

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2158217
BY NICHOLAS STEPHEN CROOM TRADING AS
McQUEEN CLOTHING COMPANY
TO REGISTER A SERIES OF TRADE MARKS
IN CLASSES 18 AND 25**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 49257
BY LEE ALEXANDER MCQUEEN**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2158217
by Nicholas Stephen Croom trading as
McQueen Clothing Company to register a
series of trade marks in Classes 18 and 25**

AND

**IN THE MATTER OF Opposition thereto
under No 49257 by Lee Alexander McQueen**

DECISION

1. On 14 February 1998 Nicholas Stephen Croom (trading as McQueen Clothing Co) applied to register the following series of two marks:

McQueen Clothing Co.



McQueen Clothing Co.

for the following specification of goods:

Class 18 - bags

Class 25 - trousers for casual wear, T-shirts, sweatshirts, jackets and tops.

2. The application is numbered 2158217.

3. On 2 December 1998 Lee Alexander McQueen filed notice of opposition to this application. The opponent is engaged in the design, production and marketing of, inter alia, clothing and fashion accessories and claims to have been using the mark ALEXANDER McQUEEN since approximately 1990. The opponent is also the proprietor of the Community Trade Mark applications (CTMs), details of which are set out in the Annex to this decision. On this basis objection is taken under Section 5(2) and 5(4)(a) of the Act.

4. Refusal is also requested under the terms of Section 3(6) of the Act on the basis that the applicant ought to have been aware of the opponent's established rights and made his application in bad faith because he cannot claim to be entitled to the mark in suit.
5. The original statement of grounds contained a number of other grounds but these were withdrawn in a letter from the opponent's trade mark attorneys dated 25 April 2002. A request to amend the grounds by, in effect, adding an additional objection under Section 3(6) was refused at an interlocutory hearing held on 11 July 2002.
6. The applicant filed a counterstatement denying the above grounds.
7. Both sides ask for an award of costs in their favour.
8. Both sides filed evidence. The parties elected to file written submissions in lieu of a hearing. These were submitted under cover of letters dated 7 August 2002 and 9 August 2002 respectively by Markforce Associates, on behalf of the opponent, and Barlin Associates, on behalf of the applicant. Acting on behalf of the Registrar and with the above material in mind I give this decision.

Opponent's evidence

9. The opponent filed four statutory declarations as follows:

Trino Verkade	-	5 May 2000
David William Lake	-	5 May 2000
Jacqueline Margaret Lake	-	5 May 2000
Michael Domenico Bilewycz	-	5 May 2000

10. Mr Verkade is the Business Manager of Birdswan Solutions Ltd, the company which manages the intellectual property portfolio and other business interests of Lee Alexander McQueen.

11. He says that the opponent has been engaged in the design, production and marketing of, inter alia, clothing and fashion accessories, since approximately 1990, and has been using the trade mark ALEXANDER MCQUEEN, and alternately MCQUEEN (stylised) since approximately the same date. Examples of the marks as represented on labels are exhibited at TV1. Prior to 1996 sales were mainly on a private client basis, and figures relating to such sales are not available. Sales figures from Spring/Summer 1996 relating to the opponent's products are set out as follows (sales for some seasons are estimates and are indicated as such):

Year	Sales
Spring/Summer 1997	Approx £2.8 million (estimate)
Autumn/Winter 1997/98	Approx £3.36 million (estimate)
Spring/Summer 1998	Approx £4.2 million (estimate)
Autumn/Winter 1998/99	£5,096,000

Spring/Summer 1999	£6,160,000
Autumn/Winter 1999/2000	£6,252,870
Spring/Summer 2000	£4,928,000

12. The opponent has consistently exhibited clothing and fashion accessories at major fashion shows including London Fashion Week. Exhibited at TV2 is a copy of the opponent's collection history showing themes, along with a brief list of some of the opponent's achievements and clients. A number of celebrities feature on the client list. Exhibited at TV3 are copies of articles, editorials and headlines referring to the opponent.

13. In the United Kingdom references to the opponent's trade mark appear in the publications Dazed and Confused magazine, Arena Spring/Summer, Marie Claire December 1995, Detour March 1996, The Face, The Sunday Times Magazine, Gay Times April 1996, Dazed and Confused No 16, Clothes Show June 1995, The Times Magazine November 11th 1995, I.D magazine, British by Design issue 1, The Guardian Weekend 6th July 1996, Vogue, The Guardian 1st October 1997, HN (Harvey Nichols Magazine) Winter 1997, Evening Standard September 1997, Timeout September/October 1997.

