

O-197-04

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2291675  
BY SPIRIT GROUP LIMITED TO REGISTER  
A TRADE MARK IN CLASSES 14, 16, 18, 21, 25, 28, 29, 30,  
32, 33, 34, 35, 36, 37, 41, 42 AND 43**

**AND**

**IN THE MATTER OF OPPOSITION No. 91212  
BY ESPRIT INTERNATIONAL**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF Application No. 2291675  
by Spirit Group Limited to register a Trade Mark  
in Classes 14, 16, 18, 21, 25, 28, 29, 30, 32, 33, 34, 35,  
36, 37, 41, 42 and 43**

**and**

**IN THE MATTER OF OPPOSITION No. 91212  
by Esprit International**

**Background**

1. On 2 February 2002 Spirit Group Limited applied to register the following mark:



2. For the sake of completeness I set out below the full range of goods and services in respect of which application has been made (though as will be noted below the opposition is not in respect of all goods and services):

**Class 14:**

Tankards, tiepins, cufflinks, badges, all of precious metal.

**Class 16:**

Printed matter, printed publications, magazines; posters and prints; stationery; bags; paper and cardboard; books, calendars, paper ornaments, postcards, transfers, albums, boxes, cards, pens and pencils; instructional and teaching materials; diaries; office requisites; packing materials; labels; stickers; beer mats of paper and card; menus; serviettes.

**Class 18:**

Rucksacks, travelbags, sportsbags, umbrellas; luggage and cases.

**Class 21:**

Glassware, mugs, dinnerware, articles of porcelain and earthenware; textile beer cloths; small domestic utensils and containers.

**Class 25:**

Articles of clothing, including t-shirts, sweatshirts, coats and headgear.

**Class 28:**

Board games, dominoes, draughts and other games and playthings.

**Class 29:**

Meat, fish, poultry and game; sea foods; fruit and vegetables, all being preserved, dried, cooked or processed; preparations made from all the aforesaid goods; dairy products; mousses, chilled desserts; milk drinks; flavoured milk drinks; drinks made from dairy products; soups; sweet spreads, savoury spreads; salads; drinks, fillings, snack foods; prepared meals and constituents for meals; proteinaceous substances; dips.

**Class 30:**

Snacks, snack foods; snack bars; prepared meals and constituents for meals; cereals and cereal preparations; non-medicated confectionery; pastries, cakes, biscuits; fillings; sweet spreads; savoury spreads; chocolate; pizzas, pizza bases; sauces and toppings for pizzas; sauces; dips; poppadums; tea, coffee and other beverages included in class 30; desserts; sauces; spices.

**Class 32:**

Beers and non-alcoholic beverages including fruit drinks and mineral water.

**Class 33:**

Alcoholic beverages (other than beers).

**Class 34:**

Ashtrays; cigarettes and tobacco; lighters and matches.

**Class 35:**

Business administration and business management services; personnel services; business consultancy

**Class 36:**

Real estate management; leasing of properties including public houses and advice pertaining thereto; real estate services; sporting sponsorship.

**Class 37:**

Property maintenance and repair; property construction.

**Class 41:**

Entertainment services, including nightclub services; training services; conference services; organisation of seminars; competitions; on line publications; provision of amusement facilities.

**Class 42:**

Legal services.

**Class 43:**

Public house services; bar services; restaurant services; provision of temporary accommodation.

3. The above takes account of a number of changes that have been made to the Class 14 specification during the conduct of the proceedings.

4. On 31 October 2002 Esprit International filed notice of opposition to this application. They are the proprietors of what they call various ESPRIT and ESPRIT derivative marks, brief details of which are shown in the Annex to this decision.

5. The opponents object under Section 5(2)(b) on the basis of similarity in the marks along with identity and/or similarity in the goods and services in a likelihood of confusion. In relation to the marks they say:

“The dominant component of Trade Mark Application 2291675 SPIRIT GROUP is clearly the element SPIRIT. Conceptually, this is identical to the opponent’s earlier trade marks ESPRIT, ESPRIT being the well-understood French word for “spirit”. The addition of a circle device above the “I” of SPIRIT and GROUP placed below the first “I” of SPIRIT are essentially non-distinctive elements which do not take away from the overall impression of the mark which is clearly the word SPIRIT.”

