

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2009499
BY ELIZABETH FLORENCE EMANUEL
(NOW OAKRIDGE TRADING LTD)
TO REGISTER A MARK IN CLASS 14**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO 43532 BY ESCADA AG**

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15

DECISION

20 On 1 February 1995 Elizabeth Florence Emanuel applied to register the mark that appears
below for a specification of goods which reads:

“Jewellery, costume jewellery and imitation jewellery; watches and clocks; precious
stones; articles made of precious metal or coated therewith; parts and fittings for all the
aforesaid goods; all included in Class 14.”

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ELIZABETH EMANUEL

35 The application is numbered 2009499.

On 23 November 1995 Escada AG filed notice of opposition to this application.

The grounds of opposition are in summary that:

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- i the opponents are the proprietors of a similar mark applied for in respect of the same and similar goods. Details of this earlier mark are given below. I take this to be an objection based upon Section 5(2)(b) of the Act;

- ii the mark applied for is of such a nature as to deceive the public by virtue of its similarity to the opponents' mark. As a result it is said that the mark offends against Section 3(3) of the Act.

5 The statement of grounds also contains the statement that "the opponent further relies on such other provisions of the Trade Marks Act 1994 as may be applicable to justify refusal of Application No 2009499". I do not think that catch-all grounds are an appropriate way to conduct trade mark proceedings. In this particular case no other grounds have ever been specified. As will become apparent later in this decision the central point at issue between the parties is that of comparison of marks under Section 5(2)(b).

10 Details of the mark referred to in (i) above are as follows:

NUMBER	MARK	CLASS	JOURNAL	SPECIFICATION
15 1575165		14	6091/6875	Jewellery, costume jewellery, precious stones, watches; all included in Class 14.



25 The applicant filed a counterstatement denying the above grounds. Both sides seek an award of costs in their favour.

30 The opponents filed evidence in these proceedings. The applicant did not file evidence. The matter came to be heard on 18 March 1998 when Mr K Hodkinson of Marks & Clerk, Trade Mark Agents, represented the opponents and Mr G Farrington of Langner Parry, Trade Mark Attorneys represented the applicant.

35 I should say at this point that this application has in fact been assigned to Oakridge Trading Ltd. This matter was the subject of discussion at the hearing because the opponents had not been informed of the devolution of title. Subsequent to the hearing the applicants provided the opponents with documentation showing that ownership had passed from Elizabeth Emanuel to Elizabeth Emanuel plc, from Elizabeth Emanuel plc to Frostsprint Ltd and finally, following Frostsprint Ltd's change of name to Elizabeth Emanuel International Ltd, from Elizabeth Emanuel International Ltd to Oakridge Trading Ltd. Mr Hodkinson, for the opponents, identified what he considered to be a number of deficiencies in the documentation and, as a result, suggested that the change of ownership was ineffective and should not have been recorded by the Registry. Following the provision of further documentation and explanation by the applicants it was agreed that I should deal with the matter on the basis of the submissions made in writing. Although at one point Mr Hodkinson suggested in correspondence that the effect of any deficiencies (if held to be such) was to render the mark deceptive and thus open to objection under Section 3 I have received no formal request to

amend the statement of grounds and I do not think any of the particularised grounds can be said to cover the point. I have also commented above on the general ground raised by the opponents. In the light of the material filed and the comments received I have come to the view that the Registry acted properly in recording the changes of title and that no issue arises which should change the basis of the opposition.

Opponents' evidence

The opponents filed a statutory declaration dated 22 August 1996 by Peter Steck who describes himself as the General Counsel and Confidential Clerk ("Prokurist") of Escada AG, a position he has held since 1993. He confirms that he is familiar with the English language and that the evidence he gives comes from his personal knowledge and company records.

Mr Steck says that his company's trade mark was first used in the United Kingdom in October 1993 and has been used since then on perfume, soap, after-shave lotion, shower gel, deodorants, flacons and coffrets. He exhibits (PS1) sample catalogues containing representations of products bearing the trade mark. Turnover in this country is given as follows:

Year	Approximate Turnover
	£
1993	322,500
1994	427,500
1995	341,518

The mark is said to have been used upon goods sold in virtually every major town in the United Kingdom through outlets of high street retail stores. A list of such retailers is exhibited (PS2). The mark has been promoted through point of sale literature and displays, catalogues and price lists. Some £155,804 has been spent on promotional activity. As a result of all this Mr Steck believes that the mark has become distinctive of his company and its products. He adds that, due to the close association between the goods on which the opponents have used their mark and the applicant's goods, all of which are in his view luxury goods, he considers that there is a likelihood of confusion particularly in relation to the device element of the application in suit.

That completes my review of the evidence. I have not taken into account a letter adduced before me at the hearing from the applicant's former agents to the opponents' German representatives as it did not comply with the Act and Rules regarding the form in which evidence is to be presented in inter partes proceedings.

