

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

**IN THE MATTER OF APPLICATION NO 1547938
BY THOMAS COOK BOOT & CLOTHING COMPANY
TO REGISTER A TRADE MARK IN CLASS 25**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
NO 42733 BY THE THOMAS COOK GROUP LIMITED**

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by Thomas Cook Boot & Clothing Company
to register a trade mark in Class 25**

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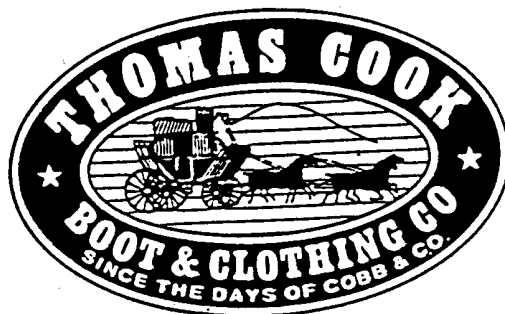
**IN THE MATTER OF Opposition thereto under
No 42733 by The Thomas Cook Group Limited**

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BACKGROUND

20 On 18 September 1993 Thomas Cook Boot & Clothing Company of Abbotsford, Victoria,
Australia applied under Section 17(1) of the Trade Marks Act 1938 (as amended) to register
the trade mark shown below

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in Class 25 in respect of the following:-

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shirts, T-shirts, shorts, pants, jackets, coats, overcoats, socks, shoes, boots; hats;
underclothing; pullovers, tops; belts; all included in Class 25.

40 The applicants disclaimed any right to the exclusive use of the words "Thomas Cook", "Boot
& Clothing Co" and "Since the days of Cobb & Co" but nothing hangs on that fact.

On 5 July 1995 The Thomas Cook Group Limited of Berkeley Street, London filed notice of
opposition against the application. These are, and I quote:

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"The opponent enjoys very substantial reputation and goodwill in the trade mark
THOMAS COOK such that its use as part of a mark by the present applicant is likely

to deceive or cause confusion. The opponent's mark should therefore be refused under Section 11 and Section 12(1).

5 The opponents' mark THOMAS COOK is extremely well known and its use by the applicant is likely to lead to its association in the minds of the public with the opponent. Accordingly, the opponent would be entitled to restrain the applicant's use under the law of passing-off. Registration should therefore be refused under Section 11.

10 The opponents' trade mark is a well known mark within the terms of Article 6 bis of the Paris Convention and its use by the applicants is liable to cause confusion.

The opposed mark should be rejected in the Registrar's discretion under Section 17."

15 The opponents request refusal of the trade mark in suit and their costs and a list of registered trade marks owned by the opponents was produced.

The opponents deny these grounds of opposition; they too seek an award of costs.

20 Both sides filed evidence in these proceedings and the matter came to be heard on 16 March 1999 when the applicants were represented by Mr Colin Birss of Counsel, instructed by their Trade Mark Attorneys, Mathisen Macara. The opponents were represented by Mr George Hamer of Counsel, instructed by their representatives Intelmark, Titmuss, Sainer & Dechert.

25 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.

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OPPONENTS' EVIDENCE

35 This consists, first of all, of a Statutory Declaration by Patricia Ann White, Head of Market Research within The Thomas Cook Group Limited and is dated 19 September 1996. She states that the information contained in the declaration is derived from facts and matters within her own knowledge and is made with the authority of her employers.

40 Patricia White's role within the Group Services Division of her employer is to commission quantitative and qualitative research that presents an accurate and objective picture of the marketplace in which The Thomas Cook Group operate and their relative position in it, to give in-depth insight into the way customers think, feel and behave towards the THOMAS COOK brand. In that connection she states that the use by the applicants on the goods covered by the specification is likely to result in members of the public being confused, or alternatively associating the applicants' business with that of The Thomas Cook Group Limited. This is based, she says, on personal opinion and also on the results of a substantial amount of market research including brand awareness research which she has conducted on behalf of the opponents over the last three years.

