

O-047-09

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NOS 2338089 AND 2354259  
BY BAKER STREET CLOTHING LIMITED**

**TO REGISTER THE TRADE MARK:**

**ALLIGATOR**

**IN CLASSES 25 AND 35**

**AND**

**THE CONSOLIDATED OPPOSITIONS THERETO  
UNDER NOS 94206 AND 94205 RESPECTIVELY  
BY LA CHEMISE LACOSTE (SA)**

## Trade Marks Act 1994

**In the matter of application nos 2338089 and 2354259  
by Baker Street Clothing Limited  
to register the trade mark:  
ALLIGATOR  
in classes 25 and 35  
and the consolidated oppositions thereto  
under nos 94206 and 94205 respectively  
by La Chemise Lacoste (SA)**

1) Baker Street Clothing Limited (Baker Street) has made two applications to register the trade mark ALLIGATOR. The first application (2338089) was made on 18 July 2003 and the second application (2354259) was made on 23 January 2004. Both applications were published for opposition purposes on 9 December 2005. The former application was published with the following specification:

*articles of sports clothing; headgear; caps and hats; scarves; beachwear and swimwear; bathrobes; articles of underclothing; socks; articles of rainwear; articles of clothing being woven or knitted; denim wear, jeans, jumpers, pullovers, sweatshirts, rugby tops, shirts, pyjamas, cardigans, fleece tops and tracksuits.*

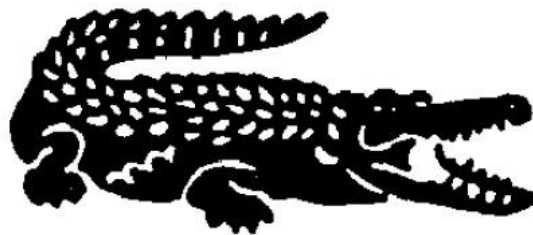
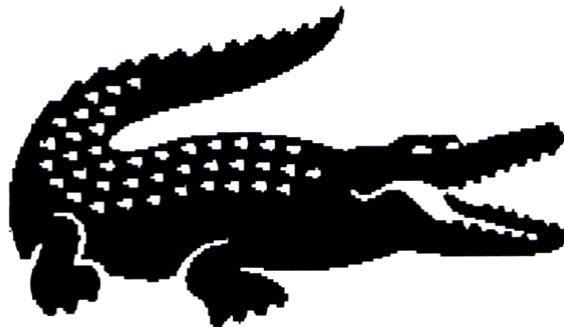
The latter application was published with the following specification:

*the bringing together for the benefit of others, of goods, namely, articles of sports clothing, headgear, caps and hats, scarves, beachwear and swimwear, bathrobes, articles of underclothing, socks, articles of rainwear, articles of clothing being woven or knitted, denim wear, jeans, jumpers, pullovers, sweatshirts, rugby tops, shirts, pyjamas, cardigans, fleece tops and tracksuits, enabling customers to view and purchase these goods from a retail store, mail order catalogues or on-line via the Internet and Internet websites; information, advisory and consultancy services relating to the aforesaid services.*

The above goods and services are in classes 25 and 35 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) On 9 March 2006 La Chemise Lacoste (SA) (Lacoste) opposed registration of the trade marks on the basis of sections 5(2)(b), 5(3), 5(4) and 56 of the Trade Marks Act 1994. Section 56 allows for injunctive relief, not a power that the registrar exercises. Consequently, section 56 is not a ground of opposition. I assume that the reference to section 56 is intended to indicate that Lacoste is claiming that it has a well-known trade mark, which is an earlier right as per

section 6(1)(c) of the Act<sup>1</sup>. As Lacoste has earlier trade mark registrations upon which it can rely, I cannot see that the claim to a well-known trade mark improves its position and so I will say no more about this matter. In relation to section 5(2)(b) and 5(3) of the Act Lacoste relies on three registrations. The trade mark registrations are for the following device marks:

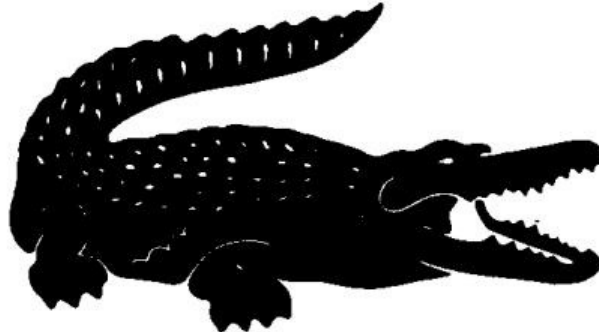


The top two registrations are registered for *clothing, footwear, headgear*. The bottom registration is registered for: *articles of sports clothing, sweaters, pullovers, jackets, slacks, suits, gowns, dresses, socks being articles of clothing, stockings and articles of underclothing, but not including any of the aforesaid goods made from reptile skin or from imitation reptile skin*. Baker Street accepts

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<sup>1</sup> (c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark.

that the third trade mark has been used on the goods for which it is registered in class 25 (it is the sole registration that is subject to proof of use). In relation to section 5(4)(a) of the Act Lacoste relies upon the three trade marks above and the following trade mark:



3) Baker Street has not denied that the respective goods are identical or similar. In relation to class 25 the respective goods are clearly identical, in relation to class 35 I cannot see that there can be any doubt that there is a high degree of similarity; the services being for the retail of clothing. Taking this into account, and the nature of the evidence before me, if Lacoste cannot succeed in relation to section 5(2)(b) of the Act I cannot see that it can succeed in relation to section 5(4)(a) of the Act.

4) Baker Street and Lacoste both furnished evidence. In its written submissions Baker Street claims that it has filed evidence of use and that it intends to continue to use the mark further. In fact the evidence shows that ALLIGATOR was used by Alligator Rainwear until 1978 when the company was put into receivership. The evidence shows that the brand was used primarily in relation to coats for women. Mr Satinoff, who worked in the business, comments that he has no recollection of Lacoste challenging the use of the ALLIGATOR brand. I have no idea what the position of Lacoste was up to 1978. I have to consider the position as of the dates of application. Mr Satinoff states that after the business went into receivership it was purchased and carried on business as Alligator Rainwear. There is no evidence in relation to this, so it is impossible to ascertain the nature of the business, what signs were used in relation to the goods produced and what goods were produced. Mr Joel Brown in his evidence for Baker Street states that he was aware of the ALLIGATOR brand in the 1960s and 1970s, he makes no reference to use after 1978. For the periods from 1978 to 2003 and 2004 there is no evidence of co-existence in the marketplace. The marketplace has also changed enormously in those years. I have no idea of what Lacoste's position was nearly thirty years ago or the nature of the goods that it produced or the norms of trade that existed back then. I do not consider that the use prior to 1978 has any bearing upon the case before me. (If the issues under section 5(4)(a) of the Act had to be considered, the evidence does

not establish anything close to a residual goodwill.) Mr Brown states that in parallel revocation proceedings he has put in evidence of demonstrations and presentations made to Moss Bros and Debenhams. He states that neither of these retailers thought any confusion would arise between the products that he wishes to sell and those of Lacoste. This evidence has not been filed in this case. If it had it would not tell me the position of the average, relevant consumer. The decision as to whether there is a likelihood of confusion rests with me<sup>2</sup>.

5) In its written submissions Baker Street states that Lacoste's case rests largely on the risk of confusion between ALLIGATOR as a word mark and Lacoste's use of the device of a crocodile in conjunction with the word Lacoste. I cannot see that this is Lacoste's case, Lacoste has relied solely on the devices of representations of members of the crocodilian family (which includes alligators and crocodiles). Baker Street also states that no evidence of actual confusion has been adduced. As there is no evidence of use of the trade mark ALLIGATOR for many years it would be impossible to show evidence of actual confusion. (Evidence of confusion is not a requisite for a finding of likelihood of confusion, anyway.) In its submissions Baker Street states that "[t]he Lacoste mark is famous and is well known". It is not clear what it means by the Lacoste mark.

6) Mr Brown states that the use of the crocodilian representation on its own is restricted to embroidery on clothing.

