

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No 2139936

by UMBERTO GIANNINI

5 TO REGISTER A TRADE MARK IN CLASSES 3,8,9,16,18,21 & 25

AND IN THE MATTER OF OPPOSITION THERETO

UNDER NUMBER 48286

by OASIS STORES PLC

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DECISION

BACKGROUND

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On 23 July 1997, Umberto Giannini of 165 Lower High Street, Stourbridge, DY8 1TT applied under the Trade Marks Act 1994 for registration of the trade mark **OSIS** in respect of the following goods:

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Class 3: "Cosmetics including hair products."

Class 8: "Scissors."

Class 9: "Video recorders: Video cassettes."

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Class 16: "Printed matter."

Class 18: "Bags."

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Class 21: "Combs and brushes."

Class 25: "Clothing."

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On the 3 March 1998 Oasis Stores Plc filed notice of opposition to the application. The grounds of opposition are in summary:

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i) that the opponent is the registered proprietor of numerous OASIS trade marks in the UK, and has used these trade marks extensively on a variety of goods including articles of clothing, bags, cosmetics and printed matter.

ii) Because of the extensive use referred to in the UK the trade marks have become well known and are therefore entitled to protection under Section 56 of the Trade Marks Act 1994.

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iii) The applicant's mark is similar to the opponent's registered trade marks and is for similar and/or identical goods. It therefore contravenes Sections 5(2)(b) and, by virtue of the opponents' reputation it also offends against Section 5(4)(a) of the Trade Marks Act 1994.

The applicant filed a counterstatement denying all the grounds other than accepting that the opponent is the proprietor of the trade marks claimed. Both sides ask for an award of costs. Only the opponent filed evidence in these proceedings, and the matter came to be heard on 27 January 2000 when the applicant was represented by Mr Burrington from Trade Mark Agents Alan Burrington & Associates, and the opponent by Ms O'Rourke from Trade Mark Agents Titmuss Sainer Dechert.

OPPONENT'S EVIDENCE

This takes the form of four statutory declarations. The first is by Mr Richard Bradbury, dated 28 August 1998, who is the Managing Director of River Island Clothing Company Ltd. He states that neither he nor his company is associated with Oasis Stores Plc. He states that he is "aware of the famous trade mark OASIS as used by Oasis Stores Plc in the clothing and accessories industry." Mr Bradbury then states that in his opinion the two marks OASIS and OSIS are confusingly similar and that if he saw the mark OSIS on items such as clothing, combs and brushes, bags, printed matter or cosmetics he would assume that there was a connection between the use of that trade mark and the trade mark OASIS.

The second Statutory declaration, dated 4 September 1998, is by Mr Vittorio Radice the Chief Executive of Selfridges Plc. He states that neither he nor his company is associated or involved with Oasis Stores Plc. He then states his awareness of the mark and his view on the confusability of the marks using identical wording to that of the first declarant.

The third statutory declaration, dated 27 August 1998, is by Mr Adrian Humphrey Austen Osborn the Chief Executive of Alexon Group Plc. He states that neither he nor his company are connected to the opponent, and then using identical wording to the two previous declarations he gives his opinion on the similarity between the two marks.

The fourth statutory declaration, dated 6 October 1998, is by Mr Maurice Bennett who is the Vice Chairman and Buying Director of Oasis Stores Plc. Mr Bennett states that:

"The trade mark OASIS (the trade mark) was first used in the UK in March 1991 in relation to articles of clothing for women. Since that date, the range of products sold under the trade mark has expanded and my company now sells women's accessories, including jewellery, bags and footwear, as well as women's clothing."

Mr Bennett provides turnover figures

YEAR	TURNOVER
1994	29,412,000
1995	47,251,000
1996	61,145,000
1997	81,651,000
1998	92,936,000

Mr Bennett states that the opponent has numerous branches throughout the UK as well as concessions in department stores. A list of branches and concessions is provided at exhibit MB2 and MB3 and these show that there are stores and/or concessions in most major towns and cities throughout the UK and also in Ireland and Germany.

Mr Bennett states that:

“My company extensively advertises products sold under the trade mark and, as an example, between January and 1 September 1997, £1,115,932 was spent in magazines, national press and regional press to promote products sold under the trade mark. In June 1996 my company received an award as best ‘High Street Retailer’ from Marie Claire magazine. Over 50,000 Marie Claire readers voted in the awards and it was an accolade to win this category. In July 1996 my company won the ‘Most Fashionable Clothes’ and ‘Best Jewellery’ awards from a poll conducted by The Clothes Show Magazine. My Company had the accolade of being voted ‘Retailer of the Year’ at the British Fashion Awards for two consecutive years, 1995 and 1996. Added to this, my company won ‘Best Retail Interiors’ at the Design Industry’s ‘Design Effectiveness Awards’ in October 1996 and in 1997 my company won two Drapers Record Fashion Retail Awards for ‘Store Brand Image’ and the supplier relationship award ‘Challenge Partnership’.”

