

O-005-04

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2270150
BY OSKA'S LTD TO REGISTER THE TRADE MARK LORNA MORGAN
IN CLASSES 9, 16, 25, 35, 41 AND 42**

AND

**IN THE MATTER OF OPPOSITION No. 80502
BY MORGAN**

TRADE MARKS ACT 1994

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by Oska's Ltd to register the Trade Mark LORNA MORGAN
in Classes 9, 16, 25, 35, 41 and 42


and

IN THE MATTER OF Opposition No. 80502
by Morgan

BACKGROUND

1. On 15 May 2001 Oska's Ltd applied to register the mark LORNA MORGAN in relation to specifications of goods in Classes 9, 16, 25, 35, 41 and 42 of the International Classification. The application is numbered 2270150.

2. On 24 December 2001 Morgan of 60-62 Quai de Jammapes, Paris filed notice of opposition to this application. They are the proprietors of the following registrations:

No.	Mark	Class	Specification
1471211	MORGAN	25	Clothing for women and children; all included in Class 25.
2042937		25	Clothing; bath robes, bathing drawers, bathing suits, belts, braces, brassieres, chemisettes, chasubles, coats, collar protectors, drawers, dressing gowns, frocks, furs, fur stoles, gaberdines, gloves, jackets, jerseys, jumpers, knitwear, leggings, mittens, neckties, overalls, overcoats, pyjamas, pants, parkas, pelerines, petticoats, pullovers, sashes for wear, scarves, shawls, shirts, stocking suspenders, singlets, skirts, smocks, socks, sports jerseys, stockings, suits, sweaters, swimsuits, teddies, tights, topcoats, trousers, underpants, underwear, vests, garters, dresses, muffs, pelisses, combinations, corsets, waterproof clothing, footwear; bath slippers, beach shoes, boots, boots for sports, half-boots, lace boots, esparto shoes or sandals, slippers,

			shoes, headgear, bathing caps, berets, caps, peaks, hats and headbands.
2129605	MORGAN	25	Footwear, headgear and men's clothing.

3. They say that the mark MORGAN and the 'family of MORGAN trade marks' has been used since 1981 and is particularly well known in relation to clothing, headgear and footwear.

4. They go on to say that the applied for mark consists of the word MORGAN to which has been added the female name LORNA, an element which is non-distinctive for clothing, in particular women's clothing. They suggest that a significant section of the public, being familiar with the MORGAN trade mark will take LORNA MORGAN to be a sub-brand. Given also that identical goods are involved they say there is a likelihood of confusion and registration would be contrary to Section 5(2)(b) of the Act.

5. Furthermore on the basis of their use and reputation the opponents also object under Section 5(4)(a) having regard to the law of passing off.

6. The applicants filed a counterstatement denying the above grounds and noting that the applied for mark is the real name of the model and actress Lorna Morgan. They also suggest that MORGAN is a common surname in the UK and cannot be distinctive on its own. Thus, it is said, it is the full name that serves to distinguish.

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

8. Both sides filed evidence. The matter was reviewed by a Hearing Officer who indicated that he considered a decision could be reached on the basis of the papers filed and without recourse to a hearing.

9. As a result of clarification sought and received at this time I understand that the opposition is directed solely at the Class 25 element of the application.

10. Neither side has asked to be heard and neither side has filed written submissions save for observations made under cover of a letter of 10 March 2003 by the applicant company. Acting on behalf of the Registrar and with the above material in mind I give this decision.

The evidence

Opponents' evidence in chief

Witness Statement of Joanna Larkey with exhibit JL1;

Witness Statement of Louise Carter with exhibits LC1 – LC4;

Witness Statement of Joanna Larkey (supplemental) – with exhibit JL1.

Applicants' evidence in support

Witness Statement of Lorna Morgan with no exhibits.

Opponent' evidence in reply

Witness statement by Catherine Willaime with exhibit M1.

