

O-283-09

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2445916  
BY MR SAMIR KADER TO REGISTER THE TRADE MARK:**



**IN CLASSES 14, 24 AND 25**

**AND IN THE MATTER OF OPPOSITION  
THERE TO UNDER NO 95375  
BY SPECIALITY RETAIL GROUP LIMITED**

## TRADE MARKS ACT 1994

**IN THE MATTER OF application No. 2445916**

**By Mr Samir Kader to register the trade marks SUITS ME and device  
in Classes 14, 24 and 25**

**and**

**IN THE MATTER OF opposition thereto under Nos. 95375  
by Speciality Retail Group Limited**

## BACKGROUND

1) On 7 February 2007, Mr Samir Kader, of Bombay Stores Wholesale, Wholesale Buildings, Woodhead Road, Bradford, BD7 1PD applied under the Trade Marks Act 1994 ("the Act") for registration of the following trade mark:



2) The application was published for opposition purposes on 20 April 2007 and on 20 July 2007, Speciality Retail Group Limited ("SRG") of Unit 4, Chester Road, Borehamwood, Herts, WD6 1LT filed notice of opposition to the application. The grounds of opposition are, in summary:

- a) Registration would be contrary to Section 5(2) (b) as the words SUITS ME are virtually identical and/or are closely similar to the opponent's six earlier SUITS YOU marks and is in respect of identical goods. Details of these six earlier UK and Community trade marks ("CTMs") are provided in an annex to this decision.
- b) The opponent has a reputation in the UK and registration of the application would be contrary to Section 5(3) of the Act. Use of the later mark, without due cause, would take unfair advantage of, or be detrimental to, the distinctive character or repute of the opponent's earlier marks.
- c) Registration would be contrary to Section 5(4) (a) of the Act. The opponent claims that its SUITS YOU marks have been used extensively throughout the UK since at least as early as 1985.

3) Mr Kader subsequently filed its counterstatement. It accepted that some of the goods in the application are identical to goods covered in some of the opponent's marks but denied the claims and, where applicable, it put the opponent to full proof of use. It also stated that it was not aware of any actual confusion between the respective marks. Mr Kader also voluntarily limited the list of goods of the application subsequent to publication and it is this amended list of goods, as detailed below, that are relevant to these proceedings:

*Class 14: Jewellery being ladies costume jewellery for traditional Asian dress.*

*Class 24: Textile fabric for use in traditional Asian dress.*

*Class 25: Shalwar kameez for men and women (traditional dress for Asian men and women); kurta (loose fitting shirt); shawls; saris; shalwars; kaftans; traditional Asian dress; all being items of traditional Asian dress and clothing.*

4) Only SRG filed evidence in these proceedings. Neither party requested a hearing nor filed written submissions. Both sides ask for an award of costs. After a careful study of the papers, I give my decision.

### **Opponent's Evidence**

5) This takes the form of a statutory declaration dated 23 April 2008, by Jeanette Pauline Wood, European Trade Mark Attorney and Director of Bison River Limited, SRG's representatives at the time. Ms Wood states that she has worked with SRG, in relation to its trade marks, since 1994 and her evidence comes from its records, the records of Bison River or its predecessor, the Intellectual Property Office, the Office for Harmonization in the Internal Market (the European Trade Mark Office) or from her personal knowledge and experience.

6) Ms Wood states that SRG is the proprietor of substantial trade mark rights in SUITS YOU dating back to at least as early as 1985 and these trade marks are used throughout the UK in respect of "clothing, footwear and headgear, retailing of these goods and of associated goods and services".

7) At Exhibit 3i, JPW1, Ms Wood provides a list of SUITS YOU retail outlets as of 22 February 2008. These number sixty three spread across the whole of the UK. She highlights that many of these locations are within key commercial positions, such as Oxford Street in London, and also in major shopping centres such as Bluewater, Thurrock (Lakeside), Brent Cross, Meadow Hall and the Trafford Centre. As a result, SUITS YOU "receives an enormous amount of promotion and advertising by virtue of their positions in and sales arising from the high street". She also points to the relevant consumer stating that SUITS YOU

customers cover a broad spectrum of the population and that SUITS YOU is an affordable brand aimed at the average person.

8) Exhibit 1f, JPW1 is a copy of financial information including “Design and Graphic Costs” and Ms Wood states that advertising expenditure “comes under this title”. These costs are reproduced below:

<b>Year</b>	<b>Design &amp; Graphic Costs</b>
2004	£242,000
2005	£411,000
2006	£526,000
2007	£476,000

Later in her statutory declaration, Ms Woods also discloses advertising expenditure for additional years, and for 2002 and 2003, this figure was £818,947 and £993,747 respectively.

