods bearing the trade mark have been available to customers in the United Kingdom. In Ms Wotring's view the exhibit indicates that the goods illustrated seem only to be offered for sale to customers in the United States
- that in relation to the invoices provided as exhibit 4 to Mr Davis' declaration, there is no indication that all the items listed bore the mark EASYRIDERS. That in so far as the invoices relate to goods sold under the EASYRIDERS mark, these are only in relation to videotapes, calendars and wallets
- in relation to the various declarations filed by members of the trade on the applicants behalf, Ms Wotring accepts that all the declarants sell goods produced by the applicants. However, she points out that they also sell other clothing goods and accessories, adding that they are all professional retailers who are knowledgeable of the trade relevant to these proceedings. She adds that none of the declarants is related to the applicants' group of companies and they have therefore provided completely independent trade evidence.

13. That concludes my review of the evidence in so far as I think it necessary.

DECISION

14. I turn to the ground upon which this application for a declaration of invalidity is founded. First of all Section 47(2) states:

"(2) The registration of a trade mark may be declared invalid on the ground -

- (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,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration."

15. As identical marks are clearly not involved here the objection must be based on Section 5(2)(b). This reads:

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

(a)

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

16. Section 6(1) of the Act deals with what constitutes an 'earlier trade mark' and reads:

"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,

(b)

(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark."

17. In determining matters it does not matter whether the earlier rights fall under (a) or (c), I need to compare the respective trade marks and goods and in doing so 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. 1, *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.

18. It is clear from these cases that:-

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

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, who is deemed to be reasonably well informed and reasonably circumspect and

observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* paragraph 27;

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;
- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG*, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

19. The registered proprietors accepted that the applicants' trade marks cover goods which are the same or similar to those of the registration in suit. The matter, therefore, turns on the marks themselves.

20. The applicants rely on the following registrations which date from 1968 and 1969 respectively and as such clearly qualify as earlier trade marks within the meaning of Section 6(1)(a) of the Act:

Registration No: 935408

Mark: LEE RIDERS - word only

Goods: Jeans being articles of clothing, and jackets.

Registration No: 938937



Goods: Jeans being articles of clothing, and trousers.

21. The registration is in respect of the trade mark EASYRIDERS presented as one word in block capital letters. In my view the opponents best case is in respect of registration No: 935408 which is for the words LEE RIDERS. If they cannot succeed in these proceedings on the basis of this registration they will not succeed in so far as the other registration is concerned, (as it includes an additional significant device element).

22. First of all it seems to me from the evidence filed by both sides that both have used their trade marks in the United Kingdom. However, it is possible to pick holes in the evidence eg the applicants in their evidence gave turnover figures for sales in the period 1990 to 1996 which is outside the relevant period here - I must consider whether at the date of application (14 September 1989) the trade mark in suit was barred from registration as a result of the provisions of Section 5(2)(b). For similar reasons the registered proprietors' evidence is also deficient. Thus, I would normally revert to consider matters on the basis of normal and fair use of both the registered proprietors' and the applicants' trade marks across the full range of goods covered by the respective specifications. (REACT Trade Mark [1999] RPC 285). However, I have 'expert evidence' in this case, submitted by the applicants for the declaration of invalidity. These are the copies of the statutory declarations exhibited by Ms Beard by Messrs Pesticcio, Cooper, Docherty, Mason, Whitworth and Julia Redman.

23. All of the declarations were sworn in 1997, some eight years after the material date in these proceedings and all of the declarants are distributors of the opponents' goods. At the hearing both sides urged me to give this expert evidence quite different weight. Mr Hornby (for the registered proprietors) pointed me to the timing of the declarations, adding that in his view the declarants could not be considered impartial given their business relationship with the opponents. Ms Carboni for the applicants accepted that the declarants did not address the position in 1989, but argued that it would be difficult to see why the situation would be so different at the date the declarations were made. She added that in view of the general knowledge of consumers one might think that they might be more sophisticated now and so less likely to be confused. In so far as the impartiality of the declarants were concerned, Ms Carboni conceded that all of the declarants do sell LEE products. That said, she noted that they were all from independent outlets who also sell their own or other people's brands. It is

as a result of this, that in Ms Carboni's view, the declarants were well placed to talk about the relevant customers and their reaction to the goods.

24. At the hearing I referred the parties to the decision of Mr Simon Thorley QC acting in his role as the Appointed Person in the LOADED trade mark case [SRIS O/455/00] and in particular his comments on the approach this Tribunal should adopt when considering expert evidence. Both parties at my suggestion and after the hearing provided written submissions on the application of the LOADED principles to the facts of this case. I do not propose to summarise these submissions in detail but bear them in mind in reaching my decision. However the conclusions the respective parties reach on the expert evidence in the light of the LOADED decision is reproduced below:

The registered proprietors' conclusions

"All "the expert evidence" submitted by Lee does not meet the standards set out in the Loaded case.