14. The Daily Telegraph alone is said to have published in excess of 1000 articles relating to the opponent since 1995.

15. Other newspapers have similarly produced many articles which related to or have made reference to ALEXANDER MCQUEEN including The Evening Standard, The Independent, The Guardian/Observer, The Scotsman, The Financial Times. A selection of such articles from these and other publications is exhibited at TV4. Mr Verkade also says that numerous references have also been made to the opponent in other media such as The News at Ten, BBC Clothes Show and Internet T.V.

16. The opponent also possesses and maintains a website under www.alexandermcqueen.net. The web site gives details of the opponent's background, some of the opponent's collection, stockists for the opponent's ranges of clothing, accessories and other products bearing the opponent's trade marks in the United Kingdom, the Middle East, the Far East and Continental Europe. Some pages printed from the opponent's web site are exhibited at TV5.

17. Information is given (Exhibit TV6) on the opponent's agents. I note that there are said to be some 24 agents in the United Kingdom. The opponent also has a retail outlet in Conduit Street, London - Exhibited at TV7 is a collection of press articles indicating the media attention received by this outlet.

18. David Lake and Jacqueline Margaret Lake are directors of Farncombe International Ltd, intellectual property and corporate investigators. They conducted enquiries into the trading activities of the applicant. I do not regard their evidence as being inconsistent in any significant way with what the applicant himself has said (see below). I do not, therefore, propose to summarise the results of their enquiries here.

19. Mr Bilewycz is the opponent's professional representative in this matter. The main purpose of his declaration is to exhibit details of the opponent's trade mark applications and registrations.

Applicant's evidence

20. The applicant submitted witness statements as follows:

Nicholas Stephen Croom	-	8 June 2001
Stephen Mucklow	-	25 June 2001
Bruce Charles Clark	-	23 July 2001
Mark Turner	-	3 August 2001
Robert Moore	-	7 August 2001

21. Mr Croom is the applicant. He says that from the year 1972 and until April 2001 he traded as a sole trader under and by reference to the mark/name MCQUEEN and MCQUEEN CLOTHING COMPANY. In or around April 2001 the assets of his sole tradership with the exception of the trade marks including the mark, the subject of this application, were transferred to a newly incorporated Limited Company having as its trade name McQueen Clothing Company Limited. He remains the proprietor of the trade marks and of the trade mark MCQUEEN CLOTHING COMPANY which has been for the past year used with his consent by McQueen Clothing Company Limited.

22. The trade mark MCQUEEN CLOTHING COMPANY was adopted in 1972 and used in relation to a range of goods comprising jeans, t-shirts, sweatshirts, bags, jackets and tops. From time to time since 1972, Mr Croom says, the mark MCQUEEN simpliciter has also been used in relation to the aforesaid goods and since 1989 the mark MCQUEEN has been used more and more. In or around 1989 the range of clothing was extended to include shorts, fleeces, hats, footwear and underwear. The marks MCQUEEN CLOTHING COMPANY and MCQUEEN have also been used from time to time in relation to umbrellas and in relation to a range of bags, rucksacks and wallets.

23. The approximate annual turnover in the goods sold under and by reference to the trade mark MCQUEEN CLOTHING COMPANY and/or the mark MCQUEEN in its various formats since 1985 to date is said to be as follows:

Year	Turnover
	£
1985	1 million
1986	1 million
1987	1 million
1988	1.5 million
1989	1.5 million
1990	1.5 million
1991	1.5 million

1992	1.25 million
1993	1.5 million
1994	1.75 million
1995	2 million
1996	2 million
1997	2.5 million
1998	2 million
1999	2.28 million
2000	2.62 million
2001	3.5 million

24. Information for earlier years is not available.

25. Mr Croom says he has expended approximately the sum of £125,000 since the date of inception of the trade mark in advertising and promoting the products as sold thereunder. In addition he spends approximately £18,000 per annum on producing carrier bags for the products, all such bags bearing the trade marks. He has also sponsored a power boat in the 1980s and a squash team for ten years.

26. He exhibits at NSC/1 sample carrier bags, specimen material showing the manner in which the trade mark MCQUEEN CLOTHING COMPANY is generally used including a swing ticket and neck labels incorporated into the clothing marketed under the trade mark.

27. The user of the trade marks has retail outlets at:

- 4 Butcher Row, Salisbury
- 11 Butcher Row, Salisbury
- 43 High Street, Winchester
- Unit 11 Marlands Shopping Centre, Southampton
- 33 East Street, Chichester, West Sussex
- Unit 8 Brunel Shopping Centre, Swindon
- 20 The Arcade, Bournemouth

28. Mr Croom confirms that the products marketed under and by reference to the trade mark MCQUEEN CLOTHING COMPANY and/or the mark MCQUEEN have been sold through his retail outlets to customers located throughout the whole of the United Kingdom.

29. Mr Croom goes on to comment on Mr Verkade, Mr Lake and Mrs Lake's declarations. The main point to emerge is that Mr Croom admits that the opponent has enjoyed some success in the fashion business but has no knowledge of his goodwill and reputation in the trade marks ALEXANDER MCQUEEN and MCQUEEN. He further suggests that use of the mark ALEXANDER MCQUEEN with the words ALEXANDER and MCQUEEN shown in equal size and prominence would not conflict with his trade marks MCQUEEN CLOTHING COMPANY and MCQUEEN.

30. The other witness statements are from individuals involved in the manufacture and sale of clothing and the packaging industry who confirm that they are aware of Mr Croom's mark

and would associate the marks MCQUEEN or MCQUEEN CLOTHING COMPANY with Mr Croom. I will return to this evidence later in my decision.

Section 5(2)

31. The Section reads as follows:

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

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
- (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.”

32. The opponent has relied on three Community Trade Marks (CTMs). Two of them cover Class 25 goods and appear to offer the opponent a better prospect of success than the third CTM which covers goods in Classes 3, 9 and 14. At the time of writing the two CTMs which cover Class 25 are still pending applications. Section 6(1) and (2) is, therefore, relevant and reads as follows:

“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,
- (b)
- (c)

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

33. It follows that CTMs Nos. 565796 and 565887 have the capacity to become earlier trade marks by virtue of their filing dates but must achieve registration for that status to take effect. I will consider the consequences of this below.

Distinctive character of the earlier trade marks

34. According to *Sabel BV v Puma AG*, [1998] ETMR 1, 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. CTM No. 565796 is for the words ALEXANDER McQUEEN. CTM No. 565887 is for the word McQUEEN presented in stylised form with the “c” contained within the oval of the letter Q.

35. The registrability (distinctiveness) of surnames is now the subject of a reference to the ECJ in *Nichols’ Application* (No. 2241892). However neither of the opponent’s marks is purely a surname. No. 565796 consists of a full name. The Registry has taken the view that full names have, by their nature, a greater capacity to distinguish the goods/services of one undertaking than a surname on its own (see *Work Manual Chapter 6 at 3.12.8*) unless the combination is extremely common. I have not been presented with submissions on what my approach should be to the name ALEXANDER McQUEEN. I do not know how common the surname McQUEEN is. My impression (and it is no more than that) is that it is relatively uncommon - a view partially offset by the fact that the well known actor, Steve McQueen, has that surname. I have little doubt that the full name, ALEXANDER McQUEEN, even in the context of a goods area such as clothing, where there are a large number of traders, is inherently distinctive. CTM No. 565887 does not consist exclusively of the surname McQUEEN. The presentational aspect of the mark contributes to its overall distinctive character. Again I find that the totality is inherently distinctive.

36. I must also consider whether, or to what extent, the intrinsic merit of the marks is supplemented by the use that has been made of them. The submissions filed on behalf of the applicant contain the following:

“This [Mr Verkade’s evidence] confirms the opponent has been engaged in the design, production and marketing of inter alia clothing and fashion accessories since approximately 1990 and has been using the two marks previously referred to since approximately the same date. There is no detailed evidence of the actual use referred to although the name ALEXANDER MCQUEEN is now well known as being the name of a fashion designer and the names / marks of the opponent would at this date be well known as applied to haute couture clothing designed by the opponent. The evidence confirms that the opponent has a single retail outlet in the United Kingdom based in Conduit Street and that clothing designed by the opponent is offered for sale at that establishment. It thus follows that the claimed reputation is exclusively associated with the opponent as a fashion designer and the clothing marketed by him by reference to his trade marks as aforesaid are all fashion collection items of clothing and as such the opponent’s business constitutes a separate and distinct business from that of the applicant.”

37. The applicant appears to acknowledge Alexander McQueen’s reputation as a designer of haute couture clothing. I regard that as being a realistic concession. There can, I think, be little doubt as to Alexander McQueen’s reputation and that this extends to both the design function and the resultant clothing.

38. In considering the guidance contained in *Sabel v Puma* regarding the account that is to be taken of a mark's reputation with the public Simon Thorley QC, sitting as the Appointed Person in *DUONEBS* Trade Mark, BL O/048/01, said:

“In my judgment, I believe what the ECJ had in mind was the sort of mark which by reason of extensive trade had become something of a household name so that the propensity of the public to associate other less similar marks with that mark would be enhanced. I do not believe that ECJ was seeking to introduce into every comparison required by section 5(2), a consideration of the reputation of a particular existing trade mark.”

39. I take the view that, within the marketplace for haute couture clothing, the mark ALEXANDER McQUEEN is indeed entitled to claim an enhanced degree of distinctive character through the use made of it. I also agree with the implicit submission made on behalf of the applicant that this reputation does not extend to other parts of the clothing market.

40. I am unable to satisfy myself from the evidence filed that the mark the subject of No. 565887 can legitimately claim an enhanced degree of distinctive character. Most of the evidence goes to use of ALEXANDER McQUEEN and to a lesser extent McQUEEN rather than the mark in the form shown in No. 565887. However, in relation to both No. 565796 and 565887 I bear in mind that I must consider the notional breadth of their specifications which are not limited to haute couture or designer clothing.

Similarity of goods

41. The opponent's specifications cover the applicant's goods in both Classes 18 and 25. 'Bags' are specifically mentioned in both the applicant's and opponent's specifications. In Class 25 the applicant has itemised particular types of clothing. The opponent's specification covers articles of clothing at large which must, by definition, include the goods of the applicant's specification. As the test is a notional one based on the full breadth of the respective specifications it does not avail the applicant that in practice the parties may have hitherto operated in different areas of the clothing market.

Similarity of marks

42. The guidance from *Sabel v Puma* and *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] FSR 77 is that:

- the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, 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.* paragraph 27;

- the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;
- 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*, paragraph 23.

43. The distinctive character of the mark ALEXANDER McQUEEN seems to me to reside in the forename/surname combination. The evidence suggests nevertheless that the surname is a distinctive and dominant component in as much as references are frequently made to McQUEEN on its own - see for instance the press material at TV3. McQUEEN is also likely to be the dominant feature of No. 565887 notwithstanding the stylised presentation.

44. In relation to the applied for series of marks the opponent suggests in his written submissions that McQUEEN is the essential feature and the words 'Clothing Co' are simply descriptive and devoid of distinctive character. I agree that McQUEEN is the element by which the mark is likely to be remembered.

45. In these circumstances it scarcely requires a full analysis of the visual, aural and conceptual similarities to establish that there is a strong degree of similarity between the parties' respective marks.

Likelihood of confusion

46. The likelihood of confusion is to be appreciated globally taking account of all relevant factors (*Sabel v Puma*, paragraph 22). I have little hesitation in concluding that, bearing in mind what it will notionally be open to the applicant to do if his mark is registered, and what it is notionally open to the opponent to do on the strength of his earlier trade marks (if they achieve registration), there is a clear likelihood of confusion. At the very least the public would be likely to believe that the applied for series of marks came from the same or an economically linked undertaking.

Honest concurrent use

47. The application at issue proceeded to publication on the basis of honest concurrent use with three existing marks including the opponent's two CTM applications, Nos. 565796 and 565887. A defence based on honest concurrent use does not appear to have been expressly pleaded in these opposition proceedings though it might reasonably be inferred from the evidence filed on the applicant's behalf. I note too that the opponent's written submissions deal with the application of Section 7(2) of the Act. In the circumstances I propose to consider the applicant's position in this regard.

48. Section 7(1) and (2) read:

“7.-(1) This section applies where on an application for the registration of a trade mark it appears to the registrar-

- (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,

but the applicant shows to the satisfaction of the registrar that there has been honest concurrent use of the trade mark for which registration is sought.

(2) In that case the registrar shall not refuse the application by reason of the earlier trade mark or other earlier right unless objection on that ground is raised in opposition proceedings by the proprietor of that earlier trade mark or other earlier right.”

49. The Registry’s general approach to the issue of honest concurrent use was set out in a notice in Trade Marks Journal No. 6171 following *Road Tech Computer Systems Ltd v Unison Software (UK) Ltd*, [1996] FSR 805. More recently the relevance of honest concurrent use in the context of opposition proceedings has been the subject of full consideration in *CODAS Trade Mark* [2001] RPC 14 at page 240. After hearing submissions on the subject the Hearing Officer concluded as follows:

“In the circumstances and for the reasons above, I reject Mr Hacon’s submission that because the proprietor of the earlier trade mark against which the applicant for registration has claimed honest concurrent use has opposed the application, the provisions of section 7(2) make the refusal mandatory. However, as I have already said, the mere fact that there has been honest concurrent use is not a defence, which in itself will save an application, but it is one of the “relevant” factors which should be taken into account in determining whether there is a likelihood of confusion.”

50. The analysis leading to this conclusion can be found at pages 246 to 248 of the decision.

51. For honest concurrent use to be of assistance to an applicant it must be possible for the tribunal to satisfy itself that, contrary to its initial view, the effect of concurrent trading has been to suggest that the relevant public has learnt to recognise that goods sold under the respective marks emanate from different trade sources. That implies that both parties are targeting an approximately similar, or at least overlapping, audience and that the applicant’s evidence of use is sufficient to satisfy the tribunal that the apparent capacity for confusion has been adequately tested.

52. If that is the correct approach to the matter then it seems to me that the applicant here falls at the first hurdle because the submissions filed on his behalf confirm that the likelihood of confusion has never been properly tested. Thus it is said:

“The nature of the respective businesses is such that both marks irrespective of the question as to whether they are confusingly similar when considered in their totality would never be seen together in the marketplace and the average person purchasing the applicant’s goods would not see such goods as being a fashion item designed by a fashion designer. Accordingly the respective businesses are remote from each other

and consequently the reputation acquired by each party in its own trade marks relates to a different market.”

53. Those comments may well be a fair reflection of the position in the marketplace but there is no restriction of either side’s goods’ specification which reflects current trading patterns. Nor can I see any realistic way of achieving such a separation.

54. There are in any case difficulties with the applicant’s evidence. As the opponent’s written submissions point out, the materials exhibited do not appear to illustrate a date of use earlier than 1998 (the material date is 14 February of that year) though I acknowledge that one of the labels contains the reference “since 1972”. The first page of Exhibit NSC/1 shows use of McQUEEN CLOTHING CO as a shop name rather than a brand applied to goods. That is in part counteracted by label use which is undeniably McQUEEN CLOTHING CO (exemplified on pages 3 to 5 of the Exhibit). But I note too that other marks are in use including an M device, and McQUEEN on its own (this last perhaps most worrying of all from the opponent’s point of view). Of the remaining enclosures to Exhibit NSC/1 the carrier bags show McQUEEN CLOTHING CO but whether in recognition of the shop name or goods sold under the mark is not clear; and a large cardboard advertisement is headed McQUEEN CLOTHING CO but appears to be directed at promotion of the retail premises rather than goods offered under that mark. Beneath the strapline “We’ve got it covered” are references to some 12 third party brands. The final enclosure to the Exhibit is a spiral bound collection of pages of clothing patterns. I say collection because, whilst it is presented as a single document, date references inside are to ‘Winter 98’ and ‘Autumn/Winter 2000’ (both after the material date). Nor am I clear as to what this material represents. It does not immediately strike me as something that would be available to retail customers though I express no concluded view in that respect. More likely it is an internal document allowing the opponent’s various retail premises to place orders with a central source or for the McQueen Clothing Co itself to place orders with suppliers.

55. These are significant weaknesses in the applicant’s evidence but it is not the only evidence relied on. There are also the four supporting statements from members of the trade. However, although the four witnesses give their own positions, there is no indication as to how or why they were chosen and what, if any, their relationship is with the applicant. Only Mr Clark claims to have been aware of the trade marks McQUEEN and McQUEEN CLOTHING CO for any length of time (since 1975). Mr Moore says he has been aware of the marks since December 1998 and Mr Turner has known them “for at least three years” but his statement was made in August 2001 and presumably reflects his state of awareness at that date. Mr Mucklow does not say for how long he has known the marks. I do not find this supporting evidence to be of particular assistance to the applicant.

56. In summary to the extent that the applicant relies on honest concurrent use I find that Mr Croom’s trade has been directed at a different segment of the clothing market to the opponent and further that the evidence of use suffers from the weaknesses described above in terms of providing substantiating detail. The opposition based on the opponent’s earlier trade marks succeeds subject to those marks achieving registration.

Section 5(4)(a)

57. As my finding under Section 5(2) turns on CTM applications whose fate has yet to be determined I will give full consideration to the Section 5(4)(a) ground. The relevant Section reads:

“(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.”

58. The requirements for this ground of opposition 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] RPC 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

- (1) that the opponent’s 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 opponent, and
- (3) that the opponent has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the applicant’s misrepresentation.

59. Assuming notional and fair use. I must assess whether use of the applicant’s marks McQUEEN CLOTHING CO (series) was as at the date of application, liable to be prevented by the law of passing off. The onus is on the opponent to make out a prima facie case. If he succeeds, in the circumstances of this case I need to return to the applicant’s own position in view of his claim to seniority of user. I say this because, although a Section 5(4)(a) claim has to be established at the date of the application, it is clear that an opponent could have had no such right if an applicant’s use is protected in the UK from an earlier date or if, by the relevant date, an applicant had established his own actionable goodwill in the UK, (*Habib Bank* 1982 RPC at 24).

60. The issue of evidence before the registrar in proceedings under section 5(4)(a) has been the subject of comment in an appeal to the High Court. Mr Justice Pumfrey in *South Cone Inc v. Jack Bessant and Others (t/a Reef)* [2002] RPC 19 stated:

“12..... As Mr Hobbs QC said in *Wild Child TM* [1998] R.P.C. 455, the registrar is often required to act upon evidence that might be regarded as less than perfect when judged by the standards applied in High Court proceedings. The second question follows: how cogent must the evidence be upon which the registrar should act in upholding an opposition on this ground?

13. There is one major problem in assessing a passing off claim on paper, as will normally happen in the registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a *prima facie* case that the opponent’s reputation extends to the goods comprised in the applicant’s specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s 11 of the 1938 Act (see *Smith Hayden (OVAX)* (1946) 63 RPC 97 as qualified by *Bali* [1969] RPC 472. Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

14. Evidence of reputation comes primarily from the trade and the public and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date.....”

61. I have recorded above the evidence filed on behalf of the opponent including the extent, duration and nature of his trade. It details the fashion events at which Mr McQueen has exhibited, the considerable press coverage he has received and the celebrity clients for whom he has designed clothes. His position as a leading fashion designer was, in my view, securely established by the material date in these proceedings.

62. Mr Croom in his witness statement comments that:

“Although it is admitted that the opponent has enjoyed some success in the fashion business, I have no knowledge of his goodwill and reputation in the trade marks ALEXANDER MCQUEEN and MCQUEEN as applied to clothing. The opponent admits that prior to 1996 sales have mainly been on a private client basis and sales figures are not available. He does not say what labels were used and does not indicate what proportion, if any, of the sales since 1997 relate to the MCQUEEN label per se.

It is my submission that Mr Verkade’s evidence does not substantiate that Mr McQueen has made any use of the name / mark MCQUEEN in the United Kingdom or elsewhere and it is in any event my belief that his use of the mark ALEXANDER MCQUEEN with the words ALEXANDER and MCQUEEN shown in equal size and prominence would not conflict with my trade marks MCQUEEN CLOTHING COMPANY and MCQUEEN.”

63. The written submissions filed on the applicant’s behalf acknowledge that the name ALEXANDER McQUEEN “is now well known as being the name of a fashion designer and the names/marks of the opponent would at this date be well known as applied to haute couture clothing designed by the opponent”.

64. I take these comments to mean that the applicant acknowledges the opponent's reputation as a fashion designer but does not concede that the opponent's reputation extends to the surname as opposed to the full name. I have some sympathy with that view. There is some evidence of the use of McQUEEN solus (see TV3 for instance) but the evidence does not distinguish between sales under the full name and the surname. It is also possible to criticise the evidence for not distinguishing adequately between fashion design services and sales of fashion clothing. However, I take the view that this is a case where the service and the goods are inextricably bound together. The provision of clothing through the agent network is simply the end product of the design process. My only hesitation in this respect is because I note from several press articles in Exhibit TV3 that Alexander McQueen was at one time appointed to design for French fashion house Givenchy. That might raise the question as to whose mark appears on the resulting products though it seems unlikely that the Alexander McQueen name would not be given due prominence. The evidence could perhaps have been a little more forthcoming on this aspect of the opponent's business but, taken in the round, it is sufficient to establish the opponent's goodwill under the name ALEXANDER McQUEEN in relation to fashion design and clothing.

65. Turning to the issue of misrepresentation it is the applicant's position that, notwithstanding the opponent's goodwill, the two businesses are separate and distinct; and further that he (the applicant) has built up his own goodwill since the commencement of his business in 1972. The following passage taken from 'The Law of Passing-Off' by Christopher Wadlow (paragraph 7.18) deals with the issue of antecedent rights:

“The definition of passing-off in terms of misrepresentation makes it necessary to deal with the case where the defendant claims to have anticipated the plaintiff in the course of conduct complained of. As the tort was formerly understood, it would normally be said that the indicia in issue could not be distinctive of the plaintiff if they were already in use by another, but this is not necessarily true. If the senior user in time is a small or local business, and the junior user a large one advertising heavily, then the public may soon come to associate the indicia in question so strongly with the larger party as to lead to the belief that the senior user is the interloper. It is self-evident that the senior user is entitled to continue with conduct which was innocent in its inception notwithstanding that it might later be said to convey a misrepresentation to the majority of the public. Thus, in *Stacey v. 2020 Communications* the evidence was that customers confused the plaintiff's small but longer established business for a branch of the defendants. Millet J., though refusing the plaintiff an interlocutory injunction, pointed out that the defendants plainly could not prevent the plaintiff from continuing to use the name *2020*, nor could they complain about third-party recommendations intended for them which accidentally benefited the plaintiff instead. However, it is not legitimate for the defendant to expand from his existing business into a different field already occupied by the plaintiff, or to recommence an abandoned business under a name or mark which has meanwhile become distinctive of the plaintiff.” (Footnotes omitted).

66. Accordingly, in response to the opponent's prima facie case of passing off, I need to consider whether the applicant's use was passing off when it commenced. Had the applicant

substantiated his claimed use at some point prior to the commencement of the opponent's trade in 1990 then he would have established himself as the senior user. In those circumstances there could be no legitimate complaint about the applicant continuing with conduct which was innocent in its inception. The continued use would not constitute a misrepresentation in those circumstances.

67. The difficulty for the applicant is twofold. Firstly, for the reasons already given in my analysis of the evidence submitted in the context of honest concurrent use, it is simply not possible to corroborate the bare claims made by Mr Croom from the exhibited material supplied in purported substantiation of his case. Secondly, whilst the parties may have addressed separate and distinct parts of the clothing market hitherto, there is nothing in the applicant's specification which restricts the ambit of his future trade. Some of the goods applied for are, admittedly, not the sort most obviously associated with haute couture but I consider it unsafe to rely on that point as a clear differentiating factor.

68. At 7.19 Wadlow's deals with expansions of field or area of business as follows:

“It quite frequently happens that two or more businesses may use the same name, mark or get-up in different geographical areas without difficulties arising, but may come into conflict when one or both of them expands. The basic rule is that each may use that name, etc., in its home territory, but that established rights of use in one area do not provide a defence should one business expand into an area where the name denotes the other.”

and

“Similar issues may arise where the conflict occurs on expansion of fields of business, although the authorities are even fewer.

In *Everest v. Camm* the plaintiffs and defendant had both used the mark *Everest* for their chairs for many years. Historically, the plaintiffs made fully upholstered chairs and the defendant wicker chairs. The defendant introduced a partially upholstered wicker chair. In the Court of Appeal the plaintiffs succeeded on the issue of trade mark infringement but failed on passing-off. In *Sterwin v. Brocades* the plaintiffs had introduced a medicine in 1974 under the name *DANOL*, knowing that the defendants already used *DE-NOL* for a totally different medicine, in fact since about 1947. The plaintiffs' medicine was a capsule, the defendants' a liquid. The defendants now intended to introduce a solid formulation of *DE-NOL*. Whitford J. held that there had been no confusion to date, but there would be a likelihood of it if solid *DE-NOL* were introduced. He granted the plaintiffs a declaration (there being no immediate threat) and dismissed the defendants' counterclaim that the plaintiffs were themselves passing off.”

69. The applicant's specification would not prevent him expanding into, or into close approximation to, the area occupied by the opponent with consequent damage to the latter's business. On the material available to me, therefore, I am not persuaded that the application should be allowed to proceed to registration in the face of the opponent's claim under Section 5(4)(a).

Section 3(6)

70. The final ground is the opponent's claim that the application was filed in bad faith because the applicant ought to have been aware of the opponent's use and CTM applications/registration. In the circumstances of this case, and bearing in mind particularly the applicant's claim to have used his mark from a date which precedes the opponent's use, I regard this objection as having very little prospect of success. In the light of my findings under Section 5(2)(b) and 5(4)(a) I do not propose to deal with it any further.

Conclusion

71. In summary I have found for the opponent under Section 5(2)(b) and 5(4)(a). However, my finding under Section 5(2)(b) is dependent upon the opponent's pending CTMs achieving registration. In the event, therefore, that on appeal these pending applications prove critical to the opponent's case it is likely that these proceedings would need to be suspended to await the resolution of these applications. As matters stand the opponent has succeeded unconditionally under Section 5(4)(a) and is entitled to an award of costs. A late request by the opponent to amend his grounds by adding a further ground under Section 3(6) was refused at an interlocutory hearing held on 11 July 2002. The issue of costs arising from this unsuccessful attempt to amend the grounds and an earlier extension of time hearing was held over for consideration at the conclusion of proceedings. I bear in mind the submissions received in relation to the costs issues.

72. In relation to the interlocutory hearing on the extension of time, on balance I consider that the outcome and circumstances lead me to conclude that an award should be made to the applicant in respect of that hearing. I note in particular that the hearing was initiated at the opponent's request in the face of the registry's preliminary view, the background of the earlier extensions to which the opponent's had taken no objection, the lack of reasonable foundation in some of the opponent's arguments, the availability of the bulk of the applicant's evidence by the time the hearing took place and the relatively limited extension requested.

