

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2209438  
BY ESKANDAR LIMITED TO REGISTER A  
TRADE MARK IN CLASSES 20, 24 AND 25**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER  
NO 50711 BY ESCADA AG**

## **TRADE MARKS ACT 1994**

**IN THE MATTER OF Application No 2209438  
by Eskandar Limited to Register a  
Trade Mark in Classes 20, 24 and 25**

**and**

**IN THE MATTER OF Opposition Thereto Under  
No 50711 by Escada AG**

### **BACKGROUND**

1. On 23 September 1999 Eskandar Limited applied to register the trade mark ESKANDAR in Classes 20, 24 and 25 of the register for the following specifications of goods:-

**Class 20:**

Furniture, mirrors, picture frames, any goods of wood, cork, reed, bamboo cane, wicker and substitutes for all these materials, or of plastics; beds; bedding; covers; curtain tie backs; pillows; bolsters; cushions.

**Class 24:**

Textiles and textile goods; bed and table covers; bath linen; bed covers; loose covers for furniture; curtains; throws ; pillowcases; quilts; wall hangings of textile.

**Class 25:**

Clothing, footwear, headgear.

2. The application was accepted by the Registrar and published in the Trade Marks Journal.

3. On 16 February 2000 Marks & Clerk on behalf of Escada AG filed a Notice of Opposition. In summary the grounds were:-

- (i) Under Section 5(2)(b) of the Act because the mark applied for is similar to the following marks owned by the opponents which cover identical or similar goods and a likelihood of confusion exists on the part of the public - UK registration Nos 1355691, 1470899, 2013368, 2018550, 2040519, 1470900, 1108269, 1108272, 1470901, 2044062, 1496652, 1108270, 1108273, 1108271, 1108274, 1469554, 1470902 and 2033442. Also, International Registration Nos 672992, 683669 and 717852. Details of these registrations,

as supplied by the opponent in their Statement of Grounds, are at Annex One to this decision.

- (ii) Under Section 5(4)(a) of the Act by virtue of the law of passing off.
- (iii) Under Section 56 of the Act because the opponent's trade marks are well known trade marks within the meaning of Article 6 ter of the Paris Convention and use of the mark in suit by the applicant on identical or similar goods is likely to cause confusion.

4. On 22 May 2000 the applicants through their agents, Sceptre, filed a counterstatement denying the above grounds. Both sides have filed evidence and have asked for an award of costs in their favour. The matter came to be heard on 11 March 2002 when the applicants for registration was represented by Mr Tritton of Counsel instructed by Sceptre and the opponents by Mr Mellor of Counsel instructed by Marks & Clerk.

### **Opponent's Evidence**

5. This consists of a witness statement by Peter Steck dated 23 August 2000. Mr Steck is the Group General Counsel of Escada AG (the opponents).

6. Mr Steck states that the trade mark ESCADA was first created and used by his company in Germany in 1976 and since that date has been used continuously in various forms in relation to clothing and footwear, fashion items, jewellery, watches, articles made of leather (including bags, handbags, trunks, suitcases, wallets and purses), perfumery and cosmetics. He adds that the mark is famous for designer goods and at Exhibit A to his declaration are examples of labels and packaging showing use of the mark on a range of goods.

7. Turning to the UK., Mr Steck states that his company has used the mark since at least 1979 and he asserts that it has built up substantial reputation and goodwill in marks comprising ESCADA on a wide range of luxury goods and fashion goods generally.

8. Mr Steck claims that the turnover of goods sold under the ESCADA trade mark is significant and Exhibit C to his declaration comprises a schedule showing turnover figures for the Spring, Summer, Fall and Winter seasons of 2000, which, of course, fall outside the relevant date for these proceedings. The UK total figure is shown as 31,290,009 Deutch Marks.

