

O-172-11

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION  
No. 2527075  
BY TOO FAST TO LIVE TO YOUNG TO DIE APPAREL CO.  
TO REGISTER THE TRADE MARK**



*Sacred Saints*


**IN CLASS 25**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER Nos. 100052 BY  
ALL SAINTS RETAIL LIMITED**

## BACKGROUND


1) On 28 September 2009 Too Fast to Live To Young To Die Apparel Co. (hereinafter the applicant), applied to register the following trade mark:

Number	Mark	Filing Date	Class	Relevant goods
2527075		28.09.09	25	Footwear, headgear, clothing, t-shirts, shirts, blouses, skirts, trousers, ties, scarf's, jeans, coats, hats, gloves, socks, underwear.

2) The application was examined and accepted, and subsequently published for opposition purposes on 23 October 2009 in Trade Marks Journal No.6808.

3) On 25 January 2010 All Saints Retail Limited (hereinafter the opponent) filed a notice of opposition. The grounds of opposition are in summary:

a) The opponent is the proprietor of the following trade marks:

Mark	Number	Filing date/ registration date	Class	Specification
ALL SAINTS	CTM 4610945	30.08.2005 / 10.11.2009	25	Articles of clothing, footwear and headgear included in Class 25.
	CTM 5240049	12.07.2006 / 24.01.2008	25	Articles of clothing, footwear and headgear.

b) The opponent states that its marks above and also All Saints London, and All Saints Spitalfields are well known in the UK with regard to clothing footwear, headgear, bags and the retailing of these goods following its use since 2005. As a result it contends that the mark in suit offends against Sections 5(2)(b) and 5(4)(a) of the Act.

4) On 1 March 2010 the applicant filed a counterstatement which denied the opponent's claims.

5) Both parties filed evidence, and both seek an award of costs in their favour. The matter came to be heard on 9 May 2011. At the hearing, the applicant was represented by Mr Tony Knight; the opponent was not represented but instead filed written submissions.

## OPPONENT'S EVIDENCE

6) This consists of six witness statements. The first, dated 3 August 2010, is by Timothy Paul Evans the Production Director of the opponent, a position he has held since December 2008. His comments are drawn from his own experience and also his company's records. He states that the company has been retailing clothing in the UK and elsewhere in Europe since 7 August 2001. He states that the opponent uses four marks which he lists as:

- a) The word mark and logo ALLSAINTS.
- b) The word mark ALL SAINTS (used since 7 August 2001).
- c) The word mark and logo ALLSAINTS SPITALFIELDS (used since 2007 in conjunction with ALL SAINTS).
- d) A ramskull logo (used since 2005).

7) At exhibit TPE2 he provides a detailed presentation of the logos which is reproduced as Annex A to this decision. He describes these collectively as All Saints' house marks and refers to them thus throughout his witness statement. He states that the house marks are used either alone or in conjunction with one or more of the other house marks and "each is both individually inherently distinctive and recognised as part of the brand of All Saints". He also provides, at exhibit TPE3 the following turnover figures:

Year	Retail Value in UK £million
2004	10.9
2005	15.2
2006	29.0
2007	51.5
2008	100.3

8) Mr Evans states that in addition to selling from retail outlets his company also sells via the internet in countries throughout Europe. He states that by 2008 online sales were £7.45 million. The values of sales to certain European countries were provided at exhibit TPE8, the main being as follows:

Year	Ireland Retail Value in £	Denmark Retail Value in £	France Retail Value in £
2004	225,135	0	0
2005	208,644	0	0
2006	737,817	172,725	0
2007	1,204,278	245,413	0
2008	2,681,696	39,046	511,098

9) Mr Evans states that almost every week his company sends emails to over 220,000 individuals who are registered with the opponent's website, although it is not known which country they reside in. He states that in keeping with the opponent's wish to be an aspirational brand, it does not carry out traditional advertising but instead concentrates upon the product and the

environment in which it is sold. He states that the brand has received media coverage because of this policy. The company also has a facebook page with 39,000 friends, they also use twitter and have launched an iPhone and iPad application. The opponent sponsors a formula one team and has taken part in fashion shows in Birmingham and Glasgow in 2007 and 2008. The opponent also published a supplement to the December 2009 Vogue magazine, approximately 800,000 copies of the magazine were sold in December. In 2009 they also sponsored a play “Who killed Summer 09” which was available on the internet and on mobile phones. One of the characters was shown entering the opponent’s main store in London and later auctioned his All Saints jacket online. Mr Evans states that it had over 300,000 views for each of the 22 episodes. Lastly, the opponent printed a supplement to the January 2010 GQ magazine. Attached to Mr Evans’ statement were the following exhibits:

- Exhibit TPE4: This is a list of shops and outlets throughout the UK and the 13 outlets in Ireland, Belgium, Germany, Denmark, Spain and France as at 15 December 2009.
- Exhibit TPE6 & 7: Copies of screen shots from the allsaints.com website which shows changes to the front cover for the various seasons and also shows how the marks are used. These show the logos 1 & 2 from Annex A, “ALLSAINTS” and “ALLSAINTS SPITALFIELDS” used at the top of the webpages, with the ramskull logo being used in a circle at the bottom of the page.
- Exhibit TPE9: copies of the emails sent to website subscribers. These show use of the registered marks and the marks at Annex A.
- Exhibit TPE10: Photographs of a variety of UK stores illustrating use of the registered marks and those at annex A.
- Exhibit TPE11: Photographs of the various marks, both registered and at annex A being used on labels and packaging.
- Exhibit TPE12: A list of media stories with, in certain instances, circulation figures. These date from 1994 and involve magazines such as GQ, Fashion Weekly, Marie Claire, Elle, New Woman and Grazia; and national newspapers such as The Independent, The Times, The Mirror, The Observer, The Guardian and the Daily Mail. There are a large number of entries for each year.
- Exhibit TPE13: 2046 pages which are said to be samples of media coverage over the period 1994-2010. The show use of the registered marks and those in annex A.
- Exhibit TPE14: A copy of the facebook page.
- Exhibit TPE16: A print of the page on the All Saints website giving details of the iPhone application. This shows use of the mark “ALLSAINTS”, ALLSAINTS SPITALFIELDS” and the Ramskull device.

- Exhibit TPE17a: photographs of the Williams Formula One team who have “ALL SAINTS” on their overalls, as a sponsor.
- Exhibit TPE17b screen shots from The Clothes Show in Birmingham in 2008 where the opponent displayed their products.
- Exhibit TPE17c: Screen shots from the Merchant City Festival in Glasgow showing the opponent’s participation in the 2008 event.
- Exhibit TPE17d: A copy of a supplement to Vogue magazine published in December 2009 published in association with the opponent and featuring their products and the trade marks both registered and at annex A.
- Exhibit TPE17f: a copy of a supplement to the January 2010 GQ magazine, published in association with the opponent and featuring their products and the full range of marks.

10) The second witness statement, dated 11 May 2010, is by James Wintle, the Head of e-commerce of All Saints Retail Ltd. He states that the company was registered on 25 October 2000 and that he is responsible for running the websites allsaints.com and allsaints.co.uk and also the on-line sales arm of his company. At exhibits JW1-3 he provides statistics for visits to these two websites from a number of countries. I have extracted the relevant figures as follows:

Period	Total visits worldwide	UK visits	Average time on site	Pages visited	New visits
01.01.10-05.05.10	5,812,274	4,751,940	05.31 minutes	14.33	33.75%
01.01.09 – 31.12.09	10,955,149	9,177,489	06.00	15.83	37.97%
01.01.08 – 31.12.08	2,424,741	2,129,205	06.28	20.45	40.51%

11) The third witness statement, dated 11 May 2010, is by Brian McCluskey the CEO of Office Holdings Limited a footwear retailing company, a position he has held since 2003. His company has a turnover of approximately £145 million and it has 115 stores in the UK and Europe. He states that:

“4. I first became aware of All Saints Retail Limited (hereinafter “All Saints”) and the ALL SAINTS and Ramskull logo trade marks roughly 4 to 5 years ago.

5. In my judgement, All Saints have successfully used a number of different trade marks, the unique industrialised appearance of the shopfit in their outlets and their product styling to create an overall brand which is highly distinctive and recognisable.

6. The Ramskull logo is an important element of this branding and is synonymous with All Saints in its own right.

7. Although the above comments in paragraphs 6 and 7 are my personal view, I would fully expect that[sic] this view to be shared by other CEO's within my industry sector and by consumers in the UK in view of the distinctiveness and strength of All Saints' branding."