“I believe that the trade mark OASIS has become a famous mark in the United Kingdom in relation to the products which are sold by my company and that it has acquired a valuable and extensive reputation internationally due to use and advertising in many countries of the world.”

That concludes my review of the evidence. I now turn to the decision.

DECISION

I turn first to the ground of opposition under Section 5(2)(b) of the Act which states:-

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

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 this issue 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:

5 “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.

10 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.

20 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.”

25 I also have regard to the approach adopted by the European Court of Justice in Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc. (case C-39/97) (ETMR 1999 P.1) which also dealt with the interpretation of Article 4(1)(b) of the Directive. The Court in considering the relationship between the nature of the trade mark and the similarity of the goods stated:

30 “A global assessment of the likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between these goods or services. Accordingly, a lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the marks, and vice versa. The interdependence of these factors is expressly mentioned in the tenth recital of the preamble to the directive, which states that it is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion, the appreciation of which depends, in particular, on the recognition of the trade mark on the market and the degree of similarity between the mark and the sign and between the goods or services identified.”

40 Further, I take account of the following guidance of the European Court of Justice in Lloyd Schuhfabrik Meyer & Co (1999 ETMR 690) in which the court held that:

45 “For the purposes of ... 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 [1998] ECR 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 be also be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question."

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In order to make the global assessment on the similarity of the marks, it is necessary to consider individual aspects of the question. I propose to firstly consider the similarity of the goods of the two parties.

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It is clear, and was accepted at the hearing, that the opponent has registrations which cover similar if not identical goods to some of those included in the application. The opponent's registrations (set out in detail at annex A) which it is accepted are for similar goods are as follows:

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Class	Applicant's specification	Opponent's registration number, mark and specification
3	Cosmetics including hair products	395527. OASIS : Perfumed soap; perfumery; essential oils for toilet purposes; cosmetics; hair lotions; preparations for washing the hair; but not including goods relating to oral hygiene products, non-medicated preparations or substances for the mouth or breath, preparations for the teeth, or dentifrice. 1086263. OASIS : Perfumes, non-medicated toilet preparations, cosmetics, soaps, preparations for the hair, essential oils, dentifrices, depilatory preparations and antiperspirants
16	Printed matter	202004A. OASIS : Printed publications, catalogues, posters, printed labels, photographs, all relating to fashion or entertainment; plastics and paper packaging materials, pens, pencils, folders and note books.
18	Bags	1556079. OASIS : Bags, handbags, holdalls, rucksacks, belt bags, suitcases, travel bags, purses, wallets, trunks, pouches and umbrellas.
21	Combs and brushes	395527. OASIS : Powder puffs
25	Clothing	1247151. OASIS : Articles of Clothing

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At the hearing Ms O'Rourke contended that the following were also similar goods:

Class	Applicant's specification	Opponent's registration number, mark and specification
8	Scissors	1086263. OASIS : Perfumes, non-medicated toilet preparations, cosmetics, soaps, preparations for the hair, essential oils, dentifrices, depilatory preparations and antiperspirants 1354641. OASIS : Jewellery and precious stones.
9	Video recorders, video cassettes	1098669. OASIS TRADING and DEVICE : Articles included in Class 20 made of basketware, imitation basketware, bamboo or of imitation bamboo; furniture and parts thereof. 2020040. OASIS :Printed publications, catalogues, posters, printed labels, photographs, all relating to fashion or entertainment; plastics and paper packaging materials, pens, pencils, folders and note books.

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Regarding goods in Class 8 Ms O'Rourke contended that stores which sold preparations for the hair would also sell scissors for hair care, and/or that stores which sold jewellery often sold scissors. Similarly stores which sold furniture often also sold video recorders, and stores which sold printed matter such as magazines usually sold video cassettes. .

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Just because a general or department store might sell both products does not mean that the products themselves are similar, it is merely one indication. Clearly the applicant's goods in Class 8 are dissimilar to the opponent's goods in Classes 3 & 8. There is a (small) degree of similarity between video cassettes and printed matter insofar as they both carry information. This similarity would be increased if the publication and the cassette were both on the same specific subject, in this case fashion.