9. Next, Mr Steck turns to the advertising and promotion of the ESCADA mark and at Exhibit D to his declaration are schedules showing the amount spent advertising and promoting the goods under the brand throughout the European Community for the winter period 1999/2000 and the summer 2000 period which, of course, fall outside the relevant date for these proceedings. The UK totals are given as 400,000 Deutch Marks for Winter 1999/2000 and 300,000 Deutch Marks for Summer 2000. Mr Steck goes on to state that his company advertises and promotes the mark particularly through well known glossy magazines and Exhibit E to his declaration comprises copies of articles and advertisement taken from European magazines and newspapers. Most of these publications are foreign but there are

advertisements under the ESCADA trade mark for clothes in Vogue Magazine in February 1991, February 1992, April 1993, March 1994 and August 1996. Furthermore, there are references to ESCADA clothing in an article on German fashion in Women's Journal dated September 1998, in an article about the Scottish designer Brian Rennie in the Sunday Mail of 26 July 1998 and also in an article in OK Magazine dated 25 September 1998.

10. Mr Steck states that it is common for fashion designers to extend their range of products into the home eg for textile products and furniture. He draws attention to other designers whom, he states have done this ie Paloma Picasso, Ralph Lauren, Christian Dior, Versace, Hermes, Laura Ashley, Paul Smith and Donna Kara, and he states offer for sale goods such as bed line, towels, cushions, wall coverings, carpets and porcelain, furniture etc.

### **Applicant's Evidence**

11. This consists of a witness statement by Eskandar Navabi dated 28 June 2001. Mr Navabi is the Managing Director and founder of Eskandar Limited (the applicant).

12. Mr Navabi states that the trade mark ESKANDAR was first used in the UK by his company in 1993 and he adds that ESKANDAR is also his forename. He explains that he started by designing knitwear but has now expanded into a full collection of clothing and fashion accessories, his "look" being described as "ethnic traditional". He adds that his first full collection was launched to the public in 1994 and in London he sells through exclusive shops. Mr Navabi asserts that his brand has a high profile in the UK and he states that his products are high quality, luxury items which are expensive and exclusive. He says they are not impulsive purchases and that at the exclusive end of the market, brands have a specific style and following. Mr Navabi goes on to state that the use of his first name, as opposed to his full name, is unusual, has drawn comment in fashion reviews and reinforces its impact. He concludes that his customers recognise his distinctive style and "look" and that as the products of ESCADA belong to a different fashion genre, it is unlikely that the customer would confuse one with the other. He is not aware of any actual instances of confusion.

13. Mr Navabi draws attention to the following samples of advertising material, literature, articles and reviews, photographs, catalogues etc. Regarding use of the mark ESKANDAR which are attached as Exhibit EN 1 to his declaration, most of which is after the relevant date for these proceedings and/or is outside the UK:-

TITLE	AUTHOR	DATE	PUBLICATION
a) "Eskandar - Winner of British Apparel Export Award for Womenswear - 2000"	British Export Awards	May 2001	Press Release
b) Press Release	Eskandar	21 May 2001	Press Release
c) "Portrait Eskandar"	Clara Young	Premiere Edition, Fall 2000	Bergdorf Goodman Magazine

d)	A World of Good	Julia Szabo	March 1999	
e)	Sustainable Style	Rebecca Voight	1998	View on Colour
f)	Beating a Path to Egg	Lucia van der Post		Weekend FT
g)	Eskandar en douce	Mimi Spencer		Vogue-French Ed
h)	Loosening Up on Slim Chic	Rebecca Voight	16 October 1998	Herald Tribune
i)	Light and Air	David Feld		InCircle entree
j)	Press Release			
k)	Patchwork Cashmere	[picture]		Elle
l)	Style Review		April 1995	Marie Clarie
m)	The Return of Alaia	Anne-Marie Schiro	2 September 1997	The New York Times
n)	Designer flair for size 16+		April 1996	Good Housekeeping
o)	Summer Essentials	[catalogue entry]		Bergdorf Goodman
p)	Effortless glide of black cashmere by Eskandar	[catalogue entry]		Bergdorf Goodman
q)	Hand knit cashmere	[catalogue entry]		Bergdorf Goodman
r)	Complete ease from Eskandar	[catalogue entry]		Bergdorf Goodman
s)	Designer draws influence from other countries	Nicole Volta Avery	21 April 2000	Detroit News (online)
t)	Photographs of Shop at 134 Lots Road			

14. Next Mr Navabi draws attention to Exhibit EN 2 to his declaration which comprises a testimonial from fashion retailer Bergdorf Goodman, who market both ESKANDAR and ESCADA products in the USA, in which Erin Kurpiewski, an Associate Buyer, states on behalf of Bergdorf Goodman that the collections of ESKANDAR and ESCADA are different enough that customers are not confused by the slight similarity of the names.

