

O-016-13

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2529550  
BY MAC GLOBAL LTD TO REGISTER THE TRADE MARK**

**FITZROY & MASON**

**IN CLASS 18**

**AND IN THE MATTER OF OPPOSITION  
THERE TO UNDER NO 100177  
BY FORTNUM & MASON PLC**

**AND**

**IN THE MATTER OF REGISTRATION NO 2343778  
IN THE NAME OF MAC GLOBAL LTD IN RESPECT OF THE TRADE MARK**

**FITZROY & MASON**

**IN CLASS 25**

**AND IN THE MATTER OF AN APPLICATION FOR INVALIDATION  
THERE TO UNDER NO 84307  
BY FORTNUM & MASON PLC**

## BACKGROUND

1) On 22 October 2009, Mac Global Ltd (“Mac”), applied under the Trade Marks Act 1994 (“the Act”) for registration of the mark FITZROY & MASON in respect of the following goods in Class 18 (Application No. 2529550):

*Leather and imitations of leather; animal skins, hides; trunks and travelling bags; handbags, rucksacks, purses; umbrellas, parasols and walking sticks; whips, harness and saddlery; clothing for animals.*

2) The application was published in the Trade Marks Journal on 20 November 2009 and on 22 February 2010, Fortnum & Mason plc (“F&M”) filed notice of opposition to the application.


3) Further, on 15 February 2012, F&M also filed an application for invalidation of Mac’s registered mark no. 2343778 for FITZROY & MASON that has a filing date of 18 September 2003 and completed its registration procedure on 20 February 2004. It is registered in respect of the following list of Class 25 goods:


*Articles of clothing for men, women and children.*


4) I will refer to both of Mac’s marks collectively as “the contested marks”. The grounds of opposition/invalidation are broadly similar in both sets of proceedings and are, in summary that:

- a) The contested marks offend under Section 5(2)(b) of the Act because they are both in respect of similar marks and in respect to identical or similar goods and services to a number of earlier marks in the name of F&M. This ground is raised against all of the goods listed in the contested marks.
- b) The contested marks offend under Section 5(3) because F&M claims that it is proprietor of earlier marks that enjoy a reputation, having been in business since the year 1707. It claims to sell a number of goods made from leather, such as leather aprons and leather bags. It claims that use of the contested marks, without due cause, would take unfair advantage of and/or be detrimental to the distinctive character and/or repute of its earlier marks. The table below provides the relevant details of its earlier marks relied upon for its Section 5(2)(b) and Section 5(3) grounds:

<b>Mark details and relevant dates</b>	<b>Relevant goods and services</b>	<b>Case and grounds where mark is relied upon</b>
963164  FORTNUM & MASON	<b>Class 29:</b> <i>Meat; fish, poultry and game, none being live; meat extracts; preserved, dried or cooked fruits and vegetables; jellies and dairy products, all for food; jams; edible oils, edible fats; fruit preserves, vegetable preserves and pickles.</i> <b>Class 30:</b> <i>Coffee, tea, cocoa, sugar, rice, tapioca,</i>	Section 5(2)(b) in the opposition and Section 5(3) in both the opposition and

<p>Filing date: 30 July 1970</p>	<p>sago, coffee essences and coffee extracts, mixtures of coffee and chicory; chicory and chicory mixtures, all for use as substitutes for coffee; flour and preparations made from cereals for food for human consumption, bread, biscuits (other than biscuits for animals), cakes, pastry, non-medicated confectionery, honey, treacle, baking powder, salt (for food), mustard, pepper, vinegar, sauces and spices (other than poultry spices).</p> <p><b>Class 32:</b> Non-alcoholic drinks and preparations for making such drinks, all included in Class 32.</p> <p><b>Class 33:</b> Wines, spirits (beverages) and liqueurs.</p> <p><b>Class 34:</b> Manufactured tobacco, cigars and cigarettes.</p>	<p>invalidation</p>
<p>2001737</p> <p>FORTNUM &amp; MASON</p> <p>Filing date: 10 November 1994 Registration date: 13 July 2001</p>	<p><b>Class 35:</b> The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a department store or in an airport retail outlet; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from a general merchandise catalogue by mail order, from a general merchandise Internet site or by means of telecommunications; advice and assistance in the selection of goods; provision of information to customers relating to goods.</p>	<p>Section 5(2)(b) and Section 5(3) in both the opposition and invalidation</p>
<p>IR(EU)*877106</p>  <p>Date of international registration: 14 December 2004 Date of protection in the EU: 14 December 2004</p>	<p><b>Class 18:</b> Bags; plastic shopping bags.</p> <p><b>Class 25:</b> Boots and shoes; clothing for use in the kitchen; pinafores; aprons; chefs hats.</p> <p><b>Class 29:</b> Meat, fish, poultry and game; meat extracts; caviar; pâté; partridge; grouse; pheasant; chicken; curried liver; curried mutton; curried chicken; fish pastes; hams; tongues; bacon; meat in tins, glasses and terriners; potted meats; beefs extracts; preserved, dried and cooked fruits and vegetables; fruits in tins and bottles; cherries; pineapple; fruit salads; apricots; pears; peaches; grapefruit; prunes; plums; figs; marrons; jellies; jams; marmalade; chutneys; mincemeat; soups; fruits sauces; dairy products; eggs; milk; milk products; edible oils and fats; preserves; fruit preserves, vegetable preserves; pickles; salad sauces; flavoured butter; brandy butter; dressings; pickled onions; cranberry sauce; soup and preparations for making soup.</p> <p><b>Class 30:</b> Coffee; tea; black tea; black tea in bags; green tea; green tea in bags; cocoa; artificial coffee; coffee essences and coffee extracts, mixture of coffee and chicory; chicory and chicory mixtures, all for use as substitutes for coffee; scented tea and flavoured tea; sugar; rice, tapioca, sago, coffee substitutes; flour, and preparations made from cereals; bread; spiced bread; biscuits; cakes; pastry and confectionery; ices; honey; treacle; yeast, baking powder; salt; mustard; pepper; vinegar; sauces; spices; ice; condiments, curry powder, and all edibles in tins and glasses; non-medicated confectionery; sugar confectionery; petit fours; salt (for food); relish sauces (excluding cranberry sauce and apple sauce); chutney; puddings; poppadums; pancakes.</p>	<p>Section 5(2)(b) and Section 5(3) in the opposition proceedings only</p>

