TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No.2260416
BY CMR INDUSTRIA E COMERCIO LTDA
TO REGISTER A TRADE MARK IN CLASS 25

AND

IN THE MATTER OF OPPOSITION THERETO UNDER
No. 52747 BY LIZ CLAIBORNE, INC

TRADE MARKS ACT 1994

IN THE MATTER OF Application No. 2260416
by CMR Industria E Comercio Ltda
to register a mark in Class 25

and

IN THE MATTER Opposition thereto under
No. 52747 by Liz Claiborne, Inc

Background

1. On 7 February 2001 CMR Industria e Comercio Ltda applied to register the following mark:

in respect of clothing, footwear and headgear in Class 25.

The application is numbered 2260416.

2. On 21 June 2001 Liz Claiborne Inc filed notice of opposition to this application. They are the proprietors of the marks, details of which are shown in the Annex to this decision. They say that the mark applied for is LIZ in stylised form and is similar to each of their marks and has been applied for in respect of identical or similar goods such that there exists a likelihood of confusion. Registration would be contrary to Section 5(2)(b) of the Act. In the event that any of

the goods are held to be dissimilar then Section 5(3) is raised as an alternative ground having regard to the reputation acquired by the opponents' marks.

3. On the basis of their use the opponents also object under Section 5(4)(a) having regard to the law of passing off.

4. The applicants filed a counterstatement denying the above grounds. In particular they say that their mark consists of a device and not the word LIZ. Furthermore, if the mark does consist of letters these are intended to be the letters LZ (consistent with their registration of those letters under No. 2267435).

5. Both sides ask for an award of costs in their favour.

6. Both sides filed evidence. The matter came to be heard on 16 September 2003 when the opponents were represented by Mr P Houlihan of fj Cleveland. The applicants, through J. E. Evans Jackson & Co Ltd, their professional representatives, indicated that they did not intend to attend the hearing.

Opponents' Evidence

7. The opponents filed a witness statement by Christine Willacy, the Merchandise & Marketing Director of Liz Claiborne Europe. This company markets the LIZ CLAIBORNE brand and related brands in Europe. So far as individual brands are concerned Ms Willacy says:

> "Currently, my company markets clothing under the trade marks LIZ CLAIBORNE, ELISABETH BY LIZ CLAIBORNE, LIZWEAR JEANS, LIZ CLAIBORNE COLLECTION, LIZGOLF, LIZ & CO and LIZSPORT. My company's primary trade mark is LIZ CLAIBORNE and this has been used in the UK since 1991. LIZWEAR JEANS is used in relation to jeans-related casualwear items such as tops, bottoms and shirts, and the mark has been used since 1996. ELISABETH BY LIZ CLAIBORNE is used on a range of fashion clothing in larger sizes. The ELISABETH mark has been used since 1999. LIZGOLF is used on a range of golfing/casualwear and has been used since at least 1996. LIZ & CO has been in the UK since 1996 and LIZSPORT since 1991. I refer to CW1 which I recognise as a representative sample of labels used by my company on the interior of its clothing."

8. Ms Willacy also supplies a list of retailers in the UK who supply LIZ CLAIBORNE clothing (Exhibit CW2) and photographs of in-store signs (CW3). There is in addition a flagship store at 211-213 Regent Street.

9. Retail sales turnover is said to have been as follows:

Year	LIZGOLF	LIZ CLAIBORNE COLLECTION	LIZWEAR	ELISABETH	LIZ & CO	LIZ SPORT	Total
1997	174,767	5,099,884	7,133,093	0	2,485,849	3,256,044	**18,149,637**
1998	164,745	3,669,491	6,595,112	0	1,303,123	4,508,170	**16,240,641**
1999	115,876	3,772,129	6,292,608	0	2,022,247	4,972,138	**17,174,998**
2000	57,915	2,964,056	6,809,535	1,425,646	2,717,091	5,483,749	**19,457,992**
2001	118,618	3,256,311	6,402,647	3,495,415	1,906,676	6,856,722	**22,036,389**

10. The company does not maintain records of advertising expenditure for each brand, but Ms Willacy says that £1,315,000 has been spent over the past five years on advertising including through fashion shows, trade journals, show cards and store catalogues. Examples of these are exhibited at CW4 and 5.