15. Turning to the applicant's turnover for goods provided under the mark, Mr Navabi provides the following information, which relates to world wide sales:-

<b>Year</b>	<b>Amount</b>
1997	£ 931,112 (year ended 30.6.97)
1998	£1,961,135 (year ended 30.6.98)
1999	£3,528,068 (year ended 30.6.99)
2000	£6,093,785 (year ended 30.6.00)
2001	£4,339,412 (8 months from 1.7.00-28.2.01)

16. On advertising and promoting the mark, Mr Navabi says that the total amount spent for the period 1 July 1998 to 28 February 2001 is as follows:-

<b>Year</b>	<b>Amount</b>
1999	£ 96,683 (year ended 30.6.99)
2000	£202,311 (year ended 30.6.00)
2001	£136,364 (8 months from 1.7.00-20.2.01)

17. He adds that the trade mark has received exposure through all forms of media including TV, radio, newspapers, magazines, posters and retail outlets and that Eskandar Limited has one retail outlet in the United Kingdom, in a prominent retailing site.

18. This completes my summary of the evidence filed in this case. I now turn to the decision.

## **DECISION**

19. At the hearing Mr Mellor withdrew the ground of opposition based upon Section 56 of the Act.

20. I turn first to the ground of opposition based upon Section 5(2)(b) which reads as follows:-

"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."

21. An earlier right is defined in Section 6, the relevant parts of which state:

"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."

22. I take into account the guidance 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.

It is clear from these cases that:-

- (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.

23. The reputation of a trade mark is an element to which importance may be attached in Section 5(2) considerations in that it may enhance the distinctive character of the mark at issue and widen the penumbra of protection afforded to such a mark. The opponents have filed evidence relating to the reputation of the mark ESCADA. While the figures relating to turnover and promotion under the mark relate to periods after the relevant date for this opposition ie. the application date of 23 September 1999, Mr Mellor submitted that the opponent's had used the mark in the UK for a considerable period and that the supporting evidence showed high profile promotion of the mark in prominent fashion periodicals such as Vogue. He added the high status of the mark, as demonstrated by high profile customers e.g. royalty and actresses, meant that ESCADA goods were highly desirable and that the mark would be known not only to customers but to the fashion conscious generally as an aspirational mark covering exclusive items of clothing and clothing accessories.

24. It seems to me that Mr Mellor's submissions on this point have much to commend them. The articles in the Woman's Journal and Mail on Sunday confirm his submissions and the evidence demonstrates the exclusive and celebrity status of the mark in relation to clothing and also shows that goods were sold under the mark prior to the relevant date through a number of well known UK outlets, including Selfridges, Harvey Nichols, Harrods and other House of Fraser stores. Despite obvious deficiencies in the supporting evidence I feel able in this particular case to infer on balance that the opponent has a reputation in the mark ESCADA in relation to clothing, in particular at the high fashion, exclusive end of the market and with the fashion conscious. I will take this into account. Furthermore, in addition to comparing the respective marks on the basis of their actual use I must also take into account notional and fair use of the respective marks across the full width of their specifications.

25. During the hearing Mr Tritton stated that the opponents have brought forward no instances of actual confusion, which should have been expected given that the applicants have used their mark prior to the relevant date both in the UK and in English speaking countries abroad. In response Mr Mellor pointed out that the applicants actual sales in the UK must be very light given that there are only two apparent outlets for their goods, the Egg shop in London and the applicants own shop which can be visited by appointment. In my view Mr Mellor has a point, the applicants use in the UK is modest and in the expensive, exclusive, designer end of the market. It is not surprising that no confusion has been shown in the UK. I do not intend to give any significant weight to this issue in my decision. I am not concerned with the situation outside the UK which, in my view, has no bearing upon these proceedings.