	<p><b>Class 31:</b> <i>Agricultural, horticultural and forestry products and grain; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals; malt.</i></p> <p><b>Class 32:</b> <i>Beer, ale and porter; non-alcoholic drinks and preparations for making such drinks; mineral and aerated waters; soft drinks; dealcoholised beverages; fruit drinks and fruit juices.</i></p> <p><b>Class 33:</b> <i>Alcoholic beverages (except beers); wines, spirits and liqueurs; cider and perry; port wine the produce of the Alton Douro district of Portugal.</i></p> <p><b>Class 34:</b> <i>Tobacco, raw or manufactured; cigars, cigarettes; smokers' articles; matches.</i></p> <p><b>Class 35:</b> <i>The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a department store or in an airport retail outlet; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from a general merchandise catalogue by mail order, from a general merchandise Internet site or by means of telecommunications; advice and assistance in the selection of goods; provision of information to customers relating to goods.</i></p> <p><b>Class 39:</b> <i>Delivery services; delivery of goods; delivery of goods by mail; distribution of goods; storage of goods, transportation of goods; packaging of goods.</i></p>	
<p>2377903</p>  <p>Filing date: 12 November 2004 Registration date: 22 July 2005</p>	<p>The same as for IR(EU)877106, above.</p>	<p>Section 5(2)(b) and Section 5(3) in the opposition proceedings only</p>
<p>CTM#9036278</p> <p>FORTNUM &amp; MASON</p> <p>Filing date: 19 April 2010 Registration date: 28 October 2010</p>	<p><b>Class 35:</b> <i>the bringing together, for the benefit of others, of a variety of goods, namely, perfumery, cosmetics, shower gels, body lotions, printed matter, books, magazines, leather goods, luggage, wallets, passport holders, luggage tags, furniture, hampers, hampers containing food, household or kitchen utensils and containers, tea pots, tea strainers, caddy spoons, textiles and textile goods, tea towels, clothing, footwear, headgear, aprons, chefs' hats, games and playthings, decorations for Christmas trees, meat, fish, poultry and game, meat extracts, caviar, pate, partridge, grouse, pheasant, chicken, curried liver, curried mutton, curried chicken, fish pastes, hams, tongues, bacon, meat in tins, glasses and terrines, beef extracts, preserved, dried and cooked fruits and vegetables, fruits in tins and</i></p>	<p>Section 5(2)(b) and Section 5(3) in the invalidation proceedings only</p>

<p>Seniority claimed from UK registrations 963164 and 2001737</p>	<p>bottles, cherries, pineapple, fruit salads, apricots, pears, peaches, grapefruit, prunes, plums, figs, marrons, jellies, jams, marmalade, chutneys, mincemeat, soups, fruits sauces, dairy products, eggs, milk, milk products, edible oils and fats, preserves, fruit preserves, vegetable preserves, pickles, salad sauces, flavoured butter, brandy butter, dressings, pickled onions, cranberry sauce, soup and preparations for making soup, coffee, tea, black tea, black tea in bags, herbal teas, green tea, green tea in bags, cocoa, artificial coffee, coffee essences and coffee extracts, mixture of coffee and chicory, chicory and chicory mixtures, all for use as substitutes for coffee, scented tea and flavoured tea, sugar, rice, tapioca, sago, coffee substitutes, flour, and preparations made from cereals, bread, spiced bread, biscuits, cakes, pastry and confectionery, ices, honey, treacle, yeast, baking powder, salt, mustard, pepper, vinegar, sauces, spices, ice, condiments, curry powder, and all edibles in tins and glasses, non-medicated confectionery, sugar confectionery, petit fours, salt (for food), relish sauces (excluding cranberry sauce and apple sauce), chutney, puddings, poppadums, pancakes, beer, ale and porter, non-alcoholic drinks and preparations for making such drinks, mineral and aerated waters, soft drinks, non-alcoholic beverages, fruit drinks and fruit juices, alcoholic beverages (except beers), wines, spirits and liqueurs, cider and sherry, port wine, enabling customers to conveniently view and purchase those goods in a department store, in an airport retail outlet, from a general merchandise catalogue by mail order, a general merchandise Internet site or by means of telecommunications; advice and assistance in the selection of goods; provision of advisory and information services in relation to the aforesaid services.</p>	
<p>963169</p>  <p>Filing date: 30 July 1970</p>	<p><b>Class 29:</b> Meat; fish, poultry and game, none being live; meat extracts; preserved, dried or cooked fruits and vegetables; jellies and dairy products, all for food; jams; edible oils, edible fats; fruit preserves, vegetable preserves and pickles.  <b>Class 30:</b> Coffee, tea, cocoa, sugar, rice, tapioca, sago, coffee essences and coffee extracts, mixtures of coffee and chicory; chicory and chicory mixtures, all for use as substitutes for coffee; flour and preparations made from cereals for food for human consumption, bread, biscuits (other than biscuits for animals), cakes, pastry, non-medicated confectionery, honey, treacle, baking powder, salt (for food), mustard, pepper, vinegar, sauces and spices (other than poultry spice).  <b>Class 32:</b> Non-alcoholic drinks and preparations for making such drinks, all included in Class 32.  <b>Class 33:</b> Wines, spirits (beverages) and liqueurs.  <b>Class 34:</b> Manufactured tobacco, cigars and cigarettes.</p>	<p>Section 5(3) in the invalidation proceedings only</p>

\* International Registration designating the European Union

# Community Trade Mark

- c) The contested marks offend under Section 5(4)(a) of the Act because F&M claims an extensive and widespread goodwill attached to its sign FORTNUM & MASON, in the UK. It claims it has used its sign on a wide range of goods and services that are listed in the annex to this decision.

F&M asserts that a passing off right exists in the goodwill attached to its sign.

d) In the invalidation action, F&M claims that its earlier mark is “well known” in the UK within the meaning of Article 6bis of the Paris Convention in respect of the goods covered by Mac’s Class 25 goods. It, therefore, claims protection under Section 6(1)(c) and Section 56 of the Act. This was not actively pursued at the hearing and I do not see how it places F&M in a better position than that provided by the existence of its reputation (acknowledged by Mac in its counterstatement – see paragraph 5 below) in the UK. Consequently, I will not comment further on this claim.

4) All of the registrations relied upon by F&M are “earlier marks” as defined by Section 6(1)(a) of the Act, because they are registered marks which have a filing date that predates the contested marks, or in the case of F&M’s CTM 9036278 because it has valid claims to seniority as defined by Section 6(1)(b).

5) The applicant filed counterstatements denying F&M’s claims and putting it to proof of use in respect to all goods manufactured of leather, including leather bound books, leather aprons, leather bags and wallets, luggage tags and gloves. It was admitted that F&M is a retailer based in Piccadilly, London, established in the year 1707 and that it has acquired a substantial reputation in the UK, and worldwide, in the mark FORTNUM & MASON in respect of the retailing of food and food goods. It is conceded that F&M had used its marks in respect of food and food goods.

6) The two sets of proceedings were subsequently consolidated.

7) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. The matter came to be heard on 24 October 2012 when F&M was represented by Mr Leighton Cassidy and Mr Hastings Guise for Field Fisher Waterhouse LLP and Mac was represented by Mr Malcolm Chapple, of Counsel, instructed by Lawrence Sternberg & Co.

### **F&M’s Evidence**

8) This takes the form of two witness statements by Nigel McGinley, Finance Director of F&M. The first was submitted in support of F&M’s case in the opposition proceedings, the second filed later and in respect of the invalidation proceedings. As the proceedings are consolidated, these statements are common to both sets of proceedings. In the first witness statement, Mr McGinley explains that F&M was founded in 1707, that it operates from its flagship shop in Central London, from duty free shops “in all major UK airports”, from its online shop as well as numerous overseas outlets. He further states that F&M has a reputation “as one of the leading providers of specialist groceries and delicatessen goods in the world”. Over the centuries F&M has expanded its

business to include retail of wines and spirits, gift products, household and kitchen goods as well as a tea shop and several restaurants run from its London store.

