

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2238138
BY ALLIGATOR BOOKS LIMITED
TO REGISTER THE TRADE MARK:**



IN

CLASSES 9, 16, 41

AND

**THE OPPOSITION THERETO
UNDER No 52545
BY LA CHEMISE LACOSTE
BASED UPON THE EARLIER TRADE MARKS:**



**Trade Marks Act 1994
in the matter of application no 2238138
by Alligator Books Limited
to register the trade mark:**



**in classes 9, 16 and 41
and
the opposition thereto
under no 52545
by La Chemise Lacoste**

BACKGROUND

1) On 4 July 2000 Alligator Books Limited (ABL) applied to register the trade mark:



The application was published in the Trade Marks Journal on 14 February 2001 with the following specification:

electronic publications; publications in electronic format supplied on-line from a database or from facilities provided on the Internet or other networks; fridge magnets; but not including any such goods, in the form of, or relating to alligators

printed matter; printed publications; books, magazines, comics; photographs; albums; photograph albums; diaries; calendars; autograph books; address books; notebooks; writing paper and envelopes; wrapping paper; gift tags; greeting cards; postcards; invitation cards; posters; drawings; labels; stickers, decalcomanias, transfers; playing cards; bookmarkers; but not including any such goods, in the form of or relating to alligators

publishing services; publication of printed matter; electronic publishing

The goods and services are in classes 9, 16 and 41 respectively of the International Classification of Goods and Services.

2) On 14 May 2001 La Chemise Lacoste (LCL) filed a notice of opposition to this application.

3) LCL states that its trade mark registration no 1328565 of:



is similar to ABL's trade mark. LCL states that its earlier trade mark contains as its principal

element a device of a crocodile. It states that although the allusion in ABL's trade mark is to an alligator, the reptile appears to be a crocodile (because alligators have a shorter and broader snout than a crocodile). It states that the goods of its trade mark are either identical or similar to the goods and services of the application. The goods of its registration are:

paper, cardboard and goods made from these materials; printed matter; bookbinding materials; photographs; stationery; adhesives (stationery) or for household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging; ordinary playing cards; all included in Class 16; but not including goods relating to reptiles

(The above goods are in class 16 of the International Classification of Goods and Services.) Right to exclusive use of the word LACOSTE is disclaimed. LCL states that there exists a likelihood of confusion of the respective trade marks.

4) LCL goes on to list fifteen other trade marks. These fall within five categories.

5) The first category is a word and picture trade mark:



This trade mark is the subject of registration nos 1064402, 1103734, 1124565, 1213941, 1227476, 1230433 and 1259081 for the following goods respectively:

balls for games, tennis rackets, squash rackets, badminton rackets and golf clubs

spectacles, sunglasses and goggles for protective purposes

leather, imitation leather and articles included in Class 18 made from all the aforesaid materials; trunks, travelling bags, umbrellas and parasols; but not including any of the aforesaid goods made from reptile skin or from imitation reptile skin

motor land vehicles and sail boats

sails for boats; bags (in the nature of sacks) and sacks, all for holding sails

furniture, mirrors included in Class 20 and picture frames; shop fittings made wholly or principally of plastics or wood

jewellery, buckles, tie pins, earrings, brooches, bracelets and pendants, all made of precious metal or coated therewith; imitation jewellery; horological and chronometric instruments

The above goods are in classes 28, 9, 18, 12, 22, 20 and 14 respectively of the International Classification of Goods and Services.

In all the above cases the right to the exclusive use of the word LACOSTE is disclaimed.

6) The next category is the trade mark:



This trade mark is the subject of registration nos 749867, 974896 and 1178977 for the following goods respectively:

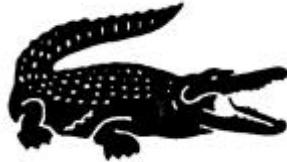
balls for games, tennis racquets, squash racquets, badminton racquets and golf clubs

sports shirts; gowns and dresses, all for women

articles of sports clothing, sweaters, pullovers, jackets, slacks, suits, gowns, dresses, socks being articles of clothing, stockings and articles of underclothing, but not including any of the aforesaid goods made from reptile skin or from imitation reptile skin

The above goods are in classes 28, 25 and 25 respectively of the International Classification of Goods and Services.