6. The opposition is against certain Classes only. Paragraph 3 of the statement of grounds refers to these as being Classes 14, 16, 18, 21, 28, 35 and 43. A subsequent reference to Class 42 must, I think, be a misprint as the subsequent detailed explanation of the basis of objection against each of these Classes contains no reference to Class 42. Nevertheless there is a subsequent expansion of the goods Classes which are objected to. I will come to this below.

7. In relation to the precise goods and marks relied on to sustain this opposition the opponents say:

“UK Application No. 2291675 SPIRIT GROUP covers articles of precious metal including tankards, tie pins, watches and jewellery in Class 14. It will be noted that these are identical and similar goods to those covered by UK Registrations 2139446 ESPRIT DE CORP, UK Trade Mark Registration 1272029 ESPRIT, UK Trade Mark Registration 2256568 ESPRIT SPORTS, UK Registration 1434597 esprit, UK Registration 2102647 ESPRIT TIMEWEAR, CTM Registration 151027 ESPRIT, CTM Registration 151126 ESPRIT and UK Registration 1162506 ESPRIT.

In Class 16, UK Trade Mark Application 2291675 covers printed matter, printed publications, magazines, posters and prints, stationery, bags, paper and cardboard, books, calendars, paper ornaments, postcards, transfers, albums, boxes, cards, pens and pencils, instructional and teaching materials, diaries, office requisites, packing materials, labels, stickers, beer mats of paper and card, menus and serviettes. These are identical and similar goods to those covered by UK Trade Mark 2139446 ESPRIT DE CORP, 1243016 ESPRIT, 1515183 ESPRIT and 2161819B ESPRIT.

In Class 18, UK Trade Mark 2291675 SPIRIT GROUP covers rucksacks, travel bags, sports bags, umbrellas, luggage and cases. These are identical and similar goods to those covered by UK Trade Mark 2139446 ESPRIT DE CORP, 11130766 ESPRIT, 2256568 ESPRIT SPORTS, 1243017 ESPRIT, 2278166 ESPRIT E-CLUB and CTMs 151027 ESPRIT and 151026 ESPRIT.

In Class 21, UK Trade Mark 2291675 covers, glassware, mugs, dinnerware, articles of porcelain and earthenware, textile beer cloths, small domestic utensils and containers. These are identical and similar goods to those covered by UK Trade Mark 2139446

ESPRIT DE CORP, 2161819A ESPRIT, 1243019 ESPRIT and CTMs 467050 ESPRIT and 470377 ESPRIT.

UK Trade Mark No. 2291675 SPIRIT GROUP covers articles of clothing including T-shirts, sweat shirts, coats and headgear in Class 25. It will be noted that these are identical and similar goods to those covered by the following UK trade mark registrations – 2256568 ESPRIT SPORTS, 2278166 ESPRIT e CLUB, 1084022 ESPRIT, 1084023 ESPRIT DE CORP, 1127619 ESPRIT DE CORP, 1127620 ESPRIT, 1179743 ESPRIT SPORT, 1298217 ESPRIT ESPRINDILLE, 1376897 ESPRIT BASICS.

In Class 28, UK Trade Mark Application 2291675 SPIRIT GROUP covers board games, dominoes, draughts and other games and playthings. These are identical and similar goods to those covered by UK Trade Mark Nos. 2139446 ESPRIT DE CORP and 1272030 ESPRIT.

In Class 35, UK Trade Mark Application 229175 SPIRIT GROUP covers business administration and business management services; personnel services; business consultancy. These are identical and similar services to those covered by UK Trade Mark Nos. 2139446 ESPRIT DE CORP and 1277340 ESPRIT.

In Class 43, UK Trade Mark Application 2291675 covers public house services, bar services, restaurant services, provision of temporary accommodation. These are identical and similar services to those covered by UK Trade Mark 1294586 ESPRIT and CTM Nos. 1390061 ESPRIT and 1390657 ESPRIT.”

8. It will be noted that the above detailed explanation of the basis of objection includes Class 25 which is not previously mentioned.

