

**TRADE MARKS ACT 1994**

**AND IN THE MATTER OF TRADE MARK APPLICATION No. 2529550 IN THE NAME OF MAC GLOBAL LTD**

**AND IN THE MATTER OF OPPOSITION No. 100177 THERETO BY FORTNUM & MASON PLC**

**IN THE MATTER OF REGISTERED TRADE MARK No. 2343778 IN THE NAME OF MAC GLOBAL LTD**

**AND IN THE MATTER OF THE APPLICATION FOR A DECLARATION OF INVALIDITY No. 84307 THERETO BY FORTNUM & MASON PLC**

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**DECISION**

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**Introduction**

1. This is an appeal from the decision of Mr. Mark Bryant, acting for the Registrar, dated 11 January 2013 (O-016-13), in which he rejected:
  - (1) The opposition by Fortnum & Mason (“*F&M*”) to a trade mark application made by Mac Global Ltd (“*Mac*”); and
  - (2) The application for invalidity brought by F&M against a trade mark registration in the name of Mac.
2. Application No. 2529550 for registration of the mark FITZROY & MASON was filed by Mac on 22 October 2009. The application covered the following goods in Class 18:


Leather and imitations of leather; animal skins, hides; trunks and travelling bags; handbags, rucksacks, purses; umbrellas, parasols and walking sticks; whips, harness and saddlery; clothing for animals.
3. The application was published in the Trade Marks Journal on 20 November 2009 and on 22 February 2010 F&M filed a notice of opposition to the application.


4. Trade Mark Registration No. 2343778 for the mark FITZROY & MASON was filed by Mac on 18 September 2003 and was entered on to the register on 20 February 2004. The registration covered the following goods in Class 25:

Articles of clothing for men, women and children.

5. On 15 February 2012 F&M filed an application for a declaration of invalidity against Mac's said registered trade mark.
6. Both the opposition and the application for a declaration of invalidity were brought under Section 5(2)(b), Section 5(3) and Section 5(4)(a) of the Trade Marks Act 1994 ("*the 1994 Act*").
7. In support of the Section 5(2)(b) and Section 5(3) grounds F&M relied upon the following earlier trade marks conveniently identified in paragraph 4(b) of the Hearing Officer's Decision as follows:

<b>Mark details and relevant dates</b>	<b>Relevant goods and services</b>	<b>Case and grounds where mark is relied upon</b>
963164  FORTNUM & MASON  Filing date: 30 July 1970	<p><b>Class 29:</b> <i>Meat; fish, poultry and game, none being live; meat extracts; preserved, dried or cooked fruits and vegetables; jellies and dairy products, all for food; jams; edible oils, edible fats; fruit preserves, vegetable preserves and pickles.</i></p> <p><b>Class 30:</b> <i>Coffee, tea, cocoa, sugar, rice, tapioca, sago, coffee essences and coffee extracts, mixtures of coffee and chicory; chicory and chicory mixtures, all for use as substitutes for coffee; flour and preparations made from cereals for food for human consumption, bread, biscuits (other than biscuits for animals), cakes, pastry, non-medicated confectionery, honey, treacle, baking powder, salt (for food), mustard, pepper, vinegar, sauces and spices (other than poultry spices).</i></p> <p><b>Class 32:</b> <i>Non-alcoholic drinks and preparations for making such drinks, all included in Class 32.</i></p> <p><b>Class 33:</b> <i>Wines, spirits (beverages) and liqueurs.</i></p> <p><b>Class 34:</b> <i>Manufactured tobacco, cigars and cigarettes</i></p>	Section 5(2)(b) in the opposition and Section 5(3) in both the opposition and invalidation

<p>2001737</p> <p>FORTNUM &amp; MASON</p> <p>Filing date: 10 November 1994</p> <p>Registration date: 13 July 2001</p>	<p><b>Class 35:</b> <i>The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a department store or in an airport retail outlet; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from a general merchandise catalogue by mail order, from a general merchandise Internet site or by means of telecommunications; advice and assistance in the selection of goods; provision of information to customers relating to goods</i></p>	<p>Section 5(2)(b) and Section 5(3) in both the opposition and invalidation</p>
<p>IR(EU) 877106</p>  <p>Date of international registration: 14 December 2004</p> <p>Date of protection in the EU: 14 December 2004</p>	<p><b>Class 18:</b> <i>Bags; plastic shopping bags.</i></p> <p><b>Class 25:</b> <i>Boots and shoes; clothing for use in the kitchen; pinafores; aprons; chefs hats.</i></p> <p><b>Class 29:</b> <i>Meat, fish, poultry and game; meat extracts; caviar; pâté; partridge; grouse; pheasant; chicken; curried liver; curried mutton; curried chicken; fish pastes; hams; tongues; bacon; meat in tins, glasses and terriners; potted meats; beefs extracts; preserved, dried and cooked fruits and vegetables; fruits in tins and bottles; cherries; pineapple; fruit salads; apricots; pears; peaches; grapefruit; prunes; plums; figs; marrons; jellies; jams; marmalade; chutneys; mincemeat; soups; fruits sauces; dairy products; eggs; milk; milk products; edible oils and fats; preserves; fruit preserves, vegetable preserves; pickles; salad sauces; flavoured butter; brandy butter; dressings; pickled onions; cranberry sauce; soup and preparations for making soup.</i></p> <p><b>Class 30:</b> <i>Coffee; tea; black tea; black tea in bags; green tea; green tea in bags; cocoa; artificial coffee; coffee essences and coffee extracts, mixture of coffee and chicory; chicory and chicory mixtures, all for use as substitutes for coffee; scented tea and flavoured tea; sugar; rice, tapioca, sago, coffee substitutes; flour, and preparations made from cereals; bread; spiced bread; biscuits; cakes; pastry and confectionery; ices; honey; treacle; yeast, baking powder; salt; mustard; pepper; vinegar; sauces; spices; ice; condiments, curry powder, and all edibles in tins and glasses; non-medicated confectionery; sugar confectionery; petit fours; salt (for food); relish sauces (excluding cranberry sauce and apple sauce); chutney; puddings; poppadums; pancakes.</i></p> <p><b>Class 31:</b> <i>Agricultural, horticultural and forestry products and grain; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals; malt.</i></p> <p><b>Class 32:</b> <i>Beer, ale and porter; non-alcoholic drinks and preparations for making such drinks;</i></p>	<p>Section 5(2)(b) and Section 5(3) in the opposition proceedings only</p>