26. In essence, the test under Section 5(2)(b) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. In this case I accept that identical goods involved in Classes 25 and 24 and that the opponent's mark possesses a



reputation in relation to Class 25. However, it was held in *Marca Mode v Adidas AG* (2000) ETMR 723:

"The reputation of a mark, where it is demonstrated, is thus an element which, amongst others, may have a certain importance. To this end, it may be observed that marks with a highly distinctive character, in particular because of their reputation, enjoy broader protection than marks with a less distinctive character (*Canon*, paragraph 18). Nevertheless, the reputation of a mark does not give grounds for presuming the existence of a likelihood of confusion simply because of the existence of a likelihood of association in the strict sense."

27. In my consideration of whether there are similarities sufficient to show that a likelihood of confusion I am guided by the recent judgements of the European Court of Justice mentioned earlier in this decision. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural or conceptual similarity between the marks, evaluating the importance to be attached to those different elements, taking into account the category of goods in question and how they are marketed.

28. At the hearing I was informed that the word ESCADA is Portuguese for staircase and that the word ESKANDAR is the Persian name for Alexander. However, it was common ground that in the UK, among the average customer for the goods, both the mark applied for, ESKANDER, and the opponent's mark, ESCADA, would be perceived as invented words and as such, would possess a high distinctive character, which in the case of the opponent's registration should be taken into account in considering its penumbra of protection.

29. Turning to a comparison of the marks, it is clear that they must be compared as a whole, although in any comparison reference will inevitably be made to the distinctiveness and dominance of individual elements. It is, of course, possible to over analyse marks and in doing so shift away from the real test which is how marks would be perceived by customers in the normal course and circumstances of trade and I must bear this in mind when making the comparisons.

30. Firstly I turn to a visual comparison of the respective marks. The similarities and differences are plain to see. Both marks start with the letters ES and share the letter A as their fourth letter. The mark in suit ESKANDER consists of eight letters and the opponents mark ESCADA comprises six letters, with the third, and the final two letters differing. However, as mentioned earlier, my decision on similarity must be governed by overall impression and on this basis, after bearing in mind the potential for imperfect recollection, the respective marks look similar overall and in my view there is considerable scope for visual confusion.

31. In relation to aural use I believe the opponent's case to be stronger again. Both marks consist of three syllables and share the same beginning. Furthermore, it is widely accepted in relation to the spoken use of trade marks that customers have a propensity to slur the endings of words and on this basis the terminations of the respective marks ie. DER and DA, may be phonetically similar in the oral use of the marks.

32. Remaining on aural similarity, I also need to bear in mind the relevant consideration of the manner in which the customer will encounter and select the goods. As stated during the hearing, the goods of primary interest to both parties are clothing in Class 25 and in this regard, the following comments appeared in a recent Registry Decision (In the matter of Application No. 2001040 by React Music Limited to register a trade mark in Class 25 and in the matter of Opposition thereto by Update Clothing Limited under Number 45787):

'There is no evidence to support Ms Clarke's submission that, in the absence any particular reputation, consumers select clothes by eye rather than by placing orders by word of mouth. Nevertheless, my own experience tells me it is true of most casual shopping. I have not overlooked the fact that catalogue and telephone orders play a significant role in this trade, but in my experience the initial select of goods is still made by eye and subsequent order usually placed primarily by reference to a catalogue number. I am therefore prepared to accept that a majority of the public rely *primarily* on visual means to identify the trade origin of clothing, although I would not go so far as to say that aural means of identification are not relied upon.'

33. This view was supported on appeal to the Appointed Person (*REACT Trade Mark* [2000] 8 RPC 285, at 289 lines 22 to 26).

34. Taking into account, the above, while I believe there may be confusion in relation to aural use of the marks, I do not consider this to carry the same weight as the visual confusion which is likely to exist.

35. Next I turn to a conceptual comparison of the marks. As both marks consist of invented words then notwithstanding the visual and oral similarity, I do not see that there is much in the way of conceptual similarity. At the hearing Mr Mellor argued that because of the opponent's reputation, the mark ESCADA would conceptually equate to the opponent. This may be so but I do not believe it follows that the applicant's mark is therefore similar on a conceptual basis.

36. On a global appreciation and after taking into account the possibility of imperfect recollection, the overall similarities between the marks makes the possibility of confusion as a likelihood when the marks are used on identical Class 25 goods. I conclude that the opposition under Section 5(2)(b) succeeds in relation to Class 25.

