

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

**IN THE MATTER OF APPLICATION NO: 1523636 BY
E.I. DU PONT DE NEMOURS AND COMPANY
TO REGISTER A TRADE MARK IN CLASS 25**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO: 45990
BY S T DUPONT**

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BACKGROUND

1. On 13 January 1993, E.I. du Pont de Nemours and Company of Wilmington, Delaware, United States of America applied to register the mark **DU PONT** in Class 25. The application numbered 1523636, was examined and subsequently, on 28 August 1996, advertised before acceptance, in Part A of the Register, under the provisions of Section 18(1) of the Trade Mark Act 1938 for the following specification of goods:

“Dresses, skirts, trousers, jackets, shirts, blouses, pants, shorts, suits, coats, tricot, 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.

2. On 28 November 1996, S T Dupont of Paris, France filed a notice of opposition. The opponents frame their objections in the following terms:

“1) The opponents have for many years used the trade mark S.T.DUPONT in relation to a wide range of goods including the goods of application 1523636 or goods of the same description. The trade mark of 1523636 is accordingly neither adapted to distinguish the goods with which the applicants are connected in the course of trade nor is capable of so distinguishing. Registration of the trade mark the subject of application 1523636 in respect of the goods specified in that application would accordingly be contrary to the provisions of Sections 9&10 of the Trade Marks Act 1938.

2. The opponents are the proprietors of numerous registered trade marks, details of which are attached, which include the word DUPONT. The goods covered by the said registrations are the same description of goods as those covered by application 1523636 and the marks of the said registrations so nearly resemble the mark of 1523636 as to be likely to deceive or cause confusion. Registration of the mark the subject of application 1523636 would accordingly be contrary to the provisions of Section 12 of the Trade Marks Act 1938.

3. By virtue of the long and established use by the opponents of the name S.T.DUPONT in relation to a wide range of goods of high quality the opponents have acquired a substantial reputation in the name DUPONT. In the circumstances, use of the trade mark the subject of application 1523636 would be likely to deceive or cause confusion and would be disentitled to protection in a Court of Justice. Registration of the mark the subject of application 1523636 would accordingly be contrary to the provisions of Section 11 of the Trade Marks Act 1938".

3. The applicants filed a counterstatement in which they comment as follows:

"1. The registration of the mark applied for would not be contrary to the provisions of sections 9 and 10 of the Trade Marks Act 1938 whether alleged by the opponents or at all. In particular, the applicants refer to the fact that the mark applied for was advertised before acceptance on the basis of use since 1963 and contend, that, on the contrary, it is the opponents' mark which is incapable of distinguishing. The applicants accordingly deny the statements made in paragraph 1 of the grounds of opposition.

2. The applicants admit the existence of the registered trade marks referred to in paragraph 2 of the grounds of opposition but contend that these marks fall outside the scope of section 12 and have no relevance to the present proceedings since none of them is for the same goods or goods of the same description as those in respect of which the application has been made.

3. The applicants commenced use of the mark applied for at least a quarter of a century before the opponents made any use of their mark for goods in class 25. Accordingly, the applicants contend that the opponents have no reputation in the trade mark in the United Kingdom and expressly deny that their use of the trade mark the subject of application no 1523636 would be likely to deceive or cause confusion. The statements made in paragraph 3 of grounds of opposition are therefore expressly denied".

4. Both sides sought an award of costs and both sides filed evidence. The applicants also ask the Registrar to exercise her discretion in their favour. The matter came to be heard on 3 October 2001. The applicants were represented by Mr James Mellor of Counsel instructed by Marks & Clerk. The opponents were represented by Mr Richard Arnold of Her Majesty's Counsel instructed by A A Thornton & Co.

5. By the time the matter came to be heard the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. In accordance with the transitional provisions set out in Schedule 3 to that Act however, I must continue to apply the relevant provisions of the old law to these proceedings. Accordingly, all references in the later part of this decision are references to the provisions of the old law.

Opponents' evidence-in-chief

6. This consist of a declaration dated 9 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.

7. 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. Most fall outside those covered by Class 25 and the articles of clothing shown can be described as outerclothing for men.

8. 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 1992/93 amounted to £58,910. 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 (but all are after the relevant date) and a photograph of the S T DUPONT outlet located in Harvey Nichols, London.

Applicants' evidence-in-chief

9. This consists of a statutory declaration dated 27 January 1999 by John Arthur Slater a partner in the firm of Marks & Clerk who are the applicants' professional representatives in this matter. The information in Mr Slater's declaration has been obtained either from his firm's records or from information supplied to him by the applicants for registration.