7) Sales of clothing in the United Kingdom by Lacoste from 2000 -2004 (inclusive) amounted to 153,337,393 €, sales of shoes for the same period amounted to 123,154,938 €. There were also sales of leather goods, eyewear, perfume, belts, household linen and watches. The evidence shows a good deal of promotion through advertising and sponsorship. The sponsorship mainly relates to tennis and golf and includes sponsorship of both tournaments and sports persons. Three forms of the crocodilian are mainly shown in the evidence, the first three forms shown in paragraph 2. The top form seems somewhat amorphous in shape in the representation but in use, as an embroidered emblem, is clearly a crocodilian. The use in promotion is invariably with Lacoste. The use of a crocodilian without a close identification to Lacoste is limited to the

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<sup>2</sup> See the comments of Millett LJ in *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283:

"The function of an expert witness is to instruct the judge of those matters which he would not otherwise know but which it is material for him to know in order to give an informed decision on the question which he is called on to determine. It is legitimate to call evidence from persons skilled in a particular market to explain any special features of that market of which the judge may otherwise be ignorant and which may be relevant to the likelihood of confusion. It is not legitimate to call such witnesses merely in order to give their opinions whether the two signs are confusingly similar. They are experts in the market, not on confusing similarity.

In the end the question of confusing similarity was one for the judge. He was bound to make up his own mind and not leave the decision to the opinion of the witnesses."

use on the outside of clothing and shoes. This is a form of use that will be seen by the owner and also by the public at large. It is the norm for clothing and shoes to have the crocodilian on the outside, this is very much the public face of the Lacoste brand. A public face that does not normally have a reference to Lacoste. Nowadays, many people wish to show the brand of clothing that they are wearing to the world at large; hence the application of trade marks to the exterior of the product. So the presence of the crocodilian is of importance to the purchaser and sends a brand message to the person who sees the items of clothing or footwear. (It is the key emblem that counterfeiters will wish to reproduce.) I must consider reputation in relation to each of the trade marks upon which Lacoste relies. As I have said, the evidence shows use of all three forms of the trade mark. There is no breakdown by reference to a particular trade mark. However, I consider that the evidence is such that it establishes that each of the trade marks will be known by a significant part of the public concerned<sup>3</sup> and so each of the trade marks has a reputation for the purposes of section 5(3) of the Act<sup>45</sup>.

8) The evidence shows, in relation to reputation, that the crocodilian device is linked inextricably with the Lacoste name. Where the average, relevant consumer knows the crocodilian device, that consumer will link it with the name of Lacoste and vice versa.

*Crocodile or alligator?*

9) Baker Street argues that the public has been educated to see the crocodilian device as a crocodile, as the Lacoste crocodile. Lacoste argues that only some members of the relevant public will have been educated to see the crocodilian device as a crocodile, there is nothing that precludes the device being seen as an alligator. Lacoste filed pages from a Google® search for the search term:

alligator and lacoste

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<sup>3</sup> The goods and services in question are purchased or used by the public at large and so the relevant public is the public at large.

<sup>4</sup> See *General Motors Corporation v Yplon SA* Case C-375/97 [2000] RPC 572.

<sup>5</sup> I have borne in mind the judgment of the European Court of Justice, in another context, in *Ponte Finanziaria SpA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case C-234/06 P:

“86 In any event, while it is possible, as a result of the provisions referred to in paragraphs 81 and 82 of the present judgment, to consider a registered trade mark as used where proof is provided of use of that mark in a slightly different form from that in which it was registered, it is not possible to extend, by means of proof of use, the protection enjoyed by a registered trade mark to another registered mark, the use of which has not been established, on the ground that the latter is merely a slight variation on the former.”

Many of the hits are not particularly pertinent to this case, some of the references being to René Lacoste's nickname, some having no reference to Lacoste, some referring to goods made of alligator skin, some, despite the restriction on the search, referring to Los Angeles, some referring to loppers! However, references such as hit no 82 show that in the United Kingdom the crocodilian device is at least sometimes described as an alligator. There will be a certain number of people who have been educated by Lacoste to know that Lacoste refers to the crocodilian device as a crocodile, as the Lacoste crocodile but there is nothing to suggest that this knowledge is widespread amongst the average, relevant consumers. The evidence does not support the hypothesis that the average, relevant consumer who knows the Lacoste device will automatically see it as a crocodile rather than as an alligator. There is nothing to suggest that those who do not know the Lacoste device, the relevant consumer who does not know of the reputation and simply sees the crocodilian device as a device without the bag and baggage of Lacoste's reputation, will see the device as a crocodile rather than an alligator. Consequently, I come to the conclusion that there will be some who would describe the device as a crocodile and some who will describe the device as an alligator.

