

O-279-05

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2320221
BY ARCADIA GROUP BRANDS LIMITED TO REGISTER
A SERIES OF TRADE MARKS IN CLASS 25**

AND

**IN THE MATTER OF OPPOSITION No. 92176
BY SEVEN S.P.A.**

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by Arcadia Group Brands Limited to register
a series of Trade Marks in Class 25**

and

**IN THE MATTER OF Opposition No. 92176
by Seven S.P.A.**

BACKGROUND

1. On 9 January 2003 Arcadia Group Brands Limited applied to register the following series of two marks:





in respect of:

Blouses; shirts; tunics; jumpers and fleeces; t-shirts; trousers; coats; jackets; parkas; skirts; tops; all the aforesaid goods being clothing for women and girls. (Class 25).

2. I note that the publication of the application in the official Journal indicated that the application had proceeded on the basis of honest concurrent use with registration numbers 1506816 (6077, 3695), 2194588 (6282, 7181) and others.

3. On 5 December 2003 Seven S.p.A. filed notice of opposition to this application. The opponent is the proprietor of the following Community Trade Mark registrations:

No.	Mark	Class	Specification
591206 (CTM)		25	Woven and knitted clothing and underwear, boots, shoes and slippers, headgear.
2305589 (CTM)		25	Clothing (including underwear and beachwear), shoes, boots, slippers, sandals, belts; headgear.

4. I should just add that the above registrations also cover goods in Classes 16 and 18 but for the purposes of the current opposition it is sufficient to record the Class 25 specifications.

5. The opponent claims that the respective sets of goods are identical and/or similar as are the marks and that there is a likelihood of confusion as the public would assume there is a connection in the course of trade between goods sold under the marks. Accordingly, objection is raised under Section 5(2)(b) of the Act.

6. The applicant filed a counterstatement denying the above claim.

7. Both sides ask for an award of costs in their favour.

8. Both sides filed evidence. Neither side has asked to be heard. Written submissions have been received from Marks & Clerk on behalf of the applicant and Bromhead Johnson on behalf of the opponent.

Opponent's evidence

9. The opponent filed a witness statement by Ross Timothy Manaton, the trade mark attorney representing it in this matter. He exhibits copies of the registrations relied on (RTM 1 and 2), a copy of an OHIM Opposition Division decision involving an identical mark to the one applied for and CTM No. 591206 (RTM3) and a certified translation of that decision (RTM4).

Applicant's evidence

10. The applicant submitted a witness statement by Adam Goldman of Arcadia Group Limited. He is also a Director of the applicant company. He exhibits (AG22) a copy of the evidence filed at the examination stage as a result of which the application was allowed to

proceed to publication on the basis of honest concurrent use. He further supplements this evidence with examples of how the mark is used (AG23) and examples of recent press material (AG24). I will come back to this evidence in my decision below. Mr Goldman also offers submissions as to the relevance of the OHIM's Opposition Division's decision referred to by Mr Manaton.

11. That concludes my review of the evidence.

DECISION

12. The sole ground of opposition is under Section 5(2)(b) which reads as follows:

“5-(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.”

13. 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] RPC 117 and *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.

14. In essence, the test under Section 5(2) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those differing elements, taking into account the degree of identity/similarity of the goods and how they are marketed. I must compare the marks in issue having regard to the distinctive character of each and assuming normal and fair use of the marks across the full range of the goods within their respective specifications. The matter must be considered from the perspective of the average consumer who is deemed to be reasonably well informed and reasonably circumspect and observant.

15. Both of the marks relied on by the opponent are earlier trade marks within the meaning of Section 6(1) of the Act.

Comparison of goods

16. The applicant's goods consist of a range of outerwear with the qualification that they are all intended for women and girls.

17. The goods of CTM No. 591206 include woven and knitted clothing and underwear. There is no restriction as to the category of consumers being targeted. Women and girls could be amongst the potential audience. The term woven and knitted clothing would include a large number of the goods of the application in suit. On that basis the goods are identical. To the extent that they may not be identical they are likely to be closely similar being woven or knitted equivalents of other types of clothing.