Patricia White goes on to exhibit extracts from two pieces of research which were carried out for the opponents by BJM Research & Consultancy Limited (BJM). These include a document entitled "Travel Agents Stochastic Reaction Monitor Presentation Charts 23 August 1995". She explains that Stochastic research is a term coined by the researchers to describe a method of measuring the effectiveness of the marketing effort that goes into a brand. The exhibit contains charts headed "Awareness Summary by Region". This compares recognition of the trade mark THOMAS COOK in the North West of England and other regions against other trade marks covering holiday travel services. This showed that brand awareness in respect of the trade mark THOMAS COOK and the other trade marks was consistently above 40% of those questioned, and in the case of THOMAS COOK it was typically between 50% and 60%. The document also contains a chart showing the spontaneous awareness of branded TV advertisements; all claimed advertisement awareness (ie not just television) or branded awareness (ie including but not limited to awareness of advertisements). The figure for the THOMAS COOK trade marks for all brand awarenesses are in the order of 50% to 70% of those sampled. Similar statistics are available in relation to "foreign exchange" activities where The Thomas Cook Group is recognised by 60% of those sampled as a supplier of those services.

In Patricia White's view the documents demonstrate that the trade mark THOMAS COOK is widely recognised as belonging to the opponents and thus any use by the applicants of a similar or identical trade mark is bound to create confusion in the minds of the public. They will assume that clothing branded with a trade mark consisting of or including the words THOMAS COOK is produced by or in some way associated with the business of the opponents.

There is also filed a Statutory Declaration by Patricia Ann Sylvester dated 11 September 1996 and she states that she is a Legal Assistant within The Thomas Cook Group Limited and that the information contained in the Declaration is from facts and matters within her own knowledge or derived from the applicants' books and records to which she has access.

First of all she provides some background on the opponents. Their business was started by the opponents' predecessor in business in 1841 when the first public excursion was organised and 570 passengers travelled 24 miles from Leicester to Loughborough. Subsequently offices were opened in London from where the business progressively grew. It now involves the arranging of group and personalised tours and itineraries at home and overseas, insurance, banking and foreign exchange facilities and the publication of timetables and travel information generally. By 1925 the total number of staff employed by the applicants worldwide numbered 4,500 in 150 offices at home and abroad. Currently the Thomas Cook Group Limited have 382 retail outlets in the United Kingdom providing travel services at large. In addition there are over 200 stand alone bureau de change together with 106 bureau de change concessions operating within the Midland Bank. A number of exhibits are provided in support of this information. Patricia Sylvester goes on to say that the applicants carry on the business of tour operator organising holidays and tours to long haul destinations such as China, Egypt and Canada and that this side of the business produces approximately 9 brochures a year as well as various leaflets and flyers, all of which carry the THOMAS COOK name. Again, exhibits are provided to show this. Holidays are also offered in conjunction with other operators under the THOMAS COOK trade mark and these account for a further 20 brochures per year and are

made available by direct marketing to the public and through the retail outlets. The opponents also produce the “Thomas Cook European Rail Timetable”, which is published monthly, and in addition there are over 40 different THOMAS COOK travellers guides to various destinations along with other publications such as “Greek Island Hopping” and “European Travellers Phrase Book”. They also issue travellers cheques in many currencies all of which bear the name THOMAS COOK.

Patricia Sylvester states that the opponents spend a great deal of time and money promoting their activities and she provides figures for the advertising and promotional spend between 1990 and 1994.