- (i) It is not clear that any of the six declarants has relevant expertise in relation to the matters on which they give evidence, at least at the relevant dates.
- (ii) No detailed reasoning is given in the declarations for the conclusions drawn. Indeed, each declaration would fit on a single sheet of A4, being about four paragraphs long.
- (iii) Impermissible conclusions about reputation and confusion are rife in this "evidence".
- (iv) In any event, the relevant dates of 1989 and 1993 are not addressed.

The six declarations should, therefore, be rejected in their entirety".

The applicants' conclusions

"Paisano is incorrect in asserting that the LOADED standards are not met. Each of Lee's expert witnesses gives evidence of their relevant experience which at the least can be said to put them in a position of being significantly more knowledgeable than either party's adviser or the Hearing Officer as to the relevant public's perception of Lee's RIDERS goods and the likelihood of confusion if Paisano uses the EASYRIDERS mark on clothing and leather goods.

It was open to Paisano to put forward trade witnesses whose views were contrary to those expressed by the six witnesses for Lee. It is notable that they did not do so.

Paisano cannot use the arrival of a new decision as an excuse for late attacks on the credibility of witnesses. That is the effect of many of its submissions. Paisano should have dealt with this by a request to cross examine. It did not. Accordingly, the evidence should stand and be taken into account."

At the hearing Ms Carboni also drew to my attention the comments of the (then) Vice Chancellor Sir Nicholas Browne-Wilkinson in *Guccio Gucci spa v Paolo Gucci* (1991) FSR 89 in which the Vice Chancellor observed (in relation to expert evidence):

“Plainly it is my decision as to whether or not people will be confused but why I should be required to make that decision on the basis of my own lack of information, rather than on the basis of expert advice from those who can tell me what the experience in that market is, I do not understand”.

25. It is clear from the above that the decision whether or not marks are confusingly similar is a matter for the Tribunal. However, it is equally clear that this decision can to some extent at least be influenced by the views of expert witnesses. In my view, in this case the most pertinent extracts from the six declarations from the expert witnesses are as follows:

Cavan Cooper - “...would stand a good chance of being confused....”

Stephen Docherty - “.....I would have some concern.....”, “...there may be some danger”

John Mason - “.....I think there could be a link between the two brands...”

Stefan Pesticcio - “.....I am slightly worried about the effects of confusion between the two brands.....”

Julia Redman - “ ...I feel strongly that the public would definitely be confused...”

Tim Whitworth - “.....I believe that there is a 50/50 possibility that people will confuse the two brands.....”.

26. But, given that these comments were made in respect of the clash between leather goods and clothing in another set of proceedings between the parties, Ms Carboni asked me to infer that if the word EASYRIDERS were to be used in relation to clothing there would be an even greater likelihood of confusion. That may be right but I think that with the exception of Ms Redman, the other declarants appear somewhat equivocal in their views as to the likelihood of confusion. I must also bear in mind that the declarations were signed some eight years after the material date in these proceedings i.e. September 1989. Thus I have no means, with any degree of assurance of judging whether the position in 1997 was any different to that in 1989 (or vice versa). In the circumstances, I do not consider it appropriate to consider this expert evidence and revert to the consideration of matters on the basis of the points laid down by the Court of Justice as set out above.

27. In doing I have regard to the average consumer of the goods in question which given that the goods are jeans, jackets and trousers will be a large portion of the adult population; that the goods are most likely to be bought on the basis of self selection and thus the visual impression of the respective trade marks assumes importance; that both trade marks, are as far as I am aware, distinctive in their nature (no submissions were made by either side to the contrary). On the latter point Mr Hornby asked me at the Hearing to take note of the fact that

EASY RIDER has motorcycling connotations arising from a film of that name. I decline to do so. I have no idea what the public's perception of the term is.

28. Taking account of the above, the applicants' trade marks No 935408 consists of the words LEE RIDERS, the registered proprietors the single word EASYRIDERS. Thus the second element of the first is the suffix of the latter. The first element of the applicants mark and the prefix element of the registered proprietors mark is completely different. LEE is a surname or male forename, EASY means simple. Neither element of the applicants' trade mark predominates, neither does the prefix or suffix of the registered proprietors' trade mark. But, for the purpose of comparison (and in particular when having regard to imperfect recollection) case law advises that it is the first element of a trade mark which assumes significance. Particularly here, where no particular concept is conveyed by either trade mark. On that basis, the difference in the trade marks far outweigh the similarities. Thus, in my view, the respective trade marks are not similar in any way sufficient to suggest that there exists a likelihood of confusion on the part of the public if the registered proprietors' trade mark remains on the register. Thus the provisions of Section 5(2)(b) do not apply in this case and the ground upon which the application for a declaration of invalidity was based under Section 47(2) have not been made out. The application is therefore dismissed.

29. The application for the declaration of invalidity having failed the registered proprietors are entitled to a contribution towards their costs. Although all but one of the grounds initially pleaded were dropped either prior to, or at the hearing, I do not propose to award costs outwith the scale, for much the same reasons indicated in my decision in opposition No: 42262. That being the case, I order the applicants to pay to the registered proprietors the sum of **£650** as a contribution towards their costs. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 13 day of November 2001.

M KNIGHT
For the Registrar
The Comptroller General