9. The opponents also extend their objection to certain other Classes as follows:

“In so far as UK Trade Mark Application No. 2291675 SPIRIT GROUP [sic] covers goods in Classes 29, 30, 32 and 33, it is submitted that these are similar goods to the bar services and restaurant services covered by the opponent’s UK Trade Mark 1294586 ESPRIT and CTM Nos. 1390061 ESPRIT and 1390657 ESPRIT.”

10. The net effect is that the opposition is against Classes 14, 16, 18, 21, 25, 28, 29, 30, 32, 33, 35 and 43.

11. There is one other matter I should refer to. The opponents submit that they have a family of ESPRIT marks at UK and CTM level.

12. A counterstatement was filed by Punch Retail (Managed) Limited. I am not clear what relationship this company is to the actual applicants though I note that they share the same address. The point does not appear to have been of concern to the opponents.

13. The applicants say that the respective marks are visually, phonetically and conceptually quite different. In particular they deny that the word SPIRIT is conceptually identical to the word ESPRIT. They deny that the French word ESPRIT is well understood as meaning 'spirit' and they put the opponents to proof on this matter. In relation to Classes 18, 21, 25, 28 35 and 43 they concede that identical or similar goods are involved. They make a partial concession in relation to similarity as regards the following Class 16 goods "printed matter, printed publications, magazines, posters and prints, stationery, paper and cardboard, books, calendars, pens and pencils, diaries, menus". They deny similarity in relation to the remaining goods. They deny that their goods in Classes 29, 30, 32 and 33 are similar to the bar and restaurant services covered by the opponents' earlier trade marks. They make no comment in relation to the Class 14 goods.

14. Both sides ask for an award of costs in their favour. Both sides filed evidence. The parties elected to file written submissions in lieu of a hearing. These have been supplied under cover of D Young & Co's letter of 16 April 2004 (on behalf of the opponents) and in a letter dated 20 April 2004 from Castles (on behalf of the applicants). Acting on behalf of the Registrar and with the above material in mind I give this decision.

#### **The evidence**

15. The evidence filed in this case is as follows:

##### **Opponents' evidence in chief:**

Affidavit by Ronald J. Lehrman with Exhibits 1-11

##### **Applicants' evidence in support:**

Statutory Declaration by Derek Walmsley

##### **Opponents' evidence in reply:**

Witness Statement by Angela Claire Thornton-Jackson with Exhibits ACTJ1 – ACTJ3  
Affidavit by Ronald J. Lehrman

##### **Applicants' further evidence**

Witness Statement by Derek Walmsley

16. I do not propose to offer a full summary of the exchanges. Mr Lehrman's evidence goes to the history and reputation of the ESPRIT brand. The other pieces of evidence consist in the main of submissions in relation to the opponents' underlying claims and further substantiation of those claims. I infer that the evidence is intended to bolster the distinctive character of the opponents' ESPRIT brand.

17. In so far as the United Kingdom is concerned the main points to emerge from M Lehrman's evidence are that:

- the opponents began applying the ESPRIT trade mark to apparel as early as 1990 in the UK;
- catalogues for the years 1998 to 2002 (at Exhibit 4) mainly show clothing and footwear items;
- there are in excess of 45 retail shops in the UK currently stocking ESPRIT products. Exhibit 8 in support of this claim shows that these are a mixture of own stores, licenses and 'shop in shops'. I note that many are in or associated with major retail chains such as House of Fraser and John Lewis. They are also located at prestigious sites such as Regent Street and some of the well known retail parks and are spread throughout the UK;
- advertisements are placed in publications with international circulation such as Vogue, Esquire, Rolling Stone, Elle, Vanity Fair etc. Copies of articles and advertisements are shown at Exhibit 9. Copies of articles from leading trade and business publications are shown at Exhibit 10;
- there is also an internet site, print-outs from which are shown at Exhibit 11.

18. In addition Mr Lehrman gives figures for Esprit's worldwide turnover for the years 1996 to 2002 and information on the expansion of the company's trade in Europe and the rest of the world.