12) The fourth witness statement, dated 23 June 2010, is by Scott Murdoch the Managing Partner in the firm CWM London. His company is the foremost niche retail property consultancy firm in the UK. His company has assisted the opponent to acquire and dispose of several properties since 2005. He states:

"4. The All Saints brand is widely regarded within the retail property industry as being significant, easily recognisable and well-established. Due to the significant strength of the All Saints brand, commercial property owners and landlords are especially keen to secure All Saints' presence within their retail centres. They feel that the strong pulling power of the All Saints brand will entice other large retailers to want to locate in the same areas, and will result in an increase in visitors and consumers. As such, they are willing to pay All Saints significant sums ("capital contributions") in order to secure All Saints' presence. In some instances, these agreements have involved sums running into several millions of pounds, as well as extensive "rent-free" periods. This displays the significant size, strength and appeal of All Saints' brand."

13) The fifth witness statement, dated 23 June 2010, is by Louise Westbury, the opponents' Trade Mark Attorney. In exhibits LW1 and LW2 she provides the following information obtained from the opponent's records:

Period	UK store transactions	Internet transactions (mostly from UK)
01.01.07 -31.12.07	712,458	28,229
01.01.08 – 31.12.08	1,198,797	86,794
01.01.09 – 31.12.09	1,674,077	331,933
01.01.10 – 20.06.10	687,941	250,405

14) The sixth witness statement, dated 24 June 2010, is by Robert Bready the Product and Trading Director of ASOS.com Limited the UK's largest independent online fashion and beauty retailer. He states:

"4. I am familiar with the products and brand of the manufacturer and retailer All Saints Retail Ltd of Jack's Place, Units C15-C17 6 Corbet Place, London E1 6NN, UK ("All Saints") and its trade marks ALL SAINTS, ALLSAINTS, ALLSAINTS SPITALFIELDS and the following ramskull logo:



5. All Saints has developed a very strong brand under those trade marks, and its products are readily recognised, by means of the marks, both within the retail industry and by consumers.

6. ASOS.com is so confident that products branded ALL SAINTS and/or with the ramskull logo above will sell to its end users that it buys significant volumes of All Saints' products."

### **APPLICANT'S EVIDENCE**

15) The applicant filed a witness statement, dated 10 October 2010, by Tony Knight the owner/founder of the applicant company. He states that he has used and managed the clothing brand Sacred Saint since 1999. At exhibit 2 he provides five invoices dated between 1 August 2000 and 3 June 2002. Only four of these are addressed to UK addresses. These four invoices show a total of 885 Sacred Saint T shirts being provided at a cost of £4,830. Mr Knight does state that these are "just some of the sales invoices going back to 2000".

16) That concludes my summary of the evidence filed, insofar as I consider it necessary.

### **DECISION**

17) I shall first consider the ground of opposition under Section 5(2)(b) which reads:

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

(a)...

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

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

18) An "earlier trade mark" is defined in section 6, the relevant part of which states:

"6.-(1) In this Act an "earlier trade mark" means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks."

19) In these proceedings the applicant is relying upon two earlier marks which have application dates of 30 August 2005 and 12 July 2006. Both are clearly earlier trade marks and as neither has been registered for five years they are not subject to The Trade Marks (Proof of Use, etc) Regulations 2004.

20) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law 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 B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P* (LIMONCELLO). In the recent case of *La Chemise Lacoste SA v Baker Street Clothing Ltd* [ALLIGATOR O/333/10] Mr Hobbs QC acting as the Appointed Person set out the test shown below which was endorsed by Arnold J. in *Och-Ziff Management Europe Ltd and Oz Management Lp v Och Capital LLP; Union Investment Management Ltd & Ochocki*, [2010] EWCH 2599 (Ch).

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods/ services in question; who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements; nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;
- (e) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element in that mark;
- (f) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;
- (g) 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;
- (h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient;



(i) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(j) if the association between the marks causes the public to wrongly believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

22) In essence the test under section 5(2)(b) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgments mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed. Furthermore, I must compare the applicant's mark and the marks relied upon by the opponent on the basis of their inherent characteristics assuming normal and fair use of the marks on the goods in their specifications.

23) The effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act was considered by David Kitchin Q.C. (as he was then) sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchin concluded at paragraph 17 of his decision:



“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in *Reed Executive & Ors v. Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become more distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

24) In the instant case the opponent has provided a considerable amount of evidence regarding media coverage of its various marks. It is clear that it enjoys a high profile in the clothing media. Allied to this the opponent has supplied turnover figures for the UK which show that in the three years prior to the application the opponent averaged a turnover in the UK of over £60 million,

and that the figures were increasing significantly each year. Although these figures have not been put in context in terms of the overall UK market for clothing, which must be very substantial, or provided an indication of market share I am willing to accept that the opponent's marks can benefit from an enhanced reputation. I also note that the opponent's marks are inherently highly distinctive.