7) The third category is the trade mark:



This trade mark is the subject of registration nos 1221370, 1221371 and 1452623 for the following goods respectively:

articles of clothing, but not including maternity clothing or clothing made from reptile skin or from imitation reptile skin

lace, embroidery, ribbons, braid, all being textile smallwares; buttons, press buttons and slide fasteners, all included in Class 26

golf clubs, golf balls, tennis balls; tennis rackets, frames and strings; golf and tennis bags, golf tees, tennis racket grips and golf gloves; all included in Class 28

The above goods are in classes 25, 26 and 28 respectively of the International Classification of Goods and Services.

8) The penultimate category consists of registration no 1328764 of the trade mark:



The trade mark is registered for the following goods:

textile smallwares, buttons, hooks and eyes

The goods are in class 26 of the International Classification of Goods and Services.

9) The final category consists of registration no 929358 of the trade mark:



The trade mark is registered for the following goods:

perfumes, eau de cologne, non-medicated toilet preparations, cosmetics and soaps

The goods are in class 3 of the International Classification of Goods and Services.

Right to the exclusive use of the word LACOSTE is disclaimed.

10) There are certain very small differences between some of the trade marks in each category. They are so small that I do not consider that anything turns upon them in the context of this case.

11) LCL states that it has a massive reputation and goodwill in the crocodile device. It states that the crocodile device is one of the foremost, word-recognized (sic) brands for a wide variety of high quality goods centred on the clothing trade but extending widely over almost all areas of commerce. It states that the goods of these fifteen registrations are dissimilar to the goods and services of ABL's application. LCL states that use of ABL's trade mark would damage LCL's reputation in the crocodile device and would also take unfair advantage of the distinctive character or reputation its crocodile device. Consequently, registration of ABL's trade mark would be contrary to section 5(3) of the Trade Marks Act 1994 (the Act).

12) LCL states that use of ABL's trade mark would be prevented in the United Kingdom as trespassing upon its goodwill. Consequently, registration of ABL's trade would be contrary to section 5(4)(a) of the Act.

13) ABL filed a counterstatement. It comments on the differences between crocodiles and alligators. It denies that its trade mark is similar to LCL's registration no 1328565. ABL accepts that as far as its application covers printed matter that these goods are identical or similar to the goods of LCL's registration. However, it denies that the other goods are similar.

14) ABL denies the other grounds of opposition.

15) Both sides seek an award of costs.

16) After the completion of the evidence rounds I advised both sides that I believed a decision could be made without a hearing. However, the sides were advised that they retained their right to a hearing. Neither side requested a hearing, so I will make a decision after a careful study of the papers.

17) ABL submitted written submissions and I take these into account in reaching my decision.

EVIDENCE

Main evidence of LCL

Witness statement of John Allen Nicholas Prenn of 19 December 2001

18) Mr Prenn is the chairman of KBL Limited which he states is the sole distributor of Lacoste clothing in the United Kingdom (excluding Northern Ireland).

19) Mr Prenn states that sales of Lacoste clothing in the United Kingdom over the last three years (financial years ending on 30 April) exceeded £41 million at wholesale prices, which would equate to over £100 million retail. I presume from the date of the completion of the witness statement Mr Prenn is referring to the three years ending on 30 April 2001. Most of the final year is after the date of the application, the relevant date. He states that for the five years period prior to this period the value of wholesale sales was £21 million.

20) Mr Prenn states that his company deals with “high quality luxury clothing” which has been imported into the United Kingdom since the 1970s. However, he states that he knows that for many years other goods such as fragrance, soaps, shoes, frames for spectacles, sunglasses and watches “have been exploited” by Lacoste. He states that in 1999 45.1% of revenue generated by Lacoste in the United Kingdom was from the sale of clothes, 50.2 % from shoes, 4.2 % from glasses, 0.3% from perfume and 0.2% from watches. Mr Prenn does not explain how he knows this. He does not state from where the figures come. He does state that his company only deals with the clothing of LCL. I must, therefore, view Mr Prenn’s comments as pure hearsay. A very weak form of hearsay as there is no indication of source. Consequently, I can attribute very little weight to these comments.

21) Mr Prenn states that the Lacoste crocodile trade mark is one of the top five in terms of logo recognition. Again Mr Prenn gives no basis for this claim. He exhibits no supporting documentation. I can, therefore, attribute, little weight to his claim.

