

**TRADE MARKS ACT 1938 (AS AMENDED) AND
TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No 1404289
FOR THE TRADE MARK ABERCROMBIE
IN CLASS 25**

**APPLICATION No 1404387 FOR THE TRADE MARK
ABERCROMBIE & FITCH
IN CLASS 25**

AND

**APPLICATION No 1404389 FOR THE TRADE MARK
ABERCROMBIE & FITCH IN CLASS 42**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
Nos 41804, 41803 AND 42935 BY
J & J CROMBIE LTD**

**TRADE MARKS ACT 1938 (AS AMENDED) AND
TRADE MARKS ACT 1994**

5 **IN THE MATTER OF Application No 1404289
for the trade mark ABERCROMBIE in Class 25**

10 **Application No 1404387 for the trade mark
ABERCROMBIE & FITCH in Class 25**

AND

15 **Application No 1404389 for the trade mark
ABERCROMBIE & FITCH in Class 42**

AND

20 **IN THE MATTER OF Opposition thereto under
Nos 41804, 41803 and 42935 by J & J Crombie Ltd**

BACKGROUND

25 On 24 October 1989 A & F Trade Mark Inc, 1105 North Market Street, Wilmington,
Delaware, United States of America, applied to register the trade marks ABERCROMBIE and
ABERCROMBIE & FITCH under application Nos 1404289 and 1404387. After examination
30 both applications were considered acceptable for registration in part B of the register and
advertised for the following specifications of goods:

1404289

35 Articles of clothing for men and women; pants, sweatshirts, t-shirts, suits, trousers,
shorts, shirts, skirts, blazers, coats, overcoats, raincoats, dresses, culottes, sweaters,
blouses, jackets, stormcoats, trench coats, slickers, scarves, ties, hats, hosiery, boots,
shoes, slippers, belts, fishing vests, caps, mufflers, helmets, ponchos, socks and braces;
all included in Class 25; but not including any such goods bearing a tartan pattern.

40 **1404387**

45 Articles of clothing for men and women; pants, sweatshirts, t-shirts, suits, trousers,
shorts, shirts, skirts, blazers, coats, overcoats, raincoats, dresses, culottes, sweaters,
blouses, jackets, stormcoats, trench coats, slickers, scarves, ties, hats, hosiery, boots,
shoes, slippers, belts, fishing vests, caps, mufflers, helmets, handkerchiefs, ponchos,
socks and braces, all included in Class 25.

On 24 October 1989 the applicants also sought to register the trade mark ABERCROMBIE & FITCH in Class 42 for a specification of services which reads as follows:

1404389

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Design, information, advisory and consultancy services, all relating to clothing, jewellery and to fashion accessories; all included in Class 42.

That application too was accepted in part B of the Register.

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On 14 December 1994 J & J Crombie Ltd of Grandholm Mills, Aberdeen, filed notice of opposition to application Nos B1404387, and No B1404289, and on 10 August 1995 they filed notice of opposition to application No 1404389. In all three cases the grounds of opposition were the same. In summary they are:-

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1. Under the provisions of Section 12 of the Act - because the opponents say that they are the registered proprietors of earlier registrations (see Annex A attached) and that the respective trade marks and their specifications of goods and services are confusingly similar.

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2. Under Section 11 - as a result of the use by the opponents of their trade marks use by the applications of their trade marks on the goods and services covered by the opponents would cause confusion and deception.

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3. Under the provisions of Sections 9 and 10 of the Act - because the trade marks the subject of the applications are neither adapted to distinguish nor capable of distinguishing the goods and services of the applicant.

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The applicants deny these grounds of opposition. Both sides ask that the Registrar exercise her discretion in their favour and both seek an award of costs.

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The matter came to be heard on 28 September 1999 when the opponents were represented by Mr George Hamer, of Counsel, instructed by William A Shepherd & Son, their Trade Mark Attorneys and the applicants were represented by Mr Richard Arnold, of Counsel, instructed by A A Thornton their Trade Mark Attorneys.

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By the time this matter came to be heard, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. In accordance with the transitional provisions set out in Schedule 3 to that Act however, I must continue to apply the relevant provisions of the old law to these proceedings. Accordingly, all references in the later parts of this decision are references to the provisions of the old law.