25) I now turn to consider the goods of the two parties. At the hearing Mr Knight agreed that each of the opponent's specifications encompasses the whole of the applicant's specification and so the goods of the two parties must be regarded as identical.

26) I now turn to consider the marks of the two parties. For ease of reference these are reproduced below:

Applicant's mark	Opponent's marks
	<p data-bbox="715 786 1102 817">CTM 4610945: ALL SAINTS</p> <p data-bbox="715 817 911 853">CTM 5240049:</p> 

27) I shall first compare the mark in suit with the opponent's mark CTM 4610945. The opponent contends that the dominant and distinctive element of the mark in suit are the words "Sacred Saints". I do not accept this contention. Whilst I accept that "words speak louder than devices" I do not believe that the unique and very arresting image in the applicant's mark can be easily relegated to a secondary role. To my mind the device does not support the words "sacred saints" it appears to be entirely contrary, as it evokes a "punk" image which is at odds with the words. They further contend that the word "Sacred" is simply a descriptor for the distinctive word "Saints" on the basis that all saints are sacred. Whilst I accept that saints are sacred it is unusual to juxtapose these words. They further claim that semantically and conceptually, "Sacred Saints" is identical to or at least a subset of "All Saints", as they both evoke a strong religious connotation.

28) Visually the two parties' marks have a degree of similarity in that they both contain the word "saints". However, the mark in suit has a highly distinctive device element of a human skull with a Mohawk hairstyle. I also note that the first words of each of the parties' marks are different "Sacred" and "All". Overall whilst there is a moderate degree of visual similarity there are considerable differences.

29) The opponent is correct in stating that the device element in the applicant's mark cannot be pronounced, therefore the aural comparison is between the words contained in each mark. They obviously both have "Saints" as their second word and clearly have different initial words, "Sacred" and "All". Again there are similarities as well as differences.

30) Conceptually, I accept that the word elements of both marks have a religious overtone. However, the opponent's mark is used annually in November to either honour all the saints or as a day of prayer for the dead in purgatory depending upon which Christian code one follows. The applicant's mark clearly also has a religious tone, but the combination of the punk human skull which has an air of defiance or aggression and the words "sacred saints" appear contradictory, and almost mocking. I therefore consider that there are minor similarities but greater differences. Taken overall I consider that the differences in the marks far outweigh any slight similarity.

31) I now move on to consider the mark in suit to the opponent's CTM 5240049. The opponent contends that the marks are similar "since both marks contain an image of a skull with the connotations that that image evokes". Suddenly the opponent believes that the words in the mark in suit are not the distinctive and dominant element after all and that the average consumer will view the mark as a "skull" mark. I have already provided my views on how the mark in suit will be viewed by the average consumer. The opponent's mark will be seen as an animal skull mark, more closely linked to pagan or devil worship than to the Christian religion. Further, the mark in suit contains a human skull not that of an animal. To my mind, the marks are completely dissimilar at every level.

32) The goods of the two parties are clothing, footwear and headgear and so the average consumer is the general public. Such items can vary enormously in price and so the level of attention paid by the consumer will vary. However, given that clothing needs to fit, and that fabrics are increasingly a consideration in the purchasing decision, it is likely that a reasonable level of attention will be paid by the average consumer. I also take into account the views of Mr S Thorley sitting as the Appointed Person in the *REACT* case [2000] RPC 285 where he said:

"[*Counsel*] ....drew my attention to the fact that in relation to clothing of the type for which the mark is to be registered, anybody using the mark aurally would be informed to some extent of the nature of the goods they were proposing to purchase; they will therefore know of a mark; and they will know what they want. I think there is force in this in the context of purchasing clothes. The Hearing Officer was prepared of his own experience to hold that the initial selection of goods would be made by eye, and I believe this is correct. I must therefore, in taking into account the likelihood of aural confusion, bear in mind the fact that the primary use of the trade marks in the purchasing of clothes is a visual act."

