

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 1562164
BY C & J CLARK INTERNATIONAL LTD TO
REGISTER THE MARK CDX IN CLASS 25**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No 43311 BY CHRISTIAN DIOR SA**

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

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**IN THE MATTER OF Application No 1562164
by C & J Clark International Ltd to Register the
mark CDX in Class 25**

10 **and**

**IN THE MATTER OF Opposition thereto under
No 43311 by Christian Dior SA**

15

DECISION

20 On 31 October 1994 C & J Clark International Ltd applied to register the mark CDX for a
specification of goods comprising “footwear; boots, shoes, slippers and sandals; parts and
fittings for all the aforesaid goods; all included in Class 25”.

The application is numbered 1562164.

25 On 24 October 1995 Christian Dior SA filed notice of opposition to this application on the
following grounds:

- 30 (i) under Section 5(2)(b) in that the mark applied for is similar to marks applied
for or registered in the name of the opponents for the identical or similar goods
(see Annex A for details of the opponents’ marks);
- 35 (ii) under Section 5(3) in that the mark applied for would take unfair advantage of
and be detrimental to the distinctive character and repute of the opponents’
marks;
- (iii) under Section 5(4)(a) in that use of the mark is liable to be prevented by the
law of passing off;
- 40 (iv) under Section 3 in that the mark cannot be distinctive of the goods of the
applicants.

There is also a reference to the discretionary powers of the Registrar but as I do not consider
that I have any general discretion in the matter I need say no more about this particular claim.

45 The applicants filed a counterstatement denying the above grounds.

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

Both sides filed evidence in these proceedings and the matter came to be heard on 6 October 1998 when the applicants were represented by Mr D Alexander of Counsel instructed by Marks & Clerk, Trade Mark Agents and the opponents by Mr R Arnold of Counsel instructed by Browne Jacobson, Solicitors.

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Opponents' evidence

The opponents filed four statutory declarations as follows:-

10 David Caldwell dated 8 August 1996
Christopher Brandon-Trye dated 6 August 1996
Grattan Endicott dated 12 August 1996
Gerard Bouet dated 5 August 1996.

15 Mr Caldwell is Director of Couture Marketing Ltd. His company has held the licence to manufacture and distribute ladies' hosiery under the Christian Dior name since 1974 during which time hosiery has been sold throughout the UK and to retailers such as House of Fraser, Debenhams, John Lewis Partnership, Fenwicks, Selfridges, Harvey Nicholls and Harrods.

20 He says that the letters CD are one of the main trade marks of Christian Dior and his company has used the letters as a logo on ranges of hosiery. An example is exhibited at DC1. Additionally the company has used the CD motif printed in diamanté on the ankles of hosiery. He also exhibits (DC2) an example of Diorella extra size tights. The letter X is, he says, often used in the trade to indicate a particular size or an extra size of the product.

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Mr Brandon Trye is a Director of Parfums Christian Dior which company is completely independent of the Christian Dior Couture operation. He says that many of the products of Parfums carry what he calls the CD lozenge on the packaging or impressed on the top covers of the products. He exhibits an example at CBT1 and a price list of the Parfums' products on which the Christian Dior mark is used (CBT2). He considers that use of the letters CDX would deceive trade buyers and the purchasing public into thinking the goods were those of Christian Dior and that "the association of the letters CD with Christian Dior might be compromised".

35 Finally he says that it is not uncommon for a descriptive letter or number to be added to a well known mark but the purchasing public still associate the product using such a mark with the owner of that well known mark. He cites as an example a new perfume by Calvin Klein called CK One (CBT3).

40 Mr Endicott is Secretary to the Trustees of the Foundation for Sport and the Arts an independent discretionary trust. He is a purchaser of Christian Dior products for their design excellence and reputation for quality. He considers that the initials CD mean Christian Dior whenever they are used on fashion or design products. He is aware that Christian Dior have made shoes under the CD trade mark. He says that if he were to see shoes sold by reference to the letters CDX he would consider that such shoes were a Dior product bearing an added mark of superiority such as "extra" or "extraordinaire" or denoting excellence.