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The opponent has provided evidence, in the form of sales figures, that at the relevant date (23 July 1997) they had a reputation in articles of clothing for women, and women's accessories such as jewellery, bags and footwear. This claim is also confirmed by awards for their clothing and jewellery. There is no evidence that the opponents had a reputation in any other goods at the material date.

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I now turn to consider the trade marks of the two parties. For the goods which are accepted as similar the opponent's mark consists of the word OASIS in plain print. The applicant's mark is OSIS.

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Visually the two marks are similar in that they share the same first letter, O, and the last three letters, SIS, are identical. Both are also short words.

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When considering phonetic similarity I was invited by Ms O'Rourke to accept the proposition that "there is a tendency for a lot of people in England to swallow their A's". Whilst in some words this may be true, in the case of the opponent's mark the "A" is very clearly pronounced. The mark forms three distinct syllables, "O", "A" and "SIS". The pronunciation of the second syllable "A" is hard. In contrast the applicant's mark could be pronounced in different ways. Some will use "O" "SIS", others will pronounce it "OZ" "IS". Neither pronunciation is confusable with the distinct sound of the opponent's mark.

The opponent's mark has a dictionary definition and is a word which most of the population will be familiar with. It conjures up the spectacle of a small island of palm trees and water in a sea of sand. The applicant's mark does not have any meaning being a made up word which brings no concept to mind.

The question of imperfect recollection was raised by Ms O'Rourke. I note that the majority of the products covered in the specifications of both parties are of relatively low value and are therefore less likely to be closely scrutinised.

Taking into account all of the above, I consider that the trade marks are not similar enough to have given rise to a likelihood of confusion at 23 July 1997 even on goods which are identical and in which the opponent has shown reputation. The opposition under Section 5(2) therefore fails.

I now consider the remaining ground of opposition under Section 5(4) which states:

"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

(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.

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."

In deciding whether the mark in question "OSIS" 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:

"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.

5 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:

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

10 (1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

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

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

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

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

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

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

40 (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.

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

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

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

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

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

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

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

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

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.

It is claimed that the public would be confused as to the source of the applicants’ goods believing them to originate from the opponents. The opponents state that their products are sold throughout the UK and that in the period 1994 - 1996 they sold approx. £138million of women’s clothing, footwear, bags and jewellery. The figures provided for promotion incorporate a period after the relevant date. Therefore, I am persuaded that at the relevant date, 23 July 1997, the opponent had established goodwill under the OASIS mark for goods in Class 14, 18 and 25.

I note that the opponent’s mark is used on goods sold mainly through their own stores, also called OASIS. The other avenue for sales is stated to be via concessionaires in department stores. Such concessionaires are usually clearly signposted with the name of the supplier. To my mind this lessens the possibility of confusion through imperfect recollection.

I have already compared the two marks and found the opponent’s mark OASIS is not similar to the applicant’s mark OSIS. In my view the lack of similarity will prevent the public believing that the products of the applicants originate from the opponents. The opposition under Section 5(4) therefore fails.

The opponent also claims that the mark OASIS is entitled to protection under the Paris Convention as a well-known trade mark under Section 56 of the Trade Marks Act 1994. This states:

56. - (1) References in this Act to a trade mark which is entitled to protection under the Paris Convention as a well known trade mark are to a mark which is well known in the United Kingdom as being the mark of a person who-

(a) is a national of a Convention country, or

(b) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country,

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whether or not that person carries on business, or has any goodwill, in the United Kingdom.

References to the proprietor of such a mark shall be construed accordingly.

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(2) The proprietor of a trade mark which is entitled to protection under the Paris Convention as a well known trade mark is entitled to restrain by injunction the use in the United Kingdom of a trade mark which, or the essential part of which, is identical or similar to his mark, in relation to identical or similar goods or services, where use is likely to cause confusion.

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This right is subject to Section 48 (effect of acquiescence by proprietor of earlier trade mark).

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(3) Nothing in subsection (2) affects the continuation of any bona fide use of a trade mark begun before the commencement of this section.

Section 55(1) of the Act defines a “Convention country” as a country that is party to the Paris Convention *other than the UK* (my emphasis). Therefore, only trade marks which are owned by proprietors outside the UK and in a convention country are protected. The opponent does not appear to be a national of a Convention country or to have a real and effective establishment in a Convention country. Thus, even leaving aside the question of reputation, the opponent cannot claim protection under this provision of the Act.

