

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2102959
BY WARNACO INC TO REGISTER A
SERIES OF MARKS IN CLASS 3**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
No 47093 BY ORIGINS NATURAL RESOURCES, INC**

TRADE MARKS ACT 1994

5 **IN THE MATTER OF Application No 2102959
by Warnaco Inc to register a series of marks in
Class 3**

and

10 **IN THE MATTER OF Opposition thereto under
No 47093 by Origins Natural Resources, Inc**

15 **DECISION**

On 18 June 1996 Warnaco Inc applied to register as a series of two marks Warner's
PRIVATE PLEASURES and WARNER'S PRIVATE PLEASURES for a specification of
20 goods which reads "soaps, perfumes and perfumery; essential oils, cosmetics; hair shampoos,
conditioners and hair lotions; all included in Class 3".

The application is numbered 2102959.

25 On 25 June 1997 Origins Natural Resources, Inc filed notice of opposition to this application.
The grounds are in summary:

- (i) under Section 5(2) having regard to an earlier trade mark standing in their
name (see below for details);
- 30 (ii) under Section 5(3) to the extent that the mark applied for is to be registered for
goods which are not similar;
- 35 (iii) under Section 5(4)(a) and (b) in that the application "is liable to be prevented
as being calculated to deceive or cause confusion or otherwise to interfere with
the opponents' rights";

Details of the registration referred to above are as follows:

40	No	Mark	Class	Journal	Specification
	1544678	SECRET PLEASURES	3	6049/6868	Perfumes; cosmetics; non- medicated toilet preparations; 45 essential oils for personal use and for use in the manufacture of fragranced products; creams and lotions, all for use in the care of the

skin and the body; deodorants; anti-perspirants; preparations for the care of the hair; all included in Class 3.

5 The opponents also refer to the Registrar's discretion. It is now well established that no such power exists.

10 The applicants filed a counterstatement denying the above grounds.

Both sides filed evidence. Neither side has requested a hearing though the opponents have drawn my attention to decisions in proceedings in other jurisdictions including a decision of the Office for Harmonisation in the Internal Market. Acting on behalf of the Registrar and after careful consideration of all the papers filed (including the above-mentioned decisions) I
15 give this decision.

Opponents' evidence

20 The opponents filed a statutory declaration by Maleka Dattu, the Sales and Marketing Manager of the Origins Division of Estee Lauder Cosmetics Ltd. She says that:

"The Opponent's products under the Opponent's SECRET PLEASURES Mark were first sold in the UK in October 1995. The Opponent markets three different products under the Mark, and an example of one of them is now produced and shown to me
25 marked "MD1". The products are referred to in the Opponent's leaflets which are now produced and shown to me marked "MD2".

The goods marked with the SECRET PLEASURES trademark are now sold to customers located throughout Great Britain through seven retail outlets which are
30 located in some of the largest and most successful department stores in the UK. These are listed in Exhibit "MD3". The products are also sold directly by the stores to the public by mail order. The products have also been displayed at a trade fair organised by "Country Living" magazine at the Islington Business Centre in November 1996. The brand therefore maintains a very high visual profile, and a significant section of the
35 public notice our products, even if they do not buy them.

We maintain public awareness of the SECRET PLEASURES brand by consistent promotion through the media. This is done mainly by arranging for editorial coverage. A typical example of this editorial coverage is that which is now produced and shown
40 to me marked "MD4", from "Health & Fitness" magazine (November 1997).

As I said above, SECRET PLEASURES was launched in the UK in 1995. Since then, our gross sales turnover at retail prices for products bearing the SECRET PLEASURES Mark in the United Kingdom have amounted to £28,000."

She goes on to make a number of observations in relation to the mark applied for. The main points are:

- 5 S the goods would not be sold side by side over the same counters because her company's products are sold over their 'own counters' in department stores. Members of the public would, therefore, be comparing the impressions created by the marks
- 10 S the public would be likely to think that one mark is alluding to the other and wonder whether there is some sort of connection
- 15 S the ideas of PRIVATE PLEASURES and SECRET PLEASURES are much the same. Adding Warner's or WARNER'S does little to help and might suggest a link between Warner and the opponents
- S no other business uses SECRET PLEASURES or PRIVATE PLEASURES in this field.

