

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2030055
BY COCKTAIL RETAILERS A/S
TO REGISTER A TRADE MARK IN CLASS 25**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO 45003
IN THE NAME OF FASHION BOX SPA**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2030055
by Cocktail Retailers A/S
to register a trade mark in Class 25**

And

**IN THE MATTER OF Opposition thereto under
No 45003 by Fashion Box SpA**

DECISION

On 10 August 1995, Cocktail Retailers A/S, of Unsbjergvej 2 B, DK-5220, Odense SO, applied to register the trade mark REPEAT in Class 25 for the following specification of goods:

Jeans, T-shirts, sweatshirts, knitwear, jackets, dresses, trousers; accessories such as stockings, caps and gloves.

The application, numbered 2030055 was published for opposition purposes on 1 May 1996, and on 29 July 1996, Fashion Box SpA filed notice of opposition to the application. The grounds on which the opposition is based are, in summary:

- 1. Under Section 5 and 6** Because the mark applied for is confusingly similar to trade mark registrations owned by the opponents.
- 2 Under Section 3** Because the mark is devoid of any distinctive character and is not capable of distinguishing the applicants' goods from those of similar undertakings.

Particulars of the trade mark registrations relied upon in the grounds of opposition are set out as an annex to this decision.

The opponents ask that costs be awarded in their favour.

The applicants filed a counterstatement in which they deny all of the grounds on which the opposition is based, and ask that costs be awarded in their favour.

Both sides filed evidence in these proceedings. The matter came to be heard on 20 December 1999, when the applicants were represented by Mr Michael Lynd of Edward Evans & Co, their trade mark attorneys, the opponents were represented by Ms Fiona Clark of Counsel, instructed by Marks & Clerk, their trade mark attorneys.

The opponents' evidence

5 This consists of a Statutory Declaration dated 2 April 1997, and comes from Attilio Biancardi, the Managing Director of Fashion Box S.p.A., a position he has held since December 1992. Mr Biancardi confirms that he has full access to the company records and is familiar with the English language.

10 Mr Biancardi confirms that his company has been selling goods bearing the trade mark REPLAY in the United Kingdom since 1984 and that sales have taken place throughout the country. He says that goods from his company bearing the mark are currently imported and distributed to retailers throughout the United Kingdom by a company called Elanmain Limited.

15 Mr Biancardi says that his company has used the trade mark REPLAY on a wide range of men's and women's clothing and accessories. He says that each year the trade mark is used on a summer and winter collection and goes on to set out some of the types of clothing and clothing accessories marketed in these collections. He next sets out the approximate yearly turnover from 1984 in respect of goods bearing the REPLAY, and which ranges from £300,520 in 1984, rising to a peak of £2,215,637 in 1995.

20 Mr Biancardi next refers to the advertisements placed by his company which he says appeared in various magazines in the United Kingdom, and lists a number of magazines with the dates in which the advertisements appeared although does not provide copies of the advertisements to show how, and in respect of what goods the trade mark was used. He goes on to refer to exhibit AB1 which consists of a collection of invoices for items of clothing and promotional materials
25 supplied by Fashion Box S.p.A. to a number of United Kingdom traders. The earliest invoice is dated 12 March 1984 and is headed with the trade mark REPLAY with a coat of arms. Later invoices are headed with the company name and list the goods supplied under names such as REPLAY, REPLAY DONNA and REPLAY BASE.

30 Mr Biancardi refers to exhibit AB2 which consists of a range of catalogues from 1994-1995 promoting the opponents' clothing under the trade mark REPLAY, and to exhibit AB3 which consists of photocopies of various labels and swing tabs for clothing and bearing the trade mark REPLAY in various forms.

Applicants' evidence

40 This consists of two Statutory Declarations. The first is dated 14 January 1998 and comes from Terrence Lesley Johnson, a Chartered Patent Agent/European Patent Attorney/Registered Trade Mark Agent and a Partner in the firm of Edward Evans & Co, the applicants' representatives in these proceedings.