Opponents evidence

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This consists of a Statutory Declaration by Mr Allan Moreland Murray. Mr Murray is a Director of J & J Crombie Ltd, the opponents, and his Declaration is dated 18 July 1996.

Mr Murray first of all provides background information on the opponents who have been woollen manufacturers producing high quality cloths for almost two hundred years. Cloths under the CROMBIE trade mark have been exported to a wide range of overseas markets in which the company's important trade marks have been protected. He goes on to provide sales figures in relation to clothing and cloth sold under the CROMBIE trade mark and to others for use with their own label eg DUNHILL and AQUASCUTUM.

	Year	Crombie Label	Own Label	Total
10	1991/92	£1928 K	£950 K	£2878 K
	1992/93	£1778 K	£877 K	£2655 K
	1993/94	£1872 K	£923 K	£2795 K
	1994/95	£2185 K	£1077 K	£3262 K
	1995/96	£1956 K	£974 K	£2930 K

15 Some £100,000 per annum has been spent in recent years on advertising and promotional material. Examples of these are exhibited together with examples of invoices showing sales of CROMBIE branded goods.

20 Also exhibited is a list of the opponents' retail outlets (including concessions and independent outlets) selling CROMBIE products throughout the United Kingdom. It is Mr Murray's belief that the continuous usage, promotion and sales of goods under the CROMBIE name has created substantial goodwill and reputation in the trade mark. He comments that the opponents have also received a Royal Warrant. He goes on to say that the opponents are
 25 concerned that the applicants desire to sell cloth and clothing in the United Kingdom and to provide clothing design services by or with reference to the trade marks incorporating the word ABERCROMBIE which itself contains the entire trade mark CROMBIE - the only obvious difference being the prefix ABER. In his view, the respective trade marks are similar not least because the applicants ABERCROMBIE trade mark could be seen as an extension to
 30 the opponents' product range under the CROMBIE trade mark and thus confusion will occur.

Mr Murray further states that the word Abercrombie is a well known Scottish surname and as evidence of this he provides and exhibits information from various Scottish telephone directories in relation to this surname (and its phonetic equivalent Abercromby). This is
 35 shown below:

	Town/City	Abercrombie	Abercromby
	Aberdeen	4	1
40	Edinburgh	20	4
	Glasgow	58	9
	Clyde Valley	47	5
	Clyde Coast	26	2
	Lomond & Argyle	10	3

45

Central Scotland		
& Trossacks	51	9
Fife & Kinross	15	1
	<u>231</u>	<u>34</u>

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Mr Murray then goes on to refer to an announcement by the Trade Marks Registry which appeared in the Trade Marks Journal dated 21 November 1979 in relation to the acceptance or otherwise for registration of words which have no signification other than as surnames.

10 Mr Murray contends that on examining the applications for registration in suit the Trade Marks Registry should have been put on notice that the name Abercrombie was, according to its ordinary signification, a surname and that it appeared 11 times in the London telephone directory. He then refers to Whitford J in the CIBA case (1983) RPC 75 at page 82.

15 Mr Murray goes on to say that if the Registrar had examined the Glasgow telephone directory in respect of the name Abercrombie then he would have seen that it fell outside the de minimis principle, and accordingly should not have been accepted for registration without evidence of substantial use.

20 Furthermore, Mr Murray draws to the Registrar's attention to the fact that some surnames are indigenous to specific regions of the United Kingdom, and he provides some examples. He considers that the surname Abercrombie which appears in the London telephone directory is not indicative of its use as a surname throughout the United Kingdom, and that if a surname appears in a London telephone directory the Registrar should check other relevant directories throughout the United Kingdom. In this case the inevitable conclusion must be that the word
25 Abercrombie is a Scottish surname and ought to be refused registration.

Applicants evidence

30 This consists of a Statutory Declaration dated 14 March 1997 by Mr Seth Johnson, the Vice President and Chief Financial Officer of Abercrombie & Fitch Inc. He states that Abercrombie & Fitch Inc was incorporated on 8 January 1988 and is a subsidiary of The Limited Inc as is Abercrombie & Fitch Trade Mark Inc. The function of Abercrombie & Fitch Inc is to operate retail outlets selling goods under the trade marks ABERCROMBIE & FITCH and
35 ABERCROMBIE under licence from Abercrombie & Fitch Trade Mark Inc.