9) Mr McGinley states that the high quality of produce selected by F&M has contributed to a large and loyal customer base and that, over the years, it has held two Royal Warrants, being appointed grocers and provision merchants to Her Majesty the Queen and His Royal Highness the Prince of Wales. Mr McGinley provides the following turnover figures:

<b>Year</b>	<b>Revenue (£)</b>
2005/2006	37.5 million
2006/2007	39.1 million
2007/2008	45.6 million
2008/2009	46.6 million
2009/2010	50.9 million

10) Mr McGinley states that F&M does not engage in large scale advertising campaigns “since to do so would be at odds with the more intimate and personal shopping experience which [it] offer[s] to [its] customers”. However, F&M does produce a fortnightly e-mail magazine sent to its customers and also produces catalogues, particularly at Christmas time. These catalogues have, from time to time, included leather goods. At Exhibits NMcG1 to NMcG9, Mr McGinley provides copies of extracts from catalogues produced in a number of years between 1964 and 1998 illustrating such “own-branded” goods and also goods produced by others, but sold by F&M. Also, shop details are provided indicating retail activity related to the following goods:

- various women’s shoes;
- men’s leather jackets;
- men’s jumpers, trousers, shirts, shoes and jackets;
- shawls and scarves;
- women’s leather belts;
- women’s hats

11) In addition, at Exhibits NMcG10 to NMcG18, Mr McGinley also provides copies of extracts from more recent catalogues (2006 to 2010) and from its e-mail magazine (2007 to 2009). These illustrate the retailing of goods including leather travel holders, handbags, briefcases and bags, leather wallets, flasks with leather cases, leather wine carriers, games made of leather, pashminas and stoles, silk purses, socks and scarves and leather jewellery boxes,

12) FORTNUM & MASON branded goods are shown in Exhibit NMcG16, being an extract from the Christmas catalogue 2008 and includes a canvas tote bag, gardening gloves, leather waist apron and ladies wellies.

13) At Exhibit NMcG19, Mr McGinley provides a copy of F&M's "press book" for July 2008. This has over 120 copies of newspaper or magazine articles that mention or refer to FORTNUM & MASON or of TV listings where FORTNUM & MASON is mentioned e.g. an episode of *Masterchef* that was filmed at a restaurant in F&M's department store. Mr McGinley states that similarly sized "press books" exist for other months.

14) Mr McGinley states that F&M sold around 4000 leather goods items between 2004 and 2009, amounting to sales of "well over a hundred thousand pounds".

15) In his second witness statement, Mr McGinley states that F&M has produced and/or retailed a wide range of clothing and accessories and includes third party brands, ranges made exclusively for F&M and also goods sold directly under the FORTNUM & MASON brand. He provides the following sales figures in respect to these:

Year	Total Sales (£)
1998/1999	4.4 million
1999/2000	4.7 million
2000/2001	4.7 million
2008/2009	1.1 million
2010/2011	1.4 million

16) Mr McGinley states that retail of clothing was a significant element of F&M's business. By way of example he states that in 2000/2001, clothing retail amounted to almost 15% of its overall revenue.

### **Mac's Evidence**

17) This takes the form of a witness statement by Paul Maclennan, company director and chief executive of Mac. He explains that Mac is a designer, manufacturer, importer and distributor of smart leisure clothing and associated products with a "cross over transatlantic feel" with its clothing being modelled on "a classic American look, but with a deliberately „up market' English detail" and "the look and feel of something a bit special and classic, ie a heritage angle ...". He states that the brand has been sold through the "more popular and high turnover retail outlets". Mac's mark has been used since the beginning of 2009.

18) A sales analysis of FITZROY & MASON goods provided at Exhibit PM1 illustrates sales of £416,756 between May 2009 and July 2011. These sales appear to be predominantly in respect of sweatshirts and t-shirts, but invoices are also listed that are described as relating to "Purse & Keyring Set", "Accessories Gift Set", "Woven Short" and "Track Pant". Mr Maclennan states that the brand has been distributed through retailers such as *TK Maxx*, *Play.com* and *Sports Direct*. He also states "that there has been no reported instance of confusion" with F&M's marks.



## **F&M's Evidence in reply**

19) This takes the form of another witness statement by Mr McGinley. He provides extracts from a number of websites that describe FORTNUM & MASON as being “firmly rooted in the nation’s heritage” and others talking about the store’s “quintessentially English” character.

20) Mr McGinley points out that the names FITZROY and MASON do not evoke ideas of tradition or heritage, but that the “heritage feel” of the mark FITZROY & MASON stems from the combination of the two words because it recalls FORTNUM & MASON

## **DECISION**

### **The Law**

21) The invalidation case has proceeded to final determination on the basis of Section 5(2)(b), Section 5(3) and Section 5(4)(a) of the Act, with such grounds being relevant in invalidation proceedings in view of the provisions of Section 47 of the Act. The relevant parts of Section 47 of the Act read as follows:

“**47.** - (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

(2) The registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

Unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2A)\* But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

- (a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,
- (b) the registration procedure for the earlier trade mark was not completed before that date, or
- (c) the use conditions are met.

(2B) The use conditions are met if -

- (a) within the period of five years ending with the date of the application for the declaration 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) it has not been so used, but there are proper reasons for non-use.

(2C) 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, and
- (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(2D) In relation to a Community trade mark or international trade mark (EC), any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Community.”

22) The opposition proceedings are also based upon essentially the same grounds. The sections of the Act relevant to both sets of proceedings are identical and are reproduced below:

“5.-(1) ...

(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.”

**5.-(3)** A trade mark which –

(a) is identical with or similar to an earlier trade mark,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC), in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

**5.-(4)** A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) .....

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark”.

23) I will consider the opposition case and invalidation case together, but keeping in mind that the earlier marks relied upon differ slightly and the analysis of goods and services will be different.

### **Proof of use**

24) At the hearing, Mr Chappel conceded that F&M had demonstrated use in respect of all the goods and services relied upon. However, Mr Chappel’s position was that in respect to the Class 35 specification relied upon in earlier marks 2001737, 2377903 and IR(EU) 877106, the phrase “the bringing together, for the benefit of others, of a variety of goods” cannot be assumed to relate to clothing or leather goods because such goods are not specifically listed. I will discuss this point in more detail later, but it is sufficient here, that I record Mr Chappel’s concession regarding proof of use.

## Consideration of the case under Section 5(2)(b)

25) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the Court of Justice of the European Union (CJEU) 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 (LIMONCELLO). 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 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; *LIMONCELLO*

### ***Comparison of goods and services***

26) 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 CJEU 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.’

27) Other factors may also be taken into account such as, for example, the distribution channels of the goods concerned (see, for example, *British Sugar Plc v James Robertson & Sons Limited (TREAT)* [1996] RPC 281).