9) Ms Wood provides turnover in respect of SUITS YOU from 1988 to 2007 inclusive. The turnover for the last five complete years prior to the filing date of the application (7 February 2007) is reproduced below:

<b>Year</b>	<b>Turnover</b>
2002	£53,323,000
2003	£53,103,000
2004	£58,385,000
2005	£57,666,000
2006	£52,158,000

10) Ms Wood explains that these turnover figures include both sales in the UK and also in Eire. Ms Wood provides turnover figures for Eire for the years 2000 to 2007 inclusive and in the five complete years prior to the filing date of the application this varied between £1.7 million and £2.8 million. These figures provide context to assess the extent of sales in the UK alone.

11) Ms Wood states that SUITS YOU has been promoted throughout the UK by means of its shops, press articles and leaflets. In support of this, Ms Wood provides a raft of exhibits, a representative example of which includes:

- An extract from the SUITS YOU website (Exhibits 3h, JPW1), dated 28 February 2008, where SUITS YOU is described as “a national chain of over 50 stores...Specialising in men’s tailoring and formal wear...”
- A press release (Exhibit 3k, JPW1), dated 28 November 2005 and a corresponding news item on the website altassets.com (Exhibit 3j, JPW1) announcing a buy-out of SRG. It notes that “SRG is one of UK’s best known specialist menswear retailers, providing high quality suits from

some 80 stores. It successfully trades through a number of well known high street brand names including “Suits You”,...In the year to January 2005, the Group generated revenues of c. £74m, making it the second largest specialist menswear retailer in the UK...The men’s suit market is estimated at c.£700m p.a....”

- A customer case study by Kewill (at Exhibit 3o, JPW1), who supplied SRG with an “order fulfilment solution”, includes the following statements:
  - “Around half of SRG’s annual revenues are generated from the sale of suits...”
  - “Prior to re-branding to “Suits You” in the 1980s...”
- Photographs of SUITS YOU shop fronts are provided at Exhibit 8, JPW1. Stickers attached to the photographs indicate that the photographs relate to shops in Reading and Southampton in 2001.
- At 18b, JPW1 is an extract from a newspaper publication, Ta Nea (self proclaimed as “Britain’s Oldest & Leading Hellenic Newspaper”), dated 7 June 1990. This is a news article reporting on the Wood Green shopping centre in North London and includes the following: “Ranking high in [sic] the menswear outlet “Suits you” which recently reopened under a new livery...”Suits You” is providing the fashion conscious North London businessman a one-stop shop to equip himself with suits, shirts, ties and accessories, as well as dinner suits and tuxedo for evening...Suits You is one of a chain of independent specialist shops which have been trading for a little over three years. At present there are eight outlets...” A number of other, mainly trade, press articles record similar information.
- A number of leaflets promoting suit hire under the mark “Young’s Hire”. All these leaflets indicate that such services are available from SUITS YOU shops. Some of these are linked to the hire of formal wear for specific events such Ascot horse races (held in York) on 14 – 15 June 2005 (Exhibit 4, JPW1) and The Richard Langhorn Trust, Winter Ball on 9 November 2001 at The Royal Lancaster Hotel, London (Exhibit 8a, JPW1).

12) The specifications of goods in the application are all limited to being “for use in traditional Asian dress” or to “all being items of traditional Asian dress”. Ms Wood addresses the issue by providing an extract from the user-authored website Wikipedia illustrating that “Asia” is the world’s largest and most populous continent (see Exhibit 28, JPW2). To support the contention that people from Asia wear all types of clothing, Exhibit 29, JPW2 is provided. This consists of a number of internet extracts that includes photographs of various Asian heads of State many wearing the type of clothing sold by SUITS YOU.

13) Exhibit 23, JPW2 provides a definition of “salwar kameez”, an item specifically listed in Mr Kader’s specification. This definition is taken from [salwar.wordpress.com](http://salwar.wordpress.com) and states that a salwar kameez is “a dress of choice for ladies in parties, weddings and formal gatherings in India, Pakistan, Canada, United Kingdom, USA, Australia, Germany and several other countries of the world.” The article also states that “[t]his ‘fusion wear’ garment is clearly the flavour of choice in the West and also the designer choice from the World’s Hottest Fashion Designers”. It also lists international celebrities such as Jennifer Lopez, Hillary Clinton, Madonna and others who have worn this type of dress at high profile events. Exhibit 26, JPW2 is an extract from [museumoflondon.org.uk](http://museumoflondon.org.uk), dated 3 March 2008; it states that the salwar kameez “became part of mainstream fashion during the 1999s” and Exhibit 27, JPW2 is an extract from [seasonsindia.com](http://seasonsindia.com), also dated 3 March 2008, that states that the salwar kameez “is clearly the current flavour of the west”.