22) Mr Prenn states that his company has repeatedly carried out advertising campaigns “just featuring the Crocodile mark and the word Lacoste”. I am not sure what Mr Prenn means by this. Does he mean that some advertisements use the crocodile and some the word Lacoste. Or does he mean that the advertisements use the two elements in conjunction? He does not exhibit any of these advertisements and so I cannot know. Mr Prenn states that the advertisements have appeared in the following newspapers: “Mail on Sunday”, “Sunday Times”, “Sunday Express”, “Sun”, “Daily Mail”, “Daily Mirror”, “Daily Telegraph”, “Daily Express”, “The Times” and “The Guardian”. In the absence of any exhibits I do not know the

size or form of the advertisements. He does not give any figures in relation to advertising expenditure. Mr Prenn states that based on results obtained in 1996 the campaign reached 85.2% of ABC1C2 adults between the ages of 18 to 34 as well as 83% of ABC1 adults between the ages of 35-44. Mr Prenn does not explain where these figures come from. He exhibits no documentation to support them. Again, I can attribute little weight to his claim.

Witness statement of David Christopher Harrison dated 20 December 2001

23) Mr Harrison exhibits extracts from “Websters New International Dictionary” relating to alligator and crocodile.

Witness statement of Christian London dated 19 December 2001

24) Mr London is the legal manager of LCL. He states that LCL uses the crocodile emblem on clothing, footwear, headgear, leather goods, sport and leisure bags, umbrellas, cosmetics, eye-wear and watches. He states that LCL has used the crocodile emblem since 1933 and currently distributes goods bearing the emblem extensively throughout the world. Mr London does not specifically state that all these goods have been distributed in the United Kingdom.

25) Mr London states that the emblem has been registered in around 185 countries. He exhibits a few trade mark certificates with his witness statement.

Witness statement of Jean-Claude Fauvet dated 28 December 2001

26) Mr Fauvet is executive director of LCL.

27) Mr Fauvet states that goods bearing the crocodile emblem are distributed worldwide and in Great Britain through independent wholesalers and retailers appointed by LCL. He refers to the crocodile emblem “as shown”. However, there is only a blank space where, no doubt, a representation of the emblem should be. He states that LCL has boutiques worldwide and in Great Britain which are devoted solely to selling goods bearing the emblem. He exhibits at JF1 what look like prints of PowerPoint slides. These are dated 1 January 2001. They indicate, amongst other things, that in Great Britain there are 12 boutiques and 32 corners. I have assumed, in the absence of explanation, that corners indicates areas in department stores and the like.

28) Mr Fauvet states that there is extensive promotion by means of brochures, newsletters, catalogues, advertisements in newspapers and magazines and television commercials. He states that the emblem appears prominently on all catalogues and promotional material, advertisements and retail shop displays as well as on LCL’s stationery. Mr Fauvet states that this promotional material is distributed worldwide and circulated in every country or region where LCL’s goods are available. He states that the worldwide turnover in goods marked with the emblem is in the order of 600,000,000 US\$ per annum.

29) Mr Fauvet exhibits samples of promotional material. This is as follows:

- An article from “WWD” of 2 May 1995 on an award to Bernard Lacoste for “the use of novel cotton fabrications in the LaCoste company’s tennis shirt line”. “WWD” is a retailer’s newspaper from the United States. There is no sign of a crocodile in the article.

- A front page from “WWD” of 3 May 1995 and an attached page referring to the 1995 Global Recognition Award made to Bernard Lacoste and La Chemise Lacoste.
- An advertisement from “Vogue”. The front cover bears the month of April but no year, although it does bear an 0171 telephone number. The advertisement does not refer to any specific goods. It bears the word LACOSTE in large print. To the right hand side of LACOSTE appears a square in which there is a crocodile under which is written the word LACOSTE. The word is more prominent than in LCL’s registered trade marks, with the exception of no 929538. However, in no 929538 the crocodile is of quite a different appearance.
- An advertisement from “Maxim” magazine for May 1999. The advertisement is for eyewear. The word LACOSTE is even larger than in the previously described advertisement. A square with a crocodile and LACOSTE appear to the right of LACOSTE, in a similar size and format to the earlier advertisement. However, in this case the word lunettes appears under the word LACOSTE.
- An advertisement from “Vogue”. There is no indication of the date of the advertisement, although it does bear an 0171 phone number. In this case it is only the square as described in the first advertisement that appears. The advertisement shows a women. She is wearing a dress, on the left hand side of the dress above the breast there appears to be a picture of a crocodile; although there can be no certainty owing to the quality of the reproduction.

