

**TRADE MARKS ACT 1938 (AS AMENDED)  
AND TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. B1481619  
BY NA NA TRADING CO., INC.  
TO REGISTER A TRADE MARK IN CLASS 25**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 41716 BY NAF NAF**

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**DECISION**

On 6 November 1991 Na Na Trading Co., Inc of Santa Monica, California, USA applied under Section 17(1) of the Trade Marks Act 1938 to register the trade mark NA NA in Class 25 in respect of the following goods:

Underwear for women and girls; hosiery; shoes, boots and sandals; hats, caps and scarves; articles of outer clothing; all included in Class 25.

On 18 November 1994 Naf Naf filed notice of opposition against the application. The grounds of opposition in summary are:

1. Under Section 12(1) because the trade mark in suit is confusingly similar to and encompasses the same goods or goods of the same description as trade marks which stand in the ownership of the opponents.
2. Under Section 11 because use of the applicants' trade mark would lead to deception and confusion because of the goodwill and reputation the opponents possess in relation to their trade marks.
3. The Registrar should refuse the application in exercise of his discretion.

The registered marks to which the opponents refer are as follows:-

NUMBER	MARK	CLASS	JOURNAL/ PAGE	SPECIFICATION
1262198		25	5645/2921	Articles of clothing for children.

**NAF NAF**

1377098

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5854/60

Babies' diapers made of textile materials, included in Class 25.

**NAF NAF**

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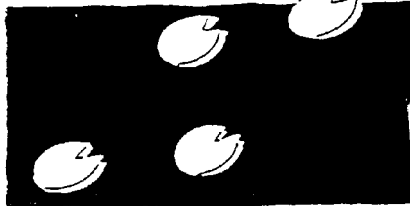
1452552

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5913/1759

Articles of outerclothing; coats,suits, trousers, shirts, skirts, socks, stockings, diapers, swimming suits; pullover, belts, tee shirts, sweatshirts; articles of underclothing; negligees, pyjamas, nightdresses, pants; hats, shoes;babies' diapers being textile; all included in Class 25.

**NAF NAF**



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The applicants filed a counterstatement denying the grounds of opposition and they too seek the exercise of the Registrar's discretion in their favour.

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The opponents seek an award of costs in their favour.

The matter came to be heard on 29 September 1998 when the opponents were represented by Miss. Caroline O'Brien of Mewburn Ellis, their trade mark agents. The applicants did not attend and were not represented.

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By the time the matter came to be heard, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. In accordance with the transitional provisions set out in Schedule 3 to that Act, however, I must continue to apply the relevant provisions of the old law to these proceedings. Accordingly, all references in this decision are references to the provisions of the old law unless otherwise indicated.

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#### **OPPONENTS' EVIDENCE (RULE 49)**

The opponents filed a declaration dated 22 December 1995 by David Sankowicz who is the legal department manager of Naf Naf SA, a position he has held since 15 September 1994.

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Mr. Sankowicz states that Naf Naf are the registered proprietors of United Kingdom trade mark registration numbers 1262198, 1377098, 1452552 and 1511699. The trade marks all consist of or contain the words NAF NAF, the advertisements are exhibited by him as exhibit DS1.

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Mr. Sankowicz goes on to state that Naf Naf was founded in Paris in 1973 and is now a public limited company whose shares are listed on the Paris stock exchange. Naf Naf specialises in casual clothes for children and young adults. He states that it one of the best known clothing brands in France and elsewhere. Naf Naf owns 170 shops in France and 38 elsewhere in Europe, 7 of which are in the United Kingdom. They also sell through 2,500 retail customers, 130 of which are in the United Kingdom.

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Mr. Sankowicz states that Naf Naf first sold clothing in the United Kingdom under the NAF NAF trade mark around July 1983 when the trade mark was used in an advertising campaign in British magazines and newspapers including: Honey, Womens Own, You Magazine, Style, Daily Express, It Magazine, Company, The Mail, and The Mail on Sunday. Sales since that time have been continuous.

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A list of the retail customers in the United Kingdom and the approximate date on which business commenced with these retail customers is exhibited as exhibit DS2, the earliest is 13/01/86 . A list of the Naf Naf shops in the United Kingdom with their opening dates is exhibited as exhibit DS3, the earliest is 12/05/93.