14) Ms Wood also states that “kaftans” have long been part of western dress. To support this, Exhibit 14, JPW2 provides copies of pages from the Spring 2008 catalogue from White Stuff featuring kaftans as part of its collection. Exhibit 13, JPW2 provides copies from Mr Kader’s website [suitsmeonline.com](http://suitsmeonline.com) illustrating what Ms Wood describes as being the same or very similar to kaftans. These garments are described as “ladies kurta” on the website.

15) Ms Wood also provides a number of further exhibits to support her contention that “Asian and Western clothing is sold side by side and worn by Asian and Western men and women”. These exhibits include the Wikipedia entry for “Nehru jacket” (Exhibit 2, JPW2), where it is recorded as being briefly popularized by the Beatles in the West during the late 1960s. Ms Wood states that mainstream shops which are competitors of SUITS YOU sell and offer for hire Asian and Western clothing. Exhibits 5, 6 and 7, JPW2 are extracts from [lafleurbridal.co.uk](http://lafleurbridal.co.uk), [navnisha.com](http://navnisha.com) and [thebestof.co.uk](http://thebestof.co.uk) respectively. The first extract shows the hire of both western wedding wear and “Asian wear” packages. The second extract identifies Navnisha as a boutique located in Mumbai, India and specialising in Indian fashion western outfits. The third extract details formal hire by Gerald Boughton based in Bury St Edmunds. This formal hire includes Asian wear such as Sherwanis, Kurtas, Chunis and Khussas. Other exhibits are provided to illustrate the same point including Exhibit 9, JPW2 which is an extract from an undated Burtons catalogue promoting its clothing hire services. The range of clothing available for hire includes Asian wear. Ms Wood states that Burton is an established retailer with four hundred stores throughout the UK and Eire.

## **DECISION**

### **Proof of use**

16) The Trade Marks (Proof of Use, etc) Regulations 2004 apply in this case. The provision reads as follows:

**“6A Raising of relative grounds in opposition proceedings in case of non-use**

(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1),(2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, ...

...

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services...”

17) An earlier trade mark is defined in section 6 of the Act, 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), Community trade mark or international trade mark (EC) 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.”

18) SRG relies on six earlier marks, five of which are registered. Whilst there may be a case that some of SRG’s goods and services are similar to Mr Kader’s goods, obviously its best case would lie with goods that are identical. In this respect, SRG’s Community registration (CTM) 1853316 includes “jewellery” at large in its Class 14 specification of goods and also “textiles and fabrics” at large in its Class 24 specification of goods. These specifications clearly encompass identical goods to all those listed in Mr Kader’s respective Class 14 and Class 24 specifications. The registration procedure for this CTM was completed on 3 June 2003 and this is less than five years before the date of publication of Mr Kader’s application (20 April 2007). As such, SRG is not required to provide proof of use in respect of these goods.

19) Two of SRG’s registrations, namely 2017172 SUITS YOU and 2157971 SUITS YOU, include goods in Class 25, but in both cases the registration procedure was completed more than five years before the date of publication of Mr Kader’s application. As such, SRG is required to provide proof of use in respect of these goods.

20) The requirements for “genuine use” have been set out by the European Court of Justice (“the ECJ”) in its judgment in *Ansul BV v Ajax Brandbeveiliging BV*, Case C-40/01 [2003] RPC 40 and in its reasoned Order in Case C-259/02, *La Mer Technology Inc. v Laboratoires Goemar S.A.* [2005] ETMR 114.

21) In *Ansul*, the ECJ held as follows:

“35. ... ‘Genuine use’ therefore means actual use of the mark....

36. ‘Genuine use’ must therefore be understood to denote use that is not merely token, serving solely to preserve the rights conferred by the mark. Such use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user...

37. It follows that ‘genuine use’ of the mark entails use of the mark on the market for the goods or services protected by that mark and not just



internal use by the undertaking concerned. The protection the mark confers and the consequences of registering it in terms of its enforceability *vis-à-vis* third parties cannot continue to operate if the mark loses its commercial *raison d'être*, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings. Use of the mark must therefore relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns...

38. Finally, when assessing whether there has been genuine use of the trade mark, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, in particular whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark.

39. Assessing the circumstances of the case may thus include giving consideration, *inter alia*, to the nature of the goods or service at issue, the characteristics of the market concerned and the scale and frequency of use of the mark. Use of the mark need not, therefore, always be quantitatively significant for it to be deemed genuine, as that depends on the characteristics of the goods or service concerned on the corresponding market."

22) In *La Mer* the ECJ held as follows:

21. ... it is clear from paragraph [39] of *Ansul* that use of the mark may in some cases be sufficient to establish genuine use within the meaning of the Directive even if that use is not quantitatively significant. Even minimal use can therefore be sufficient to qualify as genuine, on condition that it is deemed justified, in the economic sector concerned, for the purpose of preserving or creating market share for the goods or services protected by the mark.

22. The question whether use is sufficient to preserve or create market share for those products or services depends on several factors and on a case by case assessment which it is for the national court to carry out....