It strikes me that this represents very limited evidence of the nature of the promotion of the trade mark in the United Kingdom, especially taking into account the claims of LCL. The crocodile is not used on its own. Only one advertisement is clearly for clothing.

30) Mr Fauvet states that LCL’s crocodile trade mark is a well-known trade mark for luxury products in the sense of article 6bis of the Paris Convention. He does not advise how he can make this statement. He has not submitted any evidence to show that this has been accepted by any court. Neither does he explain what his expertise in trade mark law and the application of the Paris Convention is.

31) Mr Fauvet exhibits pages from a magazine “L’Expansion” for 19 September/ 2 October 1991. The article is in French. LCL has provided no translation of it. French is not an official language of the United Kingdom. It is not for the Patent Office to render translations of evidence, nor is it for the other side in proceedings so to do. Rule 23.2 of the Civil Procedure Rules states:

“Where the court has directed that a witness statement in a foreign language is to be filed—

(1) the party wishing to rely on it must:

(a) have it translated and

(b) file the foreign language witness statement with the court, and

(2) the translator must make and file with the court an affidavit verifying the translation and exhibiting both the translation and a copy of the foreign language witness statement.

I am of the view that if LCL wishes to rely on a document in French it should have had the document translated in a similar manner to that required by rule 23.2 of the Civil Procedure Rules. The other party and the registrar need to know what the document says without recourse to their own resources. Consequently, I am not prepared to give the document any weight.

32) If I did accept the article it would not have a great effect upon my deliberations. The article deals with a survey of which took place in November 1990 on the fame of various luxury trade marks. The article identifies LACOSTE, not the crocodile. As LCL's case is built on the crocodile this is not of any great assistance to its case. LCL is trying to introduce survey evidence by what is effectively hearsay evidence. If it wishes to rely on survey evidence it should have submitted the survey with all the relevant supporting documentation. The survey also took place in Germany, Spain, France, Great Britain and Italy. So there is no way of knowing what the position was in the United Kingdom. The survey also relates to November 1990, nearly ten years before the relevant date. It tells me nothing about the position as of 4 July 2000, which is what I need to know.

33) Mr Fauvet then goes on to make submissions rather than give evidence of fact. However, his penultimate paragraph does assist me as it identifies more clearly the basis of LCL's claim under section 5(3). Mr Fauvet states:

“Use and registration of the Applicant's trade mark would cause confusion and so would harm the legitimate business interests of the Opponent and would unfairly dilute the Opponent's exclusive rights to its trade mark because its reputation as a mark associated with luxury goods would be lost or lessened.”

Evidence of ABL

Witness statement of Caroline Julia Crowe dated 2 May 2002

34) Ms Crowe is a trade mark attorney. Her evidence consists of printouts of trade mark registrations and applications containing representations of alligators and/or similar reptiles. This is what is commonly referred to as state of the register evidence. State of the register evidence does not say anything about what is happening in the market. I refer to the comments of Jacob J in *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281:

“In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led to the Registrar to put the marks concerned on the Register. It has long been held that under the old Act that comparison with other marks on the Register is in principle irrelevant when considering a particular mark tendered for registration, see *e.g. MADAME Trade Mark* (1966 RPC 541) and the same must be true of the 1994 Act. I disregard the state of the register evidence.”

I disregard Ms Crowe's state of the register evidence.

Witness statement of Neil Simon Rodol dated

35) Mr Rodol is the managing director of ABL. His evidence relates to ABL's use of its trade mark. From his statement and the accompanying evidence the trade mark would appear to

have been used mainly on printed publications for children. I cannot see that this evidence affects my deliberations. Mr Rodol holds that despite ABL's use of its trade mark there has been no evidence of confusion with LCL. So what? There is no evidence that LCL has used its trade mark for class 16 goods. If LCL's trade mark is not in the market place for identical or similar goods to those of ABL there is no opportunity for confusion to arise. I do not consider that I need to say anything further about this aspect of the evidence of Mr Rodol.