37. I now go on to consider the Section 5(2) ground in relation to the goods falling within Classes 24 and 20 of the application.

38. The opponents have the following registration, (number 1108270) in Class 24 for "handkerchiefs":-

**ESCADA**

39. Although the letter S within the opponent's registration is slightly stylized the mark is, in my view, essentially an ESCADA mark and is visually and aurally similar to the mark in suit. Furthermore, the goods for which the opponent's Class 24 registration is registered (handkerchiefs) fall within the specification of the applicant's Class 24 goods which include, inter-alia, "textile goods". Accordingly the respective specifications in Class 24 cover identical goods.

40. On a global appreciation and after taking into account the possibility of imperfect recollection, the opposition under Section 5(2)(b) also succeeds in relation to Class 24 of the application.

41. Turning to the applicants Class 20 specification, I have considered the position in light of the guidelines formulated by Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 (Pages 296, 297) as set out below:

"The following factors must be relevant in considering whether there is or is not similarity:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of services;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in particular they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors."

42. Whilst I acknowledge that in view of the *CANON-MGM* judgement by the European Court of Justice (3-39/97) the *Treat* case may no longer be wholly relied upon, the ECJ said the factors identified by the UK government in its submissions (which are listed in *TREAT*) are still relevant in respect of a comparison of goods and services.

43. The opponents have no registrations in Class 20 and it seems to me that the registrations upon which they rely are for goods which are some way apart from those goods specified by the applicant in Class 20. The uses, users and physical nature of the goods are different, they would be found in different departments (when sold in the same shop) and they are not competitive. In my view the respective goods are not similar and as similarity of goods is pre-

requisite to a successful Section 5(2) case, this ground of opposition cannot succeed in relation to Class 20 of the application.

44. To conclude, the opposition under Section 5(2) of the Act succeeds in relation to Classes 24 and 25 of the application in suit, but not in relation to Class 20 where it fails.

45. In light of my decision on the Section 5(2) ground, I now go on to consider the ground of opposition under Section 5(4)(a) of the Act in relation to the goods specified in Class 20 of the application.

46. Section 5(4)(a) of the Act 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
- (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."

47. I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs WC in the WILD CHILD case (1998) 14 RPC 455. In that decision Mr Hobbs stated that:

"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) 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."

48. The date at which the matter must be judged is not entirely clear from Section 5(4)(a) of the Act. This provision is clearly intended to implement Article 4(4)(b) of Directive 89/104/EEC. It is now well settled that it is appropriate to look to the wording of the Directive in order to settle matters of doubt arising from the wording of equivalent provisions of the Act. It is clear from Article 4(4)(b) that the earlier right had to have been "acquired prior to the date of application for registration of the subsequent trade mark, or the date of the priority claimed .....". the relevant date is therefore the date of the application for the mark in suit.

49. Earlier in this decision I found, on balance, that the opponent has a reputation in the mark ESCADA in relation to clothing, in particular at the high fashion, exclusive end of the market and with the fashion conscious. However, I also pointed out that there were obvious deficiencies in the supporting evidence (paragraphs 23 and 24 of my decision refer) and I am uncertain as to the extent of the opponent's reputation.

50. In essence the question I have to address is whether the relevant public seeing the applicant's mark used on "furniture, mirrors, picture frames, any goods of wool, cork, reed, bamboo cane, wicker and substitutes for all these materials, or of plastics; beds; bedding; covers; curtain tie backs; pillows; bolsters; cushions" would be likely to believe the goods were being offered by the opponent.

51. In my view the respective marks are visually and aurally similar. However, on the evidence before me the opponent's reputation is limited and I also have no evidence as to whether the public associate clothing and household goods such as furniture and containers. At the hearing, Mr Mellor submitted that a move from clothing into such goods would be a natural brand extension exercise and it is common knowledge that high street retailers such as Marks & Spencer, Next, John Lewis and British Home Stores operate in both fields. While there is some merit in these submissions, they are in my view far from conclusive. Marks & Spencer, John Lewis and British Home Stores are active in a wide number of retail areas. I have no independent evidence before me on the point and on the face of it, clothing and furniture etc. are very different products. In the absence of any persuasive evidence to the contrary I do not consider that the opponent's goodwill will extend to the goods covered within Class 20 of the application and in my view the applicant's use of their mark on these goods will not amount to a misrepresentation.

