

O-271-04

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2263444 BY JOYCE YOUNG TO  
REGISTER A SERIES OF TRADE MARKS IN CLASSES 25, 40 AND 42**

**AND**

**IN THE MATTER OF OPPOSITION NO. 91146 BY SUN 99 LTD**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF Application No. 2263444  
by Joyce Young to register a series of trade marks in  
Classes 25, 40 and 42**

**and**

**IN THE MATTER OF Opposition No. 91146  
by Sun 99 Ltd**

**Background**

1. On 7<sup>th</sup> March 2001 Joyce Young applied to register the following as a series of two trade marks:

**BY STORM**



The image shows two trade marks for 'BY STORM'. The first is the words 'BY STORM' in a bold, uppercase, serif font. The second is a handwritten version of 'by storm' in a cursive script, with 'by' in lowercase and 'storm' in lowercase. A vertical line is positioned to the right of the handwritten mark.

2. The application (No. 2263444) specified the following goods and services:

Class 25: Dresses, jackets, trousers, skirts, suits, blouses, tops, waistcoats, cardigans, tunics, separates, scarves, wraps, swimwear, beachwear, evening wear, bridal wear, gowns, wedding dresses, headdresses, veils, hats, belts, shoes, sandals, all for women and girls.

Class 40: Custom manufacture of clothing for women and girls; alteration of women's clothing and girl's clothing; dressmaking; women's tailoring; advisory, consultancy and information services relating to all of the aforesaid services.

Class 42: Design of clothing for women and girls; fashion design and styling, none relating to hair design and styling; advisory, consultancy and information services relating to the aforesaid services.

3. The application proceeded to publication with the following clause “Honest concurrent use with Registration Nos. 1250938 (5670,989), 1500089 (9095,8063) & others.

4. On 10 October 2002 Sun 99 Ltd filed notice of opposition to this application. There were originally two grounds of opposition. A ground based on Section 5(4)(a) was struck out with the opponents’ agreement (the Registry’s letter confirming this is dated 11 December 2003). That left an objection under Section 5(2)(b) as the sole ground of opposition. The opponents rely in this respect on the registrations details of which appear in the Annex to this decision. They allege similarity of marks and goods/services leading to a likelihood of confusion. An issue appears to have arisen during the processing of the case as a result of the applicant’s attorneys noting that two of the opponents’ marks are composite marks but have been referred to at one point in the statement of grounds as purely word marks. The matter does not appear to have been resolved by an amendment to the reference in the grounds. Nor have the opponents indicated that they no longer place reliance on the composite marks. As this loose end does not appear to have unduly exercised the parties and is not critical to the outcome of the case I do not propose to say anything more about it. I note that a letter from the Registry dated 30 April 2003 indicated that the matter may give rise to a costs issue. However, I do not consider it can be said to have had a material effect on the conduct of the case.

5. The applicant filed a counterstatement denying the above ground. She makes detailed submissions and denials in relation to the respective goods and services. I will deal with the detail below. She denies that the parties’ marks are similar and suggests that combining the word BY with the word STORM has created a mark which looks and sounds different from the opponents’ marks. In the alternative she invites acceptance of the application by virtue of concurrent use since August 1993. She also refers me to two surrounding circumstances viz:

- her own existing registration of a mark incorporating the word “BY STORM” (No. 1553292);
- the fact that the opponents’ marks and her own existing mark co-exist with a considerable number of other registered UK and CTM trade marks incorporating the word STORM and relating to the same or similar goods (some 46 marks in all are listed).

6. Only the applicant filed evidence in these proceedings. Neither side has asked to be heard. A supporting statement has been filed on behalf of the opponents by Paresh Jasani, the solicitor acting for them in this matter (under cover of a letter dated 5 December 2003). Written submissions have also been received from Fitzpatrick’s on behalf of the applicant (their letter of 11 August 2004).