11. In addition to Ms Willacy's evidence, witness statements have been filed by Richard Cowlard, Director of Buying – Concessions at Allders Department Stores Ltd and Debbie Beaumont-Howell, Merchandise Director of Bentalls Plc. They both attest to their awareness of the LIZ CLAIBORNE brand and what they call the ELIZABETH brand (Ms Willacy's evidence and supporting exhibits refer to it as ELISABETH). They each say that they are not aware of any other clothing brands produced by any company which include the name LIZ and would associate LIZ with LIZ CLAIBORNE. They also suggest that their customers would make the same association.

Applicants' Evidence

12. The applicants filed a witness statement by Helene Whelbourn, a registered trade mark attorney with J E Evans-Jackson & Company Ltd, their professional representatives in this matter. Ms Whelbourn's evidence is in essence submissions. I do not, therefore, intend to summarise it here, but will bear her comments in mind in coming to my own view of the matter below.

13. That completes my review of the evidence.

SECTION 5(2)

14. The primary ground of objection is under Section 5(2) of the Act. This reads:

> "5.-(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."

15. Sub-paragraph (b) applies here. The marks relied on by the opponents are all earlier trade marks within the meaning of Section 6(1)(a) of the Act.

16. At the hearing Mr Houlihan referred me to, and I accept that I must take account of, 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] RPC 117, *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.

17. For practical purposes submissions at the hearing concentrated on two of the opponents' registrations – LIZWEAR (No. 1430343) and LIZ LIZWEAR (No. 1579360 – see Annex for the precise form of the mark). Others of the opponents' marks are similarly composed of the word LIZ along with a second element, which is likely to be taken as designating a characteristic of the goods or which is otherwise of low distinctive character (LIZGOLF, LIZSPORT and device, LIZTEENS and device, LIZ&CO, LIZKIDS and device). No. 1579360 is a convenient starting point because it contains the word LIZ as the visually dominant element supported by the word LIZWEAR.

Comparison of Goods

18. I do not think there can be any doubt that identical and/or closely similar goods are involved. The specification of No. 1579360 is couched in identical terms to that of the mark applied for.

Distinctive character of the earlier trade mark(s)

19. The distinctive and dominant components of the respective marks is a factor that must be taken into account (*Sabel v Puma*, paragraph 23). Given the presence of the non-distinctive element WEAR in the opponents' earlier trade marks, consumer attention is more likely to focus on LIZ as being the element that contributes most to their distinctive character. In the case of No. 1579360 that view of the matter is likely to be reinforced by the fact that LIZ appears as a self contained and visually dominant element within the mark.

20. LIZ is a female forename and a not particularly uncommon one. It is not unusual for clothing to be sold under the name of the designer or supplier. On that basis LIZ (as distinct from the full name LIZ CLAIBORNE) cannot be said to enjoy a high degree of distinctive character. However, the applicants have not suggested there is a plethora of other traders using the name LIZ either on its own or in combination with a surname or other matter. The supporting witness statements (from Mr Cowlard and Ms Beaumont-Howell) are from individuals whose positions in their firms suggest that they should be familiar with the clothing industry and the brands used. I note that they say they are not aware of any other clothing brands produced by any company other than Liz Claiborne Inc which includes the name LIZ. Whilst Ms Whelbourn's witness statement is critical of certain aspects of this supporting evidence, there is nothing before me that would lead to a different view on this particular point.

21. With these considerations in mind, I find that the marks in question are distinctive albeit not to a high degree. For reasons which I will explain in a little more detail in dealing with a family of marks argument below I am unpersuaded that any enhanced degree of distinctive character can be attributed to the LIZWEAR marks. Ms Willacy claims a significant level of use but the exhibited material (CW1-5) provides only limited support for the claim so far as the mark LIZWEAR is concerned (largely restricted to a label which shows LIZ CLAIBORNE LIZWEAR JEANS).

Distinctive character of the mark applied for

22. The mark applied for is:

23. How the mark is likely to be seen by consumers seems to me to be critical to the outcome of this case. The opposing positions can be simply stated. The opponents contend that it is LIZ (albeit in stylised form) made up of a lower case L with its tail extended to form a letter I (emphasised by the dot) followed by the letter Z. The applicants, through Ms Whelbourn's witness statement, say that "in fact the mark is a device mark consisting of the stylised letters LZ". In support of this they point to the fact that they have obtained registration of the letters LZ (in plain block capitals) under No. 2267435.

24. Those conflicting viewpoints must be resolved by reference to the likely response of the average consumer who does not know that a question arises. The average consumer for clothes must be taken to be any and all members of the public at large. The notional consumer may pay varying degrees of attention to his/her purchase depending on the nature of the items of clothing, price and a range of ambient circumstances, such as whether buying for own use or someone else, whether buying as a result of a recommendation or by way of repeat purchase of a brand with which the consumer is already familiar. These considerations may produce a range of degrees of attentiveness and circumspection. Generally speaking I would expect a reasonable level of care to be exercised when purchasing such goods, partly because issues of style and taste are involved and clothing is not necessarily a cheap item. Furthermore, I bear in mind that the

average consumer does not pause to analyse marks (*Sabel v Puma*, paragraph 23) but by the same token is likely to identify marks by reference to some recognisable (and describable or pronounceable) feature if it exists.

25. I have little hesitation in concluding that, notwithstanding the degree of stylisation that exists, the mark applied for will be identified, and referred to, as Liz. I say this not least because that was my immediate reaction on encountering the mark (and before coming to the grounds of opposition). I have no reason to suppose that my own immediate and unprompted reaction would not also be typical of the reaction of a substantial body of consumers. That is not, of course, to say that I should treat the mark as if it were the word LIZ alone. Plainly it is not. The distinctive character resides both in the stylisation of the presentation and the underlying word which, in my view, it will be taken to represent.

26. I find the applicants' submission that the mark is in fact stylised letters LZ unconvincing. What purpose does the dot serve? Why would consumers ignore the obvious effect that it achieves? The fact that the applicants have separately registered the letters LZ in plain block capitals is, in my view, irrelevant and unlikely to be a factor influencing consumer perception.

Comparison of Marks

27. Having come to the above view as to where the distinctive character of the respective marks lies and how the applied for mark is likely to be seen, I can deal fairly briefly with issues of similarities and differences.

28. The visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by those marks, bearing in mind their distinctive and dominant components, *Sabel v Puma* paragraph 23. I must bear in mind normal and fair use of the respective marks. Mr Houlihan submitted at the hearing that notional use "includes LIZ (and LIZWEAR as a whole) stylised in a manner very like the applicants' mark". I accept that, particularly in relation to No. 1579360, the word LIZ (which appears as a distinct and separate element) could be presented in a variety of forms. Whether normal and fair use would extend to the degree of stylisation exhibited by the applicants' mark seems to me to be somewhat doubtful. However, the opponents' case is not dependent on my determining the precise boundaries of what may constitute normal and fair use of the earlier trade mark(s). The issue is whether the applied for mark is similar to the opponents' earlier trade mark(s) and whether it can be said to capture its distinctive character (or an important element thereof). Having reached the view that consumer appreciation of the applied for mark is very likely to yield the word LIZ, it seems to me that there are marked similarities, visual, aural and conceptual, with the dominant and distinctive element of the opponents' earlier trade marks. The degree of stylisation present in the applied for mark will not go unnoticed, but in my view it does not conceal the underlying word or displace the similarity between the underlying word and the opponents' mark(s).

Likelihood of Confusion

29. This is a matter of global appreciation taking all relevant factors into account (*Sabel v Puma*, paragraph 22). Bearing in mind that identical goods are involved and that the respective marks

are similar in key respects, I have little hesitation in concluding that there is a likelihood of confusion. Even if the stylisation of the applied for mark was sufficient to avoid direct confusion I am of the view that consumers would see it as, or including, the word LIZ and take it to be a variant presentation of what is a dominant and distinctive element within the opponents' LIZWEAR and LIZ LIZWEAR marks. Had it been necessary to consider the opponents' other earlier trade marks I would have found the same to be true in relation (at least) to LIZGOLF, LIZTEENS and device, LIZ & Co, LIZSPORT and device and LIZKIDS. The opposition succeeds under Section 5(2)(b).

Family of Marks

30. Before leaving Section 5(2) I should comment briefly on Mr Houlihan's additional and alternative submission that there is a likelihood of confusion by virtue of the opponents being the proprietors of a family of LIZ marks.

31. It is clear from *The Infamous Nut Co Ltd's Trade Marks* [2003] RPC 7 and *Torremar Trade Mark* [2003] RPC 4 that any claim in this respect must be supported by evidence of use to show that an element (LIZ in this case) has achieved enhanced distinctiveness in the eyes of the public because it is common to a family of marks. It has generally been accepted that there needs to be at least three marks in the family for such a claim to have any effect. Ms Willacy's evidence provides sales figures in relation to some six marks, LIZGOLF, LIZ CLAIBORNE COLLECTION, LIZWEAR, ELISABETH, LIZ & CO and LIZ SPORT.

32. The supporting exhibits, CW1 to 5, do not in my view, entirely bear out the generality of the claim. The labels (CW1) always contain the housemark LIZ CLAIBORNE (thus ELISABETH BY LIZ CLAIBORNE, LIZGOLF BY LIZ CLAIBORNE, LIZ CLAIBORNE LIZWEAR JEANS. The in-store signage shows LIZ CLAIBORNE (and device) or ELISABETH BY LIZ CLAIBORNE (again with a device). The catalogue material (CW4) is also largely focussed on these latter two marks as are the advertisements (CW5). Most of the exhibits fail to show precisely how the LIZGOLF, LIZWEAR, LIZ & CO and LIZ SPORT marks are used and particularly whether they are used with, or independently of, the housemark. The stores listing (CW2) is similarly inconclusive in terms of providing substantiating detail (most references are to individual stores being stockists of ELIZABETH (sic) and LIZ CLAIBORNE). In short I do not consider that the family of marks claim can be said to be made out on the material before me.

Section 5(3)

33. The respective sets of goods in this case are identical and similar. On the authority of *Davidoff & Cie SA and Gofkid Ltd* Case C-292/00, Section 5(3) (equivalent to Article 4.4(a) of First Council Directive 89/104) is held to apply where goods are identical or similar as well as where they are not similar. Nevertheless on the basis on which this ground has been pleaded (essentially an "in the alternative" case in the event that the applicants' goods were held to be dissimilar) it is in my view not open to the opponents to pursue this ground. I declined to consider an amendment to the grounds at the hearing as no such requests had previously been notified and the applicants were not there to respond to it. I merely record Mr Houlihan's

request in the event that it were to become an issue on appeal. I do not need to consider the merits of any case that might arise.

Section 5(4)(a)

34. In the light of the success of the opposition under Section 5(2)(b) I do not propose to give separate consideration to whether the opponents would also succeed under this head. The opponents' position is in any case unlikely to be any stronger on the basis of this claim, particularly as the examples of use exhibited to Ms Willacy's evidence overwhelmingly relate to the marks LIZ CLAIBORNE (and device) and ELISABETH BY LIZ CLAIBORNE. These marks give rise to somewhat different considerations than the marks particularly relied on by the opponents for Section 5(2)(b) purposes. If on appeal the opponents do not succeed on the basis of the marks considered in relation to this latter ground, I doubt that they would be better placed under Section 5(4)(a).

COSTS

35. The opponents have succeeded and are entitled to a contribution toward their costs. I order the applicants to pay them the sum of **£1800**. 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 1st day of October 2003

M REYNOLDS
For the Registrar
The Comptroller General

ANNEX

Opponents' earlier trade marks (UK unless otherwise indicated)

NO	**MARK**	**CLASS**	**SPECIFICATION**
1430343	LIZWEAR	25	Articles of clothing included in Class 25.
2158098	LIZGOLF	25	Articles of clothing; footwear; headgear.
1273777	Lizteens	25	Blouses, skirts, shorts, underpants, trousers, jackets and sweaters.
1273780	Lizwear	25	Underpants, trousers, shorts, skirts, blouses, sweaters, shirts, t-shirts; jerseys and jeans, all being articles of clothing.
1579360	LIZ LIZwear	25	Articles of clothing; footwear; headgear.

1428327	LIZ & CO	25	Articles of clothing included in Class 25.
1273778	Lizsport	25	Underpants, trousers, skirts, culottes, jumpsuits, blouses, sweaters, T-shirts and jackets.
2165149	LIZ Claiborne	03 05 14 16 18 20 21 24 25 26 27	Class 03: Perfumes, colognes, toilet water; aftershave, aftershave lotions and aftershave gels; non-medicated toilet preparations, soap, talcum powder, bubble bath, bath gel, shower gel, body scrub; anti-perspirants and deodorants; depilatories and depilatory preparations; non-medicated preparations in the form of oils, creams, lotions and gels; skin cream and skin cleansing cream; cosmetics; face powder; lipsticks; hair care products; hair shampoo, hair conditioner and hair rinses; nail care products; nail enamels; preparations for use in tanning and sun protection; aromatics, essential oils, essences, incense, pomades for cosmetics purposes, pot-pourri. Class 05: Air freshening preparations; air purifying preparations; camphor; camphor oil; deodorants, other than for personal use. Class 14: Watches and clocks; jewellery; imitation jewellery; necklaces, earrings, bracelets, brooches, ornamental pins, rings; goods made from precious metals and their alloys not included in other classes. Class 16: Stationery; printed matter; books; appointment books, address books, memorandum books; calendars; diaries and agendas;

			personal organisers and multi-faceted organisers; personal organisers and multi-faceted organisers which include financial and expense report information; art and photographic prints; document bags and holders included in the class. Class 18: Leather and imitations of leather and goods made from these materials; handbags, umbrellas, wallets, purses, portfolios, briefcases, document bags and cases, attache cases, key cases, cases for toiletry or cosmetic articles. Class 20: Furniture and parts and fittings for furniture; figurines and statuettes made of wood, plastic, wax or plaster; cushions, pillows and bedding; shower curtain hooks, not made of metal; window fittings, not of metal; window blinds, slatted indoor blinds, venetian blinds and vertical blinds and parts and fittings therefore. Class 21: Household or kitchen utensils and containers; jugs, pitchers, toothbrush holders, tissue holders and soap dishes; glassware, porcelain and earthenware and goods made from such goods; vases, figurines, candleholders and candlesticks; flower pots; waste-paper baskets; hair combs. Class 24: Textile and textile goods; towels, face-cloths, fabric bath mats, shower curtains; bedding, pillow cases, pillow shams, sheets, duvet covers, bed spreads, valances, dust ruffles, blankets, quilts, comforters and comforter cases; table cloths, napkins, place mats and coasters; curtains, drapes and blinds made of fabric; window shades; tapestries and quilts in the nature of ornamental wall-hangings; fabric and fabric for making curtains and drapes, and for use in upholstery and other home furnishings. Class 25: Articles of clothing; footwear; headgear. Class 26: Hair ornaments, head bands,

			hair combs, hair clips, hair grips, barrettes, snoods, hair nets, hair pins, hair curlers; hat ornaments; artificial flowers, fruits and garlands in the nature of clothing accessories; buckles, buttons; haberdashery; lace and embroidery, ribbons and braid, hooks and eyes. Class 27: Carpets, rugs, mats and matting; bath mats, linoleum and other materials for covering existing floors; wall hangings, not of textile; wallpaper and borders.
2198954	Liz Claiborne	18 & 25	Class 18: Leather and imitations of leather and goods made from these materials; handbags; umbrellas; wallets; purses; portfolios; briefcases; document bags and cases; attache cases; key cases; cases for toiletry or cosmetic articles. Class 25: Articles of clothing for men, women and children; articles of underclothing, including underwear, underpants, bras, corsets, camisoles and petticoats; nightwear, including pyjamas, nightdresses and negligees; footwear; hosiery; socks; shoes; swimwear; headgear.
2026559	LIZ CLAIBORNE	25	Articles of clothing; footwear; headgear; belts.
1273779	Lizkids	25	Articles of clothing for children.

1164623 (CTM)	ELISABETH	3,9,14 18,25	Class 3: Perfumes, colognes, body cream, dusting powder, bath soap, toilet soap, bath gel, shower gel, body scrub and potpourri. Class 9: Eyewear, namely, eyeglasses, sunglasses, lenses, eyeglass cases and eyeglass cords. Class 14: Jewelry and watches. Class 18: Backpacks, tote-bags, all-purpose athletic bags, purses, credit card cases, wallets and waist packs. Class 25: Pants, jeans, shirts, blouses, suits, sweaters, vests, jackets, shorts, coats, belts and footwear.