...

25. In those circumstances it is not possible to determine *a priori*, and in the abstract, what quantitative threshold should be chosen in order to determine whether use is genuine or not. A *de minimis* rule, which would

not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down.

23) The evidence presented by SRG illustrates that it operates sixty three retail outlets in the UK and also undertakes Internet retail activity in respect to “men’s tailoring and formal wear”, all identified by its mark SUITS YOU. These activities generate a total turnover in the region of over £50 million a year. However, regarding use in respect of the goods themselves (as opposed to the retail of the goods), the evidence is less clear. In fact there is a suggestion (Exhibit 3f, JPW1) that SRG use different brands in respect of the goods themselves. The exhibit is an extract from the SUITS YOU website, dated 13 December 2003, obtained from the Internet archive site Waybackmachine where it states “Suits You offers brand names such as Ted Baker, Pierre Cardin, Racing Green, Van Gils as well as their own brands Scott and Taylor and Tom English.” Similarly, Exhibit 10d, JPW1 is a copy of a promotional voucher, dated August 2000, that contains the text “[w]hen you visit Suits You during August take a look at the Scott & Taylor suit range available in-store and get a Scott & Taylor shirt free with every suit purchased.” The inference in the first statement is that SRG does not use SUITS YOU in respect of the clothes themselves, but rather uses “Scott and Taylor” and “Tom English”. The second statement is illustrative of how SUITS YOU is used to identify SRG’s retail activities in respect of clothing brands such as Scott & Taylor.

24) Beyond the broad assertion by Ms Woods, in her witness statement, that SUITS YOU has been used in relation to clothing, footwear and headgear, there is no evidence of it being used in respect of clothing. Exhibits 22af and 22ag, JPW1 are photographs of clothes hangers bearing two different forms of SUITS YOU marks. I concede that, when viewed in isolation, it can be argued that such use could be viewed as being in relation to the clothes that would hang from such items but taken in the context of the evidence as a whole, I am satisfied that these items serve only to promote the retail services.

25) I also note that there are also numerous exhibits that illustrate that formal wear is hired from SUITS YOU retail outlets, but this does not support the notion of genuine use in respect of the clothes themselves. This is for two reasons. Firstly, the hire services are provided under the mark YOUNGS HIRE and not SUITS YOU and secondly, this mark is in respect of a hire service and not in respect of clothing goods per se.

26) Applying the principles set out in *Ansul*, I find that the evidence fails to demonstrate any actual use of the mark SUITS YOU in respect of any clothing or other related goods in a way that would be consistent with the essential function to guarantee the origin of the goods. Rather, the evidence illustrates use exclusively in respect of the retail of the same. However, I am not required to consider the issue of genuine use, in respect of retail services, in any more detail because SRG’s registration 2255877, which covers such services, is not subject

to the proof of use provisions by virtue of its registration procedures being completed on 30 January 2004, being less than five years before the publication of Mr Kader's application.

27) In light of these findings, SRG's best case is represented by its registrations that are not subject to the proof of use requirements and cover the following goods and services:

CTM1853316 SUITS YOU

Class 14: *Jewellery, watches; clocks; cufflinks.*

Class 24: *Textiles and fabrics; linen; sheets, towels, bedspreads, duvets, shams, dust ruffles, blankets, pillow cases, comforters, throws, cushion covers; curtains.*

2255877 SUITS YOU (Series of four)

Class 35: *The bringing together, for the benefit of others, of a variety of goods and services, enabling customers to conveniently view and purchase those goods and services from a general merchandising store, including a retail clothing, footwear and headgear store, from a general merchandising catalogue including a clothing, footwear and headgear catalogue by mail order or by means of telecommunications, or from an Internet website specialising in general merchandising including clothing, footwear and headgear.*

### **Section 5(2) (b)**

28) Section 5(2) (b) reads:

“(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.”

29) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the ECJ in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000]

FSR. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] ETMR 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P*. 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*,
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, 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.*,
- (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*,
- (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*,
- (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*,
- (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*,
- (g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,
- (h) 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*,

(i) 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 and Adidas Benelux BV*,

(j) 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.*

(k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

(l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*

### **Comparison of goods**

30) In assessing the similarity of goods and services, it is necessary to apply the approach advocated by case law and all relevant factors relating to the respective goods and services should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the ECJ stated at paragraph 23:

‘In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.’

31) Other factors may also be taken into account such as, for example, the distribution channels of the goods concerned (see, for example, paragraph 53 of the judgment of the Court of First Instance (CFI) in Case T-164/03 *Ampafrance S.A. v OHIM – Johnson & Johnson (monBeBé)*).

32) I have set out a list of the goods and services that represent SRG's best case in paragraph 28 above. I will limit my analysis to a comparison of these goods and services with those of Mr Kader's application.