Opposition proceedings against 2529550 in Class 18

28) I produce a table below that lists Mac’s goods together with the goods and services that I believe represent F&M’s best case:

<b>F&amp;M’s most relevant goods and services</b>	<b>Mac’s goods</b>
<p><b>Class 18:</b> <i>Bags; plastic shopping bags.</i></p> <p><b>Class 25:</b> <i>Boots and shoes; clothing for use in the kitchen; pinafores; aprons; chefs hats.</i></p> <p>(As listed in IR(EU) 877106)</p> <p><b>Class 35:</b> <i>The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a department store or in an airport retail outlet; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from a general merchandise catalogue by mail order, from a general merchandise Internet site or by means of telecommunications; advice and assistance in the selection of goods; provision of information to customers relating to goods.</i></p> <p>(As listed in 2001737 and IR(EU) 877106)</p>	<p><b>Class 18:</b> <i>Leather and imitations of leather; animal skins, hides; trunks and travelling bags; handbags, rucksacks, purses; umbrellas, parasols and walking sticks; whips, harness and saddlery; clothing for animals.</i></p>

29) As part of my consideration it is necessary to make a finding regarding the scope of F&M’s Class 35 specification. At the hearing, Mr Chapple submitted that as the services listed fail to identify which goods they relate, it is wrong to assume that they phrase “variety of goods” should be interpreted as relating to all goods. He further submitted that, consequently, they should be interpreted as having the lowest scope of protection. I reject this submission. The earlier mark was registered before the CJEU’s judgment in Case C-418/02, *Praktiker Bau- und Heimwerkermärkte* that provided guidance regarding acceptable ways to represent retail-type services in trade mark lists of services. This guidance is that the applicant must be required to specify the goods or types of goods to which

the services relate. Clearly, F&M's specification does not comply with such guidance, and neither was it required to, with the mark being registered before the judgment. However, there is further guidance that is relevant to my considerations. In particular, I am mindful of the guidance provided in *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] F.S.R. 267 (HC) where the court advised that word in specifications should be given their natural meaning and construed by reference to their context.

30) Taking this guidance into account, it is clear to me that I would be incorrect to adopt such a narrow interpretation of the specification in the way that Mr Chapple contends. Rather, I must give the specification its natural meaning. In doing this, it is equally clear to me that as it is not limited to any particular goods, an ordinary meaning that will be attached to the specification is that the terms cover services relating to all goods that may be available from a "general merchandise" retailer. A general merchandise retailer may well sell all of the types of goods listed in Mac's application. Consequently, I will consider the similarity of goods and services assuming that the services listed in F&M's Class 35 specification include such services relating to the retailing of identical goods that are covered by Mac's Class 18 specification.

31) In this respect, the General Court ("the GC"), in *Oakley, Inc. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-116/06, commented as follows:

"61. Thus, it must be held that „retail and wholesale services, including on-line retail store services', on account of the very general wording, can include all goods, including those covered by the earlier trade mark. Therefore, it must be held that „retail and wholesale services, including on-line retail store services', display similarities to the goods concerned."

32) Similarly in this case, I conclude that F&M's services display similarities to Mac's goods.

33) In addition, it is self-evident that F&M's *bags* are identical to Mac's *travelling bags* and *handbags*. Mac's goods are covered by F&M's broad term. Finally, whilst Mac's *trunks* and *rucksacks* may not be understood to be covered by the term *bags*, they are certainly highly similar when taking account of their intended purpose, methods of use and trade channels.

#### Invalidation proceedings against 2343778 in Class 25

34) I produce a table below that lists Mac's goods together with the goods and services that I believe represent F&M's best case:

<b>F&amp;M's most relevant goods and services</b>	<b>Mac's goods</b>
<p><b>Class 35:</b> <i>the bringing together, for the benefit of others, of a variety of goods, [...], enabling customers to conveniently view and purchase those goods in a department store, in an airport retail outlet, from a general merchandise catalogue by mail order, a general merchandise Internet site or by means of telecommunications; advice and assistance in the selection of goods; provision of advisory and information services in relation to the aforesaid services.</i></p> <p>(as listed in CTM 9036278 and insofar as reflects the seniority claim to 2001737)</p>	<p><b>Class 25:</b> <i>Articles of clothing for men, women and children.</i></p>

35) The issue here is the same as that explored in paragraphs 29 – 32 above. In light of my finding that as F&M's description of its services is not limited to any particular goods and will relate to any goods that may be available from a "general merchandise" retailer. Such a retailer may well sell articles of clothing. Consequently, in light of my earlier findings, it follows that there is similarity between the respective goods and services.

***The average consumer***

36) Matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, paragraph 23), who is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*, paragraph 27). The degree of care and attention the average consumer uses when selecting goods and services can, however, very depending on what is involved (see, for example, the judgment of the GC in *Inter-Ikea Systems B.V. v. OHIM*, Case T-112/06).

37) In respect of clothing, I am mindful of the comments of Mr Simon Thorley, sitting as the Appointed Person, in *React trade mark* [2000] R.P.C. 285:

"There is no evidence to support Ms Clark's submission that, in the absence of any particular reputation, consumers select clothes by eye rather than by placing orders by word of mouth. Nevertheless, my own experience tells me it is true of most casual shopping. I have not overlooked the fact that catalogues and telephone orders play a significant role in this trade, but in my experience the initial selection of goods is still




made by eye and subsequent order usually placed primarily by reference to a catalogue number. I am therefore prepared to accept that a majority of the public rely primarily on visual means to identify the trade origin of clothing, although I would not go so far as to say that aural means of identification are not relied upon.”

38) The General Court (GC) has continued to identify the importance of visual comparison when considering the purchasing act in respect of clothing (see for example Joined Cases T-117/03 to T-119/03 and T-171/03 *New Look Ltd v OHIM (NLSPOORT et al)* [2004] ECR II-3471 at [49]-[50] and Case T-414/05 *NHL Enterprises BV v OHIM (LA KINGS)* [2009] ECR II.). There is no evidence in the current case that would direct me to a finding that differs to this and it is reasonable that I apply Mr Thorley’s comments here. Further, the same findings can be extended to other fashion items such as Mac’s Class 18 goods and also the retail of these and clothing. All these goods and services will generally be described as consumer items/services and will involve a reasonable degree of care and attention but not the highest degree of attention. As Mr Thorley noted, the purchasing process is primarily a visual one but I do not ignore the aural considerations that may be involved.

**Comparison of marks**

39) In respect of the opposition action against Mac’s 2529550 application, when discussing the similarity of goods and services, I identified F&M’s earlier marks 2001737 and IR(EU) 877106 as providing it with its best case, therefore, the respective marks for comparison in the opposition are:

F&M’s marks	Mac’s mark
<p data-bbox="472 1245 792 1276">FORTNUM &amp; MASON</p> 	<p data-bbox="857 1289 1149 1320">FITZROY &amp; MASON</p>

40) Similarly, in respect of the invalidation action against Mac’s 2343778 registration, I identified F&M’s CTM 9036278 as providing it with its best case, therefore, the respective marks for comparison in the invalidation action are:

F&M’s mark	Mac’s mark
<p data-bbox="464 1686 784 1717">FORTNUM &amp; MASON</p>	<p data-bbox="849 1686 1143 1717">FITZROY &amp; MASON</p>

41) Despite the differences between the two earlier marks that provide F&M with its best case, I will consider the issue of the comparison of marks as a single issue (but identifying, where necessary, the different considerations that result from F&M’s different marks)

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 BV v. Puma AG*, para 23).