Mr Johnson goes on to provide some background to the Abercrombie & Fitch business and its use of the trade marks the subject of these applications. In essence he states that the trade marks are used and are registered in a large number of countries throughout the world in
40 connection with clothing at large for men and women. He exhibits labels and tags etc which are used on the goods and he goes on to provide information about sales and advertising expenditure in respect of the trade marks and goods sold under them in the United States of America. This shows that in 1988 the applicants had 25 retail outlets selling goods to the value of \$35 Billion and by the end of 1996 this had risen to 102 outlets selling \$231 Billion.
45 Advertising expenditure in the same period had risen from \$103,000 to \$4.281 Million. Mr Johnson states that A & F Trade Mark Inc has registrations and applications in the United States of America for the trade mark ABERCROMBIE & FITCH, in addition the trade marks

ABERCROMBIE & FITCH and ABERCROMBIE have been used in the United States in relation to clothing since at least 1892.

5 The opponents, he states, have registrations of the trade mark CROMBIE in the United States of America for clothing dating from 1959 and have used it in the United States of America since 1890. Mr Murray notes that no instances of confusion between the respective trade marks has been cited by the opponents despite their coexistence in the United States for over 100 years.

10 Mr Johnson states, finally, that CROMBIE and ABERCROMBIE are clearly established surnames in their own right and are distinctive one from another such that in use one would not be confused with the other.

Opponents evidence in reply

15 This consists first of all of a Statutory Declaration by Mr Allan Moreland Murray dated 17 September 1997. In essence he states that the Statutory Declaration of Mr Johnson, summarised earlier, indicates that the applicants reputation in the names ABERCROMBIE and ABERCROMBIE & FITCH is largely in the United States of America and the evidence of use
20 of the trade mark similarly goes to show use in the United States. As far as Mr Johnson's comments about the lack of confusion in the United States, despite the coexistence of the respective trade marks in that jurisdiction, Mr Murray states that there will, nevertheless, be confusion in the United Kingdom if and when the applicants products are introduced into this country bearing the trade marks ABERCROMBIE and ABERCROMBIE & FITCH, bearing
25 in mind the vast reputation of the opponents' CROMBIE trade mark. Insofar as the claim that the Crombie and Abercrombie names are distinct Scottish surnames, Mr Murray contends that when these two similar Scottish surnames are used alongside each other (bearing in mind that one is a renowned trade mark in the United Kingdom), trade and consumer confusion will result. This is because the word ABERCROMBIE may be viewed as an extension or
30 alternative product range to the CROMBIE name and it is conceivable that an association or affiliation may be drawn between the two names because of their Scottish nature.

Mr Murray goes on to exhibit documents which show that the opponents have successfully opposed the registration of the trade mark ABERCROMBIE in Spain.

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Opponents additional evidence

This consists of a Statutory Declaration dated 11 December 1997 by Mary Adrienne Zartarian who is employed by William A Shepherd & Son, the opponents Trade Mark Attorneys. She
40 provides as an exhibit a report by Carratu International which conducted a survey on behalf of the opponents in order to determine whether or not confusion was likely to occur between the use of the trade marks CROMBIE and ABERCROMBIE. The survey covered a telephone survey of staff in retail outlets as well as a street survey carried out in the West End of London, covering the general public. Mary Adrienne Zartarian makes a number of points as a
45 result of the survey. The principal ones being that 65% of the staff in retail outlets questioned

would find it confusing if the names CROMBIE and ABERCROMBIE were seen on goods in the same clothing department and that 68% of the general public would also be confused as between the same two trade marks.

5 **Applicants additional evidence**

10 This consists, first of all, of an Affidavit by Courtney Wilson, a partner in Colucci and Umans, Attorneys acting for A & F Trade Mark Inc. He states that the Statutory Declaration of Mr Allan Moreland Murray dated 17 September 1997, states that the opponents had successfully opposed registration of the trade mark ABERCROMBIE, belonging to A & F Trade Mark, Inc in Spain. However, he says that Mr Murray admits to saying that the opposition against application No 1778551 for the trade mark ABERCROMBIE & FITCH was not successful.