45 Mr Johnson confirms his company's professional involvement with the applicants and in the filing of this application. He says that his clients have told him that they first used the mark in Denmark (and other un-named countries) in 1987, and in the United Kingdom in Autumn 1996, in respect of a range of clothing which is the same as covered by this application. He refers to exhibit TLJ1 which consists of two swing tickets for clothing, one bearing the trade mark REPEAT JEANS on a sun-type device, the second, the word REPEAT on a background device of two interlocking

circles.

5 Mr Johnson says that he understands from the information provided by his clients that they have invested a great deal of money in promoting the mark, and refers to exhibit TLJ2 which consists of two catalogues and a personal calender promoting REPEAT clothing which he says are distributed at the applicants' showrooms in London. All date from after the relevant date and accordingly can be given little if any weight.

10 Mr Johnson refers to the coexistence of the applicants' REPEAT trade mark and the opponents' REPLAY trade mark on the Danish, Norwegian, Swedish and German trade marks registers, and refers to exhibit TLJ3 which consists of details of the respective parties registrations. He draws the conclusion that the coexistence in other countries suggests that these countries did not consider there to be sufficient similarity in the respective marks to give rise to confusion.

15 Mr Johnson goes on to refer to a search of the United Kingdom trade marks register, which he says shows that the opponents' registrations coexist with a number of other trade marks bearing the prefix REP, and he names some examples and refers to exhibit TLJ4 which consists of details of these registrations. He gives his opinion that these other marks dilute the exclusivity to which the opponents are entitled in their registrations for the trade mark REPLAY.

20 Mr Johnson goes on to say that the Little Oxford Dictionary of Current English shows the opponents' trade mark REPLAY as a verb meaning "play again" or as a noun meaning "replaying of match, recorded incident in game". He says that the same publication defines the applicants' trade mark REPEAT as a verb meaning "say or do over again, recite, report, recur" or as a noun meaning "repeating; thing repeated esp broadcast; music passage to be repeated". Mr Johnson refers to exhibit TLJ5 which consists of the relevant extracts from the Dictionary, and concludes saying that they show the words have different common uses.

30 The second Statutory Declaration is dated 6 March 1998, and comes from Barry Dass, Head of United Kingdom manufacturing, wholesaling and marketing operations for Cha-Cha Denmark A/S, a subsidiary of Cocktail Retailers A/S. Mr Dass says that he works at his company's wholesale showroom in London and that he has held this position since early 1997. Mr Dass says that his company manufactures and sells articles of fashion clothing on a wholesale basis throughout the United Kingdom and elsewhere.

35 Mr Dass says that he has worked in the garment manufacturing, wholesale and retail trade since 1977 and goes on to set out details and to relate his experience which has primarily been gained through his involvement with his family's clothing business. He next says that he is familiar with the trade mark REPEAT which is a brand marketed by his company and its parent company, saying that his family's business has also manufactured garments to be sold under the REPEAT label.

40 Mr Dass says that he has been told by the Sales Manager of Cocktails Retailers A/S, and that he himself believes that REPEAT branded clothing was sold to retailers for sale in the United Kingdom early in 1977. He recalls that when he took up his present post early in 1997, his company was selling, and continues to sell various items of REPEAT branded clothing. He refers to exhibit BD1 which consists of a catalogue dating from Spring & Summer 1998, and

advertising, inter alia, REPEAT clothing.

Mr Dass says that REPEAT branded clothing is targeted at the casual wear market, specifically females in the 16 to 21 year old age group. He says that he has become familiar with this particular market and sets out his awareness of the shopping habits of women in the target age group which he says includes a preference for the personal selection and brand consciousness and which in his opinion makes it unlikely that confusion will arise between the trade marks REPEAT and REPLAY.