43) In respect of F&M's word and device mark, the words FORTNUM & MASON are more dominant than the device element. These words are placed in front of the device element that is a rather detailed line drawing of an indistinguishable, round heraldic-type device flanked by two people, both standing in front of, what appears to be ornate doorways. The position of this device behind the word elements reduces its dominance in the mark, and whilst it cannot be ignored, it cannot be considered as the dominant element of the mark. Additionally, the mark also includes the words and date "Piccadilly since 1707". This merely provides information regarding F&M's date of establishment and its location and, consequently, has no distinctive character. Whilst the name FORNTUM appears first, it shares equal prominence in the mark with the name MASON and I conclude that no one of these two names dominates over the other but that, together, they form the dominant and distinctive element of the mark.

44) F&M's word mark and also Mac's mark both consist of two surnames separated by an ampersand. As I commented upon above, no one of the two names dominates over the other but that, together, they form the dominant and distinctive element of the mark.

45) Turning to the visual comparison of the marks, F&M's word and device mark shares similarities to Mac's mark in that it includes a word element consisting of two surnames separated by an ampersand. Further, the second surname in each mark is the same, namely MASON and the first surname in each mark both contain seven letters and begins with the letter "F". All the additional elements present in F&M's mark are points of difference as Mac's mark does not contain any additional elements. Taking all of this into account, I conclude that the respective marks share a moderately low level of visual similarity.

46) In respect of the comparison of F&M's word only mark with Mac's mark, the level of similarity is higher than discussed above because of the absence of the additional elements in F&M's mark. The comparison is between two marks that both consist exclusively of two surnames separated by an ampersand. As I have already identified, they share the same first letter and number of letters overall and the second surname in each mark is the same. Taking all of this into account, the marks share a moderate level of similarity.

47) Aurally, the consumer is unlikely to attempt to say the descriptive words present in F&M's word and device mark and, consequently, as the remaining words are the same as in its word only mark, the aural comparison with Mac's mark will be the same. F&M's mark is likely to be pronounced as five syllables

FORT-NUM-AND-MASE-ON (with the fourth syllable being pronounced as in BASE). On the other hand, Mac's mark is likely to be pronounced as the five syllables FITZ-ROY-AND-MASE-ON. The first syllables are similar in that they share the same first letter sound, but in other respects there is no similarity, the second syllables are dissimilar and the last three syllables are identical. Taking all of this into account, I conclude that the respective marks share a moderate level of aural similarity.

48) Conceptually, Mac's mark is very likely to be perceived as indicating two persons, one with the surname FITZROY, the other with the surname MASON. F&M's mark is also very likely to be perceived as a reference to two people, one with the surname FORTNUM, the other person with the surname MASON. Consequently, the second name present in both marks may be perceived as a reference to the same person, or at least to two persons sharing the same surname. However, the first name in each mark will clearly be perceived as a reference to different people. At the hearing, Mr Guise argued that both marks conjure up impressions of tradition and heritage, however, the only evidence on this point goes to the reputation endowed in F&M's mark of tradition and heritage. However, as I shall discuss below, the reputation relied upon is not relevant for my considerations under Section 5(2). Consequently, I conclude that such a concept is not, prima facie, evident in any of the marks. Whilst F&M's word and device mark includes additional matter, this will not impinge upon this conceptual identity. Taking all of this into account I conclude the respective marks share a moderate level of conceptual similarity.

49) Taking all of the above factors into account, I conclude that the respective marks share a moderate level of similarity overall.

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

50) I must consider the distinctive character of the earlier mark because the more distinctive it is, either by inherent nature or by use the greater the likelihood of confusion (*Sabel BV v Puma AG* [1998] RPC 199). The distinctive character of the earlier mark must be assessed by reference to the goods for which it is registered and by reference to the way it is perceived by the relevant public (*Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91). The earlier marks consist of, or contain, the two surnames FORTNUM and MASON separated by an ampersand. F&M's CTM also contains the device element and additional, non-distinctive words. As surnames, both FORTNUM and MASON are endowed with an ordinary level of distinctive character. As family names they serve to identify any of numerous individuals from families identified by these surnames. Consequently, they are not of the highest level of distinctive character. In respect to F&M's CTM, the addition of the device element serves to enhance the ordinary level of distinctive character to a small degree.

51) 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. It is common ground that F&M has a reputation in respect of food, food goods and the retail of the same. F&M do not rely upon any wider reputation, as confirmed by Mr Guise at the hearing. Consequently, the acknowledged reputation of the FORTNUM & MASON marks is only in respect to goods and services that are not similar to those of Mac. Therefore, there can be no enhanced distinctiveness in F&M's marks in respect of any goods and services that are considered to be similar or identical to those of Mac. Accordingly, I must conclude that, for the purposes of Section 5(2)(b), the distinctive character of F&M's marks is not enhanced through use in respect of the relevant goods and services.

### ***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). I must take into account all factors relevant to the circumstances of the case, in particular the interdependence between the similarity of the marks and that of the goods or services designated (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*)

53) Mr Guise drew my attention to numerous cases that he contended lends support to his submission that there is a likelihood of confusion between F&M's marks and Mac's mark. I am not bound by these cases and I must consider the matters before me, however, there are a number of specific comments I wish to make regarding these cases. Firstly, Mr Guise referred me to the decision of Richard Arnold QC, sitting as the Appointed Person in *KENNEDY FRIED CHICKEN Trade Mark*, O-227-04 where a likelihood of confusion was found with the mark KENTUCKY FRIED CHICKEN. There is a significant difference between that case and the current case. Unlike the proprietor of the earlier mark in those proceedings, F&M does not rely upon a reputation in respect of any goods that are similar or identical to Mac's goods. Enhanced distinctiveness through use (in respect of identical services) was a major factor in the earlier case. Consequently, I do not find it persuasive.

54) Mr Guise also directed me to two Registry decisions that he considered analogous to the current proceedings. The first of these is *DAISY & JACK Trade Mark*, O-365-01, where the hearing officer found that there was a likelihood of confusion between the marks DAISY & JACK and device and DAISY & TOM and device. There are some important differences between this and the current case. The hearing officer noted that the dominant and distinctive element, namely the first element was identical (unlike in the current case). Secondly, the device elements of the respective marks, whilst different were judged by the hearing officer as "fairly typical elements ... that might be used in relation to goods intended to appeal to children". The existence of such devices may influence the

consumer's perception of the marks. For these reasons, the case is not on "all-fours" with the current case.

55) The third case, is *FACETS OF LOVE Trade Mark*, O-440-10, where the hearing officer found a likelihood of confusion between the marks FACETS OF LOVE and FACETS OF DESIRE, both in respect of jewellery. As the marks do not involve surnames, are of different structure and have very similar conceptual meanings, I do not consider this case to be on "all-fours" with the current case.

56) Mr Chappel argued that as there have been no instances of actual confusion, then this supports a finding that there will be no likelihood of confusion. There is a tranche of case law to the effect that lack of confusion in the market place is indicative of very little. See, for example, *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283, *Rousselon Freres et Cie v Horwood Homewares Limited* [2008] EWHC 881 (Ch), *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 and *Aceites del Sur-Coosur SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-498/07 P*. In *The European Limited v The Economist Newspaper Ltd* Millet LJ stated:

"Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark."