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The opposition having failed the applicant is entitled to a contribution towards his costs. I order the opponent to pay the applicant the sum of £435. 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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Dated this 10 day of April 2000






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George W Salthouse
For the Registrar
The Comptroller General


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ANNEX A

	Trade Mark	Registration Number	Date Registered	Specification
5	OASIS	395527	24/9/19	Class 3: Perfumed soap; perfumery; essential oils for toilet purposes; cosmetics; hair lotions; preparations for washing the hair; but not including goods relating to oral hygiene products, non-medicated preparations or substances for the mouth or breath, preparations for the teeth, or dentifrice. Class 5: Pharmaceutical preparations for treating dandruff Class 21: Powder puffs
	OASIS	1086263	8/11/77	Perfumes, non-medicated toilet preparations, cosmetics, soaps, preparations for the hair, essential oils, dentifrices, depilatory preparations and antiperspirants.
	OASIS (series of two)	2007283	10/1/95	Class 9: Sunglasses; spectacles; spectacle cases, chains and eyeglass frames; eyeshades Class 14: Watches, clocks, key rings, precious stones, jewellery, costume jewellery, ornaments, watchbands, watch cases, watch chains, watch straps, goods in precious metals or coated therewith. Class 20: Picture frames, photo frames, boxes of wood or plastic, coat hangers, clothing hangers, clothing covers, cushions, jewellery cases not of precious metal, mannequins, statues of wood, wax, or plastic and stuffed animals.
10	OASIS	1354641	11/8/88	Jewellery and precious stones; all included in Class 14
	OASIS	2020040A	26/4/95	Class 16: Printed publications, catalogues, posters, printed labels, photographs, all relating to fashion or entertainment; plastics and paper packaging materials, pens, pencils, folders and note books.
	OASIS	2020040B	26/4/95	Class 24: Fabric: bed and table covers, towels, household linen.
	OASIS	1247151	29/7/85	Class 25: Articles of clothing
	OASIS	1556079	9/12/93	Bags, handbags, holdalls, rucksacks, belt bags, suitcases, travel bags, purses, wallets, trunks, pouches and umbrellas; all included in Class 18.
15	OASIS	1313498	19/6/87	Business management consulting; business organisation consulting; business appraisals; all included in Class 35.

Trade Mark	Registration Number	Date Registered	Specification
 <p data-bbox="261 663 600 719">Application for a series of two marks. Honest concurrent use with Registration Nos. 1098669 (5357,1096), 1197070 (5522,1348) and another.</p>	2061090	14/3/96	<p data-bbox="1091 342 1528 450">Class 18: Parasols and sunshades; parts and fittings for the aforesaid goods</p> <p data-bbox="1091 456 1528 790">Class 20: Furniture; garden and conservatory furniture; plastics furniture; furniture for children; tables; chairs; loungers; settees; swings; upholstery; bolsters; cushions; upholstered seat covers; seat covers; bases for parasols and sunshades; parts and fittings for all the aforesaid goods</p>
<p data-bbox="92 860 118 891">5</p>  <p data-bbox="284 1039 603 1084">Registration of this Trade Mark shall give no right to the exclusive use of the word "trading" and the letter "t".</p> <p data-bbox="82 1048 118 1079">10</p>	1098669	13/7/78	<p data-bbox="1091 824 1503 1039">Articles included in Class 20 made of basketware, imitation basketware, bamboo or of imitation bamboo; furniture and parts thereof included in Class 20.</p>
<p data-bbox="82 1276 118 1308">15</p>  <p data-bbox="242 1375 577 1420">Registration of this Trade Mark shall give no right to the exclusive use of the word "Trading" and a letter "t".</p>	1098670	13/7/78	<p data-bbox="1091 1167 1528 1274">Class 25: Articles of outer clothing for men, women and children, but not including footwear.</p>
<p data-bbox="82 1491 118 1523">20</p>  <p data-bbox="268 1603 651 1637">Registration of this mark shall give no right to the exclusive use of the words "Wash & Wear".</p>	1554723	26/11/93	<p data-bbox="1091 1491 1503 1559">Articles of clothing; all included in Class 25.</p>
<p data-bbox="82 1702 118 1733">25</p>  <p data-bbox="268 1899 612 1921">to be associated with No. 1,098,670 (5306, 868) and another.</p> <p data-bbox="82 1895 118 1926">30</p>	1370731	20/1/89	<p data-bbox="1091 1704 1490 1771">Articles of clothing included in Class 25.</p>

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 <p>To be associated with No. 1.354.641 (5803, 6978).</p>	1370699	20/1/89	Goods in precious metals or coated therewith; jewellery; horological and chronometric instruments; all included in Class 14; but not including goods of precious metals or coated therewith being smokers articles and not including horological or chronometric instruments being clocks incorporating radios.
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