

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2008447A BY
S T DUPONT TO REGISTER A MARK
IN CLASS 25**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No 44948
BY E.I. DU PONT DE NEMOURS AND COMPANY**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2008447A
by S T Dupont to register a mark in Class 25**

AND

**IN THE MATTER OF Opposition thereto under
No 44948 by E.I. Du Pont de Nemours and Company**

BACKGROUND

1. On 20 January 1995, S T Dupont of Paris, France, applied to register the trade mark shown below in Classes 3, 9, 14, 16, 18, 25 and 34.



2. The application, numbered 2008447, was accepted and published for a range of goods in the Classes indicated. For reasons which will become apparent later in this decision, only the goods in Class 25 are material to these current proceedings. The goods in Class 25 for which the application was published were as follows:

“Articles of clothing, neckwear, headgear, swimwear, beachwear, dressing gowns and bath robes, socks, stockings, hosiery, pantihose, tights; all included in Class 25; but not including boots, shoes and slippers or any goods similar to these excluded goods”.

3. The application is opposed by E.I. du Pont de Nemours and Company of Wilmington, Delaware, United States of America, who are the proprietors of the trade mark DU PONT which is the subject of an application for registration for goods in Class 25 under No 1523636, the grounds of opposition are, in summary:

- that at the date of filing application No 1523636 the opponents were entitled to claim protection for the trade mark DU PONT as a well-known trade mark under the Paris Convention in accordance with Section 6(1)(c) of the Trade Marks Act 1994;
- that the trade mark applied for is similar to the opponents' trade mark and the goods contained in Class 25 of the application (details below) are identical or similar to those for which the earlier trade mark is protected. Objection is said therefore to arise under Section 5(2)(b) of the Act;

- that the opponents have made substantial use of their trade mark since at least 1963 in the United Kingdom in relation to the goods covered by their application and have acquired an extensive goodwill and reputation in the trade mark in relation to those goods. As such, objection is said to arise under Section 5(4)(a) of the Act.

The details of the opponents' trade mark is as follows:

Date of Application	Trade Mark No 1523636	Specification of goods
13 January 1993	DU PONT	Dresses, skirts, trousers, jackets, shirts, blouses, pants, shorts, suits, coats, tricots, jerseys, jumpers, pullovers, cardigans, jacquards, dungarees, tee shirts, scarves, hats, gloves, underwear, lingerie, hosiery, tights, stockings, briefs, negligees, track suits, swim suits, leotards and leggings; all included in Class 25.

Objections were also founded on Section 1(1) and Section 3(6) of the Act but these were, in the event, not pursued.

4. The applicants filed a counterstatement which in essence consists of a denial of the various grounds of opposition.

5. During the course of these proceedings the applicants sought to divide application No 2008447 with the result that Classes 3,9,14,16,18 and 34 became part of a separate application, namely No 2008447B. That application has now proceeded to registration and I need make no further mention of it in this decision. Suffice to say that the opposition that remains is directed at the Class 25 element of the original application which continues under No 2008447A.

6. Both sides seek an award of costs in their favour and both sides filed evidence. The matter came to be heard on 3 October 2001. The applicants were represented by Mr Richard Arnold of Her Majesty's Counsel instructed by A A Thornton & Co. The opponents were represented by Mr James Mellor, of Counsel, instructed by Marks & Clerk.

Opponents' evidence

7. This consists of a declaration by Mary E Bowler dated 8 May 1997. Ms Bowler explains that she is the Assistant Secretary of the opponent company, a position which she has held since 1995, having joined the opponents as an Attorney in 1981. She confirms that she is authorised to speak on behalf of her company adding that the facts in her declaration are either from her own knowledge or from the records of her company to which she has full access.

8. Ms Bowler states that her company was established in 1802 and is the owner of the trade mark DUPONT which has been continuously used since that date throughout the world in relation to a variety of goods including, inter alia, articles of clothing; fibres; elastomers and plastics; film and photo products; chemical products; fluoro polymer resins and articles manufactured therefrom. Exhibit MEB1 consists of a list of registrations and pending applications filed throughout the world for the trade marks DUPONT and a device mark consisting of the word DUPONT within an oval.