57) In *Compass Publishing BV v Compass Logistics Ltd* Laddie J stated:

"22. It is frequently said by trade mark lawyers that when the proprietor's mark and the defendant's sign have been used in the market place but no confusion has been caused, then there cannot exist a likelihood of confusion under Article 9.1(b) or the equivalent provision in the Trade Marks Act 1994 ("the 1994 Act"), that is to say s. 10(2). So, no confusion in the market place means no infringement of the registered trade mark. This is, however, no more than a rule of thumb. It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale

where direct competition between the proprietor and the alleged infringer could take place.”

58) However, having acknowledged this, it is my view that there is no likelihood of confusion. This is because there are a number of factors, that when taken into account as part of the global appreciation test, lead me to conclude that the consumer is not likely to be confused. Firstly, the consumer is very familiar of the concept of differentiating between people and families by reference to surnames and FITZROY and FORTNUM are both surnames that share little resemblance to each other except for their initial letter. Secondly, despite this, the surname MASON is reasonably common and, as such, reduces the likelihood of consumers assuming that when seeing this surname in the context of the two marks being considered here that it is a reference to the same family or person. Rather it is equally likely to be perceived as indicating a completely different person or family that happens to have the same surname. When factoring this with imperfect recollection, that the degree of attention during the purchasing act being reasonable, but not the highest and that in respect of bags at least, the respective goods are identical, I find that the difference in the first name of each mark is sufficient that it is not likely that the consumer will be confused.

59) This finding is not disturbed by Mr Guise’s submission that both FITZROY and FORTNUM have connotations of class. There is nothing before me that indicates this. Whilst I recognise that F&M has a reputation for quality and tradition, but this in respect of goods and services that are not similar to those of Mac and is identified by its mark FORTNUM & MASON and not by the surname FORTNUM alone.

60) In summary, there is no likelihood of confusion and, consequently the opposition and the invalidation, insofar as they are based upon Section 5(2)(b) of the act, fail in their entirety.

#### **Consideration of the case under Section 5(4)(a)**

61) The requirements for this ground have been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *WILD CHILD Trade Mark* [1998] R.P.C. 455. The three elements that must be present can be summarised as follows:

(1) that the opponents’ goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the applicant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the applicant are goods or services of the opponents;  
and

(3) that the opponents have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the applicant's misrepresentation.

### The Relevant Date

62) In respect to both the opposition and the invalidation proceedings, the relevant date for determining the F&M's claim will be the filing date of Mac's application and registration (*Last Minute Network Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Joined Cases T-114/07 and T-115), that is to say 22 October 2009 in respect to the opposition proceedings and 18 September 2003 in respect to the invalidation action. The earlier rights must have been acquired prior to these dates (Article 4.4(b) of First Council Directive 89/104 on which the UK Act is based). The position at an earlier date may also be relevant. It could establish a senior user status, or that there has been common law acquiescence or that the status quo should not be disturbed as the parties have a concurrent goodwill (*Croom's Trade Mark Application* [2005] RPC 2 and *Daimlerchrysler AG v Javid Alavi (T/A Merc)* [2001] RPC 42). From the facts of the two current cases it is clear that F&M is the senior user in both, with use dating back to the year 1707. No case has been advanced regarding acquiescence or concurrent goodwill. Therefore, the only relevant dates in the consideration of these grounds are 22 October 2009 (in the case of the opposition) and 18 September 2003 (in the case of the invalidation proceedings).

### Goodwill

63) In order to make an assessment of whether or not F&M has goodwill in a business conducted under the FORTNUM & MASON mark, I would normally need to have sufficient information to reach an informed conclusion (see *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 and *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat)). In the current case, there is common ground between the parties that F&M has a long established goodwill attached to its mark in respect of food products and the retailing of food. At the hearing, it was stated that F&M does not rely upon any wider goodwill.

### Misrepresentation and damage

64) Having reached this conclusion, I must go on to consider if there has been misrepresentation and whether any such misrepresentation is such as to cause damage to F&M. In this respect, I am mindful of the comments of Morritt L J in the Court of Appeal decision in *Neutrogena Corporation and Anr. V Golden Limited and Anr.* [1996] RPC 473 when he confirmed that the correct test on the issue of deception or confusion was whether, on the balance of probabilities, a substantial number of the opponent's customers or potential customers would be

misled into purchasing the applicant's products in the belief that it was the opponent's. Further, Lord Fraser in *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1980] RPC 31 HL, stated that the opponent must show that "he has suffered, or is really likely to suffer, substantial damage to his property in the goodwill".

65) F&M rely upon its goodwill attached to its sign FORTNUM & MASON in respect to its food products. Such goods are not similar to, or even in the same field of activity as Mac's goods. In considering this point, I am mindful of the comments of Millet LJ in *Harrods v Harrodian School* [1996] RPC 697, where he stated:

"It is not in my opinion sufficient to demonstrate that there must be a connection of some kind between the defendant and the plaintiff, if it is not a connection which would lead the public to suppose that the plaintiff has made himself responsible for the quality of the defendant's goods or services"

In the same case he went on to state:

"The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration."

And

"The name "Harrods" may be universally recognised, but the business with which it is associated in the minds of the public is not all embracing. To be known to everyone is not to be known for everything."

66) An absence of a common field of activity will mitigate against a risk of misrepresentation. It will also mitigate against there being a risk of damage as per the judgment of Slade LJ in *Stringfellow v McCain Foods (GB) Ltd* [1984] RPC 501:

"even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one."

67) F&M's argument, as presented at the hearing, is that Mac's mark represents high quality heritage by virtue of association with F&M's goodwill. I do not consider that this case is made out when taking account of the different fields of activity involved and the difference in the marks. As I have already said,



consumers are able to easily differentiate between surnames and will identify the differences between the first elements of the respective marks, namely FITZROY and FORTNUM. The fact that the second surname is relatively common and not unusual is likely to result in the consumer not being misled into believing that it is purchasing F&M's goods.

68) In summary, taking all the relevant factors into account, I conclude that use of Mac's mark in respect of the goods listed in its specification will not result in misrepresentation or damage of F&M's goodwill.

### **Consideration of the case under Section 5(3)**

69) The scope of Section 5(3) has been considered in a number of cases notably *General Motors Corp v Yplon SA* (CHEVY) [1999] ETMR 122 and [2000] RPC 572, *Adidas Salomon AG v Fitnessworld Trading Ltd.* [2004] ETMR 10, *Premier Brands UK Limited v Typhoon Europe Limited* (TYPHOON) [2000] FSR 767, *Daimler Chrysler v Alavi* (MERC) [2001] RPC 42, *C.A. Sheimer (M) Sdn Bhd's TM Application* (VISA) [2000] RPC 484, *Valucci Designs Ltd v IPC Magazines* (LOADED) O/455/00, *Mastercard International Inc and Hitachi Credit (UK) Plc* [2004] EWHC 1623 (Ch), *Electrocoin Automatics Limited and Coinworld Limited and others* [2005] FSR 7, *Davidoff & Cie SA v Gofkid Ltd* (DAVIDOFF) [2003] ETMR 42, *Intel Corporation Inc. v CPM United Kingdom Ltd* (INTEL) [2009] RPC 15, *L'Oreal v Bellure* [2010] RPC 1 and *Whirlpool Corp v Kenwood Limited* [2010] RPC 2.