36) Mr Rodol goes on to give evidence about the differences between crocodile and alligators.

Evidence in reply of LCL

Witness statement of David Christopher Harrison dated 7 August 2002

37) Mr Harrison is a trade mark attorney. Mr Harrison's statement can be characterised as representing submissions rather than evidence of fact. Consequently, I will say no more about it here. However, I have read the statement and take on board the comments that Mr Harrison makes. Effectively I am treating the statement as written submissions.

DECISION

THE EFFECTS OF THE EVIDENCE

Crocodiles and alligators

38) Both sides have got into arguments about the characteristics of alligators and crocodiles. What reptile is represented in ABL's trade mark? This argument strikes me as being artificial to the extreme. My considerations relate to the average consumer of the relevant goods. The average consumer is not an expert on reptilian biology. The average consumer, in my view, will see the word alligator inside the drawing in ABL's trade mark and assume that the word describes the picture. He or she is not likely to consider whether the stylised drawing is closer to that of an alligator or a crocodile; he or she is unlikely to know what the differences are and unlikely to care. If the word says it's an alligator it's an alligator. Equally the average consumer is not likely to know whether LCL's reptile is an alligator or a crocodile from the representation. LCL describe it as a crocodile emblem but without other information there is no reason for the average consumer to know that it is not an alligator. There has been no evidence filed to show that the public would see the reptile as an alligator or crocodile. It might be that LCL have educated the public to see the emblem as a crocodile, however, I do not have any evidence of this before me.

39) This debate is a fruitless and sterile exercise.

The evidence of LCL

40) Two of LCL's three grounds of opposition are dependent on the effects of its evidence. Under section 5(3) it has to establish a reputation, passing-off (the section 5(4)(a) objection) requires the establishment of goodwill. The reputation needs to be established in relation to the registered trade marks. For the goodwill to have an effect in these proceedings LCL has to show that the crocodile emblem (I use LCL's description only for convenience) is a sign that is associated with the goodwill in its business.

41) I have already commented upon what I see as failings in the evidence of LCL. A lot of the evidence is hearsay, and hearsay with no establishment of the origin of the original information. A lot of the evidence is bald assertion. There is a remarkable absence of supporting exhibits. If LCL wishes to establish certain things in relation to the crocodile emblem it would seem to be useful that it shows it in use in relation to the goods. Very large claims have been supported by very little evidence.

42) The European Court of Justice stated in *General Motors Corporation v Yplon SA Case C-375/97* [2000] RPC 572:

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

The court also stated the following:

“The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant factors of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use and the size of the investment made by the undertaking in promoting it.”

“The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector.”

43) LCL has to put in evidence to attempt to satisfy the criteria set out by the European Court of Justice.

44) LCL’s strongest case arises from the turnover figures that Mr Prenn gives. However, these give rise to various issues. How much of the £41 million wholesale turnover for the three years up to 30 April 2002 took place after the relevant date? It could well be that the figures were skewed by a late increase of sales, taking into account that for the five years prior to this period the wholesale sales were £21 million. These turnover figures are not put into the context of market share. So it is difficult to ascertain how impressive they are. I also note that Mr Fauvet’s evidence indicates that LCL’s goods were sold in the United Kingdom in 12 boutiques and 32 corners. This does not strike me as being a particularly great number of retail establishments for clothing. (Although I note LCL pushes the idea of its brand as being a luxury brand.) The exceptionally limited amount of supporting documentation does not allow me to gain a view as to how many of the registered trade marks have been used or how they have been used. I need more than the assertions of Mr Prenn as to the public’s

knowledge of the crocodile emblem. The sales turnover tells me more about the business of LCL rather than the reputation of the crocodile emblem.

45) LCL decided upon the basis of its opposition and should have known what it had to show to establish a reputation for section 5(3) purposes. I have no hesitation in deciding that LCL has not established a reputation for any of the fifteen trade marks upon which it relies for section 5(3) purpose for the goods for which they are registered.

46) I now turn to the issue of goodwill. Goodwill rests in a business. For passing-off it is necessary to consider the sign or signs that are associated with that goodwill. In its grounds of opposition LCL states that it has “massive reputation and goodwill in the Crocodile Device. It is one of the foremost, word-recognized (sic) brands for a wide variety of high quality goods centred on the clothing trade but extending widely over almost all areas of commerce”. “Extending widely over almost all areas of commerce” is vague to the point of being of little use in considering the case, especially taking into account the nature of the evidence filed.