33) I also note that in *Update Clothing Ltd* BL O/258/98 the Hearing Officer said:

"There is no evidence to support Ms Clarke's submission that, in the absence of any particular reputation, consumers select clothes by eye rather than by placing orders by word of mouth. Nevertheless, my own experience tells me it is true of most casual shopping. I have not overlooked the fact that catalogues and telephone orders play a significant role in this trade, but in my experience the initial selection of goods is still made by eye and subsequent order usually placed primarily by reference to a catalogue number. I am therefore prepared to accept that a majority of the public rely *primarily* on visual means to identify the trade origin of clothing, although I would not go so far as to say that aural means of identification are not relied upon".

34) I must now take all the above into account and consider the matter globally taking into account the interdependency principle- a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods and vice versa. In this case the goods are identical but in the case of the opponent's mark CTM 5240049 the marks are dissimilar and there is no likelihood of confusion, nor is there a likelihood of association with the earlier trade mark. Moving onto the opponent's mark CTM 4610945 the similarities between the marks are far outweighed by the differences to such an extent that even when used on goods which are identical and which could be purchased with relatively little consideration, and taking into account the opponent's enhanced reputation and the fact that it is inherently highly distinctive, there is no likelihood of confusion, nor is there a likelihood of association with the earlier trade mark. The ground of opposition under Section 5(2)(b) therefore fails.

35) I now turn to consider the ground of opposition under Section 5(4)(a) of the Act.

“5. (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

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.”

36) In deciding whether the marks in question offend against this section, I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the *WILD CHILD* case [1998] RPC 455. In that decision Mr Hobbs stated that:

“The question raised by the grounds of opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the applicant from those of other undertakings (see section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Article 4(4)(b) of the Directive and section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the applicant in accordance with the law of passing off.

A helpful summary of the elements of an action for passing off can be found in Halsbury's Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731 is (with footnotes omitted) as follows:

‘The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

- (1) that the plaintiff'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 defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.'

Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

'To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

37) First I must determine the date at which the opponent’s claim is to be assessed; this is known as the material date. In this regard, I note the judgment of the General Court (GC) in *Last Minute Network Ltd v Office for Harmonization in the Internal Market* (Trade Marks and Designs) (OHIM) Joined Cases T-114/07 and T-115/07. In that judgment the GC said:

“50 First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (Cadbury Schweppes v Pub Squash (1981) R.P.C. 429).

51 However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non registered national mark before the date of filing, in this case 11 March 2000.”

38) In its evidence the opponent claims to have first used their “All Saints” mark in suit in 2001 and so this should be the relevant date. However, if the applicant had used its trade mark prior to this then this use must also be taken into account. It could, for example, establish that the applicant is the senior user, or that there had been common law acquiescence, or that the status quo should not be disturbed; any of which could mean that the applicant’s use would not be liable to be prevented by the law of passing-off – the comments in *Croom’s Trade Mark Application* [2005] RPC 2 and *Daimlerchrysler AG v Javid Alavi (T/A Merc)* [2001] RPC 42 refer.

39) I note that the applicant claims to have first used the mark in suit in 1999, although his first corroborating evidence is dated August 2000. The opponent has, in its written submissions for the hearing, cast doubt on this claim. However, it did not seek to cross examine Mr Knight nor did it challenge his evidence. I take into account the comments of Mr Arnold Q.C (as he was) when acting as the Appointed Person in *Extreme O/161/07* where he commented on the issue of unchallenged evidence and cross examination:

*“Unchallenged evidence*

33. *Phipson on Evidence* (16th ed) states at paragraph 12-12:

In general a party is required to challenge in cross-examination the evidence of any witness of the opposing party if he wishes to submit to the court that the evidence should not be accepted on that point. The rule applies in civil cases as it does in criminal. In general the CPR does not alter that position.

This rule [sic] serves the important function of giving the witness the opportunity of explaining any contradiction or alleged problem with his evidence. If a party has decided not to cross-examine on a particular important point, he will be in difficulty in submitting that the evidence should be rejected.

However the rule is not an inflexible one...

34. The authority cited in support of this statement of the law is the decision of the House of Lords in *Browne v Dunn* (1894) 6 R 67. The relevant passages from the speeches are set out in the judgment of Hunt J in *Allied Pastoral Holdings v Federal Commissioner of Taxation* (1983) 44 ALR 607, the material parts of which are quoted in the judgment of the Court of Appeal in *Markem Corp v Zipher Ltd* [205] EWCA Civ 267, [2005] RPC 31 at [59]-[60].