	<p><i>mineral and aerated waters; soft drinks; dealcoholised beverages; fruit drinks and fruit juices.</i></p> <p><b>Class 33:</b> <i>Alcoholic beverages (except beers); wines, spirits and liqueurs; cider and perry; port wine the produce of the Alton Douro district of Portugal.</i></p> <p><b>Class 34:</b> <i>Tobacco, raw or manufactured; cigars, cigarettes; smokers' articles; matches.</i></p> <p><b>Class 35:</b> <i>The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a department store or in an airport retail outlet; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from a general merchandise catalogue by mail order, from a general merchandise Internet site or by means of telecommunications; advice and assistance in the selection of goods; provision of information to customers relating to goods.</i></p> <p><b>Class 39:</b> <i>Delivery services; delivery of goods; delivery of goods by mail; distribution of goods; storage of goods, transportation of goods; packaging of goods.</i></p>	
<p>2377903</p>  <p>Filing date: 12 November 2004 Registration date: 22 July 2005</p>	<p>The same as for IR(EU)877106, above.</p>	<p>Section 5(2)(b) and Section 5(3) in the opposition proceedings only</p>
<p>CTM 9036278</p> <p>FORTNUM &amp; MASON</p> <p>Filing date: 19 April 2010 Registration date:</p>	<p><b>Class 35:</b> <i>the bringing together, for the benefit of others, of a variety of goods, namely, perfumery, cosmetics, shower gels, body lotions, printed matter, books, magazines, leather goods, luggage, wallets, passport holders, luggage tags, furniture, hampers, hampers containing food, household or kitchen utensils and containers, tea pots, tea strainers, caddy spoons, textiles and textile goods, tea towels, clothing, footwear, headgear, aprons, chefs' hats, games and playthings, decorations for Christmas trees, meat, fish, poultry and game, meat extracts, caviar, pate, partridge, grouse, pheasant,</i></p>	<p>Section 5(2)(b) and Section 5(3) in the invalidation proceedings only</p>

<p>28 October 2010</p> <p>Seniority claimed from UK registrations 963164 and 2001737</p>	<p><i>chicken, curried liver, curried mutton, curried chicken, fish pastes, hams, tongues, bacon, meat in tins, glasses and terrines, beef extracts, preserved, dried and cooked fruits and vegetables, fruits in tins and bottles, cherries, pineapple, fruit salads, apricots, pears, peaches, grapefruit, prunes, plums, figs, marrons, jellies, jams, marmalade, chutneys, mincemeat, soups, fruits sauces, dairy products, eggs, milk, milk products, edible oils and fats, preserves, fruit preserves, vegetable preserves, pickles, salad sauces, flavoured butter, brandy butter, dressings, pickled onions, cranberry sauce, soup and preparations for making soup, coffee, tea, black tea, black tea in bags, herbal teas, green tea, green tea in bags, cocoa, artificial coffee, coffee essences and coffee extracts, mixture of coffee and chicory, chicory and chicory mixtures, all for use as substitutes for coffee, scented tea and flavoured tea, sugar, rice, tapioca, sago, coffee substitutes, flour, and preparations made from cereals, bread, spiced bread, biscuits, cakes, pastry and confectionery, ices, honey, treacle, yeast, baking powder, salt, mustard, pepper, vinegar, sauces, spices, ice, condiments, curry powder, and all edibles in tins and glasses, non-medicated confectionery, sugar confectionery, petit fours, salt (for food), relish sauces (excluding cranberry sauce and apple sauce), chutney, puddings, poppadums, pancakes, beer, ale and porter, non-alcoholic drinks and preparations for making such drinks, mineral and aerated waters, soft drinks, non-alcoholic beverages, fruit drinks and fruit juices, alcoholic beverages (except beers), wines, spirits and liqueurs, cider and sherry, port wine, enabling customers to conveniently view and purchase those goods in a department store, in an airport retail outlet, from a general merchandise catalogue by mail order, a general merchandise Internet site or by means of telecommunications; advice and assistance in the selection of goods; provision of advisory and information services in relation to the aforesaid services.</i></p>	
<p>963169</p>  <p>Filing date:</p>	<p><b>Class 29:</b> <i>Meat; fish, poultry and game, none being live; meat extracts; preserved, dried or cooked fruits and vegetables; jellies and dairy products, all for food; jams; edible oils, edible fats; fruit preserves, vegetable preserves and pickles.</i></p> <p><b>Class 30:</b> <i>Coffee, tea, cocoa, sugar, rice, tapioca, sago, coffee essences and coffee extracts, mixtures of coffee and chicory; chicory and chicory mixtures, all for use as substitutes for coffee; flour and preparations made from cereals for food for human consumption, bread, biscuits (other than biscuits for animals), cakes, pastry, non-medicated confectionery, honey, treacle, baking powder, salt</i></p>	<p>Section 5(3) in the invalidation proceedings only</p>

30 July 1970	<p><i>(for food), mustard, pepper, vinegar, sauces and spices (other than poultry spice.</i></p> <p><b>Class 32:</b> <i>Non-alcoholic drinks and preparations for making such drinks, all included in Class 32.</i></p> <p><b>Class 33:</b> <i>Wines, spirits (beverages) and liqueurs.</i></p> <p><b>Class 34:</b> <i>Manufactured tobacco, cigars and cigarettes.</i></p>	
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8. As correctly stated by the Hearing Officer in paragraph 4 of his Decision each of the registrations relied upon are an ‘*earlier trade mark*’ as defined by Section 6(1)(a) or Section 6(1)(b) of the 1994 Act.
  