9. Ms Bowler provides worldwide turnover figures for goods sold under the trade mark DUPONT in the period 1986 to 1996. I note that total worldwide turnover in the period 1986 to 1994 under the DUPONT trade mark amounted to some US\$ 270 billion. Exhibit MEB2 consists of a summary of worldwide sales figures for goods sold under the DUPONT trade mark in the period 1925 to 1996. Advertising expenditure for goods sold under the DUPONT trade mark worldwide are also provided for the years 1961, 1964, 1968, 1969 and from 1984 to 1996. I note that in the period 1986 to 1994 worldwide advertising expenditure amounted to some US\$1.8 billion.

10. Ms Bowler explains that the trade mark DUPONT was first used in the United Kingdom by her company on the following basis:

Elastomers/plastics:	1958
Film and photo products:	1962
Clothing articles:	1963
Fluoropolymer resins and articles manufactured therefrom:	1964

She adds that the first European DuPont Office was set up in the United Kingdom in 1956. Exhibit MEB3 consists of a list of historical dates in the development of DuPont in the United Kingdom during the period 1956 to 1992.

11. Ms Bowler states that the trade mark DUPONT has been used continuously in the United Kingdom since 1963 in relation to articles of clothing and in particular, dresses, skirts, trousers, jackets, shirts, blouses, pants, shorts, suits, coats, tricots, jerseys, jumpers, pullovers, cardigans, jacquards, dungarees, T-shirts, scarves, hats, gloves, underwear, lingerie, hosiery, tights, stockings, briefs, negligees, tracksuits, swimsuits, leotards and leggings. Exhibit MEB4 consists of a range of brochures (of varying dates, many undated) which, says Ms Bowler, shows use of the mark DUPONT in relation to some of the articles of clothing mentioned above.

12. Mr Bowler comments that since 1963 the annual turnover generated by the sales of articles of clothing under the DUPONT trade mark in the United Kingdom has been considerable with turnover in 1993 amounting to approximately £30m. Although figures for other years are not readily available, Ms Bowler estimates that they would be on a similar scale. Similarly Ms Bowler estimates that her company spends approximately £2m per year in the United Kingdom promoting the DUPONT trade mark.

13. Products bearing the DUPONT trade mark have, says Ms Bowler, been sold in all major towns in all regions of the United Kingdom. Exhibit MEB5 consists of a resource list (dated after the material date) identifying local manufacturers both in the United Kingdom and around the world. Exhibit MEB6 consists of swing tickets, hang tags and labels showing how the mark is used in relation to clothing.

14. Ms Bowler adds that her company attends and participates at clothing exhibitions held in the United Kingdom at which goods bearing the DUPONT trade mark have been displayed. The following examples are provided: Fabrics, London - 1992 , Clothes Show, London - 1993 and Lycra, London - 1993. DuPont is also a member of the British Apparel and Textile Confederation and the Knitting Industries Federation.

Applicants' evidence

15. This consist of a declaration dated 8 January 1998 by William R Christie. Mr Christie explains that he is the President of S T Dupont adding that he has been associated with the company in his present position for three years. He states that he has full access to his company's books and records and that the facts in his declaration are taken either from these records or from his own personal knowledge. He confirms that he has a reasonable knowledge of the English language.

16. Mr Christie states that his company has used the trade mark S T DUPONT in the United Kingdom and elsewhere in respect of a wide range of goods since at least 1954. He adds that his company has used the same trade mark in the United Kingdom and elsewhere since at least October 1991 in respect of articles of clothing in Class 25. Exhibit A consists of examples of catalogues produced by the opponents which, says Mr Christie, gives a flavour of the range of goods on which the mark S T DUPONT is and has been used.

17. Turnover in the United Kingdom in respect of articles of clothing sold under the S T DUPONT trade mark in the period 1991/92 to 1993/94 amounted to £86,910. Mr Christie states that goods bearing the trade mark are available for sale at shop-in-shops located within Harvey Nichols' department stores in London and Leeds. Exhibits B and C to Mr Christie's declaration consist respectively of, examples of invoices which in Mr Christie's view shows sales of clothing items in the United Kingdom which bore the trade mark S T DUPONT and a photograph of the S T DUPONT outlet located in Harvey Nichols, London.