33) At paragraph 19, I have already recognised that the broad term “jewellery” in SRG’s registration encompasses “jewellery being ladies costume jewellery for traditional Asian dress” and also the broad term “textiles and fabrics” encompasses “textile fabric for use in traditional Asian dress”. In doing so, I recognised that respective specifications need not be co-extensive to be considered identical (*Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-133/05*).

34) I now turn to the question of the degree of similarity, if any, between the retail services listed in SRG’s registration and the clothes in Mr Kader’s Class 25 specification. The scope and nature of retail services within the context of trade mark rights has been discussed by the courts, most notably by the ECJ in *Praktiker Bau- und Heimwerkermärkte C-418/02*. At paragraph 34 the ECJ identified that the objective of the retail trade is the sale of goods to consumers and that this includes, in addition to the legal sales transaction, all activity carried out by the trader for the purpose of encouraging the conclusion of such a transaction.

35) Having regard for this definition of what constitutes a retail service, I must go on to consider if the specific retail services listed in SRG’s earlier registration are similar to Mr Kader’s Class 25 goods.

36) Having regard for the established case law identified earlier, the CFI considered the degree of similarity between clothes and the retail of the same in *Oakley, Inc., v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-116/06. In summary, the CFI found that the nature, purpose and method of use of retail services are different to clothes. It then went on to consider the respective distribution channels and concluded that retail services can be offered in the same places as those in which the goods in question are sold. It also noted that manufacturers of clothing often have their own sales outlets for their goods or resort to distribution agreements which authorise the provider of the retail services to use the same mark as that affixed to the goods sold. It concluded that it is, therefore, relevant to take account that clothes and the retail of the same are generally sold in the same outlets. Finally, the Court considered the complementary nature of the respective goods and services, commenting that it is settled case-law (*Sergio Rossi SpA v OHIM – Sissi Rossi*, Case T-169/03) that complementarity exists when the goods and services are those which are closely connected in the sense that one is indispensable or important for the use of the other, so that the consumers may think that the same undertaking is responsible for both. It concluded that as the goods involved in the retail activity are identical to the goods of the earlier mark, the services provide an important role when it comes to the consumer buying the goods offered for sale.

37) The CFI, having conducted this analysis, concluded that clothes in Class 25 and the retail of the same in Class 35 “resemble each other to a certain degree”. There is nothing in the circumstances of the current proceedings that require me

to reach a different conclusion. It is clear that retail services involving the sale of clothing is both indispensable and important for the use of clothing.

38) The fact that Mr Kader's clothes are limited to all being traditional Asian dress is not, in my mind, of any consequence in this analysis as SRG's retail services includes the retailing of clothing at large, which can include the retailing of traditional Asian clothing.


### ***The average consumer***

39) As matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, paragraph 23) it is important that I assess who the average consumer is for the goods and services at issue. I have already concluded that the respective parties' Class 14 and 24 goods are identical and it follows that the respective consumers will also be the same. Regarding the respective Class 25 goods and retail services of the same, I concluded that the goods at issue and the goods involved in the retail activity are identical. It follows that the respective consumers will be the same in respect of these goods and services.

40) Having identified that the consumers of both parties goods and services are identical, I will now go on to consider who these consumers are and what is the nature of the purchasing act involved in accessing the respective goods and services. In respect to jewellery, the purchasing act invariably involves an aesthetic consideration of the goods and therefore, it is the visual impression of the mark that will be the most important. Similarly, in respect to items of clothing, it is the visual impression of the marks that is the most important bearing in mind the manner in which such goods will normally be purchased. This would normally be from a clothes rail, a catalogue or a web-site rather than by oral request. This view is supported by such cases as *Société provençale d'achat and de gestion (SPAG) SA v OHIM Case T-57/03* and *React Trade Mark [2000] RPC 285*. Notwithstanding the importance of visual impression, aural and conceptual considerations remain important and should not be ignored completely. As the average consumer is the general public and these are consumer items/consumer services, I would normally expect the average consumer to display a reasonable degree of care and attention during the purchasing process. I do not believe that the purchasing act in respect of textile fabric will differ to that of items of clothing, to any significant degree.

### ***Comparison of marks***

41) A number of earlier marks are relied upon, but for the purposes of this analysis I will take the plain word mark SUITS YOU, that is the subject of, or one of the series of marks that are the subject of the relevant earlier rights. Therefore, the respective marks are:

SRG's mark	Mr Kader's mark
SUITS YOU	

42) When assessing the extent of similarity between the respective marks, I must do so with reference to their visual, aural and conceptual similarities bearing in mind their distinctive and dominant components (*Sabel*, para 23). I am also mindful of the guidance given by the ECJ in *Medion* that assessment of similarity means more than taking just one component of a composite mark and comparing it with another mark and also in *Shaker* that only if other components are negligible is it permissible to make the comparison on the basis of the dominant element.