	TCTC £,000	UK TRAVEL £'000	GROUP HO £'000	UK CENTRAL £'000	TOTAL £'000
1990	2,293	8,438	1,034	N/A	11,765
1991	2,354	7,538	1,156	359	11,407
1992	2,360	7,330	493	657	10,840
1993	2,272	12,523	165	537	15,533
1994	2,268	12,755	(323)	354	15,054
	11,547	48,584	2,525	1,934	64,599

Key: TCTC = Thomas Cook Travellers Cheques

All employees who work in the shops and bureau wear a uniform which bears the Thomas Cook name and examples of these are provided. There are trousers, skirts, shirts, blouses, jackets, ties etc. all of which bear at some point the name of THOMAS COOK. In addition, the applicants use items of clothing as promotion material commonly used as “give aways” for promotional activities, mainly in the applicants’ retail outlets. Examples of these are also provided and include a baseball cap, polo shirt, t-shirts and sweatshirts all of which bear the THOMAS COOK name. In addition members of the opponents sports and social club and sports teams wear garments or kit on which the THOMAS COOK name is printed and they also sponsor Peterborough United football team; and their strip displays the sponsors name and has done so since 1992. The declarant goes on to state that she believes that use by the applicants of the trade mark in suit is likely to be detrimental to the opponents’ THOMAS COOK trade mark because the public will confuse and associate the applicants use of the trade marks owned by the Thomas Cook Group Limited and thus the applicants will be taking advantage of the opponents’ reputation.

APPLICANTS’ EVIDENCE

This consists of Statutory Declarations by Thomas Charles Cook and Murray Thomas Cook.

The Statutory Declaration by Thomas Charles Cook is dated 14 April 1997. He is the Chairman of Thomas Cook Boot & Clothing Co. Pty. Ltd. (the applicants) a position he has held since 1995. He states that he is duly authorised by his company to make the declaration and the facts therein are taken either from his own knowledge or from the records of his company to which he has full access.

Mr Cook says that his father started the business in 1945 with a friend Mr James Murray, making boots and shoes under the name Murray and Cook Shoes Pty Ltd. The declarant states that he joined the company in 1966 and in 1972 took over the proprietorship of the business in partnership with James Murray's son William. However, in 1977 the partnership
5 between himself and William Murray was dissolved and the company was wound up. Subsequently, the declarant and his father incorporated the business Thomas C Cook Footwear Pty Ltd to make boots but went on in 1983 to make Australian country style clothing. Eventually the company name was changed to Thomas Cook Boot and Clothing Pty Ltd., based upon the declarant's and his father's name. In 1995 the declarant's son, Murray
10 Thomas Cook became Managing Director.

Mr Thomas Charles Cook states that the company sells its clothing and footwear in numerous countries throughout the world under the trade mark THOMAS COOK BOOT & CLOTHING CO. together with a stagecoach device the trade mark the subject of this
15 application and the THOMAS COOK AUSTRALIAN ADVENTURE label, the subject of separate proceedings. With the global expansion of the company's activities the United Kingdom market was entered in 1989 and has been trading continuously in the United Kingdom in relation to clothing and footwear since then.

Mr Cook goes on to state, finally, that when Thomas C Cook Footwear Pty Ltd was formed he was aware of The Thomas Cook Travel Company. He believed, however, and continues to believe, that his company is entitled to use his father's name and his own name in the name of the company and in the company's trade marks to get the benefit of their long standing reputation in an industry that could not, in his view, be more different from that in which the
20 Thomas Cook Travel company operates.
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The Statutory Declaration by Murray Thomas Cook is dated 6 June 1997. He states that he is the Managing Director of the Thomas Cook Boot and Clothing Co. Pty. Ltd. and that he is duly authorised to make the declaration the facts therein being taken either from his own
30 knowledge or from the records of his company to which he has full access.

He states that the company applied to register the trade mark the subject of these proceedings, the THOMAS COOK BOOT AND CLOTHING & CO and stagecoach device label; after the company first commenced trading in the United Kingdom under the trade mark in 1990. He
35 states that they have been trading continuously here since that date. Specifically, the trade mark has been used in relation to authentic Australian clothing such as oilskin coats, hats, boots and a range of shirts, pants and jackets. The retail value of sales in the United Kingdom in respect of these goods is provided, together with the names and addresses of various retailers in the United Kingdom through which the goods have been sold. Example invoices
40 are also exhibited.