9. In the invalidity action F&M also sought to rely upon an ‘*earlier trade mark*’ pursuant to Section 6(1)(c) and Section 56 of the 1994 Act. Such ‘*earlier trade mark*’ being a ‘*well known*’ mark in the United Kingdom within the meaning of Article 6bis of the Paris Convention. This basis for attack was not pursued at the hearing below and was not commented upon by the Hearing Officer (see paragraph 4(d) of the Decision). It does not form part of the appeal before me and I will therefore not refer to it again in this Decision.
  
10. In support of the Section 5(4)(a) ground F&M claimed an extensive and widespread goodwill attached to the sign FORTNUM & MASON in the UK for a wide variety of goods and services (identified in the Annex to this Decision) protectable under the law of passing off.
  
11. Subsequently Mac filed Counterstatements in which: (1) all F&M’s claims were denied; and (2) F&M was put to proof of its use in respect of all goods manufactured in leather, including leather bound books, leather aprons, leather bags and wallets, luggage tags and gloves.
  
12. In its Counterstatements Mac admitted that: (1) F&M is a retailer based in Piccadilly, London; (2) F&M was established in 1707; (3) F&M has acquired a substantial reputation in the UK and worldwide in respect of the retailing of food and food goods; and (4) F&M had used its marks in respect of food and food goods.

13. The two set of proceedings were subsequently consolidated.
14. Both parties filed evidence.
15. At the hearing before the Hearing Officer, F&M were represented by Mr. Leighton Cassidy and Mr. Hastings Guise for Field Fisher Waterhouse LLP and Mac was represented by Mr. Malcom Chapple (instructed by Lawrence Sternberg & Co).

**The Hearing Officer’s Decision**

16. The Hearing Officer rejected both the opposition and the application for a declaration of invalidity under Section 5(2)(b), Section 5(3) and Section 5(4)(a) of the 1994 Act.
17. In making his assessment of similarity of the goods and services in issue the Hearing Officer identified the goods and services which he considered represented ‘*F&M’s best case*’ for the purposes of the Opposition in paragraph 28 of his Decision in the following terms:

<b>F&amp;M’s most relevant goods and services</b>	<b>Mac’s goods</b>
<p><b>Class 18:</b> <i>Bags; plastic shopping bags.</i></p> <p><b>Class 25:</b> <i>Boots and shoes; clothing for use in the kitchen; pinafores; aprons; chefs hats.</i></p> <p>(As listed in IR(EU) 877106)</p> <p><b>Class 35:</b> <i>The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a department store or in an airport retail outlet; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from a general</i></p>	<p><b>Class 18:</b> <i>Leather and imitations of leather; animal skins, hides; trunks and travelling bags; handbags, rucksacks, purses; umbrellas, parasols and walking sticks; whips, harness and saddlery; clothing for animals.</i></p>

<i>merchandise catalogue by mail order, from a general merchandise Internet site or by means of telecommunications; advice and assistance in the selection of goods; provision of information to customers relating to goods.</i>  (As listed in 2001737 and IR(EU) 877106)	
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The Hearing Officer likewise identified the goods and services which he considered represented ‘F&M’s best case’ for the purposes of the application for invalidity in paragraph 34 of his Decision in the following terms.

<b>F&amp;M’s most relevant goods and services</b>	<b>Mac’s goods</b>
<b>Class 35:</b> <i>the bringing together, for the benefit of others, of a variety of goods, [...], enabling customers to conveniently view and purchase those goods in a department store, in an airport retail outlet, from a general merchandise catalogue by mail order, a general merchandise Internet site or by means of telecommunications; advice and assistance in the selection of goods; provision of advisory and information services in relation to the aforesaid services.</i>  (as listed in CTM 9036278 and insofar as reflects the seniority claim to 2001737)	<b>Class 25:</b> <i>Articles of clothing for men, women and children.</i>

There is no suggestion on this appeal that this was not a proper approach for the Hearing Officer to take in making the relevant assessment of similarity of the goods and services in issue.

18. In making his comparison of the marks in issue the Hearing Officer identified the earlier marks which he considered represented ‘F&M’s best case’ for the purposes of the Opposition in paragraph 39 of his Decision in the following terms:



F&M's marks	Mac's mark
<p style="text-align: center;">FORTNUM &amp; MASON</p> 	<p style="text-align: center;">FITZROY &amp; MASON</p>

The Hearing Officer likewise identified the earlier marks which he considered represented '*F&M's best case*' for the purposes of the application for invalidity in paragraph 40 of his Decision in the following terms:

F&M's mark	Mac's mark
<p style="text-align: center;">FORTNUM &amp; MASON</p>	<p style="text-align: center;">FITZROY &amp; MASON</p>

Again there is no suggestion on this appeal that this was not a proper approach for the Hearing Officer to take in making the relevant assessment of similarity of the marks in issue.

19. In addition, at the hearing below:

- (1) It was accepted on behalf of Mac that F&M had demonstrated use in respect of all the goods and services relied upon (paragraph 24 of the Decision);
- (2) It was common ground between the parties that F&M has a long established goodwill attached to its mark in respect of food products and the retailing of food (paragraphs 63 and 71 of the Decision); and
- (3) It was confirmed on behalf of F&M at the hearing that F&M relied only upon the goodwill and reputation that it had in respect of food products and the

retailing of food and not on any wider goodwill or reputation (paragraphs 51, 63 and 71 of the Decision).