35. In my judgment the learned editors of *Phipson* are correct to say that the rule is not an inflexible one. There are at least two well-established exceptions to it. The first is that, as the speech of Lord Herschell LC in *Browne v Dunn* makes clear, it may not be necessary to cross-examine on a point if the witness has been given full notice of it before making his statement. As I pointed out in *BRUTT Trade Marks* [2007] RPC 19 at [23], this may be significant in registry proceedings where evidence is given sequentially. The second is that a court is not obliged to accept a witness's evidence in the absence of cross-examination if it is obviously incredible: see *National Westminster Bank plc v Daniel* [1993] 1 WLR 1453.

36. Where, however, evidence is given in a witness statement filed on behalf of a party to registry proceedings which is not obviously incredible and the opposing party has neither given the witness advance notice that his evidence is to be challenged nor challenged his evidence in cross-examination nor adduced evidence to contradict the witness's evidence despite having had the opportunity to do so, then I consider that the rule in *Brown v Dunn* applies and it is not open to the opposing party to invite the tribunal to disbelieve the witness's evidence.

37. Despite this, it is not an uncommon experience to find parties in registry hearings making submissions about such unchallenged evidence which amount to cross-examination of the witness in his absence and an invitation to the hearing officer to disbelieve or discount his evidence. There have been a number of cases in which appeals have been allowed against the decisions of hearing officers who have accepted such submissions. Two recent examples where this appears to have happened which were cited by counsel for the proprietor are *Score Draw Ltd v Finch* [2007] EWHC 462 (Ch), [2007] *BusLR* 864 and *EINSTEIN Trade Mark* (O/068/07). Another recent example is *Scholl Ltd's Application*

(O/199/06). I consider that hearing officers should guard themselves against being beguiled by such submissions (which is not, of course, to say that they should assess evidence uncritically).”

40) I accept that the evidence provided is meagre, however the four invoices show a total of 885 T shirts being sold for £4,830 under the sacred Saint mark. I also note that the applicant states that these are “just some of the sales invoices going back to 2000”. To my mind, although scant the evidence, especially as it is unchallenged, is enough for the applicant to claim to be the senior user. The ground of opposition under Section 5(4)(a) fails.

41) However, in case I am wrong on this I will ignore the evidence of the applicant and consider the issue as if the applicant had not put its mark into use.

42) The opponent has claimed that it has used its two registered marks and in addition the three marks set out in Annex A. To my mind the registered mark “All Saints” and the ramskull logo effectively are identical to the marks in Annex A. The only difference between the first two marks and the mark “All Saints” are the font used and in one instance the word “Spitalfields”. The use of the later makes the mark more of a geographical locator as most would view the mark as referring to the church called “All Saints” in Spitalfields. This takes it further away from the mark in suit. The ramskull appears to be identical to the registered version. I do not believe that the use of the marks in Annex A advance the position of the opponent.

43) I have accepted earlier in this decision that the opponent has made use of its marks and that at the date of the application it had goodwill in both its registered marks and goodwill in the additional marks relied upon. Earlier in this decision I compared the marks of the two parties and found that the differences far outweighed any similarities. I take into account the comments of Morrill J in the Court of Appeal in *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, when he said, in effect, that the correct test on the issue of deception or confusion was whether, on the balance of probabilities, a substantial number of members of the public would be misled into purchasing the applicant’s products in the belief that they were the registered proprietor’s.

44) I do not believe that the average consumer would be so misled. The ground of opposition under Section 5(4)(a) fails.

## COSTS

45) The opponent has failed on all the grounds pleaded. As such the applicant is entitled to a contribution towards its costs. At the hearing/in written submissions, both parties sought costs over and above the scale stating that the other party had behaved unreasonably. Having considered all the papers it is my view that both sides are equally at fault and as such an award to either party in this respect would be inappropriate. As Mr Knight is a private applicant I have reduced the amount awarded by 50% in accordance with normal practice.

Preparing a statement and considering the other side’s statement	£200
Preparing evidence and considering and commenting on the other side’s evidence	£800



Preparing for and attending a hearing	£400
TOTAL	£1,400

46) I order the opponent to pay the applicant the sum of £1,400. This sum 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 19 day of May 2011**

**George W Salthouse  
For the Registrar,  
the Comptroller-General**

**ANNEX A**

Logos referred to in exhibit TPE2.

1. The logo ALL SAINTS:

**ALLSAINTS**

2. The logo ALLSAINTS SPITALFIELDS:

*All Saints*  
SPITALFIELDS.

3. The ramskull logo:

