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

IN THE MATTER OF APPLICATION NO: 1571331 BY
S T DUPONT
TO REGISTER A TRADE MARK IN CLASS 25

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO:47871
BY E.I. DU PONT DE NEMOURS AND COMPANY

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BACKGROUND

1. On 6 May 1994, S T Dupont of Paris, France, applied to register the mark shown below in Class 25. The application No. 1571331, was examined and subsequently accepted in Part A of the Register for the following range of goods:

> "Articles of clothing, neckwear, headgear, swimwear, beachwear, dressing gowns and bath robes, socks, stockings, hosiery, panti-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.

I note that the publication of the application included the following text:

Proceeding because of prior rights in Registration No. 1571156 (6078,3886) and Registration of this mark shall give no right to the exclusive use of the letter "D".

Nothing hangs on these facts.

2. The application is opposed by E.I. du Pont de Nemours and Company of Wilmington, Delaware, United States of America. The opponents say that they are the proprietors of a range of trade marks consisting of or containing the word DUPONT and a list of the trade marks on which they rely is provided. They also say that they have made substantial use of their trade marks in the United Kingdom in relation to their goods and services such that the trade marks have become well known to the trade and the public as exclusively denoting the goods and services of E I du Pont and they have acquired an extensive goodwill and reputation in the trade marks in relation to those goods and services. Subsequently the

opponents indicated that they only intended to rely on application No 1523636 the details of which are shown below:

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.

Objection is said to arise therefore:

> - under Section 12(3) of the Trade Marks Act 1938, as the trade mark the subject of the application in suit so clearly resembles the opponents' trade marks as to be likely to deceive and cause confusion;
>
> - under Section 11 of the Trade Marks Act 1938 as use of the mark applied for in relation to the goods in respect of which the application is made is calculated to deceive or cause confusion and would be disentitled to protection in a Court of Justice.

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

4. Both sides seek an award of costs, both sides filed evidence and both sides ask for 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 Richard Arnold of Her Majesty's Counsel instructed by A A Thornton & Co their attorneys. The opponents were represented by Mr James Mellor of Counsel instructed by Marks & Clerk, their attorneys.

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

6. This consists of a statutory declaration dated 3 February 1999 by John Arthur Slater a partner in the firm of Marks & Clerk who are the opponents' 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 opponents.

7. 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 opponents in connection with their opposition to trade mark application No: 2008447 for the trade mark S T DUPONT (in script form) which also stands in the name of S T Dupont (the applicants here).

8. In her declaration 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.

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

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

10. 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. Ms Bowler goes on to state 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, but many are undated) which, says Ms Bowler, shows use of the trade mark DUPONT in relation to some of the articles of clothing mentioned above.

11. Since 1963 the annual turnover generated by the sales of articles of clothing under the DUPONT trade marks 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. Ms Bowler estimates that her company spends approximately £2m per year in the United Kingdom promoting the 'Du Pont' trade mark. Exhibit MEB6 consists of swing tickets, hang tags and labels showing how the trade mark is used in relation to clothing.

12. 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 are examples: Fabrics, London - 1992 and Clothes Show, London - 1993. The

opponents are also a member of the British Apparel and Textile Confederation and the Knitting Industries Federation.

Applicants' evidence

13. This consist of a statutory declaration dated 20 March 2000 by William R Christie. Mr Christie explains that he is the President of S T Dupont adding that he has held his present position for five years having been associated with the company since 1988. 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.

14. Mr Christie states that his company has used the trade mark S T DUPONT 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 applicants which, says Mr Christie, gives a flavour of the range of goods on which the trade mark S T DUPONT is and has been used.

15. 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 and 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 (all of which are after the material date) and which in Mr Christie's view shows sales of clothing items in the United Kingdom bearing the trade mark S T DUPONT, and a photograph of the S T DUPONT outlet located in Harvey Nichols, London.

16. 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 co-exists with the DUPONT trade mark of the opponents in respect of goods in Class 25 in a number of these countries and that to the best of his knowledge no action has been taken in any by the opponents.