43) From a visual perspective, Mr Kader's mark consists of a stylised device of a person together with the words SUITS ME in large, stylised script. In small, plain text underneath is the strap line "Where Quality Costs Less". Such a layout results in the device, and the words SUITS ME, having equal dominance within the mark with the strap line being subservient to these other elements. SRG's mark consists of just the two words SUITS YOU. The word SUIT is common to both marks. The second word in the respective marks is different, namely YOU in the first and ME in the second. Other points of difference are the device element, stylised letters used for the words SUITS ME and the presence of the strap line "Where Quality Costs Less" in Mr Kader's mark. Taking all these factors into account, the respective marks share only a moderate level of visual similarity.

44) From an aural perspective, once again, the word SUITS provides a point of similarity being the first word in both marks. The different second words YOU and ME respectively are a point of difference as is the addition of the strap line "Where Quality Costs Less" in Mr Kader's mark. Overall, these similarities and differences combine to give a moderate level of aural similarity. Turning to the level of conceptual similarity, the first word SUITS, common to both marks, in this context, acts as a verb meaning "go well with or enhance the features, figure, or character of."<sup>1</sup> The second word in both marks is a pronoun both used to refer to persons. YOU can refer to any person in general<sup>2</sup> and ME refers to the speaker himself or herself<sup>3</sup>. The fact that the second word in both marks is a pronoun, to my mind, provides an element of conceptual similarity.

45) I have already identified the dominant elements in the earlier mark as being the device element and the words SUITS ME, but I recognise that the strap line is not negligible. In *Medion* the ECJ also commented:

<sup>1</sup> Compact Oxford English Dictionary ([www.askoxford.com](http://www.askoxford.com))

<sup>2</sup> ditto

<sup>3</sup> ditto



“30. However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.”

46) Adapting this to the current proceedings, I recognise that the device of a person in Mr Kader’s mark has an independent distinctive character in its own right. However, the prominence of this device element is lessened as a result of the proximity of the words SUITS ME. Taking all these points into account, I consider that the respective marks share a high level of conceptual similarity.

47) In summary, the respective marks share a moderate level of aural and visual similarity and a high level of conceptual similarity and these factors combine so that there is, overall, a reasonably high level of similarity between the respective marks.

#### ***Distinctive character of the earlier trade mark***

48) I have to consider whether the opponent’s trade mark has a particularly distinctive character either arising from the inherent characteristics of the trade mark or because of the use made of it. It consists of the words SUITS YOU, having a clear meaning in English, akin to “it enhances your look” and in respect to jewellery, textile fabric, clothing and the retail services the term will serve to suggest, in a laudatory way, the effect of the goods upon the consumer. As such, it does not enjoy the highest degree of distinctive character and I find that in fact, its inherent distinctive character is on the low side, in respect to these goods and services.

49) I must also consider the effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act. This was considered by David Kitchen Q.C. sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchen concluded at paragraph 17 of his decision:

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C in *DUONEBS* should not be seen as of

general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in *Reed Executive & Ors v Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

50) SRG’s evidence illustrates that use of the trade mark SUITS YOU in the UK began in the mid-1980s and is used in respect of a chain of clothing retail outlets, numbering sixty three across the UK. Turnover in the UK for the five years prior to the relevant date was in the region of £50 million a year. The evidence illustrated that SUITS YOU is the second largest “specialist menswear retailer” in the UK.

51) The facts clearly point to SUITS YOU enjoying a prominent position in its specific retail area and I have little hesitation in concluding that in respect of the retail of men’s formal wear that SUITS YOU enjoys an enhanced level of distinctive character.

### ***Likelihood of confusion***

52) I must adopt the global approach advocated by case law and take into account that marks are rarely recalled perfectly with the consumer relying instead on the imperfect picture of them he has in kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27).

53) I have found that the respective marks share a moderate level of visual and aural similarity and a high level of conceptual similarity. The respective goods are identical in respect of the goods in Class 14 and 24 and the retail services in SRG’s earlier registrations is similar and complementary to the various clothing items listed in Class 25. Further the respective average consumers are the same. I also acknowledged that SRG enjoys an enhanced level of distinctive character in respect of its use of SUITS YOU in respect of the retailing of men’s formal wear.

54) In summary, when taking all factors into consideration, I find that the relevant consumer will confuse the respective marks. This finding may be less certain in respect of direct confusion, where the consumer believes Mr Kader’s mark is SRG’s mark, but on balance, I believe such direct confusion will occur. I am more

certain in respect of indirect confusion where the relevant consumer will believe that the respective goods and services originate from the same trade source. In coming to this conclusion, I have kept in mind that the consumer rarely has the opportunity to compare marks side-by-side, but rather relies on their imperfect recollection. Accordingly, I find there is a likelihood of confusion and the opposition under Section 5(2) (b) succeeds in its entirety.

