

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 2014302
BY VISAGE IMPORTS LIMITED
TO REGISTER THE TRADE MARK
CREED
IN CLASS 25

AND IN THE MATTER OF OPPOSITION THERETO
BY CREEKS SA

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10 by CREEKS SA

DECISION

On 14 March 1995, Visage Imports Ltd, of Visage House, Shaftsbury Avenue, Simonside
15 Industrial Estate, South Shields, Tyne & Wear, NE3 9PH applied under the Trade Marks Act
1994 for registration of the Trade Mark CREED in respect of the following goods in Class 25:

“Articles of clothing for men.”

20 On the 2 January 1996 Creeks SA, of 37 / 39 Rue Pleyel, Saint Denis, 93200, France filed notice
of opposition to the application. The grounds of opposition are in summary:

i) The opponent is the registered proprietor of the trade mark CREEKS in various classes
and in particular number 1510595 for articles of clothing in Class 25.

25 ii) The mark applied for is not capable of distinguishing the applicant’s goods within the
meaning of Section 1 of the Trade Marks act 1994 and should be refused registration by
virtue of Section 3 of the Trade Marks Act 1994 on the grounds that it is not a registrable
trade mark.

30 iii) The mark applied for is not being used as a trade mark by the applicant within the
meaning of Section 103 of the Trade Marks Act 1994.

35 iv) At the time of filing the applicant had no bona fide intention to use the trade mark and
should therefore be refused under the provisions of Section 32 of the Trade Marks Act
1994.

v) The applicant is not the true proprietor of the trade mark and should be refused
registration under Section 3(6) of the Trade Marks Act 1994.

40 vi) The opponent claims that the mark applied for offends against Section 5 of the Trade
Marks Act 1994. Due to the opponent’s extensive use of the trade mark CREEKS in the
UK, use by the applicant of the mark applied for would, because to the similarity of the
goods and marks, be detrimental to the opponent as there is exists a likelihood of
confusion on the part of the public.

45 vii) The opponent further contends that they are entitled to protection under the Paris
Convention as a well-known mark and so objection arises under Section 56.

5 The opponent further requested that the Registrar refuse application number 2014302 in the exercise of his discretion. However, under the Trade Marks Act 1994 the Registrar does not have a discretion to refuse an application as he did under the old law. An application can only be refused if it fails to comply with the requirements of the Act and Rules in one or more respects. The applicant filed a counterstatement denying all the grounds of opposition other than accepting that the opponent is the registered proprietor of the mark CREEKS in various classes. Both sides asked for costs. Neither party wished to be heard in this matter. My decision will therefore be based on the pleadings and the evidence filed.

10 THE EVIDENCE

15 Only the opponent filed evidence in these proceedings in the form of three statutory declarations. The first, dated 17 December 1996, is by David George Minto a registered trademark agent and a partner in the firm of Eric Potter Clarkson. Mr Minto's firm act for the opponent in this matter.

20 Mr Minto states that the opponent has made extensive use of the trade mark CREEKS in the UK in relation to articles of clothing and also other goods. It is his belief that the opponent's enjoy a distinctive character and significant reputation in the UK. He provides invoices for the period 1992 - 1996 relating to shipments to the UK of articles of clothing sold under the CREEK trade mark. These show invoices which provide a value of 7485 for the goods supplied (6476 prior to the relevant date of 14 /3 /95). However, it is not clear if these figures relate to Sterling or French Francs. There are also documents said to relate to the production and sale of clothing products in the UK under the mark CREEKS. However, it is not apparent what these figures are meant to demonstrate as they are in French and also shown in a tabular format which is unclear in meaning.

30 According to Mr Minto articles of clothing sold in the UK under the mark CREEKS are manufactured by or on behalf of the opponent, whereas many of the other products sold under the CREEKS mark are manufactured by or on behalf of various licensees, a list of whom is provided. Invoices from one of the licensees, Stypen SA, have been provided and seem to relate to pens (the invoices are all in French). Mr Minto claims that the use of the CREEKS mark by these other manufacturers has assisted in establishing a significant and valuable reputation in the UK. Mr Minto's evidence is hearsay and I therefore do not intend to place any reliance upon it.