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Mr. Sankowicz states that for the period from 1983 - 1992 Naf Naf's sales in the United Kingdom were made through a wholesaler and then through an agent. A subsidiary company, Naf Naf United Kingdom Limited was set up in 1992 and sales since then have been through this company. Mr. Sankowicz continues then to set out annual sales figures for Naf Naf in the United Kingdom for the period 1984 to 1993:

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Year.	Annual Sales to United Kingdom Distribution Agent	
	K FRF	K United Kingdom £ (figures based on wholesale prices)
1984	500	63
1985	1000	125
25 1986	1927	241
1987	5918	740
1988	9700	1213
1989	25000	3125
1990	45853	5732
30 1991	44903	5613
1992	22607	2826
1993	15532	1942

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Mr. Sankowicz states that the commercial interests of Naf Naf extend to all types of clothing, footwear and headgear. Literature relating to the range of goods sold by Naf Naf is exhibited as exhibit DS4. The goods sold by Naf Naf, he states, are all marked with one of their trade marks, most usually the NAF NAF mark. Mr. Sankowicz states that frequently the NAF NAF mark is applied to the garments in such a way that it is clearly visible when being worn. He states the literature exhibited as exhibit DS4 shows use of the mark NAF NAF in relation to underwear for women and girls, hosiery, shoes, books, sandals, hats, scarves, jackets, coats and jumpers.

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Mr. Sankowicz further states that he considers that the applicants' trade mark NA NA is confusingly similar to NAF NAF and that use of NA NA would lead to confusion amongst purchasers of the goods who would believe that they were manufactured by Naf Naf. He states also that as a result of the advertising and sales in relation to the trade mark NAF NAF his

company has built up a considerable and longstanding reputation together with goodwill and that because of this there would be a serious danger of confusion with the trade mark NA NA, especially at the retail level.

5 As the applicant did not file any evidence this completes my review of the evidence filed in these proceedings.

## DECISION

10 I turn to the grounds of opposition which are based upon Sections 11 and 12(1) of the Act, which state:-

15 “11 It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.

20 12 (1) Subject to the provisions of subsection (2) of this section, no trade mark shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of:-

- 25 a. the same goods
- b. the same description of goods, or
- c. services or a description of services which are associated with those goods or goods of that description.”

30 The reference in Section 12(1) to a near resemblance is clarified by Section 68(2B) of the Act which states that references in the Act to a near resemblance of marks are references to a resemblance so near as to be likely to deceive or cause confusion.

35 The established tests for objections under these provisions are the ones set down in Smith Hayden and Company Ltd’s application (Volume 1946 63 RPC 101) later adapted, in the case of Section 11, by Lord Upjohn in the BALI trade mark case 1969 RPC 496. Adapted to the matter in hand, these tests may be expressed as follows:-

40 (a) (under Section 11) Having regard to the user of the opponents’ trade mark NAF NAF is the tribunal satisfied that the trade mark applied for NA NA if used in a normal and fair manner in connection with any goods covered by the registration proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?

45 (b) (under Section 12) Assuming user by the opponents of their trade marks in a normal and fair manner for any of the goods covered by the registrations of those trade

marks, is the tribunal satisfied that there will be no reasonable likelihood of deception among a substantial number of persons if the applicants use their trade mark NA NA normally and fairly in respect of any goods covered by their proposed registration?

I deal first of all with the grounds of opposition upon Section 11.

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The terms of Section 11 bar the registration of any mark disentitled to protection in a court of justice. In Kerly's "Law of Trade Marks and Trade Names", 12th edition (10-26) this scope of Section 11 is expressed as follows:-

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"This section is directed to some positive objection to registration and not to mere lack of qualification. It contemplates some illegality or other disentanglement in the mark itself."

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It would appear that in the view of the opponents this disentanglement in the mark applied for arises from their reputation in the trade mark NAF NAF in relation to clothing. The evidence shows that the opponents' trade mark has been used and registered in several formats but in all of these it is very much a NAF NAF mark and I am satisfied that in each case the NAF NAF element is predominant and is the one by which the trade mark will be known and referred to. The turnover figures and amount spent on advertising goods under the trade mark are of a substantial nature but the supporting exhibits supplied do not clearly support the range of clothing upon which it is claimed that the trade mark NAF NAF was used in the United Kingdom by the relevant date, 6 November 1991. (The likelihood of confusion must be considered at the date of the application to register - McDowell (1927) 44 RPC 335 and Dixon v Taylor (1933) 50 RPC 405.) Some of the evidence adduced relates to a period after the relevant date and a number of the exhibits are in French and I do not consider that they can be adduced to support use within the United Kingdom - they are clearly aimed at a different market. However, the remainder of the exhibits do support use of the trade marks and this demonstrates that the opponents had a substantial reputation in relation to outer clothing for women by the relevant date which are the same or similar goods to outer clothing included in application no. 1481619. Although the evidence submitted only fully supports outer clothing for women given the opponents reputation in respect of those goods I consider it not unreasonable, given also the nature of the clothing trade, where it is common for a trader to trade across a wide spectrum of the goods, that the opponents' reputation will accrue to a wide range of goods falling in Class 25 and this is likely to encompass all of the goods in the specification of application no. 1481619.