Opponents' evidence in reply

This consists of Statutory Declaration dated 10 September 1998, and comes from Kevin Whalley, a Chartered Patent Agent/Registered Trade Mark Agent and a Partner in the firm of Marks & Clerk, the opponents' representatives in these proceedings.

Mr Whalley goes first to the Statutory Declaration made by Barry Dass on behalf of the applicants, noting that Mr Dass does not always refer to REPEAT branded clothing. He says that given Mr Dass' position in his company, he finds it surprising that he apparently had no direct knowledge that REPEAT branded clothing had been sold to various retailers in the United Kingdom in early 1997, and notes that there is corroborating evidence. Mr Whalley goes on to say that neither Mr Dass nor Mr Johnson have given any direct evidence of any sales under the trade mark REPEAT.

Mr Whalley says that he made investigations to locate goods sold on a retail basis in the United Kingdom under the REPEAT trade mark, and that he was not able to locate any. He says that he contacted a company named Elanmain Limited, trading as Options, who he knew to be the sole distributor of the goods of Fashion Box S.p.A., the opponents in these proceedings. He refers to exhibit KW1 which consists of a letter sent by Mr Whalley to Elanmain Limited asking whether they were aware of REPEAT clothing, or the operations of Cocktail Retailers A/S or Cha-Cha Denmark A/S, and the reply received informing Mr Whalley that they had no knowledge.

Mr Whalley says that he also arranged for an employee of Elanmain Limited to visit the premises of Cha-Cha Denmark A/S to inspect, and if possible, buy REPEAT branded clothing. He says that the person was denied entry to the premises because they were a wholesale showroom only. Mr Whalley says that he attempted to telephone the premises of Cha-Cha Denmark A/S to ask for a list of stockists of REPEAT, but was not able to do so because the company is not listed in the London telephone directory or available from directory enquiries, and refers to exhibit KW2 which is a copy of his file note recording the above.

Mr Whalley then says that he wrote to Edward Evans & Co, the agents acting for Cocktail Retailers A/S to ask for a list of stockists who sell REPEAT branded clothing in the United Kingdom, or the means by which to contact their clients directly in order to obtain this information. He refers to exhibit KW3 which consists of a letter addressed to Edward Evans & Co asking for this information, an acknowledgement from Edward Evans & Co, and two reminders indicating that the information had not been provided.

That concludes my review of the evidence insofar as it is relevant to these proceedings, and I turn

to consider the respective grounds upon which the opposition has been brought.

Decision

5 At the hearing Ms Clark confirmed that the opponents' objection under Section 3 was to be found in sub-sections (a) and (b). Those sections read as follows:

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

- 10 (a) signs which do not satisfy the requirements of section 1(1),
- (b) trade marks which are devoid of any distinctive character,
- 15 (c)
- (d)

20 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.

Section 1(1) in turn reads:

25 **1-(1)** In this Act "trade mark" means any sign capable of being represented graphically which is capable of distinguishing the goods or services of one undertaking from those of other undertakings.

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

There is no suggestion that the mark is not represented graphically so the objection relates to the inherent capacity of the mark to distinguish the applicants' goods. The question is whether the term REPEAT can perform the function of a trade mark and in this respect I have regard to Canon Kabushiki Kaisha v Metro-Goldwyn -Mayer Inc (1999) FSR 332 in which it was said:

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40 "...according to the settled case-law of the court, the essential function of the trade mark is to guarantee the identity of the origin of the marked product to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin. For the trade mark to be able to fulfil its essential role in the system of undistorted competition which the Treaty seeks to establish, it must offer a guarantee that all goods bearing it have originated under the control of a single undertaking which is responsible for their quality."

