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

IN THE MATTER OF APPLICATION NUMBER 1579595
IN THE NAME OF MAHOGANY DESIGNS LIMITED

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 46409 BY CHRISTOPHER ROBERT BRYAN
and MAHOGANY CLOTHING LIMITED

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

IN THE MATTER OF application number 1579595
in the name of Mahogany Designs Limited

AND

IN THE MATTER OF opposition thereto
under number 46409 by Christopher Robert Bryan and Mahogany Clothing Limited

Background

On 25 July 1994, Mahogany Designs Limited, of 5 Turl Street, Oxford, OX1 2HU filed an application to register MAHOGANY as a trade mark in Class 3 in respect of the following goods:

> Preparations for cosmetic and beauty care; toiletries; preparations for the care of hair; hair lotions, hair conditioners, hair and body shampoos and gel; hair curling products and preparations; essential oils; all included in Class 3; but not including any such goods relating to the colouring of the hair.

On 12 February 1997, Christopher Robert Bryan and Mahogany Clothing Limited, as joint opponents, filed notice of opposition to this application. In the notice they say that the first opponent is the proprietor of a trade mark registration, number 1421549, for the mark MAHOGANY, and that the second opponent, with their consent, has used the trade mark in relation to fashion clothing. The grounds of opposition are, in summary:

1.	**Under Section 11**	Because use of the trade mark by the opponents would lead to deception and confusion. The opponents also contend that the applicant is disentitled to protection under the laws of passing off.
2.	**Under Section 17**	Because the applicant is not the bona fide proprietor of the trade mark.

The opponents ask that the Registrar exercise her discretion and refuse to register the mark and that an award of costs be made in their favour.

The applicants filed a Counterstatement in which they deny the grounds of opposition. They ask that the application be granted and that they be awarded costs.

Both sides filed evidence in these proceedings. The matter fell to be heard on 20 November 2000, when the applicants were represented by Mr I Bartlett of W.H. Beck Greener & Co, their trade mark agents, the opponents were not represented.

By the time this matter came to be determined, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. These proceedings having begun under the provisions of the 1938 Trade Marks Act must continue to be dealt with under that Act, in accordance with the transitional provisions set out in Paragraph 17 of Schedule 3 of the 1994 Act. Accordingly, all references in this decision are references to the 1938 Trade Marks Act.

Opponents' evidence in Chief

The opponents' evidence in chief consists of a Statutory Declaration dated 12 November 1997, and comes from Christopher Robert Bryan, one of the opponents in these proceedings. Mr Bryan confirms that he was the managing Director of Mahogany Clothing Co. Ltd from its incorporation in 1993 through to September 1997. He says that the company has entered creditor's voluntary winding up and a liquidator was appointed on 13 October 1997. Mr Bryan confirms that he is also a Director of the British Knitting & Clothing Export Council.

Mr Bryan says that he first used the trade mark MAHOGANY in 1990 on a range of menswear, the trade mark being used on garment labels, hang tags, packaging, seasonal brochures, retail point of sale goods, magazine advertising and exhibition stands, exhibit CRB1 consisting of the examples of such items bearing, inter alia, the name MAHOGANY and MAHOGANY with the word YORK placed below. The exhibit also consists of promotional cards, and a catalogue for the Autumn/Winter 1996 - 97 range of MAHOGANY menswear.

Mr Bryan gives details of how the MAHOGANY mark has been promoted, and refers to exhibit CRB2 which consists of details of advertisements and features for MAHOGANY menswear placed in editions of MensWear magazine between August 1992 and Autumn 1994, MensWear Buyer magazine in August 1997 and He Lines magazine in February/August 1994 and September 1997. All show the MAHOGANY name being used in conjunction with articles of mens clothing.

