

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

**IN THE MATTER OF APPLICATION NOS. 1562322 AND 1562325
BY MUSTO LIMITED
TO REGISTER A TRADE MARK IN CLASSES 24 AND 25**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NOS. 42686 AND 42794 BY J BARBOUR & SONS LTD**

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20 **DECISION**

On 11 February 1994, Musto Limited of Laindon, Essex, applied under Section 17(1) of the Trade Marks Act 1938 to register the trade mark THORNGUARD in Classes 24 and 25 in respect of the following goods:

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Application No. 1562322
Fabrics for use in the manufacture of clothing; all included in Class 24.

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Application No. 1562325
Jackets, coats, hats, hoods, trousers, leggings, waistcoats, socks, gloves, vests, shirts, jumpers, body warmers and scarfs; all included in Class 25.

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On 29 June 1995 and 17 July 1995 respectively, J Barbour & Sons Limited filed Notices of Opposition against these applications. In respect of both applications, the grounds of opposition are, in summary:-

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1. under Section 12(1), by reason of the fact that the mark applied for is confusingly similar to trade mark No. 1197039, registered in the name of the opponents, in respect of the same goods or same description of goods.

2. under Section 11 by reason of the use by the opponents of their trade marks THORNSPROOF and BARBOUR THORNSPROOF such that use by the applicants of their trade mark is likely to deceive or cause confusion.

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The opponents also ask that the Registrar refuse the application in the exercise of his discretion.

Details of the registration referred to above are as follows:

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5	<u>No.</u>	<u>Mark</u>	<u>Class</u>	<u>Specification</u>
10	No. 1197039	BARBOUR THORNPROOF	25	Articles of outerclothing, and parts and fittings therefor included in Class 25.

(rights to the exclusive use of the word THORNPROOF are disclaimed).

15 The applicant filed counterstatements denying the grounds of opposition.

Both sides seek an award of costs in their favour.

20 The parties agreed to consolidate these two opposition proceedings and filed evidence accordingly. The matter came to be heard on 21 November 1997 when the applicants were represented by Mr J Caisley of Grant Spencer Caisley & Porteous, their trade mark agents. The opponents were represented by Dr D Harrison of Mewburn Ellis, their trade mark agents.

25 By the time the matter came to be heard, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. In accordance with the transitional provisions set out in Schedule 3 to that Act however, I must continue to apply the relevant provisions of the old law to these proceedings. Accordingly, all references in this decision are references to the provisions of the old law unless otherwise indicated.

30 **OPPONENTS EVIDENCE (RULE 49)**

35 The opponents filed a Statutory Declaration dated 15 April 1996 by Mr Brian Scullion who is Company Secretary to J Barbour & Sons Limited, a position he has held for six years, having been with the Company for thirteen years.

40 Mr Scullion states that his company has used the trade mark THORNPROOF on its own or in conjunction with the trade mark BARBOUR, or other trade marks of his company, since 1951, and that that use has been continuous. He explains that fabrics are made for his company to their specification and these fabrics are then used to produce clothing on which the trade marks THORNPROOF or BARBOUR THORNPROOF are applied. About 80% of the clothing produced by his company is made up from the fabrics made to their specification.

45 Mr Scullion goes on to state that his company's use of the trade marks is in relation to smooth closely woven fabrics, almost always 100% cotton, which are then waterproofed usually by waxing. He believes that the use that his company has made, and continues to make, of the word THORNPROOF in connection with these fabrics, and the clothing made from it, is entirely distinctive and characteristic of goods made and sold by J Barbour & Sons Limited.

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5 The trade mark THORNPROOF has, says Mr Scullion, been widely publicised in sales and
other literature. He exhibits a pamphlet, exhibit BS1, entitled “Barbour - Generations of
knowing country people” which shows use of the terms THORNPROOF, BARBOUR
THORNPROOF, along with HEAVYWEIGHT THORNPROOF, MEDIUM WEIGHT
THORNPROOF and LIGHTWEIGHT THORNPROOF. Exhibit BS2 is a sales catalogue
10 dated 1988 showing use of the trade mark THORNPROOF in connection with both fabrics
and clothing.

Mr Scullion goes on to explain that every garment made has sewn into it a care label and
attached to it a swing tag both of which make reference to the trade mark THORNPROOF;
15 examples are provided at BS3 and BS4. Further, every article of clothing sold by the
company, apart from small articles, is accompanied by a mini catalogue which makes reference
to the trade mark THORNPROOF, an example of such use is exhibited at BS5. At BS6 Mr
Scullion provides a copy of the earliest advertisement, dating from 1951, showing use of the
trade mark THORNPROOF.