19. The relevance of these general claims is questioned by Mr Walmsley, the applicants' Company Secretary in his evidence. He notes that the sales figures are not broken down by country or by product. A European sales figures is given for 2002 but again is not further broken down and, I might add, is of dubious relevance in terms of the material date in these proceedings.

20. In his second affidavit Mr Lehrman seeks to address some of these points. He provides the following table of information for the period 1995/6 to 2001/02 (data for 1998/99 and 1999/2000 is not available).

	95/96	96/97	97/98	98/99	99/00	00/01	01/02
TURNOVER	9,952	8,667	6,410	-	-	779	8,004
ADVERTISING	380	541	105	-	-	411	576

All figures are provided in thousands of pounds sterling.

21. Mr Lehrman also reiterates that reliance is placed on Esprit's international reputation extending to the UK:

“I would, however, also respectfully submit that, of course, international reputation includes reputation extending to the United Kingdom. I would refer to my earlier Affidavit dated 13 March 2003 where I attach, at Exhibit 9, press clippings of major European and UK newspapers and magazines which have featured the Opponent’s ESPRIT brand. I have already confirmed that most of the publications referred to in my earlier Affidavit at paragraph 17 are readily available in the United Kingdom, including in particular, Glamour, Elle, 17, In Style and Good Housekeeping, all of which are British publications. Such usage is clearly relevant in establishing use and reputation of the ESPRIT brand in the United Kingdom.”

22. I accept that advertisements, ‘advertorials’ and other press coverage of a mark in magazines that enjoy an international reputation can assist in increasing awareness of a mark to the extent that exposure extends to the UK. But the opponents’ evidence in this respect is not convincing in the substantiating detail. Much of the material in Exhibit 9 (referred to specifically by Mr Lehrman) is of uncertain date and a significant portion is after the material date; local in nature (e.g. Metro- ‘Santa Clara Valley’s Weekly Newspaper, San Francisco Focus, the Cleveland Plain Dealer); in foreign languages; and containing brief references only to Esprit which somewhat reduces the overall impact. Even accepting that some of this material is relevant does not advance the opponents’ case to an appreciable extent.

23. As can be seen from the Annex to this decision the opponents have a large number of UK and CTM registrations covering a variety of marks and a large number of goods Classes. Mr Lehrman makes a similarly broad claim in relation to Esprit’s trading activities. Thus:

“Esprit is a fashion and lifestyle company that designs, produces and markets a wide variety of casual fashion clothing, footwear, headgear and accessories, bed and table covers, bedding, towels, and textile articles, carrying cases, handbags, purses, belts, wallets, eyewear and watches for women, men and children, and tableware under our well known ESPRIT trademarks.”

There has been no attempt to provide disaggregated figures showing a breakdown of the UK turnover as between the various categories of goods. My impression is that the sales figures largely relate to clothing under the mark ESPRIT. The extent of trade in relation to other goods and under other ESPRIT (family) marks is simply not clear.

24. There is other evidence which goes to the meaning of the word ESPRIT. I will draw on this in my decision below.

### **The law**

25. The Action has been brought under Section 5(2)(b) of the Act which reads as follows:

“(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.”

26. I take into account the well established 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] R.P.C. 117, *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.

27. According to these authorities the visual, aural and conceptual similarities of the marks must be assessed by reference to their overall impressions bearing in mind their distinctive and dominant components (*Sabel v Puma*, paragraph 24). The matter must be judged through the eyes of the average consumer who is deemed to be reasonably well informed, circumspect and observant (*Lloyd Schuhfabrik v Klijsen*, paragraph 27).

28. As the applicants have accepted that, in the contested Classes, there are, in large measure, identical or similar goods it follows that my view on the respective marks is likely to be critical to the outcome of the case.

29. The opponents have a large number of marks registered and rely in part on a ‘family of marks’ claim.

30. I will firstly consider their claim based on the word ESPRIT as the case has mainly been conducted on the basis that it is this word or element that supports the claim in relation to similarity of marks.