### **Sections 5(3) and 5(4) (a)**

55) In light of my findings in respect to the grounds under Section 5(2) (b), SRG cannot improve on its position and as such, it is not necessary for me to consider the remaining grounds for opposition, namely those claimed under Sections 5(3) and 5(4) (a).

### **COSTS**

56) The opponent, SRG, has been totally successful and is entitled to a contribution towards its costs. I take account of the fact that no hearing has taken place and that neither party filed written submissions in lieu of attendance. I also take account that the evidence filed by SRG is virtually identical to that filed in another set of proceedings between the same parties, namely Opposition No. 95374 and I have reduced the award accordingly. I award costs on the following basis:

Notice of Opposition and statement	£500
Considering statement of case in reply	£200
Preparing and filing evidence	£100
<b>TOTAL</b>	<b>£800</b>


57) I order Mr Samir Kader to pay Speciality Retail Group Limited the sum of £800. 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 18<sup>th</sup> day of September 2009**

**Mark Bryant  
For the Registrar,  
the Comptroller-General**

## ANNEX

### Opponent's Earlier Marks

Mark No. & representation of mark	Relevant dates
<p>2017172 <b>SUITS YOU</b></p> <p><i>Class 25: Evening wear, formal wear, suits, jackets, trousers, shirts, ties, waistcoats, hats; accessories for clothing.</i></p> <p><i>Class 45: Hire of evening wear, formal wear, suits, jackets, trousers, shirts, ties, waistcoats, hats and of accessories for clothing.</i></p>	<p>Filing date: 11 April 1995 Registration: 31 January 1997</p>
<p>2157971 <b>SUITS YOU</b></p> <p><i>Class 25: Men's and boys' clothing and headgear.</i></p> <p><i>Class 45: Hiring of men's and boys' clothing and headgear</i></p>	<p>Filing date: 12 February 1998 Registration: 30 July 1999</p>
<p>2218489A</p> 	<p>Filing date: 30 December 1999 Registration: 21 February 2003</p>
<p><i>Class 03: Shampoo, hair conditioner, hair gels and mousses, bath oil, shower gel, soap, body creams, moisturiser, skin conditioning cream, hand cream, sun screen.</i></p> <p><i>Class 08: Hand tools; cutlery; knives, forks, spoons and eating instruments; cooking utensils.</i></p> <p><i>Class 09: Eyewear cases; optics; computer software; CD-Rom's; computers; videos; disks and tapes; publications downloadable from the Internet.</i></p> <p><i>Class 14: Clocks; cufflinks.</i></p> <p><i>Class 16: Stationery; pens; paper; office requisites; printed materials; giftwrap; draw and shelf liners; paper; printed matter; books; publications; magazines; periodicals; manuals.</i></p>	

*Class 18: Bags, wallets, key cases, purses, cases, portfolios, bags for toiletry kits, umbrellas, billfolds, duffle and tote bags, brief cases, attache cases, credit card holders, business card holders.*

*Class 20: Furniture; picture frames; mirrors; curtains; curtain poles, runners, hooks, curtain fixtures and fittings; cushions.*

*Class 21: Household and kitchen utensils and containers; articles for cleaning purposes; porcelain and earthenware not included in other classes; glassware; combs and brushes; eating, cooking and decorative utensils; china; dinnerware; drinking utensils.*

*Class 24: Textiles and fabrics; linen; sheets, towels, bedspreads, duvets, shams, dust ruffles, blankets, pillow cases, comforters, throws, cushion covers; curtains; drapes and window coverings.*

*Class 26: Buttons; belt clasps; ornaments for clothing, footwear and headgear.*

*Class 27: Floor covering, carpets, rugs, wall coverings.*

*Class 35: Advertising and business services; advertising and promotional services; marketing services.*

*Class 36: Financial and insurance services.*

*Class 37: Dry cleaning; repair of clothing, footwear and headgear.*

*Class 40: Alteration services (for clothing and headgear); printing services.*

*Class 41: Photographic services; photographic reporting services.*

*Class 42: Web site design services; hosting of websites; creating and maintaining websites; compilation of web pages including for adverts; domain name search and registration services; graphic art and design services; architectural services; photographic research services; computer software, computer programs, CD-ROM, DVD, consultancy and design services; installation and maintenance of computer software; leasing access time to a computer database; consultancy, information and advisory services, including backup and helpline services, to all the aforesaid services.*

<p>2255877</p> 	<p>Filing date: 15 December 2000 Registration: 30 January 2004</p>
<p><i>Class 35: The bringing together, for the benefit of others, of a variety of goods and services, enabling customers to conveniently view and purchase those goods and services from a general merchandising store, including a retail clothing, footwear and headgear store, from a general merchandising catalogue including a clothing, footwear and headgear catalogue by mail order or by means of telecommunications, or from an Internet website specialising in general merchandising including clothing, footwear and headgear.</i></p>	