Mr Cook states that the retailers are encouraged to arrange their own advertising and promotion of the goods but the company supplies them with labels, swing tickets, tags and posters etc. to assist in that regard and examples of these are also exhibited together with
45 catalogues featuring the range of goods sold under the trade mark.

Mr Cook goes on to say that his company has obtained registration of the trade mark in a number of other countries and in particular he notes that his company's registration in Switzerland co-exists with the trade mark THOMAS COOK in the name of the opponents. The same situation applies in Australia where the respective trade marks also co-exist.

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Finally, Mr Cook states that since the first use of the trade mark in Australia, the United Kingdom and other countries his company has not experienced any instance of confusion with regard to the respective trade marks. In his view, this is due to the distinctly different markets in which the two companies operate.

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OPPONENTS' EVIDENCE IN REPLY

This consists of Statutory Declarations by Patricia Ann Sylvester, Maurice Bennett and Richard Bowden-Doyle.

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Patricia Sylvesters' second Statutory Declaration is dated 15 December 1997 and she states that she has read the Statutory Declarations by Thomas Charles Cook and Murray Thomas Cook. She notes that Mr Thomas Charles Cook states in his declaration that the registered proprietors' company operates in an industry that could not be more different from that in which the Thomas Cook Travel Company operates. In that connection she draws attention to a catalogue exhibited by Mr Murray Thomas Cook in which she states there are extensive references to travel and adventure in the headings and in the text. There are also numerous illustrations which relate to travel, including a visa stamp, a mosque, palm trees and a pyramid along with exotic animals and so on. She refers to particular pages of the catalogue in which she states there are specific references to travel and refers back to her own earlier Statutory Declaration and the exhibit to it in which reference is made to the numerous excursions which her company has organised and continues to organise to countries around the world including countries which are specifically mentioned in the text of headings or in the illustrations of the registered proprietors' catalogue.

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Patricia Sylvester believes that the description of the items in the catalogue indicates that these items can be used by travellers, and particularly in countries where her own company operates. This reinforces her belief that confusion will inevitably arise over the use by the applicants of their trade mark in relation to the goods covered by the application as a result of the public confusing it with her company's trade mark.

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The Statutory Declaration of Mr Maurice Bennett is undated. He states that he is the Deputy Chairman and Buying Director of Oasis Stores Plc and that his company is a major manufacturing and distributor and retail of clothing throughout the United Kingdom. He has been involved in the clothing industry for more than twenty years but neither he nor his company are in any way associated with Thomas Cook Group Ltd. He is nevertheless aware of the THOMAS COOK trade mark as used by them in the travel industry.

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He is not aware of the use of the trade mark THOMAS COOK in relation to articles of clothing, but if he did see such a trade mark on or in relation to such goods he would assume that there was a connection between them and the Thomas Cook Group Ltd. Mr Bennett goes on to say that in his experience, consumers regularly purchase articles of clothing

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specifically to use on holiday or while travelling and that the marketing of articles of clothing is often directed to this type of purchasing. He believes that the fact that the Thomas Cook Group Ltd has retail outlets in the United Kingdom, often alongside clothing stores, would enhance the possibility of confusion arising over use of the trade mark Thomas Cook on articles of clothing.

The Statutory Declaration by Richard Burdon-Doyle is dated for December 1997. He is Managing Director of Thompson Tour Operations Ltd, a major provider of travel services. He says much the same as Mr Bennett.

That completes my review of the evidence.

DECISION

At the start of the Hearing Mr Hamer stated that the opponents did not intend to pursue the opposition insofar as the grounds based upon Section 12(1) of the Act were covered. He was right so to do. None of the earlier registrations set out in the Notice of Opposition covered registrations where the goods or services of the opponent were either the same or of the same description as those covered by the application for registration in suit.

The opponents also based a ground of opposition upon the fact that their THOMAS COOK trade mark was well-known and entitled to protection under the terms of Article 6(bis) of the Paris Convention.