20 Mr Scullion then details sales of clothing associated with the trade marks consisting of or
incorporating THORNPROOF over the last ten years as follows.

25	1986 to 1987	£13,063,632
	1987 to 1988	£18,578,581
	1988 to 1989	£17,902,551
	1989 to 1990	£16,811,180
	1990 to 1991	£20,929,171
	1991 to 1992	£27,442,258
30	1992 to 1993	£36,695,193
	1993 to 1994	£49,526,833
	1994 to 1995	£51,258,551
	1995 to application date	£22,939,082

35 The figures quoted here are ex factory prices, the average mark-up to retail price will, says
Mr Scullion, be approximately 80%. He goes on to state that the mark has been the subject of
widespread advertising in trade and consumer journals as well as in catalogues, for example,
Country Life, The Field, Shooting Times, Horse and Hound, Countryman etc. Expenditure on
advertising over the last ten years has been as follows:-

40	1986 to 1987	£ 580,695
	1987 to 1988	£ 636,438
	1988 to 1989	£ 6,013,232
	1989 to 1990	£ 1,204,642
45	1990 to 1991	£ 602,487
	1991 to 1992	£ 761,314
	1992 to 1993	£ 932,436
	1993 to 1994	£ 845,586
50	1994 to 1995	£ 960,911

Mr Scullion believes that as a result of this prolonged use, and his company’s presentation of

5 the trade mark THORNPPOOF, the public would expect that any fabric of the general nature
he has described, or clothing made from it, to derive from his company. Further, in his
opinion, the element THORN is the most important element as it is that element which is
recognised by the public. The suffix elements of the respective trade marks of his company's
and the applicants, PROOF and GUARD, are very similar in their meaning and he considers
10 that if a member of the public noted the difference they would think only that it was some
other grade or quality of material, or clothing made from it, which derived from his company.
He therefore considers that allowing the application to proceed would be to cause confusion
with their trade marks BARBOUR THORNPPOOF and THORNPPOOF.

15 **THE APPLICANTS EVIDENCE (RULE 50)**

The applicants filed a Statutory Declaration from Mr Philip Lindsay Booth dated 16 October
1996. He is the Financial Director and Company Secretary of Musto Limited, a position he
has held for six years.

20 Mr Booth states that his company has used the trade mark THORNGUARD for the past three
years and as evidence of that exhibits his company's catalogues for each of the years 1994/95,
1995/1996, 1996/1997 under exhibit No. M1, M2 and M3 respectively. He states that fabrics
are made for his company to its specification and these fabrics are then used to manufacture
25 clothing. The trade mark THORNGUARD, he says, has been used in advertisements and in
catalogues to describe the fabric and construction system of the various jackets the applicant
sells. These jackets have been of three types, the Musto Highland, the Musto Heathland and
the Musto Professional Equestrian. The sales of these for the last two years are shown
below:-

	1995/96	1994/95
<u>Jacket Type</u>	<u>Sales</u>	<u>Sales</u>
	£k	£k
35 Highland	224	340
Heathland	86	109
Professional Equestrian	104	122

40 At exhibits M4 and M5 are advertisements placed in various magazines ie. The Shooting
Times, Field, Horse and Hound etc. in the year October 1995 to September 1996. The total
cost of these advertisements exceeds £15,000.

45 Mr Booth believes that the term THORNPPOOF as used by Barbour and THORNGUARD as
used by Musto are completely different phonetically and would not be confused by the general
public at large. Further, he states that the term THORNPPOOF is misleading in relation to
clothing in that it is extremely difficult to make clothing that is thorn proof in the strict sense
of the word. Brambles and thorns invariably tear even the toughest fabrics.

5 Mr Booth acknowledges that Barbour is a well known brand, but states that Musto have also developed a strong reputation in the country clothing market. Their use of THORNGUARD is not an attempt to pass off their garments as similar to those of Barbour as the price of their garments is invariably more expensive than Barbour's wax and cotton jackets. The trade and retail prices shown at Exhibit M6 support this, states Mr Booth. A typical Barbour jacket
10 retails at prices of between £100 and £180 whereas a Musto jacket retails at between £280 and £300. He does not consider therefore that there is any possibility of confusion in the marketplace between the respective products.