20. It was on this basis that the Hearing Officer decided that:

- (1) F&M's services displayed similarities to Mac's goods (paragraph 32 of the Decision);
- (2) F&M's bags are identical to Mac's travelling bags and handbags and highly similar to Mac's trunks and rucksacks (paragraph 33 of the Decision);
- (3) F&M's services in Class 35 are similar to Mac's goods in Class 25 (paragraph 35 of the Decision);
- (4) The average consumer is an ordinary member of the public who will pay a reasonable degree of care and attention but not the highest degree of attention in the purchasing process. That purchasing process is primarily a visual one but aural considerations may also be involved (paragraph 38 of the Decision);
- (5) The F&M word and device mark has a moderately low level of visual similarity to Mac's mark (paragraph 45 of the Decision);
- (6) The F&M word mark has a moderate level of similarity with Mac's mark (paragraph 46 of the Decision);
- (7) There is a moderate level of aural similarity between the marks in issue (paragraph 47 of the Decision);
- (8) There is a moderate level of conceptual similarity between the marks in issue (paragraph 48 of the Decision);
- (9) There is a moderate level of similarity overall between the marks in issue (paragraph 49 of the Decision);

- (10) The F&M word mark does not possess the highest level of distinctive character but rather is distinctive to an ordinary degree. The distinctiveness of the F&M word and device mark is enhanced to a small degree by the addition of the device (paragraph 50 of the Decision); and
- (11) The reputation of the F&M marks relied upon by F&M is only in respect of goods and services which are not identical or similar to those of Mac. Accordingly the distinctive character of F&M's marks is not enhanced through use in respect of the relevant goods and services relied upon by F&M (paragraph 51 of the Decision).
21. On the basis of the points identified in paragraph 19 above and the findings in paragraph 20 above the Hearing Officer went on to make his assessments under Section 5(2)(b), 5(3) and 5(4)(a) of the 1994 Act.
22. The Hearing Officer concluded his assessment under Section 5(2)(b) of the 1994 Act as follows:

58) However, having acknowledged this, it is my view that there is no likelihood of confusion. This is because there are a number of factors, that when taken into account as part of the global appreciation test, lead me to conclude that the consumer is not likely to be confused. Firstly, the consumer is very familiar of the concept of differentiating between people and families by reference to surnames and FITZROY and FORTNUM are both surnames that share little resemblance to each other except for their initial letter. Secondly, despite this, the surname MASON is reasonably common and, as such, reduces the likelihood of consumers assuming that when seeing this surname in the context of the two marks being considered here that it is a reference to the same family or person. Rather it is equally likely to be perceived as indicating a completely different person or family that happens to have the same surname. When factoring this with imperfect recollection, that the degree of attention during the purchasing act being reasonable, but not the highest and that in respect of bags at least, the respective goods are identical, I find that the difference in the first name of each mark is sufficient that it is not likely that the consumer will be confused.

59) This finding is not disturbed by Mr Guise's submission that both FITZROY and FORTNUM have connotations of class. There is nothing before me that indicates this. Whilst I recognise that F&M

has a reputation for quality and tradition, but this in respect of goods and services that are not similar to those of Mac and is identified by its mark FORTNUM & MASON and not by the surname FORTNUM alone.

60) In summary, there is no likelihood of confusion and, consequently the opposition and the invalidation, insofar as they are based upon Section 5(2)(b) of the act, fail in their entirety.

23. The Hearing Officer went on to express his conclusions on misrepresentation under Section 5(4)(a) of 1994 Act as follows:

67) F&M's argument, as presented at the hearing, is that Mac's mark represents high quality heritage by virtue of association with F&M's goodwill. I do not consider that this case is made out when taking account of the different fields of activity involved and the difference in the marks. As I have already said, consumers are able to easily differentiate between surnames and will identify the differences between the first elements of the respective marks, namely FITZROY and FORTNUM. The fact that the second surname is relatively common and not unusual is likely to result in the consumer not being misled into believing that it is purchasing F&M's goods.

68) In summary, taking all the relevant factors into account, I conclude that use of Mac's mark in respect of the goods listed in its specification will not result in misrepresentation or damage of F&M's goodwill.

24. Finally on the basis of the his findings and the matters referred to above the Hearing Officer rejected the case under Section 5(3) of the 1994 Act for the following reasons:

73) I will restrict my consideration to F&M's word mark because if it is not successful relying upon this mark, it will not be successful in respect to any of its earlier marks. I have already concluded that the respective marks share only a moderate level of similarity. I have also found that the respective goods and services do not share any similarity, and it follows that there is no likelihood of confusion. F&M's earlier mark is endowed with an inherent ordinary level of distinctive character, but this is enhanced through its significant reputation in the field of food and retailing of food as a result of F&M's use of its mark over many years. Nevertheless, when factoring all of the relevant points into my consideration, I conclude that the distance between the respective goods and services and the differences between the marks, in particular, are such as for F&M's mark not to be brought to mind when he/she encounters Mac's mark. It has been argued, on behalf of F&M, that Mac's mark conjures up

an impression of quality and heritage, but no evidence has been submitted as to why this is so and even if it was the case, the mere fact that both marks may create such an impression is not sufficient to create the necessary link.

74) In summary, I find that the necessary link does not exist between the respective marks and as a consequence there can be no unfair advantage or detriment and the attacks based upon Section 5(3) of the Act fail in their entirety.

### **The appeal**

25. On 7 February 2013 F&M filed a Notice of Appeal to the Appointed Person under Section 76 of the 1994 Act.

### **Standard of review**

26. The appeal is by way of review. Neither surprise at a Hearing Officer's conclusion, nor a belief that he has reached the wrong decision suffice to justify interference in this sort of appeal. Before that is warranted, it is necessary for me to be satisfied that there was a distinct and material error of principle in the decision in question or that the Hearing Officer was clearly wrong. See Reef Trade Mark [2003] RPC 5, and BUD Trade Mark [2003] RPC 25.
27. More recently in Fine & Country Ltd v Okotoks Ltd (formerly Spicerhaart Ltd) [2013] EWCA Civ 672; [2014] FSR 11 Lewison LJ said at paragraph [50]:

The Court of Appeal is not here to retry the case. Our function is to review the judgment and order of the trial judge to see if it is wrong. If the judge has applied the wrong legal test, then it is our duty to say so. But in many cases the appellant's complaint is not that the judge has misdirected himself in law, but that he has incorrectly applied the right test. In the case of many of the grounds of appeal this is the position here. Many of the points which the judge was called upon to decide were essentially value judgments, or what in the current jargon are called multi-factorial assessments. An appeal court must be especially cautious about interfering with a trial judge's decisions of this kind. . . .