45

Mr Bouet is the administrative and legal department manager of Christian Dior SA. He supervises all products made and sold under the trade marks of Christian Dior. He exhibits (GB1) a collection of advertisements showing use of the mark CD. The following goods have been sold under the mark umbrellas, leather goods (bags, diaries, wallets, key rings), scarves, handbags and bags for general use with CD buckles or CD imprinted material, childrens clothing, mens shirts, bath and bed linen, luggage, linings for mens suits, belts with CD buckles, buckles for shoes, mens ties, shoes (mens and womens), handkerchiefs.

Mr Bouet says that the value of retail sales of all these products in the UK in any one calendar year amounts to many millions of French francs. He also exhibits (GB3) material filed in support of an application in Class 14 in respect of horological products and jewellery items.

Mr Bouet says that the first use of the letters CD upon or in relation to shoes originating in France was in 1992 and the first price lists and promotional literature circulating in the United Kingdom including such shoes was in Winter 1994. He exhibits (GB4) copies of price list sheets for sales seasons in 1994, 1995 and 1996 all showing the range of shoes upon which the CD trade mark is used, and (GB5) a pair of such shoes.

Shoes bearing the trade mark CD or shoes sold under the Christian Dior trade marks including those upon which the letters or trade mark CD actually appear are available in the United Kingdom primarily through the Dior Boutique in Sloane Street London as well as through a licensed concession area in Harrods and at Heathrow Airport.

Such shoes retail for approximately £200 per pair and in the course of 1995 some 20 pairs of shoes bearing the CD logo were sold. Other examples of advertisements and catalogues are at GB6. As a result of this activity Mr Bouet says the opponents have acquired an extensive reputation in the UK.

Turning to the applicants' mark Mr Bouet says that his enquiries lead him to believe that the letters CDX are used in conjunction with the trade mark K and in association with the descriptive words "comfort design excellence" (GB7). Finally he draws a number of conclusions as to the consequence of use of the letters CDX for the opponents' business and says that it would constitute an infringement of Dior's registration of CD for the goods in question.

Applicants' evidence

The applicants filed two statutory declarations. The first dated 25 October 1996 comes from Judith Enid Derbyshire, the Company Secretary of C & J Clark International Ltd.

Ms Derbyshire says the mark CDX has been in continuous use in the UK upon and in relation to men's shoes since 1989. She exhibits (JED1) photographs, swing tags and point of sale material showing the trade mark in use.

The ex-factory value of sales for each of the years 1989 to 1994 is said to have been:

	Year	£
5	1989	3,878,000
	1990	8,069,000
	1991	6,142,000
	1992	4,422,000
	1993	7,711,000
10	1994	8,168,000

Shoes are sold under the mark throughout the United Kingdom both through the company's own retail outlets and through independent shoe shops and other retailers. A list of locations is given showing the geographical spread of sales. Approximately £150,000 is spent annually advertising goods for sale under the mark. Advertisements have appeared in a number of leading newspapers and magazines and shoes sold under the mark have been promoted at trade fairs and exhibitions. Ms Derbyshire concludes by saying that the trade mark CDX is distinctive of her company's products and she is not aware of any instances of confusion with the products of Christian Dior.

The second declaration is dated 8 November 1996 and comes from Thomas Farrand, the registered trade mark attorney who has conduct of these proceedings on behalf of the applicants. He comments on Mr Bouet's declaration. In summary:

- 25 - he notes that first use by the opponents of the trade mark CD in relation to shoes was sometime during 1994. On the basis of the use claimed he questions the acceptance of the opponents' registration No 1570147 (I add in passing that this is not a matter that is before me in these proceedings).
- 30 - he says that the applicants' use pre-dates that of the opponents in relation to footwear by some 5 years.
- in response to the opponents' claims in relation to the exclusivity attaching to the CD products of Christian Dior he exhibits (TF1) details of UK trade mark applications and registrations in Class 25 which incorporate the letters CD.
- 35 - in response to Mr Bouet's allegation that use of the trade mark CDX would infringe the registration obtained by Christian Dior he refers to the provisions of Section 11(3) of the Act and claims that the applicants have an "earlier right".
- 40

Opponents' evidence in reply

The opponents' evidence in reply comes in the form of a statutory declaration dated 6 March 1997 by Gerard Bouet. After commenting on a number of corporate changes affecting the opponents he comments on Mr Farrand's declaration. In summary:

- he does not dispute Mr Farrand's conclusion on the limited sales of shoes in the UK by the opponents but says that their registration 1570147 relates to a whole range of clothing and that there has been substantial use of CD on these goods as a whole.