10. Exhibit JAS1 to Mr Slater's declaration consists of a copy of a declaration made by Mary E Bowler dated 8 May 1997. This declaration was originally filed by the applicants in connection with their opposition to trade mark application No: 2008447 for the mark S T DUPONT (in script form) which stands in the name of S T Dupont.

11. In her declaration Ms Bowler explains that she is the Assistant Secretary of the applicant company, a position which she has held since 1995, having joined the applicants 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.

12. Ms Bowler provides details of the company's worldwide turnover and advertising figures as well as of trade mark registrations elsewhere none of which are relevant here. She goes on to state 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

13. 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.

14. 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. Exhibit MEB6 consists of swing tickets, hang tags and labels showing how the mark is used in relation to clothing.

15. 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.

Opponents' evidence-in-reply

16. This consists of a statutory declaration dated 9 October 2000 by the same William R Christie mentioned above. In Mr Christie's opinion a careful review of the evidence filed by the applicants in these proceedings, indicates that the extent of the applicants' use of their DUPONT mark in direct relation to clothing is limited to indications that other trade marks which the applicants use such as LYCRA and TACTEL are trade marks of E I Dupont de Nemours & Co. Mr Christie's comments that in the evidence filed, it appears that the word DUPONT is not used as a trade mark but as the name of a company responsible for other trade marks.

17. 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 applicants in respect of goods in Class 25 in a range of countries and that to the best of his knowledge no action has been taken by the applicants 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.

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

DECISION

Preliminary Points

19. At the start of the Hearing two points were raised in relation to the grounds of opposition set out above.

Sections 9 and 10

20. Mr Arnolds' skeleton argument stated:

"4. The sections 9/10 objection is based on the fact that DU PONT is according to its ordinary signification a surname. Although it is not particularly common in the United Kingdom (17 entries in the London telephone directory), it is a very common surname in France indeed (several hundred entries in the Paris telephone directory). Accordingly this is not a case where the *de minimis* principle enunciated in *CIBA Trade Mark* [1938] RPC 75 applies, since the Registry guidelines for the application of that principle as at 1993 required not more than 50 entries in any relevant foreign telephone directory for registration in Part B.

5. EI Du Pont seek to overcome this objection by reliance upon acquired distinctiveness. In EI Du Pont's evidence it is asserted that EI Du Pont has used the trade mark DU PONT in the United Kingdom in relation to articles of clothing since 1963. Scrutiny of the exhibits, however, shows that it has done no such thing. In fact, EI Du Pont does not trade in clothing at all, it manufactures and sells fibres and fabric. Moreover, the fibres are sold under the well-known trade marks LYCRA and TACTEL while the fabric is sold under the (rather less well-known) trade mark CORDURA. Neither the fibres nor the fabric are sold under the trade mark DU PONT. Indeed, the exhibits do not contain a single instance of the trade mark DU PONT as denoting a source of clothing as opposed to fabric from which the clothing is made or fibres from which the fabric is made. Accordingly, EI Du Pont cannot rely upon acquired distinctiveness to overcome the sections 9/10 objection."

21. Mr Arnold indicated his willingness to amend the statement of case to reflect the surnominal objection that his clients wished to run. Mr Mellor objected to this what is considered to be a new line of attack. In the event I refused to allow the basis of the objection under Section 9 and 10 to be amended.

22. The grounds pleaded under Sections 9 and 10 in the statement of case which accompanied the Notice of Opposition are set out earlier. They are by today's standards 'hopeless', as Mr Mellor put it. They do not present a case against the trade mark in suit consistent with the particular provisions of the statute. The two sections deal with the determination of whether a trade mark is adapted or capable of distinguishing the goods in issue from those of other traders. There is no way that anyone could infer that what the opponents had in mind was the precise surnominal objection spelled out in Mr Arnold's skeleton argument. Thus the

applicant, upon whom the onus rests in opposition proceedings under the Trade Marks Act 1938 (as amended) to convince the registrar's Hearing Officer that the trade mark in suit should be accepted, had not sought to respond to such an allegation and had not put in evidence to deal with that particular point. I accepted Mr Mellor's statements that if I was minded to allow an amendment to the pleadings then he might wish to seek an adjournment in order that his client could re-consider the evidence of use that had been filed in these proceedings. That which had been filed was, I was told, directed towards the objection based upon Section 11.

23. Because the opponents had been professionally represented throughout the proceedings and neither they nor the opponents themselves had sought at any point to amend the pleadings; because the nature of the objection being taken under Sections 9 and 10 had been spelled out in Mr Arnold's skeleton argument for the first time and received only two days before the hearing; because there was the likelihood of a need for an adjournment if I allowed the amendment, I refused Mr Arnolds' request. Thus the Section 9 and 10 grounds referred to were not pursued before me.

24. The second point related to the grounds of objection based upon Section 12(1). Mr Arnold's skeleton argument indicated that the opponents were relying upon their registration number 1571156 in this regard. It was not a registration that had been detailed by the opponents in their statement of case or in their evidence. I noted, however, that it was a registration of which the applicants were fully aware; was for the same goods as other registrations in their name and that the question of the similarity or otherwise of the registration and the applicants' trade mark was one for the tribunal (absence expert witnesses) (see Kerly's 12th Edition 17-25). It was therefore a matter on which oral submissions could be made. I therefore allowed the opponents to proceed on the basis that the Section 12(1) ground of opposition was being pursued only on the basis of the opponents' registration No. 1571156; all the earlier rights on which this ground of opposition had been notified being withdrawn.


25. The opposition thus proceeds only on the basis of Section 11 and 12(1) of the Act.

26. I deal first of all with the ground of opposition based upon Section 12(1) which states:

"12.-(1) Subject to the provisions of subsection (2) of this section, no trade mark shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of:-

- a. the same goods
- b. the same description of goods, or
- c. services or a description of services which are associated with those goods or goods of that description."

27. This ground of opposition is based upon the opponents' registration No. 1571156 details of which are as follows:

Trade Mark	Class	Specification of goods
	25	Articles of clothing, neckwear, headgear, swimwear, beachwear, dressing gowns and bath robes, socks, stockings, hosiery, panty-hose, tights; all included in Class 25; but not including boots, shoes and slippers or any goods of the same description as the excluded goods.

28. As Mr Arnold acknowledged, this trade mark registration had a later filing date than the trade mark application in suit, 5 May 1994, some sixteen months after the filing date of the application for registration in suit. In doing so he submitted that the Registrar's Hearing Officer was wrong in C Trade Mark [1998] RPC 439, (for the reasons argued by Mr Geoffrey Hobbs QC in that case) to hold that in opposition proceedings brought under Section 12(1) the position must be determined at the date of the application for the trade mark in suit and not the date it would otherwise fall to be placed upon the register. The Hearing Officer held in effect that it was the position in terms of earlier applications and earlier registrations at the filing date of the application in suit that had to be considered. Mr Arnold submitted that that case was inconsistent with earlier authorities and with the subsequent case of TRANSPAY Trade Mark [2001] RPC 6.

29. The latter case was one I decided under the provisions of the Trade Marks Act 1994 and therefore can not necessarily assist here. But it might be worth noting that I do not believe that that case is out of line with C Trade Mark. At paragraph 22 I said:

"In addition to the ability to amend an application for registration which is provided for by section 38 of the Act, it seems to me as a matter of practical common sense that the Act must have regard to any event which occurs in relation to any *earlier trade mark* [my emphasis] on the basis of which an objection under section 5 arises, such that the objection itself falls away. That means that if the proprietor of the *earlier trade mark* seeks to limit the specification of goods and services such that the conflict between the two marks is removed, or applies to have the registration cancelled or the applicant applies to have the *earlier trade mark* assigned to him (all events which occur after the date of application), then the registrar (and her examiners) should take them into account in assessing the acceptance or otherwise of an application for registration. Such an assessment may also, it seems to me, take place in the course of opposition proceedings and in particular where an opponent bases an opposition on an earlier trade mark which subsequently lapses. Then the hearing officer like the trade mark examiner is bound, in my view, to take that matter into consideration."

30. An earlier right is defined in Section 6(1) as something that has a date of application for registration 'earlier than that of the trade mark in question'. It follows therefore that an earlier

right can not be established under Section 5(1), (2) or (3) by an application for registration having a later filing date. Thus I consider my decision in TRANSPAY to be consistent with that of the Hearing Officer in C Trade Mark because in both C Trade Mark and TRANSPAY it was held that an earlier right established at the date of application could fall away but it is implicit that a right which post dates the date of application can not be established as an earlier right as a result of later events (e.g. registration of a later filed application).

31. I go on to note that Mr Arnold relies upon the arguments put forward by Mr Geoffrey Hobbs QC in C Trade Mark for his submission that the Hearing Officer was wrong in that case. But, for the same reasons advanced by the Hearing Officer I do not consider that there is any doubt that I must consider matters as at the date of application for registration, in this case for the trade mark DU PONT. At that date, the opponents would not appear to have had any trade marks on the register, or the subject of an application for registration which would have been a barrier to the application in suit proceeding. The fact that a later filed application by the opponents in respect of what they consider to be a trade mark which so nearly resembles the trade mark of the application in suit (and for identical goods) was placed on the register before the application in suit could be determined is not a factor which I can or should take into account. That being so the grounds of opposition based upon Section 12(1) are dismissed because the opponents withdrew all their earlier trade marks as the basis of such an objection (see para 24) and registration No. 1571156 was filed later and is not therefore a barrier to this application for registration.