11. I do not propose to offer a full summary of this evidence. Much of it consists of submissions. Where that is the case I bear the submissions in mind in reaching my own decision on the issues before me or will refer to them below.

12. I will, therefore, restrict my review of the evidence to those parts of the witness statements that deal with the opponents' use.

13. Ms Larkey's first witness statement exhibits a copy of the evidence filed in support of No. 1471211 when it was first applied for in July 1991. It deals in essence with the opponents' use up to that date. More up to date information is given in Ms Carter's evidence which picks up the story from 1992. Ms Carter is the Mail Order Manager of Tower Hill Clothing Ltd, the opponents' UK distributor. She gives the following information on sales of MORGAN clothing:

YEAR	£
1992	2,374,000
1993	6,757,000
1994	9,082,000
1995	12,282,000
1996	23,737,000
1997	42,800,000
1998	54,189,000
1999	51,076,000
2000	58,071,000
2001	58,248,000

The following sums have been spent on advertising and promotion over the same period:

YEAR	£
1992	4.5k
1993	14.1k
1994	40.4k
1995	39.8k
1996	79.9k
1997	143.4k
1998	197.5k
1999	174.9k

2000	282.7k
2001	362.5k

14. Ms Carter says that the first MORGAN shop in the UK opened in 1992 and there are now over sixty MORGAN boutiques in all parts of the UK (a list of these is exhibited at LC1). MORGAN clothing, footwear and headgear is also sold in leading department stores such as Debenhams, House of Fraser and Littlewoods.

15. Ms Carter exhibits (LC2) a small selection of examples of promotions and media coverage of MORGAN clothing, footwear and headgear which has featured regularly in magazines such as Vogue, Cosmopolitan, Elle, Company and other leading publications, as well as national newspapers, press and regional publications.

16. Also exhibited (LC3) are pages printed from the opponents' website, morgandetoi.com. The only other exhibit to Ms Carter's witness statement is an extract from "Wales on Sunday" (LC4) from which it is noted that the applicant is a glamour model. Ms Carter suggests that glamour models, unlike fashion models, are not known for their connection with clothing or fashion and, furthermore this may bring about undesirable associations with the opponents' brand.

17. The only other piece of evidence I need to refer to at this stage is a statement by Jenny Halpern exhibited (JL1) to Ms Larkey's supplemental witness statement. Ms Halpern works in fashion PR and has her own agency. It seems that her firm is used by the opponents. Her statement takes the form of a "To whom it may concern" letter. It has clearly been solicited for the purposes of these proceedings and should have complied with the requirements of Rule 55 of the Trade Marks Rules 2000 if it was to be given weight. For this reason and because Ms Halpern is closely associated with the opponents' business I am unable to give any weight to this statement.

Section 5(2)

18. 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."

19. 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.

20. In approaching the issues under this head I 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.

Comparison of goods

21. Lorna Morgan, whose name is the subject of the trade mark, has filed a witness statement in her capacity as a director of Oska's Ltd. She claims a degree of prominence as a model and suggests that her business is distinct from the mainstream fashion market. She also says that her clothing is sold to a predominantly male market. There is nothing to substantiate any of this (save for Exhibit LC4 which confirms that Ms Morgan is a glamour model).

22. The purpose of these submissions is to suggest that the parties are unlikely to meet in trade and, therefore, that (to use Ms Morgan's words) "the chances of a confusion, illusory or otherwise, are remote". The difficulty with this approach is that it is based on circumstances of current trading and marketing which may not be replicated in future and, in any case, do not find expression in the specification of goods applied for. I must approach the matter on the basis of what it will be notionally open to the applicants to do if they secure a registration for their mark. Bearing in mind that this opposition is against the applicants' Class 25 goods only, the comparison is between "clothing, footwear and headgear" and "clothing for women and children" (No. 1471211) and "footwear, headgear and men's clothing" (No. 2129605). No. 2042937 does not appear to improve or alter the opponents' position in any material way. However, the inescapable conclusion based on the above specifications is that identical goods are involved.