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- he estimates that clothing sales of in excess of £1 million have been made under the CD mark and that the opponents' first use on clothing in this country (1985) pre-dates that of the applicants. Between 1985 and 1995 Dior's European turnover in clothing averaged in the region of FF 170 million per annum. Turnover in shoes between 1992 and 1995 totalled more than FF 21.5 million.

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- as a result of the above and sales of accessories (belts, bags etc) he says that CD is a well known mark.

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- he says that the mere fact that no instances of confusion have come to light is not proof that it has not occurred. The use of CDX with the applicants' K mark reduces the likelihood of confusion. However if the mark is registered the applicants will be able to use CDX on its own.

20

- he rejects Mr Farrand's argument in relation to the state of the register. Two of the marks are Dior marks and four others are composite ones where the presence of other material means there is no possibility that they could be seen as CD marks.

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- he is advised that the defence (under Section 11(3)) referred to by Mr Farrand only applies in a particular locality and would not be available to the applicants.

That completes my review of the evidence.

30

The Section 3 objections were not particularised in the statement of grounds but at the hearing Mr Arnold indicated that he was basing his case on Sections 3(1)(b) and (c) which read as follows:-

35

“3.- (1) The following shall not be registered -

(a)

40

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

45

(d)

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

5 He submitted that, whilst the Registry’s position in relation to three letter marks is now more liberal the practice needed to be applied with care. He pointed to the fact that the evidence showed the applicants used the mark in conjunction with other matter notably their well known K mark but more particularly with the words “comfort, design, excellence” as a strapline beneath the letters themselves. He supported his view by reference to British Sugar
10 Plc v James Robertson & Sons Ltd (the TREAT case) 1996 RPC 281 and AD 2000 Trade Mark 1997 RPC 168 insofar as the mark designated the kind or quality of the goods. In relation to the proviso to the Section the applicants’ use was, in his view, of no assistance to them as the accompanying words had encouraged the public to see the mark in descriptive terms.

15 The Registry’s published practice in relation to three letter marks is that they “should be accepted in the prima facie case unless they are objectionable as descriptive words, acronyms etc”. Firstly I do not think it is correct to say that the applicants invariably use the mark CDX in conjunction with the words “comfort, design, excellence”. A variety of uses has
20 been shown but I accept that some of the use has been in conjunction with the words with the letters the visually dominant element. Whether customers would make the association between the words and the letters that make up the mark (it assumes that X would be seen as standing for excellence) is a matter of conjecture. However even if such an association was made I do not think it debars the mark from registration. It has not been suggested that the
25 mark is anything other than a combination coined by the applicants. More importantly no evidence has been brought forward to suggest that CDX is a recognised abbreviation or that the public would see it as such. To take Mr Alexander’s analogy this is not a situation where combinations such as CAD have passed into the language as meaning computer-aided design. I can see no reason why other traders would want to use the letters without improper motive.
30 Nor do I think that it should count against the applicants that they also use the mark in association with another mark namely their K shoes mark. I therefore find that the opposition fails under Section 3(1)(b) and (c).

35 I move on to consider the grounds based on Section 5 of the Act. Section 5(2)(b) reads as follows:-

“(2) A trade mark shall not be registered if because -

40 (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,

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

The term “earlier trade mark” is defined in Section 6:-

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

- 5 (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,
- 10 (b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), or
- 15 (c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well known trade mark.”

Although a number of registrations have been referred to for either the letters CD or CDCD No 1570147 is for the mark CD and covers identical goods. It will be convenient to consider
20 the Section 5(2)(b) position on the basis of this mark because if the opponents do not succeed on the basis of the registration then I cannot see how they would have any better chance of success on the strength of their other registrations.

I should say in passing that No 1570147 appears to have been an application at the date the
25 opposition was filed but has since proceeded to registration within the terms of Section 6(2) of the Act.

Both Counsel took me to Sabel BV v Puma AG 1998 RPC 199 in relation to the test I should
30 apply. The relevant passage from page 224 line 4 et seq reads:-

“The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case.