47) Pumfrey J in *South Cone Inc. v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 stated:

"There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s 11 of the 1938 Act (see *Smith Hayden (OVAX)* (1946) 63 RPC 97 As qualified by *BALI* [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date."

48) Professor Annand, sitting as the appointed person, in *Loaded* BL0/191/02, accepted that proof of goodwill could be accomplished by other means.

49) LCL has not supplied trade evidence. Its evidence does not tell me how the goods are traded. From the evidence I believe that I can accept that LCL has some form of goodwill for clothing. However, the evidence does not give me a clear indication as to the nature of that clothing. I am also unsure as to exactly how and where the clothing is sold. I have assumed from the evidence of Mr Fauvet that it is sold in LCL's shops or areas of shops dedicated to LCL's goods. If it is sold in such circumstances the position of LCL in relation to its goodwill is likely to be different to that of a brand which is sold mixed with other brands. This is the sought of information I need to come to a conclusion as the validity of the claim to passing-off. Yet another problem arises from the evidence. It does not show me just how closely the goodwill of LCL is associated with the crocodile device and clothing. I cannot discern much from an advertisement from an undated copy of “Vogue”.

50) Taking the above factors into account I consider that LCL has not established that its crocodile emblem is a sign that is associated with the goodwill in its business.

Ground of opposition under section 5(3)

51) Section 5(3) of the Act states:

“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.”

52) I decided in paragraph 45 that LCL has not established a reputation for the purposes of section 5(3) of the Act. Such a reputation is required under this section of the Act. The ground of opposition under section 5(3) must, therefore, fail.

Ground of opposition under section 5(4)(a)

53) Section 5(4)(a) of the Act states:

“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,”

54) The claim under section 5(4)(a) is somewhat vague. I assume that by claiming that ABL would trespass on the goodwill of LCL, LCL is claiming that use by ABL of its trade mark is liable to be prevented by the law of passing-off.

55) For a claim to passing-off to succeed LCL needs to satisfy the classic trinity of requirements:

- that it has goodwill in his trade mark
- that there is a misrepresentation by the ABL (whether intentional or not)
- that LCL has been damaged or is likely to be damaged by the misrepresentation

56) I decided in paragraph 50 above that LCL has not established that its crocodile emblem is a sign that is associated with the goodwill in its business. Consequently, LCL lacks the fundamental basis for a claim of passing-off, a goodwill in its trade mark. The ground of opposition under section 5(4)(a) must, therefore, fail.

Ground of opposition under section 5(2)(b) – likelihood of confusion

57) According to section 5(2)(b) of the Act a trade mark shall not be registered if because

“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.”

Section 6(1)(a) of the Act defines an earlier trade mark as:

“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”

58) LCL’s registration no 1328565 was filed on 2 December 1987 and registered on 27 March 1990. It is, therefore, an earlier trade mark.

59) In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77 and *Marca Mode CV v Adidas AG* [2000] ETMR 723.

Comparison of goods

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

61) In considering the specifications I adopt the approach of Neuberger J in *Beautimatic International Ltd v. Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267 and give the words their natural meaning subject to their being construed within their context.

62) In considering the services encompassed by the application I bear in mind the words of Jacob J in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

63) The goods and services to be compared are:

LCL's registration

paper, cardboard and goods made from these materials; printed matter; bookbinding materials; photographs; stationery; adhesives (stationery) or for household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging; ordinary playing cards; all included in Class 16; but not including goods relating to reptiles – class 16

ABL's application

electronic publications; publications in electronic format supplied on-line from a database or from facilities provided on the Internet or other networks; fridge magnets; but not including any such goods, in the form of, or relating to alligators – class 9

printed matter; printed publications; books, magazines, comics; photographs; albums; photograph albums; diaries; calendars; autograph books; address books; notebooks; writing paper and envelopes; wrapping paper; gift tags; greeting cards; postcards; invitation cards; posters; drawings; labels; stickers, decalcomanias, transfers; playing cards; bookmarkers; but not including any such goods, in the form of or relating to alligators – class 16

publishing services; publication of printed matter; electronic publishing – class 41

64) I do not consider that anything turns upon the respective exclusions, relating to reptiles and alligators.