#### *Average consumer and purchasing process*

10) The average consumer for the goods and services in question is the public at large, as I have noted above. In my experience there is a good deal of brand awareness in relation to clothing, so that even for cheap goods there will be a reasonably careful purchasing decision. However, the purchasing decision will be a long way from the type of careful and educated decision that will be involved in purchasing products such as white goods and computers. The nature of the goods and the purchasing process is not such that small differences in the trade marks will mitigate against confusion or make the consumer less subject to the effects of imperfect recollection. It is, of course necessary to take into account that the average consumer "is deemed to be reasonably well informed and reasonably circumspect and observant"<sup>6</sup>. The case law holds that in relation to clothing it is the visual impression of the trade mark that is most important<sup>7</sup>.

#### *Comparison of trade marks*

11) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details<sup>8</sup>. The visual, aural and conceptual similarities of the marks must, therefore, be assessed by reference to the overall

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<sup>6</sup> *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [2000] FSR 77.

<sup>7</sup> See *Société provençale d'achat and de gestion (SPAG) SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-57/03 and React Trade Mark* [2000] RPC 285.

<sup>8</sup> *Sabel BV v Puma AG* [1998] RPC 199.

impressions created by the marks, bearing in mind their distinctive and dominant components<sup>9</sup>. Consequently, I must not indulge in an artificial dissection of the trade marks, although I need to take into account any distinctive and dominant components. The average consumer rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he/she has kept in his/her mind and he/she is deemed to be reasonably well informed and reasonably circumspect and observant<sup>10</sup>. The assessment of the similarity of the trade marks must be made by reference to the perception of the relevant public<sup>11</sup>.

12) There is no individual distinctive and dominant component in any of the trade marks under consideration; they can only be considered in their entirety.

13) This case turns on the similarity, or lack of similarity, of a crocodilian device and the word ALLIGATOR. The premise behind Lacoste's opposition is that the average, relevant consumer seeing one of its crocodilian devices will perceive the image and convert it and record it as the word that represents the image. If the consumer converts the device into the word alligator there will be conceptual identity; Lacoste argues that if the consumer converts the device into the word crocodile there will be conceptual similarity, as both animals are crocodilians and have many similarities. Lacoste argues that this conceptual identity or similarity will give rise to phonetic and visual identity. I cannot see how there is any phonetic similarity between CROCODILE and ALLIGATOR. I fail to understand how the picture of an object and the word describing that object are visually similar; the simple fact is that they are not. The words Mona Lisa and the picture in the Louvre are not similar, the words simply identify a particular picture. As I have indicated above, I do not consider that it has been established that the average, relevant consumer would describe the devices as crocodiles rather than alligators. I consider that some would describe the devices as alligators, some as crocodiles. Lacoste's best case lays with those average, relevant consumers who would describe the devices as alligators, so I will consider the case on the basis of this hypothesis.

14) I have to decide if the average, relevant consumer on seeing the crocodilian devices will convert the images into words, will not just perceive the images but will convert them into the symbol representing the image; so making a conceptual link between the goods of Lacoste and the goods of Baker Street. If I see the picture of a crocodilian I do not convert it into its symbolic representation; all this tells me is how my brain deals with images. However, I do not doubt that others will convert the image into a word and store it in the memory as a word as

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<sup>9</sup> *Sabel BV v Puma AG* [1998] RPC 199.

<sup>10</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77.

<sup>11</sup> *Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02.



well as an image. If I saw the word ALLIGATOR on clothing I would make no association with Lacoste's crocodilian devices; the word and the image are distinct in my mind. Others, however, may convert the devices into the word ALLIGATOR, this will be held in the memory and act as a hook for the memory; it will give rise to conceptual identity. I am fortified in my view as to how others may process the devices in their brains by the ex parte examinations; where two different examiners raised Lacoste's crocodilian devices as citations against the word ALLIGATOR; whether the raising of the citations was correct is not of importance, what is of importance is how they processed the images.