31. The comparison is thus between:

**Applicants’ mark**



**Opponents’ mark**

ESPRIT

32. In their written submissions the opponents suggest that the dominant component of the applied for mark is the word SPIRIT and that that word shares a substantially similar letter sequence to that of ESPRIT. Phonetically, it is said that the final T of ESPRIT would be silent, however the SP and RI sounds are common to the marks. Conceptually, the opponents say that ESPRIT is identical to SPIRIT being the well understood French word for spirit. In this latter respect Mr Lehrman exhibits dictionary extracts confirming the meaning of the word and

showing that the word 'esprit' has taken its own place in the English language. By way of example he cites the expression 'esprit de corp'.

33. The applicants, for their part, submit that, whilst SPIRIT and ESPRIT contain a number of common components they differ in respect of their important and memorable first elements. They suggest that the pronunciation of ESPRIT will be given a French slant which phonetically distances it from that of SPIRIT. In relation to the meaning of ESPRIT the applicants suggest that use is confined to phrases which are only occasionally used in English speaking countries. They say it is significant that there appear to be no instances of usage of ESPRIT on its own. They also remind me that I must consider the totality of the applied for mark including the 'halo' device and not just the word SPIRIT. They also suggest that the average consumer for the goods at issue will pay reasonably close inspection to purchases.

34. I will start with some general observations on the respective marks. The opponents are quite correct to say that the word ESPRIT has found its way into English language dictionaries. That is not, of course, the same as saying that it is particularly well known or frequently used. Without evidence on the point I am inclined to think that it is the subject of occasional rather than regular use. I would be prepared to accept that its most commonly used and understood manifestation is in its expression 'esprit de corps'.

35. The opponents' marks in their various manifestations are based mainly on the word ESPRIT. I find that word/element to be wholly distinctive in relation to the goods and services for which it is registered. To the extent that that position is capable of being still further improved through use then, on the basis of the material before me, it would only be in relation to clothing. But this is not in my view a case where acquired distinctiveness is likely to tip the balance between failure and success.

36. The applicants' mark is a composite one consisting of the word spirit in lower case the word GROUP (in upper case) and what has been described as a halo device surmounting the word spirit. Whilst the word GROUP may be of little, if any, distinctive character in its own right being an indicator of corporate status, its interaction with the word SPIRIT must not be ignored.(cf Jacob LJ's observations on the composition of the mark Reed Business Information in *Reed Executive plc v Reed Business Information Ltd*, 2004 WL343610, Jacob at paragraphs 38 and 39). He was there considering the issue of identity of marks but the underlying point is that words that are non-distinctive in nature are not simply ignored by consumers. In this particular case the presence of the word GROUP (albeit that it is not as prominent as SPIRIT) serves to qualify the word SPIRIT in the sense that the totality creates the notion of a corporate entity. That is not to say that the word SPIRIT is not the dominant and most memorable element of the mark but it must not be treated as if it were the only element.

37. With these preliminary observations in mind I turn to the visual, aural and conceptual comparison of the marks.

38. The opponents are correct to point out that the word ESPRIT and the element SPIRIT have certain letter strings in common. But, even if the matter rested purely on a visual comparison of these words alone the presence of the initial letter E will not go unnoticed bearing in mind the

long accepted maxim that particular attention is usually paid to the start of words. The word SPIRIT is itself a common word of the English language and I can see little danger of it being mistaken with the word ESPRIT. The comparison is, of course, not simply between ESPRIT and the word SPIRIT albeit that the latter is the most memorable element of the applied for mark. There is no reason to suppose that consumers would ignore or fail to notice the other elements of the applicants' mark, namely the device and word GROUP. Visual similarity is, therefore, in my view at a relatively low level.

39. Phonetically, too, I find the marks to be readily distinguishable. ESPRIT has the look and feel of a French language word. The fact that it appears in English language dictionaries does not detract from that fact. I approach the matter on the basis that ESPRIT is a two syllable word with the stress on the second syllable and a silent final 'T'. SPIRIT will have its normal pronunciation that is to say with two syllables and the stress on the first syllable. With these differences in mind and the totality of the applied for mark to consider the case for aural similarity is very weak.