Class 16 goods of the application

65) In my view the following goods of LCL:

paper, cardboard and goods made from these materials; printed matter; photographs; stationery; typewriters and office requisites (except furniture) ordinary playing cards

encompass the following goods of the application:

printed matter; printed publications; books, magazines, comics; photographs; albums; photograph albums; diaries; calendars; autograph books; address books; notebooks; writing paper and envelopes; wrapping paper; gift tags; greeting cards; postcards; invitation cards; posters; drawings; labels; stickers ; playing cards; bookmarkers

Consequently, the above goods are identical.

66) This leaves *decalcomanias* and *transfers* of the application. *Decalcomanias* and *transfers* are, I believe, effectively one and the same thing. The former term being more common in the United States where it is often shortened to decals. I will, therefore, simply refer to *transfers* from herein. These goods transfer a printed image onto a surface, this could be paper, the skin or plastic. LCL's registration includes paper goods at large and so includes

such goods as stickers. A sticker like a *transfer* transposes an already printed image onto another surface by adhering to it. The only major difference that I can see between a sticker and a *transfer* is that the former will be on paper whilst the latter might be of a different medium. Certain transfers may be placed on the skin which is not the case with stickers. However, this is just one of the places they may be placed. The closeness of the uses and purpose of the respective goods is such that, in my view, virtually all the *Canon* criteria are satisfied. The exception is being complementary. Consequently, I am of the view that *decalcomanias* and *transfers* of the application are very similar to the goods of LCL's earlier registration.

Class 9 goods of the application

67) With the exception of *fridge magnets* all the goods of class 9 are electronic publications. The registration of LCL includes *printed matter* which in its turn will include all types of printed publications. The difference between electronic publications and printed publications is spelt out in their epithets: one is a publication in electronic form and one is in printed form. A publishing house could make available its products by either or both formats. It is not unusual for such goods as periodicals and reference books to be available in printed form, CD-Rom form and/or on-line. The content is the same, the purpose is the same, the end user is the same, the media are alternatives to each other and so are in competition. Despite the claims of ABL it strikes me as being clear that its goods in class 9 are highly similar to the class 16 goods of LCL's registration. Indeed, the claim seems somewhat disingenuous. ABL is a publisher and I presume that it has made its application in class 9 to cover electronic versions of its printed goods. The application indicates that ABL see the electronic and the printed form as natural adjuncts to one another.

68) I consequently find that *electronic publications; publications in electronic format supplied on-line from a database or from facilities provided on the Internet or other networks* of the application are very similar to the goods of LCL's registration.

69) This leaves *fridge magnets*. As I have stated above LCL's registration will include stickers. Stickers can be placed on any appropriate surface, including fridges. (My own fridge has a sticker and fridge magnets on it). Both sets of goods can be used to decorate a fridge with an image which could be of a painting, or in the case of ABL's goods might be of Sooty, Sue, Sweep and Scamp. The only major difference is the medium which allows the product to adhere to the surface. According to the "Sooty Learning to Count Sticker Book", which ABL has exhibited, stickers can be reusable. So like fridge magnets it would appear that stickers can be moved and removed. It is my view that *fridge magnets* of the application are very similar to the goods of the earlier registration.

Class 41 services

70) All the services of ABL are publishing services. As stated above LCL's specification encompasses publications. The purpose of a publisher is to publish, without publications, whether electronic or print, he has no purpose and no business. Publisher and publication are inextricably linked. The service of publishing and the product are inextricably linked. The name of the publisher on the spine of a book is the physical demonstration of the act of publication. I have no doubt that ABL's class 41 services are very similar to the goods of LCL's registration.

Summary of comparison of goods and services.

71) The goods and services of the application are either identical or highly similar to the goods of the earlier registration.

Comparison of trade marks

72) The trade marks to be compared are:

LCL's registration:



ABL's registration:



73) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Sabel BV v Puma AG* page 224). The visual, aural and conceptual similarities of the marks must, therefore, be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components (*Sabel BV v Puma AG* page 224). The matter must be judged through the eyes of the average consumer of the goods/services in question (*Sabel BV v Puma AG* page 224) who is deemed to be reasonably well informed and reasonably circumspect and observant.