15 That completes my review of the evidence filed in these proceedings. I must however record that the applicants representative, Mr J Caisley, sought during the hearing to introduce some further reference material into the proceedings. I refused to allow it to be entered into the proceedings. It had been, or could have been, in the possession of the applicants for some considerable time before the hearing took place so there was therefore ample opportunity for the applicant to have sought leave to file it earlier. Also, it was not in a Statutory Declaration
20 or Affidavit form, and even if it could have been otherwise admitted there would have been little or no opportunity for the opponents to respond effectively without an adjournment of the Hearing and increased costs to both parties.

25 DECISION

I turn to the grounds of opposition which are based upon Sections 11 and 12(1) of the Act, which state:

30 **11.** It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.

35 **12(1)** Subject to the provisions of subsection (2) of this section, no trade mark shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of-

- 40 (a) the same goods,
- (b) the same description of goods, or
- (c) services or a description of services which are associated with those goods or goods of that description.

45 The reference in Section 12 to a near resemblance is further elucidated by Section 68(2)(b) of the Act which states that reference to a near resemblance of marks are reference to a resemblance so near as to be likely to deceive or cause confusion.

50 The established tests for grounds of opposition based upon Sections 11 and 12 are set down in Smith Hayden & Co Ltd's application (volume 1936 63 RPC 101) as adapted by Lord Upjohn in the BALI trade mark case 1969 RPC 496. Adapted to the matter in hand, the relevant tests

5 may be expressed as follows:-

- 10 (a) (Under Section 11). Having regard to the user of the trade marks BARBOUR THORNPPOOF and THORNPPOOF is the tribunal satisfied that the marks applied for, THORNGUARD, if used in a normal and fair manner in connection with any goods covered by the registration proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?
- 15 (b) (Under Section 12). Assuming user by the opponents of their trade mark BARBOUR THORNPPOOF in a normal and fair manner for any of the goods covered by the registration of this mark, is the tribunal satisfied that there will be no reasonable likelihood of deception among a number of persons if the applicant's use their mark, THORNGUARD, normally and fairly in respect of any goods covered by their proposed registrations.
- 20

I deal first of all with the grounds of opposition based upon Section 11.

25 The evidence shows that the opponents have used the registered trade mark BARBOUR THORNPPOOF and the trade mark THORNPPOOF on, or in connection with, what has been described as "country clothing" ie. waxed jackets and other water repellent clothing. Such use has been continuous since 1951 and I am satisfied that the opponents have a reputation in their marks in relation to such goods. These are the same goods as those set out in the specification of goods covered by application No. 1562325 to register the word THORNGUARD in Class 25. The applicants are also seeking to register the trade mark under application number 30 1562322 in Class 24 for the fabric used to make up their clothing. Thus both the applicants and the opponents country clothing is made up from fabric which bear their respective trade marks. In both cases, the applicants and the opponents use their trade marks in association with the fabrics themselves. It would appear therefore that in the country clothing field in which both parties operate there is a very direct association between the finished garments and 35 the material from which they are made. This is not surprising given the emphasis by manufacturers of such clothing to the protective and durable qualities of their products. Thus in the minds of the public the garments and the material from which they are made are very closely related. In the circumstances I hold that the goods covered by the opponents registration in Class 25 are the same or very similar to the goods covered by the specifications 40 of the applications in Classes 24 and 25. It appears to me that if the respective trade marks are found to be confusingly similar then there is every likelihood of deception and confusion of the public. I therefore go on to compare the respective marks.

45 In my comparison of the respective marks THORNPPOOF and BARBOUR THORNPPOOF with THORNGUARD I take account of the guidance set down by Parker J in Pianotist Companies application (volume 1906) 23 RPC 777 at line 26 et seq, which reads as follows:-

50 You must take the two words. You must judge of them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In

5 fact, you must consider all the surrounding circumstances; and you must further
consider what is likely to happen if each of those trade marks is used in a normal way
as a trade mark for the goods of the respective owners of the marks. If, considering all
those circumstances, you come to the conclusion that there will be a confusion - that is
10 to say, not necessarily that one man will be injured and the other will gain illicit benefit,
but that there will be a confusion in the mind of the public which will lead to confusion
in the goods - then you may refuse the registration, or rather you must refuse the
registration in that case.

15 I compare first of all THORNPRESS with THORNGUARD. I note that there are differences
between these trade marks both from the phonetic and visual points of view. However, both
have the same prefix, the word THORN, which I consider to be the dominant element in both
trade marks and it is well established that when comparing marks the prefix elements are very
significant features. In this respect I refer to the established guidance in the comparison of
20 marks, which is expressed in Kerley's Law of Trade Marks & Trade Names, 12th Edition at
17-30 on page 445, as follows:-

“Importance of first syllable.