Insofar as this is relevant, Article 6(bis) of the Paris Convention for the protection of industrial property, states:

“1. The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel a registration, and to prohibit the use, of a trade mark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a new production of any such well-known mark or an imitation liable to create confusion therewith.

As can be seen, the protection of well known trade marks in accordance with the Paris Convention applies only to applications filed, or trade marks registered or used in respect of identical or similar goods. By withdrawing the grounds of opposition based upon Section 12(1) of the Act the opponents were admitting, in my view, that the same or similar goods were not involved in this case. The provisions of the Paris Convention therefore do not apply in this case.

As far as I can see no evidence has been filed in support of the grounds of opposition based upon Section 17(1) and no submissions were directed to me on that point. Therefore, I formally dismiss the opposition insofar as it was based upon Section 17(1) of the Act.

5 I turn now to the only ground of opposition left and based upon Section 11 of the Act which states:

10 “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 The established test under this provision was laid down by Lord Upjohn in BALI Trade Mark [1969] RPC 472. Adapted to the matter in hand thus may be expressed as follows:

20 Having regard to the user of the mark THOMAS COOK is the tribunal satisfied that the mark applied for THOMAS COOK BOOT AND CLOTHING CO and stagecoach device, if used in a normal and fair manner in connection with any of the goods covered by the registration proposed will not be reasonably likely to cause confusion and deception amongst a substantial number of persons.

25 There was, it seems to me, no dispute between the parties that the opponents The Thomas Cook Group Limited, have a reputation in the United Kingdom in relation to a wide range of travel services, including the provision of travellers cheques and bureau de change activities. It was, however, submitted that the opponents had no use of their trade mark in relation to any of the goods covered by the application. Furthermore, there was no evidence that the opponents’ trade mark (or indeed the opponents reputation) extended beyond the travel business at large. Mr Hamer submitted that the evidence showed that the opponents had a substantial reputation and that their trade mark was used on items of clothing worn by the opponents’ staff and attached to promotional give-aways such as t-shirts and sweat shirts. It was inevitable in his view, that the public at large would be given cause to wonder whether the applicants’ trade mark was associated with that of the opponents and in those circumstances the test set out by Lord Upjohn was met.

35 I have no doubt that the opponents have an established reputation in respect of travel services and that much of this reputation is vested in their trade mark THOMAS COOK. But, as the applicants point out in their evidence, the goods they are interested in are very far removed from the services provided by the opponent. Before considering the respective trade marks therefore I will deal with this point.

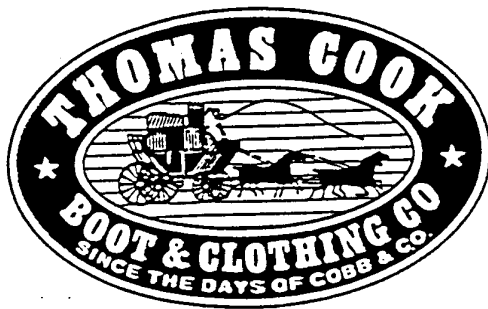
40 It seems to me that the essence of the opponents’ case is that their reputation is such that it extends well beyond the field of travel services and in particular could extend to what has been termed in the evidence ‘adventure clothing’ because this is bought and worn on holidays and trips organised by the Thomas Cook Group Limited. In support of that, the opponent’s have provided evidence that their trade mark is used on items of clothing worn by their staff and as part of the overall get up of items of clothing, such as t-shirts and sweat shirts, used as promotional give-aways. This latter use of the opponents’ trade mark is not, in my view, such

that it would be recognised by the public at large as a badge of origin of the goods. It would simply be taken as a means by which the Thomas Cook Group Limited promoted their travel services. The relevant decided cases on that issue are UNIDOOR LIMITED v. MARKS & SPENCER PLC [1998] RPC 275; DIVISIONAL TRADING OFFICER v. KINGSLEY CLOTHING LIMITED [1989] RPC 695.