45 I begin by looking at how the law stands. In the British Sugar Plc v James Robertson & Sons Ltd (TREAT) trade mark case, (1996) RPC 9, Mr Justice Jacob said:

"...I begin by considering the "not a trade mark" point. Section 1(1) has two parts, *sign*,

and *capable of distinguishing*. *Sign* is not an issue: a word is plainly included within the meaning of *sign* as the remainder of Section 1 indicates. But what about *capable of distinguishing*? Does this add any requirement beyond that found in section 3(1)? Section 3(1)(b) bars the registration of a mark which is *devoid of any distinctive character* unless it has *in fact acquired a distinctive character*. I cannot see that the closing words of the first sentence of section 1(1) add anything to this. If a mark on its face is non-distinctive (an ordinary descriptive and laudatory words fall into this class) but is shown to have a distinctive character in fact then it must be *capable of distinguishing*. Under section 10 of the old Act, for a mark to be registerable in Part B, it also had to be *capable of distinguishing*. But the Pickwickian position was that some marks, even though 100% distinctive in fact, were not regarded as *capable of distinguishing* within the meaning of that provision. I do not think the Directive and the 1994 Act takes a more limited meaning over.

Thus, *capable of distinguishing* means whether the mark can in fact do the job of distinguishing. So the phrase in Section 1(1) adds nothing to section 3(1) at least in relation to any sign within sections 3(1)(b)-(d). The scheme is that if a man tenders for registration a sign of this sort without any evidence of distinctiveness then he cannot have it registered unless he can prove it has a distinctive character. That is all. There is no pre-set bar saying no matter how well it is proved that a mark has become a trade mark, it cannot be registered. That is not to say that there are some signs which cannot in practice be registered. But the reason is simply that the applicant will be unable to prove the mark has become a trade mark in practice - “Soap” for “Soap” is an example. The bar (no pun intended) will be factual not legal.

The trade mark is the ordinary and well known English word REPEAT which as a verb is said to mean, inter alia, “say or do over again; recite, report, recur. Ms Clark submitted that in the garment industry purchasers could ask for a REPEAT order meaning a REPEAT order of the jeans ordered last time. Clothing comes in many different styles, materials and sizes and there are numerous manufacturers and traders in such goods. It may well be that a wholesaler or retailer may require a further supply of goods but it seems unlikely that they would simply say that they wish REPEAT jeans or clothing. There is no evidence which goes to this, or indeed any other basis for objection under Section 3, a fact acknowledged by Ms Clark. The matter therefore falls for a prima facie decision based on the inherent distinctiveness or otherwise of the word.

The word is not a generic description of the goods or a characteristic of the goods and apart from the sort of use mentioned above I cannot see how the trade would wish to use it. I see no reason why REPEAT cannot serve the purpose of a trade mark and in the absence of evidence to the contrary I find the objections under Section 3(1)(a) and (b) to have not been made out and consequently, they are dismissed.

I turn next to the objections founded under Section 5 of the Act. At the hearing Ms Clark confirmed that this included Section 5(2), Section 5(3) and Section 5(4)(a). I will go first to the ground under Section 5(2), which reads as follows:

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

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

(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

The opponents rely on three trade mark registrations, all of which are registered in respect of goods which are identical to those for which the applicants seek to register their mark. The matter therefore falls to be determined by a comparison of the respective marks and I look to the approach adopted by the European Court of Justice in *SABEL v. PUMA* 1998 RPC 199 at 224 and in *Lloyd Schufabrik Meyer & Co GmbH v Klijsen Handel BV* (1999 ETMR 690 at 698). It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the visual, aural and conceptual similarities of the marks must be based upon the overall impressions created by the marks bearing in mind their distinctive and dominant components;

(c) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

(d) the matter must be judged through the eyes of the average consumer, who normally perceives a mark as a whole and does not proceed to analyse its various details;

(e) 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.

In respect of the first point, the ECJ's decision in *Lloyd Schufabrik* (at page 198) is of assistance and is re-produced below.