40 The second and third statutory declarations are by Luca Lelli, dated 19 February 1997 and 24 March 1997, who is the General Manager of Creeks SA and has been with the company for one year. Mr Lelli provides details of his company's registrations of the mark CREEKS in Classes 3,5, 6,9,14,16,20,21,22,24,25,26,27, & 34. Mr Lelli states that given the registration for class 25, the applicant's similar trade mark and goods in the same class will lead to a likelihood of confusion amongst the public, which will damage the opponent's mark. Mr Lelli states that the trade mark CREEKS was first used in the UK in June 1989 (on what goods it is not stated), and on clothing in the UK for the first time in July 1992. He provides approximate annual retail sales in "relation to articles of clothing sold under and by reference to the trademark CREEKS".

Year	value FF	Volume
1994	5,435,699	49,105
1995	2,249,421	22,616
1996	563,581	5754

5

Mr Lelli states that whilst articles of clothing under the CREEKS trade mark are manufactured by or on behalf of the opponent, other manufacturers are licensed to produce goods for sale in the UK using the CREEKS trade mark. He provides the following examples of this arrangement:

Ambre SA: licensed for horological products

10 Modling SA: licensed for stationery products

Stypen SA: licensed for writing instruments, ink cartridges etc

Texas Instruments France SA: licensed for calculators and personal organisers etc.

That concludes my review of the evidence.

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The first ground of opposition is under Section 1 of the Trade Marks Act 1994 which states:

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“In this Act a “trade mark” means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.

A trade mark may in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.

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And Section 3(1)(a) which states:

“The following shall not be registered - signs which do not satisfy the requirements of section (1).”

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Each trade mark must be considered on its own merits for the purposes of determining whether it meets the criteria in Section 1(1). The opponent has not shown why this particular word is incapable of distinguishing. Consequently the opposition under Section 1(1) and 3(1) (a) fails.

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The next ground of opposition is under Section 3(6) which states:

“ A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

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The Act does not define the term bad faith, leaving it to the Tribunal and the Court to determine whether an application was made in bad faith based upon the circumstances of a particular case. The Notes on Sections, published by the Patent office, and based upon the Notes on Clauses provided to Parliament during the passage of the Trade Marks Bill in relation to Section 3(6) provides examples of where bad faith might be found, these are:

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(i) where the applicant had no bona fide intention to use the mark, or intended to use it, but not for the whole range of goods and services listed in the application;

5 (ii) where the applicant was aware that someone else intends to use and /or register the mark, particularly where the applicant has a relationship, for example as employee or agent, with that other person, or where the applicant has copied a mark being used abroad with the intention of pre-empting the proprietor who intends to trade in the United Kingdom;

10 (iii) where the mark incorporates the name or image of a well-known person without his agreement. (This should not be taken as meaning that this provision is legislating for the protection of a personal name or reputation - these remain unprotected under English law, but the nexus between unregistrability and the name of a well-known person is that of bad faith in which the application is made.)

15 In my view there is an onus on an opponent when basing a ground of opposition under Section 3(6) on the footing that the applicant is not the true proprietor, to demonstrate that the applicant is seeking to register a trade mark which it knows belongs to another. That has not been shown so far as I can see in this case. The opposition insofar as it is based on Section 3(6) is dismissed therefore.

20 The opponent has stated that the mark applied for is not being used as a trade mark within the meaning of Section 103 . This Section merely provides minor definitions of words used in the Act and is therefore not a ground of opposition.

25 The next ground of opposition is under Section 32(3) which states:

30 *“The application shall state that the trade mark is being used, by the applicant or with his consent, in relation to those goods or services, or that he has a bona fide intention that it should be so used.”*

35 There is as far as I can see, no evidence filed by the opponent in support of such a ground. The Act allows an applicant five years from the date on which the registration procedure is completed to bring the trade mark into use. The Registrar will invariably rely upon the applicant’s statement on the form of application in compliance with Section 32(3) as to the applicant’s bona fides in the absence of evidence that the applicant had no intention to use the trade mark on all goods (or services) covered by the specification on the application for registration. The opposition insofar as it is based on Section 32(3) is dismissed therefore.

40 I now turn to the final grounds for opposition under Section 5. The opponent has not been specific in the pleadings as to which sub section/s have been offended against. I shall firstly consider Sections 5(1) and (2) which state:

45 5.- (1) *A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.*

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

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

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

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

An earlier right is defined in Section 6, the relevant parts of which state

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,*

(b)...