40. Conceptual considerations appear to me to give the opponents' their strongest case. I agree that one of the meanings of SPIRIT coincides with the meaning of the word ESPRIT. Indeed, what I take to be the most common usage of the word, in the phrase 'sprit de corps' may be loosely translated as 'group spirit'. If the expression has been so thoroughly assimilated into the English language as the opponents suggest then the likelihood is that it will be used without thought as to its translated meaning. Nevertheless I think it is right to assume that some people encountering the word ESPRIT will, subconsciously at least, translate it. To the extent that that is the case they may also make the conceptual connection with the word SPIRIT. Though whether they would actually do so is far from certain. But it remains the case that the applicants' mark is SPIRIT GROUP and device. The fact that the mark in its totality projects a corporate identity will not be lost on the average consumer. I, therefore, take the view that there is some conceptual similarity between the marks but that the effect is mitigated by the overall impact of the applied for mark and the fact that consumers are not generally credited with undertaking the sort of analysis that would be required to draw attention to conceptual similarity.

41. Most of the goods and services that are the subject of objection are what one might loosely call consumer goods. The extensive range of goods and services includes some items that will be low value purchases and others that will be more expensive and the subject of rather greater care in the purchasing process. It also seems to me that visual and to a lesser extent oral/aural considerations will be to the fore. These are factors to be borne in mind when taking a global view of the likelihood of confusion. I also bear in mind imperfect recollection though it does not seem to me to be a matter of overriding importance where dictionary words are concerned. Taking all the above factors into account I have little hesitation in concluding that there is no likelihood of confusion even allowing for the fact that the marks may be used on identical goods.

42. The evidence and submissions from the parties has largely been conducted on the basis that the opponents are relying on their registration of the word ESPRIT or marks incorporating that element. They also have registrations of the mark ESPRI. However, these registrations are for goods in Classes 3 and 5 and do not appear to offer the opponents any better prospect of success in terms of marks and goods.

43. I should also briefly refer to a vacant form of presentation of the word ESPRIT as follows:

The image shows the word "ESPRIT" in a bold, black, stencil-style font. The letter 'E' is composed of three horizontal bars. The letter 'S' is a simple, rounded shape. The letter 'P' has a vertical stem and a curved top. The letter 'R' has a vertical stem and a curved top. The letter 'I' is a simple vertical bar. The letter 'T' has a vertical stem and a horizontal top bar. The overall appearance is that of a stencil or a blocky, industrial font.

44. This mark is registered in relation to goods which are identical to those of the application in suit. The ‘stencil-style’ presentation produces a mark that on casual acquaintance might be said to produce something closer to the word SPIRIT if the ascender of the letter R was also seen as performing a dual function as an I as well. It might be open to argument as to whether the first element of the mark was seen as a stylised letter E or simply as an abstract device.

45. However, I do not understand the opponents to place reliance on any such arguments. It follows that the applicants have not sought to defend their position in this regard. Although there may be some doubt about the precise impact of the first element (letter or device), the overall presentation is in a uniform and coherent style which itself is a feature of the mark. Again, therefore, I find that there is no likelihood of confusion.

46. There is one final matter I must deal with and that is the opponents’ claim to a family of marks. The concept of a family of marks is not a new one and can be found in *Beck Koller & Company (England) Limited’s* application, a case under the preceding law reported in [1947] RPC 76 (see in particular page 83). The applicability of the family of marks principle under the current Act was considered in *The Infamous Nut Co Ltd’s Trade Marks*, [2003] RPC 7 where Professor Annand, sitting as the Appointed Person, commented as follows:

“It is impermissible for s.5(2)(b) collectively to group together several earlier trade marks in the proprietorship of the opponent.

Section 5(2)(b) speaks of registration being refused on the basis of an earlier trade mark (as defined by s.6). Thus where the opponent relies on proprietorship of more than one earlier trade mark, the registrability of the applicant’s mark must be considered against each of the opponent’s earlier trade marks separately (*ENER-CAP Trade Mark* [1999] R.P.C. 362).

In some circumstances, it may be possible for the opponent to argue that an element in the earlier trade mark has achieved enhanced distinctiveness in the eyes of the public because it is common to a “family of marks” in the proprietorship and use of the opponent (*AMOR*, Decision no. 189/1999 of the Opposition Division, OHIM O.J. 2/2000, p.235). However, that has not been shown by the evidence to exist in the present opposition and cannot, as contended by Mr Walters on behalf of the opponent, be presumed from the state of the register in Classes 29 and 31.”