70) The applicable legal principles arising from these cases are as follows:

- a) „Reputation’ for the purposes of Section 5(3) means that the earlier mark is known by a significant part of the public concerned with the products or services covered by that mark (paragraph 26 of the CJEU's judgment in *CHEVY*).
- b) Under this provision the similarity between the marks does not have to be such as to give rise to a likelihood of confusion between them; the provision may be invoked where there is sufficient similarity to cause the relevant public to establish a link between the earlier mark and the later mark or sign (*Adidas Salomon v Fitnessworld*, paragraphs 29-30).
- c) Whether there is a link, within the meaning of *Adidas-Salomon and Adidas Benelux*, between the earlier mark with a reputation and the later mark must be assessed globally, taking into account all factors relevant to the circumstances of the case (*INTEL*).
- d) The fact that, for the average consumer, who is reasonably well informed and reasonably observant and circumspect, the later mark calls the earlier mark with a reputation to mind is tantamount to the existence of

such a link between the conflicting marks, within the meaning of *Adidas-Salomon and Adidas Benelux*. (*INTEL*)

e) The stronger the earlier mark's distinctive character and reputation the easier it will be to accept that detriment has been caused to it (per Neuberger J. in *Premier Brands*, and the CJEU in *CHEVY*, paragraph 30).

f) Whether use of the later mark takes or would take unfair advantage of, or is or would be detrimental to, the distinctive character or the repute of the earlier mark, must be assessed globally, taking into account all factors relevant to the circumstances of the case (*INTEL*).

g) Unfair advantage is taken of the distinctive character or the repute of the earlier trade mark where there is clear exploitation and free-riding on the coat-tails of a famous mark or an attempt to trade upon its reputation (*Spa Monopole v OHIM*).

h) The use of the later mark may be detrimental to the distinctive character of the earlier mark with a reputation even if that mark is not unique; a first use of the later mark may suffice to be detrimental to the distinctive character of the earlier mark; proof that the use of the later mark is or would be detrimental to the distinctive character of the earlier mark requires evidence of a change in the economic behaviour of the average consumer of the goods or services for which the earlier mark was registered consequent on the use of the later mark, or a serious likelihood that such a change will occur in the future (*INTEL*).

i) Taking unfair advantage of the distinctive character or repute of a mark relates not to detriment caused to the earlier mark but to the advantage taken by the third party. Such an advantage may be unfair even where the use is not detrimental to the distinctive character or to the repute of the mark (*L'Oreal v Bellure*). It is not sufficient to show that an advantage has been obtained. There must be an added factor of some kind for that advantage to be categorised as unfair (*Whirlpool Corp v Kenwood Limited*).

### **Reputation**

71) It was conceded in Mac's counterstatements, and reiterated by Mr Chappel at the hearing, that F&M has a "significant reputation" in respect to food, food products and the retailing of the same. Further, Mr Guise confirmed that F&M only relies upon its reputation in respect of these same goods and services. Consequently, it is not necessary for me to consider whether F&M's reputation also extends to *bags or boots and shoes, clothing for use in the kitchen, pinafores, aprons or chefs hats* (as covered by F&M's Class 18 and Class 25 specifications in its earlier marks IR(EU)877106 and 2377903).

## ***The Link***

72) Having established the existence and scope of a reputation, I need to go on to consider the existence of the necessary link. I am mindful of the comments of the CJEU in *INTEL* that it is sufficient for the later mark to bring the earlier mark with a reputation to mind for the link, within the meaning of *Adidas-Salomon and Adidas Benelux*, to be established. The CJEU also set out the factors to take into account when considering if the necessary link exists:

“41. The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case (see, in respect of Article 5(2) of the Directive, *Adidas-Salomon and Adidas Benelux*, paragraph 30, and *adidas and adidas Benelux*, paragraph 42).

42. Those factors include:

- the degree of similarity between the conflicting marks;
- the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;
- the strength of the earlier mark’s reputation;
- the degree of the earlier mark’s distinctive character, whether inherent or acquired through use;
- the existence of the likelihood of confusion on the part of the public.”

73) I will restrict my consideration to F&M’s word mark because if it is not successful relying upon this mark, it will not be successful in respect to any of its earlier marks. I have already concluded that the respective marks share only a moderate level of similarity. I have also found that the respective goods and services do not share any similarity, and it follows that there is no likelihood of confusion. F&M’s earlier mark is endowed with an inherent ordinary level of distinctive character, but this is enhanced through its significant reputation in the field of food and retailing of food as a result of F&M’s use of its mark over many years. Nevertheless, when factoring all of the relevant points into my consideration, I conclude that the distance between the respective goods and services and the differences between the marks, in particular, are such as for F&M’s mark not to be brought to mind when he/she encounters Mac’s mark. It has been argued, on behalf of F&M, that Mac’s mark conjures up an impression of quality and heritage, but no evidence has been submitted as to why this is so

and even if it was the case, the mere fact that both marks may create such an impression is not sufficient to create the necessary link.

74) In summary, I find that the necessary link does not exist between the respective marks and as a consequence there can be no unfair advantage or detriment and the attacks based upon Section 5(3) of the Act fail in their entirety.

## **COSTS**

75) Both the opposition and the invalidation action having failed, Mac is entitled to a contribution towards its costs. I take account of the fact that both sides filed evidence and that a hearing has taken place. I award costs on the following basis:

Considering Notice of Opposition/Application for invalidation and corresponding statements	£400
Statement of cases in reply	£400
Preparing and filing evidence	£500
Considering evidence	£250
Preparing for, and attending hearing	£900
<b>TOTAL</b>	<b>£2450</b>

76) I order Fortnum & Mason plc to pay Mac Global Ltd the sum of £2450. 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 11th day of January 2013**

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

**ANNEX**

List of goods and services in F&M's statement of grounds that it claims use, in support of its grounds based upon Section 5(4(a))

*Cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; shower gels; body lotions*

*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*

*Paper, cardboard and goods made from these materials, not included in other classes; printed matter; photographs; stationery; artists' materials; office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); address books; books; cookery books; food and wine books; magazines; calendars; advent calendars; passport holders*

*Leather and imitations of leather, and goods made of these materials and not included in other classes; trunks and travelling bags; umbrellas, parasols and walking sticks; harness and saddlery; bags; luggage; wallets; luggage tags*

*Furniture, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics; hampers*

*Household or kitchen utensils and containers (not of precious metals or coated therewith); combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; un-worked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes; tea pots; tea strainers*

*Textiles and textile goods, not included in other classes; bed and table covers; tea towels*

*Clothing, footwear, headgear; boots and shoes; clothing for use in the kitchen; pinafores; aprons; chefs' hats*

*Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees; Christmas crackers*

*Meat, fish, poultry and game; meat extracts; conserves; compotes; fruit conserves; caviar; pâté; partridge; grouse; pheasant; chicken; curried liver; curried mutton; curried chicken; fish pastes; hams; tongues; bacon; meat in tins, glasses and terriners; beefs extracts; preserved, dried, cooked and frozen fruits, vegetables, meats and fish; dry and boiled fruit; fruits in tins and bottles; cherries;*