Mr Bryan goes on to list the turnover derived from MAHOGANY branded goods and the amounts spent on the promotion between 1993 and 1997, which, for the 1993-94 financial year (the only year prior to the relevant date) amounted to amounted to £927,796 and £100,874 respectively. He refers to exhibit CRB3 which consists of, inter alia, invoices and other matter relating to expenditure on advertising and promotion of MAHOGANY between 1995 and 1997.

Mr Bryan says that the evidence shows that the MAHOGANY trade mark has established a reputation and goodwill in the United Kingdom menswear market, and that to maintain the integrity of the mark he should be free to follow the market trend and extend into perfumes and toiletries, citing some fashion labels that have already done this. He concludes by saying that use of MAHOGANY by the applicants will lead to association with his menswear brand.

Applicants' evidence

This consists of a Statutory Declaration dated 7 May 1998, and comes from Russell John Barker, Company Secretary of Mahogany Designs Limited, a position he has held since the incorporation of the company in 1988. He says that prior to this the business had, since 1979, been carried on by a partnership with which he was involved.

Mr Barker says that the MAHOGANY business started in October 1979 when two hairdressers opened a hairdressing salon in Oxford under the name, with four more being opened between 1981 and 1995. He sets out the turnover in respect of the business carried on under the mark for the years 1993 to 1997, which for 1993-94 (the only year prior to the relevant date) amounted to £1,395,906 (net). Mr Barker says that the company has spent in the order of £140,000 promoting the mark and refers to exhibit RJB1 which consists of features and advertisements relating to the applicants' MAHOGANY hairdressing salons, primarily from hairdressing and beauty industry magazines, the earliest dating from 1988. Mr Barker refers to various national television programmes, and national and international clothing, hairdressing and beauty industry trade shows in which the applicants' hairdressing services have featured, although does not give any specific details. He refers to exhibit RJB2 which consists of details of customers showing these to be located in various parts of the United Kingdom.

Mr Barker says that the MAHOGANY trade marks is used on the outside of the salons and features prominently on items of business stationery, examples of which are shown at exhibit RJB3, and which shows the word MAHOGANY being used within a circular geometric border.

Mr Barker confirms that the applicants' salons sell a range of hairdressing products, mentioning in particular the products of Aveda saying that although not branded MAHOGANY they will be placed in a MAHOGANY bag, an example of which is shown at exhibit RJB4, and which bears the MAHOGANY logo previously referred to. He says that around £100,000 of own brand products such as hairbrushes, rucksacks, T-shirts, hair dryers, books and videos are also sold each year in the salons, referring to exhibit RJB5 which consists of a T-shirt and a hairbrush bearing the name MAHOGANY.

Mr Barker goes to the claim that the applicants' use of MAHOGANY will cause confusion, which he says is highly unlikely because the trade mark is more likely to be associated with the applicants because of the use they have made of the mark. He notes that although the opponents say that they have used the mark since 1990, the turnover figures given start in 1993 from which he draws the conclusion that by the time the application was filed it is highly unlikely that the opponents could have built up much of a reputation in MAHOGANY. He concludes his Declaration by refuting the suggestion that confusion will arise.

Applicants' evidence Rule 13(8)

This consists of a further Statutory Declaration, dated 3 September 1998 by Reginald John Barker. Mr Barker says that contrary to his earlier Declaration, the applicants have not sold T-shirts and rucksacks, these being used purely for promotional purposes, or in the case of T-shirts, worn by staff at hair shows and exhibitions or given away at charitable events sponsored by his company.

That concludes my review of the evidence insofar as it is relevant to these proceedings.

Decision

I will turn first to the grounds founded under Section 11 of the Act which reads as follows:-

> **11** It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.

The established tests for objections under this provision is set down in Smith Hayden and Company Ltd's application (Volume 1946 63 RPC 101) later adapted by Lord Upjohn in the BALI trade mark case 1969 RPC 496. Adapted to the matter in hand, these tests may be expressed as follows:-

> Having regard to the opponents' user of the mark MAHOGANY, is the tribunal satisfied that the mark applied for, MAHOGANY, if used in a normal and fair manner in connection with any goods covered by the registration proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?