28. On appeals of this nature, it is necessary to bear these principles in mind.

## **The Grounds of Appeal**

29. In paragraph 5 of the Grounds of Appeal F&M made clear that it did not contest the following findings of the Hearing Officer that:
- (1) *‘[Mac] concedes that [F&M] had demonstrated use in respect of all the goods relied upon’* (paragraph 24 of the Decision);
  - (2) *‘[F&M’s] specification in Class 35 (as listed in UK Trade Mark Registration No. 2001737) covers services in relation to all goods that may be available from a “general merchandise” retailer. Such goods include all those covered by the marks in suit’* (paragraph 30 of the Decision);
  - (3) *‘the goods and services covered by the marks in suits are either identical (in the case of some Class 18 goods) or similar to goods or services covered by [F&M’s] marks’* (paragraphs 32, 33, and 35 of the Decision);
  - (4) *‘the parties word marks FORTNUM & MASON and FITZROY & MASON share a moderate level of visual similarity’* (paragraph 46 of the Decision);
  - (5) *‘the parties marks share a moderate level of aural similarity’* (paragraph 47 of the Decision);
  - (6) *‘the parties marks share a moderate level of conceptual similarity’* (paragraph 48 of the Decision);
  - (7) *‘the parties marks share a moderate level of similarity overall’* (paragraph 49 of the Decision);
  - (8) *‘the surname MASON is endowed with an ordinary level of distinctive character’* (paragraph 50 of the Decision);
  - (9) *‘[F&M] has a reputation in respect of food goods and the retail of food goods’* (paragraphs 51 and 71 of the Decision);

- (10) *'[F&M] has a reputation for quality and tradition'* (paragraph 59 of the Decision, being one example of such a finding); and
- (11) *'[F&M] have a long-established goodwill attached to its mark in respect of food goods and the retail of food goods'* (paragraph 63).

That these findings were not contested was reiterated in the written submissions filed on behalf of F&M for the purpose of the hearing of the appeal.

30. In addition there is no suggestion in the Appellant's Notice or at the hearing before me that the Hearing Officer did not identify the relevant case law on the issues that were to be decided nor, in my view, could there be.
31. Against that background the Grounds of Appeal contend in substance:
  - (1) The Hearing Officer erred in his assessment of the impact of F&M's reputation upon the assessments that he was required to make;
  - (2) The Hearing Officer erred in his assessment of the weight to be given to the conceptual impression that the marks in issue would have on the average consumer;
  - (3) The Hearing Officer erred in his treatment of prior decisions of the UK IPO relied upon by F&M;
  - (4) The Hearing Officer erred in omitting to consider the normal and fair use of the marks in particular in the context of use as the name of a bricks and mortar outlet selling clothing and accessories; and
  - (5) These errors led to the Hearing Officer failing to correctly analyse: (a) the *'likelihood of confusion'* under Section 5(2)(b) of the 1994 Act; (b)

misrepresentation under Section 5(4)(a) of the 1994 Act<sup>1</sup>; and (c) the ‘link’ under Section 5(3) of the 1994 Act.

32. There was one further Ground of Appeal relating to the conduct of the Hearing Officer in his overall approach to the matter for determination before him. In my view there was no basis for this Ground of Appeal. Quite correctly, it was expressly indicated at the hearing of the Appeal that this was not a Ground of Appeal that was being pursued. I therefore say nothing more about it.

## **Decision**

### *The effect of the F&M’s Reputation*

33. As recorded in the Decision below F&M only relied upon its reputation in respect of food products and the retailing of food and not on any wider goodwill or reputation (paragraphs 51, 63 and 71 of the Decision).
34. That these paragraphs in the Decision did not accurately record the position taken by F&M below was not identified in either the Grounds of Appeal or the arguments before me as an error made by the Hearing Officer.
35. In my view it is clear that the reputation of F&M in respect of food products and the retailing of food were fully and fairly taken into account by the Hearing Officer where relevant to the assessments that he was required to make: see paragraphs 63, 65, 71 and 73 of the Decision.
36. The correct approach to appeals in this Tribunal has been set out in paragraphs 26 and 27 above. Moreover it is bound to proceed, as an appellate tribunal, in conformity with the proposition that ‘*the trial is not a dress rehearsal. It is the first and last night of the show*’: FAGE UK Ltd v. Chobani UK Ltd [2014] EWCA Civ 5 at paragraph

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<sup>1</sup> So far as the Appeal in relation to the Hearing Officer’s analysis Section 5(4)(a) of the 1994 Act was concerned the Skeleton of Argument filed by F&M for the purposes of the hearing of the Appeal contained no specific submissions directed to the issues raised.



[114(ii)] per Lewison LJ. It seems to me that, in the circumstances outlined above, to the extent that F&M now seek to re-open the assessment made by the Hearing Officer on a different basis on appeal, i.e. on the basis that F&M now seek to rely on a reputation in respect of goods and services other than food products and the retailing of food, it must be rejected.

*The weight to be given to the conceptual impression that the marks in issue would have on the average consumer*

37. There is no dispute that the relevant average consumer is a member of the general public. What is criticised is, in substance, the weight given by the Hearing Officer to the conceptual impression that the marks would make on such a consumer when making the relevant assessments for conflict.
38. In particular it is averred that additional weight should have been given to the similarity of the conceptual impression between the relevant marks because: (1) F&M ‘*does not engage in extensive advertising and its reputation is driven strongly by word of mouth*’ and therefore there was some evidence in the present case to suggest that the visual impression in particular respect of clothing/accessory goods is not the most significant; and (2) all the marks have ‘*a shared overtone of quality and heritage*’.
39. In relation to the first criticism it is clear: (1) from the Hearing Officer’s description of the evidence in paragraphs 10 and 11 of his Decision that whilst F&M do not engage large scale advertising campaigns F&M does produce a fortnightly email magazine sent to its customers and also produces catalogues illustrating the products that it retails; and (2) that in making his findings in relation to the degree of attention which consumers of clothing (and indeed the other relevant goods) pay when selecting the relevant goods and services the Hearing Officer expressly stated that whilst he regarded the purchasing process as primarily a visual one ‘*I do not ignore the aural considerations that may be involved*’ (paragraph 38 of the Decision).