#### *Conclusion in relation to likelihood of confusion*

15) In considering whether there is a likelihood of confusion various factors have to be taken into account. There is the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa<sup>12</sup>. In this case the goods and services are either identical or enjoy a good deal of similarity. It is necessary to consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade mark (either by nature or nurture) the greater the likelihood of confusion<sup>13</sup>. The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public<sup>14</sup>. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the goods for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings<sup>15</sup>. The crocodilian devices will be descriptive for goods made from, or containing, the skin of crocodilians; for other goods they will enjoy a reasonable degree of inherent distinctiveness. The reputation of the devices is tied inextricably with the name Lacoste. So those seeing the crocodilian are likely to think of Lacoste and those seeing Lacoste are likely to think of the crocodilian. This relationship strengthens and increases the reputation of the devices and strengthens and increases the reputation of the word, one feeds the other. The reputation of the crocodilian devices means that they have gained an enormous degree of distinctiveness. The average consumer will seldom have the opportunity to compare directly the trade marks, he or she will rely upon his or her recollection. Underpinning the argument of Lacoste is that the average, relevant consumer will have the same

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<sup>12</sup> *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117.

<sup>13</sup> *Sabel BV v Puma AG* [1998] RPC 199.

<sup>14</sup> *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

<sup>15</sup> *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

conceptual hook, of an alligator, in encountering the respective trade marks, and so will believe that the goods come from the same or economically linked undertakings. In *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs)* Joined cases T-117/03 to T-119/03 and T-171/03 CFI stated:

“49 However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

In this case, as decided above, it is the visual impression that is of the greatest important. Lacoste states in its submissions:

“LCL’s rights are logo marks and therefore need to be converted into words, before consumers can refer to them.”

This submission rests on the premise that consumers will practice an act of conversion and then refer to them. There is no evidence that the average, relative consumer goes about his or her business referring to the alligator or the crocodile marks, or any reason that he or she should. It is necessary to bear in mind the statement of the CFI in *Simonds Farsons Cisk plc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-3/04:

“58. In that respect, as OHIM quite rightly observes, it must be noted that, even if bars and restaurants are not negligible distribution channels for the applicant’s goods, the bottles are generally displayed on shelves behind the counter in such a way that consumers are also able to inspect them visually. That is why, even if it is possible that the goods in question may also be sold by ordering them orally, that method cannot be regarded as their usual marketing channel. In addition, even though consumers can order a beverage without having examined those shelves in advance they are, in any event, in a position to make a visual inspection of the bottle which is served to them.”

Applying this, *mutatis mutandis*, I do not consider that it can be accepted that it can be considered the norm for the average, relevant consumer to refer to the devices of Lacoste orally. (The written references in the evidence to the Lacoste crocodile and the Lacoste alligator are not oral references and do not represent the use of the average, relevant consumer.)

16) This case turns on a conceptual link between devices and a word, the image and the word that is the symbol of that image. On Lacoste's side of the argument there is the nature of the goods, the identity or high degree of similarity of the goods, the enormous reputation of the crocodilian devices and the conceptual identity of image and word (taking the image as an alligator). On Baker Street's side there is the lack of visual similarity and no case for aural similarity. I consider that the scales are weighted towards Lacoste and that the average relevant consumer will believe that goods and services sold under the respective trade marks emanate from the same or an economically linked undertaking. **Consequently there is a likelihood of confusion and both applications are refused as per section 5(2)(b) of the Act.**

#### *Sections 5(3) and 5(4)(a) of the Act*

17) I have previously stated that I cannot see that Lacoste's position can be any better under section 5(4)(a) of the Act than it is under section 5(2)(b) of the Act. The objection under section 5(3) of the Act effectively turns upon the same issue as the section 5(2)(b) objection; will ALLIGATOR and the Lacoste devices create a link because of alleged conceptual identity/similarity? If that link is created, are the respective trade marks similar? If I am wrong in relation to my findings under section 5(2)(b) then I cannot see that Lacoste can succeed under section 5(3). If I am right then there is no need to consider the objection under section 5(3) of the Act. Consequently, I will make no findings in relation to these grounds of opposition.

#### *Costs*

18) Lacoste has been successful and is entitled to a contribution towards its costs. I award costs on the following basis:

Opposition fee x 2	£400
Notice of opposition	£300 (one sum to cover the two cases)
Considering the counterstatement	£200 (one sum to cover the two cases)
Preparing and filing of evidence	£1,000
Considering evidence of Baker Street	£200
Written submissions	£200

TOTAL

£2,300

I order Baker Street Clothing Limited to pay La Chemise Lacoste (SA) the sum of £2,300. 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 20<sup>th</sup> day of February 2009**

**David Landau  
For the Registrar  
the Comptroller-General**