The test requires me to consider the user established by the respective parties at the relevant date, that is, the date of the application for registration of the trade mark under opposition.

The opponents say that they began using the trade mark MAHOGANY in 1990 in respect of a range of mens clothing. The earliest exhibit showing use of the mark dates from August 1992 and shows use in respect of a range of menswear, which at best establishes approaching two years use prior to the relevant date. However, the opponents have given figures for turnover starting only in the 1993-94 financial year, and as a consequence it is not possible to gauge the extent of any use, reputation or goodwill likely to have been acquired in earlier years.

The applicants in turn say, and the evidence shows, that they first used MAHOGANY in 1979 in relation to hairdressing services, some 11 years earlier than the date claimed by the opponents, and I do not, therefore see how I could reach the conclusion that their use of their MAHOGANY trade mark would be reasonably likely to cause deception and confusion. They may well have primarily used the mark in the form of a logo, but I do not consider that this makes any material difference, it being well established that in composite marks, "words talk". The turnover figures provided by the applicants date from 1993, and show that at the relevant date they not only had a long use of the mark, but also a substantial business by normal standards in the hairdressing trade, which I understand to be primarily made up of localised rather than national businesses.

Both have promoted their marks quite widely although mostly within their respective trades. There are instances of national promotion but these are so lacking in any detail such that I am unable to give them much, if any weight.

The opponents point to the extension of brands established on clothing into other areas such as perfumery and toiletries, presumably to illustrate the potential damage to their business if the trade mark is registered by removing an area of progression for their business, but this is also a relevant in a consideration of a likelihood of deception or confusion, for if this has clearly established the concept of a mark built on clothing being used on other goods, and in particular the goods covered by the application, in the minds of the public, then confusion or deception seems more likely.

It is a fact that some extremely well known and well established fashion labels have extended the use of their trade marks into other areas, including perfumery and toiletries, but by no stretch of the imagination could the opponents or their use, reputation or goodwill in MAHOGANY be said to be in the same category. Whilst the concept of brand extension may be there in the minds of the public, I cannot take it as read that they will, in all cases, assume this to be the case when the same mark is used in connection with perfumes and toiletries by one trader, and clothing by another. Much will, in my view, depend upon factors such as the inherent distinctiveness of the mark, how well it has become known, and whether the public are used to seeing the mark in use in respect of goods or services beyond those on which its core reputation has been established.

The word MAHOGANY has no relevance to the goods covered by the application, at least none that I am aware of, and as such is a good and distinctive mark. There is no evidence that the opponents have ever sold goods other than menswear, or that this was their intention. The applicants claim to have sold approximately £100,000 of goods, including a range of hairdressing products (which would be covered by the application), albeit not under the MAHOGANY name, and as they do not say from when, or in what amounts this can be given little weight.

At the relevant date the applicants had, by far, the most use, and by extension, reputation and goodwill in the name MAHOGANY, and in my view, did so in relation to the provision of a service more closely related to the goods of the application than those sold by the opponents. It seems to me that if the public, on seeing MAHOGANY used in connection with the goods of the application, is going to believe there to be a connection, it is more likely to be with the applicants rather than the opponents, and whilst purchasers familiar with the opponents' menswear may be reminded of that clothing, I do not consider that it would lead to a substantial number of persons being deceived or confused into thinking that there is some connection, or that such use by the applicants will damage the opponents' business. Accordingly I find the opposition to fail under both aspects of Section 11 cited in the Statement of Grounds.

This leaves the ground founded under Section 17(1) of the Act. There is no evidence before me to substantiate this ground or that leads me to believe that I should exercise my discretion, and I dismiss this ground.

The opposition having failed on all grounds, the applicants are entitled to a contribution towards their costs. I order the opponents to pay the applicants the sum of £635, the costs are 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.

Dated this 22 day of February 2001

Mike Foley
for the Registrar
The Comptroller General