Applicants' evidence

20 The applicants filed four declarations as follows:

25	Stanley P Silverstein	-	24 September 1998
	Alan Hughes	-	24 September 1998
	Anthony John Moore	-	22 September 1998
	Stewart Gregory Rayment	-	29 September 1998

Mr Silverstein is the Vice President and Secretary of Warnaco Inc, the applicants. He comments at length on Maleka Dattu's declaration. The main points are:

- 30 S Origins has a marketing style completely different from the prestige fragrance house of its parent company
- 35 S the mark ORIGINS is used prominently on all its products
- S it is suggested that SECRET PLEASURES is a tertiary mark only and in Mr Silverstein's view intended to have a descriptive relationship to the product
- 40 S SECRET PLEASURES is used to indicate one particular product of each of two ranges respectively of inhalation oils and massaging oils
- S he notes that sales of goods bearing the SECRET PLEASURES mark were only £28,000 between 1995 and March 1998
- 45 S the parties' respective marks co-exist in the USA without any evidence of confusion

5 S he suggests that to the extent that the words SECRET PLEASURES are evocative of a characteristic of the goods the opponents cannot claim that rights under such a trade mark could extend to prevent the use of any other mark having a similarly evocative meaning unless the two marks were so similar as to be confusable at the visual or phonetic levels.

10 Mr Hughes is an editor in the Dictionary Department of Oxford University Press. Mr Moore is a retired patent and trade mark attorney. Both give their views on the words 'private' and 'secret' and conclude that they are not synonymous or interchangeable.

15 Mr Rayment is a partner in Kingsley & Talboys, intellectual property research consultants. He was instructed by the applicants' agents to visit Harrods Department Store with the object of purchasing the opponents' SECRET PLEASURE goods. He located products labelled ORIGINS SENSORY THERAPY SECRET PLEASURES and exhibits (SGR1) a sales invoice (showing only ORIGINS). He also exhibits (SGR2) an example of the opponents' trade literature.

Opponents' evidence in reply

20 Ms Dattu has filed a further statutory declaration in reply to the applicants' evidence. The main points are:

25 S she explains the system of house names in use in the group and says that signage normally includes a house name (Origins), the name of the range (Sensory Therapy), the product name (Secret Pleasures), descriptive material (on-the-spot-gel) and contents markings

30 S thus she says customers would order by reference to a product name as the house name would not in itself be enough

 S she does not believe the applicants sell products in the US. The absence of instances of confusion should be seen in this light

35 S so far as the meaning of the words 'private' and 'secret' are concerned she says that ordinary members of the public do not have the skills of the applicants' declarants. She reiterates that members of the public would be influenced by general impressions of the words.

40 That completes my review of the evidence.

I will deal firstly with the objection under Section 5(4).

This reads as follows:

45 "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.”

The opponents have not explained their claim under sub-paragraph (b) and I can see no obvious basis for it. I assume, therefore, that they base their case on sub paragraph (a) and in particular the law of passing off.

The necessary elements of an action for passing off in terms of goodwill, misrepresentation and damage, were set out by Geoffrey Hobbs QC in WILD CHILD trade mark 1998 RPC 455. I do not propose to repeat the very full guidance provided but it can be found in that decision commencing at page 460 line 5 to page 461 line 22.

In brief the necessary elements are said to be as follows:

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

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

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.

In relation to the first of the above elements (goodwill) I draw the following conclusions from the opponents' evidence:

S goods under the mark SECRET PLEASURES were first sold in this country in October 1995

S sales have been at a modest level. Ms Dattu refers to sales of £28,000 since 1995. As her declaration was made in March 1998 I infer that sales up to the material date of 18 June 1996 are likely to have been at a very low level

S the exhibits tend to support the applicants' view that SECRET PLEASURES is at best a tertiary mark. Thus Exhibit MD1 (a tube of gel) shows ORIGINS, SENSORY THERAPY (itself a registered mark) and in smaller print SECRET PLEASURES. MD2 (a product leaflet) shows each of the previously mentioned marks along with a device of trees and the word Inhalations (with a TM indicator)

5 S the promotional activities referred to relate to a trade fair in November 1996 and an advertisement (MD4) dated November 1997 both of which are after the material date. Although reference is made to 'consistent promotion through the media' no advertising schedules or other evidence has been supplied in support of the claim.

10 Ms Dattu suggests that despite the variety of marks employed in relation to the goods customers would order by reference to the product name (ie SECRET PLEASURES) and not ORIGINS. It may well be the case that the housemark on its own would be an insufficient identifier but there is no evidence as to customer behaviour or that they drop the other trade mark indicators completely in the ordering process.

15 In summary I am not persuaded that the opponents have substantiated their claim to goodwill in SECRET PLEASURES at the material date. On that basis the Section 5(4)(a) case does not get off the ground. But even if I am wrong in this respect SECRET PLEASURES is in use very much a subordinate indicator of origin to ORIGINS, SENSORY THERAPY and the tree device. Given the presence of those other more prominent indicators I cannot see any danger of confusion leading to misrepresentation if the applicants use their mark WARNER'S PRIVATE PLEASURES. The Section 5(4)(a) ground fails.

20 Section 5(2) reads:

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

- 25 (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,
- 30 there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

35 As identical marks are not involved sub paragraph (b) applies here.

I take into account the guidance provided by the European Court of Justice in Sabel BV v Puma AG (1998 RPC 199 at 224), Canon v MGM (1999 ETMR 1) and Lloyd Schufabrik Meyer & Co GmbH v Klijsen Handel BV (1999 ETMR 690 at 698).