At the hearing Mr Hodkinson indicated that he would not be pursuing the objection based on Section 3(3) of the Act. That ground, therefore, falls away.

5 The main issue I have to deal with is the ground based on Section 5(2)(b) of the Act. This reads as follows:

“5.- (2) A trade mark shall not be registered if because -

- 10 (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,
- 15 there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

The term “earlier trade mark” is itself defined as follows in Section 6 of the Act:

20 6.- (1) In this Act an “earlier trade mark” means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,
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- (b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), or
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- (c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well known trade mark.
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It is clear from the respective specifications, and was accepted at the hearing, that identical goods are involved. The matter, therefore, resolves itself into one of a comparison of the marks themselves. At the hearing both sides referred to the established guidance propounded by Parker J in Pianotist Co’s application (1906) 23 RPC 774 at page 777 line 26 et seq:

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“You must take the two words. You must judge of them both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of these trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering all

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5 those circumstances, you come to the conclusion that there will be a confusion - that is to say - not necessarily that one will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public, which will lead to confusion in the goods - then you may refuse the registration, or rather you must refuse the registration in that case.”

10 Mr Hodkinson for the opponents, also took the view that there was a danger of confusion through imperfect recollection and took me to the following passage from *Wagamama Limited v City Centre Restaurants plc* 1995 FSR 713 at page 733:

15 “I have come to the conclusion that the defendant’s mark, in either form, is so similar to the plaintiff’s registered mark that in use there exists a substantial likelihood of confusion on the part of the relevant public. That confusion is likely to take the form that some members of the public as a result of imperfect recollection will think the marks are the same while others will think that they are associated in the sense that one is an extension of the other (cf. the “Rus”/“Sanrus” case) or otherwise derived from the same source.”

20 and the following comments in *Sandow Ltd’s* trade mark application 1914 RPC 196 at page 205 lines 13 to 18:

25 “The question is not whether if a person is looking at two Trade Marks side by side there would be a possibility of confusion; the question is whether the person who sees the proposed Trade Mark in the absence of the other Trade Mark, and in view only of his general recollection of what the nature of the other Trade Mark was, would be liable to be deceived and to think that the Trade Mark before him is the same as the other, of which he has a general recollection.”

30 In his view the applicant’s mark took in the whole of the opponents’ mark. Customers might assume that there was a connection between the parties because of the common feature. That confusion would be made all the worse if the applicant was to use the principal element of her mark separately.

35 Mr Farrington, for the applicant, said that even if it were accepted that his client’s mark contained a double E device it was only a small element of the mark as a whole. He also pointed to differences in the make-up and fonts used for the letters which in his view served to differentiate. In particular he considered that the opponents’ mark created something of an optical illusion. He too drew on the *SANDOW* case (particularly at page 205 lines 27 to 30):

40 “The true test is whether the totality of the proposed Trade Mark is such that it is likely to cause mistake or deception, or confusion, in the minds of persons accustomed to the existing Trade Mark.”

On this basis he asked me to take the view that whatever points of similarity might exist did not, for the purposes of the Section 5 test, result in a likelihood of confusion when the marks were considered as wholes.

5 I should say at the outset that I do not think I should approach the matter on the basis of what the position might be if the applicant was to use the elements of her mark separately. It is well established that marks must be considered in their totality (see ERECTIKO 1935 RPC 136). On the other hand I think it is right to consider what impression the marks will make with due allowance being made for imperfect recollection. It is also useful to bear in mind that marks
10 are sometimes remembered by reference to essential features (see for instance SAVILE PERFUMERY 1941 RPC 147 at page 162 lines 1 to 9 and lines 18 to 20).

The PIANOTIST test is, of course, primarily directed towards word marks and it was, for this reason, that both sides also referred me to the SANDOW case. Whilst it is clearly possible to
15 distinguish the marks visually and orally (if the applicant's mark is referred to by the name element), it is nevertheless the case that the double E device is an essential feature in both marks. It is a visual identifier in the applicant's mark which cannot be considered to be a negligible element in the mark. I also bear in mind the position of someone who may be familiar with the opponents' mark and then meets the applicant's mark. I think it highly likely
20 that such a person would assume a connection between the marks and that products sold under those marks came from a single trade source. It is true, as Mr Farrington pointed out, that there are stylistic variations between the respective E devices but I do not think that in a trading context actual or potential customers would pause to make that sort of detailed comparison. It is nevertheless part of the applicant's case that, even if there is a degree of
25 similarity between the double E devices, the presence of the words ELIZABETH EMANUEL contribute an important element to the mark and that there is unlikely to be any resulting confusion. I do not accept that this is the case. The conceptual link between the marks is strong and I cannot be certain that the public would not simply (and wrongly) assume that there was a connection in trade between goods sold under the marks. In short I have come to
30 the conclusion that the opponents succeed under Section 5(2)(b).

As the opponents have been successful in these proceedings I order the applicant to pay them the sum of **£550** as a contribution towards their costs.

35 **Dated this 9th day of June 1998**

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