Distinctive character of the earlier trade mark

23. The distinctive character of the respective marks is a factor that must be taken into account (*Sabel v Puma*, paragraph 23). Furthermore 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 v Puma*, paragraph 24).

24. The applicants have commented that MORGAN is a common surname and cannot be regarded as distinctive on its own. The opponents say that, whilst this may be true (particularly in Wales), it is not in common use as a trade mark in relation to clothing. The question of whether a common surname should be regarded as being devoid of any distinctive character unless it has acquired such a character through use is currently the subject of a reference to the European Court of Justice in *Nichols plc's trade Mark* application [2002] EWHC 1424(Ch). The matter arose there in the context of registrability on absolute grounds. As the opponents' marks here have achieved registration I must assume that they are distinctive to a small degree at least. In fact I have not been given concrete information as to just how common MORGAN is as a surname. I think I can unhesitatingly say that it is extremely common in Wales. Doubtless it is somewhat less prevalent in England and the rest of the UK but still, I would suggest, relatively common. On a scale of distinctiveness which would have invented words and complex graphical

marks towards the top and descriptive words or commonplace images towards the bottom, I regard the surname MORGAN as having a rather low claim to distinctive character.

25. However, the opponents say that this is a case where use has improved their position. The raw data I have recorded above suggests that they may indeed be entitled to claim an enhanced degree of distinctive character through use. The opponents' turnover and advertising figures suggest a business of some size. The clothing market is a somewhat fragmented one with many players large and small. But a turnover which has exceeded £50 million per annum for each of the last four years speaks of a business with a significant and sustained position in the marketplace. Moreover it enjoys a well established track record dating back to 1981 (see Exhibit JL1). I note too that the company operates largely through its own boutiques. These frequently appear to be located in high profile stores such as Debenhams, House of Fraser and Rackhams and major shopping centres such as Bluewater(Kent), Lakeside (Essex), Cribbs Causeway (Bristol) and Merry Hill (West Midlands)). A presence in such locations is likely to increase the brand's profile and lead to awareness even amongst those members of the public who are not current customers.

26. I find the rest of the material exhibited in support of the claim to a reputation somewhat less persuasive. Exhibit LC2 consists of a collection of fashion pieces from magazines and newspapers. They are not in the main advertisements dedicated to the opponents' brand and goods but rather fashion collection items featuring goods from a variety of traders which happen to include items from the opponents' collection. Exhibit LC3, the website pages, adds little to the overall picture and I note that some of the material (as with LC2) is after the relevant date. My impression is that the brand is primarily targeted at a young female audience though I accept that is not exclusively the case. In *DUONEBS Trade Mark* BL O/048/01 Mr S Thorley QC, sitting as the Appointed Person, in dealing with the question of the reputation attaching to a mark said:

“In my judgement, I believe what the ECJ had in mind was the sort of mark which by reason of extensive trade had become something of a household name so that the propensity of the public to associate other less similar marks with that mark would be enhanced. I do not believe that ECJ was seeking to introduce into every comparison required by Section 5(2), a consideration of the reputation of a particular existing trade mark.”

27. Applying these principles it seems to me that the opponents' claim that the MORGAN brand's reputation and distinctiveness has been enhanced through use is not without legitimacy. I have some reservations as to whether the limited amount of supporting material supplied is enough to flesh out and give substance to the underlying claim but I propose to proceed on the basis that use has improved the opponents' position.

Comparison of marks and likelihood of confusion

28. The visual, aural and conceptual similarities of the marks are to 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 propose to base my consideration on the

opponents' MORGAN (solus) mark, that is Nos. 1471211 and 2129605. No. 2042937 has that word with heart devices separating the letters and the words MORGAN DE TOI in smaller lettering underneath. There is nothing about these additional features which can be said to improve the opponents' position.

29. Ms Carter submits as follows in her evidence:

“16. Although, visually, the Applicant's mark comprises two words and the Opponent's mark comprises one word, I would point out that the former subsumes the latter. The trade marks LORNA MORGAN and MORGAN have a conceptual similarity because they relate to the same surname.