40. In relation to the second criticism the Hearing Officer found that the conceptual impression for quality and heritage was '*not, prima facie, evident in any of the marks*' (paragraph 48 of the Decision) and rejected the submission that '*both the words FITZROY and FORTNUM have connotations of class*' (paragraph 59 of the Decision).
41. The Hearing Officer went on to find that the only evidence of an impression of heritage and tradition was in relation to the reputation of F&M's marks in respect of food and food products and the retailing of the same (paragraphs 48 and 59 of the Decision). Those being goods and services that were not similar to those of Mac (paragraph 59 of the Decision).
42. In relation to the mark FITZROY & MASON what is said on behalf of F&M is that the Hearing Officer failed to take into account the evidence of Mr MacLennan filed on behalf of Mac which is said to support the proposition that the mark FITZROY & MASON had overtones of quality and tradition. In relation to this evidence: (1) such evidence is specifically referred to in paragraph 17 of the Hearing Officer's Decision; and (2) such evidence related to Mac's aspiration that the look and feel of the products sold should be '*something a bit special and classic, i.e. a heritage angle that has been exploited by, for example, JACK WILLS*' it was not a characterisation of the mark.
43. No evidence was filed on behalf of F&M to support the contention that the mark FITZROY & MASON gives rise to an impression of quality and heritage.
44. It seems to me that the Hearing Officer took the view, having considered the evidence, that there was no material before him to displace his view that the conceptual impression for quality and heritage was not evident in the FITZROY & MASON mark.
45. In these circumstances and given there is no challenge to the finding that '*the parties marks share a moderate level of conceptual similarity*' (paragraph 48 of the Decision); or that '*the parties marks share a moderate level of similarity overall*' (paragraph 49 of the Decision) it seems to me that no relevant error of principle or other serious error has been identified.

*The treatment of the prior decisions of the Appointed Person/Registrar*

46. The general rule is that each mark must be assessed independently against the relevant legal criteria and will stand or fall on its own merits. References to other cases involving different marks and different circumstances (as to which the full details are not available) that could justify what might otherwise appear to be dissimilar results are not of assistance.
47. In the present case the Hearing Officer with regard to the earlier decisions said in paragraph 53 of his Decision as follows ‘*Mr Guise drew my attention to numerous cases that he contended lends support to his submission that there is a likelihood of confusion between F&M’s marks and Mac’s mark. I am not bound by these cases and I must consider the matters before me, however there are a number of specific comments I wish to make regarding these cases.*’
48. As accepted by Mr Guise on behalf of F&M in the course of the hearing before me none of the decisions of the Appointed Person/Registrar relied upon by F&M were binding upon the Hearing Officer. Moreover it does not seem to me that the Hearing Officer made any error of principle (1) in identifying the approach that he had to take; and/or (2) when identifying the reasons why in any event he considered that the prior decisions relied upon were not to be regarded as analogous to the matters which he had to decide in the present case.

*The normal and fair use of the marks*

49. In paragraph 18 of the Grounds of Appeal it is stated that the Hearing Officer did not consider the normal and fair use of the marks in the context of the use as the name of a bricks and mortar outlet selling clothing and accessories and in particular such use within an airport concourse.
50. This Ground of Appeal was not dealt with either in the written or oral submissions on behalf of F&M on appeal. In so far as F&M’s use was concerned it is clear that the Hearing Officer had in mind use of F&M’s marks in the context of airports as he expressly mentioned them in paragraph 8 of his Decision. So far as the normal and

fair use of Mac's marks in relation to clothing in Class 25 and other goods in Class 18 it is clear that such use was expressly considered by the Hearing Officer when making his comparison between the goods and services in issue at paragraphs 36 to 35 of his Decision. I do not consider that this Ground of Appeal identifies any error of principle by the Hearing Officer.

*The assessment of conflict under Section 5(2)(b)/Section 5(3) and Section 5(4)(b) of the 1994 Act*

51. The focus of the appeal under this heading (over and above those already set out above) was the Hearing Officer's assessment of the 'likelihood of confusion' under Section 5(2)(b) of the 1994 Act.
  
52. In Home-Tek International Ltd's Trade Mark Applications (O-144-05) at paragraph [21] Geoffrey Hobbs Q.C. sitting as the Appointed Person identified the necessary enquiry for the decision taker to make when assessing any conflict under Section 5(2)(b) as follows:

$$X \text{ times } Y \text{ equals } Z$$

where X is the degree of similarity between the marks in issue, Y is the degree of similarity between the goods or services in issue and Z is the existence of a likelihood of confusion.

Mr Hobbs went on to state at paragraph [22]:

In essence, a claim for protection under sub-paragraph (b) raises a single composite question: are there similarities (in terms of marks and goods or services) that would combine to give rise to a likelihood of confusion in the event of concurrent use of the marks in issue in relation to goods or services of the kind specified? The question falls to be determined from the view point of the average consumer of the goods or services concerned. The average consumer is for this purpose deemed to be reasonably well-informed and reasonably observant and circumspect. Since it is not possible for similarities between marks to eliminate differences between goods/services or for similarities between goods/services to eliminate differences between marks, the purpose of the assessment must be to determine the net effect of the given similarities and differences. These must be given as much or as little significance as the average consumer would have

attached to them at the date as of which the relative rights of the parties fall to be determined.