52. In the recent case of South Cone Inc. v Jack Bessant, Dominic Greensmith, Kenmy Gary Stringer (a partnership) 16 May 2001, Pumfrey J. in considering an appeal from a decision of the Registrar to reject an opposition under S5(4)(a) said:

*"There is one major problem in assessing a passing off claim on paper, as will*

*normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s 11 of the 1938 Act (\*see Smith Hayden (OVAX) (1946) 63 RPC 97 As qualified by BALI [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.*

*Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date."*

53. I do not consider that the opponent has discharged the onus of showing that the necessary misrepresentation required by the tort of passing off will occur in relation to the goods specified within Class 20 of the application and the opposition under Section 5(4)(a) fails.

54. As a result of my decision that the opposition is only successful in relation to Classes 24 and 25 of the application the applicant may, within one month from the expiry of the appeal period from the decision, file a Form TM21 to delete these Classes from the application. If no Form TM21 is filed the application will be refused.

55. In the main, the opposition has been successful. I consider, therefore, that the opponents are entitled to a contribution towards their costs. I order the applicant's to pay the opponents the sum of £450. 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 22 day of April 2002**

**JOHN MacGILLIVRAY  
For the Registrar  
the Comptroller-General**

## TRADE MARK ACT 1994

**IN THE MATTER OF U.K. Trade Mark Application  
No. 2209438 ESKANDAR in classes 20, 24 and 25  
in the name Eskandar Limited - and -  
Opposition thereto by Escada AG**

*Schedule 1 to the Statement of Grounds of Opposition*

U.K. Regn 1355691	ESCADA	class 3	24 August 1988	Jnl 5831,4067
U.K. Regn 1470899	ESCADA BY MARGARETHA LEY	class 3	17 July 1991	Jnl 5933,5396
U.K. Regn 2013368	ESCADA ACTE 2	class 3	8 March 1995	Jnl 6097,8706
International Regn 672992 designating U.K.	ESCADA COLLECTION	class 3	23 October 1997	Protected
U.K. Regn 2018550	ESCADA & device	class 9	25 April 1995	Jnl 6107,11587
U.K. Regn 2040519	ESCADA	class 9	7 October 1995	Jnl 6116,2074
U.K. Regn 1470900	ESCADA BY MARGARETHA LEY	class 9	17 July 1991	Jnl 5934,5588
U.K. Regn 1108269	ESCADA & device	class 18	25 January 1979	Jnl 5365,1609
U.K. Regn 1108272	ESCADA & device	class 18	25 January 1979	Jnl 5499,214
U.K. Regn 1470901	ESCADA BY MARGARETHA LEY	class 18	17 July 1991	Jnl 5933,5448
U.K. Regn 2044062	ES ESCADA SPORT & device	class 18	3 November 1995	Jnl 6120,3216
International Regn 683669 designating U.K.	ESCADA & device	class 18, 25	23 October 1997	Protected
U.K. Regn 1496652	ESCADA	class 21	18 March 1992	Jnl 5965,1424

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U.K. Regn 1108270	ESCADA (stylised)	class 24	28 January 1979	Jnl 5470,1555
U.K. Regn 1108273	ESCADA & device	class 24	25 January 1979	Jnl 5471,1625
U.K. Regn 1108271	ESCADA (stylised)	class 25	25 January 1979	Jnl 5534,3569
U.K. Regn 1108274	ESCADA & device	class 25	25 January 1979	Jnl 5534,3570
U.K. Regn 1469554	ESCADA	class 25	2 July 1991	Jnl 5950,8424
U.K. Regn 1470902	ESCADA BY MARGARETHA LEY	class 25	17 July 1991	Jnl 5937,6080
U.K. Regn 2033442	ESCADA ELEMENTS (Stylised)	class 25	13 September 1995	Jnl 6122
International Regn 717852 designating U.K.	ESCADA SPORT (stylised)	class 25	7 June 1999	Pending