18. CTM No. 2305589 covers clothing at large. Self-evidently, that term must include the individual items of clothing of No. 2320221. Again, therefore, identical goods are involved.

19. The average consumer for clothing is the public at large. The position is qualified in the case of Arcadia's application by the restriction to "for women and girls". Purchases of clothing will include items bought for personal use and items bought for others, notably by parents for children. Clothing may be either for personal adornment and/or protection against the elements. I would expect consumers to exercise a modicum of care in the purchase of these goods commensurate, no doubt, with the nature of the actual goods being purchased and the amount being spent.

Distinctive character of the marks

20. One of the fundamental contentions that underlies the applicant's position is that the word seven or numeral 7 in relation to clothing merely denotes a clothing size and is, therefore, non-distinctive in character. On that basis it is said that the distinctive character of the marks must reside in the particular form of stylisation. The applicant's written submissions suggest that I can take judicial notice of the significance of seven/7 in the clothing field. Furthermore, it is said that there are 41 separate registrations extending to the UK in respect of clothing which include a word or numeral seven. However, as no details of the registrations have been supplied it is impossible to judge the relevance of this latter claim.

21. It is not clear that the word or numeral, seven/7, is used as a clothing size as the applicant suggests. The opponent submits that the claim is unsupported by evidence and counterclaims that women's clothing sizes are generally quoted in even numbers only starting at size 8. I note that the 'Evans Direct' mail order catalogue pages at AG7 give size ranges 14 and upwards in even numbers only (and numerals rather than words) which rather supports the opponent's position. I accept that certain types of clothing (footwear comes to mind but is not issue in this case) may employ the numeral 7 as a size indicator. I am not persuaded that this is true of clothing generally. It is a point that should have been established by evidence in the circumstances of this case. Absent such evidence I take the view that the word SEVEN, whilst not possessing a particularly high degree of distinctive character in its own right, has not been shown to be an element, the potential significance of which as an indicator of trade origin, is likely to be discounted or disregarded by consumers.

22. The opponent's marks are more than the word or numeral seven/7. CTM No. 591206 consists of the word SEVEN with a numeral 7 elided into the letter S. The letter S is somewhat unusual in appearance and the numeral 7 contains a small star. The mark is thus designed around the '7' theme but the form and configuration of the elements contributes to the distinctive character of the mark.

23. CTM No. 2305589 consists of the word SEVEN within what at first glance has the appearance of a rugby ball shape. The applicant's written submissions, quite reasonably,

describe the shapes as ellipses. The whole is presented against a black background. The device and word SEVEN each contribute to the overall visual impression of the mark and make for a distinctive whole. As consumers may, of course, see no need to refer to or recollect the mark by reference to the abstract shape, I take the view that they are more likely to focus their attention on the word SEVEN as the defining and more memorable feature of the mark.

24. The applied for marks consist of the word SEVEN in uneven size lettering along with the numeral 7 in a circle above and slightly to the right of the final letter. The word and numeral are contained within large square brackets. The first mark in the series is set within, and in contrasting tones to, a black background. The central message of the mark is the concept of SEVEN/7 but the arrangement of the individual features and, particularly, the use of square brackets forms part of the distinctive character of the marks. The opponent has submitted that the square brackets constitute a minimal element of the mark and will merely be seen as a frame for the distinctive content. I think that overstates the position. It is not altogether usual to place words/numerals in square brackets in this way. It is a presentational feature that has been designed into the mark and should in my view be given due weight. I might just add, parenthetically, that most of the applicant's advertisements, labelling, tags etc faithfully reproduce the mark in the form applied for but I note that textual references in AG1 and 2 (exhibited to AG22) refer to the brand as SeVen (with the capitalised V). I do not find it surprising that that is thought to capture the core identity of the brand.

25. I regard each of the marks in issue as having a reasonably high degree of distinctive character when the combined effect of the various features is taken into account. The stylisation of the marks contributes to that distinctive character but does not displace or negate the significance of the word SEVEN.