18. Mr Christie states that his company has registered the trade mark S T DUPONT in a number of countries worldwide. He notes that his company's trade mark S T DUPONT coexists with the DU PONT mark of the opponents in respect of goods in Class 25 in a range of countries and adds that to the best of his knowledge no action has been taken by the opponents in these countries. Mr Christie adds that to the best of his knowledge and belief there have been no instances worldwide of confusion between the respective parties goods.

19. That concludes my review of the evidence filed in so far as I think it necessary.

DECISION

20. I deal first with the ground of opposition based upon Section 5(2)(b), which states:

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

- (a)
- (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 trade mark is defined in Section 6(1) which states:

"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,"

As the opponents' trade mark on which they base their claim to an earlier trade mark is subject to an application for registration then the provisions of Section 6(2) are appropriate, this states:

"6.- (2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered."

I consider that the opponents' trade mark has the necessary basic requirements in terms of its date of application to be considered as an earlier right, under Section 6(1)(a) and Section 6(2).

21. I go on therefore to consider the applicants' and the opponents' trade marks against the guidance in relation to matters under Section 5(2) provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

From these cases I take the following:-

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*, paragraph 22;

- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;
- (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; *Sabel BV v. Puma AG*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (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; *Sabel BV v. Puma AG*, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;
- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG*, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

22. As both sides have filed evidence which they claim supports what they claim to be the reputation and goodwill in their respective trade marks I will deal with that point first.

23. In their skeleton arguments and at the Hearing both Mr Mellor and Mr Arnold were critical of each others evidence. Mr Mellor said that some of the facts in Mr Christies' declaration needed to be treated with care. On examination, all that could be said about the applicants was that they had sold some clothing through two branches of a department store (Harvey Nichols in London and Leeds). But no indication had been given of which of the

applicants' trade marks had been used. In their evidence they had shown that they had a range of trade marks in use but none showed that the trade mark in suit here had in fact been used in connection with the clothing sold in these department stores or in connection with clothing at all in the United Kingdom.

24. Mr Arnold for his part said that it was asserted that EI Du Pont had used the trade mark DUPONT in the United Kingdom in relation to articles of clothing since 1963. Scrutiny of the exhibits, however, showed that it had done no such thing. In fact, EI Du Pont did not trade in clothing. It manufactured and sold fibres and fabric. Moreover, as the opponents' brochures showed that fibres were sold under other trade marks e.g. LYCRA and TACTEL; fabric was sold under the trade mark CORDURA. Neither the fibres nor the fabric were sold under the trade mark DUPONT. Indeed, Mr Arnold submitted that the exhibits did not contain a single instance of the trade mark DUPONT as denoting a source of clothing as opposed to the source of fibres or fabric from which the clothing was made.

25. The Exhibit MEB 4 attached to the copy of Ms Bowler's declaration contains brochures which show just how the opponents have used their trade mark DUPONT. Some of the brochures are directed at the trade and seek to inform them that the opponents have developed fibres and material which have particular qualities and can be incorporated into made-up clothing. These seem to support Mr Arnold's submissions because the goods being promoted are for example fibres by reference to the trade mark LYCRA with the term Du Pont being relegated to the role of the producer. Examples of a swing ticket is shown below:



This too suggests that the term 'Du Pont' is serving, at best, a secondary role as the name of the producer.

26. Of course, as was pointed out to me, goods may bear more than one trade mark, FORD FIESTA would be one example, and in the clothing industry there are trade marks used alongside 'models' for example 'BARBOUR' BEAUFORT to denote a style of waxed jacket by BARBOUR. So, have we that situation here?