7. Acting on behalf of the Registrar and with the above material in mind I give this decision.

## Evidence

8. The opponents have filed no evidence. The applicant has filed two witness statements. The first is from Ms Young herself, the Managing Director of By Storm Limited, her company. Ms Young exhibits copies of the witness statements and exhibits prepared in support of her application to register the marks in suit. I infer that this was in support of her honest concurrent use claim. For reasons which I will explain later I do not think this can be of assistance in the face of the opponents' challenge. In the circumstances it will suffice if I record the following main points to emerge from her witness statements:

- Ms Young describes her business as being in the "bridal and formal occasion wear" sector of the clothing trade;
- it includes design, manufacture and retailing. At the date of application the only outlets were Ms Young's shops in Glasgow and London;
- the goods and services are promoted by means of mailshots, press advertisements and exhibitions. I note that the latter are directed primarily at the specialist press and events;
- the goods have been sold throughout the UK. Turnover has increased from £339,988 in 1996 to £510,694 in 2000 (mainly attributable to goods rather than services).

9. The other piece of evidence filed by the applicant is a witness statement by Marc Andrew Godfrey of Magpi International Limited, an intellectual property investigations company. He was instructed to conduct an investigation to establish what use had been made of the Trade Mark STORM by the opponent company, particularly in relation to clothing. The conclusion reached was as follows:

"The investigation found that STORM is a trading name of Sun 99 Ltd. Under the brand STORM, Sun 99 Ltd currently markets a range of watches, jewellery and eyewear. The core product is the company's watch range. Sun 99 Ltd have marketed different coloured T-shirts and sweat-shirts to which the STORM mark is applied for over four years. These items of clothing are being discontinued as the company has plans to launch a new range of menswear, possibly within the next two months, under the STORM brand. STORM outlets have limited stock of STORM branded clothing."

That completes my review of the evidence.

10. The only remaining ground of opposition is under Section 5(2)(b) of the Act which reads as follows:

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

(a) .....

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

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

I take into account the well established guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

### **The parties' submissions**

11. The opponents say that the respective marks are visually and conceptually similar; that the dominant element of the applied for mark is the word STORM with BY playing a minor or insignificant part; and that BY is frequently used in conjunction with the name of the designer. Furthermore they say that similar considerations apply in relation to their composite mark (No. 2127274A) where STORM is the prominent element. In relation to the goods and services the opponents point to a high degree of overlap in the Class 25 and 42 specifications. The opponents do not have a registration covering Class 40 services but suggest that the services specified (custom manufacture of clothing, tailoring, dressmaking etc) are merely an extension of the Class 42 services. They make further observations in relation to honest concurrent use which I will deal with separately.

12. The applicant's submissions are that the marks applied for are BY STORM and not STORM solus and that there is a conceptual difference because the former has a meaning of its own in the sense of “to overwhelm” whereas STORM refers to a violent weather condition. The marks are thus said to be distinguishable in conceptual terms as well as in terms of their overall sounds and appearances. In the alternative, reference is made to the applicant's concurrent use and the fact that there have been no instances of confusion. In the further alternative, it is suggested that the respective goods and services are not in competition. In particular the applicant trades in a niche market (bridal and formal occasion wear) and through two sales outlets only. It is suggested that great care would be exercised in the purchase of wedding dresses and such like goods.

### **Comparison of marks**

13. Two preliminary issues fall to be addressed. Both can be dealt with fairly shortly. Firstly, no evidence of use of the opponents' marks has been brought forward, so in determining the distinctive character of those marks I have only their inherent merits to consider. The second point is that the applied for marks are put forward as a series of two under the provisions of Section 41 of the Act. On that basis the claim is that they “resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark”. Although there is a modicum of stylisation to the second mark in the series I do not understand the parties to suggest that this is a factor that should have a material impact on my decision. Indeed it would be surprising if that were so given the qualifying criteria for a series of trade marks. I will, therefore, for convenience simply refer to the opponents' marks as BY STORM.