Comparison of marks

26. The principles of comparison are well established. I must consider the visual, aural and conceptual similarities of the marks having regard to their overall impressions and bearing in mind their distinctive and dominant components, *Sabel v Puma*, paragraph 23. The matter is to be judged through the eyes of the average consumer who normally perceives a mark as a whole and does not proceed to analyse its various details, *Sabel v Puma*, paragraph 23. The average consumer, who is deemed to have the qualities set out in *Lloyd Schuhfabrik* at paragraph 27, 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.

27. Visually, I find that the word SEVEN (albeit in various forms) dominates each of the marks but not to the exclusion of the other elements identified above. The differences in the arrangement and presentation of the elements of the marks makes an impact on the overall impression left by the respective marks. The obvious visual similarity arising from the fact that the marks employ the word/numeral, SEVEN/7, is thus tempered by the presence of these other differentiating features.

28. Aurally and conceptually, the dominant and key element of each of the marks is the word SEVEN. It is unlikely, in my view, that the average consumer, given the obvious reference point of the word/numeral, SEVEN/7, will find it necessary to describe or refer to the other elements of the marks. From this point of view the marks are quite closely similar. It is, however, to be borne in mind that visual considerations are generally held to be of primary

importance in the context of purchases of clothing items (see *REACT Trade Mark* [2000] RPC 285).

Likelihood of confusion

29. This is a matter of global appreciation taking all relevant factors into account, *Sabel v Puma*, paragraph 22. The applicant has filed evidence of use of its mark in the UK in relation to the goods of the application since 1996/7. The goods in question are sold through the Evans stores, one of the clothing trading divisions of Arcadia Group. The Evans chain is said to have some 259 outlets in the UK and other ‘shops within shops’. There has been significant turnover under the mark rising steadily from £3.4 million in 1996/7 to £14.9 million in 2001/2. The nature and extent of this trade is documented in Mr Goldman’s evidence and supporting exhibits.

30. This evidence formed the basis of the applicant’s claim to honest concurrent use at the examination stage. The applicant’s written submissions make the point that, despite this use, the opponent has not adduced any evidence of confusion.

31. 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.”

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

32. 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 use by the parties in nature, extent and duration has been sufficient to satisfy the tribunal that any apparent capacity for confusion has been adequately tested and found not to exist.

33. As there is no evidence that either of the opponent’s marks has been used in this country, there is no empirical basis on which I can assess consumer response to exposure to both parties’ marks. As the opponent’s written submissions put it “absence of evidence of confusion cannot be equated with evidence of absence of confusion”. The applicant’s use cannot in itself, therefore, be determinative of the matter.

34. The opponent, for its part, has referred in its evidence to a decision of the OHIM Opposition Division involving the applied for mark and CTM No. 591206. As Mr Goldman has pointed out in his evidence, the relevant territory for the purposes of the opposition was said to be Italy and the relevant public was the Italian public. Different linguistic, social and

cultural considerations may, therefore, have come into play. The decision in that case is not, in any case, binding on me so, whilst I note the findings in that case, I must reach my own view of the matter. More generally, as to the relevance of decisions of other registries, I have also borne in mind the observations of the Appointed Person in *ZURICH PRIVATE BANKING Trade Mark*, O-201-04.

35. I bear in mind in reaching my decision that a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods - *Canon v MGM*, paragraph 17. The goods here are either identical or closely similar. The applied for mark, like the opponent's marks, relies to a material extent on the element SEVEN. The issue, therefore, is whether consumers, noting the stylistic and presentational differences between the marks including the presence of other elements, will take such differences as indicating that goods sold under the respective marks emanate from different trade sources.

36. There is force, in my view, to the observation in the opponent's statement of grounds that "Members of the purchasing public will be very well aware that the same trade mark may very often be used in different styles in different circumstances and that the style of usage of a mark is liable to change over time". Allowing for such reshaping and updating of marks, which is by no means an unusual process, I consider that there is a likelihood of confusion between each of the opponent's marks and the applied for mark. Accordingly, the opposition succeeds under Section 5(2)(b).

COSTS

37. The opponent is entitled to an award of costs. I order the applicant to pay the opponent the sum of £1400. 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 17th day of October 2005

M REYNOLDS
For the Registrar
the Comptroller-General