53. The single composite question requires a realistic appraisal of the net effect of the similarities and differences between the marks and the goods or services in issue from the perspective of the average consumer (who is taken to be reasonably well-informed and reasonably observant and circumspect) to be made.
54. In paragraph 52 of his Decision the Hearing Officer expressly stated that in making his assessment of the likelihood of confusion he must take into account all factors relevant to the circumstances of the case and in particular the interdependency principle which he went on to correctly summarise.
55. In the present case there is no challenge to the Hearing Officer's findings as to 'X' and 'Y' but rather a challenge to the finding that 'X times Y does not equal Z'. It is said that the error in his finding was as a result of him revisiting his findings in relation to 'X' and adopting a 'salami slice' approach to the marks in issue. I do not accept that these are valid criticisms.
56. Firstly, with regard to the revisiting of the findings in relation to the similarity of the marks it is clear that in paragraphs 43, 44, 45 and 48 of his Decision the Hearing Officer found that in the case of each of the marks that he was considering contained two surnames separated by an ampersand. The Hearing Officer also found that together such surnames formed the dominant and distinctive element of the mark. In paragraph 48 the Hearing Officer found that the name MASON in the marks might be perceived as a reference to the same person, or at least two persons sharing the same name but that the first name in each mark (FORTNUM and FITZROY) would clearly be perceived as a reference to different people. That is the finding that is reiterated in paragraph 58 of his Decision. There is no change in his approach to the marks.
57. Secondly, it is clear that whilst the Hearing Officer described the different elements of the marks he did so in the context of explaining the reasoning for his finding that 'X times Y does not equal Z' and not because he was adopting a 'salami slice' approach to the marks. In fact the Hearing officer makes clear that he is considering the marks as a whole when making the findings he did not only in paragraph 58 of the Decision

which resulted in his conclusion that *'I find that the difference in the first name of each mark is sufficient that it is not likely that the consumer will be confused'* but also in his findings in paragraphs 43, 44, 45 and 48 of his Decision.

58. In making his assessment of conflict under each of the different sections of the 1994 Act relied upon it is not disputed that the Hearing Officer correctly identified the legal principles to be applied.
59. The Hearing Officer then went on to make findings that are largely unchallenged. To the extent that the particular criticisms identified above have been made I have taken the view for the reasons set out above that they are unjustified.
60. In such circumstances, it is important to observe the distinction (as set out in paragraphs 26 and 27 above) between on the one hand making a decision at first instance and on the other hand determining on appeal whether it was open for the decision taker at first instance to arrive at the decision he did on a correct application of the law to the matter in dispute.
61. In relation to each of the sections under the 1994 Act relied upon the Hearing Officer addressed himself to the assessment that he was required to make from the correct legal perspective. He did not, when forming his view, take immaterial factors into account or disregard any material factors. I do not consider that on balancing the factors the Hearing Officer identified in the way he did, he came to a conclusion that was not open to him.

## **Conclusion**

62. In the circumstances it does not seem to me that F&M has identified any material error of principle in the Hearing Officer's analysis or that the Hearing Officer was plainly wrong. In the result the appeal fails.

63. Neither side has asked for any special order as to costs. Since the appeal has been unsuccessful Mac is entitled to its costs. I order that F&M pay a contribution towards Mac's costs of £1500, to be paid within 14 days of the date of this decision, together with the £2450 costs awarded by the Hearing Officer below.

Emma Himsworth Q.C.

3 September 2014

Mr. Hastings Guise (for Field Fisher Waterhouse LLP) appeared on behalf of Fortnum & Mason plc

Mr. Malcom Chapple (instructed by Lawrence Sternberg & Co) appeared on behalf of Mac Global Ltd

The Registrar was not represented at the hearing and took no part in the Appeal

## ANNEX

List of goods and services identified by the Hearing Officer from F&M's Statement of Grounds for which it claims use, in support of its grounds based upon Section 5(4(a) of the 1994 Act:

Cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; shower gels; body lotions.

Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments.

Paper, cardboard and goods made from these materials, not included in other classes; printed matter; photographs; stationery; artists' materials; office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); address books; books; cookery books; food and wine books; magazines; calendars; advent calendars; passport holders,

Leather and imitations of leather, and goods made of these materials and not included in other classes; trunks and travelling bags; umbrellas, parasols and walking sticks; harness and saddlery; bags; luggage; wallets; luggage tags.

Furniture, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics; hampers.

Household or kitchen utensils and containers (not of precious metals or coated therewith); combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; un-worked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes; tea pots; tea strainers.

Textiles and textile goods, not included in other classes; bed and table covers; tea towels  
Clothing, footwear, headgear; boots and shoes; clothing for use in the kitchen; pinafores; aprons; chefs' hats.

Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees; Christmas crackers.



Meat, fish, poultry and game; meat extracts; conserves; compotes; fruit conserves; caviar; pâté; partridge; grouse; pheasant; chicken; curried liver; curried mutton; curried chicken; fish pastes; hams; tongues; bacon; meat in tins, glasses and terriners; beefs extracts; preserved, dried, cooked and frozen fruits, vegetables, meats and fish; dry and boiled fruit; fruits in tins and bottles; cherries; pineapple; fruit salads; apricots; pears; peaches; grapefruit; prunes; plums; figs; marrons; jellies; jams; marmalade; mincemeat; soups; dairy products; eggs; milk; milk products; dairy products; edible oils and fats; preserves; fruit preserves, vegetable preserves; pickles; cheese; quark; cream; yoghurt; butter; flavoured butter; brandy butter; pickled onions; cranberry sauce; soup and preparations for making soup; gelatins; ready cooked meals of meat and fish; hampers containing meat fish, poultry and game, meat extracts, conserves, compotes, fruit conserves, caviar, pate, partridge, grouse, pheasant, chicken, curried liver, curried mutton, curried chicken, fish pastes, hams, tongues, bacon, meat in tins, glasses and terriners, beefs extracts, preserved, dried, cooked and frozen fruits, vegetables, meats and fish, dry and boiled fruit, fruits in tins and bottles, cherries, pineapple, fruit salads, apricots, pears, peaches, grapefruit, prunes, plums, figs, marrons, jellies, jams, marmalade, mincemeat, soups, dairy products, eggs, milk, milk products, dairy products, edible oils and fats, preserves, preserves, fruit preserves, vegetable preserves, pickles, cheese, quark, cream, yoghurt, butter, flavoured butter, brandy butter, pickled onions, cranberry sauce, soup and preparations for making soup, gelatins, ready cooked meals of meat and fish; potted meals.