15 Also filed is a Statutory Declaration by Philip Malivoire, a Director of NOP Consumer, the consumer research division of the NOP Research Group. This is dated 19 March 1998. After providing some background as to his own credentials and those of his company, Mr Malivoire states that he was unaware of Carratu International prior to receiving a copy of their report. They do not appear in the Market Research Society's organisation handbook and therefore he doubts whether the survey they conducted was in accordance with the Market Research Society's code of conduct. He goes on to offer a number of comments on the survey.

25 First of all, Mr Malivoire considers that the number of persons interviewed was too small to enable any statistical weight to be placed on the results. Secondly, the questionnaires are "typed up versions" rather than the originals. Thirdly, the preferred approach in surveys for legal purposes is to ensure that answers given by the respondent are recorded verbatim, particularly where the answers are not ones that can be pre-coded and hence recorded by ticking a box (that shows "Yes" or "No"). In the case of this survey the majority of answers are recorded as a single word and therefore it is impossible to be sure whether the single word recorded was in fact the full answer, and whether the interviewer probed for an answer and if so, what the probing might have been. Fourthly, some of the questions appear to be leading and invite the respondent to speculate. Finally, he comments that the survey related only to the ABERCROMBIE trade mark in suit.

35 That completes my review of the evidence insofar as it may be relevant in this case.

DECISION

40 I deal first of all with the objection based upon Section 10 of the Act. The objection based upon Section 9 is otiose because the applications were only proceeding on the basis of acceptance in part B of the Register.

Section 10 states:

45 10.-(1) In order for a trade mark to be registrable in Part B of the register it must be capable, in relation to the goods in respect of which it is registered or proposed to be registered, of distinguishing goods with which the proprietor of the trade mark is or

may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to the limitations, in relation to use within the extent of the registration.

5

(2) In determining whether a trade mark is capable of distinguishing as aforesaid the tribunal may have regard to the extent to which -

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(a) the trade mark is inherently capable of distinguishing as aforesaid; and

(b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing as aforesaid.

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(3) A trade mark may be registered in Part B notwithstanding any registration in Part A in the name of the same proprietor of the same trade mark or any part or parts thereof.

20

The Trade Marks Registry's practice in relation to personal names follows the guidance laid down in CIBA [1983] RPC 75, this allows the registration of surnames on the basis of a de minimis rule, if the name appears only a few times in telephone directories. The most recent guideline in the Trade Marks Registry's Work Manual (Chapter 9) states, insofar as the two trade marks in issue here are concerned:

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Surnames alone

9-124 Words which are simply common surnames, eg Jones, Brown are not acceptable, prima facie, in Part A of the register. However, some surnames may be so uncommon that their "ordinary significance" to the public generally is that of invented words, and such surnames may be accepted on the de minimis principle which was established in the CIBA case (1983 RPC 75) and which is now applied as follows:

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(b) Marks may be accepted in Part A if they appear as surnames not more than 15 times in the London Telephone Directory and not more than 30 times in any relevant foreign telephone directory;

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(c) Marks may be accepted in Part B if they appear as surnames not more than 30 times in the London Telephone Directory and not more than 50 times in any relevant foreign telephone directory.

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9-127 (a) Surname - phonetic equivalents of

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Generally these are treated as the surnames themselves eg the appearances of GOLDWIN in a directory will be added to the appearances of GOLDWYN. If the mark in question has a well known other meaning eg HEART (equivalent of HART), HAWK (equivalent of HAWKE), LION (equivalent of LYON), it can normally be accepted in Part B. Where such a name appears with a device depicting the word, the surname signification is less strong but even here it should only proceed in Part B. If it

is doubtful whether a word is the phonetic equivalent of a surname, eg BLISS (90 times in the London Telephone Directory) and BLIS, then acceptance in Part B is normally appropriate. There is a long line of authority culminating in the ELECTRIX case (1959 RPC 283) establishing that the phonetic equivalent of an objectionable word is itself objectionable. However, it should be noted that in the CRAG case (69 RPC 306) (Crag nil times in the London telephone directory and having its own meaning: Cragg 25 times) CRAG was allowed in Part A on the argument that it was unlikely that a person called Cragg would enter the trade in question, and use his own name as a trade mark. CRAG appears inconsistent with ELECTRIX but the latter, being a House of Lords decision, is of greater authority.

