

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 202904
BY ADRIAN THAWS
TO REGISTER A SERIES OF TWO TRADE MARKS
DURBAN POISON (stylised) & **DURBAN POISON**
IN CLASSES 9, 16, 25, 28 & 41

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 46980
BY KABUSHIKI KAISHA D'URBAN (D'URBAN INCORPORATED)

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DECISION

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BACKGROUND

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On 2 August 1995, Adrian Thaws C/o Fruit, The Sagacentre, Unit 104, 326 Kensal Road, London, WC10 5BZ applied under the Trade Marks Act 1994 for registration of a series of two trade marks:

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DURBAN POISON

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In respect of the following goods:

In Class 9: "Films, videos, cassettes, records, compact discs, discs, software; sound and/or video recordings"

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In Class 16: "Stationery, printed matter, books, magazines, stickers, photographs, posters, bags, prints, albums, cards."

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In Class 25: "Casual clothing for men, women and children; t-shirts, shorts, shirts, tracksuits, socks, athletics and sports clothing; caps, hats; clothing accessories including belts and scarves; casual footwear; sports footwear."

In Class 28: "Toys, games and playthings, sporting articles; parts and fittings for the aforesaid goods."

And in Class 41: “Entertainment services; film production; presentation of live performances; publishing services; sound recording services; performing of music and singing; production of text.”

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On the 6 June 1997 Kabushiki Kaisha D’urban (D’urban Incorporated) filed notice of opposition to the application. The grounds of opposition are:

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i) The opponents are the proprietors of United Kingdom trade mark registration No 1422040 advertised in Trade Marks Journal 5966 at page 1619 (hereinafter referred to as “the Trade Mark”).

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ii) Sales have been made in the United Kingdom by reference to the Trade Mark.

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iii) Application No2029014 (hereinafter referred to as “the application” offends against the provisions of Section 5 of the Act in that it is similar to the Trade Mark and is to be registered for goods which are identical with and/or similar to those for which the Trade Mark is protected, and there exists a likelihood of confusion on the part of the public which includes the likelihood of association with the Trade Mark.

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iv) The application also offends against the provisions of Section 5 of the Act in that its use in the United Kingdom is liable to be prevented by virtue of the law of passing off.

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v) The opponents ask that the application be dismissed, that an award of costs be made in their favour, and that the Registrar consider any additional or alternative relief in their favour as may be deemed appropriate..

The applicant did not file a counterstatement, nor any evidence. The opponents did not wish to be heard in the matter. My decision will therefore be based on the pleadings and the evidence filed.

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OPPONENTS’ EVIDENCE

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This takes the form of two statutory declarations. The first dated, 30 July 1998, is by Ms Jane More O’Ferrall, a trade mark attorney and partner in the firm of Haseltine Lake Trademarks advisers to the opponents.

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Ms O’Ferrall comments on the lack of evidence from the applicant and the fact that he is unrepresented and that correspondence sent to him is being returned. She also claims that the most distinct part of the opponents’ mark is the word D’URBAN.

The second statutory declaration, dated 26 August 1998, is by Mr Toshiro Mizuno the President of Kabushiki Kaisha D’urban (D’urban Inc) a position he has held since 1990.

Mr Mizuno attaches at exhibit KKD1 a copy of a statutory declaration by Mr Robert Murray. This declaration was submitted in support of the opponents own application for registration. As such it deals with the position up to 1991. Mr Mizuno confirms that the opponents' mark has continued to be used in the UK since this date and has increased its' turnover substantially.

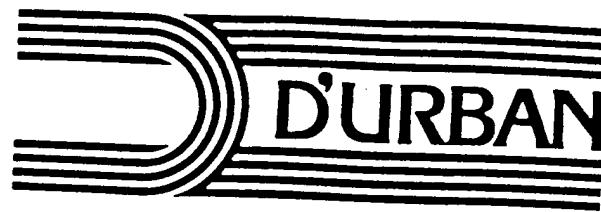
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Exhibit KKD1 comprises a statutory declaration, dated 3 April 1992, by Mr Robert Murray and also exhibits attached to that declaration. In his declaration Mr Murray states that he is a director of I.D.D.(UK) Ltd which is an international division of Kabushiki Kaisha D'urban.

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Mr Murray states that the trade mark D'URBAN & device has been used in the UK since 1979 in relation to Men's suits, jackets and slacks. He provides at exhibit RM1 a sample of the trade mark. This shows the following mark:

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Mr Murray also provides details of the turnover in the mark in the UK (although details from 1979 were provided, I have shown only the last four years):

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Year	Approx. Annual Turnover £
1988	1,276,100
1989	1,277,275
1990	1,460,000
1991	1,423,000

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Mr Murray states that very little advertising has taken place for the goods under the mark as advertising has mainly been in conjunction with their customers. Mr Murray gives as an example Harrods where he claims the clothing has featured in a window display and similarly with Austin Reed outlets throughout the UK.

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At exhibit RM2 Mr Murray provides examples of brochures from Harrods which show use of the opponents' mark. Also in this exhibit are invoices showing the supply of products to Harrods in 1989 & 1990. Lastly the exhibit has copies of labels which shows the opponents' mark and the name of Harrods. The labels show the products are produced by the opponent for the store.

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Finally Mr Murray claims that products bearing the opponents mark are sold in most of the major towns and cities in the UK, and he provides a list of 37 such locations.

That concludes my review of the evidence. I now turn to the decision.