17. Furthermore, I would say that on seeing the Opponent's mark MORGAN within the Applicant's mark LORNA MORGAN, the average consumer of clothing, footwear and headgear would not be afforded any compelling reason to discount association with the Opponent's mark MORGAN.

18. In fact I consider that apprehension of the mark LORNA MORGAN will bring to mind the familiar mark MORGAN. The consumer might reasonably suppose that the Opponent was extending its brand to LORNA MORGAN ie. by adding a female Christian name to the house name MORGAN. The consumer might reasonably suppose LORNA MORGAN to be the name of the founder of the Morgan company, being mindful of such well-known trade names as COCO CHANEL, MIUCCIA PRADA, GEORGIO ARMANI, GIANNI VERSACE etc.

19. The consumer will not have linked any other Christian name in her/his mind with the Opponents' MORGAN trade mark. So, on seeing a female name linked with the mark MORGAN for the first time, it is entirely reasonable that she/he might follow the thought process suggested at paragraph 18 above.

20. The average consumer of both the Opponent's goods and the Applicant's goods could be any member of the public. If confronted with labels bearing the marks LORNA MORGAN and MORGAN on identical goods, I submit that the consumer might very well assume the existence of an economic link between the two and/or that LORNA MORGAN was part of the same brand as MORGAN.”

30. The distinctive character of the applied for mark must in my view rest in the combination of forename and surname. Many people are likely to share the same surname or forename. It is the elements in combination that serve to distinguish. Having said that, unusual forenames or surnames, being inherently more distinctive, are likely to attract a disproportionate amount of attention and may be, or become, the dominant and most memorable element within a full name. That is not the case here. Neither LORNA nor MORGAN are uncommon names. I have no reason to suppose that consumers would rely on either element at the expense of the whole to identify and remember the mark.

31. The matter, therefore, turns critically on whether Ms Carter is correct in the conclusions she asks me to draw about the presence of the surname MORGAN in both marks. Ms Carter's submissions proceed on the basis of suppositions as to consumer reaction that in my view are not necessarily well founded. The evidence is that the opponents have traded for many years under the mark MORGAN (or MORGAN DE TOI and device) without the presence or addition of a female forename. I fail to see why any assumption should be made that LORNA MORGAN is or was the founder of the company. It is true that a number of the leading fashion houses have become recognised by the names of the founders whether presented as full names or forename or surname alone – Coco (Chanel), Giorgio (Armani), Gianni (Versace) etc. But that is in circumstances where the public has been exposed to such usage. That is not the case here. There is no evidence that the public has come to expect the mark MORGAN to be used with one or more forenames. Nor, even on the basis of distinctiveness enhanced through use, can the surname MORGAN be said to fall into the same category as Chanel, Armani or Versace in terms of the distinctive character of the mark.

32. It seems to me that the opponents' case ultimately rests on a series of possible inferences that are drawn in Ms Carter's statement:

“... the average consumer would not be afforded any compelling reason to discount association with the opponent's mark MORGAN.”

“... the consumer might reasonably suppose that the opponent was extending its brand”

“... the consumer might very well assume the existence of an economic link....”

33. The possibility of an association being made should not be discounted completely. If it is right to conclude that the MORGAN brand enjoys a reputation in the market place, some consumers may, on encountering the mark LORNA MORGAN, be put in mind of what for them might be the best known or only MORGAN mark with which they are familiar. But that does not in and of itself mean that they will be confused as to the origin of the goods. It was held in *Canon* that:

“29. Accordingly, the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 4(1)(b) of the Directive (see *SABEL*, paragraphs 16 to 18).”

and in *Marca Mode* that:

“41.....the reputation of a mark does not give grounds for presuming the existence of a likelihood of confusion simply because of the existence of a likelihood of association in the strict sense.”

34. I understand these cases to mean that merely being reminded of another mark (even one with a reputation) does not in itself constitute a likelihood of confusion. But if the association is such

that the consumer considers goods sold under the respective marks share a common or economically linked trade source that is confusion within the meaning of the Section. The difference between these positions was demonstrated in *Laura Trade Mark*, O/430/99. In that case the Appointed Person allowed an appeal against the Registrar's refusal to register LAURA in the face of 'Laura Ashley'. On the facts of the case the Appointed Person held that:

“It appears to me that Mr Krause who appeared for the appellants before me was well founded in submitting that the name “Laura” was no more objectionable because of the provisions of Section 5(2) of the 1994 Act in relation to “Laura Ashley” than the word “John” would be in relation to the words “John Lewis” if both were to be used in relation to household paints, or “Thomas” in relation to “Thomas Cook” if the former were to be used in relation to travel services.”

35. In reaching that view he expressed himself as follows:

“... mere association which the public might make between the two marks is not sufficient – there must be a likelihood of confusion and the two are not the same thing.”

and

“It is of importance that in both the relevant provisions in the European Directive and in Section 5(2) of the 1994 Act what has to be identified is the likelihood of confusion, not simply the possibility of confusion. At the very highest, in the present case, in my view, it might be said that there was a possibility of confusion in the mind of certain members of the public but I consider that it was unreal to think in terms of there being a likelihood of confusion.”

36. There is no doubt room for reasonable people to differ in applying the guidance from these cases to the circumstances of a particular use. I have not found the answer here to be straightforward particularly as the surname element is identical as are the goods of interest and, on balance, I am inclined to accept the opponents' claim that the character of their mark has been enhanced through use. However, it seems to me that full names are of particular importance as identifiers. There is nothing about the opponents' use that suggests anything other than a casual association (if that) would be made between the applicants' mark and their own. Making the best I can of the material before me I am not persuaded that I should elevate any such association into a likelihood of confusion. The opposition fails under Section 5(2)(b).

Section 5(4)(a)

37. This reads:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or
- (b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

38. The requirements for this ground of opposition have been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *WILD CHILD Trade Mark* [1998] RPC 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

- (1) that the opponent’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the applicant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the applicant are goods or services of the opponent, and
- (3) that the opponent has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the applicant’s misrepresentation.

39. The opponents’ statement of grounds expresses the objection in the following terms:

“.... the Opponent will argue that its earlier use of the trade mark MORGAN and its family of MORGAN trade marks in the United Kingdom constitutes an “earlier right” as defined by Section 5(4) of the Act and that registration of the application in suit would be contrary to the provisions of Section 5(4)(a) of the Act.”

40. I start from the assumption that the opponents’ have established goodwill in the mark MORGAN. As they have failed to persuade me that there is a likelihood of confusion for the purposes of Section 5(2)(b) then it must follow that they will be unable to establish a misrepresentation by the applicants for the purposes of Section 5(4)(a). However, I note that the opponents also base their claim on a ‘family of MORGAN trade marks’. Such a claim potentially opens up a wider and somewhat different claim to the one dealt with above.

41. With that in mind I have given careful consideration to the evidence. I find that, overwhelmingly, it shows use of MORGAN solus but with some variant forms incorporating that word. These include MORGAN/MORGAN DE TOI with heart devices (the mark of No. 2042937), MORGAN www.morgandetoi.com and a sideways facing single heart device, MORGAN PARIS and MORGAN with the M in stylised form suggesting a garment. The latter are older forms (probably pre 1991). There is insufficient evidence as to the nature, extent and duration of use of these variant marks to determine whether they can be said to constitute a family of marks. But even if a generous view is taken of the matter I cannot see that they

advance the opponents' cause to an appreciable extent and certainly not to the point where they would succeed under Section 5(4)(a). This ground also fails.

COSTS

The applicants have been successful and are entitled to a contribution towards their costs. I order the opponents to pay the applicants the sum of £1000. 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 7th day of January 2004

**M REYNOLDS
For the Registrar
the Comptroller-General**