Double and Multiple Surname Marks with no other meaning

9-129 Generally the signification of surnames cannot be avoided where they appear in combination and if this is clearly the case because the names are well known as surnames their acceptance is barred prima facie by the wording of 9(1)(d). It may be, of course, that if the surnames are very rare, particularly if they are foreign names, the surname signification is not immediately apparent. If that is the case, acceptance under (A)(I) below may be possible.

In the case of marks consisting of three or more surnames, acceptance should be possible in Part A on disclaimer or in Part B with or without disclaimer depending on the commonness of the surnames in question. It is considered that where a mark consists of three or more names being used in combination, the likelihood of such a combination being required by others is so remote that marks of this nature can be accepted in Part B with separate disclaimers even if they are very common.

The guidelines for double and multiple surname marks have therefore been revised and are now as follows:

A. Double Surname Marks

- (i) Accept in Part A without disclaimer on de minimis principles (Note, however comments above and paragraph 9-125) - If the surnames occur not more than 15 times in the London Telephone Directory and/or not more than 30 times in any relevant foreign directories.
- (ii) Accept Part A with separate disclaimers or in Part B without disclaimer - If both surnames appear more than 15 times but not more than 50 times in the London Telephone Directory (or more than 30 times but not more than 100 times in any relevant foreign directories).
- (iii) Accept Part B with disclaimer of the more common name - If one surname occurs not more than 50 times in the London

Telephone Directory (and not more than 100 times in any relevant foreign directories) but the other is more common.

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(iv) Accept in Part B with separate disclaimers - If both surnames occur more than 50 times but not more than 100 times in any relevant telephone directories.

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(i) Object under Sections 9 & 10 - If both surnames appear more than 100 times in any relevant telephone directories.

15

In other cases, marks may consist of surnames falling into different categories from those outlined above. Whether such marks are acceptable will depend on individual circumstances bearing in mind the likelihood of the two names being used in combination for the goods or services at issue.

20

Considering the word ABERCROMBIE solus, I have no doubt that the Trade Mark Examiner found that the number of occurrences of that word as a surname (and its phonetic equivalent) in the London telephone directory fell within the guidelines for acceptance of the word as a trade mark in part B of the Register. However, that is not the end of the matter because it seems to me that in respect of this name the Trade Mark Examiner could have been expected to look wider ie at the telephone directories for Edinburgh and Glasgow which would have shown that the number of occurrences were such as to indicate that the ordinary significance of the word must be as a surname. I say this because the exclusion of 'goods bearing a tartan pattern' in respect of application No 1404289 indicates that there was acknowledgement by someone in the Trade Marks Registry there that was a Scottish connection with the word ABERCROMBIE. Taking that into account and the opponents evidence of the number of entries in the Scottish telephone directories for the surname Abercrombie together with the Registry's published practice I reach the view that the word falls outside the guidelines (for they are only guidelines) for acceptance, prima facie, of the application in part B of the register. No evidence of factual distinctiveness in the United Kingdom having been placed before me (and I disregard for this purpose any reputation that the applicants may have in the United States of America) I find that the ground of opposition based upon Section 10 of the Act in respect of application Number B 1404289 succeeds.

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Insofar as the applications for the trade mark ABERCROMBIE & FITCH are concerned they fall to be considered on the basis of the guidance provided for Double Surname Marks set out above. On the basis of my earlier finding it is clear that the name ABERCROMBIE is a common surname but I have no facts before me on which to judge whether or not the word FITCH falls into that category. I assume however that it does not because the opponents have not directed any evidence accordingly. That being so I consider that the Trade Mark Examiner was right to accept the applications for the trade mark ABERCROMBIE & FITCH as acceptable for registration in part B of the Register. But in line with the guidelines only if a disclaimer (under the provisions of Section 14) to any exclusive right in the word

ABERCROMBIE is provided by the applicants.