35 That global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The wording of Article 4(1)(b) of the Directive - “... there exists a likelihood of confusion on the part of the public ...” - shows that the perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation
40 of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.

In that perspective, the more distinctive the earlier mark, the greater will be the
45 likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content

may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either *per se* or because of the reputation it enjoys with the public.”

5 I note also that in relation to the above passage and the tenth recital to the Directive Mr Hobbs QC, sitting as the Appointed Person in BALMORAL Trade Mark (an appeal against the Registrar’s decision in relation to application No 2003949 - unreported at the time of writing) indicated that:-

10 “..... an objection to registration under Section 5(2) of the Act should be taken to raise a single composite question: are there similarities (in terms of marks and goods or services) which would combine to create a likelihood of confusion if the “*earlier trade mark*” and the sign subsequently presented for registration were used concurrently in relation to the goods or services for which they are respectively registered and
15 proposed to be registered?”

I bear these comments in mind in my overall assessment of the position.

Mr Arnold contended that there was a visual, phonetic and conceptual similarity between the
20 respective marks; that confusion is all the more likely because of the reputation enjoyed by the opponents in their CD mark and that the final letter of the mark applied for would have various possible significations (I consider these below) which would impact on the issue of confusion. I will also say at this point that I accept that I must consider the matter on the basis of normal and fair use and that such use could include presentation of the mark applied for in
25 different typefaces, size of lettering or colour etc.

It is self evident that the respective marks have the first two letters in common. The opponents’ mark is of course derived from the first letters of the name Christian Dior. The applicants’ mark is not, I suggest, likely to be regarded as the initials of a name.
30 Mr Alexander submitted at the hearing that the addition of a single letter can have a very different effect in a short word or letter combination than it would have in a longer word or combination of letters. That is also my view of the matter though as always each case must be considered on its merits. I will say at the outset that I do not consider that from a visual or, aural standpoint there is any danger of confusion between CD and CDX. Nor can I see that
35 the issue of conceptual similarity arises in relation to letter combinations which have no obviously discernible meaning in relation to the goods. I will consider the issue of the opponents’ reputation in more detail when I come on to the Section 5(3) ground below. Suffice to say at this point that I would need a great deal of persuading that a reputation in CD (if accepted) could extend to three letter combinations starting with those letters. That seems
40 to me to be an unjustifiably broad claim.

There is, however, the matter of the possible signification of the letter X and whether it would be seen simply as a descriptive or otherwise meaningful element attached to a CD mark. The point has variously been made that X could be taken to mean a product of a particular size
45 (extra large) or that it could indicate superiority (extra or *extraordinaire*) or excellence. More generally it is said that it is not uncommon for a descriptive letter or number to be added to a well known mark such as Calvin Klein’s CK One. Mr Arnold also pointed to the applicants’

own use (in the strapline) and made much of the fact that the above claims had not been challenged.

Perhaps the most relevant of the claims made, not least because it is supported by an exhibit, is
5 Mr Caldwell's example of X used on packaging for a pair of tights (exhibit DC2). As is
normally the case with packaging it carries a mixture of trade mark and descriptive matter.
The main mark is the words Christian Dior set in a lozenge shape. There is other matter of
what I take to be a trade mark nature (Diorella and Lycra). The words "Extra Size Tights"
10 are printed in large script and in smaller script in the top lefthand corner are the letter and
words "X Size Tights". It seems to me to be singularly unlikely that Christian Dior (had they
been using the CD mark on this product) would have placed the letter X in close proximity to
the trade mark CD or divorced from its position as a qualifier to the words "Size Tights". It
would run counter to normal commercial behaviour to risk diluting the impact of a mark in
15 this way. It, therefore, also follows that I cannot accept Mr Caldwell's suggestion that the
applicants' mark would be seen as indicating a CD (brand) product of a particular or extra
size. It does not seem inherently likely that the public would dissect the mark applied for in
such a way that it was perceived to be Christian Dior's mark bearing an additional element
indicating superiority or excellence. I do not forget that there is evidence from Mr Endicott as
20 to how he sees the mark. I put Mr Endicott in a different category to the opponents' other
declarants because he does not seem to have any connection with the opponents. However the
context in which he came to give his declaration is not clear and I take the view that it would
require a wider sample of opinion before I was able to conclude that his views were
necessarily representative of the public at large. Nor in my view does the Calvin Klein CK One
25 example assist the opponents. Numerals play a rather different role as cataloguing references
or indicators of developments of or additions to ranges of goods and so give rise to different
considerations. Of rather more relevance perhaps is the question of what the applicants'
would be able to do by way of normal and fair use of their mark. However if they were to
present their mark in such a way that, for instance, the letter X was separated from the other
30 letters or artificially highlighted (or reduced in terms of overall impact) then that is likely to
take them beyond the boundaries of what is normal and fair.