*pineapple; fruit salads; apricots; pears; peaches; grapefruit; prunes; plums; figs; marrons; jellies; jams; marmalade; mincemeat; soups; dairy products; eggs; milk; milk products; dairy products; edible oils and fats; preserves; fruit preserves, vegetable preserves; pickles; cheese; quark; cream; yoghurt; butter; flavoured butter; brandy butter; pickled onions; cranberry sauce; soup and preparations for making soup; gelatins; ready cooked meals of meat and fish; hampers containing meat fish, poultry and game, meat extracts, conserves, compotes, fruit conserves, cavier, pate, partridge, grouse, pheasant, chicken, curried liver, curried mutton, curried chicken, fish pastes, hams, tongues, bacon, meat in tins, glasses and terriners, beefs extracts, preserved, dried, cooked and frozen fruits, vegetables, meats and fish, dry and boiled fruit, fruits in tins and bottles, cherries, pineapple, fruit salads, apricots, pears, peaches, grapefruit, prunes, plums, figs, marrons, jellies, jams, marmalade, mincemeat, soups, dairy products, eggs, milk, milk products, dairy products, edible oils and fats, preserves, preserves, fruit preserves, vegetable preserves, pickles, cheese, quark, cream, yoghurt, butter, flavoured butter, brandy butter, pickled onions, cranberry sauce, soup and preparations for making soup, gelatins, ready cooked meals of meat and fish; potted meals*

*Coffee, tea, cocoa and artificial coffee; Rice; Tapioca and sago; Flour and preparations made from cereals; Bread, pastry and confectionery; Ices; Sugar, honey, treacle; Yeast, baking-powder; Salt; Mustard; Vinegar, sauces (condiments); Spices; Ice*

*Coffee; tea; black tea; black tea in bags; herbal tea; green tea; green tea in bags; cocoa; artificial coffee; coffee essences and coffee extracts, mixture of coffee and chicory; chicory and chicory mixtures, all for use as substitutes for coffee; scented tea and flavoured tea; sugar; rice, tapioca, sago, coffee substitutes; flour, and preparations made from cereals; bread; spiced bread; biscuits; cakes; pastry and confectionery; ices; ice cream; honey; treacle; yeast, baking powder; salt; mustard; pepper; vinegar; sauces; spices; ice; condiments, curry powder; non-medicated confectionery; sugar confectionery; petit fours; salt (for food); relish sauces (excluding cranberry sauce and apple sauce); chutney; puddings; poppadums; pancakes; fruit sauces; salad sauces and dressings; hampers containing coffee, tea; black tea, black tea in bags, herbal tea, green tea, green tea in bags, cocoa, artificial coffee, coffee essences and coffee extracts, mixture of coffee and chicory, chicory and chicory mixtures, all for use as substitutes for coffee, scented tea and flavoured tea, sugar, rice, tapioca, sago, coffee substitutes, flour, and preparations made from cereals, bread, spiced bread, biscuits, cakes, pastry and confectionery, ices, ice cream, honey, treacle, yeast, baking powder, salt, mustard, pepper, vinegar, sauces, spices, ice, condiments, curry powder, non-medicated confectionery, sugar confectionery, petit fours, salt (for food), relish sauces (excluding cranberry sauce and apple sauce), chutney, puddings, poppadums, pancakes, fruit sauces, salad sauces and dressings; all edibles in tins and glasses*

*Agricultural, horticultural and forestry products and grains not included in other classes; live animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals; malt; hampers containing fresh fruits and vegetables, seeds, natural plants and flowers, foodstuffs for animals, malt;*

*Beers, ale and porter; non-alcoholic drinks and preparations for making such drinks; mineral and aerated waters; soft drinks; non-alcoholic beverages; fruit and vegetable drinks and fruit and vegetable juices; syrups and other preparations for making beverages; hampers containing beers, ale and porter, non-alcoholic drinks and preparations for making such drinks, mineral and aerated waters, soft drinks, non-alcoholic beverages, fruit and vegetable drinks and fruit and vegetable juices, syrups and other preparations for making beverages*

*Alcoholic beverages (except beers); wines, spirits and liqueurs; cider and sherry; port wine; champagne; hampers containing alcoholic beverages (except beers), wines, spirits and liqueurs, cider and sherry, port wine, champagne*

*Advertising; business management; business administration; office functions; the bringing together, for the benefit of others, of a variety of goods, namely, perfumery, cosmetics, shower gels, body lotions, printed matter, books, magazines, leather goods, luggage, wallets, passport holders, luggage tags, furniture, hampers, hampers containing food, household or kitchen utensils and containers, tea pots, tea strainers, caddy spoons, textiles and textile goods, tea towels, clothing, footwear, headgear, aprons, chefs' hats, games and playthings, decorations for Christmas trees, meat, fish, poultry and game, meat extracts, caviar, pate, partridge, grouse, pheasant, chicken, curried liver, curried mutton, curried chicken, fish pastes, hams, tongues, bacon, meat in tins, glasses and terrines, beef extracts, preserved, dried and cooked fruits and vegetables, fruits in tins and bottles, cherries, pineapple, fruit salads, apricots, pears, peaches, grapefruit, prunes, plums, figs, marrons, jellies, jams, marmalade, chutneys, mincemeat, soups, fruits sauces, dairy products, eggs, milk, milk products, edible oils and fats, preserves, fruit preserves, vegetable preserves, pickles, salad sauces, flavoured butter, brandy butter, dressings, pickled onions, cranberry sauce, soup and preparations for making soup, coffee, tea, black tea, black tea in bags, herbal teas, green tea, green tea in bags, cocoa, artificial coffee, coffee essences and coffee extracts, mixture of coffee and chicory, chicory and chicory mixtures, all for use as substitutes for coffee, scented tea and flavoured tea, sugar, rice, tapioca, sago, coffee substitutes, flour, and preparations made from cereals, bread, spiced bread, biscuits, cakes, pastry and confectionery, ices, honey, treacle, yeast, baking powder, salt, mustard, pepper, vinegar, sauces, spices, ice, condiments, curry powder, and all edibles in tins and glasses, non-medicated confectionery, sugar confectionery, petit fours, salt (for food), relish sauces (excluding cranberry sauce and apple sauce), chutney, puddings, poppadums, pancakes, beer, ale and porter, non-alcoholic drinks and preparations for making such drinks, mineral and aerated waters, soft drinks,*

*non-alcoholic beverages, fruit drinks and fruit juices, alcoholic beverages (except beers), wines, spirits and liqueurs, cider and sherry, port wine, enabling customers to conveniently view and purchase those goods in a department store, in an airport retail outlet, from a general merchandise catalogue by mail order, a general merchandise Internet site or by means of telecommunications; advice and assistance in the selection of goods; provision of advisory and information services in relation to the aforesaid services.*

*Delivery services; delivery of goods; delivery of goods by mail order or any other means; distribution of goods; storage of goods, transportation of goods; packaging of goods*

*Services for providing food and drink; temporary accommodation; takeaway food services; restaurant services; tea room services; catering services*