73. In relation to the amendment request my understanding is that the applicant chose not to be represented at the hearing itself but, through his attorney, did make written submissions. There was also correspondence on the matter prior to the hearing. I note that the Hearing Officer considered that the late amendment request had no realistic prospect of success. Taking all these factors into account I will reduce the cost award in favour of the opponent by **£300** to reflect these interlocutory issues and order the applicant to pay the opponent the (net) sum of **£900**. 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.

74. There is still an outstanding issue in relation to costs arising from 'without prejudice' correspondence that passed between the parties or their professional advisors. With the agreement of the parties and to avoid further delay in the decision itself, it was decided that I

should reserve my position on this outstanding issue for subsequent determination. A separate decision will be issued in due course dealing with the outcome of this matter.

Dated this 26th day of September 2002

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

Opponent's CTM applications

No.	Mark	Class	Specification
565796	ALEXANDER McQUEEN	18	Articles of leather and imitations of leather; trunks and travelling bags; travel cases; luggage; suitcases; holdalls; port manteaux; valises; bags; handbags; shoulder bags; toilet bags; carrier bags; rucksacks; backpacks; bumbags; sports bags; casual bags; briefcases; attaché cases; music cases; satchels; beauty cases; carriers for suits, for shirts and for dresses; tie cases; credit card cases and holders; wallets; purses; umbrellas; parasols; walking sticks; shooting sticks; belts; parts and fittings for all the aforesaid goods.
		24	Textiles; textile articles; textile piece goods; bed and table covers; household linen; linen cloth; bed linen; bath linen; table linen; table cloths; curtains of textile or plastic; pillow shams; pillow cases; sheets; towels; eiderdowns; duvets; covers for eiderdown and duvets; napery; napkins; serviettes; table mats (not of paper); face towels; flannels; tissues of textile for removing make-up; traced cloth for embroidery; tapestry (wall hangings) of textile; rugs (travelling); saris; furniture coverings of plastic.
		25	Articles of clothing; footwear; boots; shoes; slippers; sandals; socks; hosiery; trainers; headgear; hats; caps; scarves; gloves;

565887



18

mittens; belts (being articles of clothing).

Articles of leather and imitations of leather; trunks and travelling bags; travel cases; luggage; suitcases; holdalls; portmanteaux; valises; bags; handbags; shoulder bags; toilet bags; carrier bags; rucksacks; backpacks; bumbags; sports bags; casual bags; briefcases; attaché cases; music cases; satchels; beauty cases; carriers for suits, for shirts and for dresses; tie cases; credit card cases and holders; wallets; purses; umbrellas; parasols; walking sticks; shooting sticks; belts; parts and fittings for all the aforesaid goods.

24

Textiles; textile articles; textile piece goods; bed and table covers; household linen; linen cloth; bed linen; bath linen; table linen; table cloths; curtains of textile or plastic; pillow shams; pillow cases; sheets; towels; eiderdowns; duvets; covers for eiderdown and duvets; napery; napkins; serviettes; table mats (not of paper); face towels; flannels; tissues of textile for removing make-up; traced cloth for embroidery; tapestry (wall hangings) of textile; rugs (travelling); saris; furniture coverings of plastic.

25

Articles of clothing; footwear; boots; shoes; slippers; sandals; socks; hosiery; trainers; headgear; hats; caps; scarves; gloves; mittens; belts (being articles of clothing).

20

Non-medicated preparations for the application to, conditioning and care of hair, scalp, skin and nails; soaps; perfumes; perfumery; eau de cologne; toilet waters; essential and herbal oils; cosmetics; make-up preparations; non-medicated toilet preparations; hairsprays and hair gels; preparations for use in the bath or shower; bath and shower oils, gels, creams and foams; face and body masks; face and body scrubs; facial washes; skin cleansers and hydrators; skin toners; skin moisturisers; blemish creams and blemish gels; deodorants; preparations for use before shaving and after shaving; shaving soaps; shaving creams; shaving gels; aftershave preparations; pre shave preparations; talcum powders; toiletries; dentifrices; toothpastes.

09

Glasses and spectacles; sunglasses; corrective glasses and spectacles; protective glasses and spectacles; contact lenses; lenses for glasses and spectacles; frames for glasses and spectacles; corrective frames; cases for glasses, sunglasses and spectacles; cords, ribbons, chains, and devices for retaining glasses, sunglasses and spectacles in position; clip on sunglasses.

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Precious metals and their alloys and goods in precious metals or coated therewith; semi-precious and precious stones; horological and other chronometric instruments; watches, clocks, jewellery and imitation jewellery; parts and fittings for all the aforesaid goods.