<p>CTM1853316 <b>SUITS YOU</b></p>	<p>Filing date: 14 September 2000 Registration: 3 June 2003</p>
<p><i>Class 03: Cosmetics, fragrances, aftershave, after shave balm, shampoo, hair conditioner, hair gels and mousses, bath oil, shower gel, soap, body creams, moisturiser, skin conditioning cream, hand cream, sun screen.</i></p> <p><i>Class 08: Hand tools; cutlery; knives, forks, spoons and eating instruments.</i></p> <p><i>Class 09: Sunglasses; eyeglass frames; optics; computer software; CD-ROMs; computers; videos; disks and tapes; publications downloadable from the Internet.</i></p> <p><i>Class 14: Jewellery, watches; clocks; cufflinks.</i></p> <p><i>Class 16: Stationery; pens; paper; office requisites; printed materials; giftwrap; draw and shelf liners; paper; printed matter; books; publications; magazines; periodicals; manuals.</i></p> <p><i>Class 18: Leather accessories, bags, wallets, key cases, purses, cases, portfolios, toiletry kits, umbrellas, billfolds, duffle and tote bags, brief cases, attache cases, credit card holders, business card holders, eyewear cases.</i></p> <p><i>Class 20: Furniture; picture frames; mirrors; curtain poles, runners, hooks and related items; cushions.</i></p> <p><i>Class 21: Housewares; glassware; combs and brushes; eating, cooking and decorative utensils; china; dinnerware; drinking utensils; cooking utensils.</i></p> <p><i>Class 24: Textiles and fabrics; linen; sheets, towels, bedspreads, duvets, shams,</i></p>	

*dust ruffles, blankets, pillow cases, comforters, throws, cushion covers; curtains.*

*Class 26: Buttons, hair accessories and ornaments; belt clasps; ornaments for clothing, footwear and headgear.*

*Class 27: Floor covering, carpets; rugs, drapes, curtains, window and wall coverings.*

*Class 35: Advertising and business services; advertising and promotional services; marketing services.*

*Class 36: Financial and insurance services.*

*Class 37: Dry cleaning; repair of clothing, footwear and headgear.*

*Class 40: Alteration services (for clothing and headgear).*

*Class 42: Website design; creating and maintaining web sites; hosting of websites; domain name registration services; installation and maintenance of computer software; leasing of access time to a computer database; information, consultancy and advisory services to all the aforesaid services.*

CTM4551602



Filing date: 20 July 2005

Priority date: 3 February 2005

Pending

*Class 09: Sunglasses, eyewear, optics, eyeglass frames, contact lenses and contact lens cases; reading glasses; eyewear cases; optical apparatus and instruments; computer software; CD-ROMs; computers; videos; disks and tapes; telephone apparatus and instruments; mobile phones; telecommunications apparatus and instruments; publications downloadable from the Internet; parts and fittings for the aforesaid goods.*

*Class 14: Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments; watches, clocks; cufflinks; tie clips; parts and fittings for all the aforesaid goods.*

*Class 25: Clothing, footwear, headgear; trousers; jackets; outer wear; blouses; T-shirts; suits; braces; lingerie; underwear; leisure wear; casual wear; sports clothing, footwear and headgear; belts; shirts; socks; ties.*

*Class 35: Advertising; advertising services for others; business management; business administration; office functions; advertising and promotional services; marketing services; the bringing together, for the benefit of others, of a variety of goods and service providers, enabling customers to conveniently view and purchase those goods and select service providers, in a store retailing clothing, footwear, belts, headgear, hair care products and hair accessories, personal grooming products, jewellery and imitation jewellery, eye wear, sporting and leisure goods, leather goods and imitations of leather including bags, cases, wallets, purses and holdalls, stationery including cards and paper, toys, games, fabrics, textiles, furnishings, furniture, millinery, wedding apparel and also to select service providers in relation to the aforesaid; or from a merchandise catalogue including a catalogue for general retail of clothing, footwear, headgear, belts, headgear, hair care products and hair accessories, personal grooming products, jewellery and imitation jewellery, eye wear, sporting and leisure-goods, leather goods and imitations of leather including bags, cases, wallets, purses and holdalls, stationery including cards and paper, toys, games, fabrics, textiles, furnishings, furniture, millinery, wedding apparel and also to select service providers in relation to the aforesaid; or the aforesaid by mail order or by means of telecommunications, or the Internet, or from an internet website specializing in all the aforesaid; provision of information, advice and assistance in the selection of goods and selection of service providers brought together as above; consultancy, information and advisory services, including backup and helpline services, to all the aforesaid services.*

*Class 45: Hire of clothing, footwear, headgear; consultancy, information and advisory services to all the aforesaid services.*