For all these reasons I have come to the clear view that there is unlikely to be any confusion
on the part of the public. In coming to this conclusion I have not needed to consider in detail
the arguments and counter-arguments regarding existing use by the applicants and the
35 apparent absence of any instances of confusion to date. As the opponents point out the mark
is currently used with other matter whereas I must consider what the applicants would be able
to do if their mark is registered. It is on this latter basis that I have reached the above view.
Finally whilst I note the state of the register arguments that have been advanced they appear to
be of very marginal relevance to my decision on this case. The opposition, therefore, fails
40 under Section 5(2)(b).

Section 5(3) of the Act reads:

45 “(3) A trade mark which -
 (a) is identical with or similar to an earlier trade mark, and

(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

10 The provisions of Section 5(3) only come into play when the mark applied for is identical with or similar to an earlier trade mark. In dealing with Section 5(2)(b) I have already found that the marks are not similar such that there exists a likelihood of confusion on the part of the public and I can see no reason to reach a different finding in relation to the marks here, but in case I am found to be wrong I will briefly consider the matter in the light of the evidence and
15 submissions. The view has been taken in a number of recent cases that a likelihood of confusion is not necessary to substantiate an objection under Section 5(3) - see Oasis Stores Ltd’s Trade Mark Application 1998 RPC 631 and Mr Hobbs QC’s decision (sitting as the Appointed Person) in relation to Corgi Classes Ltd’s invalidity action (No 9236) in respect of trade mark No 2042334. I propose to follow that line. However, notwithstanding that
20 confusion is not a necessary ingredient in applying the test it seems to me that the sort of protection afforded under this Section is unlikely to be justified in the absence of a close similarity between the marks and a fully substantiated claim to a significant reputation amongst a substantial proportion of the relevant public.

25 It will be apparent from the opponents’ registrations and the evidence filed that their commercial interests go considerably wider than the identical or similar goods that fall to be considered under Section 5(2)(b). Exhibit GB8 to Mr Bouet’s second declaration gives turnover figures for the years 1991 to 1995. The figures (in French francs) are said to relate to UK turnover, and are broken down by product category (leather goods other than shoes,
30 spectacles, jewellery, lighters, pens and watches, clothing and other). In 1994, for instance, the turnover was 72 million French francs. The largest single category was clothing which accounted for over 51 million French francs followed by spectacles, 13 million French francs. Some 20 per cent of the turnover is said to be under the CD mark. It would seem from the evidence that this use is frequently in association with the housemarks Christian Dior or Dior
35 but I do not suggest that this is invariably the case and I note that Mr Bouet refers to CD as being one of the company’s principal trade marks. At the hearing Mr Arnold made submissions on the effects of use of the mark applied for in terms of detriment to the character of the opponents’ mark and the reputation established in that mark (he took no point in relation to unfair advantage). In doing so he considered the matter on the basis of the criteria
40 used by the Hearing Officer in the Oasis Stores’ case referred to above (the criteria being accepted with some reservations). These were:-

1. The inherent distinctiveness of the earlier trade mark;
- 45 2. The extent of the reputation that the earlier mark enjoys;
3. The range of goods or services for which the earlier mark enjoys a reputation;

4. The uniqueness or otherwise of the mark in the market place;
5. Whether the respective goods/services, although dissimilar, are in some way related or likely to be sold through the same outlets;
6. Whether the earlier trade mark will be any less distinctive for the goods/services for which it has a reputation than it was before.