74) LCL's trade mark has a disclaimed element, LCL has no exclusive right in the use of the word LACOSTE. Does this have an effect on how I consider the two trade marks? The issue of disclaimers has been dealt with in *Paco/Paco Life in Colour Trade Marks* [2000] RPC 451. In that case one side was relying upon a disclaimed element as the basis for a claim that there was a likelihood of confusion. It was held that the disclaimed element could not be relied upon. In this case LCL is not relying upon the disclaimed element to establish similarity and a consequent lack of confusion. In these circumstances the reasoning behind the hearing officer's decision in *Paco* does not apply. The rights that LCL has are in the trade mark as a whole and it is the trade mark as a whole that I must compare with the trade mark of ABL.

75) As I have indicated above I am not swayed by arguments as to the appearances of alligators and crocodiles. ABL has written the word alligator upon the reptilian picture. The average consumer will see it as an alligator. The reptile in the LCL trade mark could be seen as an alligator or a crocodile. There is no reason to presume that the average consumer would choose to identify the picture with one creature rather than the other. He or she could, indeed, identify it with both.

76) The word alligator in the trade mark of ABL reinforces and explains the meaning of the picture; word and picture are as one. For the consumer who sees the reptile in LCL's trade mark as an alligator there is a clear conceptual similarity between the two trade marks. The average consumer 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 BV* page 84, paragraph 27). I consider that the imperfect recollection that will be left in the mind of the consumer is that of a picture of an

alligator and so although there are clear visual differences in the representation of the reptile the remembered overall impression will be that of a picture of a reptile of the alligator/crocodile variety. Consequently, I am of the view that there is a degree of visual similarity between the two trade marks. If a consumer wished to refer to the two trade marks orally he/she would, in my view, refer to LCL's trade mark as LACOSTE and ABL's as alligator. I do not think that the average consumer in ordinary circumstances will orally refer to LCL's trade mark as alligator or crocodile. Although he/she is likely to keep in mind the picture of the reptile. The picture is the largest element of the trade mark. It is often written that words speak louder than devices (pictures). I would comment that in LCL's trade mark that the picture is by far the dominant element, it swamps everything else. If the aphorism is correct it must be considered on the circumstances of the trade mark.

77) ABL's trade mark is, as I have said, very much an alligator trade mark; picture and word reinforcing each other. Alligator is the hook that the consumer will hang onto for recognition and recall. Confronted with LCL's trade mark he/she could see LACOSTE as the house-mark or a sub-brand of the alligator trade mark. Having considered the two trade marks in their entirety and bearing in mind the various strictures of the ECJ I am of the view that they are similar.

Conclusion

78) ABL has made a lot of play of having used its trade mark without confusion having arisen. As I stated above this tells me nothing and shows me nothing. For this to have relevance it would be necessary to show that LCL has put its trade mark into the market place for the class 16 goods for which it is registered. No evidence of such use has been put forward. This case brings to mind *Origins Natural Resources Inc v Origin Clothing Limited* [1995] FSR 280 and the comments of Jacob J in that case:

“It sticks in one's gullet to think that a trade mark proprietor is better off *vis-à-vis* a competitor claiming honest concurrence because he has not used his mark than if he has.”

The absence of evidence of use by LCL means that LCL is in a potentially better position than if use of its trade mark for class 16 goods had been shown. Then an absence of confusion in the market place would have to be taken into account in the global appreciation.

79) In considering if there is a likelihood of confusion I have to take into account several factors. There is a greater likelihood of confusion where the earlier trade mark has a particularly distinctive character, either per se or because of the use that has been made of it (*Sabel BV v Puma AG*). The European Court of Justice held that a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*).

80) The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public (European Court of First Instance Case T-79/00 *Rewe Zentral v OHIM (LITE)*). LCL's trade mark does not allude or describe the goods. I cannot see that it has anything other than a high degree of inherent distinctiveness. I have no indication of use of the trade mark in respect of the relevant goods and so there is no question of the distinctiveness being enhanced through reputation.

81) The respective goods are either identical or very similar. This, in my view, balances the differences between the two trade marks; which it is still to be remembered are similar.

82) I find that there is a likelihood of confusion in respect of all the goods and services of the application.

COSTS

83) As La Chemise Lacoste has been successful in these proceedings it is entitled to a contribution to its costs. I order Alligator Books Limited to pay La Chemise Lacoste the sum of £1075. 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 12th day of December 2002

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