32. Finally, I turn to the ground of opposition based upon Section 11 of the Act which states:

"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."

33. The established test for determining matters under Section 11 is that in *Smith Hayden's Application* (1946) 63 RPC 97, 101 as modified by *BALI TM* [1969] RPC 472, 496. In the present case this may be expressed as follows:

Having regard to the user of ST DUPONT, is the Tribunal satisfied that DU PONT if used in a normal and fair manner in connection with any such goods covered by the registration proposed, will not be reasonably likely to cause deception and confusion amongst a substantial number of persons

In *Sprints Ltd v Comptroller of Customs* (Mauritius) [2000] FSR 814 the Privy Council approved the test for likelihood of confusion enunciated by Lord Upjohn in *BALI*:

"As was recognised in the *BALI Trade Mark* case, all that is required to be proved for the purposes of the rejection of a registration is the probability of deception or confusion, which is more readily established than what would be required for a case of passing off. In the *BALI Trade Mark* case [1969] RPC 471, Lord Upjohn observed:

It is sufficient if the result of the registration of the mark will be that a number of persons will be caused to wonder whether it might not be the case that the two products come from the same source."

34. Mr Mellor submitted that the opponents' claimed use of their trade mark was very modest, which Mr Arnold accepted, and that there was no indication of which trade mark the opponents had in fact used by reference to the evidence. On this latter point Mr Arnold referred me to the catalogues exhibited by Mr Christie. But as these are undated (and one contains telephone numbers which post date 1 April 1995 when the 1 was introduced into the dialling code) they can not assist in determining that the trade mark in use in the period up to the date of application was the script form of ST DUPONT shown in the catalogue as shown below:



35. The invoices, provided by Mr Christie, also contain the above trade mark but these too are after the relevant date. In the circumstances I am not able to establish that the opponents have used the ST DUPONT trade mark in a form which unambiguously could be read as a DUPONT trade mark. This is because I note that the opponents have a number of registrations for their DUPONT trade marks some of which are signature trade marks, some are in script form and some have other distinctive matter with the DUPONT element. Thus, I can not assume that it is in fact the script form on which their claim to use can be based.

36. Mr Mellor also took a point on the modest use claimed and sales in only two locations, ie. Harvey Nichols stores in London and Leeds. This, he submitted, meant that even if the opponents had used a DUPONT trade mark the level and location of sales was such as to militate against the likelihood of deception amongst a substantial number of persons. This led to submissions from Mr Arnold, based upon BALI, and earlier authorities, to the effect that first user, whatever the quantity was all that was needed to be established. For the reasons given below, I do not need to deal with that point.

37. The established test for the comparison of trade marks is the well known test propounded by Parker J. in PIANOTIST Co's application 23 (1906) RPC 775. The relevant passage reads as follows:

"You must take the two words. You must judge of them both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion - that is

to say - not necessarily that one man will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public, which will lead to confusion in the goods - then you may refuse the registration, or rather you must refuse the registration in that case."

38. I am prepared to accept that the opponents had achieved sales in the United Kingdom of mens outerwear amounting to approximately £37,750 (if one accepts the full 1992/1993 sales figures given by Mr Christie in the period leading up to the date of application). But there is no clear evidence of what trade mark the opponents used. As indicated earlier in view of their registrations and the variety of trade marks they cover I am unable to infer that it is the ST DUPONT in script form that has been used, which would under the test set out above resemble the applicants' trade mark and therefore could result in the registration of the trade mark in suit causing a number of persons to cause to wonder whether the goods of the applicants and the opponents came from the same source. But if it was the signature trade mark of registration number 1571156, which was used by the opponents I do not consider that it resembles the applicants' trade mark at all. One would have to know that it spelled DUPONT before one could see the word in the signature.

39. Taking all of the above into account I reach the view that the opponents have not satisfied me that they have used a trade mark which could be said to resemble the applicants' trade mark. Thus, I do not consider that if registered and used in a normal and fair manner the applicants' trade mark is likely to cause deception and confusion amongst a substantial number of persons. The grounds of opposition based upon Section 11 are not made out.

40. All of the grounds of opposition having failed the applicants are entitled to an award of costs. I order the opponents to pay to the applicants the sum of £600. This sum is 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 07 day of December 2001

M KNIGHT
For the Registrar
the Comptroller-General