Mr Hamer did not base any submissions upon the trade evidence supplied by Messrs Bennett and Burdon-Doyle. On the basis of their knowledge of the clothing retail trade and the travel industry they put forward the view that the public would confuse the applicants' trade mark with that of the opponents. I think that Mr Hamer was right not to pursue this trade evidence because it is based, in my view, on speculation and there is little foundation for the statement made. In all of the circumstances I must make the best I can on the basis of the evidence and submissions put before me.

The clothing industry covers a very wide range of activities from haute couture to mass produced ready to wear garments. And on the basis of a reputation established in these areas some fashion houses and manufacturers have gone on to market other goods e.g. perfume which it might be argued have now become related goods. However, I am not aware of any areas of industrial and commercial activity where a relationship has been established between the providers of a service such as that provided by the opponents and clothing, on the basis that staff providing the service wear a uniform bearing the provider's trade mark or give away items of clothing bearing the trade mark. And no particular circumstance surrounding the travel industry has been put forward to challenge this. I am therefore unable to find that there is any connection between the activities of the applicants and those of the opponents.

I go on to compare the respective trade marks which, for convenience, I set out below:



THOMAS COOK

In comparing the two trade marks I adopt the test laid down by Parker J. in Pianotist:

“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 those 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 circumstances, you come to the conclusion that there will be a confusion - that is to say, not necessarily that one man 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.”

5 Mr Birss accepted that the opponents’ trade mark was wholly contained within the applicants’ trade mark. However, he submitted that there was other material surrounding it which would ensure that the majority of persons would not confuse the two trade marks. Mr Hamer, for the opponents, submitted the opposite and in particular drew my attention to the fact that the opponents’ trade mark appeared in the applicants’ trade mark in a different type face and
10 therefore stood out, even when viewed against the other matter.

In my view the two trade marks are not so similar as to be confused one with the other, on the basis of first impressions. The applicants’ trade mark contains other very significant matter i.e. a stage coach and the words “since the days of Cobb & Co” in addition, the words Thomas
15 Cook appear in what is quite clearly, even on first impression, the name of a boot and clothing company. In my view therefore, all of the other matter which surrounds the two words THOMAS COOK in the applicants trade mark ensure that there would be no association with the opponents’ trade mark.

20 I can see no reason therefore why the public at large should have any cause to believe that the opponent’s reputation in their business and trade mark THOMAS COOK extends beyond the travel services that they provide. In reaching this view I take account of the views of Mr Justice Morton in the matter of an application by Edward Hack for the registration of a trade mark LV111 [RPC] 107 where, in relation to that case, he said:

25 “For my part I go further than that; I think that the large number of persons if they heard of a laxative called “Black Magic” or saw advertisements of a laxative called “Black Magic” would be likely to think that the laxative was made by the same firm who made the “Black Magic” chocolates. If so, I think that confusion is caused within
30 the meaning of Section 11. I think there are a number of other people who, without arriving at a conclusion that the “Black Magic” laxative was made by the same persons as the “Black Magic” chocolates, would wonder if it were or were not made by the same persons. I think further that there is a possibility that people who bought the “Black Magic” laxative in a shop might be left, when they had bought it, under the
35 impression that the “Black Magic” laxative was made by the same persons as the “Black Magic” chocolates, would wonder if it were or were not made by the same persons.

40 The applicants sell clothing (some of which has been termed adventure clothing) whilst the opponents sell travel services, including adventure holidays. But no connection has been established between the two activities such that anyone (or the public at large) is likely to cause to wonder whether there is any relationship between the applicants goods and the services of the opponents.

45 In all of the circumstances and because, in summary, the two trade marks are not similar and there is no association, in my view, between the services of the opponent and the goods of the applicant, the opposition based upon Section 11 of the Act is dismissed.

The opposition having been dismissed, I order the opponents to pay to the applicants the sum of £500.

Dated this 8 day of July 1999

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**M KNIGHT
For the Registrar
the Comptroller General**

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