25 It has been accepted in several reported cases that the first syllable of a word mark is
generally the most important. It has been observed in many cases that there is a
tendency of persons using the English language to slur the termination of words”.

30 In addition, I pay particular regard to the submission by Mr Scullion in his evidence and
submitted by Dr Harrison at the Hearing that the words ‘PROOF’ and ‘GUARD’ are very
similar in their meaning when associated with goods in the nature of country clothing.
Therefore, as a totality, THORNPRESS and THORNGUARD conjure up in my mind, and I
would think the minds of the public at large the same image ie. Clothing which is made from
material which will withstand heavy use or wear (being thorn proofed or guarded).

35 I go on to compare BARBOUR THORNPRESS with THORNGUARD. In respect of the
opponents’ trade mark, it was pointed out to me at the Hearing that the term THORNPRESS
was the subject of a disclaimer. However, as the Assistant Registrar stated in GRANADA
1979 RPC 13:-

40 “As Lloyd-Jacob J. put it in Ford-Werke’s application [1955] 72 RPC 191 at 195 lines
30-38, a disclaimer does not affect the significance which a mark conveys to others
when used in the course of trade. Disclaimers do not go into the market place, and the
public generally has no notice of them”.

45 Taking that into account I go on to consider these trade marks against the guidance set down
by Parker J. in Pianotist Companies application and, in addition I have regard to BULOVA
ACCUTRON [1969] RPC 4 at page 109 where Mr Justice Stamp said:-

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5 The Assistant Registrar in coming to his conclusion said this:

10 “The present issue is not simply a comparison of two words; but the
comparison of one word with a composite mark the second component of
which has been held to be confusingly similar to Accurist. Can this component
be said to be rendered innocuous now that it appears with and is proceeded by
15 Bulova? I do not think that it is and that there is any less risk of deception or
confusion. I think that a person having, for example, an imperfect recollection
of Accurist is just as likely to confuse it with Accutron in the composite mark.
As Bulova and Accutron do not hold together as a phrase or present a wholly
different meaning from the separate components, I think that their combination
will be taken by many persons on first impression as an indication that the
20 manufacturer of the watches is using two separate trade marks in connection
with his products. A person meeting Bulova Accutron and confusing the latter
word with Accurist is, I think, likely to consider that Bulova is another trade
mark which he had previously not observed or which had not been drawn to his
attention before”.

25 Mr Justice Stamp states that he “so fully agrees with the passage which he has just read that he
is content to incorporate it into his judgement”.

30 In this case, I have already held the words THORNPPOOF and THORNGUARD to be
confusingly similar. The risk of confusion or deception in respect of the trade mark
THORNGUARD is not reduced in my view, when the comparison is made with the trade
mark BARBOUR THORNPPOOF. Anyone knowing the latter could assume that each
element is a separate trade mark of J Barbour and Sons Ltd and therefore when encountering
the word THORNGUARD assume that it is another trade mark of the opponents.

35 In summary, I find that the opponents have a reputation in the trade marks BARBOUR
THORNPPOOF and THORNPPOOF in respect of country clothing and that any use by the
applicant of their trade mark THORNGUARD in relation to the same or similar goods is likely
to cause confusion and deception amongst a substantial number of people. The opposition
based upon Section 11 therefore succeeds.

40 I turn next to the ground of opposition based upon Section 12, where the comparison is
between the opponents trade mark BARBOUR THORNPPOOF and THORNGUARD.
Having already held that these two trade marks are confusingly similar in respect of the
ground of opposition based upon Section 11, I do so again in respect of the Section 12
ground. In the case of the applicants Class 25 application identical goods are at issue. In the
45 case of the applicants Class 24 application I believe the respective goods are so similar that
they are clearly “goods of the same description”. I therefore consider that use by the
applicants of their trade mark THORNGUARD, normally and fairly in respect of any goods
covered by the specifications of the applications, is likely to cause deception among a number
of persons. The opposition based upon Section 12 therefore also succeeds.

50 Finally, there remains the matter of the Registrar’s discretion but as the opponents have been

5 successful in respect of their opposition under both Sections 11 and 12 no exercise of that discretion is either necessary or appropriate.

10 As the opponents have been successful in these proceedings they are entitled to a contribution to their costs. I hereby order the applicants to pay to the opponents the sum of £1,200 as a contribution to their costs.

Dated this 27 day of January 1998

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20

25 **M KNIGHT**
For the Assistant Registrar
The Comptroller General