5
10 Taking account of both sides' comments I consider that the earlier trade mark (being simply a two letter combination) has a low level of inherent distinctiveness; that it is likely to enjoy a reputation amongst the section of the public who are purchasers of fashion clothing, perfumery and related fashion items and accessories but in the absence of evidence from a cross section of such people it is difficult to gauge the extent of the reputation; that the range of goods in which a reputation is enjoyed is typical of a large fashion house; that there is no evidence of others using a similar mark but, contextually, it is to a large extent associated with the Christian Dior or Dior housemarks; that there could be overlap in terms of sale outlets; that the opponents' mark will be no less distinctive if the applicants' mark is registered given the difference between them. I conclude from this that the opponents have not made out their claim that use of the mark CDX would be detrimental to the character or repute of the earlier trade marks. Accordingly the Section 5(3) ground fails.

20
The Section 5(4)(a) ground was dealt with fairly briefly at the hearing and in the circumstances of the case I do not think the opponents would claim that it was their strongest ground.

25 The relevant Section reads as follows:-

(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 -

30 (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

35 (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."

40 A summary of the elements of an action for passing off were set out in WILD CHILD Trade Mark (1998 RPC 455). Briefly the opponents are required to establish that they have goodwill in an indicium; that there will be an operative misrepresentation and that there will be consequential damage. On the facts before me it appears that the opponents have a very limited claim to goodwill arising from their trading activities in shoes as such. Mr Bouet's first declaration indicated that sales of shoes commenced in the UK in Winter 1994 and that some 45 20 pairs of shoes (at approximately £200 per pair) bearing the CD mark were sold during the course of 1995. It is not clear what if any sales took place prior to the application date of the mark at issue of 31 October 1994. Such sales as have taken place appear to have been within

the Dior Boutique in Sloane Street, London or at licensed concession areas in Harrods and at London Heathrow. The opponents' use is in any case predated and overshadowed by the £38 million sales (at ex-factory prices) that the applicants made between 1989 and 1994. The opponents' response to this is that their own use on fashion clothing predates the applicants' use on shoes. The low volume of activity on shoes, it is thereby suggested, is compensated for by the greater level of trading in other goods which would include closely associated items such as hosiery. I acknowledge also Mr Arnold's point that I must apply the test to the mark applied for and not the mark used with other added matter. To an extent the criticisms which have been directed at the applicants' position can also be levelled at the opponents' own use. Their own evidence suggests that in practice the mark CD is used with the words Christian Dior (for instance the Shoes at exhibit GB5) or is promoted in catalogues bearing that housemark.

There is no requirement in a passing off action that identical or similar goods need to be in play (see for instance *Lego System v Lego M Lemelstrich* 1983 FSR 155) and it seems to me that the opponents' main area of activity (at least in terms of trading volumes) namely clothing can be considered to be quite closely associated with footwear. Nevertheless even assuming that the opponents have done enough to claim goodwill in a mark used on a relevant class of goods they must in my view fail on the second leg of the test as there can be no misrepresentation in the light of my views on the respective marks. It follows also that there will be no damage arising from the applicants' use of their mark. The opposition, therefore, fails under Section 5(4)(a).




As the applicants have been successful they are entitled to a contribution towards their costs. I order the opponents to pay the applicants the sum of **£635**.

Dated this 21st day of October 1998

30

M REYNOLDS
For the Registrar
the Comptroller-General

ANNEX A

No	Mark	Class	Journal	Specification	
5	986189	CDCD	25	4929/0281	Articles of clothing
10	1256933	CDCD	18	5671/1029	Leather, imitation leather and articles included in Class 18 made from the aforesaid materials; skins and hides; bags and cases, all included in Class 18; beauty cases and vanity cases (none being fitted); travelling bags, articles of luggage, pocket wallets, purses (not of precious metals or coated therewith); umbrellas and parasols.
15					
20	1454332		24	5998/6805	Bed linen, bath linen and handkerchiefs; all included in Class 24.
25					
30	1533204		14	6087/5772	Clocks, watches, horological instruments; parts and fittings for all the aforesaid goods; items of precious metal or coated therewith; lighters, pens and jewellery; all included in Class 14.
35					
40	1535309		18	6077/3684	Articles of leather and of imitation leather; trunks and travelling bags; umbrellas; all included in Class 18.
45					

1570147

25

6092/7186 Clothing, footwear, headgear; all included in Class 25.

5

CD

10 Note: Application No 1533205 referred to in the statement of grounds has been withdrawn.