Coffee, tea, cocoa and artificial coffee; Rice; Tapioca and sago; Flour and preparations made from cereals; Bread, pastry and confectionery; Ices; Sugar, honey, treacle; Yeast, baking-powder; Salt; Mustard; Vinegar, sauces (condiments); Spices; Ice  
Coffee; tea; black tea; black tea in bags; herbal tea; green tea; green tea in bags; cocoa; artificial coffee; coffee essences and coffee extracts, mixture of coffee and chicory; chicory and chicory mixtures, all for use as substitutes for coffee; scented tea and flavoured tea; sugar; rice, tapioca, sago, coffee substitutes; flour, and preparations made from cereals; bread; spiced bread; biscuits; cakes; pastry and confectionery; ices; ice cream; honey; treacle; yeast, baking powder; salt; mustard; pepper; vinegar; sauces; spices; ice; condiments, curry powder; non-medicated confectionery; sugar confectionery; petit fours; salt (for food); relish sauces (excluding cranberry sauce and apple sauce); chutney; puddings; poppadums; pancakes; fruit sauces; salad sauces and dressings; hampers containing coffee, tea; black tea, black tea in bags, herbal tea, green tea, green tea in bags, cocoa, artificial coffee, coffee essences and coffee extracts, mixture of coffee and chicory, chicory and chicory mixtures, all for use as substitutes for coffee, scented tea and flavoured tea, sugar, rice, tapioca, sago, coffee substitutes, flour, and preparations made from cereals, bread, spiced bread, biscuits, cakes, pastry and confectionery, ices, ice cream, honey, treacle, yeast, baking powder, salt, mustard, pepper, vinegar, sauces, spices, ice, condiments, curry powder, non-medicated confectionery, sugar confectionery, petit fours, salt (for food), relish sauces (excluding cranberry sauce and apple sauce), chutney, puddings, poppadums, pancakes, fruit sauces, salad sauces and dressings; all edibles in tins and glasses

Agricultural, horticultural and forestry products and grains not included in other classes; live animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals; malt; hampers containing fresh fruits and vegetables, seeds, natural plants and flowers, foodstuffs for animals, malt.

Beers, ale and porter; non-alcoholic drinks and preparations for making such drinks; mineral and aerated waters; soft drinks; non-alcoholic beverages; fruit and vegetable drinks and fruit and vegetable juices; syrups and other preparations for making beverages; hampers containing beers, ale and porter, non-alcoholic drinks and preparations for making such drinks, mineral and aerated waters, soft drinks, non-alcoholic beverages, fruit and vegetable drinks and fruit and vegetable juices, syrups and other preparations for making beverages.

Alcoholic beverages (except beers); wines, spirits and liqueurs; cider and sherry; port wine; champagne; hampers containing alcoholic beverages (except beers), wines, spirits and liqueurs, cider and sherry, port wine, champagne.

Advertising; business management; business administration; office functions; the bringing together, for the benefit of others, of a variety of goods, namely, perfumery, cosmetics, shower gels, body lotions, printed matter, books, magazines, leather goods, luggage, wallets, passport holders, luggage tags, furniture, hampers, hampers containing food, household or kitchen utensils and containers, tea pots, tea strainers, caddy spoons, textiles and textile goods, tea towels, clothing, footwear, headgear, aprons, chefs' hats, games and playthings, decorations for Christmas trees, meat, fish, poultry and game, meat extracts, caviar, pate, partridge, grouse, pheasant, chicken, curried liver, curried mutton, curried chicken, fish pastes, hams, tongues, bacon, meat in tins, glasses and terrines, beef extracts, preserved, dried and cooked fruits and vegetables, fruits in tins and bottles, cherries, pineapple, fruit salads, apricots, pears, peaches, grapefruit, prunes, plums, figs, marrons, jellies, jams, marmalade, chutneys, mincemeat, soups, fruits sauces, dairy products, eggs, milk, milk products, edible oils and fats, preserves, fruit preserves, vegetable preserves, pickles, salad sauces, flavoured butter, brandy butter, dressings, pickled onions, cranberry sauce, soup and preparations for making soup, coffee, tea, black tea, black tea in bags, herbal teas, green tea, green tea in bags, cocoa, artificial coffee, coffee essences and coffee extracts, mixture of coffee and chicory, chicory and chicory mixtures, all for use as substitutes for coffee, scented tea and flavoured tea, sugar, rice, tapioca, sago, coffee substitutes, flour, and preparations made from cereals, bread, spiced bread, biscuits, cakes, pastry and confectionery, ices, honey, treacle, yeast, baking powder, salt, mustard, pepper, vinegar, sauces, spices, ice, condiments, curry powder, and all edibles in tins and glasses, non-medicated confectionery, sugar confectionery, petit fours, salt (for food), relish sauces (excluding cranberry sauce and apple sauce), chutney, puddings, poppadums, pancakes, beer, ale and porter, non-alcoholic drinks and preparations for making such drinks, mineral and aerated waters, soft drinks, non-alcoholic beverages, fruit drinks and fruit juices, alcoholic beverages (except beers), wines, spirits and liqueurs, cider and sherry, port wine, enabling customers to conveniently view and purchase those goods in a department store, in an airport retail outlet, from a general merchandise catalogue

by mail order, a general merchandise Internet site or by means of telecommunications; advice and assistance in the selection of goods; provision of advisory and information services in relation to the aforesaid services.

Delivery services; delivery of goods; delivery of goods by mail order or any other means; distribution of goods; storage of goods, transportation of goods; packaging of goods

Services for providing food and drink; temporary accommodation; takeaway food services; restaurant services; tea room services; catering services