"26. For the purposes of that global appreciation, the average consumer of the category of products concerned is deemed to be reasonably well-informed and reasonably observant

and circumspect (see, to that effect, Case C-210/96 *Gut Springenheide and Tusky* [1968] E.C.R.I-4657, paragraph 31). However, account should be taken of the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks but must place his trust in the imperfect picture of them that he has kept in his mind. It should also be borne in mind that the average consumer's level of attention is likely to vary accordingly to the category of goods or services in question."

Of the three trade marks relied upon, two are registered for the word REPLAY alone, the third being for the word REPLAY in conjunction with an heraldic device. I propose to undertake the comparison on the basis of the word REPLAY alone for if the opponents do not succeed with this trade mark they will be in no better position in respect of the composite mark.

The words REPEAT and REPLAY are the same length, share the first three letters and convey the idea of some recurring event, and to that extent can be considered to have some degree of visual, aural and conceptual similarity. They are, however, ordinary and well known words in the English language and although they have the first syllable in common, the endings create a distinction in their appearance and sound..

Both marks are used in connection with clothing. Such goods are unlikely to be selected without being seen by the purchaser, be it in a shop or in a catalogue, which in my view enhances the importance of the visual appearance of the marks, and in that respect I consider there to be a little likelihood of confusion. A person who buys such goods by reference to a designer or label would be aware of the names and exercise a degree of care in the selection and be unlikely to confuse these marks. In Case C-342-97, *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*, Advocate General Jacobs concluded that he doubted "whether the average consumer of the goods in question who is reasonably well informed and reasonably observant and circumspect" would make that mistake. That is, I believe the position here.

The evidence shows that the opponents have been using their trade mark from 1984 although the turnover figures are modest in the context of the overall size of the clothing market. The marks are ordinary words in common use and as such do not possess a particularly high degree of distinctiveness, and while the opponents are likely to have built a reasonable reputation in respect of items of clothing I do not consider that the use is on a such a scale so as to have enhanced the distinctiveness and warrant a wide penumbra of protection. Taking this and my earlier assessments into account, I come to the view that when considered globally the marks are not so similar so as to create a likelihood of confusion and that the objection under Section 5(2)(b) fails accordingly.

In my view my findings under Section 5(2)(b) and given that all of the earlier trade marks relied upon by the opponents are for identical goods the ground founded on Section 5(3) must fail, and I dismiss it. This leaves the objection under Section 5(4)(a). That section reads as follows:

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 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 No reference is made to any rule of law other than the law of passing off. Mr Hobbs QC set out a summary of the elements of an action for passing off in WILD CHILD Trade Mark 1998 RPC 455. The necessary elements are said to be as follows:

10 S that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

15 S that there is a misrepresentation by the defendant (whether or not intentional leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and

20 S that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

25 I have previously accepted that the evidence in these proceedings shows that the opponents are likely to have acquired a reputation in the word REPLAY in respect of clothing. However, I have found REPLAY (the opponents’ trade mark) not to be not so similar to REPEAT (the applicants’ trade mark) so as to create a likelihood of confusion, and consequently, I cannot see how there can be misrepresentation or damage. I find that the opponents have not made out their case and the opposition founded under Section 5(4)(a) fails accordingly.

30 The opposition having failed on all grounds I order that the opponents pay the applicants the sum of £635 as a contribution towards their costs. This sum to be paid within one month of the expiry of the appeal period or within one month of the final determination of this case if any appeal against this decision is unsuccessful.

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40 **Dated this 3 day of March 2000**

40 **Mike Foley**
for the Registrar
The Comptroller General

	Number	Mark	Class	Specification
5	1201267	REPLAY	25	Articles of outer clothing, but not including skirts or slacks for women, or any goods of the same description as skirts or slacks for women
10	1551752	REPLAY	25	Coats, overcoats, jerkins, jackets, trousers, skirts, shirts and blouses, hosiery, pullovers, sweaters, cardigans, tracksuits, sweatshirts, foulards, ties, socks and stockings, hats, caps, boots, shoes and slippers; all included in Class 25
15	1339509		25	Articles of outer clothing included in Class 25.