47. Further guidance can be found in *Torremar Trade Mark* [2003] RPC 4:

“At this point it is necessary to observe that marks which converge upon a particular mode or element of expression may or may not be found upon due consideration to be distinctively similar. The position varies according to the propensity of the particular mode or element of expression to be perceived, in the context of the marks as a whole, as origin specific (see, for example, *Wagamama Ltd v City Centre Restaurants Plc* [1995] F.S.R. 713) or origin neutral (see, for example *The European Ltd v The Economist Newspaper Ltd* [1998] F.S.R. 283).

The relevant propensity may, on established principles, be inherent or acquired through use. This leaves room for evidence demonstrating that the mode or element of expression in question has an established significance which the average consumer would take to have been carried through to the marks in issue.

The view that the established significance is origin specific may be supported by evidence directed to the way in which the mode or element of expression has been used as the basis for a “family” of distinctively similar marks: *Duonebs Trade Mark* January 2, 2001 SRIS O/048/01 (Mr Simon Thorley Q.C.); *The Infamous Nut Company Ltd’s Application* September 17, 2001 SRIS O/411/01 (Professor Ruth Annand); *Lifeforce International Inc.’s Application; Opposition of Novartis Nutrition AG* [2001] E.T.M.R. 106, p.1227 (Opposition Division, OHIM). The view that the established significance is origin neutral may be supported by evidence directed to the way in which the mode or element of expression has been used by traders and consumers more generally.

In neither case can the proposition in contention be substantiated simply by evidence of entries in the register of trade marks: entries in the register do not in themselves affect the way in which marks are perceived and remembered.”

48. It is thus a pre-requisite in establishing a family of marks that the claimant demonstrates use. It is only by use of marks with a common element that the public may come to attach significance to that element.

49. The opponents’ evidence is not helpful in terms of relevant detail. As is apparent from the Annex to this decision they rely on a large number of registrations and covering a range of goods and service Classes. But the turnover figures and other trading information do not distinguish between the marks used and the goods in relation to which they are used. My strong impression is that most of the use is of the mark ESPRIT or that word in stylised form (what I have called the stencil mark) and then substantially in relation to clothing.

50. If or to the extent that other of the registered marks have been used they are unlikely to advance the opponents’ case as they are simply the word ESPRIT combined with other often descriptive words such as SPORTS, COLLECTION, BASIX etc. Even with better and more detailed information on the use of these marks I doubt that it would materially advance the opponents’ case.

51. Accordingly the opposition fails under Section 5(2)(b). The applicants are entitled to a contribution towards their costs. I order the opponents to pay them the sum of £1500. 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 7<sup>th</sup> day of July 2004**

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





## ANNEX






Earlier trade marks relied on by the opponents (UK unless otherwise stated):

No.	Mark	Class
853709	ESPRI	03, 05
1134724	ESPRI	03
1175860	ESPRI	03
1567064	ESPRI	03
2139446	ESPRIT DE CORP.	03,09,14,16 18,20,21,24 28,35
2256568		03,09,14,18 24,25,35,39
CTM 151019	ESPRIT	03
CTM 151050		03
2161819A		04, 21
2218469B	ESPRIT	08, 20
2218470B		08




1229240		09
		
2128484	ESPRIT	09
CTM 151027	ESPRIT	09,14,18,24
CTM 151126		09,14,18,24
		
1162506	ESPRIT	14
1272029		14
		
1434597		14
		
2102647	ESPRIT TIMEWEAR	14
1243016		16
		



1515183	ESPRIT	16
2161819		04,16,21
1130766	ESPRIT	18
1243017		18
2278166		18,25,36
1243018		20
1243019		21

CTM 467050	ESPRIT	21
CTM 470377		21
1243020		24
1557940		24
1084022	ESPRIT	25
1084023	ESPRIT DE CORP	25
1127619		25
1127620		25

1179743		25
1298217		25
1376897		25
1272030		28
1277340		35
1294585		35

CTM 1505080		35
CTM 1505064	ESPRIT	35
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