(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.”*

I have to determine whether the marks are so similar that there exists a likelihood of confusion on the part of the relevant public. In deciding whether the two marks are similar I rely on the decision of the Court of Justice of the European Communities (ECJ) in the *Sabel v Puma* case C251/ 95 - ETMR [1998] 1-84. In that case the court stated that:

“Article 4(1)(b) of the directive does not apply where there is no likelihood of confusion on the part of the public. In that respect, it is clear from the tenth recital in the preamble to the Directive that the appreciation of the likelihood of confusion ‘depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified’. The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case.

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 the 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 of the likelihood

of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.

5 *In that perspective, the more distinctive the earlier mark, the greater will be the 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.”*

10 The opponent has the mark CREEKS registered for fourteen classes, the most relevant being class 25 where the opponent has a specification of “ Articles of clothing; all included in Class 25”. As the applicant’s specification would, if registered, be encompassed within the opponent’s goods the marks must be considered on the assumption that the goods of the two parties are identical. This provides the opponent with its strongest case.

15 Visually the marks are identical insofar as the first four letters are concerned, but the endings of the marks differ.

20 Phonetically the start of each mark is very similar, but they have slightly different sounding endings. Even allowing for imperfect recollection and the slurring of word endings, it is my view that the marks (CREED and CREEKS) are unlikely to be confused through oral use.

25 Considering the conceptual nature of the marks both have clear dictionary meanings. The applicant’s mark CREED means a statement or system of beliefs or principles, whereas the opponent’s mark CREEKS means either a river or tributary, or relates to the group of native North American Indians. It is my view that conceptually the marks are quite different.

30 It is clear from the Sabel v Puma case, that a mark with a strong reputation deserves more protection than one with a limited reputation. Indeed, the opponent has claimed that their mark is entitled to protection under the Paris Convention under Section 56 of the Act. However, the opponent has offered no evidence to back up the claim that the mark CREEKS is a famous mark, or even one with a strong reputation. The only sales figures provided show that in the three years 1994 - 1996 they sold per annum on average £275,000 worth of clothing in the UK. In comparison to the size of the UK clothing market this is not a large amount. The opponent has also claimed
35 that the mark is used under licence by other manufacturers on products sold in the UK. No evidence of the extent of these sales has been provided. There is no evidence that the opponents’ mark has a particularly distinctive character because of the reputation it enjoys with the public.

40 I therefore conclude that taking account of all the relevant circumstances and the identical nature of the goods, the similarity of the marks is not sufficient to create a likelihood of confusion at 14 March 1995 (the material date). The opposition under Section 5(2) therefore fails. The opposition under Section 56 of the Act also fails.

45 I now consider Section 5(3) which states:

(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,*

5 *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 I have already found that the marks are not similar and so the opposition under Section 5(3) fails.

Finally, I turn to the ground of opposition under Section 5(4) which states:

15 (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*

20 (b) *by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.*

25 *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.*

(5) *Nothing in this section prevents the registration of a trade mark where the proprietor of the earlier trade mark or other earlier right consents to the registration.*

30 In deciding whether the mark in question “CREED” offends against this section, I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the WILD CHILD case (1998 14 RPC 455). In that decision Mr Hobbs stated that:

35 *“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 Art.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.*

40 *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] RPC 341 and Even Warnik BV - v - J. Townend & Sons (Hull) Ltd [1979] AC 731 is (with footnotes omitted) as follows:*

45 *‘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;

5 *(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*

10 *(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
15 *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.'*

20 *"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:*

25 *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
30

(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.

35 *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.*

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

- 45 *(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.*

5 *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.”*

10 With these considerations in mind I turn to assess the evidence filed on the behalf of the parties
in the present proceedings as set out earlier in this decision.

15 The opponents claim to have a reputation in the market such that anyone who saw the CREEKS
mark on clothing or any of the other articles for which they registered would assume that it came
from the opponent. However, apart from this assertion there is little evidence of a substantial
reputation. The opponents state that their products are sold in the UK and that in the years 1994 -
1996 inclusive they sold clothing worth approx £275,000 per annum. No figures are given for
other products sold under the CREEKS trade mark.

20 I am prepared to accept that at the relevant date, 14 March 1995, the opponent had established
goodwill under the mark CREEKS in relation to goods in class 25 (articles of clothing). I am
not convinced that members of the public would confuse the products of the applicants for those
of the opponents. The opposition under this section therefore fails.

25 The opposition having failed the applicant is entitled to a contribution towards their costs. I order
the opponent to pay the applicant the sum of £435

Dated this 18 day of May 1999

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35 George W Salthouse
For the Registrar
The Comptroller General