I go on to consider the grounds of opposition based upon Section 11 and 12 of the Act which state:

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The matter falls to be decided under Sections 11 and 12¹ of the Act. These Sections read as follows:

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"11. It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.

15

12.-(1) Subject to the provisions of subsection (2) of this section, no trade mark shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of:-

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- (a) the same goods;
- (b) the same description of goods; or
- (c) services or a description of services which are associated with those goods or goods of that description."

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The reference in Section 12(1) to a near resemblance is clarified by Section 68(2B) of the Act which states that references in the Act to a near resemblance of marks are references to a resemblance so near as to be likely to deceive or cause confusion.

30

The established tests for objections under these provisions are set down in Smith Hayden and Company Ltd's application (Volume 1946 63 RPC 101) later adapted, in the case of Section 11, by Lord Upjohn in the BALI trade mark case 1969 RPC 496. Adapted to the matter in hand, these tests may be expressed as follows:-

35

(Under Section 11) Having regard to the user of the opponents' marks (CROMBIE), is the tribunal satisfied that the marks ABERCROMBIE and ABERCROMBIE & FITCH applied for, if used in a normal and fair manner in connection with any goods covered by the registration proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?

40

(Under Section 12) Assuming user by the opponents of their marks in a normal and fair manner for any of the goods covered by the registration of those marks, is the tribunal satisfied that there will be no reasonable likelihood

¹ The relevant amendments to these sections insofar as application No 1404389 in respect of services in Class 42 are to be found in the Trade Marks (Amendment) Act 1984

of deception amongst a substantial number of persons if the applicants use their marks normally and fairly in respect of any goods covered by their proposed registration?"

5 I will deal with Section 12 first. The standard test in relation to comparison of marks is that propounded by Parker J in Pianotist Co's application (1906) 23 RPC 774. The relevant passage reads:-

10 "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
15 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 those
20 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."

The first thing I must do is determine whether the same goods or same description of goods or goods and services associated with one another are involved. In doing so I take account of PANDA (1946) 63 RPC 59 which set out what is commonly known as the 'Jellinek test' which
25 requires me to consider the respective nature, purpose and channels of trade of the goods used, with the appropriate interpretations for the comparison of goods with services.

In my view the goods covered by the applications No 1409289 and No B 1404387 are the same or of the same description as the opponents' registrations which fall into the same class,
30 Class 25. However, in considering the nature, purpose and channels of trade of the applicants goods which are in essence made up clothing. I do not consider that they are of the same description as covered by the opponents registrations in Class 24 (textile piece goods). The latter may be used to make up the former, but there is no direct customer relationship in the normal course of trade between the two and the channels of trade are different, in my view.

35 When it comes to the applicants services I believe that they could be associated with the opponents goods in Class 25. The Design and consultancy services relating to clothing suggests to me that the nature and purpose of the services, particularly in view of the current fashion for 'designer' clothing, mean that design services relating to clothing must be directly
40 associated with the manufacture of the made up clothing even if the 'channel of trade' might be different.

With that in mind I go on to consider the trade marks themselves. In essence I am required to consider CROMBIE against ABERCROMBIE and ABERCROMBIE and FITCH. As was
45 pointed out in the evidence, the opponents' trade mark is contained within the word ABERCROMBIE in the applicants' trade marks. Mr Hamer said that the CROMBIE element was the dominant part of the word ABERCROMBIE even though he accepted that visually

and phonetically the two were different. He considered that there was nevertheless scope for confusion because the public (and the trade) would (or might) consider that the two syllables of the word ABERCROMBIE might be taken as two separate elements and that those who knew of the CROMBIE trade mark might be confused into thinking that the owners of that trade mark had been taken over by some called ABER and that the respective trade marks had been co-joined.

In my view the respective trade marks are not similar. In comparing the trade marks I am required to have regard to the respective trade marks as a whole, EREKTIKO (1935) 52 RPC 136, also to take account of the fact that the trade marks may not be viewed alongside each other, DE CORDOVA v VICK (1951) 68 RPC 108. Having done so it seems to me that the opponents' trade mark CROMBIE is lost within the whole of the applicants' trade marks, both ABERCROMBIE and ABERCROMBIE and FITCH. There is no likelihood, in my view, that anyone will associate the opponents' trade mark with those of the applicants in the way put forward by Mr Hamer. The grounds of opposition under Section 12 are therefore not made out and the opposition under the head fails.