27. What the evidence shows is that the opponents manufacture fibres which have particular qualities and can, depending upon those qualities, be incorporated into finished garments so

that, for example, LYCRA in a garment will assist the garment to retain its shape; CORDURA is a fabric which combines strength and durability so is suitable for 'adventure' clothing. And in each case it seems to me the term DUPONT is relegated to that of the name of the producer, rather than a subsidiary trade mark. Thus it plays "second fiddle" to other trade marks. But, there is a further factor which I need to take into account and that is that the finished garments will also have their own trade marks. Thus, the example used at the hearing was a pair of socks bought at Marks & Spencers might bear the ST MICHAEL trade mark, together with a swing tag which indicates that the socks contains LYCRA (and would therefore keep their shape) and that the swing tag might also indicate that Du Pont produced LYCRA. Thus the term DUPONT would be relegated to 'third billing'. From this I conclude that the word DUPONT would not be seen as a trade mark in respect of the finished articles but merely the name of the manufacturer of the fibre from which it was, in part, made up. I have little doubt however that the relevant 'trades', manufacturers of textiles and clothing manufacturers would as a result of the opponents' promotion of it in relation to its use as a fabric recognise the term DUPONT as a trade mark in respect of those fibres (and fabrics).

28. Taking the above into account I reach the view that whilst the opponents have used their trade mark DUPONT they have not done so on made up clothing but only in respect of the fabric or fibres from which those goods are made up. Thus the reputation in their trade mark and any consequent goodwill from its use is in respect of goods which are different from that claimed.

29. In the circumstances I do not feel able to take either the opponents claimed goodwill and reputation into account, nor the applicants' use of their trade mark. I therefore consider the matter on the basis of notional and fair use of the applicants' and the opponents' trade marks across the full specification of the applications as per REACT trade mark [2000] RPC 285.

30. First of all there was no dispute between the parties that identical goods were involved therefore matters turn on a comparison of the respective trade marks. Each consists in whole or in part of the word DU PONT - I do not consider that the space between the syllable DU and PONT in the opponents' trade mark will have any material effect in the way in which the trade mark will be seen. The applicants' trade mark consists in addition of the letters ST the whole in script form. But in my view, visually, aurally or conceptually, both are DUPONT trade marks. The fact that one may appear to be a surname whilst the other is a surname plus initials, ie. a proper name, does not dilute the similarity. Not least because the opponents' trade mark, it seems to me, has a significant degree of distinctiveness. Bringing this together I believe that the identity of the goods coupled with the similarity of the respective trade marks means that the grounds of opposition under the provisions of Section 5(2)(b) have been made out because as a result there exists a likelihood of confusion on the part of the public.

31. Thus, once trade mark application No. 1523636 upon which the opposition is based is registered this application must be refused. If the earlier trade mark is not registered then this application may proceed.

32. I turn to the grounds of opposition based upon Section 5(4)(a) of the Act 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"

33. I look to the guidance provided by the Appointed Person, Mr Geoffrey Hobbs QC in the *Wild Child* case (1998) 14 RPC 455 in which he said:

"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."

"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 *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1979] ACT 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:

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

(2) 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

(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."

34. The opponents' case rests upon their claim to goodwill and reputation in the trade mark DU PONT for clothing. For the reasons given earlier, I do not think they possess any reputation or goodwill in clothing. Thus their opposition under Section 5(4)(a) is dismissed.

35. The opponents also claim that the trade mark on which the opposition is based is a well known mark under the provisions of Section 6(1)(c) and the provisions of Section 56. I do not consider they have made out this case - mere evidence of use globally and registrations in Convention Countries (which was provided) is not enough to satisfy me that the trade mark is a well known trade mark and therefore entitled to the exceptional protection by those particular provisions of the Act (see *General Motors Corporation v YPlon SA* [1999] ETMR

page 122).

36. The opponents have succeeded in their opposition to this application for registration, subject to their own trade mark the subject of application No 1523636 being registered. Once that is achieved this application will stand refused. On that basis the opponents are entitled to an award of costs and I order the applicants to pay to them the sum of £800. This sum to be paid within fourteen days of the registration of the opponents above numbered trade mark application. If in the event the opponents' trade mark does not achieve registration and this application proceeds then the costs order will be revised and the opponents must pay to the applicants the sum of £600.

Dated this 7TH day of December 2001

**M KNIGHT
For the Registrar
the Comptroller-General**