17. Mr Christies observes that the trade mark the subject of the application in suit is a stylised signature in conjunction with the stylised letter D. He notes that the signature element (without the letter D) is already the subject of a United Kingdom trade mark registration under No: 1571156 in respect of identical goods in Class 25. A copy of the registration certificate is provided as exhibit D.

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

DECISION

19. The opposition is based upon Sections 11 and 12(3) of the Act which state:

> "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."

12.(1) .....

(2) .....

(3) Where separate applications are made by different persons to be registered as proprietors respectively of marks that are identical or nearly resemble each other, in respect of:-

a. the same goods

b. the same description of goods, or

c. goods and services or descriptions of goods and services which are associated with each other,

the Registrar may refuse to register any of them until their rights have been determined by the Court, or have settled by agreement in a manner approved by him or on an appeal (which may be brought either to the Board of Trade or to the Court at the option of the appellant) by the Board or the Court, as the case may be. "

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

Section 11

Having regard to the user of DUPONT, is the Tribunal satisfied that the stylised Dupont signature and D device 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?

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."

21. Both Mr Mellor and Mr Arnold were critical of each others clients' 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 clothing through two branches of a department store (Harvey Nichols in London and Leeds) for about 18 months prior to the date of application. But no indication had been given of which of the applicants' trade marks had been used. In their evidence the applicants showed that they had a range of trade marks 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.

22. 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, the 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.

23. The Exhibit MEB 4 attached to the copy of Ms Bowlers' 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.

24. 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?

25. 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 indicated that the socks contained LYCRA (and would therefore keep their shape) and that the swing tag might also indicate that Du Pont produced LYCRA. Thus the term Du Pont 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 but only in respect of those fibres (and fabrics).

26. Taking all the above into account I reach the view that the opponents have used their trade mark DUPONT but not on made up clothing but only in respect of the fabric or fibres from which those goods are made up. Thus the goods of the application in suit which are articles of clothing are not the same as those on which the opponents have used their DUPONT trade mark. But, as the applicants' goods - clothing can be made up from or incorporate the opponents goods - fibres and fabrics - they are goods of the same description (Panda (1946) RPC 59).

27. In all of the circumstances, the matter therefore resolves itself into a comparison of the trade marks themselves. In this respect, I refer to 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."

28. Whichever of the opponents' trade marks one considers in terms of comparison with the applicants' trade mark, the formers' are always clearly DUPONT trade marks whilst the trade mark in suit is shown below:-

29. The opponents' trade mark is in plain block capitals or in upper and lower case in some cases, the applicants' trade mark is a signature above which appears the letter D in script form. After careful analysis - or if one knows that it is a Dupont trade mark it is possible to read the signature as S T Dupont. But, as a matter of first impression I do not consider that the applicants' and the opponents' trade marks are similar. The signature trade mark of the applicants as I have already indicated requires in my view analysis to determine that it is a Dupont trade mark. To all intents and purposes it would be seen to most of the public as the device of a signature beneath a letter D. Therefore, taking account of imperfect recollection (Sandow (1914) 31 RPC 196) and my first impression (Kleenoff (1934) 51 RPC 129) and the fact that only goods of the same description are involved, I reach the view that the respective trade marks do not resemble each other at all. Certainly there is no resemblance sufficient to lead to the likelihood that a number of persons will be deceived or confused, or to wonder whether it might not be the case that the respective goods come from the same source.

30. Thus the grounds of opposition based upon Section 11 of the Act is dismissed.

31. As I have already held that the opponents' and the applicants' trade marks are not identical and do not nearly resemble each other the provisions of Section 12 do not apply and I do not need under the provisions of Section 12(3) to either order the parties respective rights to be determined by the Court or require a settlement by agreement. Thus, the applicants' trade mark, the opposition based upon Section 11 of the Act having been dismissed, may proceed to registration.

32. As the opponents have failed, the applications for registration are entitled to an award of costs in their favour. I therefore 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