5 *in particular, their distinctive and dominant components. The wording of Article 4(1)(b) of the Directive - “there exists a likelihood of confusion on the part of the public” - shows that the perception of the marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.*

10 *In that perspective, the more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either per se or because of the reputation it enjoys with the public.”*

15 I also have regard to the approach adopted by the European Court of Justice in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc.* (case C-39/97) (ETMR 1999 P.1) which also dealt with the interpretation of Article 4(1)(b) of the Directive. The Court in considering the relationship between the nature of the trade mark and the similarity of the goods stated:

20 *“A global assessment of the likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between these goods or services. Accordingly, a lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the marks, and vice versa. The interdependence of these factors is expressly mentioned in the tenth*
25 *recital of the preamble to the directive, which states that it is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion, the appreciation of which depends, in particular, on the recognition of the trade mark on the market and the degree of similarity between the mark and the sign and between the goods or services identified.”*

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35 The opponents’ mark is registration for the following in Class 25, “Suits, jackets and slacks, all for men”. This specification is clearly encompassed in the applicant’s specification in the same class. The applicant’s specification includes clothing for women and children and footwear which although not identical to the opponents’ goods are similar.

40 The applicants remaining goods in Classes 9, 16, 28 & 41 are clearly not similar to any goods for which the opponents’ mark is registered. It is my opinion that the goods in these classes are so far removed from those of the opponents that even if the two trade marks were identical that they do not form an obstacle under the provision of Section 5(2). The opposition under Section 5(2) in relation to Classes 9,16, 28 and 41 therefore fails.

45 I turn therefore to consider whether, taking into account the fact that the goods in Class 25 covered by the application are the same or similar to the goods of the opponents, the trade marks themselves are similar.

5 Visually, the opponents mark is formed of a word and a device element. The device is not very distinctive and clearly the prominent feature is the word D'URBAN. This word (with the exception of the apostrophe) is the first word of the applicant's mark (Durban). The applicant's mark also has a second word (Poison). The stylisation is present in only one version of the applicant's mark, I therefore have to consider the mark in normal type as well. They convey a similar image.

10 Phonetically, the first word in each of the marks is identical. It is my opinion that the apostrophe in the opponents' mark will not lead to the pronunciation being significantly different. The applicant's mark has a second word but it is accepted that the public attributes greater importance to the beginning of a mark in identifying a sign than it does to the following components. The marks in my view are likely to be confused aurally.

15 Conceptually neither mark conveys a particular image.

20 The opponents have provided evidence that they had sold certain clothing articles (suits, jackets, and slacks) under the mark prior to the material date, 2 August 1995. The opponents have provided sales figures relating to the period 1988 - 1991 showing sales of £5.4 million. Although this period is some time prior to the material date, the opponents have stated that sales have continued up to the time of the declaration, 1998, and they state that they have increased in value. The sales figures in the context of the clothing industry are not vast but cannot be regarded as de minimis.

25 The applicant has not filed a counterstatement or any evidence disputing the opponents statements.

30 I must consider the marks as wholes and take into account the similarity between the opponents goods and the applicants specification in Class 25. The goods are similar, as are the marks and there exists a likelihood of confusion. The opposition under Section 5(2) for goods in Class 25 therefore succeeds in respect of both the applicant's marks..

35 Finally, I turn to the ground of opposition under Section 5(4) which states:

"5. (4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

40 *(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or*

45 *(b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.*

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark."

In deciding whether the mark in question “DURBAN POISON” offends against this section, I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the WILD CHILD case (1998 14 RPC 455). In that decision Mr Hobbs stated that:

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“The question raised by the Grounds of Opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the Applicant from those of other undertakings (see Section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Art.4(4)(b) of the Directive and Section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the Applicant in accordance with the law of passing off.

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A helpful summary of the elements of an action for passing off can be found in Halsbury’s Laws of England 4th Edition Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in Reckitt & Colman Products Ltd - v - Borden Inc [1990] RPC 341 and Even Warnik BV - v - J. Townend & Sons (Hull) Ltd [1979] AC 731 is (with footnotes omitted) as follows:

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‘The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

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(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

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(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

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The opponents have shown that they have acquired goodwill under their mark by the relevant date. The goodwill is in their business as a clothing supplier. Earlier in this decision I found that the use of the applicants’ mark on clothing related goods in Class 25 would cause confusion. Such use would be a misrepresentation and damage can be inferred in these circumstances. Therefore the opposition under Section 5(4) for goods in Class 25 succeeds.

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The opponents also contend that their mark has such reputation that anyone who saw the use of the marks “DURBAN POISON” on goods in Classes 9,16,28 & 41 would assume that they came from the opponents.

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None of the opponent’s exhibits showed use of the trade mark on goods other than clothing. Apart from the opponent’s assertion there is no evidence of a likelihood of confusion or deception if the applicant’s marks are used in respect of the dissimilar goods and services which fall into Classes 9,16,28 & 41. Therefore it cannot be assumed that the public would find the applicants’ use of their trade mark as deceptive in such circumstances. As I am not convinced that members of the public would have confused the products of the applicants for those of the opponents the opposition under this section fails.

5 The opposition to the applicants' mark in relation to "Casual clothing for men, women and children; t-shirts, shorts, shirts, tracksuits, socks, athletics and sports clothing; caps, hats; clothing accessories including belts and scarves; casual footwear; sports footwear" in Class 25 has been successful. As grounds for refusal exist only in respect of goods in Class 25 the application will be allowed to proceed to registration if, within one month of the end of the appeal period for this decision, the applicants file a TM21 deleting Class 25.

10 If the applicants do not file a TM21 restricting the specification as set out above the application will be refused in its entirety.

The opposition having partly succeeded the opponents are entitled to a contribution towards their costs. I order the applicants to pay them the sum of £400

15 Dated this 30 day of December 1999

20 George W Salthouse
For the Registrar
The Comptroller General