40 It is clear from these cases that:-

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

- 5 (b) the matter must be judged through the eyes of the average consumer, of the goods/services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- 10 (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components;
- 15 (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;
- (f) 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.

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My attention has also been drawn in this case to decisions of two other tribunals. The first is a decision of the Paris Appeal Court holding that PRIVATE PLEASURES and SECRET PLEASURES were in conflict and the second a decision of the OHIM Opposition Division where a similar view was taken. The latter noted that the second word of the marks is identical and that there is conceptual similarity between the respective marks. It is acknowledged that the above decisions are not binding on me but I bear them in mind in coming to a decision on the mark before me. It is important, however, to emphasise that the mark applied for here is not PRIVATE PLEASURES but WARNER'S PRIVATE PLEASURES (series).

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I do not think there can be any doubt that the goods involved are identical and/or similar. My view of the parties' marks is, critical to the outcome of the case. Consistent with my views on the manner of use of the mark SECRET PLEASURES as discussed in relation to the objection under Section 5(4)(a) I do not consider the words enjoy any enhanced level of distinctiveness as a result of the use made of them. Taking the visual aspect of the marks first self evidently SECRET PLEASURES and WARNER'S PRIVATE PLEASURES have the element PLEASURES in common so there is a measure of visual similarity. Against that the applied for mark consists of three words and the impact of a common word is somewhat less. For much the same reason there is also some aural similarity but not such that taken on its own an averagely circumspect customer would mistake one mark for the other.

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Turning to conceptual similarity it was held in *Sabel v Puma AG* that:

45 "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.

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However, in circumstances such as those in point in the main proceedings, where the earlier mark is not especially well known to the public and consists of an image with little imaginative content, the mere fact that the two marks are conceptually similar is not sufficient to give rise to a likelihood of confusion."

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The OHIM Opposition Division in their decision considered that PRIVATE PLEASURES and SECRET PLEASURES were conceptually similar. The applicants have filed declarations from Mr Hughes and Mr Moore suggesting that the words 'private' and 'secret' are not synonymous or interchangeable. I accept that the words can be differentiated in terms of their precise meaning and may in certain contexts have quite different signification. But customers' impression of words or concepts is unlikely to be formed by reference to dictionary definitions. I, therefore, agree with the OHIM decision that the idea behind the words SECRET PLEASURES and PRIVATE PLEASURES is, or could be considered, similar. That is to say both marks suggests something that is to be enjoyed secretly or privately. Conceptual similarity must of course be weighed in the balance along with visual and aural similarity. I bear in mind also the importance of visual displays as part of the process of buying perfumes, cosmetics etc. On balance had the matter rested on a comparison of SECRET PLEASURES and PRIVATE PLEASURES alone I would have been inclined to accept that there was a likelihood of confusion.

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However the mark before me is WARNER'S PRIVATE PLEASURES (series). It seems likely that WARNER'S may be in the nature of a housemark but, whether it is or is not, the applicants' mark must be considered as a totality. The test is whether the mark as a whole is likely to give rise to confusion and not whether the mark includes an element which may suffer from this defect. It is the interaction of elements within a mark that is likely to influence consumer perception. Thus a mark which may only be weakly distinctive may have the capacity to stand on its own as a badge of origin. But if that same mark is placed with another stronger element its impact is likely to be diluted to a greater or lesser extent.

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Marks must also be seen in the context of the goods to which they are to be applied. The goods here are ranges of perfumery and cosmetic items. Although some such goods can be purely functional in nature (soaps and shampoos) they are often purchased as luxury items and with some attention being paid to branding. Whilst the words SECRET PLEASURES and PRIVATE PLEASURES cannot be said to be directly descriptive of such goods they allude to a sense of self indulgence and personal enjoyment. The opponents' exhibit MD1 suggests that the SECRET PLEASURES product range is designed as a sensory stimulant ("Inspire desire as nature's most potent turn-ons ..." etc). That is not to say that a measure of conceptual similarity does not still exist between the mark applied for and the opponents' mark but I take the view that customers are likely to give due weight and attention to WARNER'S as a distinctive element within the totality of the mark and to understand the allusive nature of PRIVATE PLEASURES within the context of the goods. Bearing in mind also that visual or

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aural confusion is unlikely I have come to the view that there is no likelihood (as opposed to possibility) of confusion on the part of the public. The opposition, therefore, fails under Section 5(2)(b).

5 As I have found that the goods of the opponents' earlier trade mark are identical and/or similar to those of the application in suit it follows that Section 5(3) cannot apply. That ground also fails.

10 As the opposition has failed the applicants are entitled to a contribution towards their costs. I order the opponents to pay the applicants the sum of £435. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

15 Dated this 16 day of May 2000

20 M REYNOLDS
For the Registrar
the Comptroller-General