14. According to the authorities the visual, aural and conceptual similarities of the marks must be assessed by reference to their overall impressions bearing in mind their distinctive and dominant components (*Sabel v Puma*, paragraph 24). The matter must be judged through the eyes of the average consumer who is deemed to be reasonably well informed, circumspect and observant (*Lloyd Schuhfabrik v Klijsen*, paragraph 27).

15. The applicant has been at pains to emphasise that her business trades under the name BY STORM and hence the mark has been applied for in that form. The evidence supports that claim. The parties differ in their view of the significance to be attached to that state of affairs. I find myself in agreement with the opponents that the use of the preposition is common in the fashion industry to indicate the designer or fashion house concerned. It can scarcely be said to make a material contribution to the overall character of the mark. Accordingly, I take STORM to be the dominant and distinctive component of the applied for mark. It is also the only component of all but two of the opponents' marks. Even in relation to the composite Marks, Nos. 2127267A and 2127274A it is a significant feature (particularly the latter). Furthermore, the word STORM would appear to be a distinctive mark in relation to a wide range of clothing.

16. It follows from this that I regard the respective word marks to be similar to a high degree on both visual and aural grounds. The applicant has sought to tease out different conceptual associations. Given that the marks must be considered in the context of the goods and services in respect of which they are to be used (and the fact that the average consumer is not generally credited with pausing to analyse marks) I regard the conceptual distinction that is argued for to be a little strained. The degree of similarity, which as indicated I consider to be high in relation to the word marks, is somewhat lower when the opponents' composite mark No. 2127274A is considered, but not to an extent that is likely to have a material effect on the outcome of the case.

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

17. The applicant has made a number of sensible admissions in relation to the respective sets of goods and services. I summarise these as being:

- that the goods of this application (Class 25) are similar to the goods of Nos. 1250938 and 1500089 and to the Class 25 goods of Nos. 2127267A and 2127274A of the opponents' marks;
- that the services of designing adults' and children's clothing are similar to the services specified in No. 2116673.

18. Ms Young denies similarity of goods in a number of respects which need not concern me for present purposes because they involve Classes in the opponents' specifications which are of no, or peripheral, relevance. More relevantly though, she denies that any similarity exists in relation to the Class 40 services.

19. On the basis of the concessions made I do not need to consider the Class 25 goods further. The applicant's goods are acknowledged to be similar. In light of the broad terms used in, for

instance, No.1500089 I would go further and say that some items are likely to be identical. Others may have a somewhat lower degree of similarity. Further analysis appears to be otiose.

20. So far as Class 42 is concerned similarity is conceded only, it would seem, in relation to the first item in the applicant's specification (in practice I regard the respective design services as being identical). The other service of "fashion design and styling; advisory, consultancy, and information services relating to all the aforementioned services" must be held to overlap with clothing design. In fact, 'fashion design and styling' appears to be little more than an alternative way of expressing the same concept. I find that the Class 42 services are identical and/or similar.

21. That leaves Class 40 where the specification is more concerned with services to do with making up articles of clothing rather than designing clothing. No evidence has been filed bearing on practices in the trade. It may be that some fashion designers restrict themselves to the more creative aspect of the work and leave the actual manufacture of the garments to others. To that extent it may be argued that these are commercially distinct services. But that seems to me to be a fine point. The applicant in this case says "My two shops display sample garments of my designs and garments to these designs are then made up in my factory to particular customers' orders". Thus the services of design and manufacture are closely associated in the applicant's business. Commonsense suggests that this is unlikely to be atypical of what happens. I conclude that the applicant's Class 40 services are quite closely linked with, and complementary to, the opponents' clothing design services in Class 42 and to a lesser degree their Class 25 goods.

### **Likelihood of Confusion**

22. The guidance in *Sabel v Puma* is that likelihood of confusion must be appreciated globally taking account of all relevant factors. In addition to the considerations addressed above there are three further issues to deal with in this case. They are the relevance of the applicant's existing registration in Class 25; the fact that there are a considerable number of marks on the UK and Community Trade Mark Registers consisting of or incorporating the mark STORM in relation to goods and services in Class 25 and 42; and the applicant's concurrent use. I will deal with these points in turn.

23. The existing registration referred to by the applicant is No. 1553292. It is a word and device mark. The quality of the image supplied is not very good but the device consists of a 'porthole' through which can be seen a ship foundering in heavy seas. The words BY STORM are written in manuscript across the waves that are engulfing the vessel. The device itself is a dominant and arresting feature of the mark. The opponents were apparently aware of this mark and say that they objected to it but did not proceed with the objection at the time as the marks were considered sufficiently different. Even setting aside the question of the relevance of a proprietors' existing registration in the face of a challenge to a current application, I find No. 1553292 to be of no assistance to the applicant here. It is a different mark. Its existence cannot act as a shield against the current opposition.

24. The second point is the so called co-existence of the opponents' mark with a large number of other UK and CTM registrations. With one exception the marks consist of STORM as a prefix, suffix or separate element in the marks concerned, some of which also have devices. By way of

example the first four on the list are STORM KING, STORMSEAL, BELSTAFF STORMSHIELD and STORMSAFE and device. With a possible exception that I will touch on in a moment there is no evidence that any of the marks are in use. On the face of it, it seems unlikely that they are all unused marks but in the absence of information on such use it is not possible to comment on the public's approach to STORM marks and their ability to differentiate between them. This aspect of the applicant's case fails for the reasons given in the following passage from *British Sugar Plc v James Robertson & Sons Ltd* (TREAT) [1996] RPC 281:

“Both sides invited me to have regard to the state of the Register. Some traders have registered marks consisting of or incorporating the word “Treat”. I do not think this assists the factual inquiry one way or the other, save perhaps to confirm that this is the sort of word in which traders would like a monopoly. In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the registrar to put the marks concerned on the register. It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, see e.g. *MADAME Trade Mark* and the same must be true under the 1994 Act. I disregard the state of the register evidence.”

25. The exception mentioned above is a reference that the applicant's investigators found to the brand PETER STORM suggesting that that mark is in use. In practice there are just two internet pages from well after the relevant date indicating that Peter Storm have a distributor in the UK and illustrating their clothing. Such limited evidence of use at a later date of what is in any case a different mark does little to advance the applicant's case.

26. That brings me to the applicant's claim based on their own concurrent use. Ms Young's position is that she has traded under the plain form of the mark since 1993 and in the stylised form since 1997.

27. The relevance of an applicant's own use was considered in *Codas Trade Mark* [2001] RPC 240. The Hearing Officer's consideration of the matter commenced at paragraph 20. It will be sufficient to record the conclusion reached:

“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 is one of the “relevant” factors which should be taken into account in determining whether there is a likelihood of confusion.”

28. Thus, concurrent use does not in itself save an application but may suggest that, contrary to the Hearing Officer's prima facie view of the matter, the relevant public has been shown to be capable of distinguishing between marks with the result that there is no confusion as to trade origin.



29. The applicant's written submissions contain the following:

".....there is no likelihood of confusion between the trade mark applied for and the opponents' earlier marks because the respective goods and services are not competitive. The trade mark applied for is used in a niche market which the applicant describes as "bridal and formal occasional wear" and investigations carried out for the applicant have shown that, to the extent that the opponent's earlier marks have been used in relation to clothing, this use has been restricted to t-shirts and sweatshirts, with apparent plans to launch a collection of men's casualwear later this year.

The applicant's goods and services are available only through her own BY STORM retail outlets in Glasgow and London and the goods are of the applicant's own design and are made to customer order. This, taken with the great care and deliberation which would be given to the purchase of such a special and relatively expensive item as a wedding dress or an outfit for another formal occasion, would further avoid any likelihood of confusion between the trade mark applied for and the opponent's earlier marks. A consumer looking for one of the applicant's wedding dresses would not come away with one of the opponent's watches or a t-shirt by mistake or *vice versa*."

30. The information about the opponent's trade is based on the investigator's enquiries. The opponents' themselves have not said that it misrepresents their trade. I will assume for present purposes that the above paragraphs represent a fair reflection of the nature and extent of the parties' businesses hitherto. It is clear from this that the applicant's trade, although not insubstantial, has been conducted through just two retail outlets and addresses a very specialised marketplace. It is also clear that the specification of goods is not restricted to 'bridal and formal occasion wear' although I accept that it includes such items. The applicant's submission that the parties' goods are not in competition with one another is in all probability a reasonable statement based on current trading patterns. But it does not allow for the full breadth of the applicant's specification. Equally importantly, it strongly suggests that the impact of the respective marks has not been tested on an overlapping customer base in a way that might shed light on the likelihood of confusion arising. It is scarcely surprising in the circumstances that no evidence of actual confusion has been adduced.

31. In summary I find that the respective marks (particularly but not restricted to the opponents' word only marks) are highly similar; that the goods are identical and/or similar; and that the applicant's services are also closely associated with and similar to the opponents' goods and services. Even allowing for the degree of care that is likely to be exercised in relation to the purchase of clothing (especially more formal wear) I find that there is a strong likelihood of confusion when allowance is made for notional use across the full extent of the respective specifications. Further, the applicant's use does not counter that finding. The opposition thus succeeds under Section 5(2)(b).

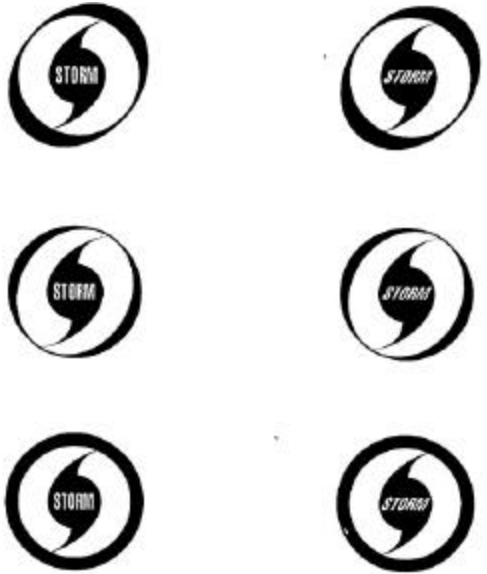
32. The opponents are entitled to an award of costs. I order the applicant to pay them the sum of £1000. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 3<sup>rd</sup> day of September 2004**


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

## ANNEX

Earlier trade marks relied on by the opponents:

Number	Mark	Class	Specification
1250938	STORM	25	Jeans being articles of clothing; articles of clothing made from knitted textile fabrics; knitted articles of clothing
1500089	STORM	25	Jeans being articles of clothing; articles of clothing (none being waterproof) made from woven textile fabrics; knitted articles of clothing; all included in Class 25.
2127267A		14 18 20 25	<p><b>Class 14:</b> Articles fashioned of or coated with precious metals or imitation precious metals; jewellery and imitation precious metal; jewellery and imitation jewellery; ornaments and objects of art; watches; clocks; ornamental articles containing watches and clocks; parts and fittings for all of the aforesaid.</p> <p><b>Class 18:</b> Articles made from leather, imitation leather or from plastics and rubber not included in other classes; luggage; purses; handbags; rucksacks; cases; briefcases; bags; wallets; billfolds; umbrellas; parasols; belts; walking sticks; whips; riding stocks and harnesses; horse brasses and saddlery; parts and fittings for all of the above.</p> <p><b>Class 20:</b> Household, office, factory and commercial furniture, including hand crafted and mass produced furniture made from natural wood, synthesised materials and metals; tables of all kinds including dining tables, occasional tables and coffee tables; chairs; easy chairs; settees and armchairs; desks and bureaux; bookcases; stools and foot stools; book cases; kitchen cabinets; shelves and shelving units; display and drinks cabinets; cupboards and wardrobes; side-boards; beds and sofa-beds; garden furniture.</p> <p><b>Class 25:</b> Jeans being articles of clothing; articles (none being waterproof) made from woven textile fabrics; knitted articles of clothing;</p>

			shoes, shirts, jackets, trousers, coats, tops, jumpers, T-shirts, jogging tops and bottoms and other leisure and sports wear, jumpers, cardigans, hats and scarves, underwear and socks, bathrobes and suits; all made from woven textiles of natural or synthetic fibres or knitted using natural or synthetic fibres.
2152209	STORM	09 28	<p><b>Class 09:</b> Optical instruments and devices, none relating to weather forecasting or weather recording; sunglasses, spectacles, monocles, binoculars, monoculars, magnifying glasses, opera glasses, telescopes; headband magnifiers; night vision aids; parts, frames, cases and fittings for all the aforesaid goods.</p> <p><b>Class 28:</b> Toys, games and playthings for humans and for pets; balloons; dolls, puppets, mobiles, teddybears; dolls houses, furniture and fittings therefor; display stands for toys; clothing for toys; playhouses, play tents; card games and playing cards; board games; building bricks, building blocks and other components all being in the nature of toys; gymnastic and sporting articles (non being angling apparatus); models and replicas in kit form or complete; craft toys sold in kit form; jigsaw and other puzzles; conjuring and juggling sets; toy action figures and accessories therefor; roller skates, ice skates, in-line skates; skateboards, surfboards, snowboards; masquerade costumes and masks; amusement park rides, Christmas tree decorations; parts and fittings for all the aforesaid goods.</p>
2127274A		14 18 20 25	<p><b>Class 14:</b> Articles fashioned of or coated with precious metals or imitation precious metals; jewellery and imitation precious metal; jewellery and imitation jewellery; ornaments and objects of art; watches; clocks; ornamental articles containing watches and clocks; parts and fittings for all of the aforesaid.</p> <p><b>Class 18:</b> Articles made from leather, imitation leather or from plastics and rubber not included in other classes; luggage; purses; handbags; rucksacks; cases; briefcases; bags; wallets; billfolds; umbrellas; parasols; belts; walking sticks; whips; riding stocks and harnesses; horse brasses and saddlery; parts and fittings for all of the above.</p> <p><b>Class 20:</b> Household, office, factory and</p>

			<p>commercial furniture, including hand-crafted and mass-produced furniture made from natural wood, synthesised materials and metals; tables of all kinds including dining tables, occasional tables and coffee tables; chairs; easy chairs; settees and armchairs; desks and bureaux; bookcases; stools and footstools; bookcases; kitchen cabinets; shelves and shelving units; display and drinks cabinets; cupboards and wardrobes; sideboards; beds and sofa-beds; garden furniture.</p> <p><b>Class 25:</b> Jeans being articles of clothing; articles (none being waterproof) made from woven textile fabrics; knitted articles of clothing; shoes, shirts, jackets, trousers, coats, tops, jumpers, T-shirts, jogging tops and bottoms and other leisure and sportswear, jumpers, cardigans, hats and scarves, underwear and socks, bathrobes and suits; all made from woven textiles of natural or synthetic fibres or knitted using natural or synthetic fibres.</p>
1374972	STORM	18	Luggage, purses; wallets; billfolds, umbrellas, parasols, walking sticks; parts and fittings for all the aforesaid goods; all included in Class 18.
2116673	STORM	42	Designing, preparing, modifying and adapting designs for; watches and clocks; adults' and children's clothing of all types including headgear and footwear an made from natural and synthetic fibres; bags and luggage; eyewear including sunglasses; umbrellas, wallets, parasols.