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Having decided that the applicants and the opponents trade or intend to trade in the same goods I go on to consider the issue of confusability (both in respect of the Section 11 and the Section 12(1) issue.)

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In comparing of the respective trade marks of the opponents and the applicants NAF NAF and NA NA, I take into account the guidance set down by Parker J in Pianotist Companies application (1906) 23 RPC 777 at line 26 et seq, which reads as follows:-

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"You must take the two words. You must judge of them both by their look and by their sound. You must consider the goods to which they are to be applied. You must

consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of these trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion - that is to say - not necessarily that one will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public, which will lead to confusion in the goods - then you may refuse the registration, or rather you must refuse the registration in that case."

In her submission Miss O'Brien also referred me to *Aristoc Ltd v Rysta Ltd* case (1945) 62 RPC in commenting upon the concept of imperfect recollection, and the *Tripcastroid* case 42 RPC 264 in relation to the importance of the beginning of words in the comparison of trade marks. For convenience I reproduce below what I consider to be the relevant respective passages from the two decisions:

"The answer to the question whether the sound of one word resembles too nearly the sound of another so as to bring the former within the limits of Section 12 of the Trade Marks Act 1938 must nearly always depend on first impression, for obviously a person who is familiar with both words will neither be deceived nor confused. It is the person who only knows the one word and has perhaps an imperfect recollection of it who is likely to be deceived or confused. Little assistance therefore is to be obtained from meticulous comparison of the two words, letter by letter and syllable by syllable pronounced with the clarity to be expected from a teacher of elocution. The court must be careful to make allowance for imperfect recollection and the effect of careless pronunciation and speech on the part not only of the person seeking to buy under the trade description but also of the shop assistant ministering to that person's wants."

and

"The termination of the new word is different. Though I agree that, if it were the only difference, having regard to the way in which the English language is often slurred at the termination of words, that might not alone be sufficient distinction. But the tendency of persons using the English language to slur the termination of words also has the effect necessarily that the beginning of words is accentuated in comparison, and in my judgement, the first syllable of a word is, as a rule, far the most important for the purpose of distinction."

Both trade marks consist of a single repeated syllable, in each case the syllables are separated by a space. Miss O'Brien submitted that the respective trade marks looked similar and that where clothing was purchased there was a danger of confusion, where customers casually browsed through a rack of clothes just glancing at the label. I consider also that there is every possibility that the vowels in both respective marks could be pronounced as short vowels, indeed I believe that that is the most likely form of the pronunciation of each.

Before I simply apply the accepted case law to this case I consider that it is important to consider all of the circumstances of the trade in which the respective trade marks are or are intended to

be used. In that respect I am aware that clothing branding is of great importance and that ordinary customers (particularly younger customers) now have a very acute awareness of brands and the various variants. Thus clothing is often purchased because of the trade mark and not just because of style or price.

5 However, even whilst taking this into account I consider that the respective trade marks are confusingly similar. I have reached this conclusion on the basis that I consider that the criteria in relation to confusion in all of the cases referred to above are met. If one judges the trade marks in this case against one another one sees trade marks that have a clear visual similarity, each contains or consists of the repeated syllable NA with a gap separating the repetition. Taking  
10 into account potential use on swing tickets or labels on clothing in racks and taking into account imperfect recollection there is a real likelihood of confusion. The beginnings of each of the syllables of the respective trade marks is the same. The criteria of Tripcastrord cannot be applied blindly. In a short word the end of the word will take on greater importance, however, in this case we have trade marks which consist of two separated syllables which are short but in  
15 which the repetition adds to the danger of confusion. I also accept Miss O'Brien's submission that owing to the closeness of the trade marks the customer might consider that NA NA represented a new range of goods produced by the opponents.

The opposition based upon Section 11 therefore succeeds.

20 I turn next to the opposition under Section 12(1).

The evidence refers to four registrations of the opponents. For convenience sake I will deal with one of the registrations: no. 1511699 for the trade mark NAF NAF in respect of clothing,  
25 footwear and headgear. For the reasons given above I consider the trade marks NAF NAF and NA NA confusingly similar, and as registration no. 1511699 encompasses the class heading the specification of the application in suit must be fully encompassed by it and so contains the same goods. Therefore the opposition under Section 12(1) also succeeds.

30 Finally there remains the matter of the Registrar's discretion. As the opponents have been successful in respect of their opposition under both Sections 11 and 12 no exercise of that discretion is either necessary or appropriate.

35 As the opponents have been successful in these proceedings they are entitled to a contribution towards their costs. I hereby order the applicants to pay to the opponents the sum of £735.

**Dated this 15<sup>th</sup> day of October 1998**

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**M. KNIGHT**  
**For the Assistant Registrar**  
**The Comptroller General**