In considering the matter under Section 11, I accept (as did Mr Arnold for the applicants) that the opponents have a reputation in their CROMBIE trade marks for textile piece goods and made up clothing. Also that that reputation extends back some considerable time.

The opponents have therefore fully satisfied me that through use their trade marks enjoy a reputation for goods which are the same or of the same description as some of those goods and services covered by the applicants specifications. And I also have the opponents' evidence in the form of the survey by Carratu International which, it is claimed, shows that the trade' would be confused as to origin if the applicants' trade marks were put into use.

Survey evidence is notoriously difficult to judge because it seldom meets the criteria set out by Mr Justice Whitford in IMPERIAL GROUP plc v Philip Morris Ltd [1984] RPC 293). The survey evidence here is no exception. I agree with the opponents declarant on the matter, Mr Phillip Malivoire, that the results are not sufficiently sound to enable me to take them in to account.

But, in all of the circumstances I do not think that there are any factors in relation to the opponents' use and reputation which displaces the view of the matter reached under Section 12. I do not consider that the trade (and by that I mean designers wholesalers and retailers) or the buying public are likely to be confused applicants trade marks for those of the opponents and therefore there is no reasonable likelihood that a substantial number of persons will be deceived if the applicants use their trade marks normally and fairly in respect of any of the goods and services covered by their proposed registration. The opposition under Section 11 therefore fails.

In summary application No. 1404289 stands refused. Application Nos. 1404387 and 1404389 can proceed, subject to the entry of a disclaimer in respect of the word ABERCROMBIE. Unless this is done within one month of the expiry of the date for appeal the applications will stand refused.

Following the Hearing both sides submitted written observations in relation to the Trade Marks Registry's practice on <surnames', which I invited them to do, and on other matters. Insofar as the former is concerned I took the observations into account in reaching my decision on the ground of opposition based upon Section 10. I have ignored the uninvited observations. Three evidence rounds and oral submissions at a Main Hearing should be sufficient for parties to represent their case without further need to press their case, unless there are very exceptional circumstances applying, which there are not in this case.

The opposition has been successful insofar as application No. 1404289 for registration of the trade mark ABERCROMBIE (under Section 10) is concerned but the opposition has failed on all grounds in relation to the trade marks ABERCROMBIE & FITCH I consider that overall the applicants are entitled to a contribution towards their costs. Taking account of the fact that the evidence filed was the same in each case and that only one substantive hearing was necessary I order the opponents to pay to the applicants the sum of £750.

Dated this 14 day of February 2000

20

M KNIGHT
25 **for the Registrar**
the Comptroller General

ANNEX A

<u>Trade Marks</u>	<u>Number</u>	<u>Class</u>	<u>Goods</u>
COATS OF ARMS DEVICE	682279	24	Piece goods wholly or substantially wholly of wool, worsted or hair.
CROMBIE	682280	24	Piece goods wholly or substantially wholly of wool, worsted or hair.
COAT OF ARMS DEVICE	682281	25	Men's and boy's coats, suits, jackets, waistcoats and trousers, and women's and children's coats, suits, frocks and skirts, all made from piece goods wholly or substantially wholly of wool, worsted or hair.
CROMBIE	682282	25	Men's and boy's coats, suits, jackets, waistcoats and trousers, and women's and children's coats, suits, frocks and skirts, all made from piece goods wholly or substantially wholly of wool, worsted or hair.
CROMBIE	895848	25	Jackets, waistcoats, cardigans and pullovers, all for men and boys: coats, suits, frocks, skirts, cardigans and jumpers, all for women and children; all being knitted articles of clothing or articles of clothing made from knitted piece good, all wholly or substantially wholly or wool or hair.
COAT OR ARMS DEVICE	1294039	25	Articles of clothing included in Class 25; but not including footwear.
COAT OF ARMS DEVICE	1296653	24	Textile piece goods included in Class 24.